

Protecting One's Trade-Marks: A Winning Strategy

By Diane Bellavance

Trade-Marks

Are your products and services known under a trade-mark or a logo? Do you wish to continue increasing your market share? Do you devote an increasingly sizeable part of your budget to advertising, promotion and the branding of your business?

Registration of your trade-mark or logo is crucial. Unfortunately, too often, trade-marks used by a business are not registered even though they are being used. A trade-mark, under certain circumstances, may have an economic value that is greater than the products sold by the business (for instance, the "Coca-Cola" brand is worth more than the tangible assets of its owner). A trade-mark represents the reputation and the recognition afforded to the product associated with the business in terms of quality, its specific characteristics, etc. Under certain circumstances, it even enables the manufacturing of products under license (known as *branding*; for instance: "Jeep" backpacks, "Caterpillar" hiking boots) and the trade-mark will be especially significant as part of a sound marketing program through *licensing*.

Any serious sub-licensee who knows his market well will require not only a patented or otherwise protected product, but also a duly registered trade-mark. The protection, quality and economic value of a trade-mark should be established from the outset.



The trade-mark agent is the only accredited professional entitled to advise you throughout the trade-mark registration process as to the selection of the mark, the manner of registration, the filing for the purposes of registration and the follow-up, once the trade-mark has been duly registered. The trade-mark agent may also advise you on the registration of your trade-mark in the United States, Europe and elsewhere throughout the world.

Trade Names and Trade-marks

With the increase of competition in the business world, companies are devoting an increasingly significant part of their budgets to creating an image for their business. Many companies wrongly believe that incorporation provides an adequate protection of the name and image of a business.

It should first be noted that incorporation is the legal vehicle through which the business carries on its activities. The trade-mark, for its part, is property to the same extent as a chair, a computer or any other asset of the business. The trade-mark is the name or logo distinguishing the product or service sold by the business. It is worthwhile to examine whether a business name ought to be registered as a trade-mark.

Domain Names and Trade-marks

A domain name is not a trade-mark but rather is the equivalent of an electronic address made up of various characters. The owner of a domain name who wishes to enjoy exclusive use thereof must also register it as a trade-mark, failing which he or she runs the risk of being sued for infringement of the intellectual property rights of the owner of a similar trade-mark duly registered in a given country. Furthermore, where a business files an application for registration of a trade-mark, it should, at the same time, register its domain name, including any variations of the trade-mark (for instance ".biz", ".net", ".com").



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The “cybersquatter” phenomenon underscores the significance of reserving one’s domain name. Cybersquatters register domain names corresponding to the names of famous or registered trade-marks and then attempt to sell them to the owners of such trade-marks. Cybersquatters essentially hold the domain name hostage until the owner of the trade-mark pays “the ransom” requested. Even if arbitration procedures have been implemented to protect the owners of registered trade-marks, it is sometimes less costly to pay the price sought by the cybersquatter than to initiate such an arbitration process.

Should you have any questions, please do not hesitate to contact Diane Bellavance of the firm of *Lavery, de Billy* at (514) 877-2907 or via E-mail at dbellavance@lavery.qc.ca.

We also invite you to visit our Web site at www.laverydebilly.com.

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