

## PROTECTING YOUR TRADE-MARK - BRAND MANAGEMENT 101

March 2006

You have designed a logo, or chosen a unique name for your product or service, your trade-mark agent has registered your trade-mark. You assume that your trade-mark is now fully protected from unauthorized use by others, however registration is only part of the protection equation. There are other steps you can take, such as a Brand Management Plan, to protect and properly use your trade-mark and in so doing build the value of your brand. The following are some suggestions of what a good Brand Management Plan should contain:

- 1) **Guidelines for Use** - It is very important to ensure your trade-mark is being used correctly within your organization. Any party that will be involved with using the trade-mark should be educated as to what proper use is. A manual for use and protection of the trade-mark is an easy way to ensure consistent, correct use of the trade-mark. The guidelines for use should include:
  - a) A guide to correct grammatical use – a trade-mark should only be used as an adjective, not a noun or verb, for example, KLEENEX tissues, NIKE running shoes.
  - b) Standards to ensure the trade-mark is obvious when used in documents and literature - such as the use of bold type face, and the ® symbol with the trade-mark if registered and the ™ if the mark is unregistered.
  - c) Tips to avoid variation of the trade-mark - small variations to the mark can occur over time, however trade-marks must be used consistently to be protected and to remain strong.
  - d) Colour guidelines - if colour is an important element of the trade-mark.
- 2) **Monitoring** - To ensure that your registered trade-marks is being properly controlled and is not being put in jeopardy by third party or licensee misuse the markets in which the trade-marked wares or services are available should be monitored. There are several monitoring methods:
  - a) Employ a third party watch service: There are several companies in Canada and the United States that will monitor the market, in countries of your choice, for infringing uses of your trade-mark. These services will alert you to unauthorized use, and to any applications made for registration of trade-marks that might be confusingly similar to yours.
  - b) Designate an employee to monitor the trade-mark: An employee can be tasked with observing the market place for misuse of the trade-mark, checking the various trade-mark office sites and the Internet.
  - c) Audit Licensees: Trade-mark licenses should include clauses that allow you as trade-mark owner to audit the licensees' use of the trade-mark, this should be done periodically to ensure the trade-mark is being used in accordance with the license rights and with wares and services that meet the quality expectations of you as trade-mark owner.
  - d) Designate one trade-mark agent: Having your portfolio of registered trade-marks managed by one trade-mark agent lowers the risk that a renewal deadline will be missed and increases the chances that applications for identical or similar trade-marks by third parties will be detected in time to take action to prevent their registration. A trade-mark agent can also receive watch reports on your behalf.
- 3) **Licensing** - You may choose one corporate entity to hold ownership of all of your trade-marks and allow other related entities to use the trade-marks, such use as well as use by unrelated third parties should only occur under license agreement. A good license will contain a clear grant of rights to use the trade-mark and contain methods for the owner to control the quality of the wares or services with which the trade-mark is being used by the licensee. Inter-corporate licenses should be entered into when the trade-mark is at the application stage or on first use, and whenever there is any corporate re-organization. Licenses with unrelated third parties should be put in place before the party begins using the trade-mark. If the owner of a trade-mark wishes to rely on third party use as evidence of use of the trade-mark a license is essential.
- 4) **Record Keeping** - Each time you use your trade-mark, whether in an advertisement, trade journal, web-site, letter head or on packaging a sample of that use should be dated and retained. Web pages should also be archived and retained. Licensees should be required to provide the owner with copies of their use of the trade-mark as well. This evidence of use is essential to establishing rights to your trade-mark should you ever be in a dispute with a third party or wish to oppose a third party application for a trade-mark similar to your own.

A trade-mark can be a valuable asset of your company and a sound Brand Management Plan will go a long way to protecting and increasing the value of that asset.