

SMART & BIGGAR

Protecting Brands and Copyright Online.

Speakers: Daniel Anthony and Mark Biernacki

Thursday, July 13, 2023

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Our Speakers



Daniel Anthony

Principal,
Barrister & Solicitor
Trademark & Patent Agent

- **Notable Practitioner**
(MIP IP Stars Handbooks 2021 - 2022)
- **Ranked for Prosecution & Strategy and Enforcement & Litigation**
(WTR 1000 – The World's Leading Trademark Professionals: 2021 - 2023)
- **Leading Trademark Practitioner**
(Euromoney LMG Expert Guides: Trade Mark: 2020)



Mark Biernacki

Principal,
Barrister & Solicitor
Trademark & Patent Agent

- **Litigation Star in IP**
(Benchmark Canada 2015 - 2023)
- **Leading Trademark Practitioner**
(Euromoney LMG: Expert Guides: Trade Mark: 2014 - 2020)
- **IP Star in Trademarks**
(MIP IP Stars Handbook Trademark & Copyright: 2018 - 2023)

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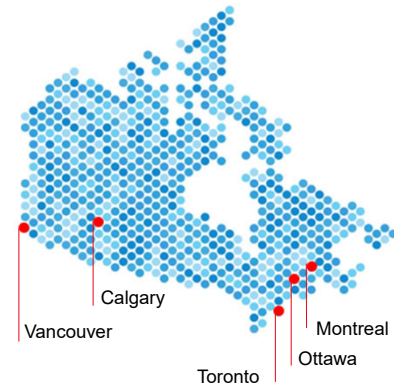
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Who We Are

Canada's **leading IP law firm**
with expertise at the interface of
technology and **business** law

- Expertise in all areas of IP
- 130+ years serving clients
- 100+ lawyers, agents and technical consultants
- 8,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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Today's Agenda

1. Three Scenarios – Hijackers, Trolls and Pirates (oh my)
2. Why Protecting IP is Important?
3. Proactive Tools
4. Reactive Tools
5. Practical Application to Scenarios
6. Questions and Answers

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1. Three Scenarios

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Scenario #1 - The Hijacker

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- Brand owner starts selling online
- Counterfeiter hijacks successful listing with low cost counterfeits
- Negative customer reviews and lost sales.
- What could they have done differently?
- What can they do now?

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Scenario #2 - The Trademark Troll



- Brand owner runs a successful online store on Amazon.ca
- A troll registers the owner's brand in Canada
- The troll uses takedown requests to shut down the brand owner's online store and demands payment to assign the registration to the brand owner
- What could the owner have done differently and what can they now do?

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Scenario #3 - The Media Pirate



- Brand owner sells video games
- They discover a Canadian operating a website that provides links for downloading pirated copies and offering "mods" for cheating in the video games.
- The website is hosted abroad and the links lead to various cyberlockers
- What options are available?

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2. Why protect IP?

Hint: value, value, value

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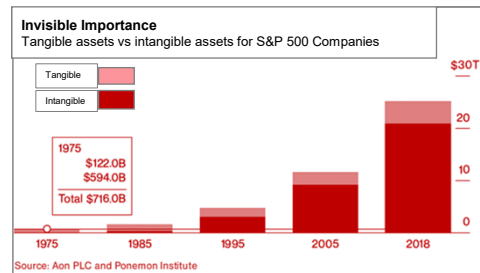
What is the value of IP?

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Almost every business undervalues its intangible assets....

“Intangible assets are estimated to account for over 80% of the S&P 500’s market value”
(compared to only 17% in 1975)

Bloomberg, October 21, 2020, 6:00 AM EDT



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Where is the value of IP?

IP rights can create value by (among other *things*):



Providing market exclusivity



Enhancing price of products and services



Being bought, sold and licensed



Enhancing company valuation



Serving as collateral / security



Providing vehicle for tax optimization

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3. Proactive Tools

An ounce of prevention is worth a pound of cure

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Proactive Tools



Identify New Marks and Copyrights



Timely Registration



Proper Marking



Ensure Ownership



Brand Registry



Request for Assistance (RFAs)



Anti-counterfeiting Measures



Technological Protection Measures



Smart Contracts



Monitor Register and Marketplace

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4. Reactive Tools

What happens is not as important as how you react


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Reactive Tools




Expedited TM Examination and © Registration




Opposition Proceedings




Takedowns



Domain Name Arbitration



Border Enforcement




Reporting to Canadian Anti-counterfeiting Centre

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Reactive Tools continued...




C&D Letters



Legal Proceedings

Action vs Application
Available Claims?
Available Relief?



Educate Consumers

Educate your customers to help them remain brand loyal
Make them aware of fakes and counterfeiters, and risks
Provide marks of distinction and proof of authenticity for products

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5. Scenarios Revisited

I wish I knew then what I know now

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Scenario #1 – The Hijaker

Proactive Steps

- Timely filing of TMs
- Participate in online brand protection programs
- Build-in indices of authenticity

Reactive Steps

- Expedited TM examination and © registration
- Educate customers by amending listing (e.g. only ships from N. A.)
- Work with online platforms to resolve infringement
- Customs recordals

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Scenario #2 – The Trademark Troll

Proactive Steps

- Timely registration of TMs & ©
- Monitoring programs
- Opposition

Reactive Steps

- C&D
- Non-use cancellation
- Litigation
 - Expungement
 - Injunction
 - Damages

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Scenario #3 – The Media Pirate

Proactive Steps


- Ensure ownership of ©
- Proper marking
- Timely registration of TMs & ©
- TPMs
- RFAs
- Brand Registry

Reactive Steps

- Expedited TM examination and © registration
- Takedown (if possible)
- C&D
- Litigate
 - John Doe Claim + interim injunction + stat damages + default judgment = \$29.7M

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6. Q & A

Questions are often more important than the answers

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THANK YOU

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