

10 Trademark Essentials

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1. When selecting a trademark, a search for same or similar names is necessary to avoid potential conflicts. To be protectable, a trademark must be distinctive. The results obtained from many third party search websites are out of date or inaccurate.
2. A clear drawing or rendition of the mark is required for TEAS applications.
3. The market, goods and services for a mark must be ascertained prior to registration. The TEAS application requires a list of goods and services for which a mark is being used and the corresponding International Class numbers that are applicable for the identified goods and services.
4. When filing a trademark application, the mark will need to be filed under a “basis,” either under the “use in commerce” basis (under §1(a) of the Trademark Act, 15 U.S.C. §1051(a)), or the “intent-to-use” basis (under §1(b) of the Act, 15 U.S.C. §1051(b)). In short, if the mark that is being registered is already being used in interstate commerce then it should be filed under the "use in commerce" basis.
5. Avoid infringement. Court's most often find infringement if there is the existence of likelihood of confusion with another mark. The likelihood of confusion is determined by the Court by weighing the following factors:
 - Intent of the second user.
 - Strength of the trademark allegedly being infringed.
 - Similarity between the two marks.
 - Whether or not there is direct competition.
 - The likelihood that the prior owner will expand into the second user's market.
 - The existence of actual confusion.
 - Whether or not the products are “like quality.”
 - The degree of care likely to be used by consumers.
6. Ensure proper use of the trademark. Trademarks are brands and should always be used as adjectives, not nouns or verbs.
7. Protect your mark. To maintain a strong mark, use the mark and use it correctly, monitor for potential infringement and take immediate action against infringers.

8. Before a trademark is registered, a “TM” may be placed next to them to show that they are being used as a trademark. Once the trademark is registered, a ® should be used whenever the trademark is being used for advertising or in commerce.

9. After five years of consecutive use, a trademark may be declared incontestable after a declaration of incontestability is filed. An incontestable mark is immune from challenge except if it has become the generic term for the goods or abandoned for nonuse, or if the registration was acquired under fraudulent conditions.

10. Consider using a lawyer from the start. It is almost always safer, more efficient and cost effective to use an experienced lawyer to properly register your trademark from the start.