



## Sole Practitioner/ Small Firm Section News

A Notice from the Atlanta Bar Association



### TIPS TO HELP YOUR CLIENTS AVOID TRADEMARK DISPUTES

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With our modern technologies, the days of two distant businesses with similar names operating unaware of each other are long gone. Since search engines have become the dominant information and advertising source, long existing competitors with similar names are discovering each other. Because of this reality, businesses, and the names of their products and services, are often an object of contention, resulting in increased instances of trademark disputes. Here are four ways to help your clients avoid trademark disputes.

#### **Pick a strong mark**

Not all trademarks are created equal. They range from strong to weak, with the majority being somewhere in the middle. Your client's goal should be to create a strong trademark. "Fanciful" or "coined" words - such as "Google" and "Kodak" -- carry the strongest protection. Next are arbitrary marks which garner less protection. These are marks that use a common word for an unrelated product or service, such as "Camel" for cigarettes and "Grey Goose" for vodka. The weakest marks are suggestive ones. These marks merely imply or suggest a quality or characteristic of the goods or services. Examples are "Jaguar" for cars and "Coppertone" for sun tan lotion.

#### **Trademark Clearance**

Before choosing a trademark, your client should have a trademark clearance search completed to determine the availability of the mark. In most cases it will be unreasonable for the client to rely solely on the search done by the USPTO since the USPTO does not, as a matter of course, research marks that are in use but not included in its database. A clearance search can help identify senior users of the mark that the USPTO might miss.

**File Trademark Registration** A federal registration of a strong and cleared mark is a formidable foe. Federal registration affords your client nationwide notice and evidence of ownership of the mark. It also allows federal court jurisdiction of infringement suits and a basis for foreign filings. Further protection includes the possible assistance of the U.S. Customs Service to prevent importation of infringing goods into the United States. Furthermore, a registered mark becomes incontestable after five years, making it significantly more difficult for your client's mark to be challenged.

#### **Intent To Use Applications**

An applicant with a bona fide intent-to-use a trademark in the near future (i.e., six to twenty-four months) can file a registration application. However, before the mark will register, it must be used in commerce. What this will do is stake your client's claim to the name, although a filing based on intent-to-use does not trump marks already on file or marks already in use, which have not been applied for.

Following these four steps will decrease the chances your client has a trademark dispute, which will save them time, money and resources.

David M. Lilenfeld a founding partner of Manning Lilenfeld LLP, represents clients in trademark, copyright, unfair competition and software litigation, throughout the United States. He also represents clients in opposition and cancellations proceedings before the United States Trademark Trial and Appeal Board.