

Your Most Valuable Business Assets Should Be Vigorously Protected

Related Professionals

Bobby Robinson
704.338.5328
BRobinson@nexsenpruet.com

Practices

Intellectual Property Law

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I'm not telling you anything you don't know but now more than ever, having clear and distinctive branding is so critical in such a hyper distracted marketplace. Your brand helps elevate your company above the noise and sets your company apart from your competitors. Your business name, logo, website, and marketing materials are therefore amongst your most valuable assets and should be vigorously protected – under various aspects of intellectual property law.

Specifically, with regard to trademarks, a trademark is one of the more popular IP tools because it helps protect your commercialized products and/or services and also puts other businesses on notice that you are asserting exclusive rights in the utilization of the brand. Although you may already have some common law rights because of the use of your brand in commerce, it is equally important that you consider taking it a step further and seek a federal trademark through the United States Patent and Trademark Office (USPTO), which gives you brand protection throughout all 50 states (and US territories), as well as the all-important right to sue infringers in federal court and receive special damages – if applicable.

Registering a trademark requires investments of both time and money, so you'll want to avoid some of the most common mistakes that I've seen—and we can learn from others who have already made them.

Below are five common trademark mistakes.

Infringing on Someone Else's Trademark

One of the first steps to registering a trademark is to perform a “trademark clearance search” to determine whether your proposed mark would infringe on the rights of a registered trademark owner. The last thing you need is to invest time and money into scaling a brand and then receive a cease and desist letter because it infringes on an existing mark. You can spare yourself a lot of issues down the road by performing a comprehensive search of existing trademarks and Nexsen Pruet can help with this.

If you move forward despite some potential conflicts, a lawsuit may be in your future. For example, New York's Coffee Culture Cafe landed itself in hot water with Starbucks over its drink called the "Freddoccino." Starbucks claimed the name is too close to one of its own drinks, "diluting the distinctive quality of Starbucks' famous Frappuccino® mark" and potentially causing confusion among consumers. So, a trademark clearance search and legal consultation would have been helpful to NY Coffee Culture Café to avoid this issue.

Trying to Trademark Generic Words

The strongest trademarks are "inherently distinctive," which makes them easiest to register with the USPTO and to defend in case of infringement. Related to this, note that even if you have invented a word to serve as your brand name, it still needs to be registered as a trademark in order to have the fullest protection under the law.

Trying to register a trademark using generic words will often result in a denial from the USPTO. Hotels.com, for instance, could not register its name as a trademark because "hotels" was ruled to be too generic even with dot com added.

Another "generic" concern is that some trademarks end up being so popular that they become "genericized" and lose protection when the trademark becomes synonymous with the general type of goods. Famous examples of these include aspirin, escalator, rollerblade, and thermos. That said, it's helpful to establish a brand name for your product or service that is inherently distinctive and not generic.

Assuming You Can Register Your Name as Your Brand

I get this question all the time and the response may surprise you. So, just because it's your name doesn't mean you automatically own it under trademark law. For example, Kylie Jenner's trademark battle illustrates how difficult it can be to receive protection of a mark that includes one's name.

In 2015, Kylie Jenner submitted an application to register "Kylie Jenner" as a trademark, and news outlets were eager to report that Kylie Minogue, a UK music artist, then filed a notice of opposition, claiming that Jenner's proposed trademark would "confuse audiences and dilute Minogue's brand," as it relates to her US trademarks.

Minogue later withdrew her opposition—no word on why—but the USPTO rejected Jenner's application anyway, finding it would be too similar to the already registered trademark, "Kylee," held by Mimo Clothing Corporation, because they would be in related categories (both include clothing and accessories) and would create a likelihood of confusion among consumers.

Jenner has since requested that the USPTO cancel the "Kylee" trademark, alleging its owner has not used it in commerce and has otherwise abandoned it. Which leads me to the next mistake.

Not Maintaining the Trademark

In order to maintain the trademark protections afforded to you as a registered owner, the owner must continue to use the mark in commerce or else risk losing the rights to it. The owner also has to keep up-to-date on when their registration needs to be renewed. Required maintenance documents must be filed between the fifth and sixth year

and between the ninth and tenth year after registration and then every 10 years thereafter. If you fail to maintain the registration or stop using the mark, the USPTO or your competition can seek to have the mark abandoned (hence, the Kylie Jenner move).

Neglecting to Enforce Your Trademark Protection

Once your trademark is registered with the USPTO, it's time to make sure all of that work wasn't for naught. What does that mean? It means you are the one ultimately responsible for making sure no one infringes upon your trademark rights. The USPTO's office will not do it for you.

Failing to monitor and protect your trademark can have serious consequences, including the value of your mark being diminished and a loss of trademark rights.

One of the best ways to monitor your trademark is to hire a trademark monitoring firm to keep an eye on this for you. Most of those services will check the USPTO's database when similar marks are being sought for registration and they'll also scan social media for brand names that may create a likelihood of confusion in the marketplace between your brand and that of a competitor.