Intellectual Property for Exporters

HiSTEP Export University

Tuesday, April 17, 2018

9:00 – 11:30 AM

Protecting Your Marks Domestically and Abroad

- Geographic Reach of Trademark / Service Mark ("TM") Rights
- Routes to Domestic TM Protection
- Routes to Foreign TM Protection
- Budgeting TM Protection
- Enforcement

Trademark / Service Mark

- Designations of Source or Origin
- Words, Logo, Composite (words and logo), Sound, even Smell
- Trademark if used with Goods
- Service Mark if used in conjunction with Services

Legal Basis for TM Rights

- Common law countries: Use or Registration
- Other (civil law countries): Registration only
  - Except if famous or well-know; limited other exceptions

Geographic Reach of TM Rights

- Geographic borders
- In the case of common law rights, where the use has taken place
- U.S. state registrations: throughout the state but not beyond
- Country registrations: throughout the country but not beyond

Geographic Reach and International Treaties

- Treaties provide for reciprocal rights (Paris Convention) and vehicles for extension of rights (Madrid Protocol) but do not themselves provide trans-border rights
  - Exception, EU Trademark
- Conclusion: Must file in each country either directly or through a treaty (Madrid Protocol)

Routes to Domestic TM Protection

- Use
  - Use “TM” or “SM” symbol and not “®” symbol
  - Only protected within territory of use
- Registration
  - State: only protected within state
  - Federal (USPTO): protected within all 50 states, Puerto Rico and Guam
    - Can use “®” once registration issues

Routes to Foreign TM Protection

- Individual Domestic (Foreign) Filings
  - Through foreign correspondents
  - Patent and TM firms: usually TM agents
- Madrid Protocol Treaty Filing
  - Based upon USPTO application or registration
  - Filed domestically
  - Requires retention of foreign correspondent in the case of an objection or refusal (often)

Budgeting - State

- State Registrations
  - Inexpensive
  - Professional assistance optional
  - In Hawaii
    - see http://cca.hawaii.gov/breg/registration/trade/
    - use required
    - $50 per class of goods/services
    - 5 year term, renewal available

Budgeting - Federal

- Federal Registrations
  - Affordable
  - Professional assistance optional but recommended
  - Budget Service Providers
    - Legal Zoom - limited attention by professionals
    - Discount trademark firms - limited attention by professionals

Budgeting - Federal

- Traditional law firms
  - 30% to 75% more than discount services
  - $1,500 to $3,000 for one mark in one class excluding searches, strategic counseling and responding to objections and refusals
  - NB: charges quoted for renewals by generic companies can sometimes be more expensive than that charged by traditional law firms – <u>always be wary of uninvited trademark registration related solicitations</u>

Budgeting - Foreign

- Madrid Filing
  - Can save money over individual filings if filing in more than two Madrid countries
  - For government fees, see http://www.wipo.int/madrid/en/fees/calculator.jsp
  - Attorneys fees for filing and reporting are additional, but not substantial
  - Foreign counsel fees for responding to objections and refusal are additional

Budgeting - Foreign

- Domestic (country by country) filings
  - Necessary for non-Madrid countries
  - Varies by country and foreign firm selected
  - From $600 (some Asian and Latin American countries) to $8,000 (some Middle Eastern countries) per mark in one class
  - Ask for foreign counsel fee schedule
  - Responding to objections and refusals always additional

Enforcement

- Cease and Desist Letters
- Registration with Border Control
- Contested Proceedings

Foreign Enforcement

- Cease and Desist Letters
  - Better if written by foreign counsel
  - Effectiveness varies with the circumstances and with respondent

Foreign Enforcement

- Registration with Border Control
  - Varies with country
  - Limited to incoming counterfeit or infringing branded goods
  - Seek advice and assistance of foreign counsel

Foreign Enforcement

- Contested Proceedings
  - Trademark Office Proceedings
    - Affordable
    - Limited to opposing and cancelling adverse party TM registrations and applications
  - Infringement Lawsuits
    - Expensive
    - May have limited efficacy in some countries

Foreign Enforcement

- Efficacy of proceedings dependent on local culture and the maturity of the country's IP laws
- Do not have an enforcement expectation based upon U.S. practice
- Rather, obtain a realistic expectations by:
  - forming relationships with foreign counsel
  - asking foreign counsel pointed questions

Foreign Enforcement

- Due Diligence – be aware of:
  - Bad faith opposition proceeding solicitations from Latin America
  - Fraudulent domain name solicitations from Asia

ANY QUESTIONS?

Please note that this presentation provides information of a general nature and is not intended as a substitute for individual legal advice!

Thank you for your attention!

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