

Trademark Protection: Key Considerations

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Trademark is a distinctive sign which identifies certain goods or services being produced or provided by a specific person or enterprise. Over the years these marks have evolved into today's system of trademark registration and protection. The system helps consumers to identify and purchase a product or service because of its nature and quality, indicated by its unique trademark which meets their needs. A trademark provides protection to the owner of the mark by ensuring the exclusive right to use it to identify goods or services, or to authorize another to use it in return for payment. The period of protection varies, but a trademark can be renewed indefinitely beyond the initial time limit upon payment of additional fees. Trademark protection is enforced by the courts, which in most systems have the authority to block trademark infringement.

In a larger sense, trademarks promote initiative and enterprise worldwide by rewarding the owners of trademarks with recognition and financial profit. Trademark protection also hinders the efforts of unfair competitors, such as counterfeiters, to use similar distinctive signs to market inferior or different products or services. The system enables people with skill and enterprise to produce and market goods and services in the fairest possible conditions, thereby facilitating international trade.

In light of the above, we consider the key standard procedures that trademark owners and marketing teams need to observe can be neatly categorised as “Select, Clear, Register, Enforce and Monitor” (SCREM). Adhering to SCREM (more fully explored below) will assist trademark owners and marketing teams to obtain rights, use and own their trademarks safely. We consider the components more fully below:

Select: Trademark should be carefully selected to represent fancy, arbitrary or suggestive terms. Always try to avoid selecting generic terms. It is not recommended to select overly descriptive terms as this will require tremendous effort from the owner to enjoy exclusivity and build its goodwill. We therefore advise brand owners to choose a distinctive mark using fancy, arbitrary or suggestive terms as it has a greater level of legal protection. Generic or descriptive marks on the other hand may not acquire proper trademark protection. For example, generic terms can not be exclusively owned by brand owners or trademark users and any investment in using generic terms will ultimately be a very risky one for brand owners. Descriptive marks are arguably capable of protection only after acquiring of secondary meaning and we consider such marks as constituting a risky investment for brand owners on the basis that acquiring secondary meaning requires substantial investment.

Clear: It is important to conduct a trademark search prior to launching a new brand. Trademark search helps eliminate conflicts with prior applications / registrations. The clearance should be ideally done in public records by conducting official searches at the trademark registry in addition to search for prior use rights. It is recommended also to clear the mark with pre-existing trade names at with applicable companies' registries. Its noted that companies' registries are not linked or cross checked with the applicable trademark registry which can cause practical difficulties.

Register: Once the clearance is completed, the registration process should be completed to prove and

obtain ownership. The trademark registry should examine the trademark application and issue a decision of acceptance if the mark is found eligible for registration and does not contradict with pre-existing rights. Valid registration should be acquired and maintained by renewing the trademarks on a timely basis.

Enforce: Publications of trademarks should be monitored in applicable trademark journals, domain names and websites as any infringement by third party should not be tolerated. Enforcement measures should be taken with law enforcement agencies or via court proceedings which will ensure continuity of ownership, maintain the trademark legal and economical equity, protect consumers' interest and most importantly strengthen the trust in the quality of goods and/or services for which the trademark is being used.

Monitor: It is prudent to deploy designated market research personnel who are responsible for monitoring the market, advertising and marketing activities. It is essential to keep monitoring the market and spot any attempts by third party who intend to capitalize or free ride on the trademark. This can be accomplished by participating in well regarded watch services programs which spot and report any conflicting usage of trademark and take necessary measures to screen the existing and potential markets for the trademark owner.

In nutshell, in our view SCREM procedures should always be considered and adhered by trademark to ensure the investment made in this important equity and intangible asset is properly built, protected and ultimately owned with mitigated risk.

Al Tamimi & Company's Intellectual Property practice regularly advises companies on their IP requirements practices in the region. For further information please contact Munir Suboh (m.suboh@tamimi.com).