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Top Ten Reasons a Trademark Portfolio Health Checkup is Good for Business

Companies of all sizes can benefit from an annual or biennial trademark portfolio checkup. In addition to a regularly scheduled review, a review of the portfolio can be particularly useful when there is a pivot in the business model, a change in the goods and services, or a new branding initiative.

What is a Trademark Portfolio Health Checkup?

A trademark portfolio health checkup involves a review of the company's business and the way it uses its trademarks, compared to a review of the company's trademark registrations, applications and other related trademark information. Armed with this information, we can then determine whether the formal protections currently in place for the company's trademarks reflect the actual needs of the company.

Top Ten Reasons that a Trademark Portfolio Health Checkup is Good for Business

The scope of your checkup can be all-encompassing, or it can be narrow and targeted. Below is a list of some of the more common goals and objectives for engaging in a trademark portfolio health checkup:

- **Confirm actual use of trademarks against use covered by registrations.** We review all trademarks in current use by the company and the goods and services for which they are used, and then we compare this information against all existing registrations and pending applications to confirm that the company's goods and services are sufficiently covered in its trademark registrations.

- **Check geographic scope of use against domestic/foreign registration coverage.** We review the geographic scope of use of the company's trademarks to make sure the company has trademark registrations in all geographic regions and territories where registrations are needed.
- **Prepare for future expansions or engage in offense.** We interview the company to determine future expansion plans so that we can advise on when and whether to file in additional jurisdictions. Many countries do not require actual use in the market to secure a trademark registration in that country. China and the European Union are two classic examples, and Canada has recently done away with the requirement to show use in Canada to obtain a registration. If your company has any dealings with China, including the outsourcing of any component of the client's products to China, you should evaluate whether it would be useful to secure trademark protection in China to help thwart the production of counterfeit products. Similarly, as supply chains diversify from China, new countries of manufacture should also be considered.
- **Confirm accuracy of chain of title.** If your company has obtained trademarks through an acquisition or merger, it is very important to have the chain of title of those registrations reviewed to ensure that it properly reflects the current and correct owner. If left too long, and one or more entities in the chain of title no longer exist, it then becomes virtually impossible in some countries to establish ownership in the current company.
- **Lighten the load.** We can sometimes identify registrations that no longer need to be maintained. This can result in cost savings to the company as local counsel can be notified well in advance of any filing due dates to allow the registration to cancel, thus avoiding any waste of time or money associated with notices and communications relating to filing deadlines.
- **Confirm docketing accuracy.** If our firm does not otherwise manage the trademark portfolio, we can review the docket for all trademark registrations to confirm that all due dates are

appropriately docketed.

- **Review and evaluate domain name strategy.** We can review all domain names, the use and status of those domain names and determine whether additional domain names should be acquired and are available for purchase. We can further review whether depositing trademark registrations with the Trademark Clearinghouse makes sense for your business in view of the vast expansion of domain name extensions over the last decade (e.g., .brand, .shop, etc.). This can assist as both a preventative measure against cybersquatting activities and as a means to obtain domain name registrations prior to public availability.
- **Confirm compliance with third party licenses, settlement agreements and other agreements.** If requested by the company, we can review all agreements to which the company is subject that in any way impact the company's marks and assess compliance with those agreements.
- **Evaluate the need and value of watch services.** We can help determine whether trademark "watch services" would be meaningful to the company in helping it to guard against infringement. Such services review trademark filings (domestic and/or worldwide) and other indications of trademark use, in an effort to identify possible concerns. These can also be expanded to review for domain name infringements.
- **Assist with internal and external brand usage policies.** We can review the company's own trademark usage practices and help it monitor brand usage both internally and with licensees and other third parties to protect goodwill and enhance the enforceability of trademark rights.

Benefits

The benefits of undertaking a portfolio health checkup can be many. In addition to the benefits noted above, a clean portfolio means that the company is in an optimal position to (1) enforce its trademark rights, (2) engage in a sale of its business or a business line, (4) attract investment, (4) expand its business through internal

expansion or acquisition, and (5) minimize attorney and other costs by avoiding unpleasant surprises in an infringement situation.

Trademarks that have no or minimal issues attached command higher purchase prices and investment value than trademarks that have significant issues attached, such as when the chain of title is outdated or the marks have not been adequately enforced.

Conclusion

Unlike other assets of a company, your trademarks are ever evolving in step with your business, and so they need to be tended to and updated at the same time as you update your business strategies and model. Aside from the goods and services provided by your company, your trademarks are your company's most valuable assets, so you should keep your trademark portfolio healthy and in tip-top shape.

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