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**EXECUTIVE SERIES:
INTELLECTUAL PROPERTY**



Cross-Border Enforcement of IP: Strategies for Building and Protecting International Portfolios

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“Your brand is the single most important investment you can make in your business.”

Steve Forbes, Editor-in-Chief of Forbes Magazine



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What is a Trademark?

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A Trademark is...

- Any word, name, symbol, slogan, tagline, character, design, or device
- Used to identify goods and distinguish them from the goods of others
- May be product shape, color, sound, motion, trade dress.






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Functions of Trademarks

- Indicate Source or Origin of Goods of Services
- Communicate Quality
- Foster Consumer Demand



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Types of Registerable Marks

- Trademarks
 - (ex. Rolex)
- Service marks
 - (ex. FedEx)
- Certification marks
 - (ex. USDA Organic)
- Collective marks
 - (ex. Girls Scouts)



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PROTECTING GLOBAL BRANDS

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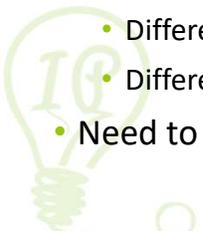
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Basic Considerations

- Tailor strategy to fit business needs
 - Expansion Plans
 - Budget
- Laws vary from jurisdiction to jurisdiction
 - Different procedures
 - Different substantive laws (First to File!)
- Need to engage foreign counsel



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Practice Tip

- 💡 Plan ahead – Remember: first to file is the rule in most foreign jurisdictions
- 💡 Develop a timeline – process may take longer than expected



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Process of Securing a Trademark

- Select
- Search/ Clearance
- Register/ Protect



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Selection of Trademarks

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Categories of Marks

- House marks / brand names
- Logos / stylized marks
- Product names
- Slogans / taglines
- Foreign character marks
- Trade dress
- Prioritize based on importance and budget



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Bars to Registration

- Immoral, Deceptive, or Scandalous
- Flag, Coat of Arms. or Insignia of Nation / State
- Name, Portrait, or Signature of Specific Person, Except upon Consent
- Likelihood of Confusion with Prior Registered Mark



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If the Mark Is Registrable – Assess Strength

- Generic (not trademarkable) = Common description/ Ex. APPLE for farm stand
- Descriptive: Describes goods or qualities = ROLLERBLADES for roller skates
- Suggestive: Hints at goods or quality = COPPERTONE for sun tan oil
- Arbitrary: Used out of context = APPLE for computers
- Fanciful: Coined, no dictionary definition= EXXON for oil



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Is the Mark Available - Clearance

- Due Diligence:
 - ✓ Scope of Intended Use
 - ✓ Meaning of Mark
 - ✓ Foreign, geographic, or trade
 - ✓ Equivalent Terms
 - ✓ Potential Conflicts
 - ✓ Consult with Legal



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Due Diligence – Conflict Information

- Search sources:
 - ✓ Agency Information/ Internet
 - ✓ Computer Knock-Out Search
 - ✓ Full, Company Name, or Merchandising Search
 - ✓ International Searches – Worldwide Identically Screening Searches



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Risk Assessment

- An Art, Not Science
 - Legal Factors
 - Business Factors
- Always Some Risk



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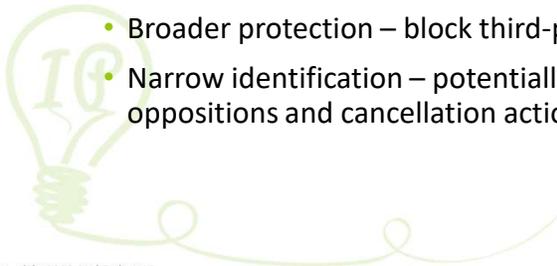
International Trademark Registration

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Filing Strategy

- Identify Marks to Cover
 - House Marks; Product Marks; Feature Marks; Non-Traditional Marks

- Identify Goods and Services – Broad v. Narrow?
 - Broader protection – block third-party applications
 - Narrow identification – potentially avoid third-party filings, less likely to draw oppositions and cancellation actions



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Key Considerations for International Filing

- Rights based on registration, not use (unlike U.S.)
- First to file has priority even against senior users
- First to file gains legal right to use, stop others
- Some limited exceptions – common law countries; famous marks



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Practice Tip

- 💡 Remember **first to file** – even if you are using TM first it may not be enough
- 💡 Far more cost-effective to register a trademark first than fighting to take it back
- 💡 Domain names and company names DO NOT convey trademark rights



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KEY ELEMENTS: STRATEGIC PROTECTION



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Foreign Filing Factors

- Market Size
- Presence & Potential
- Likelihood of Piracy
- Filing Costs



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Where To File?

- Where you currently sell or manufacture.
- Where you intend to sell or manufacture.
- Where your distributors are located.
- Where there are piracy/counterfeiting risks.



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How to File: National v. International Filing Systems

- National Filing Systems
 - United States Patent and Trademark Office (USPTO)
 - China National IP Administration (CNIPA)
 - UK Intellectual Property Office (UKIPO)
- International Filing Systems
 - European Union Trademark System (EUTM)
 - Madrid System – International Registration
 - ARIPO/OAPI
 - Benelux (Belgium, Netherlands, and Luxembourg)



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Filing Basis for Foreign Applications

- 200+ Countries
 - European Union = 27 Countries
 - Madrid Protocol (International Register)

- Trademark Laws Vary
 - First to File Most Prevalent



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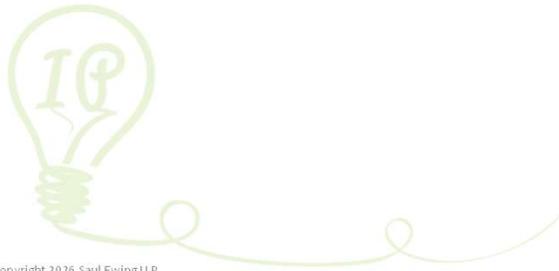
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Claiming Priority Under Paris Convention

- If foreign filing is within 6 months of filing in U.S.
- Foreign filing obtains priority date (earlier effective filing date) of U.S. application
- Must be same mark; same narrower scope of goods / services



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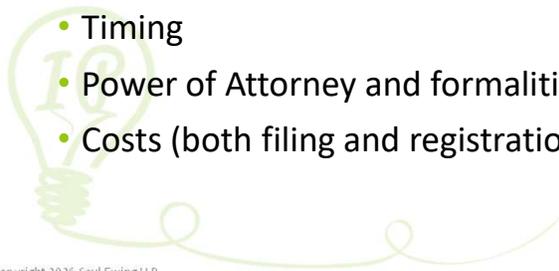
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Items to Discuss With Foreign Counsel

- Is use required? What constitutes use?
- Substantive examination (e.g. for relative rights; inherent registrability issues. etc.)
- Significance of mark in foreign country
 - Timing
 - Power of Attorney and formalities
 - Costs (both filing and registration fees)



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Maintaining Trademark Rights

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Trademark Use Guidelines

1. Core Rules
2. Symbols & Notice Lines
3. Logos & Design Marks
4. Naming & Brand Architecture
5. Digital & Marketing
6. Licensing, Co-Branding, & Partners
7. Monitoring & Enforcement



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Consistent and Correct Trademark Use



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Avoidable Threats to Trademark Rights

- **Non-use:** Not using a mark for 3 consecutive years creates a rebuttal presumption of abandonment of the mark.
- **Misuse:** While the failure to use a mark may result in abandonment of that mark, improper use may also result in the loss of trademark rights. Important to police unauthorized and / or improper use of our trademarks.
- **Failure to Police:** If third parties begin to use the same or similar mark in commerce in connection with similar goods and / or services and little or nothing is done, then the mark is likely to lose some or all of its value as a source identifier in the marketplace.
- **Naked Licensing:** Quality control.

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Trademark Notices

- TM = Goods
- SM = Services
- ® = Federally registered mark
- “Registered U.S. Patent and Trademark Office”
- “Reg. U.S. Pat. & TM Off.”



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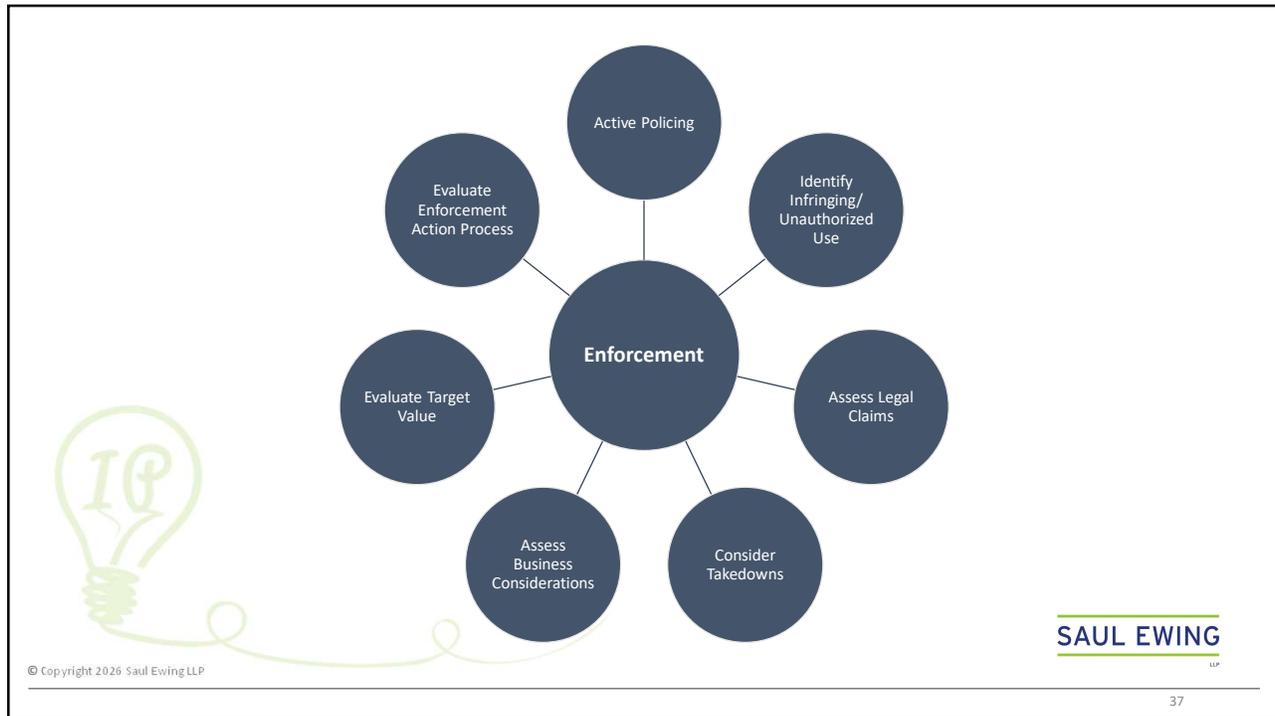
Enforcement

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Invest In Trademarks

- Identify strong, distinctive trademarks
- Apply for registration
- Enforce!
 - Cease and desist letters
 - Trademark oppositions
 - Settlement agreements
 - Warning letters
 - Monitoring companies
- Consider establishing a brand enforcement strategy with corporate buy-in

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Protection - Watching

- Marketing Department
- Customers
- Watch Services



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Protection - Enforcement

- Oppositions
- Cease & Desist Letters
- Lawsuits
- Customs



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Key Considerations/Takeaways

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- International trademark portfolios protect brand goodwill and value
- Consistent use and governance are essential
- Enforcement should be strategic and proportionate
- Brand management is ongoing legal stewardship

Bottom line: Strong brands are protected intentionally, not accidentally.

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Trademark = Assets

- Pick Them Wisely
- Guard Them Diligently!



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