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**SPECIAL
REPORT**

9 Things



You ABSOLUTELY MUST KNOW
before Filing for a Trademark

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9 Things

You ABSOLUTELY MUST KNOW before Filing for a Trademark

1 What is a trademark?

A trademark is a word, phrase, design, symbol or combination thereof that helps consumers identify where a product came from. In its best form, it is instantly recognizable and makes the viewer think about the person, product or company in a favorable light. For example, whether in the U.S. or abroad, the Golden Arches or the red Coke logo creates instant visions in your head.

A few good examples of Trademarks are:

- ❖ Apple (Brand of Computer)
- ❖ Toshiba (Brand of TV) \
- ❖ Wal-Mart (Brand of Retail Stores)
- ❖ Windows Logo (Brand of Software)
- ❖ Can't Beat The Real Thing (a classic slogan for Coca-Cola Brand Products)

The trademark is so important today that millions of dollars are spent by companies each year to promote and protect their marks. Once the mark is a success, it becomes an extremely valuable commodity that can be sold just like any other asset.

This is also an important lesson for new companies that, while trying to save money by not securing a trademark, wind up losing a valuable commodity that they could either use or sell someday for a large profit.

Many of us kick ourselves for not having the foresight to secure some very valuable domain names in the early days of the Internet. Some could have been purchased for a few dollars and sold for millions. While those opportunities are not easy today, people forget the real value of securing a trademark before someone else does. Ultimately, it could become more valuable than the business itself.

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2 How do I Trademark Something?

The trademark process begins with a comprehensive search. Some companies offer what they call a “direct hit” search, which is just a search of the Federal Trademark Register to see if anyone else is using the same name. Don’t waste your time or money, you won’t get the answer you need. You don’t just care whether someone is using the exact same name or mark, you want to know whether you should spend your hard-earned money promoting something if someone else can come along and take it from you. The only way you can even begin to know this is with a comprehensive search

Search engines do not have access, by law, to certain databases that contain information that is crucial to your trademark search.

A Comprehensive Common Law Search doesn’t just search trademarks that are registered, it searches thousands of databases of companies and services that operate throughout the entire United States to make sure that your mark or something similar is not in use by someone else.

If your mark, or a confusingly similar mark (think: Coca-Cola and Koka-Kola), is in use by someone else (even if you don’t know it) if the other person can prove prior use, they can, in many cases, stop you from using your mark. The scariest part is that you may even apply for Federal Registration of your Trademark and get approval from the Patent and Trademark Office, only to find out years later that you wasted your time and money and have to relinquish your claim to the mark. This is why you must do a comprehensive search.

A Comprehensive Common Law Search, although it cannot be guaranteed to uncover EVERYTHING, gives you the best chance of avoiding the costly mistake of starting a business and spending money to build your brand only to be forced to change your name several months or, worse yet, several years down the road.

While Google, Yahoo or another search engine is a good place to start doing research on your own, this is not to be confused with a Comprehensive Search. These search engines do not have access, by law, to certain databases that contain information that is crucial to your search.

After a comprehensive search, and you get an educated legal opinion on the search report, a Federal Trademark application will need to be filed. The current fee to apply for Federal Trademark Registration is \$325 per class. (For more on Trademark classes, see #8 below.)

*BEWARE: Some unscrupulous people may encourage you to skip the search and just file for a trademark to “test the water.” If you simply file for a trademark without conducting the Comprehensive Common Law Search and getting a thorough understanding of the result, you may not only waste your filing fee money, you may actually get the Trademark registered and still lose it after spending a great deal of time and money. The reason is because the Trademark office examiners are not responsible for checking to see if you have checked

the competition. Think about how much money you could waste promoting your trademark and building a brand. We can't think of anything more frustrating and expensive than building a brand for someone else when doing the comprehensive search could have prevented it.

3 Do I need a lawyer to apply for a Trademark?

No, BUT...

You don't need a lawyer, but you WANT a lawyer, and I will tell you why. It isn't what the fast-filing services do that will kill you, it is what they don't do. They sell a service that people want, and they promote cost savings. Unfortunately, they imply they are cheaper and this isn't even true. In most cases, you can hire a lawyer for about the same price and get a whole different level of service and guidance.

We believe in self-help law and even write books to promote it. Self-help is even better than just letting a filing service do your work for you because self-help means you have actually spent the time to understand why you

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are doing what you are doing. However, if you haven't spent the time or don't want to spend the time then you have to use someone that is willing to learn what you are trying to accomplish not just someone who is going to let you fill in the blanks and then they will file a form. There is

nothing worse than paying for something that you think will protect you (or make you money by building a valuable asset), only to find that by saving a few dollars you really lost what you were trying to protect.

While there is no absolute mandate that you hire a lawyer to file your trademark, the legal landscape of Trademarks can be extremely complex. What many people learn is that often you end up spending 10 times the amount to hire a lawyer to fix your mistakes than it would have cost you to hire a lawyer to file the trademark in the first place! Don't make this costly mistake, most reputable law firms invite potential clients to call in for a free consultation prior to hiring them. Take advantage of this.

4 Do I need to register my Trademark to stop others from using it?

As a general rule, in any geographic territory where you are not using your mark, if it is not federally registered, the mark is not protected. Federal registration allows you to expand your business at your own pace, and in the meantime your Trademark is protected nationwide.

In fact, if you do not Federally Register your Trademark, and you only use it in a limited geographic area, you may actually attempt to expand into a new area only to find that someone else in that area has already started using the Trademark and has locked you out of the market.

5 If I am protected by Common Law, why should I pay to register my Trademark?

There are many reasons that you would still want to register your mark, here is a list of just a few:

- ❖ If someone is later found to be infringing on your mark, Federal Registration makes it far easier to collect damages and attorneys fees from the infringer.
- ❖ Use of the ™ (the ™ symbol can be used as of the moment the federal application has been file) and ® (the ® symbol can be used as soon as the Federal Trademark Office has granted your registration) symbols to put the entire nation on constructive notice that you have applied for a trademark. Once you do this, no one else can choose the same trademark or a confusingly similar mark and claim that they “didn’t know” you had the mark. Once you start the application process, the general public has access to find out this information and cannot claim ignorance to the fact that they did not.
- ❖ When potential clients or infringers see a ™ or ® symbol next to your name or logo, they will know that you have taken the time and effort to protect your name, which is a further indication that you are an established business.
- ❖ Once the application has been filed, it is a matter of public record that you are the owner of the Trademark.
- ❖ Access to Federal Court instead of State Court. There are numerous advantages to being able to protect your mark and stop infringers in the Federal Court System
- ❖ You can prevent goods containing potentially infringing marks from being imported into the U.S.
- ❖ If you intend to take your product overseas, you



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can use your U.S. Trademark filing date to show priority in certain foreign countries and potentially get a head start over your competitors.

- ❖ If you keep your mark in continuous use, for five years after the registration date, you will be immune from certain infringement actions if a similar mark is later shown to have been in existence prior to your registration date.
- ❖ The right to expand your business nationally when you are ready. Common law rights are only granted in the geographical area that you have been using the mark in. Once you obtain federal registration, it doesn't matter if you have been using your mark in two states or 40 states, even in the territories that you have not yet used your mark, you are still protected!

You can start using your trademark immediately along with the TM symbol once we file your application.

6 Federal vs. State Trademarks

The Internet has changed the business landscape forever. No longer do you want to think in terms of limiting your business to your city or state. Now, everything is national and, in some cases, international. Since the expense of federal trademark registration isn't much more than a state filing, there is simply no reason not to get the greater protection.

7 How long does it take to get a trademark?

The good news is that you can start using your trademark immediately along with the TM symbol once we file your application. The actual Trademark registration process typically takes around 18 months from the date that the application is filed until registration is issued. It is important to note that in most cases you will be protected from the date of filing, NOT the date of registration. So, even though the registration process takes some time, getting started is the most important part!

8 What is a Trademark class?

In order to allow fair competition, the United States Patent and Trademark Office divides Trademarks and Servicemarks into 45 classes. This is important and people who use one of the quick online trademark filing

companies frequently miss this. To get the protection you want, you must file your trademark in the right class and frequently multiple classes to get the protection you desire. For example, let's say you wanted to get a trademark for a beverage called XYZ. You file the mark in the beverage class. Good move. But what if you had big plans to produce clothing that carried your name as well. Then you should also have filed under the class for clothing or someone could come along and see that you are only in the beverage class and start using the word XYZ on clothing. Now, you are at risk of not being able to go into the clothing business with your own original Trademark! This means that in order to gain federal registration in multiple subject areas, you would file for registration in multiple classes.

9 What is the difference between the ™ and the ® symbol?

The ™ symbol can be used from the moment the application is filed and puts the general public on notice that you are attempting to register your mark.

The ® symbol can be used from the moment the application is actually approved and registered on the Federal Register.



If you are not talking with an Attorney regarding your trademark rights, you might not be protecting ALL of your rights. Get a legal opinion for the same price as you would normally pay for just a search!

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