

Selecting your trademark

Distinctiveness

- Trademark needs to be “distinctive” in order to be registrable
- If a trademark describes the goods and services, it is not distinctive
- The more distinctive your trademark is, the stronger legal protection it gets

Search

- A trademark that infringes other’s intellectual property poses a significant legal risk for a company
- Before committing to a name, make sure it is available for use by making database searches of prior registered trademarks

Goods and services

- Trademark rights exist in relation to specific goods and services
- The goods and services are divided into 45 classes and must be identified in the application
- The list defines the extent of your legal rights

Protecting your trademark

Trademark types

- Different types get different protection
- The most common trademark types are words (names), logos, and slogans
- Usually, the name (word) is the most important
- A well-protected brand should have different types of registrations

Registration

- Trademark rights are created by registration
- In some countries, limited trademark rights can exist based on the use of the mark
- Each country has a government office that handles registrations
- After the first application, there is a 6-month “priority” period for protecting the trademark in other countries

Geography

- Trademark registrations are country-specific, registration must be made in all countries where rights are needed
- World Intellectual Property Office (WIPO) has a convenient system for international registration
- Most countries require local representation

Maintenance

- Trademarks should be used correctly in order to make sure others cannot cancel them
- Unauthorized use by others should not be tolerated
- You should periodically review your business activities (products and services) to make sure the current registrations cover them

Renewals

- Registrations should be renewed every 10 years to keep the rights valid
- If renewed periodically, a trademark can exist indefinitely
- Many countries allow a 6-month “grace period” for late renewal

Key partners

- Trademark offices that register your trademarks
- Legal service providers
- Marketing partners and designers
- Government innovation programs
- Domain registrars

Costs

- Government fees (filing fees, renewal fees)
- Legal fees
- Marketing and designer costs
- Domain registration costs