

Brand creation and protection: out with the old

Trademark experts from across the globe offer critical insight into brand creation best practice and guidance on pitfalls to avoid

As technology and markets evolve, longstanding brand creation practices and processes quickly find themselves no longer fit for purpose. Developing a brand, in partnership with the right stakeholders, and putting in place proper protection are crucial to a business' success. Yet it is often difficult for time and resource-poor rights holders to step back and assess their approach. In this exclusive roundtable a panel of experts – Clara Pombo, Marta Tolón and Stefan Edhammer from ClarkeModet (Spain), Gorodissky's Ilya Goryachev and Alexey Kratiuk (Russia), and Hank Spuhler of McAndrews, Held & Malloy (United States) – outline the arguments that counsel can make for more resources and internal cooperation, consider the critical toolkits and checklists that should be developed to launch and protect a brand, explore how the relationship with external advisers and service providers can be maximised, identify the latest options for registering rights and highlight ways to maximise enforcement and protection spend.

From a legal perspective, what aspects of a brand should be considered to ensure 360-degree protection?

Hank Spuhler (HS): Brand owners should consider any aspect of the product that a consumer may associate with them. This typically includes the product's name and any logo, tagline or slogan associated with it. In certain circumstances, trademark protection may also be available for a product's colour, sound or scent; the image and overall appearance may also be entitled to trade dress protection. In protecting a product, brand owners should also determine whether other IP rights (eg, design, patent or copyright) are available as well. The interplay between these various rights is complex and varies from country to country, so it is important for brand owners to obtain legal counsel to ensure complete protection.

Clara Pombo (CP): Having an expert assessment as to how, where and when to manage one's IP portfolio is crucial.

IP service providers must be true allies to their clients, understanding that brand management is so much more than submitting trademark applications and renewals, and occasionally filing oppositions and responses – this will pay off when it comes to maximising enforcement, time and money efforts. Another key point is distinctiveness: the stronger the trademark, the easier it is to enforce. Playing with elements that might be considered common use along with those that add distinctiveness will result in brands that are both easy to remember and highly enforceable. Finally, an accurate description of goods or services is essential. When the list of goods or services is correctly drawn up, it lowers the risk of receiving office actions. On the other hand, it is highly advisable to take mid-term business plans into account, in order to avoid having to file new applications to protect further goods and services.

Alexey Kratiuk (AK): For me, legal aspects involve four main issues:

- ensuring that your brand is duly protected (eg, by trademark registration);
- ensuring that your protected brand reflects the true commercial intentions that will subsequently allow effective contractual monetisation if necessary;
- ensuring that your brand does not infringe third-party rights; and
- monitoring infringement and employing effective enforcement techniques.

Another aspect that should be considered alongside these is how the brands are used on the Russian market. Use is obligatory in Russia and non-use or misuse of the brand may entail its early termination. In Russia, a trademark

registration becomes vulnerable to cancellation for non-use three years after the registration date; in addition, use of the mark in a form that is essentially different from that which is registered may not be sufficient to comply with the use requirements. That being said, it is advisable to protect the mark (through trademark registration) in the same basic form as that which is intended to be used in Russia or at least to ensure that any differences between the two forms are immaterial and do not affect distinctive features of the mark.

What is the one key thing that practitioners need to know about registering rights in your jurisdiction?

AK: Russia is a first-to-file jurisdiction. In this regard, it is of the utmost importance to ensure the timely filing of trademark applications covering the relevant brands. Prior use rights are not formally recognised by the trademark system. Normally it takes between eight and 10 months to get a trademark registered in Russia if the prosecution is reasonably straightforward. Examination comprises formal and substantive stages, with the relative background searches forming part of the process. Examination can be conducted on an expedited basis upon the applicant's request. Pre-filing searches are highly recommended to check the availability of a brand.

HS: By contrast and unlike most countries in the world, the United States is a first-to-use trademark system, where applicants are assigned rights and given priority based on when marks are actually used in commerce.



IP service providers must be true allies to their clients, understanding that brand management is so much more than submitting trademark applications



Under US trademark law, an applicant may file an intent to use application before using the mark in commerce, provided that it has a *bona fide* intent to use the mark in commerce at the time. Such an application constitutes constructive use of the mark. No registration will issue though, until the applicant has submitted a specimen showing actual use of the mark in commerce. Once the application is allowed, the applicant can extend the deadline for submitting a specimen (with a nominal fee) for up to three years from the date of allowance. Accordingly, trademark owners should always file applications to register a mark as early as possible, even before it is used in commerce. Brand owners in the United States also obtain common law rights simply by using a mark in commerce. While these are more limited in scope (with a limited geographical scope and not entitled to inference of validity), they are still a viable protection option for lesser marks.

Marta Tolón (MT): The key thing that practitioners need to know about registering in Spain is that they must act in accordance with the Trademark Law (17/2001, revised by Royal Decree-Law 23/2018), which introduced several important provisions; for example, to provide evidence of genuine use in opposition procedures. The owner will be entitled to prevent all third parties from:

- using a sign that enjoys a reputation in Spain;
- using the sign as a trade or company name, or as part of a trade or company name;
- using the sign in comparative advertising in a manner that is contrary to the EU Directive on Misleading and Comparative Advertising (2006/114/EC); and
- bringing goods, in the course of trade, into the member state where the trademark is registered, without being released for free circulation.

However, a trademark registration does not entitle the owner to prohibit a third party from using, in the course of trade, its name or address, where that third party is a natural person and provided that this is



Stefan Edhammer

Prosecution manager, ClarkeModet Spain
sedhammer@clarkemodet.com

Stefan Edhammer has more than 13 years' professional experience in intellectual property. He specialises in IP strategies and portfolio management, trademark processing, opposition, defence and cancellation of actions in Spain and abroad, as well as negotiations and agreements relating to trademarks. He graduated in law from the University of Uppsala (Sweden) before going on to specialise in a combination of Community law and industrial property law, with a dissertation project on Community trademark law.

used in accordance with honest practices in industrial or commercial matters. Finally, a trademark right cannot be invoked to exonerate its owner from other IP rights infringement actions that took place before the right was registered.

How can counsel best argue for early engagement and position themselves as creative partners, rather than roadblocks to creativity – to ensure that protection levels align with the business' plan for a brand and that they are involved with marketing and product development teams?

Stefan Edhammer (SE): As an in-house attorney, try to be as involved as possible in any business activities that might raise trademark issues. Involving trademark counsel at an early stage can avoid the frustrating situation of having to discard a trademark, because of prior rights, bearing in mind all the hard work that has gone into it. This is a situation which can often be avoided by conducting an inexpensive knockout search at an early stage.



Clara Pombo

Corporate director of IP strategy, ClarkeModet
cpombo@clarkemodet.com

Clara Pombo has worked in intellectual property for more than 18 years. Her skills include portfolio strategy, internationalisation and litigation management in Latin America and Spain, conflict resolution, negotiations and business opportunities. Ms Pombo's volunteer work and charitable causes include the Massachusetts Institution of Technology (MIT) Enterprise Forum Spain, which is committed to promoting ground-breaking innovation and supporting the internationalisation of innovative ideas and projects. She has a law degree from Complutense University of Madrid (Spain), an LLM in international business and trade law from Fordham University, New York and an MBA from the Sloan School of Business, MIT.

Encourage and teach your teams to play with tools such as TMView at the start of the creative process so that they are familiar with – and more involved in – clearance.

Ilya Goryachev (IG): One argument is that early engagement of legal counsel may help to shape the brand strategy from the initial stages – without incurring additional expenses for changing what could have been tailored to the legal regime at the outset. Moreover, brand protection strategy is one of the key elements of any business plan and such a strategy should take note of all the legal aspects surrounding the development and identity of the brand, which in turn requires the involvement of legal counsel from the beginning.

HS: Ultimately, it is imperative that the marketing team and counsel work together to develop and manage a brand. Often marketers want to use descriptive or suggestive marks, as this is an easy way to inform customers about new products. On the other hand, trademark lawyers see a new product as an opportunity to select a unique mark that can be developed into a valuable asset. Counsel and the marketing

team should have regular meetings to ensure that the marketing team has a basic understanding of trademark law so that it is aware of both the possible risks and opportunities. Should counsel reject a proposed mark, it is important that they explain why so that the team develops its understanding of what is permissible. Counsel may also want to participate in early brainstorming sessions so that they can provide insight and conduct preliminary searches before the marketing team gets too committed to a mark. At the same time, counsel should recognise that there may be instances where the marketing team is wedded to a mark, even if there is a risk of infringement. Under such circumstances, counsel should focus on ways to minimise this risk (eg, by slightly modifying the mark to add additional terms or design elements).

How important is a cross-enterprise internal trademark usage manual and what key elements should it include?

HS: Trademark usage manuals are particularly important for larger companies or entities involved in licensing, where

they play an important role in providing the framework for selecting, using and protecting a mark. The manual should provide general guidance regarding selecting a trademark and should outline the clearance process, including requiring legal counsel to be sought before using a new mark in commerce. The manual should also clearly outline how the owner's marks should be used in commerce (eg, font, spacing and colour preferences) and should remind employees not to alter or modify the mark. It should also include instructions on how to provide notice of the brand owner's rights through the use of "TM" and "®" designations or trademark attribution statements (eg, "X and Y are registered trademarks of Brand Owner, Inc"). Given that trademark portfolios change over time, it is also important to review and update these manuals on a regular basis.

CP: A trademark usage manual is key to ensure the proper use of a mark. This is important not only from a branding perspective (ie, to create a trademark identity among consumers), but also to avoid the potential risk of a cancellation action due to non-use. Although

our jurisdiction does not have use requirements, a trademark registration might be cancelled if substantial changes are introduced in the mark that is presented to the public. Thus, a trademark usage manual should include at least:

- the trademark as registered;
- examples of the ways in which it might be used in the packaging of a product;
- explicit prohibitions of substantial variations on the mark (eg, including or eliminating key wording elements and/or altering the design, the calligraphy or the proportion of the elements); and
- clear indications of the colour codes that can be used (if the trademark claims colour).

IG: A cross-enterprise internal trademark usage manual is, I feel, important to the extent that it can ensure consistency with regard to trademark use. In particular, if the trademark is used with elements that may influence its distinctive character, then such use may not qualify as effective trademark use, which would be necessary to defend the mark from a non-use action. Therefore, the role of the manual could be to ensure that the trademark is used in the way in which it was registered. Further, the

Counsel should work with marketing to develop and manage a brand from the outset, so as not to be seen as roadblocks to creativity further down the line





practice of using the manual may unearth the necessity of obtaining new trademark rights to build up the series of trademarks that shape the brand portfolio. A manual featuring acceptable manners of use for the brand could also be helpful in stopping the brand from becoming generic, with the distinctive features being diluted.

With protection in place, attention can turn to enforcement and commercialisation. For the latter, licensing can be a powerful commercial activity. When entering into partnerships, what are the key legal considerations for trademark counsel?

IG: Legal certainty with regard to the type of licence (exclusive or non-exclusive), selection of licensed goods, determination of whether a licensee will have the right to sub-license, the territory of the licence and other key conditions are crucial. Some local legislative rules must be considered as well. For instance, in Russia, in case of an exclusive licence agreement, a licensor cannot use the licensed intellectual property in the licensed territory within the term of the licence, unless this is permitted in the contract. Therefore, if the licensor wants to continue using the intellectual property, the exclusive licence contract must have specific provisions allowing it to use the licensed intellectual property. Another local specific is the recordation of licences at the Russia Patent and Trademark Office. The recordation procedure is not complex and short-form notifications may be used to simplify the paperwork. Unless recorded, the licence rights will be considered as not having been provided to a third party.

SE: The key aspects that should be addressed by a licence agreement in Spain are similar to those in most other jurisdictions. An application or a registration may be licensed for all or some of the goods and services, for all or a part of the Spanish territory, and this may be on an exclusive or non-exclusive basis. Sub-licences may be granted and a limited duration may be established. Failure to record an agreement in Spain



Marta Tolón

Consultant legal services, ClarkeModet Spain
mtolon@clarkemodet.com

Marta Tolón has worked in intellectual property for more than 16 years. She specialises in the integrated management of IP assets of large companies, both national and foreign customers, and advises on strategies for the international expansion of the protection of IP rights, in the preparation of agreements for licensing or assigning IP rights, technology transfers and in processing out-of-court conflict resolution, domain name recovery and the online defence of brands. Ms Tolón has extensive experience in the consumer goods, fashion, agri-food, retail and automotive sectors. She graduated in law from Complutense University of Madrid (Spain) and has a Master's in intellectual property from the University of Alicante (Spain). Ms Tolón is a member of the Madrid Bar Association.

will not affect the validity of a licence or of the trademark registration itself. However, recording is advisable in order for a licence to have effect against third parties. Commercial relations evolve over time and it is important to monitor existing licence agreements with scheduled regular reviews. It is not uncommon to see agreements that have not been renewed – even though the commercial activity itself is still ongoing – or situations where the commercial conditions have changed but this has not been reflected in a revised agreement.

HS: While terms such as exclusivity, scope and royalty rates are important, the key consideration is usually quality control. Licensees often resist having others meddle in their business. However, brand owners must ensure that all goods and services bearing their trademark meet a consistent quality standard; failure by the brand owner to monitor its licensees may result in a loss of rights. The parties therefore need to find a middle ground that allows the licensor to monitor the goods sold under its mark while not significantly disrupting the licensee's business. Licence agreements



Ilya Goryachev

Senior lawyer, Gorodissky & Partners
goryachevi@gorodissky.ru

Ilya Goryachev graduated from the Moscow State Linguistic University in 2012 as an international lawyer. He focuses on providing legal support on IP and general commercial matters, including unfair competition, domain disputes, licensing, assignments, franchising and other IP-related transactions, advertising and marketing regulations, IP issues in M&A transactions, IP due diligence, personal data protection and industry-related regulatory affairs, including advising life science companies. Mr Goryachev assists with IP enforcement and anti-piracy matters, and handles all kinds of IP infringement cases before the courts and administrative bodies. He is the author of several articles on IP and commercial law issues and speaks English and French.

may require licensees to obtain approval for new products before their release, with the understanding that approval will be prompt (or else assumed) and not unreasonably withheld. Agreements may also permit licensors to request a certain number of sample products going forward, so that they can test the product's quality. In addition, agreements should address what happens should the licensee's product fail to meet the requisite standards, including product recalls or immediate termination of the licence.

Another commercialisation strategy is to co-brand products in association with a third party. What are the main commercial and contractual considerations when entering into such relationships?

MT: When planning a co-branding partnership, it is important to determine whether the object and goals of the co-branding will provide a mutual benefit to the partners. Additionally, it must be taken into account that the partners have

a similar audience and that they want to grow this – the number of new leads obtained from the partnership will be worth the effort that the partners put into the co-branding partnership. Finally, it is crucial that the partner's trademark has a good reputation that will not damage the other partner's credibility and that both parties agree with the topic and theme of the co-branding. A co-branding agreement must include:

- the goals of the co-branding;
- the term length;
- a timeline for the partnership, including any co-marketing promotions;
- termination clauses that allow the partners to end the agreement;
- licensing provisions that define how each partner's respective logos, copyrights and trademarks can be used in the co-branding partnership;
- exclusivity clauses that prohibit partners from entering into co-branding agreements with competitors;
- the liability of each partner in case of a lawsuit; and
- market data sharing agreements, envisaging that the partners share any marketing data originated through the co-branding partnership.

IG: Co-branding is often accompanied by mutually born expenses of a monetary and organisational nature. In this regard, it is vital to clearly set out the rights and obligations of both parties and to define the areas of responsibility (eg, who will be responsible for ensuring compliance of the co-branded materials and to what extent).

HS: Co-branding can provide a platform for brand owners to increase exposure to their mark, but comes with the risk of creating confusion if not carried out properly. The main commercial consideration is to ensure that the brand owner is careful about who it selects as a co-branding partner, as the value of its marks can be severely diminished based on any negative perceptions of its partner. While this is true for all licence agreements, it is particularly important for co-branding agreements, as consumers may view these efforts as a joint venture between the parties. Brand owners may want to include a termination

clause that allows them to walk away from the co-branding arrangement for any reason. Co-branding agreements should clearly identify the marks at issue and delineate who owns any co-branded products. The agreement should also provide detailed product guidelines for the co-branded products, along with the ability for both parties to retain quality control should the products fail to meet the specified guidelines..

Success inevitably creates headaches in the form of infringement. What are the keys aspects to consider when building a (physical world) policing programme?

HS: Timing is key for brand owners policing their marks. There are several trademark clearinghouses in the United States that notify brand owners whenever a new application is filed or published or a domain name is registered that includes a confusingly similar mark. This allows brand owners to notify potential infringers of the infringement, possibly before the third-party mark ever reaches the marketplace. Even if the potential infringer does not abandon its mark, identifying the issue early can allow the brand owner to oppose the registration of the infringer's mark. Opposition proceedings are streamlined proceedings before the USPTO and are often much less expensive than litigation before the district court. Early detection will also assist the brand owner should it need to file suit in the district court. The most common remedy issued to brand owners in trademark cases is injunctive relief, prohibiting the infringer from using its infringing mark in commerce. The longer that it takes the brand owner to raise this issue with a court, the less likely the

court is to issue a preliminary injunction, meaning that the brand owner may have to wait until the end of the case (which in some courts can take between two and three years) before obtaining relief.

IG: Ranking infringers by the seriousness of the damage that they cause may be one aspect. Some infringements can be easily stopped by sending a cease and desist letter – although the wording of this may vary. While standard worded letters are helpful in some circumstances, it may be more effective to use sophisticated situation-tailored letters in others. In some cases (eg, online infringements), contacting hosting providers can be helpful as well. If case settlement options have been exhausted, then it is time to consider litigation or to approach enforcement authorities. Further, a statutory limitation term must be observed from an enforcement perspective. In Russia, this is three years, starting from the date when the plaintiff learnt about the infringement and the infringer. Failure to meet that three-year term may result in the lawsuit being dismissed.

MT: It is essential that every trademark owner has good surveillance services both online and offline. In addition, it is essential that rights holders request customs intervention and collaborate with the police, state bodies and security forces. Right now, this face-to-face monitoring must be carried out in full harmony with the online surveillance of trademarks. In this case, the Enforcement Database seems practical and is recommended in order to avoid fraudulent use and marketing of products under a trademark and, at the end, the commercialisation of fake goods within the EU territory. Hence, it is necessary to have a multidisciplinary team when managing the processing of trademarks.

“
Often social media usernames, hashtags and handles are just as important as trademarks themselves



Social media is equally important; yet there are many pitfalls in this environment. What strategies should be put in place to monitor brand-related activity and discussion – both by internal employees and in the wider community?

CP: Unfortunately, the Internet facilitates counterfeiting and the spread of fake goods. Thus, you must remain constantly on the alert to ensure that your IP rights are being respected and to flush out any counterfeiters by ensuring comprehensive monitoring. Fortunately, the Internet also has its advantages. You can use it to monitor your products through search engines or online auction platforms – often with the possibility of setting up alerts so that you are informed as soon as an object is offered for sale online. You can also flush out counterfeits by using keywords. The implementation of online monitoring tools can be a good option here.

HS: Often social media usernames, hashtags and handles are just as important as trademarks themselves. As such, brand owners should check their availability as part of the clearance process and should secure these (and useful variations thereof) before seeking to register the mark. Because there are so many social media channels, it can be particularly difficult for brand owners with limited budgets and time constraints to police their marks. In assessing this risk, brand owners should consider the potential impact to their business when picking their battles. Owners should aggressively pursue any infringer selling a competitive product but may want to hold off on confronting owners of parked websites with no content or social media accounts that have few followers.

IG: It is important to define what types of brand appearance on social media can be tolerated and what cannot. Reliable monitoring platforms (that also takes account of the Russian Cyrillic-based language) make it possible to reveal the specific areas on social media requiring



Alexey Kratiuk

Partner, Gorodissky & Partners
kratiuka@gorodissky.ru

Alexey Kratiuk graduated from Moscow State Aviation University as a radio-technique engineer and then from the Russian State Institute of Intellectual Property as a lawyer. He joined Gorodissky & Partners in 1998. Mr Kratiuk specialises in obtaining legal protection for trademarks and appellations of origin of goods – in particular, trademark prosecution proceedings in Russia, the Commonwealth of Independent States and the Baltic states. He also counsels clients on issues relating to the protection of designations registered as trademarks. Mr Kratiuk is a regular speaker at IP seminars and conferences in Russia and abroad, and has written articles for various foreign IP magazines.

attention and reaction. From online offers of counterfeits to issues of satire and parody with regard to the brand, each fact needs to be assessed from a legal position. Internal company policies, as well as training with regard to online aspects of brand use and positioning of the company online, may be helpful for avoiding potentially negative situations. In case of the wider community, this can include a timely reaction to brand-damaging publications and the avoidance of aggressive tactics.

Of course, budgets are finite, so what is your top tip for saving money across registration and protection activities?

AK: One practical tip for saving money during the registration process is to check the availability of the brand by conducting clearance searches before commencing, so as to consider registering alternative or amended names if the search reveals any conflicting name. Another suggestion is to draft specifications of goods or services correctly to ensure protection for the goods or services of interest and try to avoid collisions with potential



Ronald “Hank” Spuhler

Shareholder, McAndrews, Held & Malloy
rspuhler@mcandrews-ip.com

Ronald “Hank” Spuhler is a shareholder at McAndrews, Held & Malloy. He has a broad base of experience counselling clients in all aspects of IP law across a wide array of businesses and technologies. He currently manages trademark portfolios consisting of thousands of cases in the United States and more than 120 foreign countries. Mr Spuhler also has significant experience in enforcing trademark rights before the TTAB and in the district courts. In addition, he has assisted clients in licensing and monetising their trademarks, including representing Sears (and its successor) in connection with the sale of its Craftsman tool (\$900 million) and DieHard battery (\$200 million) businesses.

third-party rights at the same time. As for protection activities, the wide use of cease and desist letters and pre-trial actions (eg, communication with hosting providers) may prove effective in many infringement cases, thus providing fast solutions without expensive litigation procedures. Nevertheless, in some cases litigation may be the only way. In Russia, for instance, small and medium infringements can be dealt with via a simplified litigation procedure, where a judge considers the case *ex parte* subject to some procedural conditions. However, for large infringements that seriously damage the brand, the rights holder needs to consider more sophisticated enforcement approaches.

HS: My number one suggestion is to utilise attorneys who specialise in trademark law. The likelihood of confusion standard can be somewhat vague, so it is important to work with an experienced trademark attorney who has a feel for what constitutes infringement. Clients often need to protect their mark in multiple jurisdictions, each with their own requirements and nuances, so it is important to work with an attorney who

understands the international landscape. Firms with a dedicated trademark practice also typically have trademark paralegals who can assist with the administrative aspects of the registration process (eg, collecting acceptable specimens and preparing renewals) at a much lower rate. Such firms may also have subscriptions to trademark clearance sites, which have sophisticated software that attorneys can use to search federal and state registrations, as well as common law databases. Too often a client's clearance efforts consist of running a quick search on the relevant trademark office website for the exact mark. However, such searches will not uncover variants of the mark that could form the basis of a likelihood of confusion refusal (eg, phonetically similar marks, misspellings or marks with added prefixes or suffixes). By understanding the market landscape, applicants can draft the application in such a way as to minimise the likelihood of receiving an office action. That will greatly reducing the overall costs of examination (and of possibly rebranding a product should the client have commenced use before receiving the initial office action).

SE: Not all trademarks are equally valuable for an organisation and they do not all require the same amount of protection. For instance, the strategy for a house mark or company name should probably differ from that of a sub-brand. As mentioned earlier, it is crucial to clarify the expected use of a trademark for the next five years. Having this set out is essential when deciding on the type of trademark to protect, as well as the number of classes and jurisdictions to cover. These decisions will also have a significant impact on costs. If the future use of a trademark is unclear, which is often the case, set up a regular review of your portfolio in order to constantly update the protection as the use of the brand evolves. In addition, avoid overprotecting your trademark and keep in mind that a registration is not the only cost that you will have to take into consideration. Ensure that you have the budget to efficiently monitor your trademark in order to file oppositions

against conflicting applications and take action against possible infringements.

In terms of getting the most benefit from partners, how can rights holders maximise the advantages of the client-law firm relationship?

MT: It is always advisable that clients establish a relationship with an established IP firm for protecting and defending IP rights – not only in their country of origin, but also in other jurisdictions where the client conducts a significant amount of business. For this reason, it is better to work with IP law firms with a direct presence, or indirectly with exclusive association with local firms, in all countries that the client offers and/or commercialises its services and/or goods. Having local allies will allow clients to receive a more accurate and swifter response. From my point of view, having allies, such as a trusted legal firm, helps to control IP costs by virtue of close collaboration. It is important to share with the IP lawyer the company business plan that affects the extension of IP rights. A local lawyer will provide the best protection strategy, based on their experience. I believe that this close relationship – together with a controlled investment by companies and a regular audit of the trademark portfolio – avoids, for example, overprotection in some territories or registration gaps in others.

HS: Trademark protection is becoming increasingly important. The number of trademark applications filed is growing by millions each year, making it more difficult for clients to choose a unique mark. In addition, owners must consider obtaining foreign registrations, social media accounts and domains (including a wide array of new gTLDs – there soon could be hundreds of them). Even if successful, the brand owner may then have to deal with copycats and counterfeiters infringing their mark. An experienced trademark attorney can help to guide brand owners through these issues. Brand owners should engage counsel early in the selection process to maximise the likelihood of

obtaining protection. The parties should thereafter have regular conversations to discuss new product developments, any changes to existing product lines and the results of any watch notices identifying potential infringers. This constant communication will help the brand owner's portfolio continue to grow alongside the business, while ensuring that third-party use does not diminish its value.

IG: Regular workflow allows law firm practitioners to better understand their clients' needs and to adopt a flexible approach for ongoing matters. Further, while no one understands their business better than the client, practitioners can bring industry-specific legal expertise to the table. Law firm feedback can also help clients to develop better strategies with regard to the challenges posed by the market. Training seminars or similar events conducted by law firms for rights holders at which the parties can share their experiences and expertise from both business and legal perspectives can maximise the advantages of the client-law firm relationship.

Are there any other issues that you would like to raise?

IG: In terms of further brand use, the requirements of advertising law must be taken into account as well. For instance, if the trademark includes – as a non-protected element – an indication such as “No 1”, use of the mark in advertising would require this superiority element to be justified.

CP: A defined internal IP policy that includes the education of employees (especially those involved in branding) is of utmost importance for rights holders. With a basic knowledge of intellectual property, an employee might be guided towards designing a brand within the legal requirements of the corresponding jurisdictions, without feeling that the attorney is an obstacle to their creativity. On the contrary, they will see counsel as an adviser and turn to them if doubts arise in the process. **WTR**

