



Legal Protection of Trademarks, the Albanian Legal Framework for Their Protection Between Defining Similarities and Differences of the European and American System

MSc. Ingrida Behri Mustafa¹

PhD.Cand. Lira Spiro²

¹Lawyer at Legal Office "Ingrida Behri and Coo."

²Lawyer at Legal Office "Temis&AOK"

Received: 19 February 2024 / Accepted: 15 March 2024 / Published: 23 March 2024
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Doi: 10.56345/ijrdv11n122

Abstract

The subject of this study is the submission of trademark protection within the national and international legal framework. In this respect, the legal protections enjoyed by a trademark registered under legal norms were laid out first, secondly through comparative analysis the similarities and differences between the European and American system for the legal protection of trademarks. At the end of the work is prohibited under the domestic legal framework of trademarks. Adequate legal protection is that which differentiates a symbol, a letter, a mark from simple rating to legally protected trade mark.

Keywords: trademark, law, defense, brand, franchise etc

1. Introduction

1.1 What is a trademark?

A trademark is a sign capable of distinguishing the goods or services produced or offered by one company from those of other companies. Any distinctive words, letters, numbers, drawings, figures, shapes, colors, logotypes, labels or combinations used to distinguish goods or services may be considered trademarks¹. Trademarks and service marks may include colors, smells and sounds.²

Trademarks play an important role in the open source ecosystem – while copyrights and patents are freely shared in open source licensing, trademarks are not. A project's reputation is at risk if it allows malicious software, poor quality software, or software that does not work as expected to be distributed under the same name.

Open source projects can, and therefore generally do, exercise their exclusive rights under trademark law.³ The term "service mark" is used for services and "trademark" is used for goods, although the words "trademark" and "brand" are also often used to encompass both goods and services. The terms "trademark" and "brand" will be used interchangeably in this chapter for both trademarks and service marks. 'Trade dress' is a term used to 'freeze' or dress a product, meaning the packaging for the product, the configuration of the product itself, the decor or the environment in

¹ J.K. Ahmadu-Suka, "Making a mark intellectual property" for business series, No.1, fq.4

² <https://tsdr.uspto.gov/#caseNumber=76408109&caseType=SERIAL>

³ Elasticsearch filed a trademark infringement lawsuit against Amazon, *Elasticsearch, Inc v Amazon.com, Inc.*, No. 3:19-cv-06158 (N.D. Cal.) (complaint filed 27 September 2019).

which the services are performed, such as interior design of a chain restaurant.

The concept of "brand" is similar to "trademark". A "brand" is a marketing term used to describe a consumer's entire engagement with a product or business. A "trademark" is a container for the brand's identity, the tangible manifestation that the consumer associates with the product or business.⁴

A trademark identifies a single, unique source. However, the consumer should not be able to identify the source by name. The quality of being a trademark, rather than just a word, means that consumers recognize that the word or symbol indicates that the goods or services come from a particular entity, differentiated from others of a similar type in the market⁵.

Although a trademark always identifies a single source, the way a trademark is used can indicate different types of relationships with that source.

A trade mark can indicate the source of production, 'I made this' to say: (a) that the trade mark owner controls the quality of the goods and services but did not make them, such as in a franchising relationship- franchisee; (b) that the trademark owner has endorsed the third party's goods and services, such as licensed sports team apparel and promotional items; or (c) that the trademark owner is merely advertising, such as venue naming rights. The consumer will understand these different relationships based on where the trademark is placed, whether other trademarks are used, wording that can clarify the relationship and common sense, and the consumer's familiarity with how businesses operate. It will be a trademark infringement to suggest to consumers that any of these relationships exist if they are not true.⁶

A growing number of countries also allow the registration of less traditional forms of trademarks such as single colors, three-dimensional signs (product shapes or packaging), audible signs (sounds) or olfactory signs (smells).

The main function of a trademark is to enable consumers to identify a product of a particular company in order to distinguish it from other identical or similar products offered by competitors. Customers who are satisfied with a particular product are likely to buy or use the product again in the future. For this, they must be able to easily distinguish between identical or similar products.⁷

By enabling companies to differentiate themselves and their products from those of the competition, trademarks play a key role in the branding and marketing strategies of companies, contributing to defining the image and reputation of the company's products in the eyes of consumers. A company's image and reputation create trust that is the basis for creating a loyal clientele and increasing a company's goodwill. Consumers often develop an emotional attachment to certain trademarks based on a number of desired qualities or features embodied in the products bearing such trademarks.⁸

Trademarks also provide an incentive for companies to invest in maintaining or improving the quality of their products in order to ensure that products bearing their trademark have a positive reputation.

1.2 What is the legal value of a trademark and why should it be legally protected?

A carefully chosen and nurtured trademark is a valuable business asset for most companies. For some, it may be the most valuable asset they own. Estimates of the value of some of the most famous brands in the world such as Coca-Cola or IBM exceed 50 billion dollars each⁹. This is because consumers value trademarks, their reputation, their image and a number of desirable qualities that they associate with the brand and are willing to pay more for a product that bears a trademark that they recognize and that meet their expectations. Therefore, the very ownership of a trademark with a good image and reputation provides a company with a competitive advantage.¹⁰

While most businesses understand the importance of using trademarks to differentiate their products from those of their competitors, not all understand the importance of protecting them through registration. Registration, under relevant trademark law, gives the company the exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar brand.¹¹

⁴ G & C Merriam Co v Syndicate Pub Co, 237 US 618, 622 (1915) ('[U]pon the termination of [the copyright on the work] there by the copyright.)

⁵ G & C Merriam Co v Syndicate Pub Co, 237 US 618, 622 (1915)

⁶ Richard Stallman, '[Savannah-hackers] Re: Issue of Trademark Logo Images in Source Distribution' (2004) accessed 15 January 2020

⁷ J.K. Ahmadu-Suka, "Making a mark intellectual property" for business series, No.1, pg.5-6.

⁸ J.K. Ahmadu-Suka, "Making a mark intellectual property" for business series, No.1, pg.5.

⁹ J.K. Ahmadu-Suka, "Making a mark intellectual property" for business series, No.1, pg.6.

¹⁰ J.K. Ahmadu-Suka, "Making a mark intellectual property" for business series, No.1, pg.6-7

¹¹ J.K. Ahmadu-Suka, "Making a mark intellectual property" for business series, No.1, pg.7.

Without trademark registration, companies' investments in marketing a product may become wasted as rival companies may use the same or a confusingly similar brand for identical or similar products. If a competitor adopts a similar or identical brand, customers may be misled into buying the competitor's product thinking it is the company's product. Not only can this reduce the company's profits and confuse customers, but it can also damage the company's reputation and image, especially if the rival product is of inferior quality. Given the value of trademarks and the importance a brand can have in determining the success of a product in the market, it is essential to ensure that it is registered in the relevant market.

2. Trademark Values

Trademarks:

- ensure that consumers can distinguish between products;
- enable companies to differentiate their products;
- are a marketing tool and basis for building a brand image and reputation;
- are licensed and provide a direct source of income through royalties;
- are an essential component of franchise agreements;
- can be a valuable business asset;
- encourage companies to invest in maintaining or improving product quality;
- may be useful for obtaining financing.

The basic concept of trademark law is universal that distinctive signs indicating commercial origin are protected by acts of third parties which would expose consumers to the risk of confusion of goods offered by different sources¹². From these essential objectives derive the essential components of trademark systems worldwide: To fulfill their role as indicators of commercial source, trademarks must have a basic ability to distinguish goods or services by their commercial origin and protection provided by the acquisition of a trade mark must at least permit the exclusion of others from the use of signs which, having regard to their identity or similarity to the protected mark, and because they are used for identical or similar goods or services similar, may create a possibility of confusion¹³. So far, so good. However, beyond the main features they all share, trademark systems can be quite distinct in their details. Although the reasons for the divergences may be manifold, they usually reflect a fundamental difference in the emphasis placed on the proprietary interests of actual or potential rights owners on the one hand, and those of consumers and the general public on the other.¹⁴ As far as European trademark law is concerned, identifying the underlying policies that take into account its peculiarities is not an easy task. Compared to US law, the current legislation is still in its infancy, and the national systems from which it grew were quite different in their basic approaches¹⁵.

However, despite its somewhat broken character regarding common concepts and objectives, it is safe to say that compared to its American counterpart, European law places more emphasis on the proprietary aspects of trademark protection. It is basically taken for granted that trademarks are just another category of intellectual property rights that has more in common with patents and industrial designs than with the broad and widespread field of marketing regulations (which in European legal parlance would be labeled "unfair competition").

3. Legal protection of the trademark

Trademarks are generally protected through registration, following an application filed with a national or regional intellectual property (IP) office. In some countries, trademark rights are also available through use.

A trademark protects the right to distinguish the owner's goods or services from other goods or services of another owner. Trademark protection provides exclusive rights to owners¹⁶. It means that the protection gives the owner the right to exclude other parties from using his mark or imitating his mark for goods or services that do not originate from him. The

¹² *The Community Trademark System (infra Part II, note 6) has been operative since 1996, and the process of harmonization of national trademark legislations on the basis of the Trade Mark Directive (infra note 5) was concluded around the same time*

¹³ *Ibis.*

¹⁴ *Annette Kur, Fundamental concerns in the harmonization of (European) trademark law, in TRADEMARK LAW AND THEORY 151-76 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008).*

¹⁵ *Ibis.*

¹⁶ *A. L. Brookman, Trademark law, Second Edition, 2015 USA, p.4*

trademark right is limited, it can be protected for the next 10 years with 10-year renewable options¹⁷. Trademark rights are purely territorial in scope. There are two ways of trademark protection, national protection and international trademark protection.¹⁸

Commercial markets today enjoy a double protection, firstly by national domestic legislation and secondly by international legislation.

- **National Protection** -- Trademarks may be reproduced in any country. National trademark protection is when the applicant applies for protection in a current state or territory at their national office. Examiners will examine whether the mark meets the requirements in accordance with national legislation. The protection of this mark is valid only in the territory in which the protection is sought¹⁹. The procedure for the protection of national trademarks is regulated by national law and their implementing regulations. If the mark meets the requirements of those laws and regulations at the national level, then the mark will have protection.²⁰
- **International Protection** -- International trademark registration simplifies the procedure for obtaining a trademark registration in more than one country by completing an application. The protection of international trademark registration is regulated by the Madrid Agreement and the Madrid Protocol and is known as the Madrid system of protection. The Madrid Agreement was signed in 1891 and provides for the protection of trademarks in many countries which receive a valid international registration in each contracting party.²¹ Accordingly, nationals of each of the contracting countries may, in all other countries party to this Agreement, secure protection for their trademarks applicable to goods or services, registered in the country of origin, by filing said trademarks with the Bureau International. of Intellectual Property referred to the Convention for the establishment of the World Intellectual Property Organization, through the mediation of the Office of the country of origin in question. This means that international registration is when the trademark owner applies to gain registration in member countries, each of which applies its own rules and laws to determine whether or not the trademark can be protected in their jurisdiction. As we can see, the Madrid system offers protection to trademark users who apply for protection in a number of countries at the same time. When we say the number of countries, we mean all countries that are contracting parties to this treaty, including countries outside the European continent. The applicant must apply for international protection at the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva.

On the other hand, there is also another community for trademark protection (CTM). CTM is a unitary mark for each EU member state. The Office for Harmonization in the Internal Market (OHIM) simplifies the procedure for obtaining trademark protection in the EU especially for a person doing business in more than one EU country²². By filing a CTM, the applicant can obtain trademark protection in all EU countries. The number of EU member states has reached 28 with the accession of Croatia since 1 July 2013. This means that a CTM can provide trademark protection in all 28 countries. The EU has 24 official languages, so an applicant applying for a CTM can complete the trademark application in any of these 24 official languages. However, the applicant will have to translate the application into one of the five official languages of the OHIM which are English, French, German, Italian and Spanish. As we can see, there are five official working languages of OHIM.²³

3.1 *The similarities and differences between the European and the American System within the legal protection of the trademark*

Trademark law in Europe includes both European Union (EU) legislation and the national laws of the 27 Member States of the Union for the protection of trademarks.

The Community Trade Mark Regulation (CTMR) of December 1993 (in 2009 codified as Regulation [EC] No. 207/2009) allows the registration of Community trade marks which provide Community-wide protection. Community

¹⁷ Article 18 of TRIPS Agreement has set minimum terms of years for duration of protection

¹⁸ B.M. Barkoff and A.C. Selden, *Fundamentals of Franchising, Third Edition, 2008, USA, p.44*

¹⁹ L. Brookman, *Trademark law, Second Edition, 2015 USA, p.4*

²⁰ *Ibis.*

²¹ MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS, article 1, point 2, available online: http://www.wipo.int/edocs/lexdocs/treaties/en/madrid-gp/trt_madrid_gp_001en.pdf

²² C. Colston, *Principles of Intellectual Property Law, 1999, London, p. 374*

²³ F. ABBOTT, TH. COTTIER and F. GARRY, *International Intellectual Property In An Integrated World Economy, Second Edition, USA, 2011*

trademarks are administered by the EU's trademark and design office, the Office for Harmonization in the Internal Market (OHIM), located in Alicante, Spain. The CTMR coexists with national trade mark laws, which were substantially harmonized in terms of substantive law in 1988 by the First Directive to approximate the laws of the Member States relating to trade marks (Trade Marks Directive). Since the three Benelux countries established a common trademark system in 1970, there are 25 different national trademark regimes in the European Union. The German Trade Marks Act of 1994 implemented the Directive, but is, in addition, a comprehensive law ensuring the protection of all distinctive signs. European trade mark law relies on two structures: the Trade Mark Directive (TMD) and the Community Trade Mark Regulation (CTMR). TMD obliges EU member states to harmonize their laws in order to comply with the provisions set out in it. The CTMR has created a unitary trade mark right that extends throughout the EU.⁸ Once a Community trade mark (CTM) has come into existence, it is not subject to the territorial divisions that otherwise divide member states. As stated in article 1(2) of CTMR:

"The Community trademark has a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the owner or declaring it invalid, nor shall its use be prohibited, to the exclusion of the entire Community."

The requirements for the protection of trademarks at national and Community level are the same, with only a few exceptions. Under both regimes, registration is refused if the mark does not have any distinctive character, or can serve as an indication of the quality, geographical origin or other characteristics of the goods or services, or is customary in bona fide trade²⁴. However, so far no harmonization has been achieved regarding registration procedures: Some Member States carry out a full examination, including the prior rights of third parties, while others limit their examination to the so-called absolute grounds for rejection (distinctiveness, functionality, or fraud) and leaves it to the initiative of the owners of prior rights to oppose the request in the opposition procedure.

The last approach is also followed by the authority entrusted with the administration of the MKT system, the "Office for Harmonization in the Internal Market" (OHIM).²⁵

Most important in comparison to US trademark law is the fact that protection under the CTMR as well as the TMD is provided only by registration.²⁶ There is no requirement that the mark be used in commerce at the time of application or registration, and it is also not necessary for the applicant to file a statement of intent to use at any time during the process.²⁶ The issue becomes relevant only if, after a continuous period of five years after registration, the trademark has not been put to genuine use within the territory for which it has obtained protection.²⁷

But even then, no official action is taken to clear the trademark register of unused trademarks. Only if non-use is claimed in inter partes proceedings within OHIM (or a national office) or before a court, the case will be examined, which may ultimately lead to revocation and annulment of the mark. Such situations usually occur if an applicant, faced with an opposition filed by the holder of a prior trademark, raises a counter-objection, claiming non-use as a defense. Otherwise, the trademark remains registered. It can even be extended without difficulty, as neither OHIM nor any of the national offices require a declaration of use to be made at the renewal stage.

Trademark protection is available for all types of signs that can distinguish the goods or services of one enterprise from those of others. These signs include traditional signs such as words, names and figurative signs, but also shapes and colors and color combinations, and even invisible signs such as sounds. To be entitled to trademark protection, a sign must be capable of being represented graphically. Case law has interpreted this condition strictly and requires that the representation be clear, accurate, independent, easily accessible, understandable, consistent and objective.

The Community trade mark system is based on the principle of the unitary character of a Community trade mark. Thus, any absolute basis that exists in one part of the European Union will result in a rejection or invalidity, as will any previous right of extension throughout the Union or throughout the Member State. In national systems, earlier Community trade marks constitute earlier rights; in other respects, the obstacle must exist in the Member State concerned. Consequently, a mark which cannot be registered as a Community trade mark or in a particular Member State because of its descriptive character may be registered in other Member States where a different language is spoken. In this presentation we will cover European and German trademark law.

²⁴ Office for Harmonization in the Internal Market, <http://www.oami.europa.eu>

²⁵ In addition, EU member states are free to grant protection to unregistered marks, see TMD, *supra* note 5, recital no. 5.

²⁶ *ibis*

²⁷ CTMR, *supra* note 6, art. 15 (CTMs must be used in the community); see also TMD, *supra* note 5, art. 10 (national marks must be used in the relevant Member State).

Procedure for obtaining trademark rights. To obtain registration of a Community trade mark, an application must be filed, either directly with the OHIM, located in Alicante, Spain, or through a national office in one of the Member States. The application must contain a presentation of the brand, a list of goods or services grouped in accordance with the international classification of goods and services defined under the Nice Agreement.

Applications may claim the priority date of an earlier filing with a Paris Convention or WTO member. The application fee and additional class fees for classes beyond the third class must be paid within one month from the date of filing. Applicants without domicile or residence in the European Union must appoint a professional representative authorized to represent them in trademark matters in one of the Member States. Applications are reviewed ex officio for compliance with formal requirements and absolute grounds. OHIM also conducts a search for the previous community.

In conclusion of this sub-point we can say that in the European Union, the legal framework for trademarks is based on a four-level system for trademark registration, which "co-exists" with national trademark systems harmonized by the Trademarks Directive Commercial²⁸. Possible routes for trademark protection are the Benelux route and the international route. The EU regulation²⁹ codifies and replaces all previous EC regulations on branding. The trademark has unitary character and equal effect throughout the EU. The EUIPO (European Union Intellectual Property Office) is responsible for the management of the EU trademark and design and determines the amount of fees payable to the EUIPO.

In the following, we will present the differences between the two systems regarding the legal protection of trademarks.

➤ **Registration Levels**

The US uses a two-tier system for trademark protection. Trademark owners can register their mark at the state level or with the federal government through the USPTO. Under the Lanham Act, a federal registration gives rights to registrants throughout the US. Whereas a state trademark registration protects the mark only in the state where it is registered.³⁰

EU trademark law consists of a system valid throughout the European Union. It is not possible to limit the geographical scope of the protection of an EU trade mark to individual Member States. If you want to register your trademark in a particular country, you must go through the national trademark office of that particular country (the Spanish Patent and Trademark Office for Spain).

➤ **Trademark Offices**

The United States Patent and Trademark Office (USPTO) is one of the largest and most recognized trademark registration offices in the world, with a strong legal framework for trademark protection.³¹ According to official USPTO statistics, in 2021, there were approximately 576,000 trademark applications filed and approximately 480,000 trademark registrations issued. These numbers include domestic and international trademark applications and registrations.

The European Union Intellectual Property Office (EUIPO)³² offers a single registration system for trademarks in all 27 EU member states, making it an attractive option for businesses looking to protect their brand across the EU. According to the official statistics of the European Union Intellectual Property Office (EUIPO), in 2020, there were approximately 173,000 trademark applications filed and approximately 160,000 trademark registrations granted in the European Union (EU) through the EUIPO.³³

➤ **Trademark priority**

The United States follows a "first to use" trademark system, meaning that the first party to use a trademark in commerce generally has superior rights over subsequent users of the same or similar trademark. Under the US first-use system, a business can establish common law trademark rights simply by using the mark in commerce, without

²⁸ Directive 2015/2436 e 16.12. 2015 "For alignment with Member States' trademark laws"

²⁹ Regulation EU 2017/1001 of June 14, 2017 "EU Regulation on Trademarks"

³⁰ https://www.newsearchtoday.co/web?q=uspto+trademark+application&o=1671927&gad_source=5&gclid=EAIaIQobChMlzv_p8q63hAMVukJBAh3pbAGdEAAyAiAAEglFy_D_BwE&qo=semQuery&ag=fw&an=google_s&tt=rmd&ad=semA&akid=1000000912nst149769009760kwd-299660674231

³¹ https://www.newsearchtoday.co/web?q=uspto+trademark+application&o=1671927&gad_source=5&gclid=EAIaIQobChMlzv_p8q63hAMVukJBAh3pbAGdEAAyAiAAEglFy_D_BwE&qo=semQuery&ag=fw&an=google_s&tt=rmd&ad=semA&akid=1000000912nst149769009760kwd-299660674231

³² https://www.offshorecompanycorp.com/intellectual-property-service/eu-trademark-registration-services?gad_source=1&gclid=CjwKCAiAlcyuBhBnEiwAOGZ2S7E8F60voCV0tldvy3qdOQyKzdvSnoeDmiXIFLvlngL7LyTGZK5EZBoCjlsQAvD_BwE

³³ https://www.offshorecompanycorp.com/intellectual-property-service/eu-trademark-registration-services?gad_source=1&gclid=CjwKCAiAlcyuBhBnEiwAOGZ2S7E8F60voCV0tldvy3qdOQyKzdvSnoeDmiXIFLvlngL7LyTGZK5EZBoCjlsQAvD_BwE

necessarily registering the mark with the United States Patent and Trademark Office (USPTO).³⁴ However, registering a trademark with the USPTO can provide additional legal benefits and protections, such as nationwide notice of the trademark owner's claim to the mark, the ability to use the ® symbol, and a legal presumption of ownership and validity of the mark.³⁵

In contrast, the European Union follows a "first to file" trademark system, meaning that the first party to file a trademark application with the European Union Intellectual Property Office (EUIPO) has rights superior to subsequent users of the same or similar trademark. Regardless of whether they actually used the trademark in commerce. Under the EU's first-filing system, businesses seeking trademark protection must apply for registration as soon as possible to ensure they have an advantage over potential competitors.

➤ **Examination process**

There are a number of differences in the trademark examination process between the European Union and the United States. One of the main differences is that the EUIPO conducts both formal and substantive examinations of trademark applications, while the USPTO focuses primarily on substantive examination. The EUIPO examines applications to ensure that they meet formal requirements, such as the proper classification of goods and services, and that they comply with the technical requirements of the trademark registration process. In addition, the EUIPO carries out a substantive examination to assess whether the applied mark is distinctive and does not conflict with existing marks. In contrast, the USPTO's examination focuses primarily on assessing the distinctiveness and potential for confusion of the applied-for mark with existing marks.

Additionally, the opposition period in the US is 30 days after publication of the trademark application, with a possible extension of up to six months. The EU opposition period is three months after publication of the trademark application and this time cannot be extended.

➤ **Usage Requirements**

Both the United States and the European Union have usage requirements for trademarks, although the specific requirements differ slightly. In the United States, a trademark owner must use the trademark in commerce to maintain its registration and protection. The trademark use requirement is a common feature of the trademark registration process in the United States. When filing a US trademark application, business owners must specify the legal reason why they are allowed to federally register a trademark. This is known as the base of the files. There are multiple filing bases and business owners must meet all legal requirements for the filing base they choose.

➤ **Classification System**

Both the US and the EU use the Nice Classification system, which is a system of organizing goods and services into 45 different classes for trademark registration purposes. The Nice Classification System was developed by the World Intellectual Property Organization (WIPO) and is used by most countries around the world.³⁶

A major difference between the US and the EU is in the way goods and services are grouped into classes. In the US, goods and services are grouped into 45 different classes, with each class covering a specific type of goods or services. The classes are quite broad and it is not unusual for a single class to cover a wide range of goods or services.³⁷ In the EU, goods and services are also grouped into 45 different classes, but the classes are more specific and narrower than in the US. This means that it may be necessary to file multiple applications in the EU to cover all the goods or services that a trademark applicant wishes to protect. In addition, the US allows "dual classification", meaning that a single product or service can be classified in more than one class if it is considered to be relevant to multiple classes. However, in the EU, a product or service can only be classified in one class.

➤ **Common Law trademark rights or European trademark rights**

In the US, the user of a trademark can acquire certain common law rights simply by being the first to use the mark in commerce, even without registration. In the EU, trademarks must be registered to receive protection.

➤ **Registration requirements and use in commerce**

³⁴https://www.newsearchtoday.co/web?q=uspto+trademark+application&o=1671927&gad_source=5&gclid=EAlaIqobChMlzv_p8q63hAMVukJBAh3pbAGdEAAYAiAAEgIFy_D_BwE&qo=semQuery&ag=fw&an=google_s&tt=rmd&ad=semA&akid=1000000912nst149769009760kwd-299660674231

³⁵ https://www.newsearchtoday.co/web?q=uspto+trademark+application&o=1671927&gad_source=5&gclid=EAlaIqobChMlzv_p8q63hAMVukJBAh3pbAGdEAAYAiAAEgIFy_D_BwE&qo=semQuery&ag=fw&an=google_s&tt=rmd&ad=semA&akid=1000000912nst149769009760kwd-299660674231

³⁶ <https://www.wipo.int/portal/en/index.html>

³⁷ <https://tm.legal/en/differences-between-us-and-eu-trademark-law#:~:text=In%20the%20U.S.%2C%20the%20user,Requirements%20and%20Use%20in%20Commerce>

Trademark rights in the United States are based on use in commerce. There are two types of applications: "use in commerce" or "purpose for use". The application must include the date of the applicant's first use of the mark and the applicant's first use of the mark in US commerce. In "intent to use" cases, there must be evidence of use of the trademark when the opposition period has expired or the period can be extended up to six months after the end of the trademark process to provide evidence.³⁸

The EU has no requirement that a mark be used in commerce at the time of the trademark application or registration. This means that an EU trade mark can be registered for goods or services even if the trade mark owner does not use it or does not intend to do so. However, if an EU trademark is not used for five consecutive years, another party, by filing a request with the European Intellectual Property Office, can try to invalidate it based on its lack of use.

➤ **Differences in several important types of signs**

The US has different types of marks, one of the most common of which is the standard character mark, also known as a word mark. A wordmark protects wording regardless of how the words appear. A special form of this is called a stylized font. This mark is considered another form of a word mark where the font, color or size of the text is distinctive - or stylized. The EU does not have stylized lettermarks.³⁹ In the EU there are word marks and figurative marks. A punctuation mark consists of words consisting of a group of letters, punctuation marks, or numbers. In the EU, a logo or a stylized word falls under the category of figurative mark. The EU also has various other signs, including 3D signs and phonetic signs, among others.

➤ **Protecting your trademark against identical or similar marks**

In the US, the trademark examiner will usually refuse to register a proposed mark if it resembles an already registered mark. In the EU, it is up to the trademark owner to monitor and oppose other applications. It is therefore important that EU trademark owners monitor their trademarks closely.⁴⁰

➤ **Appeal periods**

The opposition period in the US is 30 days after publication of the trademark application, with a possible extension of up to six months. The EU opposition period is three months after publication of the trademark application and this time cannot be extended.⁴¹

As far as European trademark law is concerned, identifying the underlying policies that take into account its peculiarities is not an easy task. Compared to US law, the current legislation is still in its infancy, and the national systems from which it grew were quite different in their basic approaches. However, despite its somewhat impaired character with respect to common concepts and objectives, it is safe to say that compared to its American counterpart, European law places more emphasis on the proprietary aspects of trademark protection⁴². It is basically taken for granted that trademarks are just another category of intellectual property rights that has more in common with patents and industrial designs than with the broad and widespread field of marketing regulations (which in European legal parlance would be labeled "unfair competition"). The conceptual differences between European and American trademark law are reflected not least in the way in which trademark protection is affected by the actual use of trademarks in the marketplace. As will become more transparent in the course of this article, the assessment of actual use is also important for the delicate balance between national and Community trade mark systems, which is another characteristic feature of European trade mark law.⁴³ The impact of current use on the acquisition and maintenance of brands and the difficulties caused by the coexistence of trademark systems at two different levels are addressed in this paper in the light of a study that was recently carried out as part of a general assessment of the functioning of European trademark system⁴⁴.

³⁸ <https://tm.legal/en/differences-between-us-and-eu-trademark-law/#:~:text=In%20the%20U.S.%2C%20the%20user,Requirements%20and%20Use%20in%20Commerce>

³⁹ <https://tm.legal/en/differences-between-us-and-eu-trademark-law/#:~:text=In%20the%20U.S.%2C%20the%20user,Requirements%20and%20Use%20in%20Commerce>

⁴⁰ <https://tm.legal/en/differences-between-us-and-eu-trademark-law/#:~:text=In%20the%20U.S.%2C%20the%20user,Requirements%20and%20Use%20in%20Commerce>

⁴¹ <https://tm.legal/en/differences-between-us-and-eu-trademark-law/#:~:text=In%20the%20U.S.%2C%20the%20user,Requirements%20and%20Use%20in%20Commerce>

⁴² Annette Kur, *Fundamental concerns in the harmonization of (European) trademark law*, in *TRADEMARK LAW AND THEORY* 151-76 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008)

⁴³ Max Planck Institute for Intellectual Property and Competition Law, *Study on the Overall Function of the European Trade Mark System* (Feb. 15, 2011), <http://www.ip.mpg.de/shared/data/pdf/mpi-fmal-report.pdf> [hereinafter *Trade Mark Study*]

⁴⁴ *Ibis*.

4. Domestic Legal Framework for Trademark Protection

Industrial property in Albania has its beginnings as early as 1920. From archival sources⁴⁵ of the time we learn that traders were sensitive to the protection of their products from counterfeiters. This was achieved through the protection of products through trademark registration. The first trademark certificate dates back to April 16, 1920, issued for the "Hobdari" brand, which created the soap factory. During this period, a large number of foreign trademarks were protected in Albania. At that time it was the Trademark Registration Bureau under the Chamber of Commerce, under the Ministry of Foreign Trade.⁴⁶

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Law No. 9947 dated 07.07.2008 "On industrial property", as amended, defines as trademark or service mark any sign or combination of signs, which is presented graphically and serves to distinguish the goods or services of a natural or legal person from those of another person physical or legal, is a brand that represents those goods or services⁴⁷. Music, computer-generated film images, and perfumes all have the potential to be recordable, as today sounds, computer images, and smells can be represented graphically. What is important is what is also a limiting factor, that trade marks must be published in the Industrial Property Bulletin, in which the external appearance of the marks must be given. The purpose of this publicity is to introduce each dealer to products similar to the ones they sell. Article 140 provides specific signs that can serve as trademarks. Thus, in this article it is stated that the following signs constitute a trademark:

a) words, including personal names, letters, numbers, abbreviations b) figurative signs, including drawings c) two- or three-dimensional shapes, shapes of goods and/or their packaging ç) combinations of colors and light-shadows, as well as colors by itself d) any combination of signs, mentioned by the letters "a" to "ç" of this point.⁴⁸

A brand that is likely to be dangerous to the public cannot be registered as may be the case if a brand used for medicine is misleadingly similar to a brand used for poison. An example of such a trademark is the Jardex trademark application for the poison disinfectant product, at a time when a Jardox meat extract was on the market.

Once the trademark is registered, the owner or exclusive licensee has exclusive rights over it, which may be infringed if the owner has not given consent for the trademark to be used. The rights start from the date of registration, which is the date of filing the claim.⁴⁹

Cases of conflicts for industrial property rights⁵⁰

Karelia Tobacco Company Inc. v. Ballgini shpk

The plaintiff trades mainly cigarette products in Albania. In order to protect his products, the plaintiff has regularly registered his brand, including the Karelia Slims brand (in Albania, this cigarette has a good name and is one of the best-selling cigarettes).

In the first week of 2006, Anonime Company Kakavije, the company responsible for the import and distribution of Karelia cigarettes in Albania, notified the plaintiff regarding the release on the Albanian market of packages of a quantity of 350 thousand packages of Elegant Slims cigarettes, this package, which according to plaintiffs, carried a mark that was very similar to the Karelia Slims trademark. Elegant Slims was produced in Turkey by the European Tobacco SA Company and was imported into Albania by the respondent with destination for the Albanian market.

The court, after reviewing the evidence presented, concluded that there was a great similarity between the Karelia Slims and Elegant Slims cigarette packages, which in market conditions could lead to public confusion. According to the Court, the similarity consisted in the following aspects: the format of the package, its design, the white color of the package, the coloring strips located and of the same size, the similarity of the emblems and their locations, the stylized word Slims, as well as the way of opening packages. The above elements and, in particular, their overall image, make

⁴⁵ <https://dppi.gov.al/rrethdppi/historiku>

⁴⁶ *The responsible institution for the registration of brands which operated according to Decree No. 2490 dated 22.07.1957 amended by decrees no. 3530 dated 01.07.1962 and No. 4253 dated 11.04.1967 "For the production and trade market"*

⁴⁷ *Article 140 of the Law. 9947 dated 07.07.2008 "On industrial ownership"*

⁴⁸ *ibis*

⁴⁹ *Article 146 of Law*

⁵⁰ *Commentary on Patents and Trademarks, pp. 137-143, legal publications Ombra gvg, 2007*

these two packages too similar to be distinguished by the average consumer.

As a result of the similarity between the packages of Elegant Slims and Karelia Slims, the sale of Elegant Slims cigarettes caused confusion in the market, to the detriment of consumers of Karelia Slims. At the same time, this similarity favored the sales of Elegant Slims packages to the detriment of Karelia Slims packages, thus also violating the rules related to protection from unfair competition.

Based on the similarity between these two packages, from the marketing of the quantity of 350 thousand pieces of Elegant Slims packages, the plaintiff was caused a significant financial and non-financial damage, the values of which are specified in the request of his lawsuit. Under these conditions, the court, considering the production and sale of Elegant Slims packages in the Albanian market as a violation of the rights arising from the registration of the Karelia Slims brand, based on articles 76 and 77 of law no. 7819, as well as a violation of the rules that protect fair competition on the basis of Article 638 of the Civil Code, decided to declare as an illegal activity the circulation in the Albanian market of Elegant Slims packages as well as the prohibition of the defendant as well as any third party related to him, to import and circulate to distribute and sell Elegant Slims packages in the Albanian market.

Bacardi & Company Limited and Davide Campari-Milano S.P.A v. Cantina e "Gjergj Kastriot Skënderbeu" Alcoholic Drinks

Campari & Martini, which respectively belong to the plaintiffs, are registered and regularly renewed as trademarks in the Register of Trademarks at the DPM.

In order to benefit from the good name and successful business of these brands, the defendant launched two types of drinks called Kamparid & Martinid on the market and simultaneously submitted two requests to the DPM for the registration of these brands, requests which were approved. In their lawsuit, the plaintiffs requested not only the deregistration of the Kamparid & Martinid brands but also the compensation of damages, based on articles 76, 83/1/a and 89/2/a of Law no. 7819 as well as article 638 of the Civil Code.

In its decision, the Court of the Judicial District of Tirana reached the conclusion that the brands Kamparid & Martinid were similar to the brands Martini & Campari and such sites violated the rights of the plaintiffs. Based on this argument, the court should have ordered the de-registration of the Martinid & Kamparid trademarks from the Trademark Register. But, during the trial, it was established that the defendant had not made the registration fee payments, for which the DPM decided to reject the registration of the Martinid & Kamparid brands. In this aspect, the Court had no choice but to establish the similarity between the brands as well as the consequences that flowed due to this similarity and to order the termination of the unfair competition. In relation to the compensation of damages, the Court decided to dismiss this request with the argument that since the sale of products with the names Kamparid & Martinid was not proven, the claimant failed to prove the existence of a damage caused.

5. Conclusions

The political, economic and social development of any society is effective when the members of the society make good calculations about how to organize legal norms. Industrial property law represents one of the newest and most attractive subsectors of law. In recent years, this has become increasingly important in the framework of judicial doctrine and practice. Nowadays, industrial property rights are given more and more attention and special interest.

The protection of these rights is one of the main priorities and objectives of the European Union and the American system and every other country.

In this context, one of the concrete steps that our country has undertaken in the framework of its commitment to integrate into the European Community, consists in ensuring and guaranteeing a level of protection of industrial property rights equal to that offered from EU member states. Normally, as well as in other areas, this is achieved through the approximation of the legislation, but it is certainly not enough to guarantee the proper legal and effective protection of the trademark.

In conclusion, the industrial property system helps to strike a balance between the interests of innovators and the public interest, providing an environment in which creativity and invention can flourish, to the benefit of all. Industrial property should not be seen as an end in itself, but as an instrument for achieving certain political policies, stimulating and distributing creativity. Its protection is no longer the cause of a country, but is an integral and inseparable part of regional and international developments.

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