

# Importance of International Trademark Protection



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*EmERGEcounsel*

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The importance of international trademark protection, and what is the best option for your business? A trademark is a source indicator to distinguish an entity's goods and services from others. It is also known as a brand (think Oreos for cookies, Spotify as a music platform). Trademark protection is thus synonymous with brand protection. Goods and services trade across international borders all the time. However, trademark protection is country-specific, and protection generally stops at each border. So, how do you protect your US brand when your goods and services cross borders?

Fortunately, EmERGEcounsel has extensive experience protecting brands through the multi-jurisdictional supply chain to the US consumer because this issue frequently arises.

Many countries have joined together to make international filings easier. Specifically, trademarks can be filed through the World Intellectual Property Organization ("WIPO") Madrid Protocol Multinational Filing System ("Madrid"). American counsels, such as EmERGEcounsel, use Madrid frequently because the US, China, EU, and other major trade players have joined Madrid.

However, EmERGEcounsel also has relationships with jurisdictional counsel in almost every nation globally. Whether to use Madrid, jurisdictional counsel, or both requires strategic thinking.

## The Madrid Protocol System

Generally speaking, Madrid can be handled by one attorney in a signatory country (such as the US, EU, or China) and cover many jurisdictions in one application. It is thus generally cheaper and more efficient than a filing country-by-country strategy if you are filing in multiple countries.

However, Madrid only helps applicants file the application(s). Each country still reviews the application, conducts a relevant search in its jurisdiction, writes a decision (based on legal authority), and communicates its decision to WIPO, which sends it to the applicant. Additionally, the trademark office in each country is independent, meaning they reserve the right to process applications their way. For example, Canada requires a local Canadian counsel on record to respond to any issues. Therefore, if Madrid is used, the applying attorney needs a pretty darn good grasp of the laws of each country to ensure the mark will register in each jurisdiction they are filing it in and needs an extensive network of international attorneys to assist if issues occur.

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## Use and/or Management of Jurisdictional Counsel.

Instead of Madrid, some international marks are filed by local counsel or jurisdiction counsel. Using jurisdiction counsel means EmergeCounsel manages one or more international counsel to file and manage a trademark application through their local jurisdiction's IP office. Jurisdictional trademark counsel then reports the progress to EmergeCounsel and/or the client for tracking into an international IP strategy spreadsheet. This allows the client not to have to reiterate their brand and business goals to multiple counsels to file marks and provides the client with a single contact to receive all the information they need about their IP strategy.

## How to Choose Between Madrid and Jurisdictional Counsel?

The general answer is that you shouldn't; both are useful depending on the age of the brand, the current scope of protection, and desired international protection. Instead, you need an anchor IP attorney to help you strategize the next steps locally and abroad to protect your trademarks completely. At EmergeCounsel, we strive to provide strategic, cost-effective, and competent international protection.

*Strategy: Necessary to minimize the complexity of Madrid and local international filings and fast-track protection in the key countries as soon as possible.*

*Cost-Effective: We always compare jurisdictional filings versus Madrid to provide clients with a strategy that matches their budget and desired international protection. We provide cost-effective US application services and strive to find international counsel that has the same strategic, cost-effective focus as us.*

*Competent: Knowing how to file a trademark is not enough. You need competent counsel who knows key differences in the trademark laws of other countries that may affect your mark. At EmergeCounsel, not only do we have experience with international trademark laws and know what pitfalls to look for, but we also have local counsel who is competent and reliable to ensure we protect every aspect of your mark.*

Contact us today to schedule your free consultation!

## About the Author

After years of corporate counsel experience with a Fortune 100 company, Steven Weigler built and managed a startup where he was able to create and institute a protective intellectual property strategy, commercialize the resulting products and protect the intellectual property, build and manage a sales, marketing and operations team under a “lean startup” budget, and secure both angel and A round financing, and finally negotiated an exit.

Steven’s combination of legal, entrepreneurial, governmental and corporate experience gives him a unique, focused perspective on what entrepreneurs who are starting up or emerging their businesses need but rarely have: a someone who zealously protects their interest and b someone who has the empathy to understand each entrepreneur’s vision and motivation as well as their business plan. Steven has a passion of ecommerce and advises many clients on all aspects of the industry.

## About EmergeCounsel

EmergeCounsel strategizes with worldwide clientele in the focus areas of protection of intellectual property and business assets for eCommerce business. Our TotalTM® provides trademark guidance, search, appeals of office actions and denials, and trademark monitoring for flat and affordable rates. In addition, EmergeCounsel has a network of professionals who provide co-counsel and services to assist businesses of all sizes