FICPI WORLD CONGRESS
Frequently simple to register, invariably complex-to-enforce, trademark registrations are reaching record heights. Many offices forego relative ground examination and allow or even encourage the grant of rights in association with goods and services beyond true commercial interests.

Trademark clogging is becoming a concerning issue complicating clearance and enforcement and driving up cost. Unrepresented applicants are also adding cost.

How can companies new on the scene cope?
Moderator:
Coleen Morrison
Managing Principal
Marks & Clerk
Speaker:
Mireia Curell Aguilà
Managing Partner
Curell Suñol SLP
Speaker:
Ian Isdale
Group Company Secretary and Legal Adviser
Tiger Brands
Speaker:
Jef Vanderkerckhove
IP Consultant
(formerly IP & S manager PGI at Philips International B.V.)
Getting protection

- Extent of protection of trademark registrations
- Clearance searches and register clogging
- Excess of information
- Filing strategies
Enforcing rights

- Value of the mark: weak or strong marks
- Opposition policy
- Defensive policy
- Use of the mark
TRADEMARKS

Free information, accessibility, timeliness, efficiency of operations, cost-effectiveness
Consonances & Dissonances
TRADEMARKS

More for less? Too much?
Clearing the way
Cancellation & Revocation
Excess of information
Filing strategies
Word or device? Color or b&w?
Unrepresented applicants
Enforcing the rights
Distinctiveness

Most distinctive

- Coined
- Arbitrary

Less distinctive

- Suggestive
- Descriptive
TRADEMARKS

Examples
Examples

FLAVOUR AND AROMA

LoC T-149/12

Fresh Sardine

micro
The weak character of the verbal element “micro” does not necessarily mean that it cannot constitute a dominant element of the earlier mark if the validity of the mark is not to be called into question and does not preclude a finding of a likelihood of confusion.

The fact that a mark has been registered means that that mark has a minimum of inherent distinctive character.

The word element MICRO must be regarded as the dominant element of both applied for and opponent’s mark.
Examples

LoC C-422/12

CLORALEX / CLOROLOX

No LoC T-272/13

M&Co.   MAX&Co.
TRADEMARKS

Opposition
TRADEMARKS

Defense
TRADEMARKS

Avoiding genericide
Adapt use to protection?
Adapt protection to use?
Conclusions
SOME PRACTICAL HINTS FROM A CLIENT ON TRADE MARKS IN AFRICA
TIGER BRANDS FOOTPRINT IN AFRICA

On-shore manufacturing
Export territories

NIGERIA

CAMEROON

SOUTH AFRICA

ETHIOPIA

KENYA
• Clogging in Africa
  - unusual
  - too expensive

• Registration is key

• Identify markets, marks and classes as soon as possible
• Registration searches not necessarily reliable, but should be considered as may highlight direct conflicts

• Registration is a long haul
• Do not file directly - use reputable firm

• Use trade mark management system or use a firm that has one
OAPI

Oapi is a very effective mechanism for Francophone countries

Frankophone countries
WHAT ARE THE...?
Thank you for your attention!