Top 10 Useful Trademark Tips

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In my years advising clients on trademarks, there continue to be a number of recurring questions or issues that I'm consulted about on a regular basis. Here is a summary of ten of the more common ones and the corresponding trademark tips you can act on.

Is there a difference between a company name and a brand/trademark?

Not all trademarks are company names and not all company names are trademarks. A lot of our startup clients are concerned with whether the name they want for their company is available in a particular state like Delaware when they first form their LLC or c-corporation. If the name is different by one character from another registered company name, it is technically available as an entity name. However, this is not the same as assessing whether that desired company name is also available in association with their products or services – for use as a brand/trademark. The best course of action to assess the availability of a trademark is to perform a trademark clearance search. It may turn out that a "company" name available in Delaware is not actually a name that can readily be utilized as a brand/trademark in association with the goods or services the company plans to provide. For example, Uber® is a registered trademark used in association with rideshare services, but the company name is Uber Technologies, Inc. If someone were to form a new LLC in Delaware, according to the State of Delaware they could call it Uber Rideshare, Inc. because that is at least one character different from Uber Technologies, Inc. However, clearly, there would be a trademark infringement issue assuming the new entity Uber Rideshare, Inc. provided rideshare services, which would be in violation of the registered trademark Uber® for rideshare services. This scenario happens more often than it should.

What is a trademark vs. a copyright or a patent?

A trademark relates to a brand, like Apple® for computers and electronics. Trademarks can be words or phrases or logos, or a combination of these elements in a composite mark, and occasionally can be a specific color, unique sound, or sometimes even a non-functional product design. Trademark rights cannot be acquired for items such as book titles or for complete sentences, which are protected by copyrights. Trademark rights also cannot be acquired for inventions, those are protected by patents (utility or design). The trademark is most recognizable as the brand that a customer identifies as the source of a particular product or service.

When can I file to protect my trademark in the United States?

Applications for trademark registration can be filed well before the trademark is used in commerce as an intent-to-use application. If the runway for use of the mark in commerce is a few months to as long as 2 or 3 years, then now is the time to research trademark availability and file an intent-to-use application. It takes at least 9-12 months after filing before you know if it might be registrable, and over 1 year before a certificate of registration is issued. That said, if you

already have sales in interstate commerce of a product or service in association with your trademark, then you should consider filing an in-use trademark application for registration.

Who should own the rights to a trademark?

Trademarks must be owned by the entity that controls the use of the trademark. If a company founder filed a trademark application registration in their own name before forming their company, either trademark rights and an associated application or registration for trademark must be assigned to the company, or alternatively, a license must be put in place granting rights to the company to use the trademark along with the goodwill of the business. If a company changes its name, converts from an LLC to a c-corporation, or takes similar action, an assignment may be required, and it should be recorded with the Trademark Office. If an asset purchase, merger, or other acquisition has occurred, the trademarks must be assigned. In summary, whenever ownership or entity status changes for any reason, it is a good idea to consult a trademark attorney about how to ensure the trademarks are appropriately assigned, managed, and recorded as needed.

Is there a process for providing public notice of ownership of a trademark registration?

Trademark assignment documents should be recorded with the Trademark Office. Trademarks are best assigned in a specific way using specific language that involves the goodwill of the business. If a company changes its name or participates in an acquisition, be sure to always have a separate stand-alone trademark assignment document signed by both parties that assigns the trademarks along with the goodwill of the company, because the document assigning the trademark becomes publicly available and most companies do not want the full asset purchase agreement or other similar documents to be public. An executed trademark assignment properly recorded with the USPTO establishes a clear chain of title and enables the public to search and recognize the current trademark owner, which helps in situations such as times when trademark rights need to be enforced against an infringer.

When do I use the ® versus the TM?

Trademark usage and symbols matter. Whenever you have a trademark, you should at a minimum always use the “TM” next to it (as a superscript or subscript) and you should use the mark as an adjective, not a noun or a verb, if it is being used in a sentence. If it is being used by itself, such as at the top of a webpage or on the packaging, that is a great place to position the mark and use the proper symbol. If you have obtained a registration for the mark, you may switch from the “TM” to the ® symbol shown next to the mark. It is okay to use a TM even when the mark is registered (it is not best practice, but it should not negatively impact your rights). However, it is fraudulent to use the ® if it is not registered, which could result in total loss of trademark rights. Therefore, pay attention to which symbols are being used.

Do I need to do a trademark clearance search before starting to use a new trademark?

Trademark clearance searches are risk mitigation tools. Regardless of whether a company name is available in Delaware, or whether no one seems to have ever heard of your newly proposed trademark, whenever you have a new name that is customer facing it is best practice to have a trademark clearance search performed. That new name could be a new company name, or a product or service name. Most of the time, the clearance search will either identify major problems with taking on a name for a company that would expose you to trademark infringement scenarios, or the clearance search will identify a number of close but not quite the same marks owned by others that will inform you of potential risks, so you do not march forward completely blind. The potential risks can often be further assessed and quantified to better inform and guide the company’s decision on whether to move forward.

Is it better to file an intent-to-use application before using the mark, or wait until after use has begun?

Before dollars are invested in marketing new products or services with their desired trademark, filing an intent-to-use application provides an earlier priority date than what you would have if you wait until you have revenue from actual use in interstate commerce by selling the product or service. Time and again companies find they wish that they filed trademark applications just 6 months, 3 months, or even 1 month earlier, and if they had they would have been the party in a trademark dispute with senior user rights based on the earlier filing date, and would have prevailed in scenarios where a third party desires the same or similar trademark. "File early, file often" is a good mantra to follow when it comes to securing early priority, senior rights, and blocking competitors from getting ahead of you.

Is the application for a trademark registration publicly available for anyone to see?

Yes. One or two weeks after an application for trademark registration is filed in the United States Trademark Office, it becomes public. This is another form of risk mitigation because owners of existing trademark rights should have watch services that would alert them to new filings for similar marks to their own. This can draw out potential opposers to your desired trademark and lead to the receipt of a cease-and-desist letter from a third party claiming to have rights to the trademark. That may require you to stop altogether and change course with a different mark. However, it is better to know of such issues sooner rather than later. The alternative is staying in stealth mode, investing in a big marketing campaign and product launch, and then receiving a cease-and-desist letter requiring a total change of the trademark and rebranding (maybe even changing the company name as well). "File early, file often" continues to be the best strategy when it comes to trademarks.

Do I need a separate trademark registration for a word mark and a logo that uses the same words?

Trademark registrations must be obtained for every variation in logo or word. Once they are filed and eventually obtained, they provide evidence and a presumption of valid trademark rights across the United States and all its territories. This discourages other parties from using confusingly similar marks, even if they are on opposite ends of the country, thereby preventing problems before they begin. Registration also serves as the only basis for the Trademark Office to reject other applications for registration for confusingly similar marks (they won't refuse applications based on common law use by our client). And the applications for registration in the US can serve as priority for foreign registrations to prevent others from filing in foreign countries before our clients. Therefore, once again, "file early, file often" so that each meaningful variation in trademark configuration or even the goods and services associated with the mark accurately aligns with what is being used in commerce.

As you might imagine, there are many other questions and issues that arise in the effort to properly use and develop trademark rights. If you have further questions, please contact trademark attorney Sean Detweiler, head of the trademark practice group at Morse.