

TRADEMARK AWARENESS

Protecting your Business Names, Logos and Slogans

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How do your customers distinguish your goods and services from those of other business owners? Is the primary factor your business name or do you have a unique logo or slogan that clearly identifies your product? Consider the following trademarks:

i'm lovin' it

Just Do It

“Chester Cheetah” and “Dangerously cheesy!”

Though none of the above mention either the business name, product or service, you probably already know that these trademarks belong to McDonald's, Nike and Frito-Lay Cheetos, respectively. When you think about your own business, try to identify all the names, logos, slogans, color schemes, sounds and any other identifying features that distinguish your product or service. These distinguishing marks are your trademarks.

Your trademarks represent your investment in goodwill. If you sell your business, your marks could be a key asset. It is therefore important to protect valuable marks and take steps to prevent others from using the same or confusingly similar marks.

Trademark infringement may occur both intentionally and unintentionally. In some cases, other business owners begin using the same or similar name simply because it is fitting. They may not realize the name is already in use. In other cases, the infringement is deliberate. When a competitor notices that your trademarks are working for you, they may try to divert your customer base by using a similar mark to trick the customers.

To protect your trademarks against infringement, you will need to first identify your marks, determine which ones you wish to protect, and take the steps necessary to register your trademarks with the state, the United States Patent and Trademark Office, and possibly other countries.

A. Identifying Trademarks

Take some time to review your advertising materials including websites, brochures and even business cards to determine if you have any valuable trademarks or service marks that you would like to protect. Trademarks and service marks may include business names, names of products and services, slogans, designs, symbols and logos. They can even include sounds, fragrances, colors, and package designs in some cases. Trademarks and service marks differentiate your goods and services from those of your competitors.

B. Common Law and State Trademark Rights

Once you have identified your trademarks, it is important to understand that you may already have common law trademark rights in those marks, provided you are not infringing on another's rights. Common law trademark rights arise from the mere use of a word, logo, slogan or other mark to identify a product or service.

The disadvantage of relying solely on common law rights, is that these rights are limited to the geographic territories in which the owner has actually used the mark. For example, if a San Diego business sells products exclusively in San Diego under the name XYZ Gadgets, then a competitor could sell the same products in Dallas under the same or similar mark without infringing on the San Diego trademark owner's prior rights.

For this reason, it is advisable to obtain state or federal registration. State registration provides your trademark protection in the state in which you register. It also serves to create a public record of your use of the mark in that state. However, if you would like protection in the entire country, you will need to register your mark with the United States Patent and Trademark Office.

C. United States Federal Trademark

If you use your trademark in more than one state or in international commerce, your mark may be registered with the United States Patent and Trademark Office (USPTO). By registering with the USPTO, you will expand your trademark protection to include the following:

1. The right to use the ® symbol in conjunction with the mark;
2. Constructive notice to the public of one's claim of ownership of the mark;
3. A legal presumption of one's ownership of the mark and one's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;
4. The ability to bring an action concerning the mark in federal court;
5. The use of the U.S registration as a basis to obtain registration in foreign countries; and
6. The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

D. International Trademark Protection

Most companies are content with the federal registration of their trademarks, but if you have an international business, you will want to consider global protection or at least protection in certain foreign countries. While there is no single "global trademark," it is possible to obtain registration in foreign countries on the basis of a U.S. registration by filing trademark applications directly with the trademark office of each country and/or by filing a single application through the USPTO pursuant to the Madrid Protocol.

1. Madrid Protocol

The Madrid Protocol allows owners of U.S. registered trademarks to file applications in up to 65 countries by simply filing one application directly with the USPTO. The application may be filed in English, and all related fees are paid in one lump sum to a single office (International Bureau of World Intellectual Property Organization) rather than to the individual trademark offices of each country. An international mark so registered is equivalent to an application or a registration of the same mark effected directly in each of the countries designated by the applicant. If the trademark office of a designated country does not refuse protection within a specified period (usually 12 to 18 months), the protection of the mark is the same as if it had been registered by that office.

In addition to providing a simplified registration process, the Madrid Protocol facilitates the maintenance of the marks abroad by allowing all changes subsequent to the international registration, such as name and address changes, to be recorded through the International Bureau. As with the initial registration, the per country fees for such recordings may be paid in one payment to the International Bureau.

The per country fees for international registration vary but generally fall within the range of \$600 to \$1200 for one mark in one international class of goods and services and in one country. You will also be required to pay a certification fee per class to the USPTO and fees for legal services. If your company is interested in registering a mark in another country, please let me know and I will provide you an estimate of the total cost.

2. Canadian Trademarks

In recent years, Canada has become a concern for some of my trademark clients. U.S. federal registration does not provide protection of trademarks in Canada, and some trademark owners are finding that competitive Canadian companies are using very similar marks to identify their goods and services. Because Canada is a neighboring country and because sales are frequently made over the Internet, the Canadian competitors can easily reach U.S. consumers. Likewise, U.S. companies can reach Canadian consumers.

In order to protect U.S. trademarks in Canada, the trademark must be registered with the Canadian trademark office. This cannot be done through the USPTO because Canada is not a contracting party of the Madrid Protocol. However, I have arranged for a Canadian law firm to register my clients' U.S. trademarks in Canada. If you need a quote for Canadian trademarks, please contact me with the details of your mark.

E. U.S. Border Protection

Another way to leverage federal trademark protection is by recording the trademark with the U.S. Customs and Border Protection ("CBP") to prevent importation of infringing foreign goods. "Recordation" refers to the process by which the CBP collects information

from an intellectual property owner about specific registered trademarks, copyrights, or trade names, and then enters that information into an electronic database accessible by CBP officers across the country. CBP uses this recordation information to actively monitor shipments and prevent the importation or exportation of infringing goods. This is primarily useful for goods which have to cross borders as opposed to services that may be provided over the Internet. The recording fee payable to CBP is \$190 per class.

If your company requires assistance with identifying its trademarks or if you wish to discuss any of the above, please contact me.



For more information:

US Patent and Trademark Office
www.uspto.gov

US Customs and Border Protection
www.cbp.gov

California Secretary of State (Trademarks)
www.sos.ca.gov/business/ts/

Other states
See Secretary of State in your state

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