

Guard your mark

How to choose strong trademarks and protect them

INTERVIEWED BY ADAM BURROUGHS

A trademark's value is wholly contingent on how well it conveys to the public who is behind a product or service. That's why it's critical for companies to ensure their trademarks are strong and protected. However, not all companies take the proper steps.

"The costliest mistake companies make when choosing a trademark is getting too far along in the process before evaluating whether or not it's a good and useable trademark, one that's capable of passing a clearance review with the U.S. Patent and Trademark Office (USPTO)," says Suzanne Bretz Blum, a partner at Brouse McDowell.

A second critical mistake is failing to protect a trademark once it's created, leaving it vulnerable for use by other companies, which may diminish its value or transfer the value built up to another company.

Smart Business spoke with Blum about how companies can ensure their trademarks are strong and the mark's value is protected.

What legal protections exist for trademarks?

Federal law provides protections for trademarks, including provisions for suing someone who is using a trademark registered to another company through the USPTO.

In addition to federal protections, most states have their own trademark registration systems. There are also common-law trademark protections that exist under states' unfair competition laws. These protect businesses from economic injury through deceptive or wrongful business practices, including the hijacking of a long-held but unregistered mark.

How do companies enforce trademark protections once they're secured?

It's the responsibility of companies to watch

SUZANNE BRETZ BLUM

Partner
Brouse McDowell LPA

(216) 830-6830
sblum@brouse.com



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the market for infringing uses of their trademark. Larger, international companies often pay for a service that monitors usage of their marks around the world and will alert the company to any potential infringers.

Companies with products that aren't distributed as broadly should keep an eye out where their goods are sold, as well as in local advertising, and chase infringers with cease-and-desist letters.

Another useful strategy for protecting your marks is to take advantage of programs like Amazon's brand registry program, through which companies can alert Amazon when they see other products on the site using an existing trademark. If the complaint is valid, Amazon will intervene and block the imposter from using the mark on the site.

What are the limitations of trademark protections?

Companies might not be able to stop others from using a trademark if it is not distinctive, or is too literal — for example, using an image of an apple to sell apples. An earlier user of a similar mark may also challenge a company's ability to protect its trademark.

There are 45 trademark classes that categorize marks by the type of goods and services represented. Two companies that have the same mark but are in completely different trademark classes have a good chance of registering and protecting them.

It becomes an issue when similar marks are used in the same marketplace and could cause confusion among consumers.

To evaluate your trademark's strength in such a situation, consider evidence of the first use of each mark, like early advertisements, brochures or dated photos of packaged products for sale. Consumer surveys that show public awareness of the link between a company and trademark, and evidence that the company has taken steps to prevent others from using the trademark, will help establish rights where challenged.

How can companies ensure they're on strong legal footing as they select a trademark?

It benefits companies seeking trademark protections to work with an attorney at multiple stages of the process. Experienced attorneys can conduct clearance reviews quickly and with a clear understanding of what to look for, which leads to a more reliable conclusion. They also understand what the courts are likely to say is confusing and can help companies strategize when it comes to the registration process.

Careful consideration in the early stages of developing a trademark is important. Once a company has invested in and is using a trademark, protecting the mark is critical. An experienced attorney can help ensure that companies continue to benefit from the value they've created in their mark. ●