2020 has thrown the world for a loop: COVID-19, its implications and global consequences have been grabbing our attention like little else. While the coronavirus pandemic has caused tremendous loss and pain for people worldwide affecting our lives in ways never imagined possible, it has also had an impact on intellectual property (IP) offices around the globe. Over the past couple of months, many thousands of trademark applications related to COVID-19 and the coronavirus pandemic have been filed around the world. The most common trademark applications are for medical equipment, while others are attempting to register trademarks for games or clothing items, such as sweatshirts and hats sporting a KEEP CALM AND CORONAVIRUS ON slogan. Even though these opportunistic attempts at virus-related trademarking are in bad taste, brand protection is now more important than ever. A good trademark strategy should be in place well before disaster strikes, however.

Against this backdrop, the present Bulletin will dive into the at first glance seemingly intricate waters of trademark application and management.

We are launching our edition with a general overview on what to consider before, during and after the application process and how to steer clear of the most common problems. Our newest fact sheet on trademarks is a quick and handy guide that takes a closer look at managing trademarks, before we are approaching the subject from a slightly different angle. In the humorous, yet still informative, article “What do Zumba, Bodypump, Weight Watchers, Cards Against Humanity and the Assimil method all have in common?” you will learn what unites a dieting regimen and a rude card game.

Next, Inge Buffolo, Customer Department Director at the European Union Intellectual Property Office (EUIPO), shares with us her sizable knowledge on filing successful trademark applications. According to her, proper registration of trademarks “can make the difference between life or death in the business world”. Various tips shared by Novagraaf’s Chantal Koller in the next article on trademark management alongside best practice examples and information on the future challenges of trademarking and IP rights (IPR) round off this ‘do’s and don’ts section.

To keep up to date with the legal developments in trademark law, have a look in the following at our interview with the immediate past President of the European Communities Trademark Association (ECTA), Sozos-Christos Theodoulou, who has given us his views on the status quo of the implementation of the EU Trademark Directive.

The next part delves into an important but often neglected topic in regards to trademarks: the protection from theft of businesses’ IPRs by trademark squatters and counterfeiters. Our first article dispels the common misconception that counterfeiting is solely a problem for luxury brands, whereas, in fact, more than 30 % of small and medium-sized enterprises (SMEs) that use IPR have suffered from IPR infringement in the past. We spoke with Maya Razavi from the International Trademark Association (INTA), who leads the association’s global anticounterfeiting efforts, about major challenges and best strategies to combat counterfeiting. What else to do proactively against infringement is shown in an interview with Red Points, a company that has developed a technology-based solution for detecting and enforcing online IP infringements.

Lastly, we are broadening our scope to include trademark strategies specific to China, South-East Asia and Latin America. Our colleagues from the international IP Helpdesks provide a wealth of insightful cases and guidelines addressing trademark protection when taking your business abroad, and we just spotlight some.

Happy reading!

The European IP Helpdesk editorial team
Consumers are exposed to trademarks daily. Some brand names are so pervasive that they have become generic terms to describe all brands in a product category – think Post-its, Google and Pampers, to name but a few. Trademarks do not even need to be a word, as the Nike logo proves. The “Swoosh” is recognized globally, regardless of language or cultural background. The fact that consumers so easily associate signs with brands and companies as well as the values and attributes they stand for is their biggest advantage. This association between brand and product is not a result of chance, however. The companies behind these products have created a name and design uniquely representing their product concept, which is distinguishable from others on the market. Registering their intellectual property as trademarks has protected their assets from competitors. Proper brand management through trademarks results in a loyal consumer base. Seeing a familiar trademark instantly leads to recognition, long-term consumer preference and, ultimately, boosts sales. Thus, trademarks become the face of a business and are one of the most important factors in a company’s growth.

Protect your assets

Trademarks are one of the best-known intellectual property rights (IPR). But what distinguishes them from other IPRs, like patents or copyrights? Many things can be registered as a trademark, with names and logos (or a combination thereof) being the most common forms. A trademark can be anything that allows consumers to differentiate between the goods and services of a company and others on the market. In short, a trademark typically protects brand names and logos used for products and services, while copyrights protect an original artistic or literary work and patents protect an invention. To make it easier for customers to find products or services, domain names are often carrying the same or a very similar name to the trademark. It is imperative for businesses of any size – from small start-ups to multinational corporations – to legally protect their unique products or services from competing firms. Failing to register a trademark can otherwise result in loss of revenue, minimised market share and slow growth. A registered trademark ensures that the owner has exclusive rights to use it unless the licensor sells it or decides to share the trademark with a third party. Anyone who uses the trademark without the owner’s consent may face legal proceedings. In turn, it is important to remember that it is the trademark owner’s responsibility to ensure that their intellectual property has not been infringed on.

It is easier than you think

Overall, choosing and designing an appropriate trademark, its protection and subsequent use in advertising should be done with utmost care. Even though it may initially seem taxing to apply for trademark protection, it is well worth the time and effort. Most importantly, it is not as difficult as you may think. Our new fact sheet gives you useful insights into some trademark basics, such as a more detailed definition, before also addressing the application process. Please be aware that most countries have individual trademarking systems. Our fact sheet will, therefore, give you a general overview on how to start your application process and how to perform an availability check for your trademark. It will further counsel you on the most common pitfalls to avoid during the application process and will give you information about absolute grounds of refusal. Lastly, the fact sheet will delve deeper into the actual management aspects of trademarks and how to revoke or invalidate your trademark claims.
From the outset, this question may seem arbitrary, even a bit forced perhaps. After all, how does a card game relate to a diet programme or to a language learning method, let alone to workout classes? However, there is not much suspense here as the answer is connected to trademark law.

When talking to friends, seeing ads or going to sports classes, one thing is noticeable: Why is it possible to play Cards Against Humanity with a deck of cards labelled under a different name? Why can countless sports centres offer Bodypump or Zumba classes, but not all of them advertise it this way? Why can dozens of dieting companies offer meals and weight loss programmes that seem to copy each other indefinitely?

Generally speaking, there are many uncertainties as to what intellectual property can or cannot protect, through questions such as – How to protect a dance class programme? How to protect a card game? How to obtain exclusive rights over the contents of an innovative learning course or a diet programme?

The quick answer is that you cannot obtain any exclusive rights for these, taken as such. Indeed, intellectual property never protects ideas, methods, game rules. Allowing so would kill creativity and innovation as all ideas that the human brain can craft could then become proprietary. As a result, ideas and methods always remain free for everyone to use.

This being said, once ideas come to life in a specific way, their realisation can in certain cases be protected via intellectual property rights. For instance, an innovative technical solution itself could be protected by patents or utility models to make an idea work. Another example are the books from the series A Song of Ice and Fire, better known as the books that the hit TV series Game of Thrones is based on. These are all protected by copyright, but this cannot, should not, and most definitely will not prevent countless aspiring writers to keep writing heroic fantasy stories about throne wars and dragons.

So what is the issue at hand? Even if something bearing high commercial potential is created, it remains outside the realm of intellectual property protection as such. A diet programme is “just” a method based on eating less, eating different and counting calories. Rights such as copyright or patent will not protect it in any way. A sports class is essentially a series of moves taught by a coach who ensures that they are reproduced properly. A language learning method is simply a way of teaching how to listen, pronounce, and write. None of those aspects are protectable by intellectual property rights – or else we would need an IP Police checking every move (“you can’t jump and kick in that direction, that move is protected”), every word, and all the game nights with friends.

So what can be done when a company develops something different and valuable – and yet intellectual property does not grant exclusivity – over the diet plan, the workout routine, the fun card game rules, or the intricate language learning experience that took years to create? This is where trademarks come into play. Hence, in the following we’ll turn to a bunch of key questions in this regard.

What do Zumba, Bodypump, Weight Watchers, Cards Against Humanity and the Assimil method all have in common?

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Important Things to Consider When Applying for a Trademark

Within the intellectual property ecosystem, brands are the most directly connected to the soul of companies. Patents, designs and copyrights have a limited ‘life’ but trademarks never ‘die’, unless you do not use them or do not renew them after each 10-year period. This characteristic makes them the core of the relationship between intellectual property and the business world.

In this interview with Inge Buffolo, Director of the European Union Intellectual Property Office’s Customer Department, we will look at the benefits that trademarks bring to companies and provide some practical ‘know-how’ on filing successful trademark applications.

Why should I register my trademark?

As consumers we all know the power of brands. Our purchasing decisions are clearly influenced by trademarks and the reputation that brands represent. As consumers we all know the power of brands. Our purchasing decisions are clearly influenced by trademarks and the reputation that brands represent.

The first thing to define is the kind of mark you want.营销 experts and graphic designers can advise SMEs on what a brand should look like: it should be eye-catching, consistent, adaptable to different media and markets, easily recognisable and pronounceable in several languages. In addition to this commercial vision, we must also think about the legal and administrative requirements, which are no less important. The registration of the names or symbols of your business as trademarks is a smart decision. It protects the reputation you have built up on the quality and the core of the relationship between intellectual property and the business world.

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Another important reason for registering your trademark is to attract investors. Including information about IP assets, such as trademarks, patents or copyrights, in your business plans, will increase the possibility of securing finance. Financing institutions, business angels or banks prefer to invest their money in companies with a registered trademark that is effectively protected and enforced.

Finally there is another important advantage to registration: trademarks can work for you. Brands are valuable intangible assets: the more your business grows, the more valuable your brand becomes. By doing a financial valuation of your brand, you can, for example, obtain a bank loan using it as guarantee, or even sell or license your brand in exchange for periodic payments known as royalties.

The most common types of mark are word marks and figurative marks. In 2017, the ‘graphical representation requirement’ was removed. That means that you can register sounds, holograms or multimedia marks as trademarks. You can find information on the different kinds of marks and formats that the EUIPO accepts as EU trademarks.

Next, it is important to ensure that your mark is not descriptive.

To get your trademark registered it cannot only consist of a description of what your company sells. You cannot get a monopoly on words or signs that merely describe the goods or services that your company offer. Such descriptions should remain available for everybody. For example, the words “ice” or “creamy” cannot be trademarks for an ice cream company. An apple would not be a good trademark for a fruit shop, but as we know it makes a great trademark for computers.

The registration of the names or symbols of your business as trademarks is a smart decision. It protects the reputation you have built up on the quality and value that your customers associate with your brand. It gives you the exclusive right to use your trademark and can make the difference between life or death in the business world.

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Once you have a well-defined sign that is not descriptive, the final important factor is distinctiveness.

The customers need to understand that what they see is a trademark so it cannot be commonplace or non-distinctive. For example, simple statements like “the best” or “be happy” cannot be trademarks.

If someone else has already registered your mark for the same or similar products or services, unfortunately, it is not available.

The EUIPO offers a free trademark database, TMview, allowing you to search for similar trademarks before applying for your own. This database contains information from approximately 60 intellectual property offices from around the world, including all the EU national and regional ones, providing access to over 40 million trademarks online.

You should be proactive and search for marks that could conflict with yours. It costs nothing to search, and the information you find is crucial for your application. If someone already owns a similar trademark, they may want to oppose your application and you could lose your trademark, your time and your money. We recommend you to watch our short video on the most common mistakes made when applying for an EU trademark.

When you apply for a trademark using any of the EUIPO’s online application forms, you will be able to search and choose from a list of approved goods and services. You can use our ‘Goods and services builder’, a tool to prepare your list before applying, or TMclass that will allow you to create lists, export them to your application, download them for future use and even translate them into all EU languages.

When selecting the list goods or services for your trademark, think carefully about what you choose and get the balance right. It is important to know that once you send the application, you cannot add any new goods or services. You need to be ambitious and think about what products and services you are likely to offer in the future. If your company now sells cloth but is likely to also sell perfume in the future you should include “clothing” and “perfume” in your application. At the same time, you need to be reasonable: the cost of filing may increase with a greater number of goods/services. If you narrow down your specification, you’ll also reduce the risk of conflict with other marks.

Is my trademark available?

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Do I need a domain name?
By 2040 up to 95% of all sales will be online. As online sales increase, it seems clear that businesses today need an online presence. Your brand will be the first thing your potential customers enter into a search engine or social media platform and what they expect to find is a website. The corresponding domain name of your website should be similar to your trademark.

Again you must be careful, trademark filing is public and registers are sometimes checked by those who, in bad faith, register domain names for newly filed trademarks. This is called cybersquatting. Registering your trademark and domain name in parallel can be the solution.

With the intention of reducing the risk of cybersquatting, Europages, the registry manager of eu domains, and the EUIPO have recently strengthened their collaboration. Thanks to this, trademark applicants from the EUIPO can now easily check if an equivalent .eu domain name is available and register it if they so wish. Owners and applicants of an EU trademark can opt in to receive alerts as soon as an .eu domain name is registered that is identical to their EU trademark (application). By receiving such alerts, EU trademark holders are informed faster and may take appropriate action much sooner.

Where is my market?
Today’s competitive global economy requires a well-designed international brand strategy to help your company expand into different market places.

Trademarks rights are territorial, that means they are granted on a territorial basis. Having a trademark protection in your country, at national level, does not protect your brand in other countries. You should protect your trademarks in those countries where you are selling now and where you plan to sell in the future. Take into account that if you register and use your trademark in one country but do not register it in other territories, the day you decide to expand into those new markets someone else may have already registered your trademark there and they can prevent you from using it in that market.

However, there is the possibility to extend the boundaries of your brand through an EU trademark, valid in all the 27 EU member states, or through an international trademark registration that allows protection in up to 122 countries.

When internationalising your trademark you should think big but, at the same time, be realistic. Keep in mind that EU or international protection is not free and, therefore, before making a decision, it is essential to evaluate your future markets, the resources of your company, and the strategic position of your competitors, among others things.

How do I apply?
It is best to file your EU trademark application online. You can also do it by post or using a special courier service, but e-filing is safer and faster.

When applying for your EU trademark we recommend you use our 5 step Fast Track application form. You will be guided through the procedure step by step and in this way you will avoid making mistakes that would slow down the registration process. Before you start, make sure you have your trademark representation ready in the right format and that you have your list of goods and services clear.

During the application process you will open an account in the User Area, a free channel of communication with the EUIPO. If we detect an error or have to tell you something about your application, we will send an official communication to this User Area indicating what the issue is and how to resolve it.

What happens if I get an opposition?
If someone else has already registered an identical or similar trademark for the same or similar products or services, your trademark can be opposed, during the 3-month period following publication. If your application is opposed, you must file an answer to each of the arguments made in the notice of opposition. You can try to reach an agreement with the opponent but if this does not work out, the EUIPO will decide.

If the decision is in your favour, your trademark will proceed to registration. Once registered you have the right to oppose the registration of other identical or similar marks applied for anywhere in the EU. The EUIPO will inform you about possible conflicting new EU trademark applications. Opposition proceedings are like mini-trials and expert advice is often needed.

Who can advise me?
The responsibility of a public administration like the EUIPO is to provide EU citizens with services and tools to assist them in successfully registering their trademarks but we cannot provide legal advice on enforcing trademarks. As a trademark owner it is your responsibility to oppose others trying to register an identical or similar trademark. The EUIPO is not an enforcement agency, so we cannot provide legal advice on enforcing trademarks but we offer a free search tool for EU trademark applications and registrations called TMview where you can configure automatic watch alerts and receive a notification whenever potentially conflicting trademark applications are received at IP offices in the EU and beyond. You should also ensure nobody uses your trademark, or another confusingly similar one, in the market by monitoring the marketplace, checking the press, trade publications and the internet.

Check the EUIPO IP Enforcement Portal, intended to help enforcement authorities to recognise counterfeit goods, and consider making an application for infringement protection with your national customs authority if needed.

What happens after registration?
As a trademark owner it is your responsibility to oppose others trying to register an identical or similar trademark. The service focuses on the needs of small businesses, especially after COVID-19, ensuring that they get the advice on trademarks and other intellectual property matters they need to protect and maximise their rights, and the proper professional representation to defend those rights when challenged. If you need advice on such matters you can apply for a free one-to-one consultation here in the “Ideas Powered for Business” section of the EUIPO website. This is a pilot and the offer is limited to 500 consultations.

All SMEs registered in the EU can apply for this free, one-to-one legal advice for any question relating to intellectual property rights, both national and international, such as:

- understanding which IP rights (trademarks, patents, designs, etc.) are best for you
- preparing a trademark, patent or design application
- how to make money with your IP rights (licensing, etc.)
- resolving disputes, dealing with oppositions.
Best Practices in Trademark Management: Setting the Strategy

In the following excerpt from the white paper 'Best practices in trademark management: A practical guide' published by Novagraaf earlier this year, Chantal Koller, Managing Director – Trademarks, Novagraaf Switzerland, looks at the steps that need to be taken in order to put a trademark strategy in place to support and build your business.

Corporate approaches to IP management have varied considerably over the years, driven in part by changes to business structures and practices, as well as to stakeholder understanding of the role and value of intangible assets. While I could lead you through a long list of recommendations, of ‘do’s’ and ‘don’ts’, and of lessons learned over this time, it is arguably more valuable to look forward: to take a look at how businesses operate today and the challenges they are likely to face in the future.

We are living at a time in which wealth is driven by IP rights rather than tangible goods. Indeed, in its recent study, 'Intangible capital in global value chains', WIPO estimates that more than a third of the value of manufactured products sold around the world comes from ‘intangible capital’, such as branding, design and technology. This is twice the value of tangible capital, such as buildings and machinery, underscoring the growing role of IP in the world’s economy. Clearly, if a business wishes to thrive, locally or globally, it needs to identify, protect and export its IP.

Building a trademark strategy to support your goals

To develop a trademark management programme that is not only fit-for-purpose, but also fit-for-the-future, the following basic requirements first need to be met:

**Business alignment**
Firstly, there must be alignment with the business, and this requires stakeholders to:
- Define goals in terms both of corporate identity and product development, so that the IP strategy is, as closely as possible, in line with the company’s business plan over the coming 5-7 years
- Set priorities in terms of the material and geographical scope of anticipated business development, such as defining a top 20 of countries of interest for key brands, as well as towards competitors and their IP strategies
- Assign adequate budget
- Endorse the strategy throughout the business (the so-called ‘top-down’ approach).

Next, there should be product alignment, namely:
- Alignment with the marketing and communication team on branding elements
- Prioritisation of activity in terms of product campaigns
- Trademark protection that supports the geographic scope/market for each product
- Trademark protection that supports the evolution of the product over time.

Trademark protection is unlimited in time and not subject to secrecy. Take the time you need to define a phased-out protection strategy and registration programme.

Don’t lose sight of the other ‘soft IP’ family of rights that are also at your disposal. What cannot (or does not need to) be protected by trademarks may be protectable through other IP rights. Industrial designs, copyright, domain names should also be used to create a network of legal protection.

**Future challenges**

While it is important to identify, protect and enforce the IP rights that already exist in your business; it’s just as crucial to identify those rights that will become important in the future, even if the law often seems to be lagging some way behind when it comes to facilitating their protection.

Non-traditional trademarks are a good example of this. As services rise in importance over traditional goods/products, ways of communication naturally change. Even traditional businesses, such as banks or department stores, are calling on once unusual forms of branding, such as colours, smells and jingles, to differentiate themselves from their competitors. As a result, so-called non-traditional trademarks have risen in importance, and need to be taken into consideration when building an IP strategy.

In the luxury and the FMCG sectors, anti-counterfeiting efforts also need to be stepped up, as the trade in fake continues to explode online. If companies are to avoid spending all their time and efforts fruitlessly chasing infringers online, they need to revisit their anti-counterfeiting strategy and invest in online enforcement. Image search and data clustering tools, as well as technology to capture and track infringing information, will become key in years to come.

Geographically, three main jurisdictions should attract most companies’ attention in addition to their local markets: the People’s Republic of China, the US and the EU – keeping Brexit in mind.

For more articles on recent IP developments and hot topics take a look at Novagraaf’s “Insights”.
EU Trademark Directive: Modernising National Legislations with a Clear View to the Future

In the European Union, national and EU trademark laws have long coexisted. While several past changes in EU law have brought about a first harmonisation of trademark law in Europe, a new Directive has aimed to further intensify harmonisation and update existing trademark laws amongst EU Member States. The revised EU Trade Mark Directive 2015/2436 was required to be implemented into national law by 14 January 2019. In the following interview, the immediate past President of the European Communities Trade Mark Association (ECTA), Sozos-Christos Theodoulou, assesses the benefits of the Directive for SMEs and expounds his opinion on the status quo of trademark law in the European Union.

A little recap: key changes resulting from the Trademark Directive

From your point of view, what major changes has the Trademark Directive brought about? This question may be better answered from a national perspective. Indeed, each Member State had different legislations and practices before, so the changes are also different. Nevertheless, I believe it may be securely stated that one of the most important changes all over the EU has been the abolition of the graphical representation requirement. This opened the door to many novel types of trademarks, such as marks comprising sounds, smells, moving images, holograms and multimedia. Further, the fight against counterfeiting has been reinforced, through strengthening the provisions relating to stopping counterfeit goods in transit. Another novelty in many Member States is the introduction of certification marks. There are many other changes, but these three stand out, in my opinion.

How do brand owners benefit, especially SMEs?

If we focus on the above main changes alone, it is obvious that brand owners are now able to protect not only their traditional trademarks that existed before (word marks, device marks, combinations of the two, colour marks, etc.), but also other important marks in line with the progress of technology and new market requirements. Innovation is encouraged in this way and SMEs may benefit from relatively low costs. As for the seizure of counterfeit goods in transit, this will clearly enable brand owners to prevent illegal commerce that passes through EU territory, a fact that will by extension also provide safety and protection to the end consumers in third countries. Lastly, certification marks will allow for better quality products to circulate in the marketplace and increase the revenue of the relevant SMEs.

Do you still see shortcomings, things that could have been addressed differently? And, if so, why? Each piece of legislation presents advantages and disadvantages. If one examines the articles of the Directive one by one, it is likely that quite a few things could be improved. However, people must not forget that legal texts are the result of multiple reviews, discussions and negotiations of politicians, especially between Member States, so personally, I believe that we should be happy with what has been achieved by the new Directive. After all, the big bet is on the way Member States will apply the new Directive at a national level. And – not to forget – the EU is regularly reviewing its texts anyway, so any eventual shortcomings could be spotted in a timely manner and remedied in the near future.

Where are we today?

The deadline for EU member states to implement the Directive was 14 January 2019. However, many member states were not able to meet this deadline – why?

Although nowadays we are almost done, you are perfectly right in bringing this up, as many Member States had indeed not implemented the Directive by the prescribed deadline, but also for quite some time after that. Well, the main reason behind this fact is that, as already stated above, each country used to have different legislations and, consequently, different needs, as to what had to be changed, abolished or introduced in its own legislation. Further, the legislative review processes differ among Member States, so it can take longer for some than for others.

What is the actual state of play today?

It is not easy to follow the state of play in each Member State and even the EU Commission is trying hard to stay in the loop. Because of my geographical area of expertise, I personally know that Greece was among the last to pass a national implementing law last March and that Cyprus was the penultimate Member State to do so, only last June! Romania has been the last to recently enact its national implementing legislation.

What is your view on the transposition process? What do you think were the major challenges the individual states were/have been facing in implementing the Directive into national law?

At the end of the day, this is the most important question one has to ask! In our experience, many EU legislative texts are continuously transposed into national legislation, at a fast pace and without the necessary local consultation. Obviously, the right way to go would be for each Member State to set up specialised committees, consisting of authorities’ representatives and legal professionals, who should review the proposed texts in detail and make specific comments. These should then be debated and taken into serious consideration by the respective national Parliaments, before a final vote on adopting the law is taken. According to information from reliable channels, it would seem that a few Member States (luckily, a minority) were in a hurry to vote on their new national laws, so as to simply not face fines from the EU! In my opinion, even after the formal transposition has taken place, all Member States should review the texts, under the EU Commission’s supervision.

To sum up, the implementation of the new EU Trademark Directive must be seen as an opportunity to modernise the relevant national legislation, according to the needs of the new era and with a clear view to the future, as Intellectual Property is a field that must constantly keep up with technological progress.

Partner, The Law Offices of Dr Christos A. Theodoulou LLC, Cyprus and ECTA President from 2018–2020, Sozos-Christos Theodoulou (CY)
“As soon as an SME gains a little bit of notoriety, bad actors are waiting to steal these brands’ goodwill.”

The International Trademark Association (INTA), a global not-for-profit association of brand owners and professionals, has long promoted proper brand protection through trademarking. INTA spans 185 countries as well as all industry lines and sectors. We spoke with Maysa Razavi, who leads INTA’s global anticounterfeiting efforts, about the major obstacles of brand protection, its advantages to SMEs and start-ups and the best strategies to combat counterfeiting.

Do you have the feeling that SMEs and aspiring entrepreneurs consider IP as a business asset? Especially in the early stages of business, SMEs and entrepreneurs are often not yet considering the important role of IP in their business plan, or the value and protection it can bring to the business and brand in the long term. This opinion is backed by the EUIPO SME Scoreboard, which highlights:

1. For those SMEs without registered IP rights, the main reason for not registering was a lack of knowledge about what IP is and its benefits. The percentage giving this reason has grown from 25 percent in 2016 to 38 percent in 2019.
2. Only 25 percent of medium-sized IPR owners have professionally valued their intangible assets, and this drops to 20 percent for both small and micro-sized IPR owners.

No doubt, trademarks and related IP rights are often among the most valuable assets of a business. Moreover, a distinctive trademark allows a business to build public goodwill and brand reputation in the goods or services it sells.

Are they aware of the benefits of a sound IP strategy? Broadly speaking, SMEs are not thinking about IP as a business asset. This is especially true in the early stages of the enterprise and is likely not part of their initial strategy. With trademark rights, if you do not register and enforce your rights properly you are at risk of losing them. Often it is when these rights are in jeopardy that the business owner discovers the value of a sound IP strategy and the importance of early registration.

What do you think are the greatest challenges SMEs face when it comes to IP management in general, and brand protection in particular?

Cost is the greatest challenges to SMEs. There is a cost to registering and protecting IP rights that are not budgeted in a new business. These unforeseen costs can be financially disastrous if not addressed at the beginning of a nascent company.

What are major hurdles and obstacles for start-ups and SMEs with regard to trademark protection?

Other than cost, lack of knowledge and foresight are the most common obstacles facing start-ups and SMEs when it comes to trademark protection.

Trademarks are the foundation upon which a business and brand’s reputation is built. They should be chosen carefully. A descriptive mark or a mark similar to an existing mark can be risky and costly for a business.

With globalisation and e-commerce, today SMEs can grow rapidly into new markets, and they can do so without registering or enforcing their IP rights in the new jurisdictions they’re operating in. This can be quite grave to the business. This can be avoided with an IP strategy in place from the start.

Business owners also do not realise how clever trademark squatters and counterfeiters are at following businesses or how quickly they will act. As soon as an SME gains a little bit of notoriety, bad actors unfortunately are waiting to steal these brands’ goodwill.

What are essential steps SMEs or start-ups should take if they want to ensure brand protection?

Brand protection begins with early IP registration in a company’s target markets. Registration of marks in any country which an SME intends to expand into is crucial.

It is advisable to work with an IP attorney to get your IP registered and to develop a broader IP strategy for your organization.

The EUIPO SME Scoreboard boasts benefits to registering IP rights: 54 percent of owners claimed to have seen a positive impact, such as increase in reputation (52 percent), turnover (39 percent) and ability to access new markets (37 percent).

After registering a trademark, it must be enforced. This includes recording the mark with customs and acting quickly with the help of a brand protection professional when you discover any infringements or counterfeiting.

What impact does counterfeiting have on micro as well as small and medium-sized businesses?

It’s a misconception that counterfeiting is limited to major brands and large corporations. Given limited resources and experience, an SME often finds that its products and trademarks are being targeted by counterfeiters before the brand owner even begins the process of establishing its IP rights. This can ruin the SME’s entry into the global market before it has even begun. The EUIPO reports that 31 percent of SMEs with registered IP suffered from infringement, and that micro SMEs feel the negative impact of infringement more than larger SMEs.
What are major struggles, but perhaps also misconceptions, related to counterfeiting on the side of SMEs?

Due to the prevalence of counterfeiting, perhaps the greatest misconception about counterfeiting is that it is a problem only for luxury brands. The reality is that every type of good can be counterfeited, and criminal organisations will exploit any brand that they can. For example, counterfeiters were quick to take advantage of the COVID-19 pandemic to produce fake equipment and medicines, which are currently rampant in the market.

Protecting marks from counterfeiters can be quite costly and time consuming, and this can be a major challenge for an SME focused on establishing its product and bringing it to market. Brands need a good strategy in place, especially since counterfeiters can exploit reputable e-commerce sites to sell their counterfeit goods anonymously to unsuspecting customers.

What would you recommend businesses, which face trademark or product counterfeiting, to do?

Since the cost of brand protection is a significant barrier for many SMEs, they should proactively allocate a dedicated budget for trademark enforcement. It is advisable to take any of the earnings from successful counterfeit cases and reinvest it into this budget.

What kind of support measures do you think are needed to help SMEs to better combat IP infringement and abuse?

SME owners or other representatives should speak to peers at SMEs in the same industry and other industries to help develop brand protection strategies. Advice about effective counsel, investigators, and service providers is invaluable. If counterfeiting becomes an issue for the SME, develop an overall, and if appropriate – global strategy to tackle counterfeiting, including online counterfeiting. Counterfeits are often sold directly to consumers, thanks in part to the ease of buying and selling goods on the Internet. Many big brands that have big anti-counterfeiting budgets struggle to enforce their marks online. Shutting down standalone websites and navigating platform policies is often just not feasible. The help of skilled brand protection professionals and service providers is invaluable for developing an anticounterfeiting roadmap.

What initiatives do already exist to support SMEs, specifically about counterfeiting?

Information provided by governments in this area is invaluable. The European IP Helpdesk is a great example; the 4P Council has stellar resources for SMEs. IP attaches, law enforcement, and IP offices have many programs to help SMEs thrive and efficaciously protect their brands. Finally, INTA has many fact sheets and educational information available for members and non-members on its website.

How can SMEs best prepare and protect themselves?

1. Retain counsel in every jurisdiction that an SME plans to market its product well before launch.
2. Develop a brand strategy to include protecting your brands – starting with marketing of the products and involve consumers.
3. Distinguish the brand by including a product’s unique and identifiable features on the product that are difficult to reproduce.
4. Set up a system to receive and respond to consumers’ reports of counterfeiting activity.
5. Monitor the brand online with a service if cost-effective.
6. Keep detailed records of possible counterfeiters and make sure to act when needed.
7. Educate distributors and sales teams about how to identify fakes (keeping in mind that these are trade secrets).
8. Train customs officials and local enforcement on how to identify fakes. Follow up on inquiries from law enforcement and develop these relationships.
9. Include IP protection clauses in all contracts for business relationships, including those with manufacturers.

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Red Points: Making the Internet a Safer Place for Brands and Consumers

Red Points is the world’s first Brand Intelligence platform. By combining online brand protection, copyright enforcement and distributor monitoring capabilities, Red Points gives its clients full visibility into their brands’ presence online. Over 700 brands rely on Red Points to fight fakes, piracy and distribution abuse online, allowing them to maintain control, improve their brand value and increase revenues.

With offices in Barcelona, Beijing, New York and Salt Lake City, the company serves leading global brands as well as smaller innovators across a variety of sectors, from sports, cosmetics, fashion, entertainment and many more.

The key to the team’s success is their investment in technology and product to make their solution intuitive, effective and easy to use. By leveraging automation and artificial intelligence, Red Points’ technology enforces intellectual property (IP) rights and removes issues from global online marketplaces with great speed and at scale.

We spoke with Laura Urquizu, CEO and chairperson at Red Points to learn a little bit more about the company’s journey and the challenges of brand protection in a digital world.

Laura Urquizu joined Red Points in 2014 as CEO and Partner. In the past 6 years, Laura has driven the company’s new business model forward, transforming it into a globally renowned “Software as a Service” (SaaS) solution. Following her vision, Red Points has developed its business model to serve global enterprises of all types in online brand protection, digital piracy, counterfeiting, grey market and other online infractions.

The Story of Red Points

What is Red Points and how does it work exactly?

Red Points offers an all-in-one SaaS solution for detecting and enforcing online IP infringements, including online counterfeiting, piracy and distribution fraud. Red Points’ proprietary software currently removes more than hundreds of thousands of incidents of illegal products and content from the web monthly.

Brand Intelligence is a holistic approach to brand protection to offer brands a 360° look at their brand exposure and turn this data into actionable pieces of information to inform their IP strategy.

Red Points’ Brand Intelligence platform utilises artificial intelligence that continuously connects a targeted web crawler to a rule-based rights management database that learns from each account’s history and improves the quality of protection over time. With the help of machine learning tools, such as keyword generation and image recognition, we are able to process the information retrieved across many thousands of online marketplaces, websites and social networks to detect fakes, piracy or sellers online and allow our customers to take enforcement actions.

Hence, we offer different kinds of protection to help brands address the following issues online:

**Counterfeit:** A product that depicts your trademark, displayed in an offer-listing that contains sufficient information for you to believe or suspect that the good is not original or is trying to pass off as one of your original products.

**Replica:** A product that does not depict your trademark, potentially infringing on the claims of your patent as per the form of a prominent keyword. However, the product on offer is not branded, or it is a good from another brand. This is done with the intention to mislead or redirect people, rather than to pass it off as an offer from a genuine brand.

**Copyright Abuse:** An offer-listing that contains your copyrighted work within the listing (photos or text) to sell a counterfeit product.

**Brand Abuse:** An offer-listing that contains your trademark in either the title or description of the listing in the form of a prominent keyword. However, the product on offer is not branded, or it is a good from another brand. This is done with the intention to mislead or redirect people, rather than to pass it off as an offer from a genuine brand.

How did you come up with the idea? What challenges did you face as a start-up?

The company was founded in 2011 by an IP lawyer. Initially, the company’s vision was focused on copyright protection. However, 6 years ago, when I joined Red Points as the CEO, the company underwent a massive transformation and pivoted to expand our brand protection remit and shifted to our current SaaS model.

As a fast-growing company, we put a lot of pressure on ourselves to grow fast and release new features at the speed of light. However, this can often be a big mistake if not executed well. We truly believe it is key to first ensure that whatever you put on the market is aligned with your main vision; in our case that is to protect brands against IP infringements in order to make e-commerce safer.

Copyright Abuse

**What do you think are major challenges with regard to brand protection, piracy and counterfeiting in general?**

The IP protection landscape has undergone a lot of changes in recent years in part due to the rise in popularity of e-commerce sites, whilst copying techniques have also improved so much that some counterfeits now look just like the originals. The truth of the matter is that online sales make fakes even harder to spot.

In order to address this growing issue, our Brand Intelligence platform utilises artificial intelligence that continuously monitors online marketplaces, social media and other websites, connecting that data with...
our rule-based rights management database that learns from each account’s history to highlight only the most important potential incidents to right owners.

What are the main “pain points” for clients when dealing with these and IP/trademark issues, especially for SMEs?

Many companies can often spend a considerable amount of time and legal fees trying to sue all the counterfeiters selling their products illegally. However, in most cases, favouring a mitigation approach is often the best solution when it comes to combating counterfeit online. Once you know which IP is in need of protection, you can start the process of enforcement by gathering all the evidence which will be used for the final report. In the long term, this process is not only less costly but also more effective because online counterfeiters are always looking for ways to evade your efforts of protecting your brand, and limitations are usually too slow to be considered an efficient way of counter-arresting them.

Registering your IP is crucial for brands. This might be a no-brainer for big organisations that most certainly have a dedicated team of in-house lawyers in charge of online protection. However, SMEs can tend to overlook this very important step. The work protected by copyright includes anything from literary works to musical works or motion pictures and other audio-visual works and sound recordings. Registering your IP is the best way to ensure your work is protected against any potential infringements.

Why Red Points?

What is the added value/benefit you provide to your clients, could you give us a practical example or a “success story”?

Red Points’ technology helps clients fight against counterfeiters and illegal distribution online, but we also provide them with added value to help them grow their business online. This includes:

• **Safeguard reputation.** To build a brand is not an easy job. It takes time and effort. When consumers unknowingly buy counterfeiters online and realise it is not a genuine product, they blame it on brands. In many cases, unhappy consumers can be very vocal and post negative comments on social media or bad reviews on marketplaces or Google among others. By taking down all the counterfeits online, we are helping brands to preserve the reputation they worked so hard to build.

• **Increase in trust.** Trust is directly linked to reputation. If consumers see bad reviews online, they will probably not risk it and instead choose another brand that offers a similar product. This can also affect the relationship between the brand and its partners, as cheap fake products online create unfair competition for their distributors.

• **Increase in revenue.** Finally, the increase in revenue is also related to the values mentioned above. If our clients gain back the trust of their consumers by deleting all the fakes on the Internet, their sales will also increase. As a matter of fact, Lekué, one of our clients from Spain, explained that since they implemented Red Points a year ago, the online sales of their best sellers have increased by 60%.

Another more recent example is the case of FOREO, a Swedish cosmetic brand. They started seeing counterfeits online some years ago. After having done all the anti-counterfeiting work manually for over a month, they realised that it was neither time- nor cost-efficient going through all the listings themselves. Therefore, they started searching for third party suppliers who could offer a more scalable solution to online brand protection.

Since using Red Points, FOREO has managed to take down 22,000 listings and more than 2.5MS worth of counterfeits has been removed. Furthermore, they managed to increase customer trust as a result.

When or at what stage should a company seek out your services?

It is never too early for a business to consider a brand protection strategy. If your product is online, it can get pirated very easily even if you are crowdfunding for it.

One of our clients, furniture designer and CEO David Trubridge, went to the Hong Kong Lighting Fair in 2014 and while walking down the aisles to have a look at other exhibitors’ work, discovered that another company was exhibiting the same products as them.

There are many more horror stories of SMEs who, because of their relatively small size and scale, failed to protect their invention and got beaten to the punch by Chinese manufacturers.

In fact, one of our very own clients, Food Huggers, discovered counterfeits of their products during their Kickstarter campaign before they had even entered product development.

However, unless business owners start putting brand protection at the top of their agenda, counterfeiters will continue to exploit loopholes in the system to reap the benefits of other people’s inventions.

Looking Ahead

What are your plans for the future?

The brand protection ecosystem has undergone a real transformation over the past decade with new entrants challenging incumbents by offering new disruptive and scalable technological solutions. This has led to the intensification of the global race for the leadership of the brand protection industry. However, many companies lack the technology to effectively process and automate large amounts of data.

Ultimately, the speed at which online infringers have been moving has put a lot of pressure on the industry not only to use the most advanced information technology to collect as much data as possible but also to quickly process and understand them to offer real insights and predictions to clients on a single all-encompassing platform. This is something we have been able to deliver with our unique Brand Intelligence platform.

In the future, we will continue to develop our market-leading Brand Intelligence platform, adding new features and functionality to meet our clients’ growing needs and stay ahead of counterfeiters and pirates.

When did the idea of the Red Points Academy and training programme come up? What was the reason?

Businesses on the Internet are becoming more and more niche-oriented, allowing smaller companies to thrive in this environment. However, counterfeiters constantly keep an eye on those success stories, too. There’s a real need for well-trained professionals who will cover the needs of the thousands of brands, which are conquering the online space without the correct professional guidance regarding online brand protection. Red Points Academy brings innovation and collaboration to this sector, which are important traits embedded in our DNA.

Educational initiatives like these are an obligation for companies like ours. Red Points is on the frontier of technology development for IP protection, so it is important that we share insights we have been able to obtain thanks to our brand protection solution.

www.redpoints.com
International Trademark Protection

When it comes to protecting your trademarks outside the EU, registration procedures, requirements and databases differ from country to country. Our colleagues from the International IPR SME Helpdesks offer a variety of supporting material providing you with insights into the registration procedures and specifications of China, South-East Asia and Latin America. Take a look at the following guides and SME case studies focusing on international trademark protection.

Overview: Trademarks in Latin America in a Nutshell

Check out this useful collection of the most relevant information on trademark registration in Latin American countries. While providing core information for each country at a glance, it also includes links to more detailed guides for each country.

Guide: International Trademark Protection through the Madrid System

The 'Madrid System' for the international registration of trademarks is a cost-effective solution for registering trademarks worldwide. The three International IPR SME Helpdesks have teamed up for this guide providing useful background information on the Madrid System as well as IP management best practice related to international trademark protection.

Case Study: Trademark Opposition Procedure in Argentina

This recent case from the Latin America IPR SME Helpdesk reflects on IP considerations for an EU SME when expanding their business to Latin America. Being well aware of the importance of IP protection, the SME decided to expand their business to Argentina and register the company’s name and logo as well as the name of their star product as trademarks. Four months later, they were informed that their mark had already been registered in Argentina before.

Case Study: Expanding Your Online Business to Chile

After the successful launch of their cloud-based innovation in Europe, a German SME takes their product to Chile. Despite properly protecting their invention through the appropriate trademark, patent and copyright application, they were affected by a trademark infringement through an unauthorised plugin developed by one of their users.

Case Study: Trademark Registration in Thailand and South-East Asia in the Automotive Industry

Textra Automotive ("Textra") is a medium-sized European company known for producing high-tech sensors for cars. After an extensive market study, Textra decides to enter the ASEAN market, and pursue sales of the products in Indonesia, Malaysia, Vietnam and the Philippines. It applies for trademark registration in Thailand, with a plan to register the same mark in the other four countries, claiming priority from the Thailand application. However, Textra discovers that the trademark had already been registered by another company. Based on Textra’s example the case study spotlights the challenges companies may face when registering trademarks in South-East Asian countries.

Case Study: Trademark Registration in South-East Asia

Given the increasing prominence and attractiveness of the South-East Asian market, trademark owners should give these countries serious consideration, even if they do not have immediate plans to expand into the region. This case study involving a Chinese trademark squatter, a German electronics company and goods seized at Chinese customs, emphasises why SMEs need to register their trademarks in China even if they are not selling their goods on the Chinese market.

Case Study: Trademarks Recordals in China

An established German electronics company had been manufacturing their product in China for years until, suddenly, they were contacted by Chinese customs telling them that a shipment of their goods from China had been detained and was suspected of infringing trademark rights. This case study involving a Chinese trademark squatter, a German electronics company and goods seized at Chinese customs, emphasises why SMEs need to register their trademarks in China even if they are not selling their goods on the Chinese market.

Guide to Trademark Protection in South-East Asia

Given the increasing prominence and attractiveness of the South-East Asian market, trademark owners should give these countries serious consideration, even if they do not have immediate plans to expand into the region. This guide provides an overview on trademark protection in South-East Asia, with a special focus on offering country-by-country details as well as web links for additional information.
Update from the Team

Extended Online Training Schedule & Newcomers
With the corona virus pandemic turning our world upside down, COVID-19 has also affected our on-site training schedule. In order to make up for this and provide you with some fresh IP insights, we doubled all IP training web sessions in the first half of 2020. Additionally, we have added some new topics to our online training portfolio which also reflect concrete demands of our user community. Our “newcomers” included webinars on IPR & software as well as on IP management in digitalisation and ICT projects. Reacting to the current situation, we provided a specific training session featuring recent examples of successfully implemented IP strategies in the field of biotechnology and potential short-cut avenues of admission useful for businesses and research teams involved in the fight against the coronavirus outbreak.

New Case Study: Freedom to Operate
Many sports, but also many work environments require protective clothing to prevent athletes or workers from severe injuries. However, due to the rigidity of the material often used for this kind of clothing, it can be rather uncomfortable to wear. This is what made Richard Palmer and Philip Green, both material scientists at the University Hertfordshire/UK and passionate snowboarders in their free time, think about developing a new material that would be flexible but stiffen on impact.

Our latest case study highlights the importance of Freedom-to-Operate analyses by spotlighting Palmer’s and Green’s journey in developing and patenting this new material, which took a sudden and unexpected turn, when they found out that their initial invention had already been patented by someone else. But it also tells the story of how, in the end, this shock prompted them to come up with an even better invention that laid the foundation for a very successful company.

Guide on IP Management in International Business
Taking your business international can be quite challenging and may entail a number of risks, especially for Small and Medium-sized Enterprises (SMEs). It may be intimidating to properly address all relevant financial and regulatory aspects linked to such a step, while at the same time reaching out to potential business partners abroad. Therefore, before venturing into foreign markets, make sure to protect the IP assets such as patents, know-how, trademarks or designs that are at the core of your company.

Our guide “IP Management in International Business” intends to outline the basic steps you should take in terms of IP management, before expanding your business abroad.
Although the European IP Helpdesk, too, had to react to the pandemic and work from home, our Helpline team has continued their work throughout this unprecedented time. If you are looking for someone to address your questions on the protection and management of IP, get in touch with our experts for individual support in your IP matters.

Interactive Guide: 4 Reasons 4 Trademarks
Organisations rely on trademarks to distinguish themselves from their competitors, to create an association between their trademarks and product quality, and to build their reputation and consumer loyalty. Once again, we have teamed up with 4iP Council, a European not-for-profit dedicated to developing high-quality academic insight and empirical evidence on topics related to IP and innovation to develop a new interactive guide. As it fits in nicely with the overall topic of this Bulletin, we invite you to take a look at the interactive guide “4 Reasons 4 Trademarks” designed to help innovative European businesses to understand the strategic value of trademarks as an intellectual property tool.

Take a look at the series of interactive guides and the complete IP support portfolio provided by 4iP Council.

Continuous Support in COVID-19 Crisis: Our Helpline

Although the European IP Helpdesk, too, had to react to the pandemic and work from home, our Helpline team has continued their work throughout this unprecedented time. If you are looking for someone to address with

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The European IP Helpdesk Bulletin

The Bulletin is published twice a year with the second issue dealing with “Go-to-Market Strategies” at the end of this year. All issues can be found in our library on the European IP Helpdesk website.

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