

TRADEMARKS: OFFENSE, DEFENSE & FAIRPLAY

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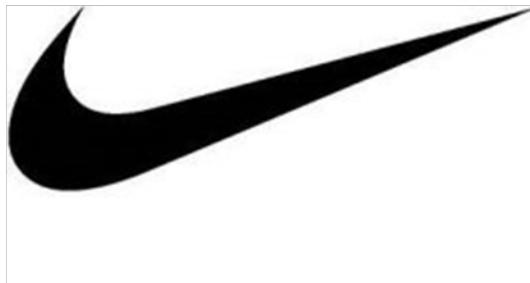
TRADEMARKS

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WHAT IS A TRADEMARK?

- A trademark is any word, name, symbol, device, slogan, package design, or combination that identifies a specific product and distinguishes it from others in the marketplace.



ASPECTS OF TRADEMARKS

- Distinguishing one company's products and services from others is increasingly difficult to achieve, but trademarks
 - help consumers “cut through the clutter”
 - capture the consumer's attention
- Trademarks can communicate a company's message across borders, cultures and languages
- Trademarks are important assets that can be perpetual in duration, grow in value and be bought and sold
- Trademarks can drive repeat business and higher traffic on websites and social media



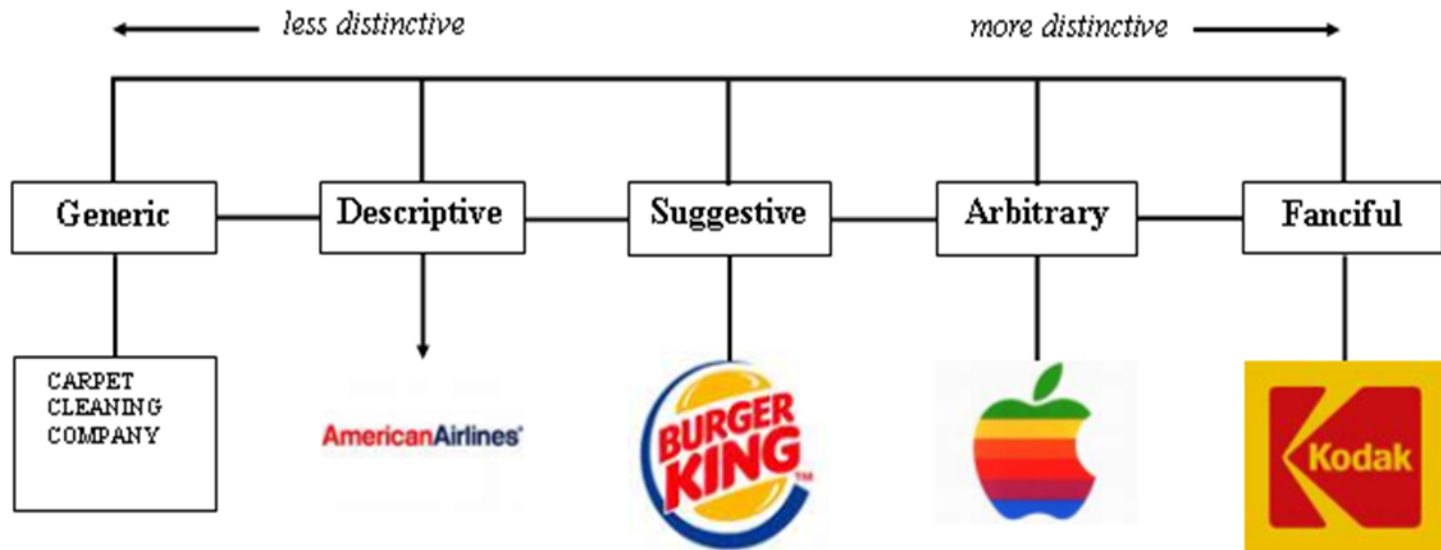
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TRADEMARK SELECTION

- Two common issues in trademark selection
 - ☐ Failing to properly clear a mark
 - ☐ Selecting a “weak” mark
- Less obvious issues in trademark selection
 - ☐ Mere ornamentation
 - ☐ Brand inconsistency

SPECTRUM OF DISTINCTIVENESS

- The more distinctive the mark, the stronger and more protectable the mark is.



REGISTER MAIN TRADEMARKS

- Types of U.S. Registration
 - Word Mark v. Logo
 - Intent to Use – can take up to three years after application is allowed to prove use
 - Use-Based Applications
- Focus on the main marks

DEFENSE: Enforcement

- Once obtained, trademarks must be protected and nurtured like any other property
- Proper use on all business documents, advertising, displays, packaging, labels, and correspondence is critical to survival
- Use the ®, TM and SM trademark notices as frequently as possible
- Make sure that only those customers, affiliates with a license to use the marks use them
- Monitor the marketplace
- Document situations of confusion

THE COURTS

- Direct infringement (e.g., Disrupting the marketplace and taking sales)
- Send cease and desist letter out very quickly
- Expensive and time consuming
- Document all costs, damages, expenses
- Especially useful when the conduct/activity must be stopped (e.g., competitor uses very similar trademark)
- Litigation serves as warnings for others

Other Options

- Maintain library of information on major platforms' terms and conditions and enforcement policies
- Google and Facebook have takedown procedures for trademark infringement and other IP infringement
- Uniform Domain Name Dispute Resolution Policy (UDRP)
 - In use for many years to protect brand owners from cybersquatting and infringement in legacy TLDs.
 - Generally decided within 30-60 day span,
- Anti-Cybersquatting Consumer Protection Act (ACPA)
 - U.S. law integrated into Lanham Act that provides avenue of relief in U.S. federal court for cybersquatting.
 - Can proceed in rem against foreign-registered domain names, so long as U.S.-based domain registration authority involved.
 - Relief similar to UDRP – cancellation or transfer.

FAIR PLAY

- Honor and make proper use of other parties' trademarks
- Conduct a clearance search before adopting a trademark
- Use the ® and TM notices to let competitors know that there are rights in the marks
- Know your marketplace

Conclusion – Protect your IP

- Create unique marks
- Register trademarks with the USPTO
- Use marks consistently and often
- Maintain records and examples of all advertising, press releases, and web sites that use your name, trademark or slogan
- Actively protect marks from infringement.
- Take quick action to deter or shut-down cybersquatting sites.
- Warn or prevent customers from reaching sites.