

Protecting Trademarks Outside the US

IF YOU HAVE QUESTIONS REGARDING THIS MATTER, PLEASE CONTACT:



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People are consumers. Consumers make buying decisions by looking for and recognizing trademarks. Consumers in most major countries are continually barraged by trademarks in stores, on the TV, on billboards and in many other ways. Accordingly, with all of this exposure, consumers should be experts on trademarks. Unfortunately, just the opposite is true.

There are many misconceptions about how to obtain trademark rights here in the US; but there are even more misconceptions about how to obtain trademark rights outside of this country. Many believe that once a business establishes rights to a trademark here in the US, these rights somehow magically work their way around the world. Others believe that once one registers a trademark here in the US, the US trademark registration automatically covers Canada and Mexico. Some even believe that a US trademark registration provides the right to use the registered trademark worldwide. These folks are often shocked to learn that multiple applications must be filed to obtain trademark registrations around the world.

Those who understand that multiple trademark registration applications must be filed around the world, are often surprised to learn that the listing of a trademark on a trademark register may be granted in one country and refused in another.

Here are some things that those who expect to spread their brand from the US to other countries need to know.

File for a trademark registration in a country outside the US as soon as that country is identified as a potential market for the new product. Being first to apply for a trademark registration in countries outside is key to obtaining rights to a particular trademark.

Expect the trademark registration process outside the US to take a long time. The registration of a trademark in most countries is a quasi-adversarial process where the initial application to add a new trademark to a register of trademarks will be refused and local counsel must be obtained to obtain the desired trademark registration.

Expect the trademark registration process outside the US to be expensive. Many countries outside the US understand the tremendous power of trademarks in attracting consumers to choose a particular product. Accordingly, these countries have continued to increase the cost of registering trademarks to obtain large revenues.

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Anticipate that prior similar registrations for trademarks not in use, will be cited against an application to register a new trademark. While the US bases trademark rights on use of a trademark, many other countries around the world do not.

While there are international treaties for the registration of trademarks in multiple countries, these treaties are not particularly advantageous to US businesses; accordingly, most US businesses do not use these treaties.

Mis-appropriation of another's trademark or trademark infringement in countries outside the US is not always handled as it is in the US. That is, a trademark owner may not be able to bring a lawsuit; but, instead a trademark owner will have to rely on a governmental agency to remedy a trademark infringement matter.

Bottom line is that plans to expand a business to other countries outside the US should be lead by a plan to obtain the necessary trademark rights. Such a plan should include searching to determine if the desired trademark rights are available and a plan to determine what marks are to be registered in what countries for what goods/services. Because the execution of such a plan can be expensive, many businesses have found that it best to execute an international trademark registration plan in stages, beginning with the most important goods/services in the most important countries.

Because of the importance of trademarks to the success of a business venture, businesses with international expansion plans are advised to consult a trademark professional to assure that proper protection is obtained where needed.

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PAGE 2 OF 2