

Trademark Registration

More to it than meets the eye

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HIS ARTICLE WILL be the first of three covering trademarks, copyrights and patents. The decision as to

whether to register each is based upon unique business considerations. For trademark registration, there is a process to go through in evaluating the cost and benefit of federal registration of your trademark.

The first step in registering a trademark should be a trademark search. A high-quality search of all public record uses of the name costs around \$500. This search would ideally include domain name registrations, corporate name state registrations, fictitious name registrations, local business license registrations and state and federal trademark registrations. Your lawyer then should go through the results and identify what potential issues exist. The cost of this process varies widely. If your mark is “clean,” with no apparent potential conflicts with other companies selling similar products or services, then it is inexpensive. If you have a mark that could be infringing on another trademark, either a registered or a common law mark, then your lawyer should evaluate the strength of the claim.


Many small businesses skip this investigatory step and go straight to filing for trademark registration. If no one objects, and the mark seems to be “clear” in the judgment of the examiner, then your trademark registration will likely be permitted. If not, then you will either have to litigate the matter (prosecution), have your lawyer attempt to convince the examiner of the merits of your registration or abandon your application. If you go through a search, you know in advance what issues you have, and you can decide whether to proceed with an application for registration. You can also identify potential infringers and proceed against them, or even decide to change your trade name to avoid being the target of a trademark infringement claim. If you are investing heavily in building an online presence and have optimized your name to the point that it has a valuable Google ranking and history, you can’t afford to lose your domain name. Get clearance of that name before investing in it. Protecting your trademark asset or protecting your business by recognizing problems with your trademark are often involved decisions that depend upon the strength of your mark, capabilities and practices of a company that may have a conflicting mark and other business and legal considerations.

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The benefits of trademark registration for the small or mid-size online business should be considered. A registration mark is much more impressive to a recipient of a cease-and-desist letter. Litigation, for the small online company, is often not feasible, so the ability to bring a lawsuit and claim certain enhanced damages is probably of secondary importance to you. The cost of litigating and proving a trademark infringement can easily surpass six figures. By owning a registered trademark you can convince search engines to remove infringing sites. You can still win domain name disputes, however, by proving common law rights in the name. Without getting into a detailed discussion, if your business or product name is either inherently distinctive or has acquired a secondary meaning in the marketplace by which your product is identified, then you probably have a common-law trademark.

Keep in mind that a registration filing will put the world on notice of your use since most large companies monitor all filings that could arguably conflict with its trademarks. Are you “telling on yourself” and inviting trouble? These factors should be considered before filing a trademark application. Like most things in the online world, the formal process of protecting your trademark is a double-edged sword. 

The information in this article is not intended to be legal advice. Always consult your attorney when faced with legal issues.

PREVIOUS ARTICLES



JUNE 2006
“Privacy Policies”

JULY 2006
“Web User Agreements”