

SPECIAL SECTION: EUROPEAN UNION

# Managing Your Foreign Trademarks

*Big ideas for small budgets*

**By Cindy Johnson Walden / Fish & Richardson**

**T**oday's increasingly global marketplace – combined with limited budgets – makes it more important than ever for companies to think strategically about the development and management of their international trademark portfolios. This means making smart business decisions about which marks to adopt, where to register them, and how and when to prioritize enforcement on a worldwide basis. Pay attention to these key issues when managing a global trademark portfolio.

### **Develop Internal Protocols**

An important first step is to establish internal protocols for the selection, adoption and use of trademarks to ensure focused efforts and the efficient use of resources.

### **Register in Many Locations**

Since trademark rights are jurisdictional and rights flow from registration in most countries outside the United States, it is important to proactively register trademarks in the countries

where your company is currently doing business (including where you are manufacturing) as well as where you plan to do business in the next few years. Filing in countries where trademark counterfeiting and piracy are rampant can also be a smart investment compared with the potentially significant expense of having someone else register your mark and then hold it hostage, or the uphill battle of attempting to enforce your trademark when local laws do not provide the basis for a successful claim without a registration.

### **Protect Local Languages**

Register local language (e.g., Katakana, Kanji, Arabic, Cyrillic) versions of trademarks in non-English speaking countries, as local consumers will inevitably develop and use a local language equivalent for trademarks in the marketplace.

### **Use Appropriate Marking**

Consult with local counsel regarding the use of appropriate legal notice marking for your trademarks to ensure compliance with local regulations.

### **Add Appropriate Provisions**

All license and distribution agreements should include clear provisions that acknowledge trademark ownership and prohibit registration of company trademarks (including domain

names incorporating the trademarks) by distributors and licensees. These agreements should also include provisions about the authorized use of the trademarks, and this use should be monitored.

*Think strategically about what marks your company adopts.*

### **Don't Forget Recordal of Licenses**

In many countries, recordal of trademark licenses is required in order to be able to rely on the use of your trademark by a licensee in an infringement proceeding. Consult with local counsel on this issue.

### **Register With Customs**

Enlist the help of local customs departments to identify and seize counterfeit products by recording your trademarks with customs in the jurisdictions where you do business. In the European Union, it is possible to secure an EU-wide registration that enables customs officials in all EU countries to seize counterfeit products.

By proactively focusing on the key steps outlined, you will best position your company in protecting its valuable trademark assets. Investing the time and effort to do this up front will pay dividends in the long run as it will ensure that your company is thinking strategically about what marks it is adopting, is taking steps to register marks in jurisdictions that are important to the business and is establishing the best brand positioning for the company to deal with challenging infringement issues.



**Cindy Johnson Walden**  
*A principal and practice group leader of the Trademark and Copyright group at Fish & Richardson in Boston.*  
walden@fr.com