



# A STITCH IN TIME

## SMART USE OF INTELLECTUAL PROPERTY BY TEXTILE COMPANIES





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INTELLECTUAL PROPERTY BY  
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# INTELLECTUAL PROPERTY IN THE **TEXTILE** INDUSTRY

*“In the field of observations, chance favors only the prepared mind.”*

*Louis Pasteur, who “accidentally” discovered the fabric later named rayon, while doing research to find artificial silk.*

Innovation in the textile and fabric industry has revolutionized its three main sectors – clothing, home and technical textiles – over the last fifty years. *Lycra* changed the women’s and active wear clothing industry forever. Cotton overalls treated with the chemical flame retardent *Proban* and hoods made of *Nomex*, a flame resistant fabric, have saved the lives of firefighters the world over. The use of new fabric has also made furniture more durable, comfortable and attractive.

There can be no doubt of the tremendous value of intellectual capital in the textile and fabric industry. Yet many of the small and medium-sized enterprises (SMEs) in the industry pay little attention, if any, to protecting their intellectual assets. In the current business environment, the primary source of competitive advantage for all businesses is innovation and original creative expressions. Business managers need to identify such valuable intangible assets in a timely manner, determine their business relevance, and conduct cost-benefit analyses to determine which of these should be protected and leveraged by using the tools of the intellectual property (IP) system.

*“Those [SMEs in the textile and clothing sector] that are closing are the less innovative ones. Among the few answers to the increased competition [...from Asia] are technology, know-how, a faster supply chain, better intellectual property management and a quick response.” Silvia Grandi, coordinator of the FP6 Fashion Net project (European Innovation/July 2005)*

This booklet looks at the strategic management and use of IP rights to reduce risk, develop business partnerships and enhance the competitiveness of all types of businesses in the textile industry.

*“Look at usual things with unusual eyes.” Vico Magistretti, one of Italy’s most exclusive furniture designers*

*“As opposed to the common perception that registering designs is a cumbersome and expensive process, once we went through it we realized that it is not at all so.”*

*Mr. T.J. Singh of the House of Valaya, the first Indian company to protect their design the “Valaya Diasun” pattern as both a trademark and a work of art.*

Fashion is at the heart of the textile and fabric industry. Fresh, new fabrics designs are introduced in every season. Among the range of IP tools, the protection of industrial designs – also simply referred to as designs – is the most clearly relevant to the fashion industry. Registering a design helps the owner to prevent all others from exploiting its new or original ornamental or aesthetic aspects, be they three-dimensional features, such as attractive shapes, or two-dimensional features, such as aesthetically pleasing textile prints.

The fashion and clothing industry invests huge sums to create new and original designs each season. Despite this significant investment, little use is made of relevant national and/or regional design law to register and protect these designs. In some countries, they may be adequately protected by copyright law as works of applied art. However, a frequently cited explanation for not registering designs is that the short product life cycle does not justify the time and financial cost involved. In practice, the arguments for registering a new design have to be considered on a case-by-case basis. Registering a design should help to deter others from copying it, and help to fight unscrupulous competitors who do so.

Moreover, design protection is not always a major financial burden. Some countries and regions, such as the United Kingdom and the European Union (EU), offer an unregistered form of protection for industrial designs for a relatively short period of time. Unregistered design protection, wherever available, is extremely useful for fashion designers or small businesses with limited budgets, and for all those that wish to test market new designs before deciding which to register. The **unregistered community design right** of the EU offers protection for a maximum period of three years, starting from the date on which

# DESIGNS

the design is first made available to the public in any of the 27 countries of the EU. It should also be noted that many countries permit the registration of a large number of different designs (10, 20 or even 100) in a single application provided they all relate to the same product or “class” of products.

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## FASHION DESIGN SUCCESS IN SOUTH AFRICA

The South Africa Fashion Week, created as a showcase for the abundance of fashion talent that had gone largely unnoticed in the country, is now in its ninth year. The resounding success the 2005 Fashion Week showed how far the industry had advanced in developing fashion into a serious business, creating wealth through design, and giving South Africa’s designers a presence on the international stage.

Fashion Week exclusively promotes the South African design industry – clothing, accessories, footwear and textiles. Its organizers hold workshops fusing fashion and crafts in the country’s smaller remote provinces. They also support talent competitions for young South African designers – winners get an opportunity to launch a debut collection at the Fashion Week.

The rich colors and exotic designs in South African textiles and fashion set it apart from others. Many of the country’s designers take inspiration from their cultural heritage. South Africa’s fashion industry is moving forward with confidence that it is being taken seriously.

*The Bongiwe Walaza collection  
at SA Fashion Week 2004*



Photographer: Ivan Naude

While fashion trends may come and go in the blink of an eye, some never pass. Many items, along with the high quality fabrics and textiles used to make them, become classical pieces. There is a one-year waiting period at the French fashion house **Hermès** for the classic “Kelly” Bag, which grew to fame in 1956 after Princess Grace Kelly of Monaco appeared carrying the bag on the cover of LIFE Magazine. Each bag is made to order in the specific color and textile or leather requested by the client. Another example, the plaid designed **Burberry** fabric still seduces new generations of shoppers many decades after it was first created.

*Hermès is one of the top ten users of the Hague System for the international registration of industrial designs (see page 20), with hundreds of designs registered through the System.*



Courtesy: Hermès

Photo: Salmaan A. Mahmood



*Model Amna Shafaat in one of the Yahsir Waheed designs which imitators copied.*

## **BRIMFUL DESIGNS, PAKISTAN**

For the past seven years Brimful Designs, a textile design studio based in Lahore, Pakistan, has produced and marketed a successful brand of high quality, printed cotton designer clothing under the label **Yahsir Waheed Designer Lawn**. But in 2003 the very existence of the company was threatened by large scale copying. Inferior quality copies of Yahsir Waheed's original print designs for its spring/summer collection flooded the market under various labels at a third of the price of the original product. Salesmen used the Yahsir Waheed Designer Lawn's product catalogue to sell the fake designs, thus confusing Brimful's loyal customers.

A negative backlash from customers led to a rapid decline in the company's market share. Brimful consulted local experts at an IP training seminar organized by Pakistan's Small and Medium Enterprise Development Authority (SMEDA), who recommended seeking protection under Pakistan's Industrial Design Ordinance 2000. Brimful engaged legal counsel and since 2004 has registered all designs for the Yahsir Waheed Designer Lawn Collection with the aim of deterring infringers and providing the possibility of legal action.

As yet, their battle continues. The infringers are no longer replicating the exact designs, but the copies are still close enough to confuse buyers. While IP legal counsel is becoming widely available in Pakistan, this remains an expensive route; Brimful owners note that the process of obtaining and implementing a court injunction currently takes too long. They would like to see strong, high profile punitive action by the authorities against IP violators in the textile sector in order to give teeth to design protection legislation and to deter further wide scale copying.

(WIPO Magazine May/June 2005)

[www.yahsirwaheed.com/enter.htm](http://www.yahsirwaheed.com/enter.htm)

For fashion items with a long life span, filing an application for a registered industrial design may be the best way to prevent others from using the design. It is possible to request at the time of filing – not after – that the **publication of the application be deferred** for up to 30 months. This is a particularly useful feature, offered under the Hague System, the EU community mark, and many national systems, for those who may want to keep their design secret until it comes to market.

# PATENTS

## PATENTS

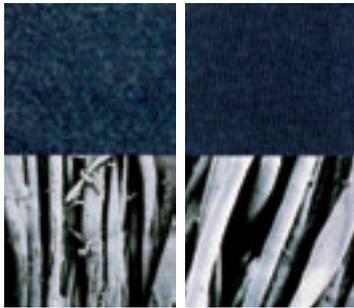
*“In technical textiles, innovation is forced both by fierce competition and by the requirements of customers – the development of a new car or aircraft often triggers an invention step by the suppliers of the technical textiles that will go into them.”*

*Lutz Walter of the European Apparel and Textile Organisation, Euratex.*

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Technical innovation – protected by patents – is one way to put a textile producer ahead of the competition. A portfolio of patents signals a company’s technical superiority, for example in inventing new fabrics that do not crease, are softer, more weather-resistant, have greater elasticity, etc. Such a patent portfolio can help attract business partners or investors.

### Treatment of cotton



without cellulase    with cellulase

Courtesy: Novozymes

**Novozymes**, a Danish, biotech company specializing in enzymes and microorganisms ([www.novozymes.com](http://www.novozymes.com)), pioneered the use of enzymes in the treatment of fabrics.

Though not previously involved in the textile industry, in 1987 the company developed and patented a technology for the treatment of “stone washed” denim jeans. This technology is based on an enzyme called cellulase, which removes some of the indigo dye from denim so as to give the fabric a worn look. Within three years, most of the denim finishing industry was using cellulase under license from Novozymes. Today, Novozymes’ technology for improving production methods and fabric finishing has been licensed worldwide. The company holds more than 4,200 active patents and patent applications, and pursues a pro-active licensing strategy to maximize royalty revenue from these IP assets.

Courtesy: Suberis



Suberis footwear

The Italian company **Grindi Srl** invented Suberis, an innovative fabric made of cork, said to be as smooth as velvet, light as silk, washable, unscratchable, stain-resistant, waterproof and fireproof. After testing and codifying the treatment, Grindi filed an international patent application under the Patent Cooperation Treaty (PCT) in 1998 to protect its unique product in a large number of countries. The Suberis fabric is used in the manufacture of clothing, footwear and sportswear, as well as in many other applications. (For the story of Grindi Srl see [wipo.int/smelen/case\\_studies/suberis.htm](http://wipo.int/smelen/case_studies/suberis.htm).)



### ECO-DESIGN: A FABRIC "SAFE ENOUGH TO EAT"

Sustainability is becoming a buzzword in design. In the textile sector, as elsewhere, the green market is rapidly expanding and ever more companies are using ecologically-friendly design to mark themselves out from the competition.

Swiss textile manufacturer **Rohner Textil AG** made headlines, cut costs and won new business when the company teamed up with green design guru, William McDonough. Together they have produced a biodegradable upholstery fabric that they describe as "safe enough to eat."

Although Rohner had already been complying with all the Swiss environmental regulations, its fabric trimmings had been declared hazardous waste. In producing their new fabric, Climatex® Lifecycle™, a fundamental re-design took place in every aspect of production, from the factory work space, to the elimination of all toxic dyes and chemicals, to the use of organically grown materials. As a result, the factory waste water now tests cleaner than the water coming into the plant, and the fabric trimmings can be processed into felt for upholstery interliners or gardening mulch.

William McDonough notes: "Not only did our new design process bypass the traditional responses to environmental problems (reduce, reuse, recycle), it also eliminated the need for regulation, something that any businessperson will appreciate as extremely valuable."

*"Have nothing in your house that you do not know to be useful, or believe to be beautiful."*

*William Morris, the British craftsman, designer (including textiles), writer.*

# PATENTS

## CASE: NEW PATENTS MAY REVOLUTIONIZE TEXTILE PRODUCTION

In 2002, the Procter & Gamble Company donated 37 patents and patent applications relating to a significant advance in textile production technology to North Carolina State University. The technology uses cationic peroxide bleach activators to potentially lower the temperatures, and therefore cost, at which textiles are manufactured.

### GEOX BREATHES® PATENTED SYSTEM

Rubber shoes, introduced over 50 years ago, represented a technological achievement – waterproof footwear that kept feet dry and warm, especially in winter. However, the downside was the lack of evacuation for perspiration, not a minor detail considering that the third highest concentration of sweat glands is found in the soles of our feet. Geox addressed this problem with a simple, yet revolutionary, patented system. Geox undertook extensive research and development to come up with a breathable membrane made of a special micro-porous material which absorbs sweat through the insole and evacuates it through the outer sole in the form of water vapor. The micro-pores – larger than water vapor molecules, but smaller than water droplets – keep water out and feet dry while maintaining an ideal microclimate in the shoe.

Geox's research team also worked on a solution to the same problem with clothing, and discovered a way for warm air and humidity to be absorbed into a cavity created in garments and expelled through special aerating holes positioned in the shoulder. This patented GEOX technology provides a natural dissipation of sweat from the garment and a natural regulation of body temperature.

Use of cationic activators results in much milder bleaching conditions and allows cotton to retain more of its fiber strength than the high temperature bleaching currently in use. The invention shows promise in permitting an effective, pre-processing bleaching of raw cotton at room temperature. In addition, the successful development and use of cationic peroxide activators could permit a wider range of fabrics to be treated with a permanent press finish. This invention, which will require further development and testing, is expected to have a significant economic impact on textile production and the manufacture of new types and long-lasting articles of clothing. As sole new owners of the technology, NC State University will benefit from all future revenues if it is successfully developed and commercialized.

*Source: NC State University Press Release*



Photographer: Ivan Naude



Juan Pablo Montoya



### TEXTILE INNOVATION IN THE WORLD OF SPORTS

The Speedo® FASTSKIN FSII swimsuit fabric, modeled on the skin of a shark, is designed to reduce drag and enable competition swimmers to gain vital split seconds.

Many textile manufacturers work with sports equipment and clothing companies to solve particular problems. Flame and abrasion resistant materials have been developed for the overalls and helmets of racecar drivers and motorcyclist significantly reducing fatalities.

*“The collective group of automotive textile companies are inventing as at no time in their long history. It is an explosive time for creation in this business, with new yarns, new finishing capabilities and new weaving and knitting technologies.”*

*Transportation interior design expert George Moon.*

### PATENT DOCUMENTATION

Patent documents may hold information that can lead to further improvements in the product or shorten the time taken to get the product to market or increase the quality of the output. Enterprises in the textile industry may license-in patented technology to gain a competitive advantage or form a strategic partnership with a company to gain access to its technology.

Patents contain information on the state-of-the-art, which can help an enterprise to avoid wasting resources, in terms of money and time.

Aside from checking whether an invention is patentable, timely and effective searching of patent databases may provide very useful information and intelligence on:

- The R&D activities of current and future competitors;
- Current trends in a given field of technology;
- Technologies for licensing;
- Potential suppliers, business partners, or sources of researchers;
- Possible market niches at home and abroad;
- Patents of others to ensure that products do not infringe them;
- Patents that have expired and technology that has come into the public domain; and
- Possible new developments based on existing technologies.

# BRANDING AND TRADEMARKS

In the clothing industry, as in the furnishings and technical textile industries, canny businesses capitalize on their brand equity. They develop a bond with their customers who come to associate their products with good design, or quality and workmanship, or outstanding technical properties. Trademarks are the most obvious means of distinguishing one company's products from those of their competitors. Trademarks can be protected through registration, and the associated artwork by copyright law. Trademarks are just as important for a small or start-up company as they are for the big names in the business.

The Italian clothes company, **Pickwick** ([www.pickwick.net](http://www.pickwick.net)), offers an interesting example of the strategic use of a trademark to build a successful business from scratch in the high street fashion sector. Pickwick now sells a range of casual fashion wear to adolescents across Europe. But not so long ago, all that the company had was the trademark itself, which depicted a young, faceless boy with a spiky hairstyle. The trademark owner started his business by selecting items he judged would have particular style appeal to teenagers, adding his distinctive trademark and distributing them through the local shops in Rome. Initially, the business costs were kept low by operating from a garage.



Teenagers perceive the Pickwick logo as trendy and are willing to pay more for clothes bearing its trademark. Today, the company subcontracts the manufacturing and focuses on marketing, distribution and monitoring and controlling the use of the trademark.

## CASE STUDY: MORE THAN A NAME

The Japanese designer Takada Kenzo built on his reputation as a trendsetter over 30 years to create a strong trademark. He used warm rich textiles, mixing modern design with ethnic fabrics and styles, crossing cultural boundaries, to create a the *Kenzo* look. In 1993 Takada Kenzo sold his fashion house to the French luxury giant LVMH for 29 million Euros, but stayed on as *Kenzo's* top designer until his retirement. In 1997, shortly before his retirement, LVMH ceded the trademark of his name and surname used jointly back to the designer and retained the *Kenzo* trademark.

A few years later Takada Kenzo decided to return to the fashion industry, but this time to design textiles for furniture covering as well as other household items. He planned to register the Chinese letter version (pictogram) of his name as a trademark for the venture. This is when he discovered LVMH was already using the Chinese trademark. Thus in early 2005, he sued LVMH for the illegal use of his logo, and asked the court to order the company to pay millions in royalties. He claimed the disputed trademark was part of the rights returned to him in 1997 under the deal negotiated with LVMH. The dispute was ultimately settled out-of-court.

## GEOGRAPHICAL INDICATIONS, COLLECTIVE AND CERTIFICATION MARKS

Among the various trademark tools available to businesses to promote particular aspects of their products, are specific types of “shared” marks, notably collective marks, certification marks and geographical indications.

**Collective marks** are usually defined as signs that distinguish certain valued characteristics common to the goods or services of a number of enterprises using that mark, for example their geographical origin, material, mode of manufacture. The owner may be either an association of which those enterprises are members or any other entity, including a public institution or a cooperative.

# TRADEMA

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## EGYPTIAN COTTON

Egypt's year round moderate climate is perfect for cotton plantation and is the primary reason why Egyptian cotton is of such superior quality that it has won worldwide recognition. The Egyptian government recognized the value of their product at a very early stage, already in 1926 they imposed strict controls of the seeds to make sure they were not mixed with others of lesser quality. In 2001, the Egyptian Ministry of Economy and Foreign Trade along with Alexandria Cotton Exporters Association (Alcotexa) jointly registered an international trademark application (Madrid system number 756059). Egyptian Cotton can only be used under license agreement and guarantees the quality and superiority of products made of 100 percent Egyptian Cotton.



Courtesy of Iran's Cultural Heritage Foundation



Products from a distinct geographical origin may, in many countries, also use **geographical indications**. These are designed to identify a product as originating from a country or locality therein, reputed for particular qualities or characteristics. Geographical indications for certain products, mainly for wines and spirits, enjoy a more far-reaching protection than geographical indications for other products and products marketed under a collective mark.

## GEOGRAPHICAL INDICATIONS FOR IRAN'S CARPETS

With 1.5 million people directly engaged in carpet production throughout Iran, the country has compelling economic – as well as cultural – reasons to protect against imitations. Iranian carpets woven by hand in the various regions of the country are known for the distinctive characteristics associated with each region: traditional motifs, the type of knots and methods used while weaving, the dyes based on local plants, etc. Local producers cooperatives and guilds have for many years been able to use legal provisions covering collective marks to protect these regionally-specific characteristics. But now the Iranian parliament has also approved a Law for the Protection of Geographical Indications (2005), which further strengthens the hand of carpet weavers to safeguard the distinctive elements which make the carpets of their region special.

Source: *Special Characteristics of Iranian Hand-Woven Carpets: How to protect them on national and international levels on the basis of geographical indications*, by Massoud Taromsari, University of Tehran.

A number of countries also provide for the protection of **certification marks**. Certification marks are usually given for compliance with defined standards, but are not confined to any membership. They may be used by

anyone who can certify that the products involved meet certain established standards. Famous certification marks include WOOLMARK, which certifies that the goods on which it is used are made of 100 percent wool.



RUGMARK is a certification label set up by a non-profit organization working to end child labor in India, Nepal and Pakistan. The label provides consumers with an assurance that no child labor was employed in the manufacture of rugs and carpets bearing the certification mark. In order to be authorized to use the RUGMARK, participating carpet manufacturers register their looms with the Rugmark Foundation and undergo regular monitoring including unannounced inspections. Each carpet is individually numbered, so that it can be traced back to the loom on which it was produced. This also protects against counterfeit labels.



Collective and certification marks may represent useful instruments for assisting SME textile firms to overcome some of the challenges associated with their small size and isolation in the market place. National IP offices will be able to provide more information on the procedures for the registration and use of collective and certification marks.



Credit: Raymond Sluiter, The Netherlands

*A Peruvian Vicuna Llama*

## PRECIOUS FIBERS

Vicuña wool, the world's most valuable natural fiber, sells for US\$225 per pound of raw fleece. The vicuña, a llama indigenous to an area of the Andes shared by Argentina, Bolivia, Chile, Ecuador and Peru, is almost impossible to domesticate. The governments of these countries have developed policies to prevent their extinction, while trying to benefit from the huge economic opportunities offered by the rare wool of the vicuña, which is considered better than cashmere. In the time of the Incas only the ruler and his court were allowed to wear the fine fiber; today in Buenos Aires tourists pay as much as US\$2,000 for a vicuña coat.

**Loro Piana**, an Italian textile and fashion company that has made selecting the best raw materials in the world one of its strengths, has maintained a direct relationship with the government of Peru for years, actively participating in an operation to stop the extinction of the vicuña species. To protect the animal from poaching and guaranty the livelihood of the local people, it is proposed that all vicuña garments be sold with a certificate of origin as is already the case in Peru.

## UNIQUE SARIS FROM HANDLOOM WEAVERS

A group of handloom weavers in Pochampally, a small town in Nalgonda district of Andhra Pradesh, India, known for centuries for its very unique traditional *ikat* design, now have geographical indication protection. The town's 5000 handloom weavers make the famous Pochampally *ikat* design tie-and-dye sari, which requires extremely laborious weaving and dying. It is the first traditional Indian craft to receive this status under the country's new geographical indication law instituted in 2003.

Many other fabrics made in South East Asia may also be able to benefit from this type of IP protection. For example, the hand-crafted *longyi* silk, used for generations to make *sarongs* in Myanmar, which is so intricate it takes eight hours to weave an inch and at least three months to finish a piece of fabric; or *Jusi*, an embroidered fabric woven from silk and pineapple fiber, which is worn on formal occasions the northern Philippines.

Saris courtesy: Sangeeta Jaiya



# SECRETS

## TRADE SECRETS AND NEW BUSINESS MODELS

Trade secrets may range from a list of key suppliers and buyers, to use of software tools for fashion design, to logistics management of the entire value chain, to processes and secret inventions. In some fashion businesses, core trade secrets serve to protect the computer-implemented, software-based business models, which underpin an entire business strategy, based on stealth and speed, to supply a limited quantity of fashion products.

For example, the Spanish retail fashion chain, **ZARA**, uses a proprietary information technology (IT) system to shorten their production cycle – i.e. the time from identifying a new trend to delivering the finished product – to a mere 30 days. Most of their competitors take from 4 to 12 months. The company receives daily streams of e-mail from store managers signaling new trends, fabrics and cuts, from which its designers quickly prepare new styles. The fabric selected is immediately cut in an automated facility, and sent to work shops. A high-tech distribution system, with some 200 kilometers of underground tracks and over 400 chutes, ensures that the finished items are shipped and arrive in stores within 48 hours.

Other fashion houses use IT to make customized products in response to an individual customer's request. For example, **Shirtsdotnet** ([www.shirtsdotnet.com](http://www.shirtsdotnet.com)) aims to reshape the traditional clothing industry by reversing the process of decision making and following the made-to-order business model. Shirtsdotnet is a Business to Business clothing software platform provider, offering made-to-measure, mass customization clothing solutions for mail order companies. Customers can design and order apparel directly from the virtual shop. The business relies on proprietary software, which is protected as a trade secret and by copyright law.

As shown throughout the examples in this booklet, intellectual capital and creativity are central to successful businesses in the textile industry. Protecting that intellectual capital in the form of IP assets serves to boost income through sale, licensing, and commercialization of differentiated new products, to improve market share, to raise profit margins and to reduce the risk of trampling over the IP rights of others. Good management of IP assets in a business or marketing plan helps to enhance the value of an enterprise in the eyes of investors and financing institutions.

The next section provides a brief summary of the different routes available to businesses seeking to protect their IP both at home and overseas.

# PROTECTING INTELLECTUAL PROPERTY

## HOW TO PROTECT INDUSTRIAL DESIGNS

In most countries, an industrial design must be registered in order to be protected under industrial design law. To register an industrial design an application must be filed at the national IP office of the country where protection is sought.

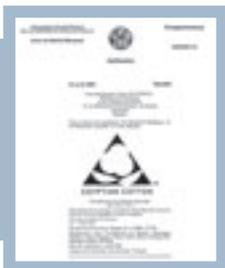
Recent legislation in some countries or common economic areas, such as the European Union, have made it possible to obtain limited industrial design protection for unregistered designs for three years from the date on which the design was first made available to the public (see page 3).

## HOW TO APPLY FOR PATENT PROTECTION

A patent application has to be prepared and submitted to the relevant national or regional patent office. Preparing a patent application and following it through to the grant stage is a complex task, it means:

- making a prior art search in order to identify any prior art that renders the invention unpatentable;
- writing the claims and full description of the invention combining legal and technical jargon;
- corresponding with the national or regional patent office especially during the substantive examination of the patent application;
- making the necessary amendments to the application requested by the patent office.

The application will include a full description of the invention, the patent claims that determine the scope of the patent applied for, drawings and an abstract. Preparing these will require in-depth knowledge of patent law and patent office practice. Therefore, even if legal or technical assistance is generally not mandatory, it is strongly recommended to consult an IP expert.



Madrid International  
registration no. 756059

EGYPTIAN COTTON



Madrid International  
registration no. 429177

HERMÈS



Madrid International  
registration no. 659163

RUGMARK



## HOW TO PROTECT A TRADEMARK

Trademark protection can be obtained through registration or, in some countries, also through use. Even where trademarks can be protected through use, it is advisable to register the trademark by filing the appropriate application form at the national trademark office. Registering a trademark will provide stronger protection, particularly in case of conflict with an identical or confusingly similar trademark. For the registration of a trademark, the services of a trademark agent are often very useful and in some countries compulsory.

The first step is to submit a trademark application form to the national IP office, including the contact details of the company, a graphic illustration of its mark (a specific format may be required), a description of the goods and services and/or class(es) for which the business wishes to obtain trademark registration, and to pay the required fees. The time required for the registration of a trademark will vary significantly from country to country, generally ranging from three months to two years, so the application must be sent well in advance to secure registration in time for its use in the advertising and marketing of the relevant products.

While the term of protection varies, in many countries registered trademarks are protected for 10 years. Registration may be renewed indefinitely (usually, for consecutive periods of 10 years) provided renewal fees are paid in time.

### CHECKLIST FOR SELECTING A TRADEMARK

- Check that the trademark meets all the **legal requirements** for registration.
- Make sure that it is not identical or **confusingly similar** to existing trademarks.
- Make sure the trademark is easy to **read, write** and remember and is suitable for all types of advertising media.
- Make sure the mark does not have any **undesired connotations**.
- Check that the corresponding **domain name** is available for registration.

# PROPERTY

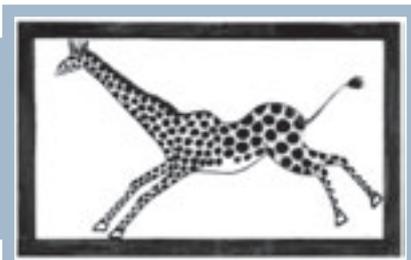
## PROTECTING IP ABROAD – PRIORITY CLAIMS

IP protection is territorial in that it is generally limited to the country or region where it is registered. So a key decision for business managers is in which other countries the company needs to protect its IP. Time, here, is of the essence:

The filing date of the first **patent** application for a given invention is called the **priority date**. Any subsequent applications in other countries filed within 12 months of that date (i.e., within the priority period) will benefit from the earlier application and will have priority over other applications for the same invention filed by others after the priority date. It is highly advisable to file foreign patent applications within the priority period. After the expiration of the priority period, and until the patent is first published by the patent office (generally 18 months after the priority date), an application for protection may still be filed for the same invention in other countries, but the priority of the earlier application can no longer be claimed.

With **industrial designs**, an applicant is usually granted six months from the date on which the application for protection in the first country was filed to claim the right of priority when applying for design protection in other countries. Once this period has lapsed, the applicant may not be able to apply for design protection in foreign countries, as the design will no longer be considered new.

The period of priority for a **trademark** is six months from the date of filing the first application. The registration of a trademark in a country gives rights only in that country unless the mark is considered a well-known mark.



Hague International  
registration no. DM/58977



Hague International  
registration no. DM/58977



Hague International  
registration no. DM/58980

## THREE ROUTES FOR PROTECTION

**National route:** One may seek protection by applying separately to the national IP office of each country in which protection is required. The process can be rather cumbersome and expensive. Translation into the national languages is generally required as well as payment of administrative (and sometimes legal) fees.

**Regional route:** Certain regional agreements enable the registration of designs in a group of countries that are signatories to that agreement. An applicant interested in obtaining protection in those countries has the option of filing a single application at the regional IP office concerned.

Regional IP offices for **industrial designs** and **trademarks** include:

- the Organisation Africaine de la Propriété Intellectuelle (OAPI) ([www.oapi.wipo.net](http://www.oapi.wipo.net));
- the African Regional Industrial Property Organization (ARIPO) ([www.aripo.org](http://www.aripo.org));
- the Benelux Office for Intellectual Property (BOIP) ([www.boip.int](http://www.boip.int));
- the European Union Office for Harmonization in the Internal Market (OHIM) ([oami.europa.eu](http://oami.europa.eu)).

Regional IP offices for **patents** include:

- the Organisation Africaine de la Propriété Intellectuelle (OAPI) ([www.oapi.wipo.net](http://www.oapi.wipo.net));
- the African Regional Industrial Property Organization (ARIPO) ([www.aripo.org](http://www.aripo.org));
- the Eurasian Patent Organization (EAPO) ([www.eapo.org](http://www.eapo.org));
- the European Patent Office (EPO) ([www.epo.org](http://www.epo.org)); and
- the Patent Office of the Gulf Cooperation Council ([www.gulf-patent-office.org.sa](http://www.gulf-patent-office.org.sa)).

**International route: industrial designs** – Companies that wish to register their designs internationally in several countries can also save time and money by using the mechanism offered by the WIPO-administered **Hague System**. An applicant from a member country can file a single international application with WIPO, designating as many of the other member countries as the applicant wishes. For more information visit the WIPO website at: [www.wipo.int/hague/](http://www.wipo.int/hague/).

**International route: patents** – The WIPO-administered **Patent Cooperation Treaty** (PCT) offers the option of filing a single patent application to protect an invention in any or all of the PCT member countries. For a business to be eligible to use the PCT, it must have a real and effective industrial or commercial presence in one of these countries. The application may be filed either at a national or regional patent office and/or at the PCT receiving office at WIPO. For more information visit the WIPO website at: [www.wipo.int/patentscope/en/](http://www.wipo.int/patentscope/en/).

**International route: trademarks** – The WIPO-administered **Madrid** system provides a cost-effective procedure for registering – and maintaining – a trademark in the countries that are party to the system by means of a single application. To be eligible, the applicant's home country must be a member of the Madrid system and the trademark must have been registered or applied for in, or with effect in, that country. For more information visit the WIPO website at: [www.wipo.int/madrid/](http://www.wipo.int/madrid/).



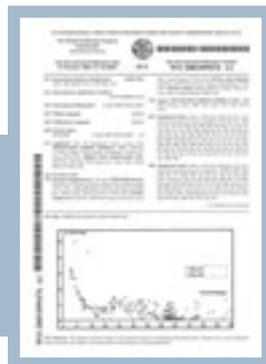
GEOX

PCT International application  
no. WO 2004/028284



GRINDI

PCT International application  
no. WO 02/055767



NOVOZYMES

PCT International application  
no. WO 2005/099476

**PUBLICATIONS IN THE  
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WIPO publication No. 900.



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An Introduction to Copyright and Related Rights for Small and Medium-sized Enterprises.  
WIPO publication No. 918.

