

PROTECT YOUR BRANDS IN OVERSEAS MARKETS



ARE YOUR BRANDS PROTECTED IN YOUR OVERSEAS MARKETS?

You probably have heard about certain famous brand holders encountering difficulties using and registering their trademarks abroad. For example, you may have heard that Apple paid \$60 million to settle a dispute with a third party in China that allows Apple to sell its “iPAD” products in China in light of an earlier third party registration. Or you may recall that Michael Jordan had to engage in a long legal battle with a trademark squatter over rights to the Chinese version of his name and trademark. If Apple and Michael Jordan are facing these issues, how does a small or mid-sized company stand a chance? An understanding of the potential issues and attention to IP planning and protection can be your first line of defense. What follows are FAQs about international trademark protection and preliminary answers and food for thought.

Do I need to register my company’s marks internationally?

If your company is selling products or services outside of the US, you likely need international trademark protection to open your markets and to keep them open.

Or else, what could happen?

Your company could be prevented from selling its goods/services under the mark in important markets which might necessitate re-branding, either in the country of interest or globally. Or, your company could find itself paying a large sum of money just to use its own mark in an important market.

How are TM Rights Developed?



First Use



Registration

In the United States, rights in trademarks are developed primarily through use, so the first party to use a mark for particular type of goods or services has priority. In most other countries around the world, rights in trademarks are developed primarily through registration. Therefore, if a third party beats you to the Trademark Office, they often will have superior rights.

You should know your prospects for registration in any significant markets before you adopt a mark, which is why international searching can be important. International search also can be costly, and your trademark counsel should be familiar with various searching options and your company's tolerance for risk.

Where do I need to search and register?

International trademark searching is always an interest can quickly become cost prohibitive. an international search strategy that works are my most important current and anticipated "much would it hurt my business?" That is

Other considerations include: which countries owners experience significant counterfeiting "trademark squatting" (registrations by un

How to file?

There are different methods for filing foreign through local counsel in the country of interest filing method for filing in multiple countries can help you determine which approach is

When to file?

International trademark applications may initial (often home country) application for initial application may be granted a priority

How broadly to file?

Some companies prefer to file outside of t can be claimed in the U.S.) and then start focus their coverage on the real goods and biggest market. Both approaches have the tolerance, and budget, as well as the strength of scope of coverage issues is a very fact-sp

What about International Enforcement?

Make sure your trademark counsel has ex counsel in the relevant countries. Increasing can manage these disputes with experien



Dana Brody-Brown is an attorney with Hoge Fenton in S area, Dana has a special interest and wealth of experience in trademark portfolios. For questions, call Dana at 408.947

The Fine Print.

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