

Kluwer Trademark Blog

Worldwide Trademark Assignments – Tips, Tricks and Best Practices

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It is a common occurrence in the lifetime of a brand for ownership to change. In some cases, multiple times as part of corporate restructuring or the sale of a brand. The cost and process for recordals can vary significantly in different countries.

Generally, it is recommended that ownership be updated with local Trademark Offices. If not, this could affect the client's ability to enforce its rights and affect the registration of new similar marks.

After completing a worldwide assignment recordal project for a multinational corporation with applications and registrations in nearly two hundred countries, we would like to share what we have learned and provide our tips and best practices.

Preparation and planning are of primary importance. First, we suggest asking foreign associates to provide:

- Timelines for recordal
- Document requirements, such as whether Powers of Attorney are required
- Appropriate signatories
- Is notarization or legalization required?
- Do the documents need to be translated?
- Confirmation of details of trademarks being assigned, including details on ownership e.g., the owner name and address
- Does the owner name and address match that on record and, if not, do these changes need to be recorded separately and prior to the assignment?
- What if some of the marks are not of interest and the client does not wish to record the ownership change against such marks?
- Can an assignment be recorded against pending applications?
- Costs for providing/confirming the information and attending to all aspects of the recordals

Planning

Before preparing and arranging for any documents to be executed, determine if there are constraints on when the assignor and assignee can sign the documents. Are there deadlines to invoice? If drafting a worldwide assignment, it may be possible to create a document that is acceptable in multiple jurisdictions. Remove unnecessary information and consider having the

foreign associate prepare jurisdiction-specific documents for countries with very specific requirements for recordal. Arrange for multiple original copies of the assignment to be signed as these may come in handy if difficulties are encountered with the filing of certified copies.

Document Requirements

Powers of Attorney are often required. Determine if the original is required or if it is acceptable to provide an electronic signature and transmission. In some countries, the original Certificate of Registration or Renewal is necessary. If the client does not have these records, certified copies can often be ordered. However, this could delay recordal and increase costs. In some cases, corporate documentation on the parties is requested, such as certificates of incorporation or documents showing that the signatory has authority to act on behalf of the corporation. It is often possible to arrange for additional documentation to be prepared in advance, and preferable to do so if the assignor company is going to be dissolved following the transfer.

Obstacles

It is not uncommon to discover that prior ownership changes were not recorded, and the owner of record may no longer exist. In some cases, there could be a typographical error on the record or an old address which will also need to be corrected. Certain countries require that the assignor's name and address on documents filed with the Trademarks Office match exactly with the name and address on record, which could necessitate multiple recordals to correct or bring that information up to date. In other countries, ownership changes cannot be recorded against pending applications, which could result in lengthy delays for completion.

Tips

While it may be tempting to outsource assignment recordals to third party services who purport to offer heavily discounted rates, it may be advantageous to work with preferred local counsel who may be prepared to offer discounted rates and ensure fewer surprises arise based on their expertise and prior and existing knowledge of the marks.

In our experience, recordals in Australia, New Zealand, Canada, the U.S., the EU, U.K., and Singapore are easy to file and not costly. Recordals in China and certain Middle Eastern and Latin American countries can be challenging because of their highly specific document requirements for recordal. For example, certain countries go so far as to require that the passport numbers of the signatories be included in the assignment. Legalization can also be a challenge, and it is important to confirm requirements with the consulates in advance to ensure that the necessary documents are available.

Remember, Trademark Offices are constantly changing, and information obtained in the past may no longer be up to date.

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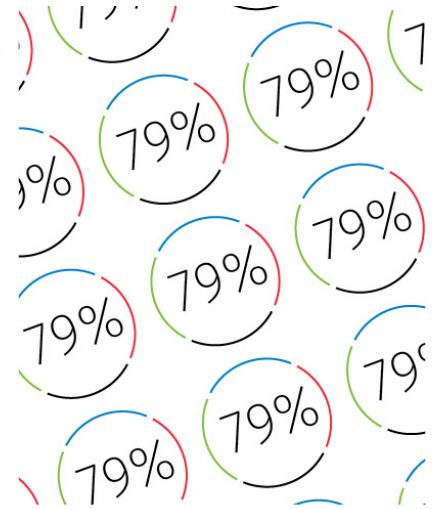
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