

Protect your brands

Registering and policing your trademarks **Interviewed by Leslie Stevens-Huffman**

Nothing sets a business apart from the competition like a stable of product or service names or logos. It is imperative to protect those trademarks by appropriate management and registration. In today's global market, businesses must lay a foundation for protection in every country of interest to their business. Starting this process early provides maximum security.

Careful trademark/brand management not only builds brand loyalty, but, when used effectively, trademarks can become their own entities, symbolic of the total consumer experience when purchasing a product or service. This phenomenon makes the trademark one of the most valuable forms of intellectual property.

"There are several trademark management best practices that will protect a company's investment in its brands," says Kathleen Pasulka-Brown, partner and co-leader of the Trademarks & Copyrights Practice Group at Procopio, Cory, Hargreaves & Savitch LLP. "They include: methodical brand-name selection, managed registration of all existing and prospective brand names and logos, and a carefully prepared trademark strategy with an ongoing review process that maintains the effectiveness of the brands. Mistakes in any of these areas can be costly in terms of monetary value as well as a reduction in brand value."

Smart Business spoke with Pasulka-Brown about how to register and protect your company's trademarks.

What is the impact of the length of the trademark registration process?

It has always taken more than a year to obtain a trademark registration. It is important to note that while a trademark can be used during the approval process, it can ultimately be declined, causing losses in marketing investment and any good will developed under the trademark. This, in turn, may translate into a costly endeavor of relabeling products and packaging. Initially, in the United States, trademark



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registration requests are scrutinized by an examining trademark attorney who checks to confirm whether the new mark is capable of trademark significance and whether a conflict exists between the new mark and any existing trademark applications or registered marks.

Why is the trademark selection process so important?

In the United States and many other countries, marks do not have to be identical and the goods or services do not have to be the same in order for the trademark examining attorney to find that a conflict exists. It may be enough that the marks are similar and the goods or services are related. To make certain a particular trademark is approved, a thorough search should be conducted before filing the application. However, because the confusion criteria are subjective, marketing departments may miss some of the nuances in this search. For this reason, it is preferable to have a trademark attorney perform and evaluate the search because

they have access to more comprehensive databases and will evaluate the choices on a different level, looking for nuances that may create a likelihood of confusion. Last, marketing departments should select several names. This will prevent them from becoming enamored with just one, in case the more prudent decision is to move forward with another selection. It is vital to request a search in each country of interest by an attorney if you are planning to use the brand during the approval process and in order to protect the investment in the application.

What are the other benefits of trademark registration?

Besides the enhanced marketing capabilities, benefits of registering a trademark in the United States include: notice to the public of the claim of ownership of the mark by the registrant, legal presumption of ownership by the registrant, increased rights in court, use of the symbol ® and the ability to obtain enforcement action by U.S. Customs. The benefits in other countries are similar.

How can CEOs maximize the value of the company trademarks?

In order to maintain the validity and enforceability of a trademark registration or the enforceability of a nonregistered trademark, owners must police their mark, meaning that if they become aware of an infringement — which happens when another party uses a similar mark — they must take appropriate action. Trademark owners should also protect their mark by obtaining a domain name that is the same as their trademark. Companies should also engage watch services that will assist in the policing process. The watch service results should be reviewed by trademark counsel, which is a good way to keep an eye on competitors. <<

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