

How to protect your trademark smartly

by Rasha Al Ardah - r.alardah@tamimi.com - Dubai International Financial Centre

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The Dubai Government has recently announced a project to transform Dubai into a “Smart City”, linking the emirate’s government services and the public through the use of smart devices accessed freely using high-speed wireless internet connections. This initiative has been the talk of the city for the past couple of weeks.

Such initiatives seek to exploit the fact that smart electronic devices are a part of our everyday lives, and many companies are now creating and launching their own applications to expand their accessibility to consumers. An Application or also known as an “App” is essentially a software programme developed for smart devices (phones or tablets).

It is a common trend that companies are now providing their services and even products through mobile applications. However, with this new selling tool companies are faced with new challenges as to their trademark protection and enforcement strategies. In this article we are going to highlight the basic steps to be undertaken when protecting and enforcing trademarks in the smart environment.

1. Expand protection of trademarks to cover additional Classes

Although many brand owners have protection for their trademarks under the specific Classes covering their services or products; brand owners are now required to also expand their protection to cover the services provided through applications as well.

The protection of a trademark depends on the classes under which the trademark is registered. According to the Nice Classification (an international standard for the classification of goods and services), there are 45 Classes which cover almost all goods and services that can be offered. Usually when considering registering a trademark, the Classes of protection are decided based on the primary product or service the mark will be used for and any other relevant Classes.

It is important to consider the expansion of the protection of trademarks to cover Classes related to computer software and associated services, even if a company is not providing such services, as this is necessary to have protection for the App.

In addition, a company may offer additional services through its App which were not previously provided. In such cases new protection for such services should be considered. The services provided through an App shall be carefully reviewed to determine the proper protection to be sought.

2. Consider protection of the App icon logo

Another issue to be taken into consideration is the protection of the App icon that will show in the application store or on the device desktop. Companies can create new logos as App icons, and these logos should be reviewed and proper trademark protection shall be made.

3. Conduct clearances if using a new name for an App

In some instances companies may choose to use a new name for their App, which has not been used before. In such instances, and before using this new name for the App, the usual process for

trademark clearances shall be made for the application name.

The clearance would include official searches at Trademark Registry to ensure that the name is available for use and does not infringe third parties rights. If the name was cleared an application to register the name as a trademark shall be made to cover the relevant services.

4. Amend the enforcement strategy to include App stores

Obtaining the proper trademark protection for the App name and logo is of no value if the trademark rights are not enforced properly. Enforcement of a trademark right means preventing third parties from using your trademark without authorization or improperly, as such use may cause damage to the trademark value and image, and can even result in you losing the trademark.

As usual practice enforcement strategies require trademark owners to monitor their trademarks to ensure that identical and/ or similar trademarks are not used by third parties. As a monitoring tool trademark owners may use 'watch notices', which is the term used for the process of essentially monitoring the publication pages of trademarks published in the local Trademark Journal, monitoring domain names and websites, and monitoring the market and the activities taking place.

Therefore, it is recommended that trademark owners amend their enforcement strategy to include App stores within their monitoring programs, so as to ensure that their trademarks are not being used by third parties through Apps. In case a potential infringement of a trademark is discovered through an App, action should be taken against such infringement as it may affect the overall brand of the company.

Conclusion

In conclusion, a careful review of the current trademark protection is required to ensure it is adequate to the business plans in the smart environment and covers the existence of the brand through application. In addition, it is crucial for brand owners to revise their trademark protection and enforcement strategies to reflect these changing times.