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Registering Your Trademark Offers Protection and Peace of Mind

Posted on September 26, 2014 by Lee Kirner (<http://www.canteyhanger.com/blog/author/lee-kirner/>) and Stephen Taylor (<http://www.canteyhanger.com/blog/author/stephen-taylor/>)

Lately we have had a number of clients approach wondering whether they should file for federal or state trademark protection for their existing name or logo as a trademark or service mark. A trademark is used in connection with tangible goods or products sold in commerce, while a service mark is used in connection with services. Trademarks and service marks are generally in the form of word marks and design marks. For purposes of this discussion, trademarks and service marks are jointly referred to as trademarks.

Many times we hear from non-attorneys that trademark rights do not exist until registered with the state or federal trademark authority. That is simply not the case. Common law rights to trademarks arise from actual use of a mark (not from registration), and may allow the common law user to successfully challenge a federal or state registration or application. That is, in the event another person is using a confusingly similar trademark in the same region, the party that was using the mark first can seek to enjoin any use of the confusingly similar mark. While common law rights provide an avenue of relief for a party that has not registered or attempted to register its trademark, common law offers nowhere near the protections afforded a state or federally registered trademark. For instance, common law rights are limited to the geographic area in which the trademark is used and the owner of a common law mark may only identify its trademark with the unregistered trademark designation of ™ instead of the more powerful ®.

There are several major benefits to registering a trademark. First, once approved, there is a presumption that (1) your trademark is valid; (2) you are the owner of the trademark; and (3) you have the exclusive right to use the mark in the relevant jurisdiction of the approving authority in connection with the relevant goods or services.

Second, the process of obtaining a federal or state registered trademark itself provides some assurance that you are not infringing on another's trademark. Prior to approval of your trademark, the federal or state authority will run extensive searches to determine if there are other businesses using a confusingly similar trademark for similar goods or services. The state and federal authorities only issue a trademark once they are satisfied that there are no other confusingly similar trademarks associated with similar goods or services and a publication period has expired (a period when the public may comment or objection to a proposed registration). Thus, the likelihood of facing a trademark infringement claim lessens once the trademark has passed the rigors of trademark certification. It must be noted though, the registration of a trademark cannot be considered a guarantee of non-infringement as registration does not automatically prevent third parties from being able to challenge a registered mark. For example, another party may have its own common law rights to a trademark, and those rights are not lost just because you or the state or federal authorities were not aware of them during the registration process.

Third, obtaining trademark registration decreases the likelihood that someone else will infringe on your trademark. This is because your trademark is listed on publicly reviewable federal or state registries, as applicable, which puts others on notice of your trademark. Similarly, once your trademark is registered, anyone that attempts to register a confusingly similar mark can be summarily rejected by the trademark authorities, or by your own challenge, thereby providing further assurance that others will not infringe on your trademark.

Finally, and arguably most important, if you discover another person is using a confusingly similar trademark for similar goods or services after registration of your trademark, both state and federal trademark laws provide a statutory cause of action and damages for infringement. In that litigation, you will also enjoy a presumption that your trademark is valid and that you have the exclusive right to use the trademark.

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Of course, there is a tradeoff for these added protections. Filing and registering a trademark is not without some expense (investigation costs to determine if comparable marks have been applied for, registered or exist under common law, plus applicable filing fees and legal fees). Also, there is always the risk that the trademark authorities will reject the trademark as too similar to an existing trademark. However, most clients find the costs pale in comparison to the potential benefits of registration. The last thing a client wants is to spend significant time and effort developing and marketing a unique name or design only to later learn that the mark is not so unique after all. Unfortunately, more often than not this is first discovered when the client receives a cease and desist demand letter or a lawsuit filing, both of which typically involve the prospect of an injunction preventing use of the trademark and liability for monetary damages.

These are but a few of the benefits to registering a trademark and is not meant to be all inclusive. Please also note that each trademark carries with it unique issues related to registration, and therefore, we suggest that you consult an attorney experienced with trademark registration for further information and guidance related to your specific trademark.

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