

Legal Connections



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"Many seemingly complex legal matters can be simplified by an attorney well-versed in the client's business needs."



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PROTECT YOUR BRAND: INTERNATIONAL TRADEMARKS

If you have international aspirations for your business, you should consider filing a Madrid Protocol application as part of your brand development.

Generally, trademarks are protectable in a given jurisdiction, but only to the extent that the owner has begun to use the mark on goods or services that are offered for sale in that particular jurisdiction. Stated otherwise, use and registration of a mark in the United States does not generally provide the U.S. trademark owner with the ability to stop use of the same mark by others in another jurisdiction if they have not begun to offer goods or services in that foreign market. Consequently, a U.S. business can invest significant amounts of time and money to build and protect its brand domestically, but fail to do the same internationally, only to fall prey to "interlopers."

Trademark "interlopers" register U.S. marks in foreign countries where those marks lack protection in order to exploit the global brand recognition of the U.S. mark. Even though a U.S. company has not yet offered its goods or services in foreign markets, its brand may have already penetrated



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the foreign market through internet advertisements. Interlopers identify such popular brands and begin using the mark in the foreign jurisdiction prior to the U.S. trademark owner actually entering the foreign market. When the U.S. trademark owner does enter the foreign market, it may have to compete against another company using its own mark.

China, the world's second largest consumer market, is rife with interlopers. President Trump recently won a decades-long trademark battle in China against an interloper that prevented him from providing construction services there under his TRUMP mark. Other interlopers to that mark still exist, selling toilets and paint,

What can be trademarked?

- ✓ A word
- ✓ A combination of words, letters, and numerals
- ✓ Drawings
- ✓ Symbols
- ✓ Shapes
- ✓ Scents
- ✓ Sounds
- ✓ Color shades



among other things, under the globally recognized mark.

The most effective way to safeguard one's company against interlopers in foreign jurisdictions is through the Madrid Protocol. The Madrid Protocol is a treaty

among several countries, including the U.S., which allows a trademark owner to file for protection in designated foreign jurisdictions. A Madrid Protocol trademark application may mature into registration in designated foreign jurisdictions without the U.S. business entering and using the mark in those jurisdictions. This application can be filed at the same time as the trademark owner files its U.S. trademark application, or at a later date.

A Madrid Protocol registration, however, has limitations. First, a business must begin use of the mark in the applicable foreign jurisdiction within three years of registration or risk cancellation. Second, the Madrid Protocol filing can be expensive; applicants still pay each foreign jurisdiction's filing fees.

To get your brand the international recognition you're looking for, first determine in which countries you require protection to keep your filing fees reasonable. Then, create a plan of action for timely use of your mark in those foreign jurisdictions to prevent cancellation. ■

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HOW MUCH LEAVE IS TOO MUCH?

Many employers ask, "How much leave is too long as an accommodation under the Americans with Disabilities Act (ADA)?" The Seventh Circuit recently answered that question. It's not reasonable for an employee to receive additional leave under the ADA after the employee has exhausted their twelve weeks of FMLA. While this decision is limited to Illinois, Indiana and Wisconsin, it brings some clarity to the otherwise murky law on reasonable accommodations. This opinion suggests



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multi-month leaves of absence are not required by the ADA.

Despite this small glimmer of hope for employers, questions remain. Not all requests for an unpaid leave of absence are an unreasonable accommodation. For example, an employer may be required to grant an employee's request for a few days or weeks off from work as

a reasonable accommodation under many circumstances.

The EEOC, however, takes a somewhat different stance than the courts. Many

employers have policies that prohibit an employee from returning to work after a long period of leave. In August 2017, the EEOC settled an eight-year-old lawsuit against United Parcel Service (UPS), challenging UPS's policy of discharging workers who cannot return from medical leave after one year. This settlement was a "win" for the EEOC in its effort to restrict employers' use of maximum leave policies.

The current conflicting circuit court rulings and the EEOC's recent settlement serve as a reminder to employers that:

1. An employer may have a leave policy providing a "maximum" amount of leave, but may have to make exceptions for an employee with a disability.

2. These leave policies may violate the ADA when they effectively require the automatic termination of an employee with a disability after he/she reaches a prescribed, inflexible leave limit.

3. Employers should utilize the interactive process to ensure additional leave is not available as a reasonable accommodation before terminating an employee under a maximum leave policy. ■

6th Annual

Martin Luther King, Jr.
Memorial Civil Rights
Symposium

January 26, 2018 @ 9:00am Columbus Bar Association

50 YEARS LATER: The New Civil Rights Movement

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