

THE FPT NEWS

"... useful information for clients and prospective clients."

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IS THE GOODWILL IN YOUR BUSINESS ADEQUATELY PROTECTED?

IS THE DOOR UNLOCKED?

Are your trademarks and service marks protected? Would you have any recourse if a competitor started using an identical or confusingly similar mark you've been using for years? If you are starting a business or product line, how can you be sure the mark you choose is not already taken?

Trademark law is a specialty, but if you have an attorney who knows the rules, it is easy to make sure your trademarks and service marks have the maximum protection. You do not want to invest time and money in building name recognition and a reputation for your products and services, only to have competitors freeload on the goodwill you've worked hard to develop. Even worse, what if you invested time, effort, and money in developing name recognition for a mark, only to find out that some other business had senior rights to that mark?

REGISTRATION IS EASY: STRONGER PROTECTION

Merely using a trademark or service mark in your business may give you some rights to the mark, as long as your mark is not confusingly similar to an existing mark already being used to describe similar products or services in the same market. By simply registering your mark with the United States Patent and Trademark Office will give you much greater protection. Federal registration is quick and easy, and will give you these benefits:

- The world will be on notice that you claim the mark

- Your registration will be prima facie evidence that you are entitled to the exclusive use of the mark as you've described it in your application
- No one will be entitled to claim they did not know about your use of the mark, eliminating the "innocent infringer" defense
- You will have access to the federal courts to protect your mark
- You will have the right to seek recovery of profits, damages, and costs in a federal infringement action, and you may even be entitled to treble damages and attorneys' fees in a willful infringement case
- Criminal penalties for counterfeiting are available
- You can file your mark with the U.S. Customs Service to prevent importation of counterfeit or infringing foreign goods
- After five years, your mark can become "incontestable" - it can be challenged only for fraud, abandonment, or "genericide"

USE YOUR MARK SAFELY

Are you using your mark in a way that will protect your rights? Many names that companies spent enormous sums to develop and promote have been lost to "genericide" - they have entered the public domain because they've become synonyms for the product, rather than distinctive brand names. For example, aspirin, escalator, raisin bran, and yo-yo were once trademarks, but have lost their distinctiveness and are no longer protectable as trademarks.

Other well-known brands are in danger of “genericide,” and their owners have mounted advertising campaigns to save them. For example, Band-Aid® changed its jingle to “I am stuck on Band-Aid® brand ‘cause Band-Aids® stuck on me.” Xerox® has also created a campaign to emphasize that Xerox® is a brand, and not another name for copier. We all hope our trademarks and service marks become household words, and some simple steps will help make sure we can reap the benefits when they do.

To protect your marks, follow these simple rules:

- Always use your marks the same way - display them in a similar style and position, and always use the TM, SM or ® designators to show the mark is a trademark or service mark. (Anyone is entitled to use TM or SM, with their mark, but only federally registered marks may be designated ®).
- Always use “brand” with the mark in your descriptive text when you describe the product or service, to make it clear that your mark is not just a name or descriptive term for the product or service.

DON'T ABANDON YOUR MARK

If a mark has gone unused in commerce for three years, it may be deemed abandoned, and another user can claim it. Make sure you don't lose your marks through neglect if you intend to use them in the future. An occasional ad, flyer, or display can keep the mark active at little cost.

ENSURE YOUR INVESTMENT AND REPUTATION ARE PROTECTED

Take a little time to consider whether the time, effort, and money you are investing in your business's name, reputation, and goodwill are adequately protected. It is quick and easy to register your trademarks and service marks, and to make sure you are using your marks in a way that will keep them yours. It's a small investment that's good insurance, and it will pay off handsomely in peace of mind.

Epilogue: When choosing the brand name of a new product, consider searching the internet for other uses of the word. You would not want to choose a brand name that carries unwanted baggage. Also, register a domain name (in various spellings of the product) to protect the brand name from being pirated or abused by the internet wizards.

- Aaron E. Albert

For more information or to learn about our law firm's services and experience, see our website at www.fpmtlaw.com or call telephone number (201) 569-5959 and ask to speak with one of our partners:

Arthur L. “Scott” Porter (aporter@fpmtlaw.com);
 Alan C. Thomas (athomas@fpmtlaw.com);
 Jay D. Fischer (jfischer@fpmtlaw.com).

Our Of Counsel can be reached as follows:

Howard Davis is Chair of Office of Environment Law (hdavis@fpmtlaw.com).
 Ronald V. DeCaprio (rdecaprio@optonline.net)
 Bart E. Eagle (eaglelaw@mindspring.com)
 Reena Forst (rforst@rflawfirm.com)
 Eddie Raynord Hadden (haddenlaw@aol.com)
 Peter H. Tilem (ptilem@fpmtlaw.com)

Our address in New Jersey is 440 Sylvan Avenue (Route 9W), Suite 130, Englewood Cliffs, NJ 07632-2701.

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