

Globally Challenged? Strategies for Protecting Your Brand in a Global Marketplace¹

The current commercial market for goods and services increasingly requires trademarks to function as source designators in a global marketplace. There are many considerations when bridging these geographical and, oftentimes cultural, divides. It is important to be aware of these differences upon entering into the world of international trademark protection.

I. Strategies for working with foreign associates to clear marks

It is almost always necessary to hire foreign associates to prosecute foreign trademark applications. It can be a great help to engage the services of these associates at the trademark search stage where they can become familiar with the market associated with the proposed mark. At that time, they can perform searches and even draft opinion letters regarding the risks of pursuing registration in their nation or region.

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Generally, a U.S. attorney initiates contact with the foreign associate (which may be an attorney or a trademark agent) and provides the pertinent trademark information to them. This includes the trademark, owner information (name, address, state/country of incorporation), goods/services to be covered, dates of first use and priority information, if applicable. The associate will then explain the clearance process within their country. If a search report is ordered, the foreign associate will review the report and can provide an opinion regarding the registrability of the mark and whether it is available for use (i.e., whether use of the mark will infringe a third party's rights).

A. Choosing your foreign associate

There are many factors that need to be considered when choosing a foreign associate to perform your trademark work. In some situations, such as when existing foreign trademark applications and registrations are transferred to you for prosecution, your choice for a foreign associate is already made for you. In those cases, it is usually more efficient to continue working with the associate who has been prosecuting your client's applications or registrations because they are already familiar with them.

Many countries do not have online search options that allow you to view the full file for a mark or provide a record of what goods are covered by an application or registration, or to ascertain the status of an application or registration. Maintaining a relationship with the existing foreign associate allows for an easy transition and provides you access to the information the foreign associate has regarding the mark and the status of the active applications and registrations.

Similarly, if a client has previous registrations that are prosecuted by a certain foreign associate, it is usually wise to file the new application using that same associate. This

makes it easier to determine past pitfalls encountered by the client in certain countries and allows you to become familiar with the prosecution style of the particular firm. Additionally, keeping most of your trademark portfolio in one country with one firm might enable you to negotiate a discount in the foreign associate's service charges and also attract that associate's business when they need to file trademark maintenance or oppositions in your home country.

Practice Tip: Most foreign associates provide *schedules of fees* for clients or potential clients. Be careful when considering and comparing flat fees, as some charges cover the cost of the entire transaction while others only cover partial transaction charges. If the volume of your legal work is substantial, consider negotiating for reduced fees and make sure to have the final rates in writing prior to authorizing any services.¹

Practice Tip: Some foreign associates require *payment prior to rendering services*. This requires advanced planning, so that you can provide early instructions to these associates, particularly when a definite filing date must be obtained.

Practice Tip: Request a potential foreign associate to complete a *conflict check*, as this is not a customary practice in most foreign countries. This is especially important when seeking to retain foreign counsel in adversarial matters such as oppositions and cancellations or for infringement advice.

B. Searches

Conducting a trademark search in the region where your client is interested in trademark protection is highly recommended. Prior to development and adoption of a trademark it is advisable to complete a trademark search to analyze the business risks associated with using and

registering a trademark. These searches can be performed on your own or via a search vendor or foreign associate.

1. Pre-Screening Search

The pre-screening search, commonly known as a “knock-out” search, is a very preliminary search that can be performed by marketing personnel prior to coming to the legal department or outside counsel. These searches are conducted utilizing common internet search engines and the online trademark database of the particular country or regional trademark registry, where available. If the identical trademark for the same or nearly the same products or services is located and appears to be in current use, i.e., a “direct hit,” there is no need to invest in a further search and it is time to go back to the drawing board.

2. Trademark Searches

Conducting searches on an international scale generally requires making some strategic decisions as there is no single commercial search product that covers all major countries.

Most commercial search firms offer numerous products that assist in evaluating the availability of marks outside of the U.S. Some of these searches are of limited assistance, and many of the search products provide listings of marks that are identical, nearly identical or phonetic equivalents without screening for similarity of products. Clearing marks in other countries is also complicated by the extremely broad product descriptions permitted in foreign registrations which make it difficult to ascertain whether there is any actual overlap with the client’s use of the proposed mark. In addition to commercial products, searches can be conducted by private law firms in the countries of interest which can provide helpful legal assistance in

determining whether a mark is available for use or registration.

Full searches are provided by outside vendors. These searches can be ordered for particular regions or specific countries and can be ordered with or without a legal opinion. Experienced researchers conduct manual search strategies and filter the information based on relevance. There are many variations of full searches based on the mark, classes, whether the search is national, multi-national or international, etc. Details about these searches can be found on a search vendor's website.

Search vendors also offer owner/registrant searches. These searches collect the international trademarks owned by a certain entity. There are also international screening searches which identify exact, near-exact and phonetically equivalent marks that are published or registered as well as company name searches. Common law usage searches, internet common law usage searches, pharmaceutical usage searches and connotation analyses are also available.

Regardless of the type of search obtained, clearing a trademark in another country frequently requires some level of local expertise.

3. Considerations in Searching

In a search completed with or without the aid of a search vendor or foreign associate, it is important to understand and consider the many variations of a mark that could be utilized. Such variations include deliberate misspellings, puns, slang, variations on otherwise common words, corrupted spellings, colloquialisms, foreign language equivalents, words with the same root, tense variations, pluralisms or conjugations, variations in prefixes and suffixes, irregular plurals, contractions, phonetic similarities,

word play, abbreviations, punctuation, synonyms, alternative spellings, visual equivalents, repeating words, coined words and cardinal and ordinal numbers.² All of these variations of the mark should be searched in each country under consideration. Search vendors cross-reference many of these variations, the extent to which is explained on their websites.

Searches can be conducted for similar marks, near-exact marks, in all classes or only the classes related to your mark, in an entire region or only the nation of interest to your client. Be sure to note that not all countries have adopted the international classification system and instead use their national equivalents. This could affect the results obtained from searches that are run utilizing International Class numbers. Even if a country utilizes the International Class system, not all countries classify products the same way in the same class. Also note that the search vendors provide different options as far as the extent of a search and that prices vary upon the extent of the search and the desired turnaround time of the search results.

Search results are reviewed in order to ascertain whether the proposed mark is confusingly similar to existing marks. This is critical to determining whether a claim for trademark infringement can be avoided.³ The analysis usually involves ascertaining whether the search identifies similar marks for the same or related products.

In addition to a likelihood of confusion analysis, it may also be prudent to conduct a dilution analysis when considering search results.⁴ If the proposed mark is identical or very similar to a famous mark (that may or may not be identified in the search results), the client's adoption of the mark should be carefully considered in order to avoid provoking a suit for dilution of the famous trademark. Note that not all countries have dilution laws.

Practice Tip: *In most countries, prior use of a trademark provides little or no benefits. Trademark rights only exist when a registration is issued. Simply stated, if there is no registration in a country, the trademark owner has no trademark rights. Indeed, the trademark owner may find itself in the awkward position of having to defend a suit brought by a prior registrant having no good faith reason for registering the trademark. For this reason, it may be unnecessary to conduct searches that go beyond a country or region's trademark registry.*

Practice Tip: How thorough a trademark search should be depends on the client's plans for use of the mark, such as: the geographic extent of the use of the mark, the product's life span, the manner in which the mark will be used (i.e., directly on the product or on labels that can be easily removed, on-line, etc.).

4. Search Opinions

When counseling clients on the selection and clearance of a proposed trademark, it is important to explain that a trademark search cannot guarantee the availability of a proposed mark for use (i.e., there is no way to guarantee that an objection will not be raised by a third party). Especially in common law countries⁵, it is not possible to guarantee that every unregistered common law user, who will own superior rights to use the trademark, has been located in the search. However, full searches reduce the risks associated in adopting a new mark, thereby providing the greatest degree of assurance as to the availability of a mark for use and registration.

In analyzing the search results, it is helpful to first identify the most relevant references. Make sure to analyze those references in terms of use, registrability and

protectability of your mark. Also, it is important to provide a recommendation that addresses your client's business plans.⁶

After the search has been reviewed, there are several options. If there are no confusingly similar marks for the same or related products/services, you may advise the client that it is a reasonable business risk for it to adopt and use the proposed mark. Additionally, advice as to the registrability of the mark can be provided.

If a confusingly similar mark for the same or related products/services is identified in the search as a registered mark, you should confirm whether the registered mark is being used and the nature of the use. If the registered mark is being used, it is usually best to advise the client that it should not adopt the proposed mark at this time. When faced with this situation, the client may want to consider attempting to purchase the prior registration, or seek permission to use the mark from the owner of the registration via a license or a more simple consent agreement. If the registered mark identified in the search is not being used, a further investigation can be conducted to ascertain whether the registration is subject to cancellation on the grounds of non-use or abandonment.⁷

Practice Tip: For a preliminary indication as to the availability of a trademark in the European Union, searches can be run on www.oami.europa.eu [website for the Office of Harmonization in the Internal Market (OHIM), the European agency responsible for registering trade marks and designs in the 27 countries of the European Union, referred to as "Community" Trademark Registrations] and on <http://www.wipo.int/romarin/> or <http://www.wipo.int/ipdl/en/search/madrid/search-struct.jsp> [website for the Madrid System for the International Registration of Marks administered by the World Intellectual Property Organization (WIPO), a specialized agency of the

United Nations dedicated to developing a balanced international IP system].

Practice Tip: Be mindful that searches of the Community Trademark Database and the WIPO International Registry are not conclusive as to the countries they cover. In order to have a complete assessment, you must also search each member nation's national trademark registry.

Practice Tip: Remember that in addition to words and logos, trademarks can be in the form of colors, packaging, three-dimensional configurations, holograms, motions, sounds, and slogans. Even if you think that the proposed term or design is not registrable, a good practice is to run at least a preliminary search. Sometimes, the search results are quite surprising⁸ and will result in a decision not to use the proposed mark, thereby saving much time and money. An additional consideration for conducting a search is that it can serve as a defense to an allegation of bad faith or intentional infringement. However, in virtually every circumstance, there is no legal obligation to conduct a trademark search.

Practice Tip: Trademark databases are not immediately updated, nor can your opinion be guaranteed with respect to actions that third parties may take. Therefore, it is wise to include a disclaimer in your opinion to your client upon transmission of the search results.

Practice Tip: If your firm or company has a presence in the country where you are filing, consider asking the employees of that branch if they recognize any obstacles to registering your proposed trademark. Often, they are more familiar with the local marketplace and can be a useful resource.

Practice Tip: In Latin America there is almost no requirement for use of a mark to maintain it forever. Therefore, searches are particularly important in order to detect dormant marks. In most cases, a foreign associate can assist in negotiations with the current owner of the dormant mark for an assignment or license of rights.

5. Domain Name Searches

In most cases, the trademark owner will want to use a domain name that contains the proposed mark, or at minimum, will want to prevent a third party from registering a domain name consisting of its proposed mark. Thus, it is a good idea to conduct a domain name search to see whether the *.com* domain name or other country code top-level domain names are available and, if so, to register them in view of the minimal costs involved. (Note: there is no requirement to actually use a domain name before or after it is registered.)

Practice Tip: *Register any domain names before the proposed mark is made public, i.e., before the product is introduced into the marketplace or prior to the filing of a U.S. or international application.* It is not uncommon for unscrupulous parties, (also known as “cybersquatters”), to monitor U.S. trademark filings and then rush to register the newly-filed marks as domain names, hoping to force the trademark owner to purchase the domain names at inflated prices. This type of conduct is actionable under the Anticybersquatting Consumer Protection Act⁹ which can be used to pursue cybersquatters, but doing so can be costly and time consuming. Another option is to initiate a dispute resolution proceeding through the program administered by the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center. Almost 24% of the cybersquatting matters handled by WIPO in 2009 were settled prior to a panel decision. Of the remainder, a

whopping 87% of the WIPO dispute resolution panel's decisions were in favor of the complainant.¹⁰

II. **An in-house counsel perspective—What marks should be registered?**

A. *Develop Filing Strategy “Tiers”*

In order to prepare an economically feasible trademark protection program, it is helpful to establish a “tiered” approach that prioritizes the trademarks and regions in which trademark protection will be sought over time. The following factors are among those considered in developing the appropriate tiers.

1. “Level” of Mark

Identify whether the mark constitutes a: (1) brand name (sometimes referred to as a “housemark”), (2) product name, or (3) name of a feature. This will assist in understanding the value of the proposed mark. The lower the “level” of the mark, the lower the extent of protection that may need to be pursued.

2. Intended Market

Is the product/service intended for the consumer market or is it marketed to a specific industry or to a limited number of customers? Products/services directed to the consumer market where brand names are important warrant a more aggressive filing approach.

3. Geographic Areas of Use and Production

Identify countries where products/services bearing the mark will be sold initially, those countries where there are plans to expand into, and those countries where the products

will be produced. Protection should be pursued in at least those countries where products/services will be marketed and manufactured. The scope of protection to be pursued will usually correspond to the geographic scope of marketing. A product that will not be launched internationally does not require the same scope of protection as a product that will be marketed multi-nationally.

4. Locate/Know the Competition

Identify countries where competitors are located. Such countries should be included in the filing strategy to ensure that competitors do not preempt your trademark in their home country.

5. Counterfeiting

Consider whether your client's product is subject to counterfeiting. If so, identify and include countries where counterfeit products will likely be manufactured as this will assist in stopping counterfeit products where they originate.

6. Conclusion

When deciding on filing strategies with clients, the old adage an "ounce of prevention is worth a pound of cure" is helpful to convey. That is, the money spent on registering a mark is much less than the amount of money that will be needed to pursue an infringer or rescue a mark from the hands of a counterfeiter. The key challenges to establishing and maintaining an effective international program are understanding the business implications, knowing the client's risk threshold, and ascertaining an appropriate cost-efficient strategy.

Practice Tip: Determine which marks in your client's portfolio are the most important to its business. If these marks become dormant (as a result of non-use), consider re-filing an application to maintain your company's rights to the mark and to avoid cancellation for non-use.

Practice Tip: Make sure to keep your foreign associate informed as to which marks are not in use by your company. In some countries, non-use for a specified period renders the mark subject to cancellation. You will not want to assert a registration that is subject to cancellation against a third party and risk losing the rights to that trademark. An informed foreign associate will be able to provide guidance regarding whether to file a new application for your trademark before pursuing an infringer.

Practice Tip: When applying for a word mark in a non-English speaking country, consider filing an additional application for a translation and/or transliteration of the mark into the native language. Also consider that an exact translation of the mark into the native language might have an unappealing or even offensive translation or could be nonsensical. In those instances, look into coining a new trademark in that country's native language.

Practice Tip: Prior to registering product packaging, consider how often the packaging is updated and whether the packaging differs between different geographical and commercial markets. Determine whether there are common elements that exist for packaging used in most or all countries, and consider filing an application to cover those elements.

II. Appropriate jurisdictions to seek protection

A. What is the budget?

When your client is working on a tight budget it might want to file only where its mark is currently in use. If your client does most of its business in Germany, it might not need to incur the expense of filing a Community Trademark application and would be advisable to file a national application in Germany only. A client with a heftier budget, on the other hand, can afford to register its mark in regions where it plans on using its mark as well as where, if anywhere, its mark is currently in use.

B. Where are the goods/services distributed?

The purpose of registering a trademark is to establish ownership rights in your mark. This is most important in the areas of the world where your products/services are distributed. It is in those areas that a trademark owner is most likely to be financially affected by trademark infringement.

C. Where are the goods manufactured?

It can be valuable for a trademark owner to register its marks in the country(ies) where the associated goods are manufactured. As mentioned above, such registrations can be used to protect the marks from appropriation by counterfeiters and/or pirates looking to “sell” the registration to the rightful trademark owner, and can be used to stop the exportation of goods bearing infringing marks.

III. Alternatives to national filings, including the CTM and Madrid Protocol

The increasing importance of a global marketplace has resulted in the harmonization of protection afforded to trademarks and the implementation of new trademark laws in many countries, including the U.S. This harmonization has been welcomed as it provides a greater degree of certainty for trademark owners, enabling them to develop more effective international marketing strategies.

Through harmonization, many countries have conformed their trademark laws to an approved framework, and participated in centralized filing systems permitting trademark protection to be obtained in several countries through a single filing. It is important to remember, however, that while various treaties have made significant advances in certain areas, trademark protection remains territorial. Therefore, the establishment of trademark protection in one country does not mean that the trademark will enjoy the same level of protection in other countries.

A. The Paris Convention

The Paris Convention for the Protection of Industrial Property, first adopted in 1883, is among the oldest international treaties addressing the protection of trademark rights. One of the most significant principles of this treaty is that of “priority.” Specifically, an applicant who files a trademark application in one of the signatory countries to this treaty possesses a right to claim the same filing date for subsequent trademark applications that are filed within *six (6)* months in any of the other signatory countries. For example, an applicant who files an application in the U.S. on June 12, 2010, has until December 12, 2010 to file applications in foreign countries that are members of the Paris Convention, and claim June 12, 2010 as the filing date in those countries. Even though the foreign applications will be filed several

months after the U.S. application, they will receive a filing date of June 12, 2010 based on the priority claim. This is a significant benefit because most countries award trademark registrations on a first-to-file basis; thus the applicant with the earliest filing date will receive the registration.

The ability to claim a “priority” filing date is an important planning tool for an international trademark program. It enables trademark owners to gradually increase trademark protection rather than having to incur the considerable costs of seeking trademark protection upfront.

Once the trademark owner has identified the countries or geographic areas in which it is interested in pursuing trademark protection, counsel should consider the appropriate filing systems. One route is to file applications in each country of interest. Depending on the number of countries and the geographic areas of interest, there may be a more efficient way to file the applications. U.S. applicants have at least five multi-national filing systems to consider: the Community Trademark system, the Madrid Protocol, the African Regional Industrial Property Organization, the African Intellectual Property Organization and the Benelux system.

Practice Tip: Remember the “priority rule” when reviewing trademark searches. Where pertinent references identified in a search are marks first-filed outside of the U.S., that foreign applicant may have a right of priority over your client’s proposed application if the foreign applicant’s U.S. application is filed within six months of the filing date of its foreign application. For example, if the foreign applicant files a CTM, Madrid Protocol, or a foreign national application, it has six months in which to file an application in the U.S. claiming priority from the foreign filing date, thereby establishing superior rights over your client’s application. Of course, this priority claim would also apply

to applications filed in any other country that is a member of the Paris Convention.

B. Community Trademark System

The Community Trademark (CTM) was established in 1996 and is administered by the Office for the Harmonization in the Internal Market (OHIM) located in Alicante, Spain. See: www.oami.europa.eu. It covers the 27 member countries of the European Union,¹¹ making it possible to obtain a registration that covers the entire European Union by filing a single application. The filing fees for a CTM application are significantly less than pursuing national applications in even a few countries and, in 2009, the OHIM reduced the cost of obtaining a CTM registration by more than 40%,¹² making it an even better value.

A CTM registration is granted for a period of 10 years and renewable for subsequent 10 year periods. In order to maintain a CTM registration, the mark need only be used in one of the member countries. Other benefits are that there is a single renewal fee and it is possible to obtain an injunction covering all of the European Union if a CTM mark is infringed. The CTM allows applicants to claim seniority over a national trademark registration, thus paving the way for many registrants to drop their national trademark registrations and maintain only their CTM.

CTM applicants need not use their marks prior to having them registered. The fact that use of a mark in one member of the European Union constitutes use in all of the member countries can lead to tactical problems because an applicant can register a mark that is used only in one region and block any new applicants from extending use of their marks in the entire European Union. A subsequent applicant

must prove that its mark is famous in order to overcome this obstacle.

Practice Tip: CTM applications are only examined for meeting the formalities for protection as a trademark. The OHIM does not conduct a search of prior conflicting registrations. Accordingly, receipt of a CTM registration does not come with any assurances that the trademark owner will not face an infringement claim by a prior registrant. For this reason, CTM applicants may wish to have a search performed in the European Union prior to filing a CTM application, or before using a trademark in the European Union.

C. Madrid Protocol

The Madrid Protocol provides for the international registration of trademarks in the 83 member countries (plus the European Union) that belong to the Protocol. The Protocol is administered by the International Bureau of the World Intellectual Property Organization (WIPO) located in Geneva, Switzerland. See: www.wipo.int/madrid.en. It is important to note that popular foreign filing countries such as Canada, Mexico and all of Latin America, except Cuba, are not members of the Madrid Protocol.

An international “Madrid” application is filed in the applicant’s home country (in English, French or Spanish), and is based on an application or registration in the applicant’s home country, referred to as the “base” application or registration. At the time of filing, the applicant designates the countries in which it desires to obtain protection, which then determines the amount of the filing fee.

The application information is sent to the International Bureau of WIPO which confirms compliance

with the filing requirements and then notifies the respective national trademark offices for the designated countries. Each national trademark office must then examine the application and act to issue any objections within 18 months. If successful, the trademark owner will receive one registration covering the countries of interest. A highly-desirable feature of an International Registration is that there is a single renewal date¹³ and, most importantly, a single renewal fee.

In order to receive a registration, the mark must be registered with the trademark office in the applicant's country of origin. Registration under the Madrid Protocol can streamline international registration and, if no objections are raised by the national offices, may do so much more economically than individual national filings.

The advantages to Madrid filings include the cost and ease of only filing one international application that extends coverage to many countries. It can also be a great tool for priority trademark applications. If circumstances do not provide sufficient time to contact foreign associates for national or CTM filings, it is possible to file a Madrid application at the last minute via the Madrid Protocol forms on the U.S. Patent and Trademark Office's Trademark Electronic Application System (TEAS). Also, when filing in more unfamiliar countries it may be easier to communicate through the International Bureau of WIPO than with local attorneys.

There are also some disadvantages to the Madrid system for U.S. trademark owners. If the base trademark application was filed in the U.S., your client's Madrid application is constricted by the more detailed description of goods required by the U.S. Patent and Trademark Office. This can be very narrow in scope and limit protection of the mark. If the base application originated in another country,

the goods description can be very broad, and the resulting protection in the Madrid countries will be broad as well.

Another disadvantage is that oftentimes there will be issues with the Madrid application that will require retention of foreign associates to handle rejections raised by the national trademark offices. Additionally, the International Bureau of WIPO and the U.S. Patent and Trademark Office do not always communicate well, which can lead to mistakes in Madrid applications. Finally, it is common that the International Bureau of WIPO will communicate with your client instead of your firm and, consequently, there may be very little time to respond to deadlines in foreign countries.

In 2009, the number of Madrid applications dropped by 16% due to the economic downturn.¹⁴ Applicants paid an average of 3,408 Swiss Francs (~ US \$3,525) in official fees for an international registration,¹⁵ and for the fifth consecutive year, China was the most designated country in applications filed under the Madrid System, followed by the Russian Federation, the U.S., Switzerland, the European Union and Japan. Last year, on average, seven Madrid member countries were designated per International Registration. U.S. applicants have been relatively cautious in taking advantage of the Madrid Protocol as reflected by the fact that no U.S. company made the 2009 top 20 list for applications filed.¹⁶

Based upon Madrid applications filed with WIPO in 2010, international trademark applications filed through the Madrid System are expected to show strong growth, increasing by a projected 11% in 2010.¹⁷

Practice Tip: Madrid Protocol filing forms can be found on <http://teas.uspto.gov/>.

Practice Tip: Use the Fee Calculator found at: <http://www.wipo.int/madrid/en/fees/calculator.jsp> to assist in calculating filing fees due based on countries selected.

Practice Tip: The European Union has joined the Madrid Protocol, thus it is possible for CTM applications to be filed via the Madrid Protocol.

Practice Tip: Certain circumstances and nuances with respect to filing under the Madrid System can jeopardize the entire international application or registration. Accordingly, it is important for the trademark applicant to be familiar with prosecuting an international application prior to initiating this process. For example, for a 5 year period, the protection afforded by an International Registration is dependent upon the issuance of a registration in the trademark owner's home country. Thus, if the home registration is cancelled for any reason during this 5 year period, all of the protection afforded by the International Registration will be invalidated. Also, if an applicant files a Madrid application and later assigns the mark to an entity (related or unrelated to the applicant) located in a non-member country, the Madrid application or registration will be invalidated.

Practice Tip: On October 1, 2010, WIPO launched a new Customer Service Center which will respond to questions and receive feedback and suggestions. The Customer Service Center can be reached by email through the "Contact Us" page on WIPO's website (www.wipo.int) or by telephone at 44-1-22-338-8787.

D. ARIPO (Africa)

The African Regional Industrial Property Organization (ARIPO) allows one regional filing covering ARIPO members,¹⁸ which are primarily comprised of

English-speaking countries. Applications can be filed with ARIPO in Harare, Zimbabwe or at a national office of a member state. See: www.aripo.org. ARIPO applications are checked for formalities and then sent to the national offices of the designated states for examination. If there are no objections, ARIPO registers the mark with effect in all designated states. While there is a single renewal, certain procedures such as oppositions, cancellations and infringements are handled by each individual country.¹⁹

E. OAPI

The African Intellectual Property Organization (OAPI) (officially, Organisation Africaine de la Propriété Intellectuelle), established a uniform trademark law applicable in the 16²⁰ French-speaking African member countries. It also established a central office in Yaoundé, Cameroon for filing trademark applications. An OAPI trademark is not subject to national trademark laws and, therefore, provides identical rights in all 16 countries. See: www.oapi.wipo.net.

F. Benelux Trademark Register

Benelux is a union formed by Belgium, the Netherlands and Luxembourg to administer a unitary trademark registry. Registration of a mark is required in order to establish rights in a trademark in these countries and is usually a relatively quick process.²¹ It is recommended that an applicant perform a search prior to applying for registration. The official register can be searched online. See: www.boip.int.

G. The Andean Community

There is no separate filing scheme or register that covers the member countries of the Andean Community.

The Andean Community includes Bolivia, Colombia, Ecuador and Peru. If a registration is owned in one country of the Andean Community, it can provide grounds to oppose a later filing in another member country. This is referred to as an Andean Opposition. The Andean Use policy allows for a trademark owner in one member country to defend itself from a third party cancellation proceeding by claiming earlier use of the mark in another member country.²²

IV. Conclusion

In a global economy, it is necessary for trademark practitioners to be familiar with searching and filing strategies for protecting trademarks abroad. The foregoing discussion provides the building blocks for developing an international trademark program. By understanding how to build an international trademark program, you can be a valuable business resource for your client.

¹ See Tom Hoffman, *How to Control International Trademark Costs Strategies Include Closer Scrutiny of Foreign Counsel Fees*, 5/17/93 Nat'l L.J. S18, (col. 1) at 2-3 (1993).

² See Jon R. Cavicchi, *Trademark Searching Tools and Strategies: Questions for the New Millennium*, 46 IDEA 649, 656-57 (2006).

³ In the U.S., *the test for infringement is whether the use of the allegedly infringing mark is "likely to cause confusion, or to cause mistake, or to deceive," 15 U.S.C. § 1114; most other countries have a similar infringement test.*

⁴ Under 15 U.S.C. § 1125(c), the owner of a famous mark "shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade

name in commerce that is likely to cause dilution by blurring or by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of economic injury.” As defined in 15 U.S.C. §1125(c)(2) (B) and (C) respectfully: “‘dilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark” and “‘dilution by tarnishment’ is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”

⁵ Examples of common law countries, which award trademark ownership to the first user of a mark, include: the United States, Singapore, Pakistan, India, Canada, Ireland, New Zealand, South Africa, and Australia.

⁶ See Karol A. Kepchar, *Selecting and Searching Trademarks, Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel* (ALI-ABA Course of Study Materials) (Oct. 2004).

⁷ 15 U.S.C. § 1127 provides that nonuse of a U.S. mark for 3 consecutive years is *prima facie* evidence of abandonment. Under 15 U.S.C. § 1064 (3) a petition to cancel a registration of a mark may be filed at any time if the registered mark has been abandoned. In most countries registrations are subject to attack if the registered trademark has not been used for a set period of time.

⁸ For example, “Patent It!” for legal services is the subject of U.S. Service Mark Registration No. 3,557,533.

⁹ 15 U.S.C. § 1125(d); also see, 15 U.S.C. § 1129.

¹⁰ WIPO press release, PR/2010/635, March 23, 2010.

¹¹ Note that Switzerland and Norway are not members of the European Union and do not participate in the Community Trademark System.

¹² This overall fee reduction is due to the elimination of the €850 registration fee in conjunction with a slight increase in the application fee. Shortly after this fee reduction was made public, the U.K. Intellectual Property Office announced up to a 15% fee reduction in its trademark fees.

¹³ Owners of an International Registration that extends protection to the U.S. must file a §71 Declaration of Use between the 5th and 6th anniversary dates of the issuance of the certification of extension of protection to the U.S. (i.e., the U.S. registration), and every 10th anniversary date thereafter. Note that these dates are usually different from the date of the International Registration.

¹⁴ WIPO press release PR/2010/634, March 18, 2010.

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ September 15, 2010 WIPO Press Conference, “Signs of Recovery Emerge After Economic Crisis Hits Innovation & IP Filings” (PR/2010/655). Available at: <http://www.wipo.int/pressroom/en/articles/archive.html?page=2>

¹⁸ The 17 member ARIPO states are: Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia, and Zimbabwe.

¹⁹ African Regional Intellectual Property Organization (ARIPO): Marks, Banjul Protocol Regulation, 24/11/1995 (26/11/1999), *Regulations for Implementing the Banjul Protocol on Marks Within the Framework of the African Regional Industrial Property Organization (ARIPO)* available at http://www.wipo.int/clea/en/text_html.jsp?lang=EN&id=68.

²⁰ The 16 OAPI member countries are: Benin, Burkina Faso, Cameroon, Central Africa, Congo, Cote d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Mali, Mauritania, Niger, Senegal, Chad, Togo. (See: African Intellectual Property Organization, History of OAPI, available at <http://www.wipo.int/wioplex/en/outline/oapi> (last updated: March 30, 2010))

²¹ International Trademark Association, Country Guides, *Benelux*, available at http://www.inta.org/apps/cgs_presentation/full_report_results/ (last updated January 2010).

²² International Trademark Association, Country Guides, *Bolivia*, available at http://www.inta.org/apps/cgs_presentation/full_report_results/ (last updated January 2010).
http://www.inta.org/index.php?option=com_simplefaq&task=display&Itemid=0&catid=284&page=1&getcontent=5#FAQ152