

Making a mark

The need for – and benefits of – a single repository for global brands

Thomas Golsong

Until recently, the only port of call for detailed brand information i.e. who owns a brand and for which goods and services it is registered, has been the well-established trademark search process. This process involves the vast number of government-operated trademark registries around the world. Many of these registries have existed for a long time – some created long before the car was invented – and unfortunately the same processes remain in place today, made more complex by the fact that the legal aspects of trademark protection have evolved differently in the various countries. There are no synergies, nor common views as to how to deal on a multinational basis with trademark information. As a result of this, brand custodians can spend literally months and huge amounts of money, researching the availability of a single brand. The Community Trade Mark registration system, administered by the Office for Harmonisation in the Internal Market (OHIM), does not have a remit beyond the European Community and there are no political or legal entities trying to address such issues on a global basis.

Fragmented Registries

The generally antiquated trademark registry systems, and the differences that exist from one country to another, pose a problem for brand managers and legal teams involved in checking the availability of new brands across a broad geographic spread or even for existing brands entering new foreign markets. The range of signs used by brand owners to signal their products or services have steadily expanded beyond the traditional words and logos and now include shapes, symbols, colours, sounds and animations. However, many registries have failed to adapt their laws and systems to permit registration of these as trademarks, making it difficult to protect all the elements that comprise a brand. Brands are not static, nor do they only appear in black and white. Trademarks live through brands, and brands are colourful, shapely devices that consumers associate with specific services and products. The world has become graphically astute, and we are bombarded every single day by images, sounds and moving features. Brands are recognised by their shapes and colours more than through words or names in a global, multicultural and multilingual context. These are realities which the old systems fail to address. Nobody can justify having to spend half-a-million dollars and wait months for poor quality, black-and-white photocopies to come back when carrying out a device

mark search across multi-country lines. New products are launched more frequently and the speed to market grows ever faster. In addition, the lifecycle of brands is often far shorter than that of trademarks, which can in many cases take several years to achieve registration.

The Case for Global Brand Visibility

There are many barriers to brands trying to evolve vertically across new products or service groups, or horizontally into new territories. Take, for example, the existing mark of a small local company. Its registered mark can stop larger companies from entering the market with a new product if the smaller company can prove that its mark is recognised locally and that local consumers would be confused by the new entrant and that the newcomer's mark would damage its business. Similarly, a larger well-known corporation with a "famous mark" can often prevent smaller players from entering new markets or market segments based on the reputation and goodwill that the larger corporation enjoys, even if its trademark is not registered in the country concerned for the relevant goods or services.

So, the question remains, if a brand exists but it is not visible to those creating new brands or planning brand extensions, how can one take care to avoid running into trouble? The Internet provides a potential solution

and RioBrand is providing the vehicle for change.

An Online Solution

RioBrand, a London-based company, is the first global resource for brands and is unique to the highly specialised trademark registry market. RioBrand, is attempting to meet the needs of marketers, whilst trying to conciliate the needs of brand custodians and legal practitioners as well. Currently, there is no worldwide repository of brand intelligence, and RioBrand aims to become the first port of call for clearing existing and newly launched brands at the early stages of a design program. RioBrand is not bound by any legal or political pressure groups to conform with any specific legal framework, but rather is an independent, impartial and truly 'open' resource for all businesses, whether they own registrations or not. RioBrand offers two unique benefits to anyone who looks after brands – visibility and protection – and the two are inextricably linked.

Now even small companies can inexpensively signal the existence of their brand properties by registering with a single online entity. Similarly, large corporations can instantly give notice of their brands by depositing them with RioBrand to give notice to potential infringers. For attorneys, when clients approach them with an idea for a new brand, company or logo, the initial mark search could be much more valuable than in the past by utilising RioBrand's database. The free service would allow them to perform brand identity searches on colours, designs or logos, as well as WIPO international filings. RioBrand earns its revenue from the companies that list their brands on the site.

These search features hold tremendous appeal for one intellectual property attorney working in California. "RioBrand will be one of the best places to start the full-search process when developing brands," said Todd Bontemps, an associate in the Trademark, Copyright and Advertising group at Cooley Godward, LLP. "Most

trademark registries around the world still publish all of their pending registrations in black and white. This is somewhat ludicrous as the purpose of the 30-day 'advertising' period in the US (also referred to as the 'publication' period in the U.S.), which follows the acceptance of the application is to demonstrate to the public how the mark actually appears in commerce. If I am concerned about a competitor's mark, I want to be able to see it in full living colour as it will appear on the product itself."

An infringement lawsuit could result in a huge loss of income, among other problems, and brand managers,



designers, attorneys and custodians who struggle with these issues under the current systems could find that the RioBrand solution might help fulfil their needs. Bob Boad, Senior Trade Marks Adviser at BP, agrees. "The RioBrand system will surely become a key resource for searching and viewing brands worldwide," said Boad. "It differs from formal national registries in several important respects: data registration takes moments rather than years; it provides global rather than national or regional visibility; and it can cope with an exhaustive range of trademark types, including sounds and moving images online. It should have an essential role to play in future brand development and clearance programmes."

The Future

These days, the issue of trademark protection does not just apply to a company's logo or brand name but extends to the unique packaging or design of the product itself – its look and feel which you could call the 'DNA' of a brand.

Brand owners are looking at ways to represent this brand DNA in a cost effective and efficient manner, in ways that go beyond acquiring formal design patent, copyright or trademark rights.

However, current registries are not able to represent product images in a meaningful manner. To address this important issue, one of the innovative features that the RioBrand team has developed is a tool which presents a revolving 3D graphic of the product and its packaging. This gives the user a 360-degree view of the particular product.

Finally, consider those companies that need protection but do not have a tangible product, only software codes and colour schemes. For 100 percent online companies (as opposed to a 'bricks and mortar' retail shop), their 'store front', 'product packaging' and 'marketing and advertising channel' is their homepage. Therefore, to the extent that a site displays a distinctive look or feel for a type of goods or service – based on a combination of colour, arrangement, animation, sound, etc. – trade dress protection, as well as copyright protection, should be available for their website. The problem is that copyright offices and courts are grappling with how to incorporate this area of IP with a relatively archaic system in place. In the future, RioBrand can benefit companies that are 100 percent online to the same extent as 'traditional' companies because thumbnails or screen shots can be submitted and searched in much the same way as a brand or logo.

For now we must continue to work within the confines of the current system, but clearly the Internet has opened the door for an alternative that can supplement it and overcome many of its deficiencies.

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