

Case study | International trademarks

# Opening a new world of international trademarks



**Wang Zhi He from Germany? Hong Ta Shan from the Philippines?**

**Don't be fooled. Both have nothing to do with the well-known Chinese brands, they are the result of local trademark squatting.**

Today, as more and more Chinese brands are going global, trademark owners are facing complex challenges that come with it. Limited access to effective searching and monitoring, paired with lack of familiarity with foreign trademark law, can lead to additional expenses, extended timelines and unexpected processes. These familiar complications are discouraging Chinese companies from expanding their businesses abroad.

To meet the challenge of going global, turn to the professionals.

In China's intellectual property industry, Unitalen Attorneys at Law is an authority in international trademark business.

Established in 1994, Unitalen now has over 650 employees in the main office and several regional offices, including 20 major commercial cities in Mainland China, Hong Kong, Tokyo Japan, San Francisco United States, and Munich Germany.

Providing international trademark services since 1999, in 200+ countries and regions for 5,000+ Chinese enterprises, Unitalen has long been considered a premier provider and has worked on a large number of international registrations through the Madrid system filings.

Valuing quality above all, Unitalen has found the perfect partner, CompuMark™, a Clarivate Analytics company, to open a new world of international trademarks for Chinese companies.

## **Relying on three major advantages to become an industry benchmark**

Depending on the country of trademark service, Unitalen manages its international trademark business under three teams. International Trademarks I is in charge of outgoing trademark cases of Chinese companies, including trademark prosecution, trademark enforcement, as well as trademark strategic consulting.

"After years of development, the role of Unitalen's International Trademarks I in the field of outgoing trademarks is no longer the traditional 'message passer' but a professional adviser that, with three major advantages, is capable of protecting the mark in every stage of its development" Zhou Xinyan, Partner and Director of International Trademarks I.

The first advantage of International Trademarks I is the level of experience and expertise. Unitalen, with 30+ departments



and clearly defined specialties including domestic/international trademarks, patents, proceedings, process, etc., is a perfect partner to provide targeted and critical information needed to make strategic international trademark business decisions.

“The proven international experience of our incoming Trademark and Patent teams provides information about foreign attorneys, which enables us to select professional attorneys with which to cooperate. Similarly, the Litigation Trademark team’s knowledge and experience enable us to handle complex cases effectively. The International Business team’s full knowledge of international customs and practices facilitates our effective communication with foreign attorneys. With internal support as mentioned above, International Trademarks I has grown rapidly and has been an essential part in promoting Unitalen’s development” says Zhou Xinyan.

Talent is a core asset of the intellectual property industry and International Trademarks I has a strong and talented team. To date, the team has gained 40+ members, including 11 senior attorneys and 10 agents, most have graduated from highly regarded law universities in

China, some with master’s degrees from universities abroad. With an average of more than six years of experience, this team of professionals has profound legal knowledge, proficiency in English and an in-depth understanding of European and American culture.

In this challenging field, the International Trademarks I team has worked tirelessly, with a passion for the intellectual property industry and a strong curiosity for the leading intellectual property systems in other countries. After 20 years of growth, the International Trademark I team has garnered expertise with complex trademark systems in numerous countries, helping Unitalen earn its superior reputation.

And the most unique and prominent advantage of International Trademarks I, and Unitalen as a whole, is the handling of cases together with foreign attorneys. Breaking the traditional agency model of translation only – conveying customer requirements – soliciting opinions from foreign attorneys, Unitalen is more like an adviser to clients and working-partner to foreign attorneys. To date, Unitalen has established long-term partnerships with 1,200+ firms and scientific research institutions in 200+ countries.



# Working with Clarivate Analytics to refresh the trademark world

## Trademark research and protection that inspires confidence.

With the increasing number of trademark application filings, there is greater need for workflow efficiency and quality service. To meet those needs, International Trademarks I has partnered with CompuMark, a highly regarded information service provider, since 2014. When talking about the relationship over the past five years, Zhou Xinyan acknowledged it's the right decision for trademark screening and monitoring services.

Trademark screening is the first step for Chinese companies and brands to go global, but you can imagine the difficulty of doing it properly given the vast amount of trademark data in countries and regions all over the world. "In the past, International Trademarks I relied heavily on foreign law firms to conduct a trademark screen. However, due to their different work habits and time differences in various countries, the efficiency and accuracy of this approach could hardly meet the high standards and strict requirements of Unitalen." Zhou Xinyan noted.

"Unitalen aims to extend its trademark legal services to every corner of the world, so we chose CompuMark's most extensive trademark database SAEGIS® on SERION® for screening. For example, when assisting a well-known Chinese mobile phone brand in its overseas trademark layout we used SAEGIS to select 100+ screening options from its exclusive trademarks, domain names, company names and industrial designs in 186 countries/regions, and then based on the results of the screen, the online search results, as well as our agency experience, reduced the number of trademark options to 5-10.

The customer finally decided on 1-2 trademarks very easily and then proceeded to the application registration process. In terms of screening of identical and highly similar trademarks as well as consultation response and OA forwarding, SAEGIS also plays an important role. Moreover, CompuMark's image search database TM go365™ provides us with a new, fast and accurate image trademark search experience, eliminating the limitation of text search and greatly broadening our horizon of trademark discovery."



The completion of a screen and registration of international trademarks does not mean the work is done. It is vitally important to safeguard and protect the investment in that international trademark. In fact, as their trademarks become well-known overseas, many Chinese companies have suffered from trademark squatting or free-riding. CompuMark's Watch on SERION®, a global trademark monitoring service, enables Unitalen to stay updated about global trademark dynamics.

“CompuMark's Watch data covers 187 registries and reaches 254 countries and regions. It can be used not only for worldwide and regional monitoring but also for monitoring by individual registration place/country/region. Its timely feedback on potentially infringing marks provides us with efficient and convenient assistance in helping customers avoid infringement risks and protect their rights and interests. To date, International Trademarks I has provided global trademark monitoring services for more than 500 Chinese brands.” Zhou Xinyan added.

**Figure 1. SAEGIS® on SERION® Interface**

**Figure 2. TM go365™ Interface**

“Trademarks should be evaluated before products are available in the market. This is a golden rule for Chinese companies intending to go global. In line with the service philosophy of considering every problem from the customer perspective and attending to every detail of the customer, Unitalen selected CompuMark to help improve its service level even more. Over the past five

years, our trademark research provider, CompuMark, has opened a new world of international trademark services for us. In the next five years or even more distant future, we are still willing to continue the cooperation with Clarivate Analytics to open up a new world of international trademarks for Chinese companies intending to go global” Zhou Xinyan finally concluded.

**Figure 3. CompuMark Watch on SERION® global trademark monitoring list**

International Register Community Trademark				
Afghanistan	Congo	Israel	Nicaragua	St Lucia
Albania	Croatia	Italy	Nigeria	St Vincent and the
Algeria	Cuba	Jamaica	Northern Cyprus	Grenadines
Andorra	Curacao	Japan	Norway	Sudan
Angola	Cyprus	Jersey	OAPI	Suriname
Antigua and Barbuda	Czech Republic	Jordan	(16 African countries)	Swaziland
Argentina	Denmark	Kazakhstan	Oman	Sweden
ARIPO	Dominica	Kenya	Pakistan	Switzerland
(18 African countries)	Dominican Republic	Kosovo	Panama	Syrian Arab Republic
Armenia	Ecuador	Kuwait	Papua New Guinea	Taiwan
Aruba	Egypt	Kyrgyzstan	Paraguay	Tajikistan
Australia	El Salvador	Laos	Peru	Tangier
Austria	Estonia	Latvia	Philippines	Tanzania
Azerbaijan	Ethiopia	Lebanon	Poland	Thailand
Bahamas	Falkland Islands	Lesotho	Portugal	Togo
Bahrain	Fiji Islands	Liberia	Puerto Rico	Tonga
Bangladesh	Finland	Libya	Qatar	Transkei
Barbados	France	Liechtenstein	Romania	Trinidad and Tobago
Belarus	Gambia	Lithuania	Russian Federation	Tunisia
Belize	Gaza	Macao	Rwanda	Turkey
Benelux	Georgia	Macedonia	Sabah (Malaysia)	Turkmenistan
Bhutan	Germany	Madagascar	Saint Martin	Turks and Caicos
Bolivia	Ghana	Malawi	Samoa	Islands
Bophuthatswana	Gibraltar	Malaysia	São Tomé and	Uganda
Bosnia-Herzegovina	Greece	Maldives	Príncipe	Ukraine
Botswana	Grenada	Malta	Sarawak (Malaysia)	United Arab Emirates
Brazil	Guatemala	Mauritius	Saudi Arabia	United Kingdom
British Virgin Islands	Guernsey	Mexico	Serbia	United States of
BES Islands	Guyana	Moldova	Seychelles	America (USA)
Brunei	Haiti	Monaco	Sierra Leone	Uruguay
Bulgaria	Honduras	Mongolia	Singapore	Uzbekistan
Burundi	Hong Kong	Montenegro	Slovakia Republic	Venda
Cambodia	Hungary	Montserrat	Slovenia	Venezuela
Canada	Iceland	Morocco	Solomon Islands	Vietnam
Cape Verde	India	Mozambique	South Africa	West Bank of Jordan
Caymen Islands	Indonesia	Myanmar	South Korea	Yemen
Chile	Iran	Namibia	Spain	Zambia
China	Iraq	Nepal	Sri Lanka	Zanzibar
Costa Rica	Ireland	New Zealand	St Kitts and Nevis	Zimbabwe





## About CompuMark

CompuMark is the industry leader in trademark research and protection solutions. We enable trademark and brand professionals worldwide to launch, expand and protect strong brands through the highest quality global content; expert analysis; superior trademark screening, search, and watch tools; and best-in-class service. Key products include: SAEGIS Trademark Screening Tools; TM go365 Self-service Research Solution; Trademark Full Search; Trademark Watching; Copyright Searches; and Custom Solutions. For more information, please visit [compumark.com](https://compumark.com).

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