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## *Top Ten Trademark Tips*

*By Gregory M. Krakau & Thomas F. Dunn*

## *MBBP's Top Ten Trademark Tips*

1. Selection
2. Clearance
3. U.S. Filings
4. International Filings
5. Cost
6. Domain Names
7. Watching & Enforcement
8. Trademark Use Guidelines
9. Maintain Ownership
10. Licensing

## 1. Select a Good, Strong Mark

### A. What is a Mark?

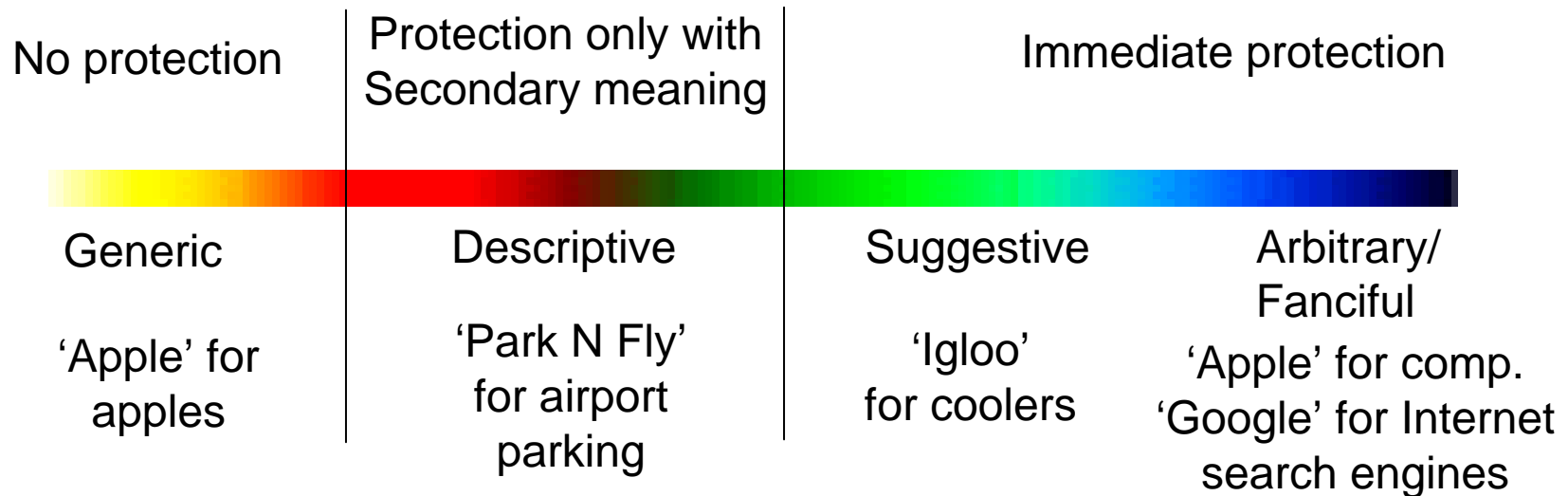
*A symbol denoting the source of goods or services*

- word
- design
- slogan
- color
- sound
- scent

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### B. The Spectrum of Distinctiveness

- Strength of Mark



## 2. Clear the Mark For Use and Registration

### A. Corporate Name

- Clear it like it is a trademark
- Trade name Use = Trademark Use

### B. Trademarks, Slogans, Designs

- Basic Screening Search
- Full U.S. Screening Search
- International Screening Search

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### C. Why Conduct a Search?

- Checking for marks that are:
  - the same; or
  - confusingly similar
- Checking for goods or services that are:
  - the same; or
  - closely related

The marks and goods/services don't have to be identical.

## 3. File U.S. Trademark Applications

### A. File in the US immediately

- Filing date = Nationwide priority date
  - Particularly important if the mark is not yet in use
- Puts third parties on notice
- Most prospective trademark owners will at least do a preliminary check

### B. Filing basis

- Use
- Intent-to-Use
- Section 44(d) and (e)
- Section 66A

## 4. File International Applications

### A. Priority Filing Date

- File internationally within 6 months
- Primary brands in major markets
- Single filing options
  - European Union (EU, a/k/a CTM)
  - Madrid
  - National
    - » Not a member of EU or Madrid
    - » Eligible for broader ID of goods/services
    - » Assignment (can't assign to non-Madrid member)
    - » Fate not tied to home application

### **5. Costs: Don't be Penny-wise and Pound Foolish**

#### A. Costs are manageable

- How Much Does it Cost to Register?
  - Basic search = \$750; Full search = \$1,500
  - One mark in one class = \$1,075
  - Filing (with full search) = about \$2,500
  - Prosecution from filing to registration = Varies
    - » If in use and no major issues arise, modest (<\$3K)
- How Much Does it Cost Not to File?
  - \$0 – Priceless
    - » Cost to fix a problem makes filing cost seem trivial

## 6. Be Master of Your Domain

A. Reserve domain name(s)

B. Mark Monitor

- gTLDs, e.g., .com, .net, .org
- ccTLDs, e.g., .ca, .cn, etc.
- New gTLDs

## 7. Use It Or Lose It

### A. Basics of TM Use

- Proper adjective
- ®, TM, SM
- Trade name vs. trademark
  - Apple is the best company in the world.
  - Apple® computers are the best in the world.

### B. Monitor promotional material for proper use

- Presentations, press releases, website
- Advertising, promotion, trade show materials

## 8. Maintain Ownership of the Mark

- A. Keep title clean and current
- B. Record within 3 months
  - Assignments
  - Mergers and acquisitions
  - Releases (e.g., security interests)
  - Name changes

## 9. Licensing: Don't Get Caught With Your Pants Down

- A. Put it in writing
- Including mfg., distribution, sales agreements
  - Unique laws in foreign jurisdictions
- B. Terms
- Specify the goods and/or services
  - Exclusive or non-exclusive
  - Territory (regional, U.S., worldwide, etc.)
  - Quality control – must have right to control ***and*** exercise it; otherwise, naked license (could result in abandonment)

## 10. Watch and Enforce Your Mark

### A. Subscribe to a watch service

- Annual subscription
- Cost varies depending on subscription
  - USPTO (application and/or publication)
  - State trademark and corporate filings
  - International trademark registries
  - Domain Names and web content

### B. Enforcement

- Cease and desist letters – BE CAREFUL!
  - Claim and priority
  - Beware declaratory judgment action
  - Responding to cease and desist letters

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### B. Enforcement (continued)

- Court (usually federal) versus TTAB
- Court determines right to use, can award damages and attorneys' fees in exceptional cases
- TTAB determines only right to register, cannot award damages or fees



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*Questions?*

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