

Check of requisites for trademark registration and protection

Requisites for trademark validity are:

- **novelty**: the trademark should be novel, that means that it can not be identical or similar - confusingly similar to an earlier trademark registered for identical or similar products, or to a company name or a trade name etc. of competitors operating in the same field. To this purpose our Law Firm can provide [identity and similarity search](#) in order to check any pre-existence of filed or registered trademark. Besides, a trademark should not consist exclusively of signs that have become customary in current language or in established practices of the trade.

- **distinctiveness**: the trademark can not consist exclusively of generic denomination of goods/services or in descriptive indications related to them, as signs or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service. *Our Law Firm always check these grounds, providing the Client with advice concerning best solutions in case of critical situation with reference to the requisite of distinctiveness.*

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[Please see the document concerning confusingly similar trademarks](#)

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- **lawfulness**: the following shall not be registered: trademarks which are contrary to public policy or to accepted principles of morality; trademarks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service; signs which may be prohibited by virtue of an earlier right: a right to name, a copyright, an industrial property right.

Denominative trademark – Figurative trademark

Denominative trademark is made up of a word or an assembly of words. It consists only of words, without any design or further graphic characteristics than simply words. Word-trademark application is intended to protect words in any graphic representation.

When filing a figurative trademark application, protection is claimed with reference to exact graphic representation of the sign according to the application instead. (being safe anyway protection even against confusingly similar trademarks).

Therefore the most important thing is to decide whether to file a denominative trademark application (only word or group of words), or a figurative trademark application (only images, or word & design, or words represented in distinctive graphic representation or colour), or to file two different applications, one denominative (with the denominative element that characterizes the trademark) and one figurative (with the design, with or without denominative element). *Our Law firm provides the Client with assistance when making this important decision*

Selection of the classes of goods/services

In order to file a trademark application, goods/services intended to be distinguished with the trademark have to be indicated. To the purpose of rationalizing the choice of goods/services, 45 goods/services classes have been individuated. The applicant may indicate one or more classes and with reference to each class can further on specify products or services intended to be protected by trademark application ([please see Nice classification](#)). *Our Law firm provides the Client with assistance when making this important decision*

Territorial extension of protection

Italian trademark – Community trademark – International trademark

Fundamental decision concerns the territorial extension of the right, for this purpose you may choose:

1. **National trademark:** the application is filed in front of Italian Patent and Trademark Office (U.I.B.M.) and the protection covers the whole Italian territory;
2. **Community trademark:** the application is filed in front of Office for Harmonization in the Internal Market (OHIM – based in Alicante, Spain) and the protection covers European Union;
3. **International trademark:** the application is filed in front of World Intellectual Property Organization (WIPO, based in Geneva, Switzerland), through U.I.B.M., and is based on a national or Community trademark registration or application; the protection can cover any of the [Countries belonging to Madrid System](#)

the Applicant may indicate, according to business interests.

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