



## Protecting Your Brand – The “Dos and Don'ts” of Entering Emerging Markets

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## Emerging markets – our focus

- © “BRIC” – Brazil, Russia, India, China
- © The 7 largest “emerging economies” by GDP are the “BRIC” countries + Mexico, Indonesia & Turkey
- © Other definitions – “BRICS” (+ South Africa), “BRICK” (+ South Korea), BRICM (+ Mexico), etc.
- © World Bank Report, May 2011 – BRIC + South Korea & Indonesia will have > 50% of global economic growth by 2025
- © In 1<sup>st</sup> quarter 2011, emerging market hedge fund capital was \$121 billion.

## Selecting your mark

- © English or invented word – but does it mean something (else) in local market?
- © Negative/offensive/taboo connotations? E.g. PROVO (KIA)
- © Ease of pronunciation?
- © Translation or transliteration?
- © Use of appropriate non-Latin characters
- © Which language?
- © Is translation appropriate to target market/demographic?
- © Importance of local knowledge - use your contacts!

# Availability and searching

- © “First to use” or “first to file”?
- © Search or file?
- © When and where to search – and how much?
- © Local agent/manufacturer, etc., issues



## Going forward – filing applications

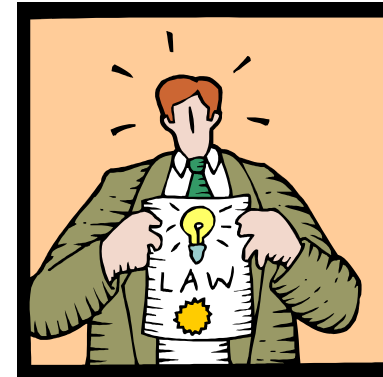
- © International vs national
- © Madrid Protocol – China, Russia, Mexico, Turkey, South Korea, but NOT India, Indonesia or Brazil
- © Single class/multi-class jurisdictions
- © Classification issues – interpretation of Nice Agreement
- © Use/intent-to-use/proposed use requirements
- © Word counts – extra costs
- © TLT - harmonisation
- © Hidden costs – legalisation, translation, local publication, additional supporting documentation, late filing, etc.

- © “Do TM rights date from filing or registration?”
- © Prosecution delays in key territories
- © Does TM protection process fit in with product “lifecycle”?
- © Response deadlines can be very short



# Use and enforcement of registrations

- © Proper marking – ® or TM/SM?
- © Use of mark in form registered
- © Proof of registration of International Registrations – issuance of national certificates
- © Additional documentation requirements?



## Miscellaneous matters...

- © Set up watching service for your own marks – and/or those of your competitors!
- © Customs provisions
- © Anti-counterfeiting issues
- © Domain name issues – registration, scams, etc.



## China – Particular issues

- © Rights through registration – “first to file”: importer beware!
- © Translation/transliteration issues
- © Classification interpretation issues
- © Single class national vs multi-class international
- © Extra fees for lengthy specifications
- © Lengthy examination process – 3-4 years from filing, but...
- © Short deadlines for official responses!
- © No registration certificate for International Registrations
- © Customs provisions
- © Difficulties in enforcement

## India – Particular issues

- © “Common law” country, so can acquire rights through first use
- © Not a signatory to Madrid Protocol ...yet!
- © “English” marks generally sufficient, but obtain local advice from your distributor/licensee. Several hundred languages in India; “Standard Hindi” is official language of government, written in Devanagari script.
- © Considerable delays in Indian TM Registry in prosecution, opposition, revocation, etc. – 2-3 years minimum
- © Examination process fairly erratic; many errors in official certificates, results in delays for corrections.
- © Enforcement process is also slow through courts – specialised appellate boards have been set up to speed up the process
- © Certificate of Registration cannot be used in legal proceedings; is necessary to obtain Legal Proceeding Certificate from Registrar.

- © Brazil – “first to file”; single class – registration mandatory to establish rights. Extreme delays in prosecution of applications (min. 3-4 yrs from filing). Not (yet) a signatory to International Registration system.
- © Indonesia – multi-class, but additional charges for each item of goods or services over three. Not IR signatory.
- © Russia – “first to file”, multi-class, IR signatory; no provision for opposition of an application: have to seek cancellation afterwards, no later than 5 years from publication
- © Turkey – “first to use” jurisdiction; multi-class, IR signatory
- © Mexico – “first to file” jurisdiction; single class, registration is mandatory if the mark is in use in Mexico; IR signatory

# Thank You!

## Questions?

## Prize Draw

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