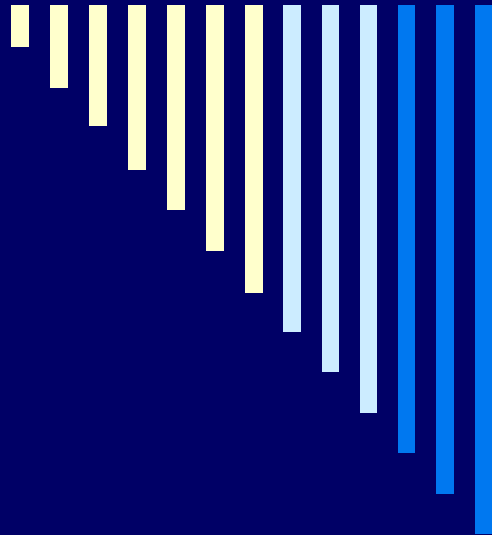


# e|MARKS PROJECT

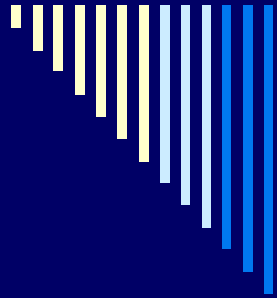
---



## International Workshop on “IPR, Strategy & IP Search Practices”

Athens Information Technology,  
November 28, 2008

---



G.S. KOSTAKOPOULOS  
& ASSOCIATES Law Firm

“THE IMPORTANCE OF MONITORING  
OF TRADEMARKS AND INDUSTRIAL  
DESIGNS”

PRESENTATION BY  
PANAGIOTA V. MOURKOU



---

# INTRODUCTION

Aim of the presentation:

- The need of every business to monitor its IP rights,
  - The possibilities and ways for you to best manage your IP rights, and
  - The value of the Emarks project, for the monitoring and management of IP rights.
-



---

# I. MONITORING YOUR IP

By monitoring we mean a constant search and control within a specific IP rights database of your own or other trademarks and designs in order to ensure that:

- your IP rights are at all times correctly registered and protected;
  - that there exists no new IP rights that could infringe your own;
  - you shall react on time in case of any infringements.
-



---

# 1. Benefits of IP Protection

- Provides you exclusivity of your IP rights;
- Enables you to take legal action against any infringers;
- Enables you exploit your rights in any legal way: sell, license, insure them.

The IP rights, once fully protected constitute an economic asset of your business.

---



---

## A. Benefits of a registered trade mark protection

- may discourage people from using your trade mark without your permission;
  - allows you to take legal action against anyone who uses your trade mark without your permission;
  - allows Trading Standards Officers or Police to bring criminal charges against counterfeiters;
  - **CONSTITUTES** a valuable asset of your business.
-



## **What if you do not register your trade mark?**

**The legal action against passing off.**

In order to be successful in in a legal action against a passing off action, you must prove that:

- the mark is actually yours;
- you have built up a reputation for this mark;
- you have been harmed in some way by the other person's unauthorized use of the mark.



## **B. Benefits of a registered design protection**

A registered design allows you to:

- sell your design and the intellectual property (IP) rights to it;
- license your design to someone else and retain the IP rights to it.

If you do not register your designs, you must only rely on protection for unregistered design right if someone illegally copies your designs.



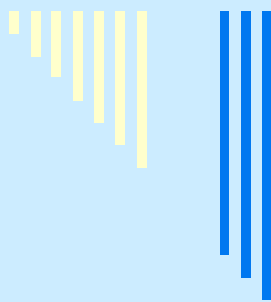
---

## 2. Infringement of IP rights

What is trade mark infringement?

If you use an identical or similar and \ or confusable trade mark for identical or similar goods or services to a trade mark already in use you are likely to be infringing the earlier mark.

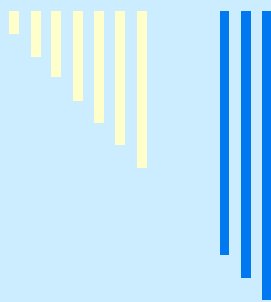
---



# Infringement by you of IP rights

In case you might infringe someone else's IP rights, you should:

- **cease trading** under the trade mark in question
- attempt to negotiate a **settlement** with the owner of the trademark.



---

# Infringement by others of your IP rights

Take legal action:

- receive a **court order** to force the infringer to **cease trading products** under your brand;
  - negotiate with the infringer and receive a price for the unauthorized use of your trademark;
  - take legal action against him asking for compensation.
-

---



# Infringement of an industrial design

The exclusive IP rights with regard to an industrial design are infringed by any third party who uses the design, by means of making, offering, putting in the market, importing or exporting the design without your permission and obtains for commercial gain.

---



# Defense against legal action against you for infringement

Two basic types of defense if someone claims you are infringing their design:

- **You are not infringing** - what you are doing does not infringe their design, and you are falsely accused, or
- **The design that you are alleged to infringe is invalid** – this means that you can take legal action to challenge the validity of the design.



---

# Posing Objections

- The monitoring of IP rights can also be helpful as a precautional measure for the protection of your intellectual property.
  - If you think that the IP Office should not give intellectual property (IP) protection to a particular application for IP rights, or a granted or registered right, you can object to it in order to have it cancelled or invalidated
-

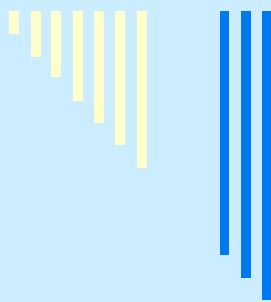


---

# Objecting a trademark

If :

- this trademark is the same or similar to your own and/or
  - If it is used for the same or similar goods or services and
  - If its use could cause confusion to the public, with regard to the origins of the goods or services.
-



# Objection of an industrial design

- it was not new or lacked individual character when compared with an earlier design at the time it was applied for; or
- there exists other procedural reasons for which its registration could have been refused, for example if the design was registered under a false owner.



---

## 4. Resolving disputes

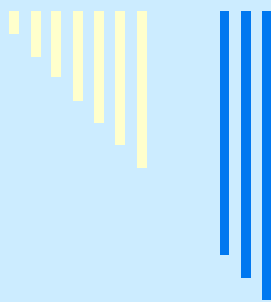
- Disputes can arise over the ownership of IP rights, the scale of goods or services or the kind of actions your IP covers or, and most commonly, because someone has infringed your IP.
  - Importance of negotiation and mediation.
-



## II. MANAGING YOUR INTELLECTUAL PROPERTY

### 1. Managing changes:

- Change owner's name or personal data
- Change or appoint an attorney
- Transfer ownership
- Correct an error
- Cancel or resign from your rights
- Modify a registered or granted right



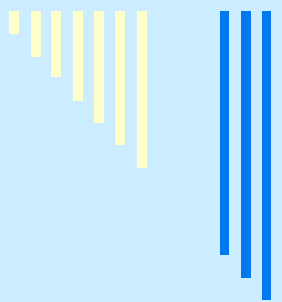
---

## Managing through the renewal of rights:

1. Trademark renewals every 10 years
2. Design renewals every five years up to a maximum of 25 years.

If you miss a renewal date, your rights will be cancelled.

---



## 3. Managing through using of IP rights

- Marketing
- Licensing
- Selling – Assigning
- Mortgaging
- Showing your IP is protected
- Enforcing



---

### III. Monitoring your IP rights through EMARKS

EMARKS has created a specific mechanism that allows you to receive warnings every time a change occurs in a trademark or design, that you have requested to be monitored.

---



---

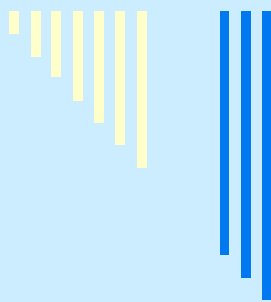
First step:

Electronically fill in an application requiring information about particular events in the progress with regard to your or any other trade mark or industrial design.

Second step:

EMARKS shall every time send you a warning or notification, that a particular action has taken place on a trade mark application or registration.

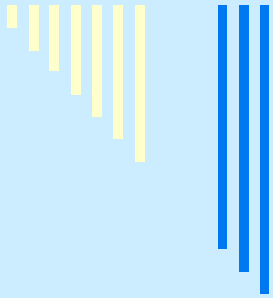
---



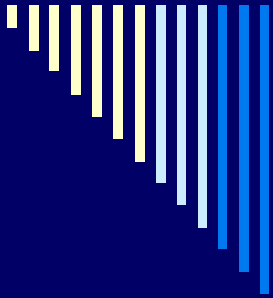
---

You can then ask to be notified if any of the following events or actions occurs:

- application published, or withdrawn, refused or deemed abandoned before publication;
  - opposition filed against an application;
  - application registered, or withdrawn, refused or abandoned after publication;
  - registration not renewed;
  - registration renewed or expired;
  - registration withdrawn or revoked;
  - assignment application received;
  - mark assigned, either partially or in full;
  - anything else.
-



This new service that EMARKS has created and offers to you which actually allows you to easily monitor every trademark and industrial design that you wish and benefit easily and with low cost all advantages of monitoring and having your IP rights monitored.



---

**THE END**

**THANK YOU VERY MUCH!**

---