

A Winthrop & Weinstine blog dedicated to bridging the gap between legal & marketing types.

[What Serious Trademark Owners Do](#)

Posted on January 17, 2011 by [Steve Baird](#)

There are many things that serious trademark owners do throughout the lifecycle of a trademark to mitigate risk, protect the valuable goodwill in their underlying brand, and preserve their valuable investment in this important intellectual property asset. Here is a fairly extensive, but certainly not exhaustive, and often forgotten, list of those things:

1. [Clear new marks](#) before using them [even if "only" for brand extensions](#);
2. Understand the [pros and cons of different name styles](#);
3. Adopt [suggestive marks](#) over merely descriptive ones;
4. Self-police marketing materials to [keep marks suggestive](#) and [non-functional](#);
5. Steer clear from the [D-word](#);
6. Appreciate the [pros and cons](#) of [non-verbal wordless logos](#);
7. Strive to own logos that can truly [stand alone](#) without words;
8. Spend time [developing an acceptable generic name too](#) when launching new brand;
9. Develop [non-traditional trademarks](#);
10. Recognize the [power of federal trademark registration](#);
11. Know when [concurrent trademark registration](#) makes sense;
12. Appreciate the [paradox of brand protection](#);
13. Attend to [brand strength](#) and understand the [importance of trademark enforcement](#);
14. [Educate themselves](#) about trademark likelihood of confusion issues;
15. Prefer their own creativity over [borrowing the creativity of others](#);
16. Question [how realistic the risk of trademark genericide is](#) for them;
17. When realistic, they take [concrete steps](#) to avoid the perils of trademark genericide;
18. Develop plans to [avoid trademark abandonment](#);
19. Avoid bona fide allegations and findings of [trademark fraud](#), [trademark bullying](#) and [reverse domain name hijacking](#);
20. Know what a [touchmark](#) is;
21. When appropriate, they [pick up the phone](#) before writing a demand letter;
22. Follow [Seth Godin's marketing advice](#), but [avoid his trademark advice](#);
23. [Manage the legal risks](#) of verbing trademarks and brands;



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24. Appreciate the limits of the [nominative trademark fair use defense](#);
25. Steer clear of [Dr. No on the Parade of Horribles](#);
26. Hire trademark counsel prepared and expected to [take a position](#); and
27. Of course, read DuetsBlog every day and note the [milestones](#) along the way.

Now, this is not to say that trademark owners who don't do each of these things is comedic or not to be taken seriously, but many at least consider or should consider doing these things.



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