




U.S. TRADEMARK PROTECTION: A STEP-BY-STEP GUIDE

1. SELECTING A TRADEMARK

A trademark is a word (COCA-COLA®), a logo () or other designation (i.e., the shape of a Coca-Cola bottle) that functions to identify the source of a good or service. A strong trademark is an arbitrary or invented designation that has no connection to the goods/services it is used in connection with (i.e., XEROX® for copy machines, KLEENEX® for tissues, APPLE® for computers). A trademark that describes the goods/services it is used in connection with (i.e., APPLE for fruit) may be difficult or impossible to protect and enforce.

2. TRADEMARK CLEARANCE

Purpose: Identify marks owned by others that may conflict with your mark from an infringement or registration perspective.

Strategy: Search federal, state and common law trademarks. Look for marks that may be perceived as similar (not just identical). In making such determination, consider the commercial impression of the marks and whether the goods/services or manner of distribution/marketing are similar.

Also, consider the availability of domain names and social media handles for brand cohesion.

If you don't find any identical or similar marks, move to the point 3. If you find something identical or highly similar → consider a new mark or contact legal counsel to further evaluate risks.

3. APPLICATION FOR FEDERAL TRADEMARK REGISTRATION

File the application. Once the application is filed, the Trademark Office will examine the application and may provide feedback, including a refusal to register, or request additional information.

Filing strategy: you may file a federal trademark application if you are using or plan to use a trademark. The application is slightly different depending on the status of use of the mark.

Filing information:

- | | |
|---|--|
| <input type="checkbox"/> Trademark (e.g., word or design) | <input type="checkbox"/> Sample showing use of the trademark in connection with the applied-for goods/services** |
| <input type="checkbox"/> List of goods/services associated with trademark use | <input type="checkbox"/> Name of owner of the mark and, if a corporate entity, the state/country of formation |
| <input type="checkbox"/> Date of first use of mark anywhere and in commerce** | |

** - information not required if you are not using the mark upon filing; however, it will be required at a later point in the application process.

Foreign filing priority -- Within six months of filing a U.S. trademark application, the trademark owner is eligible to file a trademark application in a foreign country and obtain the same filing date of the U.S. application.

4. OTHER CONSIDERATIONS

Use of trademark – Generally, a failure to use a trademark will result in loss of trademark rights even if you have secured a federal trademark registration.

Maintenance -- A trademark owner must file paperwork demonstrating use of its trademark between the 5th/6th years and 9th/10th years following the registration date, and every ten years thereafter. If appropriate documents are not filed, the registration will lapse.

Enforcement – Regularly review internet, trade journals and other publications for others' unauthorized use of your trademark, and act when there is infringement. Failure to police improper third-party use of your mark could result in the loss of rights. >

DISCLAIMER: This paper provides background information of potential interest to facilitate and inform a reader's specific inquiry to be made with legal advisers of their choosing. It does not constitute legal advice. This paper is neither a guide nor an explanation of all relevant issues under consideration. Moreover, the law is ever evolving; observations made today may be inapplicable tomorrow. Fishman Stewart PLLC assumes no responsibility for any use of, or reliance on, this paper.