

Insights

5 Tips For Protecting Your Trademarks

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Choosing a strong trademark can be more difficult than it looks. The risk of the mark being used by a third party as well as the risk of the mark being found as merely descriptive of the business, goods, or services offered is cause for concern. While there are many nuances in picking and registering a strong trademark, listed below are some of the more important elements to consider.

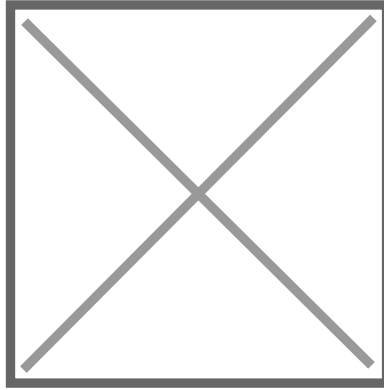
1. Choose a Strong, Unused Mark

The first and arguably most important thing you can do to protect your trademarks is to choose marks that no one else is using. An Internet search can help to identify if others are using a trademark, although best practice is to have your trademark attorney search the USPTO database and order a comprehensive trademark search.

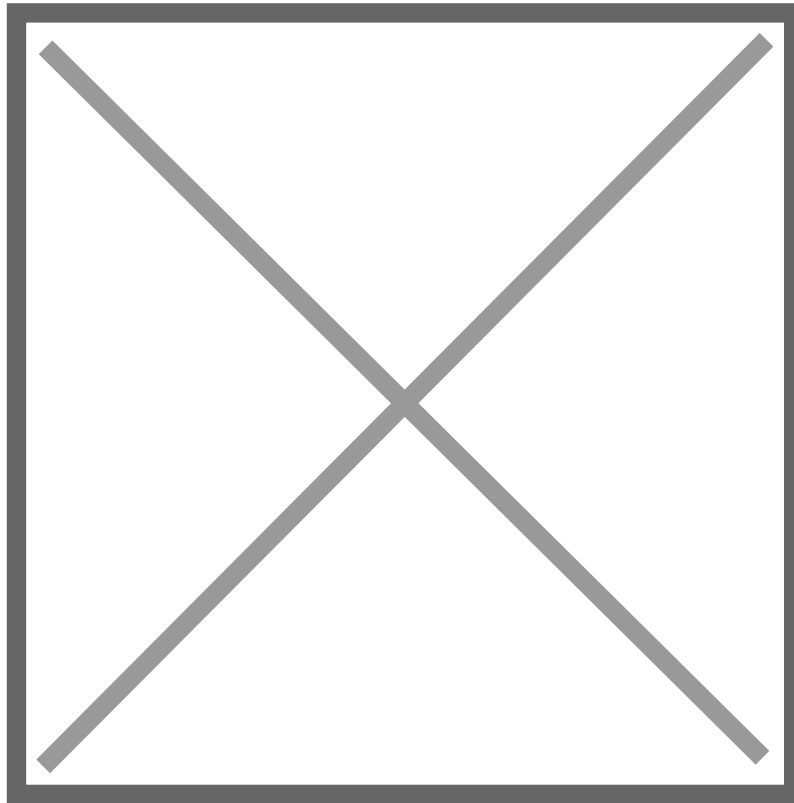
You should try to select marks that are considered "strong," as opposed to "weak." As a general rule, the more descriptive a mark is of the goods or services with which it is used, the weaker the mark. Conversely, the more arbitrary a mark is in relation to the goods or services offered under it, the stronger the mark is. Fanciful and arbitrary marks, like "Exxon" for oil and "Apple" for computers, are the strongest marks and enjoy the greatest trademark protection. The next strongest type of mark is one that is suggestive, meaning that it indirectly suggests something about the quality or a characteristic of the good or service, and which requires some imagination and thought before consumers connect the goods or services with the mark. For example, "Greyhound" is a suggestive mark in relation to a bus line because greyhound dogs are known for their speed, which suggests, in the context of a bus line, that Greyhound's buses are fast. Descriptive marks, like "International Business Machines" for computers and office machines, describe the goods or services with which they are used and require "secondary meaning" with consumers, meaning that consumers have come to identify the mark with the company as opposed to merely the goods or services themselves, before they can be registered with the United States Patent and Trademark Office ("USPTO"). Finally, generic terms like "corn" are not protectable as trademarks.

2. Use the Mark Consistently

Another tip for strengthening your trademark is to always use your mark in exactly the same way. For example, if you have a trademark for ACME + and the corresponding logo



then you should always refer to the brand as ACME + in writing and always use the same logo. Referring to the brand as just ACME, or using variations of the name and logo like



weaken the trademarks, thus providing less protection against infringement by third parties. Consistency strengthens trademarks, whereas variation weakens them. Also, it is best to use the TM symbol for unregistered marks and the ® symbol for registered marks on every web page, advertisement, or other document the first time the mark appears and/or where the mark appears most prominently.

3. Register the Mark

Once you have started using your trademark “in commerce,” meaning that you have sold and/or shipped your goods out of state or started providing your services across state lines or to individuals who have traveled from out of state, in either case for more than just a few isolated sales, then, assuming that you are the only person or entity using the mark in conjunction with the same or similar goods or services, you can apply for registration of the mark with the USPTO. Registration brings several benefits, including nationwide notice of your use of the mark, the right to direct U.S. Customs to block imports of infringing goods, and that the USPTO will bar trademark applications for marks that it deems confusingly similar to your registered mark, among other benefits.

4. Monitor the USPTO's Official Gazette

While the USPTO will endeavor to deny applications for marks that it deems confusingly similar to your registered mark, some confusingly similar marks do occasionally slip through the cracks and are published in the USPTO's Official Gazette, a periodical that lists all trademark applications pending registration. Once published, third parties (including you) have 30 days to contest a trademark application or to request an extension of time. By having your attorney monitor the Official Gazette, you increase your chances of catching any trademark applications for marks that might infringe your registered mark, thus allowing you to contest the mark's application before it achieves full-fledged registration. Ask a trademark attorney for more information about monitoring the Official Gazette.

5. Use License Agreements

Finally, if you permit third parties to use your registered or unregistered trademarks in order to advertise your or their goods or services, including subsidiaries and other affiliates of your company, your distributors, your customers, etc., then you should have written license agreements in place dictating how the mark should be used and allowing you to monitor and enforce such party's use of the mark in order to ensure that the mark is not being used in a manner that dilutes, tarnishes, or infringes upon your trademark rights. Failure to include such enforcement rights can result in abandonment of your trademark with the USPTO.

For more information on trademark law, contact Bob Goode at (317) 238-6304 or rgoode@kdlegal.com or your trademark attorney to discuss how else you can protect your company's most valuable assets.