
Why register and don't even think about it

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SPECIAL TO THE NEWS

Part Two of Three-Part Series

In the first installment of this series on Trademarks I defined what a Trademark was and the types of things that are able to be registered as a Trademark. Always keep in mind that, the ultimate goal for having a Trademark is to provide you, the business owner, with a specific name for your business, product or service so that the public identify you, your products or services greater than they know your competitor. For this installment I want to examine what is not considered a trademark and then begin to examine the process of registration.

Federal Trademark or Servicemark registration requires that the mark you are seeking to register must be used in connection with goods or services sold in interstate commerce. That does not require you to sell all over the U.S. in order to be granted registration. The fact that you can and might is sufficient. It is also possible to register a mark if you intend to use the mark in commerce at a later time period even though you might not be using it right now. During the registration process you will be requested to indicate if you are currently using the mark or you intend to use the mark. More importantly, when will Trademark and Servicemark registration be rejected?

Most often, certain marks seeking registration will not be granted due to their type and nature. Anything involving the name, portrait, or signature of a living person who has not given consent or the name, portrait, or signature of a deceased U.S. President, as long as the President is survived by a widow who has

not given consent, is not eligible for trademark protection.

Material that is "immoral, deceptive or scandalous", which is highly debated in our Courts, is not eligible for trademark protection. False suggestion or disparagement of anyone, living or deceased, or with institutions, beliefs, or national symbols with the consequence of deceiving the public is not eligible for trademark protection. Finally, anything similar to a trademark already registered or used and not abandoned, if its use is likely to deceive purchasers, or cause confusion or mistake is not eligible for registration.

Let's put all of this into practice. Think about a stroll down New York's famous 5th Avenue. If you have been there in the last few years you would have seen street vendors selling products with the names of Rolex, Cartier, Louis Vuitton, Coach, Prada, Gucci and Ferragamo.

The interesting thing is that these products being sold on the New York street corners are at 80% to 90% discount. Is it a coincidence that the corporate store up the block has the same merchandise for the true price? For those that believe the products are real, I have a bridge in Brooklyn to sell you. They are certainly not real but these knockoffs are products infringing on the trademarks of these famous companies. These products are counterfeit and considered contraband and by law should be confiscated.

Now that we are aware of what can be registered let's briefly examine registration. First, why register and where do you do it for the maximum protection? The overall reason to register your mark is to create protection and ultimately give you the right to stop others in a court of law from using the mark or anything



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similar.

Specifically, federal registration through the U.S. Patent and Trademark Office gives you a statutory remedy, the right to sue the offender in federal court and provides you the protection against registration by another for the same or any confusingly similar mark. Moreover, your registered mark becomes an asset of your business as it is part of your business intellectual property.

There is no bigger challenge or problem for you and your business to endure than having someone leverage off of your hard work and good reputation while competing against you using the names and marks that you have painstakingly created, built and continue to develop. Good business sense to register your intellectual property will save you costly litigation expenses defending it in the future. Stay tuned for the nuts and bolts of how to register and some stories on what non registration can bring.
