



WHITE PAPER

# Launching New Brands: Latest Trends, 10 Best Practices

January 2016

Global markets and online channels have transformed the trademark landscape. Understanding new risks that have emerged and the trademark clearance practices that can help mitigate those risks is key to building and protecting strong brands.

## Global Brands, Global Challenges

Clearing and launching new brands has never been more important—or more complex. New global markets, new marketing channels and the impact of the Internet on all commerce have created tremendous, new business opportunities. But they also present new challenges for trademark owners and IP professionals, according to Mark Foreman, trademark attorney and executive at international IP firm Rouse in London.

“The market today is worldwide. We are no longer looking to clear new trademarks just in one core area; we’re also looking to see where it might go in the future,” Foreman says. “Clients want brands that can grow geographically, as well across different products and services. So it’s not enough just to clear your brand in your home market; the clearance should include all possible markets of expansion.”

## The China Factor

Foreman points out that globalization creates risks that are often overlooked by brand owners—especially when it comes to China.

“As soon as you go public with a new brand in one market, whether on social media or any other public space, there’s a good chance someone will find it and apply to register your brand in China,” While China has greatly improved its practices in recent years, Foreman says it remains the single largest market for bad faith trademarks.

He also stresses the importance of registering your mark, rather than relying on your prior rights as a brand owner. “Many international companies have relied on well-known trademark status, but proving that fact is not easy.”

## European Trademark Reforms

Of course, one should not ignore western markets—and, here too, Foreman sees an important trademark trend. Changes to the Community Trade Mark Regulation

(CTMR), now called the European Union Trade Mark Regulation (EUTMR), are designed to make trademark registration across the European Union more accessible and efficient. One effect has been to reduce the role of official examinations in identifying potential conflicts during the trademark clearance and registration process.

“This marks a shift to brand owners being the ‘policemen’ of their brands rather than relying on trademark offices to refuse trademarks on the basis of an existing prior registered right,” he says, explaining that the onus is now on brand owners to enforce their rights through opposition or other enforcement mechanisms.

## Costly Infringement

Today’s global, online marketplace is creating more opportunities for brand owners to inadvertently infringe on others’ marks—with costly consequences.

“Now you can enter new markets almost instantly, potentially exposing your brand to prior rights in another country,” he explains. “So you have to clear marks more broadly and sooner to make sure you can secure local rights to that mark. And once you’re there, you need to make sure you’re protecting your brand and enforcing your rights.”

As an example, Foreman points to the case of a client

*“The cost of clearing a brand is dwarfed by the budgets for the branding exercise and the marketing. And sometimes you have to take a little from those other budgets to make clearance happen.”*

— Mark Foreman,  
Rouse, London, UK



**Changes to the Community Trade Mark Regulation (CTMR), now called the European Union Trade Mark Regulation (EUTMR), are designed to make trademark registration across the European Union more accessible and efficient.**



looking to expand into Europe. With no global plans back when their brand was developed, the company had only cleared their mark in their home market. As they rolled out their brand into European markets, they found that a Swiss company had already obtained rights to the same trademark, entirely by coincidence. “The only way we could address the conflict was to acquire an earlier right in Switzerland that gave us leverage against the other right that was threatening our client’s use of the brand. This allowed us to have a discussion,” Foreman explains, noting that major brand owners will tend not to risk high court litigation unless the potential gain is in the six-figure range.

UK fashion company ASOS objected to the brand ASSOS, a Swiss cycling wear company. The case ultimately went before the Court of Appeal and ASSOS emerged victorious. “All of this stemmed from someone not clearing their trademark. The judge in the case actually commented that a clearance search could have prevented this,” Foreman says.

Foreman says this highlights the false economy of not effectively clearing new brands. “Some people take the view that they can buy their way out of problems. But you can buy a whole lot of trademark searching for the sort of money that was spent to deal with these conflicts,” he emphasizes.

## 10 Best Practices for Securing Brands

So what should brand owners and IP professionals do to address these trends and ensure they are safeguarding their brand rights? Foreman points to the following clearance practices that can help reduce the risk of problems.

### Create a brand protection budget

Start by establishing a budget to support a strategic plan that covers three key elements: availability, protection and enforcement.

#### 1. Clear early in the process

“Design and branding agencies play an important role in clearance,” Foreman says. “They are looking to clear at a very early stage—not just for the final product, but they often will be looking to clear maybe a dozen different names, before they spend time and effort on the creative.”

#### 2. Think long term

Could the brand extend to include other “follow on” brands? If so, consider clearing them at the same time to reduce the risk of someone registering them first.

*“Now you can enter new markets almost instantly, potentially exposing your brand to prior rights in another country. So you have to clear marks more broadly and sooner to make sure you can secure local rights to that mark. And once you’re there, you need to make sure you’re protecting your brand and enforcing your rights.”*

— Mark Foreman,  
Rouse, London, UK

### 3. Secure your rights broadly

“You need to make sure your brand is available in the geographic markets and across the product and service lines you want to move into,” Foreman acknowledges this requires an investment in time and money. But it can dramatically reduce the risk of problems down the road—after you’ve invested significant sums in a new brand.

### 4. Don’t overlook China

Whether or not you have immediate plans to do business in China, Foreman says registering your mark there is good insurance. “You need this for defense and protection of your mark.” He notes that, even though registrations become vulnerable to cancellation after three years of non-use in China, “you’re buying yourself a few years of peace of mind.”

### 5. Keep your options open

“Don’t fall in love with your first brand name. You may become infatuated with your first idea, only to find out it’s not available in one or more markets.” He suggests developing a number of trademark candidates and build time into your launch schedule to clear alternative marks if required. If time is in short supply, you may need to clear multiple marks in parallel just to cover your bases.

### 6. Register with customs offices

A key element of protecting your branded products is registering with customs offices in the markets you plan to do business. “You want to make sure the customs offices are looking out for your products and that you can react to their requests quickly,” Foreman says.



#### 7. Don't forget online channels

In addition to basic trademark registration, don't ignore the importance of securing and enforcing your branded domain names and social media usernames. "Having domain name watching and monitoring what's happening to your brand on social media have become very important," he says.

#### 8. Create strong partner agreements

Distributors and licensees are often part of a global business strategy. Foreman says it is imperative that brand protection be part of any such agreement. "It's critical to have a watertight agreement that ensures all IP is owned by the client and that all uses of the brand are reviewed and controlled by the client. It should also spell out what happens when that relationship comes to an end," Foreman notes.

#### 9. Watch your brand, enforce your rights

"Getting a trademark registration today is just the starting point; enforcing it is crucial," Foreman says, noting that proactive trademark watching is absolutely key, helping brand owners identify potential conflicts early so they can respond quickly. "If you want your brand to be respected and trusted, you have to take action," he says, adding that robust enforcement can often create publicity that sends a message that you are serious about defending your brand.

### A Wise Investment

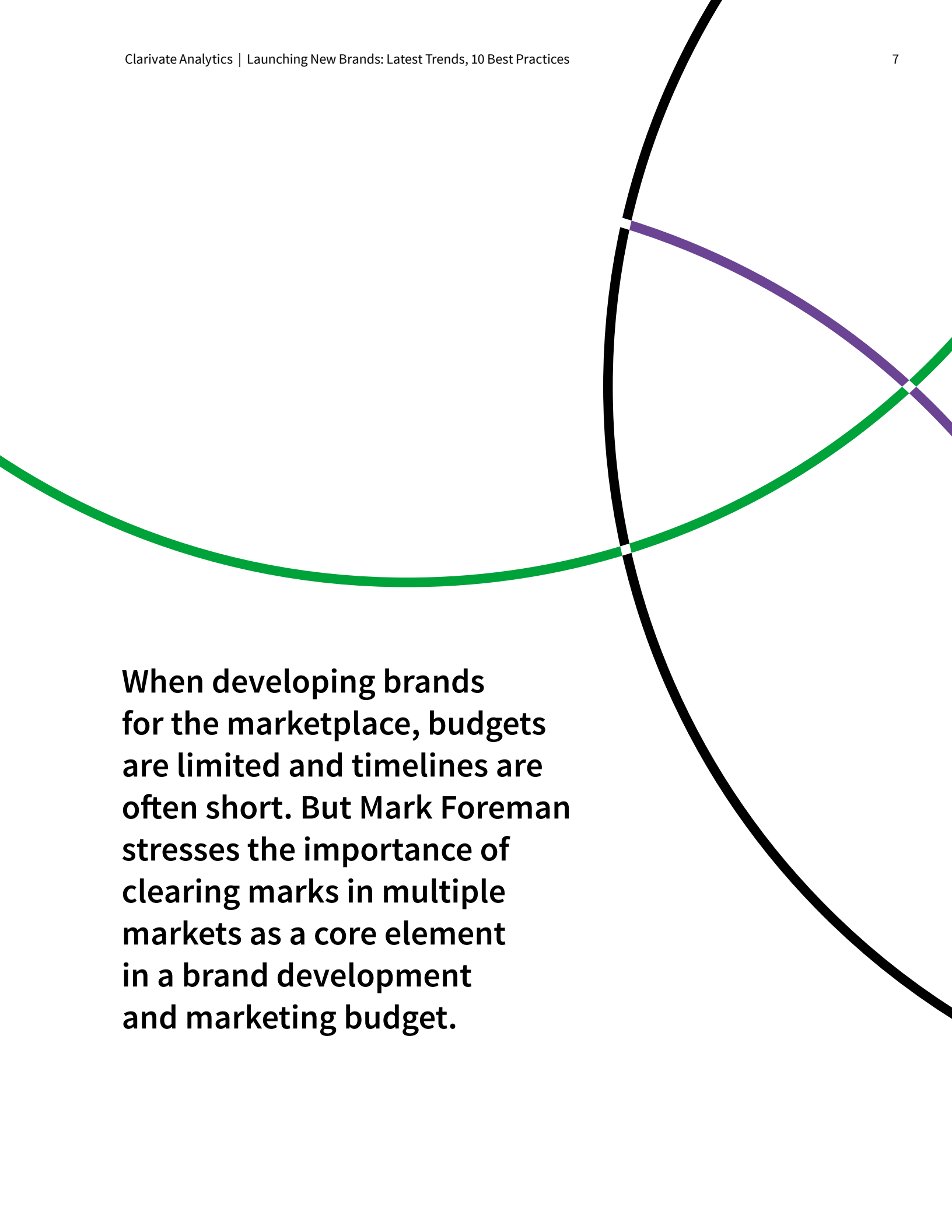
When developing brands for the marketplace, budgets are limited and timelines are often short. But Foreman stresses the importance of clearing marks in multiple markets as a core element in a brand development and marketing budget.

"The cost of clearing a brand is dwarfed by the budgets for the branding exercise and the marketing. And sometimes you have to take a little from those other budgets to make clearance happen," he says. "But it's cheaper to get it right at the outset and to spend that little extra to ensure good trademark clearance, protection and enforcement. That's so much better than finding yourself on the back foot, trying to buy your way out of problems. After all, no one likes paying money to lawyers."

*“It's critical to have a watertight agreement that ensures all IP is owned by the client and that all uses of the brand are reviewed and controlled by the client. It should also spell out what happens when that relationship comes to an end.”*

— Mark Foreman,  
Rouse, London, UK





When developing brands for the marketplace, budgets are limited and timelines are often short. But Mark Foreman stresses the importance of clearing marks in multiple markets as a core element in a brand development and marketing budget.



## About the Expert

**Mark Foreman** is an attorney and executive with international IP firm Rouse in London, UK, having developed the firm's international trademark practice. Highly respected in the IP legal field, he was elected a Fellow Member of the Institute of Trade Mark Attorneys (ITMA) in 1996 and has served on the ITMA Council and acted as an ITMA Examiner. He is a European Trade Mark Attorney and an Associate Member of INTA. He was named among the most highly regarded trademark attorneys by Who's Who Legal Trademarks 2015 and ranked Silver for Prosecution and Strategy in the 2015 WTR 1000. He lectures widely on a range of trademark and related issues.

## CompuMark

*CompuMark* provides the industry's broadest range of trademark research and brand protection solutions. We enable trademark and brand professionals worldwide to launch, expand and protect strong brands through unmatched global content, expert analysis and tools, and best-in-class service.

## Clarivate Analytics

*Clarivate Analytics* accelerates the pace of innovation by providing trusted insights and analytics to customers around the world, enabling them to discover, protect and commercialize new ideas faster. Formerly the Intellectual Property and Science business of Thomson Reuters, we own and operate a collection of leading subscription-based services focused on scientific and academic research, patent analytics and regulatory standards, pharmaceutical and biotech intelligence, trademark protection, domain brand protection and intellectual property management. Clarivate Analytics is now an independent company with over 4,000 employees, operating in more than 100 countries and owns well-known brands that include Web of Science, Cortellis, Thomson Innovation, Derwent World Patents Index, CompuMark, MarkMonitor and Techstreet, among others. For more information, visit [clarivate.com](http://clarivate.com).

Learn more about our trademark clearance solutions at [compumark.com](http://compumark.com).

### AMERICAS

Main office (USA): + 1 (800) 692 8833  
[compumark.us@clarivate.com](mailto:compumark.us@clarivate.com)

Canada: + 1 (800) 561 6240  
[compumark.ca@clarivate.com](mailto:compumark.ca@clarivate.com)

### EMEA

Main office (Belgium): + 32 2 200 89 98  
[compumark.be@clarivate.com](mailto:compumark.be@clarivate.com)

UK: + 44 020 3564 5888  
[compumark.uk@clarivate.com](mailto:compumark.uk@clarivate.com)

France: + 33 01 57 32 47 99  
[compumark.fr@clarivate.com](mailto:compumark.fr@clarivate.com)

Italy: + 39 02 23 33 1221  
[compumark.it@clarivate.com](mailto:compumark.it@clarivate.com)

Germany: + 49 69 153 253 300  
[compumark.de@clarivate.com](mailto:compumark.de@clarivate.com)

[compumark.com](http://compumark.com)  
[clarivate.com](http://clarivate.com)

03.2017

© 2017 Clarivate Analytics