



Technology & Intellectual Property

Legal Trends

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Trademark Registration

By Kevin Oliveira

The ease of national marketing via the Internet has increased the potential for trademark conflicts in marketing your business, products and services. Where filing federal trademark applications was once passed off as a source of cumbersome paperwork and unnecessary legal fees for most small, regional businesses, the changing marketplace and the desire of smart business people to protect this valuable aspect of their businesses has convinced many that the benefits outweigh the costs.

Benefits

Generally, trademark rights in the United States vest when any person or entity first makes use of the mark. There is no law that mandates the federal registration of a trademark, however proactive registration often reduces the cost and inconvenience caused by a trademark challenge. Likewise, registration simplifies a business' ability to protect its trademark against would-be infringers and can save significant time and money if another person or entity tries to adopt the same mark.

Before a trademark is formally registered, the owner has "common law" rights to it as long as the owner is the first to use the mark in commerce. However, common law trademark rights are limited in geographic and market scope.

Federal registration provides a number of significant additional benefits including:

- Evidence of and a presumption of ownership
- National and constructive notice of trademark ownership
- Federal court jurisdiction legal enforcement.

The most important benefit of registering a mark is that any other person or entity who later begins to use the same or a confusingly similar trademark may be presumed by the courts to be a "willful infringer" and therefore liable for damages.

In addition, registration provides notice to any person or entity seeking to adopt the same or similar mark that the registered mark is in use. Registration also signifies that the owner of the mark clearly desires its right to exclusive, nationwide use of the mark to be unrestricted.

Upon securing a registration for a mark, the owner can ensure that even prior localized users of the mark are geographically restricted in their use of that mark and confusingly similar marks. Likewise, the unregistered company's abilities to expand the scope of goods and services that they offer in conjunction with the trademark are "frozen" as of the date of the owner's registration.

Process

Although each trademark application is unique, the process typically involves the following:

- Attorney and client consultation regarding the selection of a mark and the description of goods or services;
- Attorney preparation of a trademark application for the client's review and signature;

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Intellectual Property Audits

By Jonathan Frieden

A company's intellectual property, its trade secrets, patents, trademarks and copyrights, are often among its most valuable assets. However, companies often lose sight of this value as they focus time, energy and financial resources on the creation and protection of tangible property.

The failure to implement a considered approach to the development, protection, and enforcement of intellectual property rights can cost a company tens or hundred of thousands of dollars in lost business and litigation expenses. The most direct harm often comes from a company's ignoring, or misusing, such property.

The intellectual property audit is designed to assist a company in evaluating its intellectual property and developing procedures and policies for handling such property. Particular emphasis is given to:

- Identifying specific property which will benefit from trade secret, patent, trademark or copyright protection;
- Developing strategies to protect the company from losing its rights to use valuable intellectual property;
- Identifying opportunities (through licensing or otherwise) to increase revenues derived from, or add value to, existing intellectual property;
- Eliminating unnecessary costs associated with unused intellectual property; and

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- Filing of the trademark application and supporting documents with the United States Patent and Trademark Office (USPTO);
- Attorney preparation of responses to an Examiner's Amendment or Office Actions that are made by the USPTO (along with other administrative and supporting filings to ripen the application to registration);
- Attorney docketing and calendaring of the registration in a computerized database and will provide reminders for necessary renewals and maintenance to ensure that the rights afforded by the registration do not lapse.

In the current marketplace, dominated by Web-based marketing that instantaneously reaches a national and sometimes international audience, businesses that could reasonably justify a prior practice of protecting a mark in a limited geographical area may now provide for broader geographical protections. Federal trademark registration provides an opportunity to reduce a company's risk and increase their insurance against competitor's infringements.

Kevin Oliveira is a principal with Odin, Feldman & Pittleman in Fairfax, Va. He represents private and publicly held companies and individuals in a wide range of transactions including international and domestic marketing and distribution agreements, franchising, mergers and acquisitions, strategic alliances and joint ventures. He also represents technology companies and institutions who need assistance with highly regulated industries including franchise operations and serves clients on a range of intellectual property issues. He can be contacted at 703-218-2138 or Kevin.Oliveira@ofplaw.com.

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- Identifying strategies to reduce potential liability and legal exposure associated with the misuse of intellectual property belonging to a third party.

Jonathan Frieden is a litigator and principal with Odin, Feldman & Pittleman in Fairfax, Va. His clients include online retailers, telecommunications companies, engineering and consulting firms, software developers, trade associations, and construction companies.

Mr. Frieden's diverse practice encompasses intellectual property litigation, the defense of corporations against federal and state consumer claims, representation of management in employment discrimination claims, the resolution of commercial contract disputes and other complex commercial matters. Last year, Mr. Frieden led a team of lawyers representing an online retailer in its multi-million dollar acquisition by a publicly-traded company.

For additional information on intellectual property audits, please contact him at (703) 218-2125 or Jonathan.Frieden@ofplaw.com.

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