

GUIDELINES FOR THE CUSTOMIZATION  
OF THE TRADEMARK GUIDE  
MAKING A MARK - AN INTRODUCTION TO TRADEMARKS FOR  
SMALL AND MEDIUM-SIZED ENTERPRISES

Overall objective

- The main objective of customizing the guide is to make it suitable for providing specific guidance to SMEs based on national trademark law, regulations, practices, forms, fees, institutions, trademarks agents, other trademarks services, case law providers, court decisions, and the specific administrative procedures available in each country.
- While doing so, include illustrations, examples and case studies from the country for which the guide is being customized. Authorization for the images included in the international edition of the guide have only been granted for that specific edition. Therefore, customized guides should include different examples and images or, if the same images are included, authorization should be requested directly to the relevant companies.
- The guide is to be translated into the local language(s).

General remarks

- The words “your national trademark office” should be replaced every time they appear with the actual name of the industrial property (IP) office in your country.
- The words “your country” should be replaced every time they appear with the name of your country.

SECTION 1: TRADEMARKS

What is a Trademark?

- Provide the exact definition as contained in your national law.
- Can advertising slogans be protected in your country? If so, explain.
- Can less traditional forms of trademarks (e.g. sounds, smells, etc.) be protected in your country? If so, explain.
- As far as possible, the examples should be of trademarks of businesses which are considered to be “national” or “local”. If not possible, invented marks may also be used to illustrate this section.

SECTION 2: PROTECTING TRADEMARKS

How can your company protect its trademark(s)?

- State whether unregistered trademarks are protected through use in your country. If not, you may still make reference to the fact that some countries protect trademarks through use, but you should make it clear that this is not the case in your country.
- State when the use of a trademark agent is compulsory, if at all, for registering trademarks in your country.
- State whether a trademark application may be filed on-line in your country and include a reference to the Internet address where the on-line application form can be found, if available.
- Is there a provision for registration of defensive trademarks?
- Is there a single trademark register or does it have part A and part B with different categories of rights?

Is the registration of the trade name of your company sufficient?

- State whether trade names applications may be filed at the national IP office or at one or more other places. If the latter is the case, include address, telephone number and e-mail/website (if available) of the institution in charge of receiving trade name applications.

What are the main reasons for rejecting an application?

- State the reasons for rejecting applications in your country. Delete or add points as deemed necessary.

**BOX: REGISTERING A TRADEMARK — STEP BY STEP**

- Describe the full procedure for registration of a trademark in your country.
- Indicate whether applicants must mention the specific list of goods for which protection is sought or only the trademark class.
- State if there is a specific format required for the graphic illustration of the trademark that is to be included in the application.
- Is it necessary to present proof of use of the trademark at the time of registration? If not, reference to this could be omitted.
- Does the IP office in your country conduct substantive examination of trademarks? Does it provide time for opposition procedures? When are trademarks published? How long is the original term of protection? All these issues should be checked and amended in the text so that it reflects actual procedures in your country.
- It would be preferable to add a flow chart, with an outline of the procedure for registration, and the average time taken at each stage.

How long does it take to register a trademark?

- State the range and the average time taken to register a trademark from the date of filing a complete application.
- If there is a grace period for renewal of the trademark, this could be mentioned.

What are the costs associated with trademark protection?

- Include small table with the main fees associated with the trademark registration process (e.g. application fee, publication fee, registration fee, etc.) and amend text accordingly.

How can you find out if your chosen trademark might conflict with other registered trademarks? What is a trademark search?

- Does the national IP office offer trademark search services? How much does it cost? Can a trademark search at the national IP office be done on-line? Amend text taking into consideration your replies to these issues. If there is an on-line database, add website address. Add contact details of office in charge of trademark searches within the IP office.

BOX: A WELL — CLASSIFIED SYSTEM

- State which classification system applies in your country. If not the Nice System, write a paragraph with reference to the system that applies in your country and include it as Annex II instead of the Nice Classification System.

Do you need a trademark agent to file a trademark application?

- Amend paragraph with specific reference to whether a trademark agent is required in your country.

For how long is your registered trademark protected?

- Amend in order to specify the number of years for which trademark protection is granted in your country.

How can you register the trademark of your company abroad?

- This part will have to be adapted depending on whether your country is a party to any of the regional protection systems (e.g. Office of Harmonization in the International Markets (OHIM), African Regional Industrial Property Organization (ARIPO), African Intellectual Property Organization (OAPI), etc.) or whether it is a party to the Madrid system. Even if the country is not a member of the regional systems it is still important to include reference to them, as foreigners may also use them to obtain protection in various countries.

- Is there any government assistance for registration of trademarks abroad?

### TYPES OF TRADEMARK

- Does the national legislation include the possibility of registering collective marks and/or certification marks? Only those instruments of protection that exist in the national legislation should be mentioned. The definitions and explanations should be amended if necessary to reflect the actual provisions in the national trademark legislation and regulations.

### USING YOUR TRADEMARK

#### Can you register a trademark without having used it?

- Reply to this question with specific reference to how it works in your country.

#### TM or ®

- Other symbols (such as MD or MR, etc.) may be used in your country to indicate that a given sign is a trademark. Include them in the explanation and explain when they are used.
- In some countries, there are fines for companies using the ® sign if their product is not registered. If this is the case, a reference may be included here.

### ENFORCING YOUR TRADEMARK

#### What should your business do if its trademark is being used by others without authorization?

- Indicate the role of courts, police and customs in IP matters in your country. Include reference to relevant laws, regulations, notifications, etc.
- In this section you may make specific reference to institutions that may be of assistance in case of infringement, provide address, telephone number, e-mail and website, if available.
- Check the rest of the text to see whether it is suitable and whether it reflects enforcement measures available in your country and amend accordingly.
- Provide details of industry or business associations that provide assistance to members to deal with counterfeiting and infringement of trademarks.
- Do trademark assignments or licenses require to be registered at the IP office for enforcement purposes?

Annexes

- Annex I provides a list of websites of IP offices.
- Annex II should provide the trademark classification system(s) applicable in your national trademark office.
- If your country is a party to the Madrid Agreement and/or the Madrid Protocol, Annex III should provide the list of countries which are members of the Madrid System.
- The national application form could be provided as Annex IV.

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