



# Strategies to Combat IP Infringements

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We all have heard words like:



# Let's start with a case study.

*An example of how someone is abusing a trademark – Coming to America film from Paramount Pictures, 1988.*



# Two similar images.

*Image: Coming to America 1988 film by Paramount Pictures.*



*Manchester, 1988. The 1st McDonald's drive-thru restaurant in the UK (Image: Manchester Local Image Collection at Manchester City Council)*



**The Golden Arches (McDonald's)**  
**vs.**  
**The Gold Arcs (McDowell's)**



# The Big Mac (McDonald's) vs. The Big Mick (McDowell's)

INGREDIENT	 BIG MAC	 BIG MICK
TWO ALL-BEEF PATTIES	✓	✓
SPECIAL SAUCE	✓	✓
LETTUCE	✓	✓
CHEESE	✓	✓
PICKLE	✓	✓
ONION	✓	✓
BUN	✓	✓
SESAME SEEDS	✓	



**Even if it's a purely hypothetical example, it's a good one to illustrate how important it is to protect your brand!**



# IP is one of your most valuable assets!

*Intellectual property can take various forms, and each must be secured using distinct strategies.*





# The most common types of Intellectual Property Protection you might encounter

## Copyright

Copyright (or author's right) is a legal term used to describe the rights that creators have over their literary and artistic works. Works covered by copyright range from books, music, paintings, sculpture, and films, to computer programs, databases, advertisements, maps, and technical drawings.

## Trademark

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Trademarks are protected by intellectual property rights.



# The most common types of Intellectual Property Protection you might encounter

## Patents

A patent is an exclusive right granted for an invention, which is a product or a process that provides, in general, a new way of doing something, or offers a new technical solution to a problem. To get a patent, technical information about the invention must be disclosed to the public in a patent application.

## Trade secrets

Trade secrets are intellectual property (IP) rights on confidential information which may be sold or licensed. This can include including formulas, programs, and data. Trade secrets grant one party an economic advantage over competing interests.



# Strategies to combat IP infringement

*Let's look at strategies to combat patent and trade secret infringement in brief:*

- A **patent** application clearly signifies that you were the first to file your patent as it is the best way to ensure the secrecy of your non-commercial intellectual property. It's also advisable to publish a reference to your patented invention wherever your company's name is mentioned.
- The best way to safeguarding your **trade secrets** is through adequate security controls e.g., by installing tight security controls in your computer systems, such as an intrusion detection system, a security monitor, a defensive firewall and more. It is also essential to include appropriate clauses in employment contracts when hiring new employees to ensure that they do not bring in/use trade secrets from previous employers.

Depending on your products and services a tailored strategy should be applied to protect your IP.

I will focus today on strategies to combat Trademark infringements.



# Let's look together at the most common pitfalls and mistakes businesses come across

## Too slow with the trademark registration procedure

- Sometimes you forget how important it is to protect your trademark because of the enthusiasm for the new product. Ideally, registration should be done before the product is launched on the market.

## Inadequate checks and searches are carried out

- In any case, a comprehensive due diligence check should be carried out, including checking the name to ensure that there is no other company with a similar name, logo, or trademark. The aim is to ensure that the trademark cannot be disputed, and that money has not been invested in vain.
- You should also not forget that incomplete protection of your intellectual property can also be a value-reducing factor in the future when it comes to your business's valuation or sale.



# Let's look together at the most common pitfalls and mistakes businesses come across

## Not getting all the rights and agreements you need

- As you build your business and brand, you are likely to work with external suppliers with whom you should have binding contractual agreements. This should make it crystal clear who owns the intellectual property rights of the work you produce together.
- For example, if you use a brand designer or external agency to create logos, brand messages and other content, they may own the intellectual property for those elements. It is crucial that you own these assets – and you should seek legal advice to make sure that you have written agreements signing copyright over to you.



# Let's look together at the most common pitfalls and mistakes businesses come across

## Be specific, but don't miss the bigger picture

- Variables such as the exact choice of words, design elements and even punctuation can determine how well your trademark is protected in the event of a possible trademark challenge.
- It is important that you also register your trademark in all classes of goods in which you want to market your product or service. Within these classes, you may need to further specify the product and/or service you wish to protect to counteract any potential risk of confusion.
- Concentrate not only on your logo, but also on registering your trademark as a word mark and not just as a figurative trademark. A word mark generally guarantees the highest level of protection. You may also want to evaluate whether you can protect similar-sounding names that could be closely associated with your trademark.



# Let's look together at the most common pitfalls and mistakes businesses come across

## Failure to renew your rights

- Trademarks expire 10 years after the filing date and can be renewed from six months before the expiry date. If you miss the date, you also have a chance within a grace period of 6 months post the expiry date to renew against payment of additional fees. Past that period, you can only apply to restore the mark to the register, but you must prove good reason for not renewing with the term or the grace period.

## Failure to protect your brand

- You should always ensure that your trademark portfolio is actively managed.
  1. You should actively monitor the use of your trademark so that you can take immediate action against third parties if they use a name or logo that is similar to your registered trademark. If you fail to do so, your trademark may be diluted or damaged.
  2. If a third party applies for a trademark, you should be informed so that you have the opportunity to oppose the third party's application to prevent registration.



# Strategies to combat Trademark infringement

## 1. *Run an Assessment*

- Determining the best way to protect intellectual property in line with your product and services your company offers or will offer in the future.
- Assess and analyse the market landscape, competition, and potential infringement risks specific to your industry and to your products and services.
- Evaluate your IP portfolio and potential risks.

A collaboration with Legal Experts to support you in the process might be a good idea.





# Strategies to combat Trademark infringement

## 2. *Ensure Registration*

- Consult your in-house legal team or an external IP lawyer to support you with the registration of your Intellectual Property Rights. They will ensure that you register in the applicable classes and in all relevant countries for your business's purposes.
- Ensure you use your trademarks in the countries where they have been registered to avoid a cancellation request by a third party for non-use. The burden of proof lies with you to show the trademark has been used.
- Make sure to maintain your protection:
  - Trademarks have a 10-year lifespan and require active renewals;
  - patents mostly have a 20-year lifespan;
  - copyright have a 70-year lifespan, and;
  - trade secrets lifespan is indefinitely or in other words until they are no longer secret.

Therefore, renew your IPRs on time, ensure continuous use and file the paperwork documenting use.



# Strategies to combat Trademark infringement

## *3. Ensure ongoing market observation*

- *Keep an eye on your industry and your competitors.*
- The easiest (and cheapest) way is to set up internet search alerts to notify you about words and phrases like yours.
- Consider investing in a trademark search firm to do deeper search on your trademark usage.



# Strategies to combat Trademark infringement

## 4. *Legal remedies and measures to be taken*

- Ensure you use non-disclosure agreements ('NDAs') when sharing confidential information with employees, contractors, or partners. An NDA can be enforced legally if breached.
- **Ensure you have trademark licensing written agreements in place.** The agreement should not only detail the term but also be very explicit about the conditions:
  - Quality control provisions
  - Name of the licensor and the licence holder
  - Type of licence
  - Scope of the licence granted
  - Trademarks covered by the licence
  - Products or services for which the trademark can be used
  - Identification of the territory
  - Payment details
  - Term restrictions



# Strategies to combat Trademark infringement

## 5. *Legal measures in the event of trademark infringement*

Trademark law protects a trademark owner's exclusive right to use a trademark when use of the mark by another would be likely to cause consumer confusion as to the source or origin of goods.

- The most common legal remedy for trademark infringements is **injunctive relief**. Injunctions are court orders requiring the infringer to immediately cease their unlawful behaviour.
- Another option that can be considered under certain circumstances is a so-called **coexistence agreement**. Coexistence of trademarks describes a situation where two different companies use a similar or identical trademark to market a product or service without necessarily interfering with each other's business, meaning in different trademark classes. This type of agreement aims to resolve a potential trademark dispute.

The burden of proof lies here with the plaintiff who must prove that the defendant's use of a mark has created a likelihood-of-confusion about the origin of the defendant's goods or services.



# Strategies to combat Trademark infringement

## 6.1 Legal measures in the event of trademark dilution

The dilution of a trademark must be distinguished from trademark infringement.

Dilution means the use of a trademark or trade name that is sufficiently similar to a famous trademark that by association confuses or diminishes the public's perception of the famous trademark.

Dilution can be divided into three types :

- **Blurring** is when the use of a similar or identical trademark impairs (or diminishes) the distinctiveness of the famous mark.
- **Tarnishment** happens when someone links a famous trademark to poor-quality products or services to depict the trademark or its owner in a scandalous or unflattering way.
- **Free-riding** is when a trademark owner starts exploiting the benefits of a positive association between the owned and a famous mark.



# Strategies to combat Trademark infringement

## 6.2 Examples for trademark dilutions

Tarnishment



Freeriding



# Strategies to combat Trademark infringement

## *6.3 Legal measures in the event of trademark dilution*

Dilution differs from normal trademark infringement in that no likelihood of confusion has to be proven in order to protect a trademark.

Instead, all that is required is that use of a 'famous' trademark by a third party causes the dilution of the 'distinctive quality' of the mark.

Usually, the remedy obtained in a successful suit is an injunction against any further dilution.

However, if the plaintiff can show that the defendant wilfully sought to 'trade on the owner's reputation or to cause dilution of the mark,' attorney fees, monetary damages, and even triple damages would be available.



# Strategies to combat Trademark infringement

## *7. Additional options to combat trademark infringement*

- Ensure you have an inhouse team or a third party engaged to continuously monitor your Trademark Portfolio.
- Register your Trademark on all Social Media Platforms you are using or intent to use in the future – register before others do it instead of you.
- Register your domains in all relevant markets.
- Consider using AI tools to monitor internationally – there are great providers with very efficient ways to close down any form of infringements.







**Thank you very much  
for your attention.**