



™... ®... ?! Protecting Your Trademarks. Some Frequently Asked Questions

GENERALLY

Q: What is trademark protection all about?

A: Trademark protection operates at the intersection of intellectual property law and consumer protection law. The law recognizes that when a business uses a distinctive mark to identify its goods and services, consumers form a connection between the mark and the source of the products. The law recognizes the value that businesses invest in building their brands. Trademark protection keeps others from capitalizing on your investment in brand building by stealing your mark and putting it on their products.

Q: What do I need to do to legally put the ™ symbol next to my trademark?

A: Federally, there are no regulations of that symbol. All you have to do is use the mark in commerce. Once consumers begin to identify your mark with your business, the common law of the states will automatically give you a legal remedy if somebody begins passing off their products as yours. The ™ symbol indicates that you claim the mark as a distinctive identifier that distinguishes your products. It serves as a warning sign to others that you consider the mark to be a business asset. It does not, however, convey any special protections or advantages under the law. Under the common law the plaintiff has the burden of proving every element in their case for trademark infringement.

Q: What does the ® symbol mean, and when can I use it with my trademark?

A: The ® symbol indicates that the mark it accompanies is federally registered by the United States Patent and Trademark Office. When a mark is federally registered, it gains special advantages that make it easier to protect in court. To get your mark federally registered you must file an application with the Trademark Office and have it examined by their employees for compliance with rules and regulations. Once your mark is added to the principle register you have a number of advantages over an unregistered mark:

- You have given constructive notice nationwide of your claim to the mark;
- Registration is evidence of your ownership of the trademark;
- You may go to the federal courts to protect your mark;
- You have a solid basis for obtaining registration in foreign countries; and

- Your registration may be filed with the U.S. Customs Service to prevent importation of infringing products from overseas manufacturers.
- After five years on the principle federal register, a mark becomes incontestable. That means that nobody can challenge the validity of the mark after it has been in use for five years.

Q: What is this principle register you mentioned?

A: There are two types of federal registration, the principle register and the supplemental register. The supplemental register gives fewer benefits than listed above, but allows marks to be registered that are not distinctive enough to be allowed onto the principle register. After five years on the supplemental register, it becomes easier to upgrade your mark to the principle register, which is where you want it to be.

ABOUT CHOOSING A MARK

Q: What kinds of marks are allowed to be registered?

A: The law categorizes potential marks into four categories: fanciful, suggestive, descriptive and generic. You can never trademark a generic term. To register a descriptive term, you have to have been using it in commerce long enough for it to have developed associations in the minds of consumers with your company. Suggestive and fanciful marks are the most easily registered. A mark can be a word or phrase, but it could also be a graphic logo, or a particular shade of a color, or a sound, or any other distinctive identifier that is associated with your goods or services.

Q: If I register a mark, I own it exclusively everywhere, right?

A: Not necessarily. If some others have been using a mark longer than you have and haven't registered it, after you register your mark, you can't make a senior user of your mark stop using it. You can prevent them from expanding their use of the mark outside of the markets they were using it in at the time you registered it, but they can't be made to stop. In fact, they can try to stop you from using your mark in their markets.

Q: How thoroughly should I search for senior users before I decide to register a mark?

A: You should always search the federal register of trademarks, since all federally registered marks carry with them the presumption of notice to everybody everywhere. There is always a risk that an unregistered senior user of a mark might get litigious with you if your mark is successful and expands into their territory. Ideally, you should pick a mark that nobody else has ever used anywhere. There are services that will do a comprehensive search down to the level of phone books, newspapers, and state corporation records. These services are not inexpensive, but will alert you to potential issues ahead of time.

THE REGISTRATION PROCESS

Q: I've got a mark I'd like to register, what do I do?

A: Gather all of the information that the federal application requires, and then decide whether you want to try filing the application yourself, or whether you want an attorney to help you file.

Q: How long does registration take?

A: At least a year, usually. The PTO receives a lot of applications, and only has so many examiners.

Q: Do I have to wait until I have used my mark in commerce to apply for registration?

A: No. You can file an “Intent to Use” application. You’ll have to file an additional statement of use after you start using it or the registration will disappear, but you can reserve a mark before you begin using it.

AFTER REGISTRATION

Q: Now that I’ve got my mark registered what next?

A: Now you’ve got a great bargaining chip to include in the letters you send out to businesses you find using marks that are identical or confusingly similar to yours. You’ve also got a snazzy looking document that you can frame if you want. You’ll also likely receive a number of mail solicitations by shady companies trying to look official with offers of various services. If the mail does not come from the United States Patent and Trademark Office in Virginia, don’t be deceived into thinking it is official.

Q: How long does my registration last?

A: Your registration will last six years. If you file additional forms during the final year, your registration will be extended by ten years, and every ten years you’ll have to file those same forms again.

Q: Who will protect my mark?

A: It is the owner’s duty to monitor the marketplace and assert your rights when you find people using marks that are identical or confusingly similar yours. This usually means working with an attorney who negotiates with the infringing users.

TRADEMARKS AND THE INTERNET

Q: Somebody has a domain name that includes my trademark in it. What can I do about it?

A: There are laws against some behavior of that type, so consult an attorney. There is a procedure that all domain registrars must adhere to that deals with this situation also.

Q: Where can I get more information about trademarks on the Internet?

A: See <http://www.uspto.gov/main/trademarks.htm> for the USPTO's trademark site. See <http://www.inta.org> for the International Trademark Association's website.

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