

A Bit about Trademarks

08.29.13 | Linda J. Rosenthal, JD



Many clients ask me about whether or not they need to register their business name or newest product name as a trademark with the United States Patent and Trademark Office (USPTO).

Well, as is true with so many things *legal* – it depends.

In the United States, common law trademark rights arise on the first use of that mark within a product category/class or geographic market.

That means that if you go ahead and incorporate using the name you love, and/or sell a product with that great, unique and catchy name you came up with in the middle of the night – you start off with presumed rights to that mark.

It's sometimes a good idea to get your trademark registered with the USPTO, however, because common law rights are limited to the geographic location in which the mark is used.

Also – having a registered mark will help you in case someone challenges your use of what they see as THEIR mark.

Note: Remember to protect your trademark by using the designation “TM” after it; you will use an “R” in a circle after the mark is registered.

But suppose you decided not to register your mark and depend on the common law protections only... what if it turns out that unique and catchy name for your product – or, heaven forbid, your business name – turns out to be the intellectual property of someone else? Even your direct competitor??

That's when things can get dicey.

So when is the best time to consider registering your mark? Well, depends on how much you value your name/brand and how unique you believe it truly is.

If your business name describes you perfectly and you plan on using it on EVERYTHING you produce, then you likely value your mark a great deal. If that's the case – then the right time to conduct a search and consider registration is BEFORE YOU START.

So the next question I usually get is how important I believe a trademark search actually is... My response is that choosing not to conduct a search is, in reality, a gamble you could win or you could lose. If you lose the gamble, it could be a critical blow to the success of your entire enterprise.

Is that a gamble you're willing take? If so – then stick with the common law protections.

Consulting with an attorney and having them conduct a preliminary search and to register your mark probably isn't as expensive as you might think... and it's most definitely less expensive than having to cease production and retool the manufacturing of an infringing product name or to re-create a new business filing, reorder all your stationery, business cards and marketing materials because of an infringing mark.

The final question I typically get is, "Can I just register this mark myself?" The answer to that is yes, you can. There are many resources out there to assist you in doing some form of search and to file for registration with the USPTO.

However (and I know this seems self serving) it is nearly always better to hire an attorney to handle your trademarks and other intellectual property.

Why?

A recent University of North Carolina School of Law [study](#), released in April, analyzed 25 years' worth of USPTO data. In it, the writers shows that applicants who retained an attorney were 50 percent more likely to get their trademarks approved than were those who applied without legal representation.

Something to ponder.