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A fortnightly column featuring commentary on branding topics in the field.



Protecting Your Trademark Far from Home

by Cassiano Golos Teixeira

The power of a brand in the market is directly related to the legal protection of the trademark. Therefore, any company that desires to be competitive and maintain or improve its own image in the market must adopt an international intellectual property (IP) strategy in order to have a strong trademark.

There are uncountable cases of companies that, before launching a product or even the name, do not make a deep clearance of their trademarks, identifying earlier trademarks that may be confusingly

similar. So far, there are even more cases of companies that, after the clearance, forget that a strong trademark must not only be new and distinct, but must also be maintained so worldwide. Many times the consequences of not having an effective IP strategy only arises when the first shipment of goods to a foreign country is blocked in the alien port due to the existence of a similar registered trademark by a competitor. The problem is that covering foreign trademark regions may be costly, and, many times, impossible.

One would say that the best international strategy is to file trademark applications in all countries immediately, before any deal. But is this worthwhile? Indeed, notwithstanding the legal advantages of such an option, in most cases this is a utopian idea, especially for small- and medium-sized enterprises or for low gross profit products of large enterprises, which simply don't have the resources to acquire full trademark worldwide.

Many countries have means in their legislation to avoid unfair registrations. For instance, the Brazilian Industrial Property Law of 1996 provides that every person who, in good faith on the priority or filing date, has been using an identical or similar mark in Brazil for at least six months to distinguish or certify an identical, similar or alike product or service shall have the right of preference for the registration. In other words, a person who has been using a trademark in Brazil for at least six months has priority registration if there should enter a competing, similar mark (not yet registered) on the market.

Although, if it is not easy to enforce a prior used trademark by such legal means, it would be even harder or impossible if the prior user does not know that a further application has been filed.

Another point: Even if you have an application or a registered trademark, you must be proactive, enforcing it against other applications or counterfeiters. But if you don't know what your potential competitors or counterfeiters are doing worldwide, what can you do? Nothing—just lose your corporate identity among uncountable similar trademarks.


But do not forget: In some countries (for example, Switzerland, which is not a party to the European Community Trademark system), there prevails a first-to-file system where the protection for prior users is very restricted.

Therefore, in the determination of the intellectual property strategy of a trademark, it is very important to consider many factors, such as the intended lifecycle of the brand, potential

consumer markets, and potential producers' and counterfeiters' countries, among others. Choose the strategy that best fits your business plan budget.

In this manner, the best practice that should be included in all strategies would be: Watch out!

[26-Sep-2005]

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