

Global Trademark Portfolio Management & Enforcement

Camille M. Miller
Co-Chair, IP Department
Cozen O'Connor

Steps in Managing a Global Trademark Portfolio

1. Obtain the Appropriate Trademark Rights
2. Keep Track of Important Dates & Take Appropriate Action
3. Use Marks
4. Monitor & Enforce Against Incorrect or Infringing Use of Marks
5. Review & Update Your Portfolio Periodically

1. Obtain the Appropriate Trademark Rights

Background: The Trademark Portfolio

Trademark Portfolios May Contain:

- Registered trademarks (or pending applications) filed by you
- Unregistered trademarks and service marks that you are using
- Domain names that you have registered
- Trademark rights that you have acquired through licenses and assignments, such as those granted in:
 - merger and acquisition agreements
 - franchise agreements
 - co-branding agreements
 - sponsorship agreements, etc.

Planning for and Acquiring Trademark Rights

- Determine which trademarks are important
- Determine which jurisdictions are most relevant
 - Where is/will the product/service be sold, offered, and/or marketed?
 - Potential future expansion of sales/marketing into additional jurisdictions?
 - Is there a high potential for infringing use in certain jurisdictions?
- Perform a trademark clearance search in the relevant jurisdictions to determine whether you should proceed with adopting the trademark/continuing use the trademark and/or filing trademark applications
- If your mark is cleared for filing, file an application immediately in the relevant jurisdictions

2. Keep Track of Important Dates & Take Appropriate Action

Pre-Registration Dates

- Filing Date
 - In most jurisdictions, the first party to file has priority over subsequent filers
 - In the US, once a mark registers, the filing date = date of “constructive use” and establishes nationwide priority (except for uses predating filing date)
- Date of Use in Commerce
- Other Important Pre-Registration Dates
 - OA Issuance Date (US) - Respond w/n 6 mo or application will abandon
 - NOA Issuance Date for ITU Applications (US) - File SOU or extension w/n 6 mo or application will abandon

Registration and Post-Registration Dates

- Registration Date
- Post-Registration Dates
 - Declaration of Incontestability (US) – Can file 5 years after registration
 - Declaration of Use (US) – Must file between 5-6.5 years after registration (incl. grace period) or registration cancelled
 - Renewal Deadline
 - In most countries, a trademark is protected for ten years from the date of filing and must be renewed every 10 years upon filing of the required fee.
 - In the US, must file a Declaration of Use and Application for Renewal w/n 1 year of every 10-year period after the registration date (or w/n the 6 mo. grace period)
 - Failure to renew before deadline results in cancellation/expiration of registration

3. Use the Marks

Proper & Continuous Use of Trademarks

Marks must be properly and continuously used as trademarks to ensure don't lose trademark rights

- Non-Use
 - Trademark registrations can be cancelled if owner fails to use the mark for a certain number of years after registration
 - In most jurisdictions, cancellation after 3-5 years of non-use
- Improper Use
 - Trademark rights can also be lost when marks become generic as a result of improper use
 - A trademark becomes generic when the trademark becomes known as the name of a product instead of identifying the brand of the product
 - Can be caused by trademark owner's incorrect use of the mark on labeling and in advertising or by the public's incorrect use of the mark
 - Examples of trademarks that have become generic: Aspirin, Zipper, Kleenex

Avoiding Genericism By Proper Use of Marks

Trademarks should be:

- Used as proper adjectives to identify the source of the goods or services
 - Do not use as a noun or verb
- Followed by a generic descriptor of the goods/services or the term “brand”
- Distinguished from the surrounding text using the ® symbol, capital letters, quotation marks, Italics, initial capital letters, etc.
 - ie. APPLE® watch or APPLE® brand
- Used consistently
 - Spelled the same as in the registration
 - Not used in possessive form

4. Monitor & Enforce Against Incorrect or Infringing Use of Your Trademarks

Strategies for Protecting & Enforcing Trademark Rights

- Prompt registration of trademarks in important markets
- Consistent and proper use of trademarks, including use of ®
- Monitor expiration and renewal dates of registrations, timely renew
- Consistently monitor marketplace for infringing and improper uses
- Consistently monitor of trademark applications for infringing marks
- Educate consumer and resellers re: how to identify genuine products vs. counterfeit products
- Issue cease and desist letters

Strategies for Protecting & Enforcing Trademark Rights

- Register marks with customs and border control
- Educate customs agents re: re: how to identify genuine products vs. counterfeit products
- Publish warnings to infringers
- Send press letters advising publications about your trademark rights and the proper use of your trademark
- Trademark oppositions and cancellations
- Pursue litigation

Strategies for Protecting & Enforcing Trademark Rights on the Internet

- Use your trademark as your domain name
- Monitor for domain names or webpages making unauthorized use of your trademark
- Monitor for webpages making improper use of your trademark
- Initiate UDRP proceeding for use of your trademark in a third-party domain name
- Submit Trademark Infringement Reports to social media providers, such as Facebook, Instagram, Twitter, etc.

5. Review and Update Your Portfolio Periodically

Review & Update of Trademark Portfolio

- You should review and update your trademark portfolio in order to ensure your trademark portfolio continues to align with your company's overall business strategy.
- Periodically auditing your trademark portfolio can assist you in:
 - Determining if marks are up for renewal or need to be used in commerce in order to maintain registration
 - Disclosing defects in registrations (ie. assignment not recorded or marks registered under a previous owner's name)
 - Assessing whether you should file additional trademark registrations (ie. new marks or logos) or whether you should file in additional jurisdictions based on brand expansion
 - Determining whether you should maintain registrations that no longer align with your business strategy, let these registrations lapse or license to a third-party

Questions ?

Thank you!

Camille M. Miller
Cozen O'Connor
1650 Market St.
Philadelphia, PA 19103
cmiller@cozen.com