



European IPR Helpdesk

Case Study

Projects acronyms and trade marks: preventing risks

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Background¹

Seven organisations, including 3 research centres, 3 small and medium-sized enterprises (SMEs) and a large company have set up a consortium with the purpose of applying for a call within the Seventh Framework Programme – ICT. After preparation of the proposal, the consortium was successfully evaluated and signed a grant agreement with the European Commission. For this three-year project, the consortium established a management structure and concluded a consortium agreement dealing with intellectual property issues. Using the project's acronym ECOLLAIR, the consortium set up a website (www.ecollair.eu) presenting the project summary, details on the technology as well as all the dissemination activities. Brochures and a project video were also prepared under the name ECOLLAIR. The consortium intended to exploit the main software resulting from the project under the ECOLLAIR mark.

¹ All names used in this case study are fictitious to preserve the anonymous character of the information.

Problem faced

After six months of smooth implementation of the project, the coordinator received a "cease and desist" letter from the legal counsel of a company based in Italy. In this letter, the legal counsel explained that his client was the owner of a technology called ECOLLAIR in the field of ecological aircraft starter-generation systems, the same technology field of the consortium. The letter included further information on the domain name held by the company (www.ecollair.com), as well as the community trade mark registration details. Therefore, the counsel advised the consortium that the use made of the term ECOLLAIR constituted an infringement of its client's community trade mark and consequently requested the consortium to cease using such term, including giving up the domain name www.ecollair.eu.

Action undertaken

The coordinator carefully analysed the letter and performed a trade mark search in order to verify whether the information in the letter concerning the registered community trade mark was correct. For performing the search, the coordinator used TMview². A quick search allowed him to retrieve the trade mark information mentioned on the letter.³ In particular, he assessed whether the trade mark was registered and when it would expire. Moreover, he confirmed with the Office for Harmonization in the Internal Market (OHIM) that it was indeed a community trade mark and therefore valid in all the EU member states. The information on the trade mark owner was also in accordance with the letter. Finally, he checked which classes of goods and services the trade mark owner had selected, confirming that indeed the community trade mark was registered for design of computer programs and software relating to aircraft (Nice class 42).

After this quick analysis, the coordinator was convinced that the letter of demand was serious and therefore immediately informed all consortium partners, suggesting this matter to be dealt with by a legal advisor.

Lessons learned

- ✓ Refraining from using an acronym similar to a registered trade mark for goods and/or services in the same area is important, particularly when consortium partners intend to commercially exploit a result or provide a service in the market under the acronym or name of the project.

² TMview is available at www.tmview.europa.eu/tmview/welcome.html. TMview is in constant evolution: it aims to be a search platform for trade marks registered at national level (all EU Member States), community level (OHIM) and international level (WIPO).

³ If you need assistance on performing trade mark searches, we suggest that you consult the fact sheet "*How to search for trade marks*", available in our online library.

The use of a trade mark in the context of a research and development project could be an infringement. It all depends on the particular circumstances of the case. However, why take the risk when performing trade marks searches does not take that long and is not very costly?

If a consortium accepts the allegations of infringement this means, at least, that all marketing material must be changed, often with significant expenses. Moreover, the investment in the creation of goodwill in a name takes time and money. Therefore when choosing a project acronym or the name of the technology, it is important to perform trade mark searches to confirm whether the term is not identical or similar to a registered trade mark in the same business area. This certainly helps partners avoid wasting time and resources, as well as potential infringement claims.

- ✓ The use of a domain name identical or confusingly similar to a trade mark of a third party may lead to the loss of rights on the domain name.
- ✓ Preliminary searches can be performed in-house, using the internet and the free search tools provided by the OHIM or the World Intellectual Property Organization (WIPO) tools. More comprehensive searches can be performed by certain national Intellectual Property Offices or IP professionals.
- ✓ When receiving a letter of demand, it is best practice to seek legal advice before responding on the substance.