

LAW

Acquire, Advance, Protect Your Trademark

Trademarks are more complicated than they seem and a common source of confusion for business owners. Here is a list of the 10 most frequently encountered issues and questions:

1) Choosing a Name. Before using a name, it helps to carefully choose the name. Try to avoid names that merely describe your product or service or an attribute of your product or service.

This proves to be quite difficult for many people because, of course, the marks that are the most attractive in terms of creating instant consumer recognition, such as Errand Girl for an errand-running service or GuardWare for home security software, are also typically descriptive and unprotectable.

The more inventive names take time, effort and advertising to build up an identity with consumers. But in the world of trademarks, the most creative marks are the most protectable and, in the long run, are the best source identifiers and the most valuable. Think Xerox, Google and Exxon.

Arbitrary marks (Apple for computers) and suggestive marks (Microsoft) are also protectable and are good choices if you do not want a completely invented mark.

2) Search. There is a duty to do a search before adopting a trademark to ensure that no one else is using it already. Doing a Google search and a search of the U.S. Patent & Trademark Office (USPTO) site maybe a good start, but a full search report from a reputable trademark research compa-



Stacey Friends

ny is best. If you plan to operate internationally, an international search is also helpful.

3) Acquiring Trademark Rights. In the U.S., you acquire trademark rights through use in commerce. Although it is usually best to have a federal registration, the "first user" of a mark, with some exceptions, will prevail in case of a conflict. Once you are reasonably secure that you can use the mark you have chosen, begin using it properly in advertising, on your Web site and in commerce as soon as possible in order to establish your rights.

4) Use the Mark Properly. When using your mark, you should always use it as a source identifier, not as the descriptive name for the goods.

You may have heard the old story about "escalator" and "cellophane" having former lives as trademarks, but

through unchecked descriptive use by the public, the marks became generic names for the goods and lost their trademark protection.

Kleenex and Google are other marks that battle this problem constantly. That is why you will notice these companies all work hard to ensure that people say, "Kleenex tissues" and "Google search."

Always use your mark as an adjective, not a noun. Capitalize or use initial caps with your mark, and never use your mark in the plural form, for example, "Band-Aid bandages," not "Band-Aids."

Correct your employees, the press or others if they misuse or mis-abbreviate your mark. You should also use your mark consistently.

You can abbreviate it, but first use the whole mark, and then abbreviate, e.g., Hewlett-Packard (HP). Also, use the proper trademark symbol.

5) ™ or ®. "When can I use trademark symbols ™ and ®?" and "Which symbol do we use?" are very common questions. The ™ symbol merely signifies that you are claiming trademark rights in your mark – a notice to the public. The mark can be unregistered and, in fact, you do not even need to have a federal application pending to use the ™ symbol.

The ® symbol is only for federally registered marks. You cannot use this symbol until you have received your registration certificate and, then, you should use this symbol since it functions as a notice system.

6) Federal Registration Benefits.

Registration with the USPTO has several important benefits:

- A presumption of the validity of your trademark rights,
- The right to pursue infringers in federal court,
- The right to pursue counterfeiters with the U.S. Customs Service,
- The right to file a foreign application based on your application and
- Constructive notice to the public of your rights.

The filing fee for trademarks is either \$275 or \$325 (per class of goods and services), and it usually takes an hour or two to compile all the necessary information and file the application.

There are also some costs later on for processing and responding to the various notices from the USPTO as the application goes through the registration process, which vary depending on a variety of factors.

7) Beware of the Deceptively Easy USPTO Online Filing System. Applying for a federal registration is not as easy as it looks. There are many peculiarities of trademark law and USPTO rules and procedures that the average (and even above average) business person could not possibly know about.

It is recommended that companies use an experienced trademark attorney to navigate the process. There are many good trademark attorneys nationwide. You can get a referral from another attorney, your local bar association or through the Internet.

8) Use vs. Intent to Use. There are two ways to apply for a federal registration. If you are already using your mark in interstate commerce (basically, in more than one state – this requires discussion with your attorney), you can submit an application based on that use. You will submit specimens

It is recommended that companies use an experienced trademark attorney to navigate the process. There are many good trademark attorneys nationwide.

proving your use as well as your date of first use to the USPTO when you apply.

If you are not yet using your mark or are not yet using it in interstate commerce but you expect to be doing so in the near future, you can still file an application, but it will be based on "intent to use" instead.

With this type of application, once your application makes it through the examination and publication stages, you will have six months to prove your use to the USPTO and submit a "statement of use" (SOU).

SOU's have a \$100 filing fee per class of goods and services and take an hour or so of attorney or paralegal time to prepare, so this type of application is more expensive than filing a use-based application. But it is great for those who want to reserve the name.

If, after six months, you are not ready to file your SOU, you can request a six-month extension. You are permitted up to five extensions, so you have two-and-a-half years to prove your use.

But beware of the filing fees. Each

extension will cost \$150 per class plus a little bit of paralegal time. This can really add up, so if you think you will need a lot of time to use your mark in interstate commerce, budget accordingly.

9) State Registrations. Many people ask if they should file a state registration. If you are just starting out and are not yet operating in interstate commerce, or you will only operate locally, then a state registration is a good idea. It is an easy and inexpensive process that will add some strength to your case if you ever have to defend or enforce your mark.

Under the new trademark law just recently adopted in Massachusetts, you may also be eligible for treble damages for willful infringement or bad faith. In addition, state registrations show up in search reports, acting as a notice system to potentially warn others away from your mark.

10) Foreign Use and Registration. Most countries besides the U.S. are "first to file" countries. This means that the first party to file – not the first user – is the winner. If you plan to operate in a foreign country, you should file there as soon as possible.

You can get an early filing date in most foreign countries by filing there within six months of your U.S. application. If you have already filed in the U.S., you should not operate, send merchandise or even samples into a foreign country unless you have an application pending, due to problems with trademark squatters, counterfeiters and other unscrupulous copy cats.

Stacey C. Friends is an associate at the Boston business law firm Ruberto, Israel & Weiner, where her practice focuses on trademark and copyright law, licensing, corporate and business matters, and arts and entertainment.