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Developing a sound global trademark filing strategy.

Key considerations and best practices

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Our speakers



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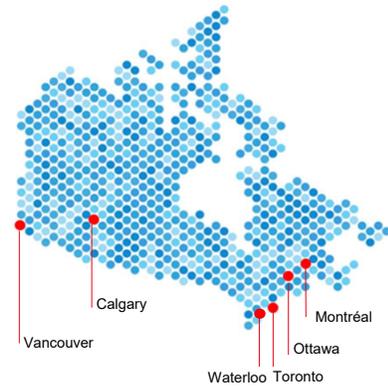
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Who we are

Canada's leading IP firm
with expertise at the interface of
technology and business law

- Expertise in all areas of IP
- 130+ years serving clients
- 180+ lawyers, agents and technical consultants
- 17,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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The IPH Group

A leading international IP services group

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Patent group
in Australia, Canada, New Zealand and Singapore²

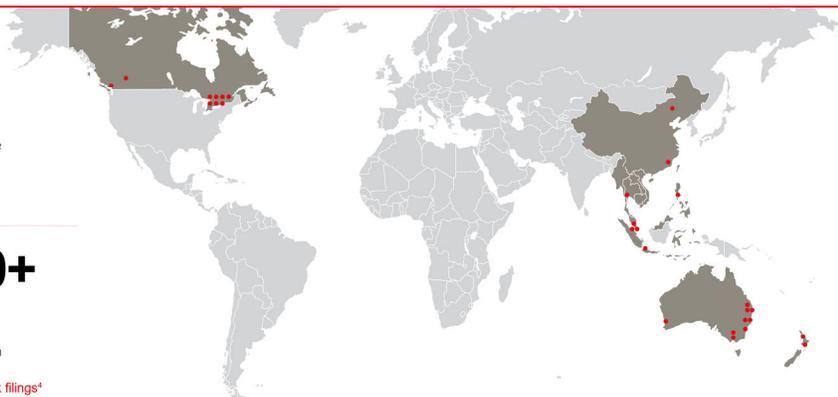
Trade mark group
in Australia and New Zealand³

10
IP jurisdictions

1,600+
Employees⁴

36k+
Annual patent filings⁴

14k+
Annual trade mark filings⁴



7 brands: **AJPark** **applied marks** **GRIFFITH—HACK** **PIZZEYS** **ROBIC** **SMART & BIGGAR** **SPRUSON & FERGUSON**

1) Approximate employee numbers across the Group.
2) Management estimated market share based on local IP office filing data: Australia (FY23 as at 16/7/23), Singapore (FY23 YTD April as at 20/7/23), New Zealand (FY23 as at 6/7/23), Canada (CY21 and CY22 YTD May as at 27/6/23).
3) Management estimated market share based on local IP office filing data: Australia (FY23 as at 17/7/23, share of top 50 agents), New Zealand (FY23 as at 21/7/23).
4) Cases filed or instructed to be filed worldwide based on IPH internal data for FY23, including Smart & Biggar.

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Introduction

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- **Why do you need a global filing strategy?**
 - We live in an interconnected, global economy
 - Where leading brands' reach spans multiple jurisdictions
 - Where infringers do not respect borders
- A global filing strategy equips brand owners with **“a sword and shield”**
 - to **defend** against threats from competitors
 - to **enforce** rights abroad

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Introduction

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- **Most brand owners must protect their brand identity and image not only on “home soil” but also overseas, in foreign markets**

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The Challenge of Global Trademark Protection

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Developing a **cost-effective and commercially sound filing strategy** by:

- **Maximizing protection** across the jurisdictions of interest.
- **Managing risks** such as obstacles to use and registration.
- **Managing costs** related to searching, filing, and maintenance.



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Agenda

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In this presentation, we explore **three essential steps** for developing a cost-effective and commercially sound global trademark filing strategy:

- 1. Determining key parameters**
- 2. Conducting trademark clearance searches**
- 3. Taking advantage of multinational filing systems**

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Determining key parameters

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Determining key parameters

Taking the time to assess the scope of your current business activities and future growth plans to:

- ensure that your **strategy aligns with your overall business objectives**; and
- **determine the key parameters** of your trademark applications.

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Determining key parameters

Key trademarks

- What is the trademark of interest?
 - A **word**? A **design**? A **non-traditional mark**?
- Will you use translations or transliterations of the mark in certain jurisdictions?
 - Consider Quebec, *French Charter* implications
- Will you use the mark in certain **colours**, *styles* or **typefaces**?

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Determining key parameters

Example:

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Determining key parameters

Key goods and services

- What are the goods and services of interest?
 - Take a long view: Consider what goods and services you are likely to offer **down the road**, based on where you see the business and industry going in the years ahead
- Are some goods actually... services?

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Determining key parameters

Key goods and services

- Will you provide the **same goods and services** across all markets? Or will you offer only **certain goods and services** in certain markets?

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Determining key parameters

Key jurisdictions

- In which markets are you currently using the mark (either directly or indirectly, through licensees)?
- In which markets do you plan to expand in future?
- Does the commercial value of each market justify the expense of a trademark application? Of enforcement?



Conducting trademark clearance searches

Benefits of searching

- Provides a **snapshot of the local market and register**
 - identify third parties that may pose potential risks to the registration and/or use of the trademark of interest.
- Helps brand owners **evaluate the likelihood of registering** their marks
 - identify potential obstacles, allowing you to adjust accordingly.
 - determine the distinctiveness of the trademark of interest and thus the scope of protection to which the mark will be entitled.

Practical Considerations

Ideal Strategy

- Conduct comprehensive searches in every jurisdiction of interest, ensuring a complete understanding of potential conflicts.

Reality

- Budget constraints often limit the scale and scope of searches.

Practical and Tailored Approach

- Prioritization based on risk, costs, and value.

Practical Considerations

Company-specific factors

- Risk tolerance
- Adaptability

Market-specific factors

- Cost of searching
- Recognition of common law rights
- Examination of prior marks by the IP offices

Project-specific factors

- Launch timing
- Commercial value of the trademark

Taking advantage of multinational filing systems

Trademark filings options



National: filing distinct national applications in each jurisdiction of interest



Regional and Madrid: protection in multiple countries within one application

National filing systems

• Advantages

- **(Usually) the fastest** way to registration.
- **Ability to tailor** applications to local practices and business objectives.

• Disadvantages

- **Higher costs** due to local counsel fees.
- **Increased administrative burden** due to multiple filings.

Regional filing systems

• Advantages

- **Protection in multiple countries** with one application.
- **Cost-effective** for regional protection.
- **Reduced administrative complexity** due to the limited number of filings.

• Disadvantages

- **Limited flexibility** to tailor filings for each jurisdiction.
- Rights in the mark may be **jeopardized throughout the region** if the application is opposed, or your registration is invalidated.

Madrid filing systems

• Advantages

- **No need to retain local counsel** unless obstacles arise.
- **Reduced administrative complexity** due to centralized filing.
- **Cost-effective** when filing in 5+ countries.

• Disadvantages

- Application must be **based on a home application or registration**.
- **Limited flexibility** to tailor filings for each jurisdiction.
- Rights in the mark may be **jeopardized throughout the region** if your IR is invalidated.

Conclusion – Best Practices and Recommendations

Take the long view

- Carefully consider what you want to be, and where you want to be, in three, five, ten years from now.

Conduct thorough clearance searches

- Identify potential conflicts early to allow for proactive adjustments to your filing strategy and risk management.

Leverage multinational filing systems

- Take advantage of streamlined filing systems to simplify the application process.



Questions?