

## **7 Reasons to Register Your Trademarks - Now by Milord Keshishian**

Bruce Springsteen may be known as "The Boss," but he is not The Boss when it comes to controlling his trademark as a domain name. The famous rock 'n' roll singer lost his www.brucespringsteen.com domain name arbitration dispute to a notorious cyber squatter partly because he had never registered his name as a trademark with the United States Patent and Trademark Office ("USPTO").

If it can happen to Springsteen, it can happen to you. Here are seven reasons why you should become and remain The Boss of your trademarks by filing for federal registration.

(1) Valuable Asset. In today's Internet economy, trademarks are a valuable asset for companies of any size and federally registering your trademarks with the United States Patent and Trademark Office ("USPTO") grants you valuable national rights to the trademarks. Coca-Cola® is consistently ranked as one of the world's most valuable trademarks with annual revenue generating capacity in the billions of dollars.

(2) Nationwide Priority. By registering your trademarks federally, you preserve the right to expand your business into geographic regions of the country where you have not previously conducted business. If you do not have a federal registration and you have only used your trademark in, for example, California and Nevada, another person that later files an application for registration of the same trademark -- even after you had started use thereof -- can prevent your use of the trademark in any other states other than California and Nevada.

(3) Tool Against Cyber Squatters. If a cyber squatter is infringing on your trademark by registering it as a domain name, federal registration of your trademark is one of the elements considered in legal proceedings to determine the rightful owner of the domain name. In addition, federal registration allows a hold to be placed on the domain name until the ownership dispute is determined through arbitration or by a court, thus preventing the erosion of the goodwill and value in your trademarks. In a matter handled by our office, because our client held federal trademark registrations, we were able to force a cyber squatter to relinquish an infringing domain name without incurring litigation expenses.

(4) Advantages in Court. Having a federally registered trademark provides the advantage of a legal presumption that you are the owner of the trademark, that the trademark is valid, and that you have the exclusive right to use the trademark nationally. The federal registration certificate provides a "stamp of approval" in the mind of a judge or jury that you are the rightful owner of the trademark. Furthermore, a federal registration provides the right to sue in federal court assuring oversight by judges that are more familiar with trademark matters than those in the state courts

## **How to Register a Trademark by Mikki Barry**

So, you've just come up with a snappy product name and you've decided you want to trademark it. What should you do next? Is it really as easy as the website at the US Patent and Trademark Office says it is? Can I really do it without a trademark lawyer? These and other questions will be answered in this article.

Once you come up with your product name, you must first find out whether or not that name is already being used for the type of product or service that you wish to use it for. You can do this by doing a web search for the name, searching it through the US Patent and Trademark Office website to see if it's been registered or applied for, or by contracting with a special search company who also check through telephone listings, company names, and has further resources available than either of the previous options. If it's already being used, you will likely have to consult a trademark attorney to find out whether or not your use is different enough from the one already in use, to justify spending your money on trying to promote a name that is going to have to be changed later.

Let's say you can't find any other uses of the name out there. Does this mean you are home free? Well, not quite. If the name you have chosen is merely "descriptive" of the product, such as "Red Rubber Ball" for a rubber ball toy, or "Meaty Dog Food" for a dog food made of meat, it might be great for the consumer, but it is not necessarily a name that the US Patent and Trademark Office will accept as a trademark. A name that is "merely descriptive" is not going to pass muster, and will not be awarded a registration. There are other categories of name that are also not registrable, however they are a bit more complicated, and you really should consult a trademark attorney regarding how best to proceed in those cases.

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If your product or service name is not already being used, and is not descriptive, what then? Well, at that point you have a number of choices. You can begin using the name, spending the necessary money to promote it, print it on labels, etc., relying on your "common law" trademark rights, or, if you are only going to be using the name locally you COULD go after a state trademark (check with your particular state for details), or you could then proceed with national trademark registration.

Your "common law" trademark rights are good, and you CAN sue someone for infringement if they were to copy your name for a similar product, but the court battle would be a lot more difficult than if you had a national registration. A state registration is pretty good, but what happens when you border another state, and the guy just over the way starts using your product name for a similar product? It's rather difficult to limit your "territory" in the days of the Internet and easy transportation. Again, a national trademark would definitely make your life easier. (Please note that you can also register your mark internationally once your company grows to the extent that you are trading overseas. I positively recommend a qualified trademark attorney for international registrations.)

If you decide to go for a national mark, and wish to try to apply on your own, you can go to the US Patent and Trademark Office website at [www.uspto.gov](http://www.uspto.gov) and go through the entire application online. In some cases, where the name is very distinctive, and the product is easy to describe and fits neatly into one of the classes for trademarks that you can find on the website, and you can easily send a "specimen" showing that the name is in use in the way you say it is in use, your registration may go through without a hitch and you would receive a registration in approximately 18 months. Then, in most cases, you would be protected against anyone in the United States using your product or service name on a similar product.

Unfortunately, it is not always the case that your application for trademark registration goes through quite this easily. Oftentimes, you will receive what is called an "Office Action" from a Trademark Examiner in the US Patent and Trademark Office asking you to clarify something, rewrite your statement of use, submit a different sample, or asking for more information. Or, your name may be "published for opposition" (a required step in the process) and someone who you didn't find in previous searches turns up to "oppose" your registration. These are cases where you will most likely need the services of a qualified trademark attorney to assist you.

Once you have submitted your application, an attorney can help you with many of the changes that might have to be made to achieve registration status. However, there are mine fields and pitfalls associated here as well. It is entirely possible that you may have made a "fatal error" in the application, and it must all be started over again. If you don't find this out until your first office action, you may have wasted six months or more of time, AND your entire filing fee, just to have to start over again with a lawyer's help. If the problems come up at the time of publication for opposition, this is the point where you're almost entirely through the process. Starting over at this point would likely cost at least a year's worth of effort.

In summary, your product name can be protected either by common law trademark, state trademark, or national trademark. Both common law trademarks and state trademark registrations have serious limitations, but are available. For national registrations via the US Patent and Trademark Office, you CAN do them yourself, but be aware of the pitfalls and possible difficulties involved. Otherwise, consulting a qualified trademark attorney will likely save you significant time, and will probably save you money in the long run.