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Proactive and reactive strategies to protect your brand at the border and on the web.

Presenters: Graham Hood & Tamara Céline Winegust

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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
- 10,000+ patents & trademarks filed annually
- Litigation bench strength and record of success

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Thinking about the problem

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Thinking about the problem

- Controlling your narrative.
- If your product is making money, someone, somewhere, is likely trying to knock it off.
- AI tools pour fuel on the fire.

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Proactive strategies

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Categories of PROACTIVE strategies

- **Internal / Consumer Mobilization**
 - In-house training
 - Product authentication
 - Integrate IP into go-to-market strategy
 - Strategic watches
- **External / Government**
 - CIPO registrations
 - CBSA records
 - Enrollment in online programs
 - Amazon Brand Registry
 - Alibaba Int'l IPP Platform

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PROACTIVE brand protection strategies

- **In-house training**
 - Most risks are spotted **outside legal first**
 - The most effective anti-counterfeiting strategy is prevention
 - Develop short, practical trainings for your business teams:
 - what counterfeiting looks like
 - what trademark misuse looks like
 - when to escalate the issue to legal
 - Early flags save enforcement time and cost

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PROACTIVE brand protection strategies

- **Build authentication into your products**
 - **What to do**
 - QR codes / serial numbers / batch codes / invisible ink
 - Consistent packaging & labeling standards
 - Centralized “how to spot an authentic product” guidance
 - **Why it matters**
 - Reduces consumer confusion
 - Strengthens takedowns and customs actions
 - Lowers refunds and reputational damage
 - Enhances customer awareness and loyalty

PROACTIVE brand protection strategies

- **Integrate IP into go-to-market strategy**
 - **What to do**
 - Clear your trademark before the product launches
 - Align legal timing with marketing drops
 - Register IP in Canada early (not if/when the product becomes a commercial success)
 - **Why it matters**
 - Counterfeiting often follows **successful launches**
 - Legal needs to be part of launch planning, not cleanup

PROACTIVE brand protection strategies

- **Strategic watches**

- **What to do**

- Schedule regular scans of social media for your brand names
 - Use AI-powered tools (such as Haloo) to monitor trademark registers
 - Utilize your own team members to monitor the marketplace
 - Ask outside counsel to monitor potentially problematic filings for opposition

- **Why it matters**

- Addressing infringement before it grows can preserve valuable resources
 - Coordinating a POA before a mark is advertised (or even used) avoids “fire drills”

PROACTIVE brand protection strategies

- **Register, register, register**

- **CIPO**

- TM registration unlocks rights – additional causes of action, border recordal
 - Copyright registration is another helpful tool; expedient and inexpensive

- **Online Platforms**

- E.g., Amazon Brand Registry, Alibaba Int'l IPP Platform

- **Canada Border Services Agency**

- Registration required to record TMs, but not copyrights (i.e., logos, packaging, etc.)

PROACTIVE brand protection strategies

- **Online brand registries**

- Offer rightsholders tools to monitor, and police, online marketplaces
 - Alerts
 - Flag 'n' Tag
- TM registrations are not required, but encouraged
 - Amazon Brand Registry now accepts pending applications
- An “elbows up” approach to distinguishing your brand from fakes in a crowded online marketplace

PROACTIVE brand protection strategies

- **Border recordals**

- The “Request for Assistance” program has been in place since 2019
 - Over 600 RFAs now on file
- Rightsholders may record TMs, copyrights and even GIs with the CBSA
 - RFAs are valid for two years
- Rightsholders may include educational literature and media with RFAs
- CBSA will alert rightsholders to incoming, outgoing and in-transit shipments containing suspected counterfeit goods
- Rightsholders may take action against the importer while the CBSA detains the goods

PROACTIVE brand protection strategies

- **Border recordals**

- Filing Requirements
 - Mandatory
 - Rightsholder's name and address
 - List of TMs, copyright-protected works and/or GIs
 - Contact person (outside counsel)
 - Optional (but Recommended)
 - List of known authorized importers
 - List of known distributors of illegitimate or suspect goods
 - Training materials (e.g., product identification guides, videos, etc.)
- Valid for two years, amendable/renewable indefinitely

Reactive strategies

Categories of REACTIVE strategies

- **Consumer-facing**
 - Follow the proactive steps
 - Alert customers
 - Manage PR
- **Direct action**
 - Legal
 - Demand letters; litigation
 - Quasi-legal
 - Private dispute proceedings
 - CDRP, UDRP
 - TMOB proceedings
 - Intermediary / Platform complaints
 - CBSA / HC / Police / RCMP

REACTIVE brand protection strategies

- **Consumer-facing**
 - *Consider only if there are pressing consumer considerations*
 - E.g., health and safety
 - Alert customers
 - E.g., press releases; notices on website
 - Similar to customer education
 - Manage PR
 - Have a plan, narrative, designated spokesperson, etc.

REACTIVE brand protection strategies

• Direct action – First steps

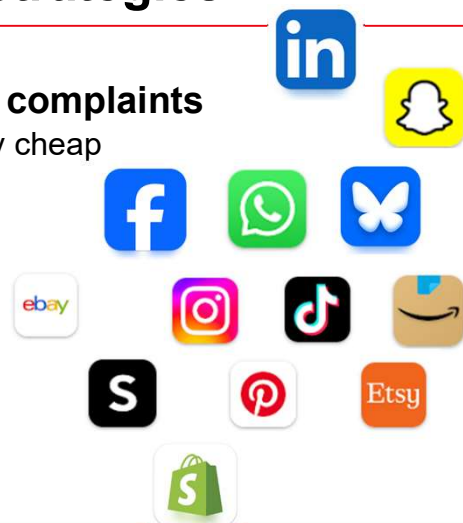
- Gather evidence, information
 - Take photographs, screenshots, etc.
 - Investigate user / contact information
 - Order a corporate report, identifying directors, officers and addresses
- Ensure registered rights are up-to-date
 - Defensive filings
 - Expedited examination



REACTIVE brand protection strategies

• Direct action – Intermediary / Platform complaints

- Most utilized – if works, it's fast and relatively cheap
- Process varies platform to platform
- NEED (usually)
 - Complainant name, address
 - Rights relied on (TM reg. no.; CR reg. no.)
 - URL of complained of matter
 - Description of complaint
- Promptly address follow-up communications



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REACTIVE brand protection strategies

- **Direct action – Intermediary / Platform complaints**

The image shows two screenshots of platform complaint forms. On the left is the TikTok 'Report trademark infringement' form, which includes a dropdown menu for 'What issue are you having?' with options like 'I'd like to report a possible trademark infringement in user-generated content', 'Reporting a possible IP infringement in advertisement', 'Reporting a possible trademark infringement in TikTok Shop', 'Reporting a possible copyright infringement in user-generated content', 'Reporting a possible impersonation violation', and 'Reporting a possible privacy violation'. On the right is the Instagram 'Trademark Report Form', which is a more detailed form with multiple sections for reporting trademark infringement on the platform.

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REACTIVE brand protection strategies

- **Direct action – Quasi-legal**
 - CDRP / UDRP – for domain name disputes
 - TMOB proceedings – for oppositions and cancellations

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REACTIVE brand protection strategies

- **Direct action – Legal**

- Demand letters
 - Benefits - clearly sets rights; recipient may comply
 - Challenges - dispatch; could be ignored
- Litigation
 - Consider – jurisdiction/forum; interlocutory
 - If unanswered ► Default judgment
 - Still must enforce

REACTIVE brand protection strategies

- **Indirect action – Law enforcement**

- HC / Police / RCMP
 - Usually only act if health & safety issue
 - Drugs, gangs, guns
- Canadian Anti-Fraud Centre
 - If truly fraud
 - Project Chargeback
- Challenge - process beyond rights holder's control

Turning strategies into action

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PLAN! PLAN! PLAN!

1. Develop a plan

- Internal decision tree, enforcement matrix
- Consider:
 - Misuse v counterfeit v resale
 - Platform v CBSA v police
 - Highly problematic v likely tolerable
- Internal tracking mechanisms?

2. Stick to the plan

- Create certainty
- Be smart with your budget and resources
- Avoid over-enforcement
- Consider PR – consistent, defensible responses

3. Adjust the plan (as needed)

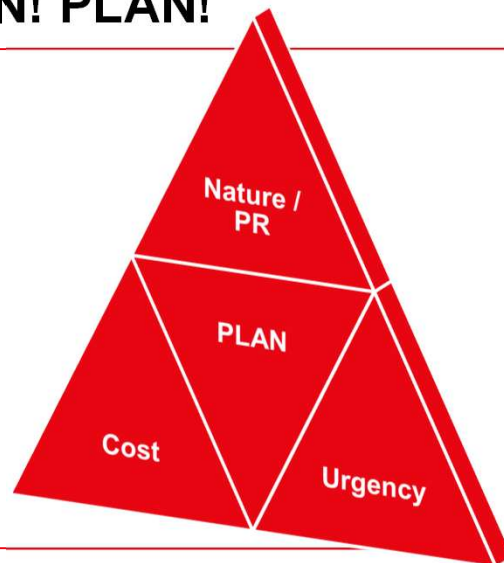
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PLAN! PLAN! PLAN!



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PLAN! PLAN! PLAN!

• **Border enforcement**

- How many detained?
 - If small amount, let go?
 - Other rights holders involve?
- Demand letter ASAP.
- Follow up periodically.
- Stay in touch with CBSA.

• **Online enforcement**

- Automatable form?
- Costs / efficiency
 - In-house specialist
 - Legal v external counsel
- Need to bring into the “real world”?
 - Identify real actor?
 - Repeated bad actor?
 - Couple with demand letter?

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Questions?

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