

Virginia Business Lawyers

The Fine Line Between Trademark Policing and Bullying

By: Donna Ray Chmura. May 31st, 2011



Image via Wikipedia

The trademark ~~geeks~~ [lawyers](#) at Sands Anderson have been debating how far a company should go to “police” its trademarks. [Entrepreneur Media](#) (publisher of *Entrepreneur* magazine and owner of [Entrepreneur.com](#)) got us thinking about it: in attempts to protect its Entrepreneur brand, it sent [cease and desist letters](#) to EntrepreneurOlogy.com for workshops, EntrepreneurPR, a firm that had a newsletter called *Entrepreneur Illustrated*, and 3Entrepreneurs, which sold T-shirts, sweaters and hats with the phrase “Entrepreneur Generation”.

While it is never too soon to [protect](#) your company’s valuable trademark, registration alone is not enough. The owner of a trademark has to stop people from infringing its marks, known as policing the mark.

It is a difficult line to walk. If you don’t police, you could be deemed to have abandoned your mark or have allowed infringing uses to go unchecked. Too much (or inappropriate) policing can make your company look like a bully and generate bad PR.

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It is important to remember that a trademark registration protects the use of the brand name in connection with the goods and services provided in the registration only. So if your registration is for ENTREPRENEUR.COM for “downloadable podcasts in the field of business, current events, lifestyle issues, and developments in science and technology”, is a Tshirt with “ENTREPRENEUR GENERATION” on it likely to cause confusion with your service? Entrepreneur Media thought this was justified, because it had produced clothing with its “entrepreneur” logo.

The first step in policing is to find other people who are using your mark or something substantially similar that is likely to cause confusion in the marketplace. This can be done through search engine alert services or by hiring “watch” companies. Then you need to send a cease and desist letter, demanding that the infringing use stop. After that, there are a number of ways to maintain control of the mark from licensing the use to seizing and destroying infringing material.

In addition to policing, maintaining a trademark after registration also includes making occasional post-registration filings.

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