

SMART & BIGGAR

# IP Strategy from Bricks to Clicks.

Protecting Brands and Copyright Online vs Trolls, Counterfeiters and Pirates

**Speakers:** Mark Biernacki, Daniel Anthony

August 19, 2021

1

2

## Our Speakers



### Mark Biernacki

Partner,  
Barrister & Solicitor  
Trademark & Patent Agent

- **Litigation Star in IP**  
(Benchmark Canada 2015 - 2021)
- **Leading Trademark Practitioner**  
(Euromoney LMG: Expert Guides: Trade Mark: 2014 - 2020)
- **IP Star in Trademarks**  
(MIP IP Stars Handbook Trademark & Copyright: 2018 - 2021)



### Daniel Anthony

Counsel,  
Barrister & Solicitor  
Trademark & Patent Agent

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

SMART & BIGGAR

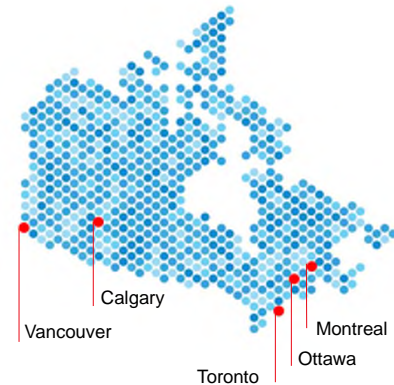
2

3

## 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



**SMART & BIGGAR**

3

4

## Today's Agenda

1. Three Scenarios – Trolls, Counterfeiters 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

**SMART & BIGGAR**

4

# 1. Three Scenarios

SMART & BIGGAR

5

## Scenario #1 - The Domain Name Troll

6



- Brand owner clears availability of marks and matching domains
- They file trademark applications
- They later try to register the domain names and find that someone else beat them to it!
- What could they have done differently?
- What can they do now?

SMART & BIGGAR

6

7

## Scenario #2 - The Counterfeiter



- Brand owner is selling a popular consumer product
- They are beginning to see counterfeits being offered for sale both online and in bricks and mortar locations
- They have never registered their trademarks or copyright
- What can they do?

SMART & BIGGAR

7

8

## 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?

SMART & BIGGAR

8

## 2. Why protect IP?

*Hint: value, value, value*

SMART & BIGGAR

9

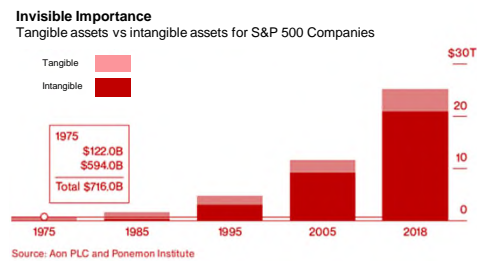
10

## What is the value of IP?

**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



SMART & BIGGAR

10

## 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

SMART & BIGGAR

11

## 3. Proactive Tools

*An ounce of prevention is worth a pound of cure*

SMART & BIGGAR

12

## 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 Marketplace

**SMART & BIGGAR**

13

## 4. Reactive Tools

*What happens is not as important as how you react*

**SMART & BIGGAR**

14

15

## Reactive Tools



Expedited TM  
Examination and ©  
Registration



Opposition  
Proceedings



Takedowns



Domain Name  
Arbitration



Border Enforcement



Reporting to Canadian  
Anti-counterfeiting Centre

**SMART & BIGGAR**

15

16

## 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

**SMART & BIGGAR**

16



## 5. Scenarios Revisited

*I wish I knew then what I know now*

SMART & BIGGAR

17

18

### Scenario #1 – The Domain Name Troll

#### Proactive Steps

- Timely registration of domain names
- Registration of .ca by Canadian counsel

#### Reactive Steps

- C&D + negotiation
- Domain arbitration
- Takedown?
- Implement new protocol

SMART & BIGGAR

18

19

## Scenario #2 – The Counterfeiter

### Proactive Steps

- Timely registration of TMs & ©
- Anti-counterfeiting measures
- RFAs
- Brand Registry
- Monitoring program

### Reactive Steps

- Expedited TM examination and © registration
- Border Enforcement
- Takedown
- Report to Canadian Anti-counterfeiting Centre
- C&D
- Litigate
- Educate consumers

SMART & BIGGAR

19

20

## 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

SMART & BIGGAR

20



# 6. Q & A

*Questions are often more important than the answers*

---

SMART & BIGGAR

21



# THANK YOU

---

SMART & BIGGAR

22