

- *The protection of trademarks in Malta is by no means any recent phenomenon. Its inception goes back to 1899 when the legislator felt the need to extend some form of specific protection over existing trademarks.*
- *The first parameters that need to be defined are the marketing and business reaches of the company.*
- *Creating a solid brand means taking into account considerations such as local TM protection, European Trademark Protection (CTM), Asian and American portfolio planning, domain portfolio planning, IP corporate structuring and other less evident considerations such as IP valuations, tax planning and goodwill issues.*
- *Upon embarking on the search for a new unique and distinctive mark, various steps need to be taken to ensure the ensuing investment is made in the right mark.*



Investing hard-earned money in marketing a brand is something we are all familiar with. However, many times we place trademark (TM) planning and protection on the backburner until, one fine day, we are smacked with a third-party suit for trademark infringement... or a competitor enters our market with an identical or similar tradename. It is only then, with the benefit of hindsight, that we realise the importance of good brand planning and trademark protection. Problems faced by many include domain name squatting; similarity marks that cause confusion, and infringement of previously used but non-registered TMs.

In this article, I shall attempt to present guidelines on international best practices in proper IP planning, with special focus on the creation and maintenance of a TM portfolio. The issues involved vary from mere registration of existing and new TMs; international protection and prosecution; corporate structuring of a TM portfolio; domain name planning; and creation, development, ownership and sale of intellectual property. This is definitely not an exhaustive guide, yet it is a general attempt to guide the Chief Marketing Officer (CMO) or owner-manager of an enterprise to understand the basic issues involved in creating a brand and protecting it thereafter.

Protect your Brand - Make Your Mark.

Maria Chetcuti Cauchi

THE LEGAL BUNDLE

The protection of trademarks in Malta is by no means any recent phenomenon. Its inception goes back to 1899 when the legislator felt the need to extend some form of specific protection over existing trademarks.

This resulted in two specific pieces of legislation: the Industrial Property (Protection) Ordinance (1899) (IPPO) and various provisions in the Commercial Code (CC) that seek to protect marks and their use.

These two pieces of legislation covered both registered and non-registered marks in the sense that the IPPO protected marks which are officially registered and the Commercial Code provided protection to non-registered marks, under the title "Limits of Competition". The latter protection was based on 'use'.

These laws were amended several times but nonetheless, recently it was felt that the varying needs and requirements of the

business community necessitated a total re-haul of the relevant legislation. The Trademarks Act (Act XVI of 2000) was the ensuing result. This new Act came into force on 1 January 2001 and even though Malta, at the time, was still not a member of the EU, the Act still incorporated modern concepts of TM protection based on EU and other international laws & conventions.

Malta's decision to join the EU resulted in the new legislation being compiled in a manner compliant not only to the TRIPS Agreement but also with the *Acquis Communautaire*. In fact, the new Trademarks Act embraces the framework provisions of Council Directive 89/104 and also provides for the issue of regulations for the extension of the Community Trademark regime to Malta.

Malta is also a member of treaties, organisation and conventions such as:

- the World Intellectual Property Organisation (WIPO); ▶



- Paris Convention for the Protection of Industrial Property (Paris Convention);
- the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention); and
- the World Trade Organisation Agreement (WTO).

Malta implemented the pertinent provisions of the WTO Trade-related Aspects of Intellectual Property Rights (TRIPS) in the year 2000.

THE GEOGRAPHICAL ARENA

As a brand custodian, a company's CMO must be aware of the laws under which legal protection is available. One must also be aware of the operational sphere in which the company will operate. The first parameters that need to be defined are the marketing and business reaches of the company. Is the company only trading or offering its services in Malta? Does this mean that protection only needs to be sought within our shores? In the past, replies to this question might have been relatively simple with local registration sufficing.

This is however an era of Malta establishing itself as a European world-class centre for international business, with financial services, education and ICT on the fore of Malta's economic advancement. More Maltese entrepreneurs are venturing successfully beyond our shores. Local companies are adopting a more forward-looking approach and are devising sophisticated IP Protection Plans covering companies' immediate and growth requirements. Creating a solid brand means taking into account considerations such as local TM protection, European Trademark Protection (CTM), Asian and American

portfolio planning, domain portfolio planning, IP corporate structuring and other less evident considerations such as IP valuations, tax planning and goodwill issues.

THE BUILDING BLOCKS

Initially one needs to understand the different legal terms and permutations of the TM world. Trademark law protects a brand's identity and this comes in various forms and shapes including names, titles, taglines, slogans, logos, other designs, product shapes, sounds, smells, colours or any other features that distinguish one source of products or services from another. Trademarks that protect services are often called service marks ("SM"). The Maltese Trademark Act provides for the registration of service marks, name marks and shape marks. It also provides for trademark licensing, the protection of well-known marks, collective and certification marks. Internationally, terms vary and one finds other types of protections such as "collective membership marks" (eg Boy Scouts of America).

Upon embarking on the search for a new unique and distinctive mark, various steps need to be taken to ensure the ensuing investment is made in the right mark. Your IP specialist will, amongst others:

- carry out local TM searches and work with foreign international specialists to obtain clearance in important overseas markets, taking into account identical, similar or other confusing marks;
- carry out a phonetic impact assessment of the mark;
- research the meaning of the mark in

other foreign languages;

- building an intellectual property inventory;
- analyse the sphere of operation of the company to ensure that all the classes of goods are covered;
- advise on intangible asset protection structures for your brand portfolio;
- recommend domain portfolio build-up techniques;
- devise a TM protection plan; and finally
- present you with a documented IP Strategic Plan for use by your marketing department or external marketing consultants.

CONCLUSION

Intellectual property law is that branch of law which protects your company's valuable intangible assets. Be it your distinctive design or mark, be it your unique invention or formula; be it your domain name ... whatever renders your company unique in your market deserves maximum protection. Intellectual property is that area in commercial law which provides entrepreneurs with the legal comfort to create and discover without the constant fear of an impending attack on their initiative. The essence of careful IP portfolio planning is an in-depth knowledge of the business and the problems encountered in the path to absolute creativity. The role of the Intellectual Property Advisor in all TM portfolio strategies is to apply a pragmatic business approach to a company's brand portfolio and obtain results consistent with the enterprise current and future intellectual property needs. ■

This article is intended to be of a general nature and is not intended to address the specific circumstances of any individual or entity. The author shall not be responsible for any damage which may arise from reliance on information contained in this article. Specialist advice should also be sought before any action is taken on this basis.

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