

THE NAME GAME: ABC'S of Trademarks

Are you wondering, so what's a trademark? A trademark can be any word, slogan, design, symbol, or even a color, smell, product configuration or a combination of these, used to identify the source of origin of particular goods and services. The trademark serves as a source identifier of your goods and services, to distinguish it from the goods and services of others. The name game is the process of selecting a trademark that best suits your product or service's qualities. A name can evoke the product is luxurious and world class or fun and trendy. For example, Opus One® has a registered trademark with the United States Patent and Trademark Office ("USPTO"). Their mark is used to distinguish their goods and services over other wineries. Opus One® conveys the image of world class. The winery chose this mark to distinguish its world class Opus One® cult wine from all others.

Remember the "Pants on the Ground" guy, General Larry Platt from American Idol? He applied for a trademark application for this trendy slogan with the USPTO. If this trademark ultimately gets issued, the registration provides it's owner, Larry Platt, the right to use the slogan "Pants on the Ground" in connection with specifically designated goods (apparel, including pants). Therefore, if the mark does ultimately issue, he will have federal rights to prevent others from using the mark in connection with the same or similar apparel goods he registered the mark with.

Why You Need to Conduct a Trademark Search and File an Application.

Say, you are ready to launch a new product, or you are about to start a new business and you have a great name you want to use. But can you? Here is a typical scenario: ABC wants to open a winery. ABC opens its doors (a physical wine tasting facility and an online store) ABC selects a spectacular name without, unfortunately, conducting a full trademark search. ABC starts promoting its name by investing in advertisements (print and online such as Google adwords). Months go by and ABC is doing quite well financially, it invested a lot money in advertising and marketing, its page ranking in Google went up for its desired terms (after spending a ton of money for search engine optimization marketing). Then one day, ABC receives a cease and desist letter from winery XYZ's attorney similar to this:

Winery XYZ is the owner of United States Federal Trademark Registration No. XXXXXXXX and other trademark registrations pertaining to this trademark. Winery XYZ uses this mark in the United States in conjunction with its goods and services, including wines and related beverages. Winery XYZ legally owns the trademark upon which your winery, online store, wines and related beverages are infringing.

Winery XYZ believes that you are intentionally trading on the goodwill of Winery XYZ by using a trademark that is confusingly similar to Winery XYZ's trademark and that your use of the trademark does, or is intended to confuse or mislead customers seeking Winery

XYZ's goods and services. This activity is actionable under federal law and causes you to be liable to Winery XYZ in every state in which you have made sales or done business. Your activities are unlawful and constitute unfair competition, intentional trademark infringement and dilution, false designation of origin and/or cybersquatting.

Federal Law provides numerous legal remedies for trademark infringement and dilution, including, but not limited to, preliminary and permanent injunctive relief, monetary damages, claim to a defendant's profits.

So now what? You think, I can't stop using the name I've been using all this time and spent so much money to promote. Think again. Although you may be able to fight or settle in order to prevent your name from being taken away, it typically takes time and a lot more money. This is the sad scenario many business owners face when they neglect to take into account intellectual property rights of others.

Rather than being a victim to bad business practices, the proper way to proceed is to obtain a full trademark search on each and every name you intend to use in connection with the goods and services your business is promoting. A competent trademark attorney will conduct the search and analyze the results to advise you whether or not you should use the name. If name appears to be clear, then it is advisable to proceed with your own application for a trademark in order to serve as a defense and to be used offensively against would be trademark infringers.

Upon issuance of your federally registered trademark, you have the following significant benefits:

- Nationwide constructive notice of trademark ownership
- Evidence of and a presumption of rightful ownership
- Federal court jurisdiction (should you have to sue to prevent infringement)
- Federal registration can be used to obtain foreign registrations
- The registration may also be filed with U.S. Customs Service to prevent importation of foreign goods that infringe on the trademark

Trademark Issues on the Internet

What about domain name disputes; use of trademarks in Google adwords advertising or banner advertisements; cybersquatting; how about parody or criticism websites like www.starbucked.com; trademark issues with pop up ads; etc. These are all issues that occur everyday online and are costing business owners millions. Each issue can be resolved in different ways, either by the use of cease and desist letters; negotiations and settlement; a traditional trademark infringement lawsuit in either federal or state court; an Anti-cybersquatting Consumer Protection Act (ACPA) lawsuit; or an Uniform Domain Name Dispute Resolution Policy (UDRP) proceeding.

*Carol Smith is a partner at **Hiaring + Smith, LLP** a full service intellectual property law firm located in San Rafael, California. Feel free to give her a call on any questions you might have.*

Carol L. Smith, Esq.
HIARING + SMITH, LLP
101 Lucas Valley Road, Suite 300
San Rafael, California 94903

t: 415 457 2040
f: 415 457 2822
email: carol@hiaringsmith.com
www.hiaringsmith.com