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Brand Protection

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Protecting your brand, or brands, is crucial for your business. Blake Morgan's specialist team can assist you in developing, clearing, protecting, enforcing and maintaining your brand, or brands, throughout the world.

Regardless of your business or industry the basic steps to developing, clearing, protecting, enforcing and maintaining, a brand are:

- Create the potential brand name/logo
- Conduct clearance searches to ensure that the new brand name/logo is clear to use
- Protect the new brand name/logo through trade mark registration(s)
- Enforce the brand by monitoring:
 - Any new applications for similar marks by using a watch service and taking action where appropriate
 - The market for competitors, or counterfeiters, impinging on your brand and taking action where appropriate
- Maintain your trade mark registration(s) by ensuring that the records are kept up-to-date, registration(s) renewed and any licences/assignments/security interests recorded.

This guide outlines the key considerations in brand protection.

Developing

When going through the process of creating a new brand it is important to consider both the brand proposition, and to align the new brand with that proposition, but also the extent to which the brand is registrable as a trade mark and whether there are likely to be issues with enforcing the mark if registered. Simply, there is little sense in investing considerable sums in developing a new brand that cannot be protected.

The basic requirement for a trade mark is that it must be capable of distinguishing the goods/services of the proprietor from those of third parties. Accordingly, trade marks that are purely descriptive or consist solely of indicative words which have become customary in current language or an established term within a trade or business sector will not be registrable – at least until such time as the mark has acquired distinctiveness through established use.

Furthermore, whilst a mark may, just about, be deemed sufficiently distinctive to function as a trade mark it does not mean that it is a strong trade mark and this can impact the ease with which the mark can be enforced against others. Generally speaking the more distinctive the trade mark the easier it is to enforce.

Take the following examples of potential trade marks for cars (with the weakest mark types to the left and the strongest to the right):

Descriptive	Suggestive	Arbitrary	Fanciful
Transporter	Caravelle	Golf	Tiguan

As you will see the strongest marks are either entirely made-up or, at least, have no meaning in respect of the goods/services for which they will be used. The downside with these mark types is that, for the marketing team, it can be difficult to reflect the brand proposition without at least some kind of reference to the product type.

Care therefore needs to be taken in balancing the brand proposition with its registrability and enforceability as a trade mark.

Clearing

Once you have identified your proposed brand, or, preferably, have a short list of proposed brands, it is important to conduct appropriate clearance searches to ensure that the new brand is free to use without infringing third party rights.

The risks of not conducting searches, and inadvertently infringing on third party rights, can be extremely serious with the possibility of the third party obtaining:

- An injunction preventing you from using the new brand
- Damages or an account of profits
- Recovery of legal costs.

In addition to this you will also have to deal with the expense of going through the rebranding process again and the potential reputational and public relations damage caused by infringement and a subsequent rebrand.

There are different search processes and strategies that can be employed depending on the importance of the brand to the business, its stage in the brand lifecycle, available budget and the brand owner's attitude to risk.

Broadly speaking however there are three types of searches:

Knock-out	The knock-out search is quick and relatively inexpensive option which covers identical and highly similar marks only. It is useful either to whittle down the number of potential brands from a long list, for non-critical brands and for non-critical territories. The downside of the knock-out search is that it doesn't look at unregistered use of a mark nor does it look at marks that are merely similar to the brand searched against. Accordingly, there is a risk that it could miss problematic marks.
Register only	This search looks at identical, highly similar and similar registered marks in the relevant territory. It doesn't however cover unregistered use of a mark and will therefore need to be accompanied by, at the very least, in-house internet searches to gain some understanding of third party use of the same, or similar, marks without registration.
Full	The full search looks at identical, highly similar and similar registered marks in the relevant territory and, to a limited extent, unregistered use of the mark both online and through registration as a company name or similar. This search option provides the greatest coverage and is therefore recommended for all critical brands.

We use a third party search provider to conduct our searches. The search provider uses specialist software to search the relevant trade mark registers and then provides us with a list of results. We then review those results and provide you with a report of our advice.

It is highly unusual for a search to be entirely clear (i.e. not produce any results). This is because of the sheer volume of registered trade marks. However, just because the search has identified earlier similar marks doesn't mean that you need to immediately move to a new brand. Rather, our report will consider the similarity of the marks, the similarity of the respective goods/services, your attitude to risk and the commercial realities and will make recommendations on how best to proceed.

The recommendations may include:

- Proceeding to use the mark with a view to negotiating with the earlier rights holder to agree a coexistence arrangement
- Cancelling the earlier rights due to invalidity and/or non-use
- Further research into the owner of the mark to see if they still exist and/or if they would be willing to assign the mark to you
- Proceeding to use the mark and to take the risk that action is brought
- Tweaking the mark to reduce the level of risk
- Changing the mark entirely to avoid the identified risks (but, of course, new searches would then be required for the proposed new mark).

Protecting

Having conducted appropriate clearance searches the next stage in the brand protection process is to apply to register the brand, as a trade mark (or a number of trade marks), for the relevant goods/services in the appropriate territories.

What mark?

It may seem obvious that, having created a brand, you simply apply to register the brand. But that oversimplifies the situation. There are different types of trade marks and any one brand may contain a number of potential trade marks that could be applied for. These include:

Word only	This would protect your use of the word and would cover use of those words in most normal types of font commonly available. Once registered, this would give you the widest protection - the mark would be protected when you use it in correspondence, advertising or as a title in a variety of styles (underlined, etc) and, furthermore, future-proofs the mark against changes to the visual identity of the brand as time passes. However, because it gives wide protection, there is a greater risk of an objection or opposition being raised during the application process.
Logo	If you have developed a distinctive logo then you may wish to consider protecting the logo through registration. This can either be separate to the word or, as below, in a combined form.
Word and logo	You could register your trade mark as a combined word and logo mark. This has cost benefits over registering the two separately but, importantly, the logo element of the mark, if distinctive, will 'water down' the protection that you enjoy in the word itself. It is however a useful option if the word element is of a low level of distinctiveness.
Other	There are a whole host of other types of marks including sounds, smells, shapes, colours, video sequences, placement marks and various others all of which are, potentially, registrable (at least in the UK/EU) if distinctive.

The appropriate mark, or marks, to apply for will differ from business to business and from brand to brand. There isn't therefore a one-size fits all answer and we will discuss with you and agree upon the best strategy to protect your brand through registration.

What goods/services?

Trade marks offer a limited monopoly over the use of a mark, in a particular territory for the goods/services covered by the registration. To that end all goods/services are split between 45 classes, When applying to register a trade mark an applicant must list the goods/services for which it seeks protection and must intend to use the mark for those goods/services at the time of filing the application — failing which any resulting registration is liable to be found invalid.

Once an application is filed the list of goods/services cannot be added to and can only be amended negatively i.e. by deleting goods/services or by otherwise narrowing the list of goods/services. Accordingly it is important to ensure that the list of goods/services is comprehensive, but at the same time only covers the goods/services for which it is intended that the mark will be used.

As part of the application process we will prepare a list of goods/services for your consideration and will need to agree upon the same before any application can be filed.

What territories?

Trade marks are territorial and thus there is no such thing as a 'world-wide' trade mark. It is a case of working out the key territories for your brand and then we can devise an appropriate filing strategy to protect the mark in an effective, economic and timely fashion.

The starting point will likely be an application in your local territory, or the key territory for the brand, from there we can look to 'springboard' the application using a combination of the 6 month priority period and/or the International Registration system to obtain protection in the other commercially important territories.

The International Registration system is essentially a filing system and allows a cheaper and simpler method of obtaining trade mark protection in the 103 member countries that are signatories to the Madrid Protocol. Outside of the member countries applications have to be filed directly to the intellectual property office of the country in which you wish to gain protection.

We file international registrations and have a network of agents around the world through which we file direct applications for non-member countries.

An example filing strategy might be:

- UK application
- Within 6 months apply for an International Registration designating your business critical territories (for example the EU, US, China etc)
- Thereafter effect batches of filings in accordance with commercial importance but with particular reference to those territories that operate a 'first to register' as opposed to 'first to use' system.

Enforcing

There is little point in going through the expense of developing, clearing, protecting and, fundamentally, building a brand to then allow third parties to exploit the same by using or seeking to register the same, or a similar mark.

Accordingly it is important to ensure that you are prepared to enforce your rights once acquired. This is important both to prevent customer confusion but, fundamentally, to maintain the validity in your mark. If you allow third parties to use and/or register your mark, or similar, then over time its distinctiveness erodes and, ultimately, the mark risks becoming generic (consider, for example, the likes of Tannoy, Hoover, Velcro etc all of which are, potentially, at risk of being deemed generic).

In order to take action against potential infringers you first need to identify the issues. Whilst it is, of course, important to educate your team to be alert to competitors' activities that may impinge on your rights that won't be enough to spot all such issues in a sufficiently timely manner such that you can take action.

It is therefore advisable to put in place a watch service. A watch service monitors the trade mark register(s) in the countries you select for applications that may conflict with your trade mark. This gives you the opportunity to object to the use and registration of those trade marks on the basis of your earlier trade mark rights.

In some countries trade mark registries do not check whether or not new applications may conflict with earlier rights and so it is down to owners of registered trade marks to monitor new applications and object to them if necessary. This is where the watch service comes in.

Once you are aware of a third party application that you feel is too similar to your own then the next step is to challenge the same through filing an opposition or similar. This is something that we can deal with directly in the UK/EU and through our network of local agents throughout the rest of the world.

Another consideration for enforcing your rights is to put in place an online monitoring system. These can either be run in-house by your team or, alternatively, through a third party service provider. The precise details of the monitoring will differ from business to business based on its needs and the touchpoints. However, broadly-speaking, the system will monitor online sources for infringing use of the same or similar mark and will alert you to the same, likely through a monthly reporting function. We can then work with you to adopt a suitable strategy for dealing with such infringements which may include:

- Creating an 'escalation process' with template documents so that you can contact the infringer initially with a view to resolving the matter and, if that doesn't work, then escalating the matter to us
- Filing takedown complaints with relevant websites/social media operators to obtain the removal of infringing content/listings
- Instigating infringement action through the courts with a view to obtaining injunctions/damages/costs from infringers
- Liaising with trading standards and customs officials to take action against infringers and/or to have infringing products stopped in transit.

Maintaining

Like any asset your trade mark portfolio requires a degree of maintenance to ensure that it is kept up-to-date, that no rights are lost through inaction and that you are not incurring unnecessary renewal fees (and the like) for marks that are no longer in use.

Key to maintaining your trade mark portfolio is record keeping. We use a market-leading portfolio management system to ensure that we know what is happening, when, for our client's portfolios and can then liaise with you to take appropriate action to maintain your portfolio. This can include:

- Renewals
- Changes of name/address
- Changes of owner
- Recording of licences
- Recording of security interests
- Filing of statements of use.

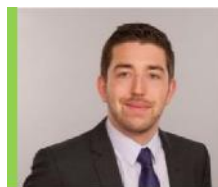
Failure to maintain your portfolio can result in issues such as the loss of rights (through failure to renew/file statements of use (where appropriate)) or an inability to recover legal costs in infringement proceedings (through failure to record the assignment of a mark within 6 months of transfer). It is therefore important to ensure that you keep your portfolio up-to-date.

The final aspect of maintaining your portfolio is to keep the portfolio itself under review. In particular it is to ensure that you have appropriate registrations for the marks that you use, in the form that they are used, for the goods/services for which they are used and in the territories for which they are used. Whilst this might sound obvious it is only too common for businesses to register their mark at the outset of a brand's launch and to then ignore the same until a potential infringement occurs. When then looking at the registration it is often the case that the way the brand has been used has shifted over time, perhaps it now has a logo element, or a new service line has been created, or that the mark is only used in X country (where registration wasn't obtained) any of these changes can impact the prospects of enforcing your rights and, accordingly, it is important to keep your portfolio under regular review – certainly on an annual basis if not more frequently.

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