

Protect your trademark in five crucial steps

by *Lisa W. Martin*

Your company's brand can be its most valuable asset, but a brand can become worthless if you don't protect it with a properly maintained trademark. Trademarks are the most commonly known form of intellectual property and can include words, phrases, tag lines, logos, colors, fragrances, three dimensional shapes, and sounds.

It is worth the investment to engage the services of an intellectual property attorney early in the business process as s/he can help develop, protect, and prevent exploitation of your brand by others. Counsel will be able to help properly register your trademarks, avoid common mistakes in the application process, and make sure you are protected through the varying rules in foreign countries.

To adequately protect your brand, a trademark owner should follow the following five strategies:

#1—Select a protectable trademark

Not all brand names are eligible for protection; therefore, selection of a trademark should be driven by the acceptability for registration and the strength of the mark.

Registrability. The mark you choose should be capable of registration in each country in which you conduct business. You must

consider various factors, including:

- Any meaning of the mark, including in a foreign language;
- Whether any conflicting or confusingly similar marks are used and/or registered;
- Whether the mark is generic or immediately descriptive of the goods or services the company sells; and
- Whether the corresponding domain name is available.

Strength. Trademarks are classified into five categories of "strength." The stronger the trademark, the easier it is to register and protect. The first category listed below is the strongest; the last category is the weakest and afforded no protection at all.

- Fanciful – The strongest marks, these are coined terms invented specifically for the designated goods or services (e.g., Xerox®.)
- Arbitrary – Second in strength, these marks are actual words that have no connection to the designated goods or services (e.g., Apple® for computers.)
- Suggestive – Next in strength, these marks suggest the goods or services they designate without directly describing them

(e.g., COPPERTONE® for tanning products.)

- Descriptive – On the weaker end of the scale, these marks describe the designated goods or services and are not immediately registerable unless and until the user can establish that the trademark has acquired distinctiveness to the consuming public (e.g., Honey-Baked® for hams.)
- Generic – These marks are at the lowest end of the scale and are entirely unprotectable. Terms are generic if they are commonly used to describe the designated goods or services.

Do your best to select a trade-



Lisa Martin is an associate and member of the trademark practice group at Wolf Greenfield, where she focuses on U.S. and

international trademark counseling, prosecution, and proceedings before the Trademark Trial and Appeal Board, advising on branding strategies, pursuing and resolving trademark and copyright infringement, right of publicity, domain name disputes, and licensing issues.

Telephone: 617.646.8331

Email: lmartin@wolfgreenfield.com

mark that falls into the first three categories.

#2—Determine the availability of the trademark and domain name

Before establishing a trademark, you should conduct a clearance search of your top trademark contenders for both the trademark and the domain name. A clearance search examines registration records to uncover any prior registered or common law uses that would prevent use of your mark. These searches will uncover trademarks that are identical or similar in sound, meaning or appearance and are for use on similar or related goods.

#3—Use your trademark properly

The use of your company's trademark must satisfy the statutory requirements; otherwise, your company can lose rights in its trademark.

- **Use your trademark as an adjective.** Do not use your trademarks as a noun or a verb.
- **Use distinctive type.** Display your trademark in a manner that distinguishes it from the rest of the text, such as capitalized, bolded or otherwise distinctive lettering to distinguish the trademark from the surrounding images or text.
- **Use appropriate markings.** Designate your trademark with the appropriate "™" or "®"

symbol to give notice of your trademark rights. The registration notice ® or should be used only when a mark has been registered for the designated good or service. If your mark is not yet registered, use the ™ symbol.

- **Only use your trademark on approved goods/services.** Use your trademark only for the goods and services for which it is has been cleared or registered.
- **Apply your trademark on your goods or services.** Marks must be affixed to the designated goods or services. Always apply your trademark directly to your goods, the packaging for the goods, or the labels that are attached to the goods. Apply your service mark to advertisements, brochures, catalogs or similar notices offering the services.
- **Use your mark consistently.** Do not vary the way your trademark is used. Be consistent to enhance the distinctiveness and consumer recognition of the mark.

#4—Obtain rights in your trademark through registration

Trademark laws vary from country to country. In some countries, including the United States, a trademark owner has rights in a trademark without registration. However, in most countries, filing an application for and issuance of a registration is the only way to obtain rights in a trademark. A trademark registration can pro-

vide protection against trademark infringers, can be cited against later filed applications, and provides prima facie evidence of ownership of the trademark.

It is not uncommon for international manufacturers, distributors, and pirates to register your trademark if you have not done so. Therefore, be sure to consider filing in the increasingly important international markets. The best way to avoid piracy is to file early.

#5—Monitor and protect your trademark rights

Now that you have registered your trademark, you must be vigilant in monitoring and protecting your trademark rights. Failure to do so can have legal consequences. You must keep an eye on your company's marketplace by defending your trademark against infringers, opposing applications that are confusingly similar to your trademark, and constantly asserting your company's rights to its trademarks.

To help in this process, set up a Google Alerts account, use a watch service to monitor third party uses and applications, and register with U.S. Customs to prevent importation of goods bearing your registered mark.

Take immediate action to halt misuse or you risk jeopardizing your trademark rights. Follow the above strategies to ensure proper use, protection, and policing of your valuable trademarks.