



Trademark Basics and Best Practices for Businesses



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Disclaimer	1
About Crystal Broughan, Esq.	2
Introduction	3
Chapter 1: What It Means to Register Your Trademark	4
What You Can Register As a Trademark	4
What You Cannot Register for a Trademark	5
Understanding the Strength of a Trademark	6
Understanding “Secondary Meaning” and How to Get Your Mark There	7
The Supplemental Register for Merely Descriptive Marks	7
Chapter 2: Creating Your Trademark Carefully	10
What You Need to Know About Trademark Searches	10
The Du Pont Factors to Determine Likelihood of Confusion	11
Chapter 3: Costs Associated with Trademark Application	13
Other Factors to Consider	15
Chapter 4: The Benefits of Registering Your Trademark	16
When Not to Register a Trademark	17
Chapter 5: How to File for Trademark Registration	18
Chapter 6: The Trademark in the Digital Age	19
Can You Register Your Domain Name as a Trademark?	19
Trademark Coexistence Agreements in an Internet World	20
Chapter 7: Best Practices to Protect Your Trademark	22
Why You Should Develop a Trademark Enforcement Plan	23
Why Companies Should Encourage Respect for Intellectual Property Assets	24
Conclusion	26
Additional Resources	26
Glossary of Keywords	27

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Every case is unique, and we strongly encourage you to consult with an experienced intellectual property attorney for advice regarding your particular situation. This book is not intended to be an exhaustive guide on trademark law. No guidance or recommendation provided is an indication or representation that a particular result may or will occur.

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About Crystal Broughan, Esq.



Crystal Broughan's practice focuses primarily on intellectual property matters such as trademarks, copyrights, trade secrets, non-disclosure agreements, and licensing agreements. She handles copyright and trademark infringement cases, as well as domain name disputes, and prepares and files trademark and copyright applications for a wide variety of clients.

Broughan represents clients in both federal and state courts, before the Trademark Trials and Appeals Board on trademark disputes, and the World Intellectual Property Organization on domain name disputes.

If you have any questions about trademark law, you can reach out to Crystal Broughan by emailing cbroughan@marksgray.com or calling 904-807-2180.

Introduction

Welcome to the world of trademarks. I have practiced law for over 30 years. In the years that I have focused on intellectual property law, I have enjoyed working with entrepreneurs, artists, marketing teams, and large and small businesses in their efforts to identify and protect their trademarks.

Along the way, I have learned valuable lessons about trademarks, copyrights, licensing agreements, and trademark scams, just to name a few. When meeting with new and potential clients, I have found that the same questions often come up, so I have compiled my thoughts and knowledge in this book to share them as a resource for others with those same questions. I believe you will find plenty of useful resources and helpful information within this book.

Some of my most interesting clients are ones who tried to register trademarks with the United States Patent and Trademark Office (USPTO) on their own. Sometimes they were successful, but sometimes the applications were refused.

When their applications are refused, those stumped clients come to me, asking that I save the application. I enjoy helping my clients understand why the application was refused and how we can fix the problem. I don't enjoy telling them we must start over entirely because they made a mistake.

Hopefully, the lessons in this book will prevent others from making those mistakes in the future.

Trademarks are very valuable assets for companies. Learning proper trademark selection and protection is immensely important to all businesses — no matter how many people they employ or how much money they make.

Your trademarks distinguish your goods and services in the marketplace from competitors. Take the time to create a strong trademark and make sure the goods and services you provide under the trademark bring value to the consumer.

Best of luck on your venture!
Crystal Broughan, Esq.

Chapter 1: What It Means to Register Your Trademark

Your business, your ideas, and your art are important to you. You have spent years dreaming up these ideas. Sharing them with the world increases the risk someone copies what you have created.

One powerful way to protect your work is filing for trademark registration.

A trademark identifies a product's source. It helps customers differentiate your business from competitors. Once you develop a good reputation, customers know they can trust products bearing your trademark.

Service marks are close cousins to trademarks and serve a similar purpose. They identify the source of *services* instead of *goods*.

But you cannot register a trademark or service mark for just anything. Learn the rules of what can and cannot register as a trademark before you file any applications with the United States Patent and Trademark Office (USPTO).

What You Can Register As a Trademark

When you apply for a trademark registration, you apply to legally register intellectual property (IP) that identifies your company or products.

This includes:

- Words
- Stylized words
- Symbols
- Combinations of words and designs
- Designs

For example, business owners can apply to register their brand logo and brand name as separate trademarks.

What You Cannot Register for a Trademark

However, not all brand names and logos are eligible for trademark registration. The USPTO will refuse to register your trademark for any of the following reasons:

- Generic Name of the Goods or Services
- Merely Descriptive
- Geographically Descriptive
- Deceptively Misdescriptive or Deceptive
- Geographically Deceptively Misdescriptive
- Geographical Names for Wines and Spirits
- Use of Name, Symbol, or Device of Organization Prohibited by Statute
- Flag, Coat-of-Arms, or Other Insignia of the United States, State, Municipality, or Foreign Nation
- The Name, Portrait, or Signature Identifying a Particular Living Individual or a Deceased President of the United States During the Life of the Widow
- Primarily a Surname
- Non-Ownership of the Mark
- Mark Does Not Function as a Trademark or Service Mark
- Unlawful or Improper Use in Commerce
- Likelihood of Confusion, Mistake, or Deception

There are some exceptions to the list of reasons for refusal, but it is wise to stay away from these types of words and designs.

It is important to note a few items that many people mistakenly attempt to register as a trademark. If original artwork is *not* used as a source identifier for goods and services, it should be protected with a copyright registration — not a trademark registration. If you want to protect an original invention, you will have to apply for a patent with the USPTO, though you might be able to obtain a trademark registration for the brand name and logo (design marks) attached to the product and the business that sells the product.

Understanding the Strength of a Trademark

There are five official categories of trademarks, from strongest to weakest:

- Fanciful
- Arbitrary
- Suggestive
- Merely Descriptive
- Generic

Fanciful marks are literally made-up words. They have no other inherent meaning. Xerox® and Kodak® are good examples. These tend to make the strongest trademarks since they are, by nature, unique.

Arbitrary marks do have meaning outside the trademark, but that meaning is incredibly different from how the business is using them, like Apple® for computers and cell phones or Camel® for cigarettes. Arbitrary marks also tend to be a stronger type of trademark.

Suggestive marks serve to suggest the meaning of the mark without acting as a direct description. Some examples include Playboy®, Coppertone®, and Microsoft®. Suggestive marks are moderately strong and tend to be the most common. Businesses like to make their marks evocative of what they are offering while still remaining unique enough to stand out.

The weakest marks are generic, like “Auto Mechanics,” “Bikes,” or “Shoes.” These are words that are so widely used and non-specific that anyone selling similar products or services should be able to use them; therefore, they cannot become registered trademarks for these products.

And then there are merely descriptive marks. Falling somewhere between generic and suggestive, descriptive marks are those that describe “an ingredient, quality, characteristic, function, feature, purpose, or use of the relevant services” or products in a literal, straightforward way. Such as “Creamy” for yogurt or “Coastal Winery” for varietal wines. Marks that include a surname may fall into this category, such as “Smith’s Pawn Shop.”

There is, however, an exception. If a merely descriptive mark attains a “secondary meaning” or has “acquired distinctiveness” in the marketplace, it can be registered by the USPTO.

Understanding “Secondary Meaning” and How to Get Your Mark There

Secondary meaning is achieved when a specific merely descriptive mark becomes so associated with a particular company or product/service that it attains a meaning with consumers beyond the original definition.

Let’s look at a couple of examples – Sharp® and Windows®.

When referring to televisions, sharp describes the image on the screen and maybe even the sound. You do not have to worry about any fuzziness.

However, when you capitalize the word – Sharp® – you know that we are talking about a specific brand. The word has achieved secondary meaning within the world of TVs and consumer electronics in general.

A similar situation happened with windows as a way of describing computer software that used windowing. Despite the fact that iOS and other operating systems use windowing features, no one thinks of that when they hear the word windows in reference to software. Consumers think of Microsoft Windows®.

Just like Sharp®, the word windows attained a secondary meaning in the computer world. Windows® is not considered merely descriptive of a type of operating system software, but a specific product created by Microsoft.

How did these merely descriptive marks attain secondary meaning? The same way anything else might: publicity and long-term use. In other words, so many people see the trademark associated with a particular company or product/service over a period of five years or more that the mark immediately calls that company or product/service to mind.

The Supplemental Register for Merely Descriptive Marks

In certain situations, after filing a trademark application, you will receive an Office Action (refusal to register) from the trademark examining attorney suggesting you amend the application to the Supplemental Register.

This happens when the examining attorney thinks the mark is capable of serving as a source identifier of goods or services.

The types of marks placed on the Supplemental Register include:

- Descriptive marks that could acquire distinctiveness in commerce in the future
- Surnames
- Geographic terms
- Nondistinctive, nonfunctional trade dress

The Supplemental Register does not afford the same level of protection as the Principal Register, but it still has valuable advantages versus not being registered at all.

The advantages include:

- You may use the notice of federal trademark registration, ®.
- You have the right to bring a trademark infringement lawsuit in federal court against a trademark infringer and claims of unfair competition.
- The USPTO examining attorneys may cite the registration against later trademark applications for similar marks for related goods/services since the registration on the Supplemental Registration helps you establish priority.
- A Supplemental Registration will appear in trademark clearance searches.
- It serves as a means of protecting the mark while working to acquire secondary meaning or acquired distinctiveness in commerce.
- The registration may be used as the basis for securing trademark registrations in foreign countries.

The benefits not afforded by the Supplemental Register include:

- There is no presumption of validity, ownership and exclusive rights to use the mark;
- Cannot be used to prevent the importation of infringing or counterfeit products; and
- The mark may never become incontestable

Trademarks that are placed on the Supplemental Register are never published, so third parties may not oppose the registration on the Supplemental Register. If a third party is opposed to the registration of a trademark on the Supplemental Register, the third party will have to file a Petition to Cancel the registration after the certificate of registration on the Supplemental Register has been issued by the USPTO.

After five years, if the owner of the Supplemental Registration thinks the mark has acquired secondary meaning in commerce, the owner can file a new trademark application with the USPTO and try to get the mark registered on the Principal Register.

The owner may need more evidence that the mark has acquired secondary meaning/distinctiveness to overcome the merely descriptive label, such as:

- Documentation showing the mark has gained notoriety.
- Evidence the mark has been extensively used in advertising on multiple platforms.
- Declarations from third parties (consumers) that the mark has become well-known and is associated with the goods/services of the trademark owner.

A Supplemental Registration will protect the trademark while the business grows and establishes its brand in commerce. If the business is successful and consumers start to automatically associate the trademark with the business as the source of goods/services, the owner may be able to obtain a registration on the Principal Register for full protection of the mark.

Chapter 2: Creating Your Trademark Carefully

Not all logos or business names qualify for registration with the USPTO and the accompanying protections. Consider these factors to select and protect your mark.

- **Make sure it is distinguishable.**

You want your trademark to be considered arbitrary or fanciful. If your mark simply describes the products you produce or services you provide (e.g., Delicious Ice Cream, Effective Marketing Solutions), it can be considered “[merely descriptive](#).” (See chapter 1 if you need a reminder for why that is not good.)

- **Make sure it is not already in use.**

You cannot register a mark that too closely resembles a competitor since that would make it hard for consumers to differentiate the source of goods or services (i.e., likelihood of confusion). Conduct a thorough trademark search before committing to a mark.

What You Need to Know About Trademark Searches

When a company decides to change their logo or create a new product line that needs a name and logo, they will task their marketing department or a branding consultant to develop the new name and logo.

As the new names and logos are narrowed down to a select few choices, the person in charge of the process should make sure that trademark searches are conducted on the proposed new names and logos before any final decisions are made. This is important because the new trademark and logo cannot be registered with the USPTO if someone already owns an identical or similar trademark registration in the same (or similar) class of products or services.

There are many types of searches that can be conducted, and the cost varies based on their thoroughness.

- A preliminary search includes government databases, proprietary databases, and the Internet.

- A comprehensive trademark search includes searches of registrations in all states of the United States as well as the top internet search engines and domain names to determine if anyone is using the mark in commerce. And it will include searches by different classes (i.e. Class 25 for clothing, Class 30 coffee, Class 11 Coffee roasters, Class 21 coffee mugs, Class 43 coffee shops).
- An international trademark search should be conducted if your company plans to sell its products or services in other countries in the future.

When determining how much should be spent on a trademark search, a company needs to balance the cost of search with the risks of not searching. Spending money upfront on a comprehensive search may help prevent a company from spending thousands of dollars on a new brand and then having to change their entire brand strategy because another company is already using the trademark and has priority in the marketplace.

The Du Pont Factors to Determine Likelihood of Confusion

The USPTO uses a thirteen-factor test known as the Du Pont factors when reviewing a trademark registration to determine if there is a likelihood of confusion among consumers under Section 2(d) of the Lanham Act:

1. the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
2. the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a mark is in use;
3. the similarity or dissimilarity of established, likely-to-continue trade channels;
4. the conditions under which, and buyers to whom, sales are made, that is, “impulse” vs. careful, sophisticated purchasing;
5. the fame of the prior mark;
6. the number and nature of similar marks in use on similar goods or services;
7. the nature and extent of any actual confusion;
8. the length of time during, and the conditions under which, there has been concurrent use without evidence of actual confusion;
9. the variety of goods on which a mark is or is not used;
10. the market interface between the two marks;
11. the extent to which a trademark owner has a right to exclude others from use of its mark;

12. the extent of potential confusion, that is, whether de minimis or substantial; and
13. any other established fact probative of the effect of use.

In re E.I. du Ponte de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

Not all of these factors are applicable in every case, but they should always be considered when conducting a trademark search.

Chapter 3: Costs Associated with Trademark Application

The first question many potential clients ask is, “How much will it cost to register my trademark?” Since there are many variables that come into play when registering a trademark, there is no set answer to this question. Here are a few issues that need to be considered before an estimated price can be provided.

- **Are you currently using the trademark in commerce? If so, for how long?**

This will determine if you file an intent-to-use trademark application or an in-use trademark application.

If you file an intent-to-use trademark application, there are additional costs associated with filing a Statement of Use or a Request for Extension of Time to file a Statement of Use.

- **Are you aware of anyone else using the same or a similar trademark to sell the same goods and services?**

If so, you will encounter more expense in the long run, because there is a good chance there will be a challenge to your trademark application or registration.

- **Have you conducted a thorough trademark search?**

See the previous section on What You Need to Know About Trademark Searches.

- **What is your trademark? A simple wordmark? A stylized wordmark? A design/logo with words? Or a design/logo without words?**

If your trademark consists of a design/logo with words, you have to decide if you want to register the words separately from the design/logo.

You need to consider how you are using the trademark. Do you use the design/logo without the words and words without the design/logo?

You may need to file trademark applications for each variation of the trademark that you are using in commerce. For example, Starbucks® has registered the siren design, the word Starbucks®, and the combination of the word with the siren design.

- **What products and/or services are you providing?**

You may need to file trademark applications in more than one class of goods and services.

For example, if you are opening a coffee shop that also sells food and coffee accessories, you could register in many different classes (e.g., Class 43 for coffee shop, Class 30 for coffee, Class 11 for coffee roasters, Class 21 for coffee mugs, scoops).

- **Where are you selling the products and services – locally or nationwide over the internet?**

If you are only selling your products in the city where you live and have not expanded beyond those boundaries, then you only need to obtain a state trademark registration.

If you have a website and are promoting your goods and services throughout the nation, it is wise for you to obtain a trademark registration through the USPTO.

- **Do you want to file a trademark application in the primary state in which you do business?**

The filing fees range from state to state. Contact the state agency which manages trademark registrations, usually the State Division of Corporations, and find out how much it costs to file the trademark application.

- **Do you want to file a trademark application with the United States Patent and Trademark Office?**

The USPTO filing fees range from \$225 to \$325 per class. The filing fee depends upon the description of goods and services you insert into the application

If you use a description from the Acceptable Identification of Goods and Services Manual (ID Manual), then it costs \$225 when you file the application electronically. If you customize your description of goods and services, then it costs more.

Other Factors to Consider

Once the trademark application is filed, the state trademark office or the USPTO may refuse to register the trademark for many different reasons (you will receive an “Office Action”). A simple edit to the description of the mark or the goods and services may be requested, or the issue could be bigger or more complex.

The trademark owner then has to determine if they want to file a Response to the Office Action or abandon the application. The Response to Office Action takes more time and costs more depending upon the seriousness of the refusal and whether or not there is a chance of ultimately getting the examining attorney to change his/her mind.

If the trademark examining attorney does not accept the arguments presented in the Response, the trademark owner must decide if they want to appeal to the TTAB, which costs even more money.

- **Petition to Cancel**

The trademark owner may need to file a Petition to Cancel another trademark registration if a prior registration is preventing the registration of your trademark. This is possible if your trademark has priority in commerce or if the other trademark registration has been abandoned and is not being used in commerce.

- **Notice of Opposition**

The trademark application may be accepted by the USPTO but, during the 30-day period of publication to the public, another entity may file a Notice of Opposition with the TTAB opposing the trademark application. The trademark owner then has to decide whether or not to fight the Notice of Opposition, abandon the trademark application or try to negotiate a settlement or coexistence agreement with the opposing party.

All of these factors play into the overall cost of obtaining a trademark registration.

When you meet with your attorney, make sure you have answers to the questions listed. Discuss with your attorney the best strategy for protecting your trademarks and a good budget for obtaining and maintaining the trademark registrations.

Chapter 4: The Benefits of Registering Your Trademark

Your brand name and logo are valuable. A brand name and logo that have been registered as trademarks are *more* valuable.

By registering your trademark, you will obtain the following benefits:

- Official documentation of ownership of the trademark
- Presumption of exclusive right to use the registered trademark in commerce
- Registration appears on the USPTO's on-line trademark database, which is open to the public to search
- Right to use the ® symbol next to your trademark, which tells the public it is a registered trademark
- Right to exclude importation of counterfeit or similarly branded goods from foreign companies
- US registration can be the basis for an international registration of the trademark if you decide to expand into foreign markets
- Presumption of validity gives you an advantage in terms of the burden of proof in a trademark infringement lawsuit (may even be entitled to treble damages in certain cases)

Registered trademarks contribute value to your company, showing potential investors or buyers that you are the legitimate owner of the brand name. They are important protection if you plan to expand your business into other regions of the country or if you plan to register your trademark in international markets.

Additionally, you gain protection from cybersquatting, the practice of registering a company name related to an existing business as an internet domain and hoping to resell the domain for a profit (often considered a form of extortion). You may be able to get the domain name transferred to your control using the Uniform Domain Name Dispute Resolution Policy or file a lawsuit in federal court under the Anticybersquatting Consumer Protection Act.

When Not to Register a Trademark

Trademark registrations are a fantastic way to protect your brand. But how do you know if you really need to invest the time and expense in registering a trademark with the USPTO?

There are at least four reasons a trademark registration may not be necessary.

- **Use is limited.**
Is your product use limited to a certain location? Is the trademark needed only for a brief period (i.e., a seasonal promotion)? If you can answer yes to these questions, it may not be worth seeking registration with the USPTO.
- **Copying is not a threat.**
You may operate in an industry that is not highly identified by brands. If branding is not a big deal, you are probably not too worried about copycats. You can simply register one or two top brands within your company and leave the rest unregistered.
- **Your trademark is descriptive.**
If your trademark has a dictionary meaning commonly used to describe your products or services, the USPTO may reject your trademark application for being merely descriptive. (See Chapter 1.)
- **Competition is crowded.**
The USPTO may be handling several other similar registrations, in which case they will either suspend your application or refuse to register your mark due to the likelihood of confusion among consumers. Consider finding a new angle and developing another brand.

Once you have determined that you should file for trademark protection, the next question is how. We will cover that in the following chapter.

Chapter 5: How to File for Trademark Registration

If you have a trademark and are ready to apply for a trademark registration, here is the information you will need to provide to your lawyer to start the process.

- Is the trademark currently being used in commerce? Or do you intend to use it in the future?
- Is the trademark a word or words, a design and/or a combination of words with a design? What is the trademark?
- How is the trademark being used in commerce?
- What are the products and/or services that the trademark is being used to market in commerce?
- Do you have .jpg files of the design mark or a combination of words with design?
- Do you want to claim a specific color scheme as part of the trademark? If yes, what are the colors?
- Who or what is going to own the trademark registration? An individual, a corporation, a Limited Liability Company?
- What is the address and contact information for the owner of the trademark?
- Where do you want to register the trademark? State government agency? USPTO? Foreign countries?
- What is the date of the first use of the trademark anywhere?
- What is the date of the first use of the trademark in commerce?
- How are you using the trademark in commerce?
- Do you have specimens (examples) of use in commerce? For products, the trademark needs to be on packaging, labeling, or on the product itself. For services, the trademark needs to be on a website, or in a marketing brochure, a manual, or menu.
- Who originated the mark? How did you come to own the trademark?

Most experienced trademark lawyers will give a potential client or client a form to complete that will provide the lawyer with all of this information. If you decide to register a trademark on your own, here are [video resources from the USPTO](#).

Chapter 6: The Trademark in the Digital Age

Trademark protection is increasingly beneficial, but also complicated in the internet age.

In this chapter, we will look at some issues related specifically to trademarks and the internet, including registering a domain name as a trademark and trademark coexistence agreements.

Can You Register Your Domain Name as a Trademark?

A domain name can be registered as a trademark only if it is used as a source identifier of goods and/or services. Simply registering a word or words as part of a domain name does not establish trademark rights.

Remember, a trademark identifies and distinguishes the source of goods or services in commerce. The key is whether the trademark has been used to make such a visual impression that consumers would see it as a symbol of origin of goods and/or services separate and apart from anything else.

The USPTO looks at the following factors to identify whether or not a designation is used as a trademark:

- larger-sized print,
- all capital letters or initial capitals,
- distinctive or different print style,
- color,
- and a prominent position on the label or advertising copy.

If the domain name is only used in the address for the website or as a link in correspondence, then it is not being used as a trademark.

Domain names are considered the equivalent of street addresses, telephone numbers, or radio station call letters. All of these are designations that permit one to locate and communicate with a place or person, but without more, such designations do not perform the function of a trademark.

So if you think the domain name for your company should be registered as a trademark, take a good look at how you use the domain name in the company marketing materials.

Ask yourself the following questions:

- Is the domain name in a larger sized print than the rest of the words on the page?
- Is the domain name distinctive or in a different print style or color?
- Is the domain name in a prominent position on a label or advertising copy?
- When people see the company domain name, do they identify it as a source identifier of your company's specific goods and services?

Register only marks that clearly distinguish your company as the source of the goods or services your company sells in commerce.

Trademark Coexistence Agreements in an Internet World

Have you ever noticed two businesses on the internet functioning under the same or similar trademarks?

This is not an uncommon occurrence. And if each business is producing different products or services, there is usually no problem. Additionally, if businesses are selling similar products and services in different geographical areas, there may not be a problem. The trademarks are still able to maintain their main function: to distinguish a company's goods or services from its competitors.

However, with the internet, smaller brands are now competing nationwide or even globally. There is more potential for businesses to develop identical or similar trademarks and more potential for two businesses that previously coexisted without a problem to find that they overlap.

Even if there is no physical overlap, there may be digital overlap. The business owners may seek the same domain name or encounter trouble with consumers erroneously going to the competitor's website. There may also be confusion caused by the use of a similar social media user name that impacts your brand's reputation.

If you find that another company is using the same or a similar trademark for similar services or goods, you may want to consider a trademark coexistence agreement where both parties recognize the other's right to the trademark and agree to terms that allow them to exist together in the marketplace.

The goals of this type of agreement are to resolve a potential trademark dispute, prevent future situations where the two trademarks overlap in an undesired or infringing way, detail the rights of both parties, and avoid confusion in the marketplace.

You can find more information about the potential benefits and downsides of trademark coexistence agreements in the Additional Resources section of this book.

Chapter 7: Best Practices to Protect Your Trademark

Your trademark is valuable intellectual property, and you can – and should – protect it. Here are several best practices your company should follow.

- **Use your trademark continuously and consistently.**

This means you should always use the same capitalization, font, and colors. Also, use the same punctuation and spacing every time.

Never use the plural or possessive form of a mark.

- **Be consistent in your use of recognized trademark symbols.**

There are three recognized trademark symbols: ® TM SM. You should only use the ® symbol after you have received a trademark registration from the USPTO.

Before you receive a registration, you can use TM or SM to let the public know you are claiming a common law right to the mark.

The TM symbol stands for common law trademark and should be used for marks that represent goods. The SM stands for common law service mark and should be used for marks that represent services.

The use of these recognized trademark symbols does not impact your trademark rights, but it does let competitors know that you own the trademark and will protect and enforce your rights.

You should only use the symbols when the mark is used as an adjective to identify the source of specific goods or services.

This is an important distinction because if it is used as a noun or verb, it could become generic. Generic marks are not entitled to legal protection. Here are a few examples:

Incorrect: “use a Kleenex,” “Xerox some photocopies,” “rollerblade to the store”

Correct: Kleenex® brand tissues, Xerox® brand photocopier, and “skate in Rollerblade® brand inline skates to the store”

Be sure to use the same generic term to describe your product. For example, do not call it “JW® brand baked goods” in one spot and “JW® brand desserts” elsewhere.

Consistently use an attribution statement on marketing materials, ads, product packaging, website, and manuals.

- **Create branding guidelines.**

Your company may have many employees who use your trademark on a regular basis. This can cause inconsistent use of anything from color to attribution.

You can help prevent this by creating brand guidelines that detail exactly what is required every time your trademark is used. Then share these guidelines with all employees – regardless of their position – and make them easily available as a reference.

Why You Should Develop a Trademark Enforcement Plan

You have invested time, money, and resources into the development and registration of one of your company’s most valuable assets – it’s trademarks. The next step is developing a trademark enforcement plan to actively protect the trademarks.

Although the idea may seem daunting, the core of a trademark enforcement plan boils down to three simple steps:

- **Monitor the market.**

Unless someone monitors the market, there is no way of knowing whether an infringement is occurring. If you are unaware, you cannot protect your trademarks.

The quickest method for monitoring the market is engaging in regular online searches, including the USPTO database, Google, and popular social media platforms for your industry. You also have the option to use a third-party monitoring service.

- **Consult an intellectual property attorney.**

You should enlist the guidance of an intellectual property attorney before any infringement has occurred. She can advise you on preventative measures and ensure you understand your rights related to the registered trademark.

- **Take action.**

Swift action is key when protecting your trademarks, and your attorney will be your best line of defense. You and your attorney will most likely draft a cease-and-desist letter. If there is no change in the infringing parties' actions, you may decide to enter into litigation.

Imitation is inevitable when you have a successful product or service on your hands. Developing a trademark enforcement plan will provide you with peace of mind and the confidence you need when you do encounter infringement.

The question is not whether you *should* have a plan but *how quickly* you can put one in place.

Why Companies Should Encourage Respect for Intellectual Property Assets

In my experience as an intellectual property lawyer, I have seen the benefit of educating individuals on the value of trademarks and other IP assets in the success of businesses.

Learning to identify, monitor, and protect key IP assets will build value in a company. That's why, whether large or small, all businesses should develop and maintain a culture of respect for the intellectual property created and owned by the business.

Here are a few tips for doing so:

- **Create a culture of knowledge and respect for IP assets.** This includes trademarks, copyrights, patents, trade secrets, and trade dress.
- **Learn how to make the most of your IP assets.** If your company is small, focus on building value in the IP assets. If your company is large, demonstrate and build on the value created by the IP assets.
- **Leverage the value of IP assets in commerce.** For example, make use of strong licensing agreements and engage in the ongoing protection of products and brands.
- **Get rid of IP “waste.”** Dispose of or sell off IP assets that the company is not using and bring no value to the company.

- **Learn to collaborate with in-house and outside counsel.** Outside counsel should understand the culture of the business and know the business well.
- **The fewer resources you have, the more you need to plan.** Proactively monitoring and protecting your trademarks is more efficient and cost-effective than reacting to a crisis. Planning keeps costs under control in the long term.
- **Be a more attractive investment.** Investors and venture capitalists like intellectual property assets that are registered and protected. Proper registrations and ongoing protection bring greater value to trademarks, patents, copyrights, and trade dress.

Today's business world is crowded. In many cases, you are not just competing with companies in your community or state, but across the country or even the world. To succeed, you must offer a differentiated product or service.

It is your IP assets that allow consumers to quickly differentiate your company from others. This makes them powerful, indispensable tools for staying competitive and growing your business.

Conclusion

The Marks Gray intellectual property team is always willing to work with individuals and businesses that value their trademarks and want to ensure their trademarks are properly registered and protected. We also help defend our clients against trademark infringement and stop others from infringing on their valuable trademark.

If you would like the Marks Gray intellectual property team to assist you, please feel free to contact us at 904-398-0900. Attorneys Crystal Broughan and Logan McEwen will be more than willing to assist you.

Additional Resources

- [4 IP Tips for Expanding Your Business Globally](#)
- [Foreign Trademark Applicants and Registrants Now Required to Have US-Licensed Attorneys](#)
- [Trademark Coexistence Agreements in an Internet World](#)
- [The Pros and Cons of Trademark Licensing](#)
- [Accused of Trademark Infringement: Do You Have Insurance?](#)
- [What to Do After Discovering Infringement of Your IP Assets Blog Series](#)
- [Trademark Counterfeiting Blog Series](#)

Glossary of Keywords

Acceptable Identification of Goods and Services Manual – Also known as the USPTO ID Manual, this document provides a listing of identifications that have been deemed acceptable for specific goods and services.

Co-existence Agreement – This is a type of agreement made by two parties who do not want to interfere with each other’s businesses or products, but do wish to continue marketing under a similar trademark.

Copyright - Copyright is a form of protection grounded in the U.S. Constitution and granted by law for original works of authorship fixed in a tangible medium of expression (i.e. books, artwork). Copyrights protect both published and unpublished works.

Cybersquatting – A practice whereby an individual or entity registers specific domain names in the hopes of later selling them for a profit. When this is done with company or brand names in bad faith, it is against U.S. federal law.

Declaration of Continued Use – An official signed statement (under Section 8 of the Lanham Act) from the owner of a trademark claiming they have continuously used that trademark for at least five years.

Declaration of Incontestability – An official signed statement (under Section 15 of the Lanham Act) from the owner of a trademark claiming no one has contested the owner’s right to use the mark in the past five years.

Domain Name – The web address where Internet users can access a website; a website name. (Examples include amazon.com and npr.org.)

DuPont Factors – A set of factors laid out in the case *In re E.I. du Pont de Nemours & Co.* that are used in Federal courts to determine whether two trademarks could likely be confused in the minds of consumers.

JPG (.jpg) – A method commonly used to compress digital images; a digital image filetype.

Lanham Act – Also called the Trademark Act, this law went into effect in 1947 and is the primary federal trademark statute in the United States.

Madrid Protocol – An international treaty signed by over 120 countries that is designed to simplify the international trademark registration process; trademark owners can file a single international trademark application for protection in the countries that signed the treaty.

Notice of Opposition – This is the official document that must be filed with the Trademark Trial and Appeal Board (TTAB) during the 30 day period of publication of a trademark application if a third party wants to prevent a trademark from being registered after it has been preliminarily approved by the USPTO.

Office Action – When you apply for trademark registration with the USPTO, the application will be examined by an examining attorney. If that attorney uncovers any legal problems related to your trademark application, they will issue an official letter called an “office action” that states the reasons for refusal and issues that need to be corrected.

Patent – A patent is a right or title given by the U.S. government that provides the owner sole rights to make, use, or sell an invention for a set time period.

Petition for Cancellation – If an individual or entity thinks that a trademark registration will cause them damage, they may file a petition with the TTAB for the registration to be canceled within the first 5 years of registration.

Service Mark - A recognizable symbol, word, or words which serves as a source identifier for a service in the commerce.

Trade Dress – A type of intellectual property comprised of the various elements used to market or sell the product or service. Trade dress for a product typically consists of things like packaging, displays, and even the look of the product itself. Trade dress for a service may consist of things like the environment in which the service is delivered, such as the decor of a restaurant.

Trademark – A recognizable symbol, word, or words which serves as a source identifier for a product used in commerce.

Trade Secret – Specific designs, formulas, instruments, patterns, practices, processes, or compilations of information used by individuals or entities that have economic value because they are not well-known and which the individual or entity strives to keep secret.

TTAB – The Trademark Trial and Appeal Board is a neutral administrative body at the USPTO that handles adversarial trademark proceedings, such as Notices of Opposition, Petitions to Cancel, and appeals for Final Office Actions.

URL – The address of a specific page on the World Wide Web. Differs from a domain name in that it can refer to pages within a domain, such as <http://www.marksgray.com/category/news/>.

USPTO – United States Patent and Trademark Office, a federal government agency that grants U.S. patents and trademark registrations.

WIPO – World Intellectual Property Office is the global forum for intellectual property services, policy, information and cooperation. They are a self-funding agency of the United Nations, with 193 member states.

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