



# 101 Trademark Protection in International Commerce

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## Faculty Biographies

### Linda Heban

Linda Heban is vice president and chief trademark counsel with Harley-Davidson in Ann Arbor, Michigan. She is responsible for managing Harley's trademark portfolio worldwide, its trademark litigation, and related internet domain name and customs matters. She also frequently conducts trademark training for Harley marketing, sales, and communications personnel. She supervises a staff of thirteen, located in the U.S. and Europe.

Prior to joining Harley, Ms. Heban was with the law firm of Jones Day in Chicago and also worked as an in-house attorney with Kraft Foods. She began her trademark career as an examining attorney with the U.S. Patent and Trademark Office.

Ms. Heban is an active member of the International Trademark Association, and has served as chair of the trademark committee of the Intellectual Property Law Association of Chicago.

### Elizabeth G. Regan

Elizabeth G. Regan is vice president and senior counsel for intellectual property with Marriott International, Inc., in Washington, DC, a leading worldwide hospitality company with more than 2,600 lodging properties in approximately 70 countries under more than a dozen different brands. Her responsibilities include domestic and international trademark clearance, counseling, prosecution, and maintenance, protection and enforcement of intellectual property rights, intellectual property litigation, and transactional matters related to intellectual property.

Before joining Marriott, Ms. Regan worked in-house with Warner-Lambert Company in Morris Plains, New Jersey and with F. Schumacher & Co. in New York. She also has worked at several law firms, including Kilpatrick Stockton LLP in Northern Virginia and Townley & Updike in New York.

Ms. Regan has been active in the International Trademark Association (INTA) and was a panelist on trademark searching and clearance at the 2004 INTA Annual Meeting. She also served as a panelist on trademark litigation at conferences in 2003 and 2004 by Law Seminars International.

Ms. Regan graduated from Princeton University, has a master's degree from Northwestern University's Medill School of Journalism, and holds a law degree from the University of Virginia.

### Lisa Sotir Ozkan

Lisa M. Sotir Ozkan is the vice president for legal and the associate general counsel for Blackboard Inc. in Washington DC. For the past five years, her responsibilities have included developing, managing and enforcing Blackboard's international corporate and licensing structure and its intellectual property strategy for trademarks, patents, copyrights, trade secrets, and domain names.

Over the last 14 years of practice, Ms. Sotir Ozkan has focused on international and corporate practice, at Gardner Carton & Douglas' Washington DC office, Thompson Hine's southwestern Ohio offices, and Teleglobe International in Reston Virginia. At Teleglobe, Ms. Sotir Ozkan's responsibilities included overseeing Teleglobe's international trademark portfolio.

Ms. Sotir Ozkan has a Bachelors degree from Cornell University, a J.D. from the George Washington University, and an L.L.M. from the Vrije Universeit Brussel in Belgium.



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## Why Protect Trademarks Internationally

- Expansion of market through Internet and global commerce make protection of trademarks outside of the United States vital
- Unlike the United States, most countries are “first to file” jurisdictions
- Branding has become more important as country borders become less important in the global marketplace

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## International Trademark Protection Process

- Same as in the US
  - Selection and Adoption
  - Registration
  - Maintenance
  - Enforcement

## First Phase: Selection and Adoption

- What is the mark?
- What are the goods/services on which it will be used?
- In which countries is mark going to be used?
- Have you searched the mark?



## Selecting the Mark

- What is the level of risk exposure?
  - Is it core product or secondary product?
  - Is it a core or secondary market?
    - » Is it a major brand or just a tagline?
    - » How long will the mark be in use?
    - » Can the mark be changed or deleted where necessary for different countries, or will there be centralized advertising, promotional materials and/or production that require a single mark for all countries?



## Selecting a Mark (II)

- Is the mark descriptive of the product, or is there some other characteristic of the mark that bodes ill for protection?
  - Is it an arbitrary letter string?
  - Does it use “American” or “USA”?
  - Is it a surname or geographic descriptor?
  - What are the meanings in non-English languages?



## Selecting a Mark (III)

- Which countries is mark going to be used in?
  - Will it be your standard mark or a localized version or both?
  - When to use a localized version of your marks
    - When market (i.e., consumers) would not accept English marks (e.g., China)
    - When market confusion may result from another's translation of your mark (e.g., Blackboard® in English or Pizarra in Spanish)
    - When local laws and regulations require local language on signage and/or labels



## Selecting a Mark -The Search

- How to conduct a search?
  - Get a policy/procedure in place with marketing, advertising, development and other Company business units re when to contact Legal re a new name/trademark. Make sure they know to contact Legal as early as possible and that they know how long it can take to conduct trademark searches and obtain trademark registrations.
  - Level of searching
    - preliminary knock-out search or full search?
    - US only?
    - WISS?
    - CTM?
  - Timing of search – preferably before use.
    - What to do when Legal learns of trademark use after-the-fact, a search is run, in which a problem is uncovered.
  - Who will conduct search?



## When the Search Raises Issues

- What to do when a problem (confusingly similar trademark) is uncovered.
  - When can Legal say “there is risk here but you can do this if you understand the risk and are willing to take it” vs. “you can’t do this, the risk is too great.”
  - Should you contact the owner of the conflicting mark?
  - Should you conduct investigations to determine whether the conflicting mark is still in use and/or whether it may be vulnerable to cancellation?
  - Legal says “no,” the mark is not available. If Legal knows that Marketing loves this trademark, should Legal continue to monitor it indefinitely to see if the situation changes and the mark becomes available?



## Second Phase – Registration

- Outside the US – trademark rights generally are based on “first to file”, not “first to use”
  - Use of <sup>TM</sup> or <sup>sm</sup> without registration filing is not sufficient to protect in “first to file” countries.
  - Registration in “first to file” countries can be made without proof of use.
  - Filing, either nationally or through protocols, are essential to protect trademarks in first to file countries



## Registration (II)

- National v. Protocol Registrations
  - With over 160 countries, can choose national registrations and/or protocol registrations
  - May choose a mix
  - Goals for protection must be kept in mind:
    - Ability to use and protect brand currently
    - Ability to enforce rights proactively
    - Ability to fend off local infringers in future



## National Registrations - Benefits

- Once you have registration in country, you have protection there
- Can enforce in country using their standard procedures
- Local competitors have little excuse to argue that they didn't know about your mark
- Can get domain registrations in country, often even without local presence based on trademark registration
- Can revise the description based on actual use in country
- If registration denied, doesn't affect registrations in other countries
- National Registrations in particular countries (such as the U.K. and France) may be necessary to receive registration in other jurisdictions (such as certain Caribbean countries and other islands and territories).





## National Registrations - Drawbacks

- Only covered in that country
- Often language barriers
- Need to procure local counsel to file in each country
- Often more expensive
- Different descriptions, different filing requirements, different use requirements

## Madrid Protocol - Generally

- US acceded to Madrid Protocol in 2004
- Allows applicant resident in one of the 58 Protocol Member countries to file one application to register in all or designated Protocol Member countries
- Filed in either English, French or Spanish
- Duration of 10 years, provided home country registration occurs within 5 years of application



## Madrid Protocol – Benefits

- Applications filed under the Madrid Protocol may mature to registration more quickly in many countries than if individual applications had been filed
- Cost savings in eliminating the high filing costs associated with filing separate national applications in each foreign country
- Cost savings on renewals, records of changes in the name or address of the proprietor and assignments, can be carried out centrally at the International Bureau without having to records these changes separately in each of the designated countries.
- The Protocol sets strict time limits (12 months or 18 months) for objections to be raised by the designated offices, so registration is generally secured within a shorter time frame than with a national application.



## Madrid Protocol – Drawbacks

- Refusal: An application can be refused registration by any of the designated countries under their national laws
- Central Attack: The rights granted by an international registration can be extinguished if its home application does not mature to registration or if its home registration is cancelled during its first 5 years.
- Costs: Though still possible to convert the international registration to national applications in the designated countries if the home application/registration is successfully challenged, the total cost would actually be higher than if the national route had been initially pursued.
- Cancellation Vulnerability: The international registration will be vulnerable to cancellation, in most cases after a period of 5 years or more in each and every country where the mark has not been used.
- Limitations: Requires exact same applicant as for home country application/registration and exact same goods/services covered by home country application/registration.



## Community Trade Mark Protocol

- The Community Trade Mark (CTM) system is a unified system of protection throughout the European Union (EU) through the filing of a single application.
- If successful, this one application results in a CTM registration that is recognized in all countries of the EU.
- A CTM applicant is not required to have a commercial establishment in the EU
- CTM has been designed to complement the national systems of protection. If applicants for a CTM already hold a prior identical national trade mark for identical goods and services they may claim the seniority of that mark. This allows them to preserve their prior rights even if they surrender their national trade mark or do not renew it.



## CTM Protocol - Benefits

- **Cost:** Trademark protection in all 25 Member States of the EU at a cost that is much lower than that of filing separately in each Member State.
- **Proof of Use:** Use of the trademark is not required to secure registration or renewal.
- **Limited Use:** Bona fide use on a reasonable scale in a single Member State is normally sufficient to maintain the validity of the CTM registration throughout the EU, and prevent it from being vulnerable to cancellation through nonuse over a five-year period.
- **Ability to Convert:** A CTM application that is refused registration may be converted into national applications maintaining the priority of the original CTM application.
- **Enforcement:** Infringement proceedings may be brought before the Community trade mark courts in each country. Decisions have effect throughout the EU. This avoids the need to prosecute infringers in each Member State.
- **Duration:** The initial registration is ten years from the date of filing the application



## CTM Protocol – Drawbacks

- Prior national trademark rights by the owner of a similar trademark may preclude registration of a CTM application. The owner of an earlier national right acquired in good faith may prevent an extended CTM from being used in its territory.
- Existing national marks cannot be challenged on the basis of CTMs registered or applied for before accession.
- Trademarks covered by a CTM application must possess sufficient distinctiveness to be registrable in all national jurisdictions of the EU; if a mark is not capable of registration in any one of the EU Member States, it cannot be registered as a CTM.
- The CTM registration process can take longer than in some individual countries of the European Union.
- If applications are met with several oppositions, the costs of dealing with the oppositions may be high. The Opposition Division of OHIM may award attorneys' fees to the other party, but these fees are awarded on a set scale and costs awards are very low



## National v. Protocol Registration: Panelists Experience

- Have you used the Madrid Protocol?
- Have you used the CTM Protocol?
- What reasons lie behind the decisions made?



## Trademark Maintenance Program

- Periodically review all marks for:
  - Actual continued use in country or protocol region
    - If not being used, consider why
  - Use in connection with the registration description
  - “Use creep” – file additional applications to cover
  - Maintenance of samples of registered usage
  - Whether company desires to maintain mark in that country or for that product.



## Maintenance

- Most countries will register without use – but registration may be vulnerable if not used for 3 consecutive years after registration
  - How do you provide use?
  - Does advertising suffice?
  - Does Internet usage count as use to support the registration?
  - Does use by a licensee count as use by the registrant in that country?
  - Must the license have been recorded in that country for the licensee's use to benefit the registrant?



## Maintenance

- What if not using? Cancellation vulnerability
  - What if using, but not in a particular class?
  - What if using, but not in that particular country?

## Maintenance

- If a country permits re-filing a new application for the same mark, do so
- What have panelists' companies done in these cases?



## Infringement

- What means can you use to detect?
- Continual review for infringement
  - Monitor the local trademark registries through watch services and other means
  - Review customs records and educate US and other countries' customs officials to recognize infringement of your marks.
  - Monitor eBay, Yahoo!, Google and other internet auction sites and search engines for use of infringing marks
  - Education of consumers, of distributors, of resellers, of sales force
  - Monitor eBay again.
  - Properly incentivize channels to report infringements
- What do panelists use as tactics to detect infringement?



## Enforcement

**So, your mark is being infringed in another country – what do you do about it?**

- At the Trademark Office:
  - When you've registered, file oppositions and cancellations where necessary to keep the register clear of confusingly similar marks
  - When you've not registered the mark or for the specific goods/services— what options do you have?



## Enforcement outside Trademark Office

- Criminal v. Civil Enforcement
- Domain Names Dispute Resolution Processes- URDP and ACPA
- Use the local press (or not)
- Work with local counsel to send demand letters and file trademark infringement lawsuits where infringing activities are ongoing in the marketplace

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## Global Enforcement Strategy

- Developed based on:
  - Size of Market
  - Nature of Infringements
  - Emphasis on registration activity (keeping it clear of confusingly similar marks) or infringement activity (stopping actual infringers in the marketplace), or both

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## Enforcement

- Counterfeiting – how to stop
  - Enforcement against Manufacturers
  - Enforcement against Distributors
  - Anti-counterfeiting technologies
  - Anti-counterfeiting associations
  - Customs recordals and training
  - Education



## Other Enforcement Mechanisms

- What have panelists done?



# Trademark Protection in International Commerce

● Thank you!

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## Trademark Protection in International Commerce A Trademark Life Cycle Approach

Association of Corporate Counsel  
October 17, 2005

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### I. Selection and Adoption

In selecting and adopting a mark for use in any country, some considerations are:

- A. What is the Mark, and what are the goods/services on which it will be used?
  1. What is the level of risk exposure?
    - a) Is it core product or secondary product?
    - b) Is it a core or secondary market?
    - c) Is it a major brand or just a tagline?
    - d) How long will the mark be in use?
    - e) Can the mark be changed or deleted where necessary for different countries, or will there be centralized advertising, promotional materials and/or production that require a single mark for all countries?
  2. Is the mark descriptive of the product, or is there some other characteristic of the mark that bodes ill for protection? For example:
    - a) Is it an arbitrary letter string?
    - b) Does it use "American" or "USA"?
    - c) Is it a surname or geographic descriptor?
    - d) What are the meanings in non-English languages?
  - B. Which countries is mark going to be used in?
    1. Will it be your standard mark or a localized version or both?
    2. When to use a localized version of your marks
      - a) When market (i.e., consumers) would not accept English marks (e.g., China)
      - b) When market confusion may result from another's translation of your mark (e.g., Blackboard® in English or pizarra in Spanish)
      - c) When local laws and regulations require local language on signage and/or labels
    3. What are country's trademark enforcement policies?
  - C. Is a search even necessary?
    1. How difficult or embarrassing would it be to change or stop using the mark after use has begun?
    2. Will the mark be used by the Company itself or by franchisees or licensees?

- D. How to conduct a search?
1. Get a policy/procedure in place with marketing, advertising, development and other Company business units re when to contact Legal re a new name/trademark. Make sure they know to contact Legal as early as possible and that they know how long it can take to conduct trademark searches and obtain trademark registrations.
  2. Level of searching
    - a) preliminary knock-out search or full search?
    - b) US only?
    - c) WISS?
    - d) CTM? Explain.
  3. Timing of search – preferably before use.
    - a) What to do when Legal learns of trademark use after-the-fact, a search is run, in which a problem is uncovered.
      4. Who will conduct search?
      5. What to do when a problem (confusingly similar trademark) is uncovered.
        - a) When can Legal say “there is risk here but you can do this if you understand the risk and are willing to take it” vs. “you can’t do this, the risk is too great.”
        - b) Should you contact the owner of the conflicting mark? Risks: (Is it an admission of confusing similarity, or are consents routinely given in that country? You’re then on their time schedule. They may look for big \$\$\$, Are the right personnel discussing the issue?)
        - c) Should you conduct investigations to determine whether the conflicting mark is still in use and/or whether it may be vulnerable to cancellation?
        - d) Legal says “no,” the mark is not available. If Legal knows that Marketing loves this trademark, should Legal continue to monitor it indefinitely to see if the situation changes and the mark becomes available?
- E. Do you have an international trademark strategy – if so, what should it include?
- II. Registration**
- A. Outside the US – trademark rights generally are based on “first to file”, not “first to use”
1. Use of <sup>TM</sup> or <sup>SM</sup> without registration filing is not sufficient to protect in “first to file” countries.
  2. Registration in “first to file” countries can be made without proof of use.
  3. Filing, either nationally or through protocols, are essential to protect trademarks in first to file countries
- B. National registration v. Using Protocols
1. Benefits/drawbacks of National Registrations
    - a) Benefits
      - (1) Once you have registration in country, you have protection there
      - (2) Can enforce in country using their standard procedures
      - (3) Local competitors have little excuse to argue that they didn’t know about your mark
      - (4) Can get domain registrations in country, often even without local presence based on trademark registration
      - (5) Can revise the description based on actual use in country
      - (6) If registration denied, doesn’t affect registrations in other countries
      - (7) National Registrations in particular countries (such as the U.K. and France) may be necessary for getting registration in other jurisdictions (such as certain Caribbean countries and other islands and territories).
    - b) Drawbacks
      - (1) Only covered in that country
      - (2) Need to procure local counsel to file in each country
      - (3) Often more expensive
  2. Benefits/drawbacks of Madrid Protocol (not the Madrid Agreement)
    - a) Where: The following countries are members of the Madrid Protocol: Antigua and Barbuda, Armenia, Australia, Austria, Belarus, Benelux (Belgium, the Netherlands and

- Luxembourg), Bhutan, Bulgaria, China (People’s Republic of), Cuba, the Czech Republic, Korea (Democratic People’s Republic of), Denmark, Estonia, Finland, France, Georgia, Germany, Greece, Hungary, Iceland, Ireland, Italy, Japan, Kenya, Latvia, Lesotho, Liechtenstein, Lithuania, Monaco, Mongolia, Morocco, Mozambique, Norway, Poland, Portugal, Macedonia (Republic of), Moldova (Republic of), Romania, the Russian Federation, Serbia and Montenegro (State Republic of), Sierra Leone, Singapore, the Slovak Republic, Slovenia, South Korea, Spain, Swaziland, Sweden, Switzerland, Turkey, Turkmenistan, Ukraine, the United Kingdom, the United States and Zambia.
- b) Who: An applicant for an International Registration must be a national of, or domiciled in, one of the member countries of the Protocol or have an industrial or commercial establishment in one of the member countries.
  - c) How: File one application in the US and designate any combination of the 58 Madrid Protocol member countries to be part of your international registration. The World Intellectual Property Organization (WIPO) maintains the International Register of marks and administers the Madrid Protocol System. All applications and communications are in the applicant’s chosen language (either English, French, or Spanish). Once a US trademark owner has an international registration through the Madrid Protocol, the registrant will be able to expand the list of designated countries.
  - d) Duration: An international registration is valid for a 10 year period and can be renewed for 10 year periods The initial international registration period is ten years from filing; however, it is dependent upon a valid home application or registration for the first five years. If the home application or registration fails for any reason during this period (e.g., is refused, withdrawn or cancelled), so is the international registration. After five years, the international registration becomes independent..
  - e) Madrid Agreement: A country that is a member of both treaties is subject to the rules of the Madrid Agreement first.. The US is NOT a party to the Madrid Agreement.
  - f) Benefits:
    - (1) Applications filed under the Madrid Protocol may mature to registration more quickly in many countries than if individual applications had been filed
    - (2) Cost savings are realized in two stages. First, the Protocol eliminates the high filing costs associated with filing separate national applications in each foreign country. Secondly, renewals, records of changes in the name or address of the proprietor and assignments, can be carried out centrally at the International Bureau without having to records these changes separately in each of the designated countries.
    - (3) The Protocol sets strict time limits (12 months or 18 months) for objections to be raised by the designated offices, so registration is generally secured within a shorter time frame than with a national application.
  - g) Drawbacks:
    - (1) An application can be refused registration by any of the designated countries under their national laws
    - (2) The rights granted by an international registration can be extinguished if its home application does not mature to registration or if its home registration is cancelled during its first five years (this concept is commonly referred to as “central attack”). Although it would still be possible to convert the international registration to national applications in the designated countries if the home application/registration is successfully challenged, the total cost would actually be higher than if the national route had been initially pursued.
    - (3) The international registration will be vulnerable to cancellation, in most cases after a period of five years or more (the nonuse term will depend on the trademark law of the country concerned) in each and every country where the mark has not been used.
    - (4) Involves certain limitations. Requires exact same applicant as for home country application/registration and exact same goods/services covered by home country application/registration (which may be more limited than would otherwise be available for a national registration in the extension country).
  - h) More information on Madrid Protocol: [http://www.wipo.int/madrid/en/legal\\_texts/index.html](http://www.wipo.int/madrid/en/legal_texts/index.html)

### 3. CTM Protocol

- a) The Community Trade Mark (CTM) system is a unified system of protection throughout the European Union (EU) through the filing of a single application. If successful, this one application results in a CTM registration that is recognized in all countries of the EU.
- b) The countries currently covered by a CTM registration are Austria, Benelux (Belgium, the Netherlands and Luxembourg), Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, the Slovak Republic, Slovenia, Spain, Sweden and the United Kingdom
- c) A CTM registration is issued by the Office for Harmonization in the Internal Market (OHIM).
- d) The CTM process is available to nationals of the EU countries, countries that are parties to the Paris Convention and other countries granting reciprocal rights. A CTM applicant is not required to have a commercial establishment in the EU.
- e) Searches are carried out by national offices of the EU Member States (except France, Germany and Italy) at OHIM's request to notify the applicant of any potentially conflicting prior national trademark rights. OHIM also conducts a search among prior CTMs and notifies the proprietors of such rights of the existence of the later application automatically. However, neither of these notifications has any direct bearing on a CTM application: no examination on relative grounds is carried out.
- f) The Community trade mark has been designed to complement the national systems of protection. If applicants or proprietors of a Community trade mark already hold a prior identical national trade mark for identical goods and services they may claim the seniority of that mark. This allows them to preserve their prior rights even if they surrender their national trade mark or do not renew it.
- g) Drawbacks:
- (1) If there is a ground for refusal (e.g. a pre-existent national right), then the CTM fails.
  - (2) Besides the ordinary grounds for refusal of a trademark application, prior national trademark rights by the owner of a similar trademark may preclude registration of a CTM application.
  - (3) The owner of an earlier national right acquired in good faith may prevent an extended CTM from being used in its territory.
  - (4) Existing national marks cannot be challenged on the basis of CTMs registered or applied for before accession. Likewise, the owners of CTMs are unable to prevent use of descriptive terms in accession countries.
  - (5) Trademarks covered by a CTM application must possess sufficient distinctiveness to be registrable in all national jurisdictions of the EU; if a mark is not capable of registration in any one of the EU Member States, it cannot be registered as a CTM.
  - (6) The registration period has proven lengthy. The CTM registration process can take longer than in some individual countries of the European Union.
  - (7) If applications are met with several oppositions, the costs of dealing with the oppositions may be high. The Opposition Division of OHIM may award attorneys' fees to the other party, but these fees are awarded on a set scale and costs awards are very low.
- h) Benefits:
- (1) CTM registration offers trademark protection in all 25 Member States of the EU at a cost that is much lower than that of filing separate applications in each Member State.
  - (2) Use of the trademark is not required to secure registration or renewal.
  - (3) Bona fide use on a reasonable scale in a single Member State is normally sufficient to maintain the validity of the CTM registration throughout the EU, and prevent it from being vulnerable to cancellation through nonuse over a five-year period.
  - (4) ACTM application that is refused registration may be converted into national applications maintaining the priority of the original CTM application.
  - (5) Infringement proceedings may be brought before the Community trade mark courts, which are national courts designated by the Member States to have jurisdiction in respect of

Community trade marks. Decisions have effect throughout the EU. This avoids the need to prosecute infringers in each Member State.

(6) The initial CTM registration period is ten years from the date of filing the application and is independent of any other application or registration

i) For more information on the Community Trademark: <http://oami.eu.int/en/mark/default.htm>

#### 4. Panelists Experience with Both

- a) Why using/not using CTM
- b) Why using/not using Madrid
- C. Other issues
  1. Check the translation back into English of any proposed description for a mark in a national registration (often problematic in Japan)
  2. Confirm with local counsel the scope of the goods/services to be covered by the registrations. Some countries routinely may offer broader coverage than others.

### III. Maintenance

- A. Periodically review all marks for:
1. Actual continued use in country or protocol region
    - a) If not being used, consider why
    2. Use in connection with the registration description
    3. "Use creep" – file additional applications to cover
    4. Maintenance of samples of registered usage
    5. Whether company desires to maintain mark in that country or for that product.
  - B. Most countries will register without use – but registration may be vulnerable if not used for 3 consecutive years after registration
    1. How do you provide use? Does advertising suffice? Does Internet usage count as use to support the registration? Does use by a licensee count as use by the registrant in that country? Must the license have been recorded in that country for the licensee's use to benefit the registrant?
      2. What if not using? Cancellation vulnerability
        - a) What if using, but not in a particular class?
        - b) What if using, but not in that particular country?
          - c) Does the country permit re-filing a new application for the same mark?
      3. What have panelists' companies done in these cases?
    - C. Infringement
      1. What means can you use to detect?
      2. Continual review for infringement
        - a) Monitor the local trademark registries through watch services and other means
        - b) Review customs records and educate US and other countries' customs officials to recognize infringement of your marks.
        - c) Monitor eBay, Yahoo!, Google and other internet auction sites and search engines for use of infringing marks
        - d) Education of consumers, of distributors, of resellers, of sales force
        - e) Monitor eBay again.
        - f) Properly incentivize channels to report infringements
      3. What do panelists use as tactics to detect infringement?

### IV. Enforcement

- A. At the Trademark Office:
1. When you've registered, file oppositions and cancellations where necessary to keep the register clear of confusingly similar marks
  - B. When you've not registered the mark or for the specific goods/services– what options do

you have?

1. Criminal v. Civil Enforcement
2. Domain Names Dispute Resolution Processes- URDP and ACPA
3. Use the local press (or not)
4. Work with local counsel to send demand letters and file trademark infringement lawsuits

where infringing activities are ongoing in the marketplace

C. Global Enforcement Strategy

1. Size of Market

2. Nature of Infringements

3. Emphasis on registration activity (keeping it clear of confusingly similar marks) or infringement activity (stopping actual infringers in the marketplace), or both

D. Counterfeiting

1. Enforcement against Manufacturers

2. Enforcement against Distributors

3. Anti-counterfeiting technologies

4. Anti-counterfeiting associations

5. Customs recordals and training

6. Education

#### Useful Sources

##### **International Trademark Association – [www.inta.org](http://www.inta.org)**

Information on country registration, protocol registrations, and valuable international trademark protection sources

##### **U.S. Patent and Trademark Office – <http://www.uspto.gov/main/trademarks.htm>**

Information on US accession to various international protocols, search sites and other valuable trademark information.

##### **World Intellectual Property Organization – [www.wipo.int](http://www.wipo.int)**

Information about the Madrid Protocol from the administrator of the system

##### **World Trade Organization – [www.wto.int](http://www.wto.int)**

Information about Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).

##### **Intellectual Property Rights Training Program Database - <http://www.training.ipr.gov/>**

Maintained by agencies of the United States Government and industry associations who provide training and technical assistance relating to protecting IPR. The database is a tool designed to permit the IPR Training Coordination Group, composed of these U.S. private and public sector training providers, to share information in order to coordinate and plan IPR training, as well as respond to queries about U.S. IPR training activities.

##### **International Anti-Counterfeiting Coalition - <http://www.iacc.org/>**

A trade group working to deter piracy and counterfeiting