Challenges and Issues Affecting the Use and Protection of Trademarks by SMEs

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Turning challenges into opportunities

1. Creation
2. Protection
3. Using / TM management
4. Creating a brand
5. Commercialize
6. Enforcing
Why a cotton shirt can be bought for €10 in a market and for €100 in a boutique? Both are produced by same manufacturer in Cambodia ...

Answer:

BRANDING
First challenge/opportunity: CREATION

Compliance with:

- Legal requirements

- Marketing considerations
Marketing Considerations

a) The big «easy» to read, write, spell, pronounce ... remember
b) The big idea (why are you different / better?)
c) Colour/s
d) Font
e) Language (must match the prod., the customers, your brand)
f) Interesting forms
g) Suitable for all types of media
h) No undesired connotations in any relevant country
i) Personality
Distinctiveness

- NOT conflict with prior signs / «Novelty»

- NOT Misleading, Descriptive, Generic Contrary to public order/morality ...
Second challenge /opportunity: ACQUIRE PROTECTION

Registration:
- @ Home
- In other countries

PRINCIPLE OF TERRITORIALITY
A centralized filing mechanism
A one-stop shop for trademark holders to obtain and maintain trademark protection in export markets
An option to the national route
A purely PROCEDURAL treaty
The domestic legislation of the designated Contracting Parties set the SUBSTANTIVE conditions for protecting a trademark and determine the rights which result from protection
National Route

- Many Offices for filing
- Many application forms
- Many languages
- Many currencies
- Many registrations
- Many renewals
- Many individual modifications
- Foreign attorney needed from beginning in ALL countries

Madrid Route

- One Office for filing
- One single application form
- One language (E/F/S)
- One currency (Swiss francs)
- One international registration
- One renewal
- One modification
- Foreign attorney needed only in case of refusal

Madrid v. National systems
Third challenge/opportunity: USE OF THE MARK

- If not used: waste of opportunities
- Avoid forfeiture for lack of use (use it or loose it)
- Avoid vulgarization:
  - Never as a verb / noun
  - Use with generic term
- Enhance Secondary meaning
- Use it in a **consistent** manner (= as registered)
- Use «TM» or ®
- Carry out periodical TM AUDIT
- TM valuation
- Securing capitals
What is BRANDING?

Strategy to promote your strengths

The essence of your business: its personality

Highlighting what makes your prod/serv different

Strategy to generate a set of associations in people’s mind
<table>
<thead>
<tr>
<th>Advantage</th>
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<tbody>
<tr>
<td>Can make your business stand out</td>
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<tr>
<td>Loyalty, credibility and trust by customers</td>
</tr>
<tr>
<td>Better income / increased sales</td>
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<tr>
<td>People expect to pay more for branded products</td>
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<tr>
<td>Increased public recognition</td>
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<td>Make sales less sensitive to price increase</td>
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<td>Less sensitive to new competitors / Creates habit</td>
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</tbody>
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BRANDING: How?  (TOOLS)

- Trademarks (+ logo)
- GIs
- Industrial Designs
- Domain names
- Marketing / Advertising
- Packaging
## Most Valuable TMs in 2018

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<table>
<thead>
<tr>
<th></th>
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</thead>
<tbody>
<tr>
<td>1. Amazon</td>
<td>145 Bl €</td>
<td></td>
</tr>
<tr>
<td>2. Apple</td>
<td>140 Bl €</td>
<td></td>
</tr>
<tr>
<td>3. Google</td>
<td>115 Bl €</td>
<td></td>
</tr>
<tr>
<td>4. Samsung</td>
<td>85 Bl €</td>
<td></td>
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<tr>
<td>5. Facebook</td>
<td>80 Bl €</td>
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</table>
Fifth challenge/opportunity: COMMERCIALIZATION

- Licenses
- Franchising
- JVs
- Merchandising

... endless times and all at the same time!!
Avoid Litigation!!!

- “Create around” or License
- Be your own policeman!
- Other “friendly” agreements
- Cease and Desist letter
- Negotiate an out-of-court attempt
- ... money from damages/compensation ...
ACTIONS BEFORE COURT

CIVIL MEASURES

ADMINISTRATIVE MEASURES

CRIMINAL MEASURES

BORDER MEASURES

EX PARTE MEASURES
LET’S TURN CHALLENGES INTO OPPORTUNITIES !!!
Thank you

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