

# “Teaching Trademark Portfolio Management”

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European Intellectual Property Teachers' Network Workshop

4-5 July 2016, Sofia

➤ The course in “Brand and Trademark Management” at UNWE

➤ Bachelor’s program in Intellectual Property

Mandatory course

about 50 students per year

Since 1994

➤ Bachelor’s program in Industrial Business

Elective course

about 25 students per year

Since 2015

## FOCUS (presented last year in Riga):

- The interaction between brand management and trademark management (interdisciplinary approach)
- What an interdisciplinary approach to brand and trademark management can give students in economics and management
- The importance of collaboration between marketers and lawyers toward:
  - ✓ preservation and increasing of brand equity
  - ✓ and strong trademark rights over the brand.

# Structure of the course

## Section I

Brand from marketing perspective (Brand management)

## Section II

Trademark management (a new special feature of the course)

## Section III

The interaction between brand management and trademark management

# Section II

## Trademark management – objectives

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- There is a commonly shared view that teaching trademark management of non-lawyers and in particular of students in business and management must aim to give students basic knowledge on the trademark rights, so that they become better entrepreneurs and managers;
- There is no doubt that **the interdisciplinary knowledge about brand and trademarks is an unique advantage for taking a job position in the marketing and advertising departments of medium and big companies;**
- My personal contacts and observations show that many of our students in business and management work after graduation in positions where the interdisciplinary knowledge about brands and trademarks is a unique advantage.

## Section II

# Trademark management – new objectives

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- Over the years, the practice of trademark management in Bulgaria has changed as many companies and entrepreneurs have discovered that much of a business's value may be associated primarily with its name and core marks.
- Unless the corporation is large, **corporate legal team is the only responsible for trademark portfolio.**
- Some companies entrust their portfolios to a paralegal or trademark specialist who is not an attorney;
- Recently, we as paralegal educators have detected another trend requiring flexibility and creativity in curriculum design.

# Our approach

- Our approach does not share the common view that trademark paralegals handle only administrative work and are involved in formal correspondence between the trademark attorney or lawyers and Patent Offices;
- The in-house trademark specialist and trademark paralegals are a vital part of the business team responsible for protecting the valuable trademarks of the company and for developing and implementing strategies to enhance and leverage the brand identity of the corporation;
- The in-house trademark specialists or paralegals generally are responsible for close cooperation between the corporate legal team and the marketing, advertising, communications and product line management departments of the company that trademark practice in a company requires.

# ...our approach

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- More and more graduates are seeking and are finding paralegal employment outside the traditional tasks in a law office ;
- There are opportunities for trademark paralegal employment in corporations, governmental entities, and law-related bodies;
- Freelance or contract paralegal opportunities are also increasing;
- New educational obligations arise for educators.



# Teaching Trademark Portfolio Management

- Teaching Trademark Portfolio Management is a new special feature of the course “Brand and Trademark Management” at UNWE for the students in Bachelor’s program in Intellectual Property;
- In Section II “Trademark management” of the course in “Brand and Trademark Management” we approach new objectives:
  - ✓ the course underlines and highlights the **steps in Managing Trademark Portfolio, as a responsibility of in-house trademark specialists and paralegals;**
  - ✓ it addresses how trademark rights are acquired, exploited, enforced and maintained, in order to maximize their value to the business.

## Section II

# Trademark management – teaching and training about Managing Trademark Portfolio:

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- Trademark portfolio planning;
- Develop a protection or rights acquisition strategy;
- Secure the appropriate or necessary rights;
- Update the portfolio;
- Trademark use audit.

# Trademark portfolio planning

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- A trademark audit is a useful tool for determining and reviewing the status of a company's trademark portfolio;
- Determine which marks are important and protectable;
- Identify valuable distinctive signs, other than brand names, such as slogans, packaging, colour itself;
- Determine which jurisdictions are important from a business and marketing perspective.

# Develop a protection or rights acquisition strategy

- Assessing the potential risk of a brand under trademark law:
  - ✓ doing search for prior trademark rights in public sources  
(WIPO's ROMARIN, TM View, web sites of national trademark offices);
  - ✓ violation of morality, misleading...;
- Assessing the trademark filing options according to the particular business situation:
  - ✓ filing systems: national applications; international applications; EUTM applications; international applications designating EU;
  - ✓ advantages and disadvantages: time; costs; number of countries; special options (CTM seniority, CTM conversion, IR opting back conversion by territorial extension, IR transformation);
- Advise on protection mechanism and secure the appropriate rights.

# Update the portfolio

- Update the portfolio and ensure that the portfolio management strategies are aligned with your overall business strategy, competitive intelligence and market analysis;
- Periodically review and assess trademark portfolio:
  - ✓ the audit can reveal unused or expiring trademarks or disclose defects in the rights so that remedial steps may be taken (e.g., by registering, renewing or using the mark);
  - ✓ the audit can also identify trademarks which are no longer aligned with the business and assist it in determining the appropriate action to take (e.g., to shed or license the asset).

# Trademark use audit

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- A critical aspect of managing trademark portfolio is to guard acquired trademark rights against cancellation as a result of non-use;
- Another aspect of the audit of trademark use is the manner in which own trademarks are used, in particular if it enables them to acquire, or maintain, their distinctiveness;
- It is important to ensure correct usage of own trademarks in order to avoid loss of their distinctiveness and becoming generic as well as loss of their value as trademarks, and rights' cancellation.

# ... trademark use audit

- The in-house trademark specialists and paralegals are generally responsible for reviewing advertising and promotional materials, manuals, internal and external communications (such as newsletters, press releases and annual reports), sales and packaging materials, corporate websites, and technical specifications for the proper use of trademarks;
- He or she is often asked to conduct training sessions for company employees on the proper use of company's and third parties' trademarks, and to create and maintain a brand identity manual for the company.
- He or she often oversees any licensing programs involving the corporate marks.

# Enforcement actions

- Apart from some more offensive enforcement strategies including:
  - ✓ appealing or opposing applications or registrations and
  - ✓ issuing cease and desist letters
- the trademark in-house paralegals can be extremely useful in enforcement:
  - ✓ educating the consumer and resellers on how to identify the genuine product;
  - ✓ watching programs involving infringing or diluting use of the corporate marks by the company's competitors and other third parties.
  - ✓ identifying of infringement or dilution cases (distributors, company's competitors and other third parties);
  - ✓ publishing warnings to infringers and
  - ✓ working with customs and border control agencies.



# Summary

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- As usually happens, the practice shows us an important way to improve teaching “Brand and Trademark Management” and the course content so as to meet the new needs of the labour market;
- Our 22 years of experience in teaching “Brand and Trademark Management” gives our students a greater chance of finding a job after graduation as trademark specialists and paralegals in companies and IP law firms.

*Thank you for your kind attention!*

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