

Brand protection – beyond registration

For many, brand protection will mean the registration of that brand as a trade mark in all countries of trade or manufacture.

However, obtaining protection is often just the first step in a long process of consistent monitoring and action, particularly for brands that attract a following making them vulnerable to counterfeiting or copying.

Once the brand is registered, there are multiple additional services that one can employ in order to protect the brand and reduce the in-house burden.

Watching services

Trade mark watching services are an extremely cost effective tool for policing your trade mark from third party appropriation or competitor encroachment. Once subscribed, trade mark owners are notified of the acceptance and advertisement of identical or similar trade marks, thereby providing them with the opportunity to object. This subscription can be for a specific country, region or cover worldwide applications. This may also provide trade mark owners with an opportunity to investigate the Applicants, and perhaps identify individuals or entities involved in bringing counterfeit products to market.

Domain name watching services provide useful intel for brand-owners without the 'man hours' required in monitoring domain name registrations on a daily, or weekly basis. This service provides a bi-weekly or monthly report of all domains registered within that period including the brand name of interest. This is a quick way of identifying new infringers, or infringers branching out onto new sites, allowing one to take action against their use.

Web watch services fill the gap between a trade mark and domain name watch; they identify use of your marks online, where such use is not within the domain but in relation to products or services. This will help in identifying counterfeit goods and genuine trade mark infringement.

Monitoring of online marketplaces

Online marketplaces are now increasingly causing issues for international brand owners. Unfortunately there is yet to be a software package that monitors these sites on your behalf, simply delivering results. However, our top tips for tackling infringement on online marketplaces are listed below:

- 1.** Ensure you have brand guidelines that are applied consistently across the business, and a method for identifying genuine products.
- 2.** Where possible, register those rights with the online marketplaces so that a streamlined approach to take-downs can be pursued in the future. For example, VeRo at eBay, AliProtect for AliExpress/Alibaba. These systems assist in enforcement and allow you to report multiple listings simultaneously.
- 3.** Consistency and resiliency is key in the current enforcement landscape. Unfortunately, the best way to continually police the sale of counterfeit products is to consistently monitor the marketplaces, designating time and resource to doing so and de-listing as many links as you can on a regular basis.

4. Focus your efforts on the big fish. Focus on the marketplaces with the most traffic and also take the time to look at the number of items one seller is selling. If you are limited on resource, enforcing your rights against those sellers will deliver the best results.

5. Consider dual action. Is a seller selling products under numerous brands? Could you team up with other brand owners to take the relevant action against those sellers?

6. Maintain a joined up approach and keep records; where the same sellers keep reappearing in multiple forums, civil action may be the best forum.

Trading standards and customs

Relationships with trading and standards and customs are extremely important for businesses within the product sector, where identifying counterfeit goods will be core to the brand protection strategy. Utilising a trade mark attorney to manage these relationships on one's behalf could be beneficial in terms of efficiency, knowledge of the brand portfolio and the turnaround of Witness Statement and Grounds for Action. If you are managing these relationships in-house, ensure that turnaround times are fast, seizures are not turned away and that all relevant rights are recorded with Customs in the countries where seizures are prevalent.

It is also worth considering use of the Enforcement Database offered by the Office of Harmonisation of the Internal Market. This allows a direct and efficient communication chain between European Union Customs Officials and rights holders, which is hoped to improve the action rates of customs officials who sometimes struggle to obtain the answers they require. There are also plans to extend this to the police forces so that it becomes a staple 'icon' on their working desktops.

The police intellectual property crime unit (PIPCU)

PIPCU was formed in 2013 and has been charged with tackling IP Infringement. Following a recent review and re-structure, the Unit is encouraging brand owners to actively contact PIPCU, inform the Unit of the issues they are encountering and use its resources to tackle infringement that is proving difficult to address.

Ensure you use this service, send employees to meet the team and actively learn about the resources the Unit has to offer; see how it can assist in delivering your brand protection strategy.