

# Brand Protection Guide 2018

## Brand Protection Is A Process.

As trademark lawyers, we noticed that lots of brand owners make an avoidable and potentially costly mistake: they believe that brand protection begins and ends with filing for a trademark registration. Brand protection includes a trademark registration, but it goes far beyond trademark registration and getting brand protection right is essential to real business growth.

**That's the purpose of this guide: to help you understand the process of brand protection and how brand protection can help you grow your business. It is also a high-level overview of the trademark process and gives you the basics you need to be a successful trademark owner.**

Brand protection is a process, and while trademark registration is a big part of that process, it is only 1 step out of 3 that should be taken to create real brand value for business owners. [There are three parts of the brand protection process: choosing the right trademark, registering your trademark and enforcing your trademark.](#) The world's best-run brands do all three of these things diligently.

Since your brand will very likely become your business' single most valuable asset, it makes sense to understand the process of brand protection. And the rewards of proper brand protection can grow your bottom line through new revenue opportunities through revenue, marketing and customer goodwill.

All of this translates into concrete and sustainable business growth.

## How To Use This Guide

This guide is for anyone trying to build a brand. The idea is to guide you - the business owner - through the process of brand protection and the issues that you should consider when building a brand.

All of the content in this guide relies on the foundation of trademark law, which is the area of law that helps businesses protect brands. Some of it will be very clear on first reading, and other parts might take some more time to digest.

**The guide itself is divided into three major sections: selecting and clearing your trademark, registering and maintaining a trademark, and enforcing your trademark.** You can read the guide straight through or you can focus on the section that is most useful to you and your business.

Throughout the guide, there are links to articles, checklists and other tools that are designed to help you understand all the concepts that you need to know to establish, grow, and protect your brand. Exploring them will help you to gain better insight into this material.

Finally, if you still have questions around trademarks and branding, you can always schedule a call with one of our attorneys. The first call is absolutely free - our goal is to help as many business owners as possible learn to use trademark law to their advantage.

**Schedule a call here:**

<https://counselforcreators.com/consult/trademark/>

And without further ado, let's get into what it takes to protect your brand.

## Three Parts of Brand Protection

There are 3 parts to a successful brand protection program:

1. **Choosing and clearing prospective trademarks:** This involves picking a name that can be registered (and avoiding those that cannot), avoiding conflicts with registered and unregistered trademarks and picking a mark that will be entitled to full trademark protection.
2. **Registering and maintaining registrations:** This involves properly filing a trademark application with the United States Patent & Trademark Office (USPTO) and maintaining your registration by making periodic filings.
3. **Enforcing and protecting your trademark:** This means using your trademark properly, sending appropriately-drafted cease and desist letters to infringers, monitoring USPTO filings for trademarks that could infringe upon or weaken your trademark.

The goal is to build and protect brand value from day one. Many business owners only focus on the trademark registration part of the process and miss some serious growth opportunities or needlessly endanger their brand (aka their most valuable asset). By understanding brand protection, you are investing in the success of your brand and of your business.

Below we go into detail about the three major parts of brand protection: choosing and clearing a trademark; registering and maintaining a trademark; and enforcing and protecting a trademark.

## But First...What Is A Trademark?

The short answer is that a trademark represents your brand. In legal parlance, a trademark is known as a source identifier. Trademarks help customers find your product and refer to your product. And that's why having a trademark is the cornerstone of building a brand.

A trademark can be anything that helps customers (or others) find your company or recognize your products. Trademarks can include:

- Company names
- Product names
- Slogans
- Logos
- Logotypes
- Colors
- Sounds
- Smells
- Textures
- Product packaging

As long as they help customers find your product or company, almost anything has the potential to serve as a trademark. While many companies might start out with a single trademark (typically the company name itself), it is not unheard for established companies to have dozens or even hundreds of trademarks.

In a crowded marketplace, trademarks help you stand out from your competition and protect your business from copycats and anyone else who might try to unfairly trade on the hard work that you have done to build a brand. And a good trademark will make it easier for your customers and therefore build brand loyalty.

This is why it is so important to carefully choose your trademarks so that they can provide maximum value to your brand.

## Choosing and Clearing A Trademark

Before your trademark registration is filed or the ink is even dry on your business cards (or new domain name), you will want to choose and clear your trademark. You do this to: (a) pick a name that can be protected as a trademark (some cannot be, for a variety of reasons); (b) avoid conflicts with existing trademarks; and (c) to ensure that you get full protection for your trademark.

Once you have chosen a name or set of names that you would like to protect as a trademark, the next step is to talk to an attorney to “clear” your trademark. “Clearing” a trademark means having an attorney conduct a search of a few different databases. Your attorney will typically search the federal trademark database, state trademark databases and any relevant corporate databases to find marks that could potentially conflict with yours.

## The Knockout Search

When you are picking a brand name or naming your business, you will want to [conduct a “knockout search”](#). Simply put, a knockout search is a quick search of the [USPTO database](#) and will help you avoid any obvious conflicting marks. It is not designed to be a comprehensive search, but rather it is meant to help you “knock out” trademarks that have no chance of getting a registration.

In addition to the USPTO search, you will also want to do a Google search, a search of app stores, and a search for domains that contain your mark. While none of those things may give you a conclusive answer as to whether or not there will be trademark conflicts with your brand, they will at least alert you to potential issues to discuss with your trademark attorney.

But it is only a preliminary step. I often tell clients that a knockout search gets you about 30% of where you need to be. To get to 100%, you need to get a comprehensive search.

## The Comprehensive Search

People often come to us and tell us that they have had a quick search of the USPTO database and didn’t find any marks that were the same as the mark that they want to register; **this is potentially one of the biggest mistakes that a brand owner can ever make.**

**Here’s why: trademark law prevents the registration of trademarks that are confusingly similar to a previously-registered trademark.** [Note that the rule is “confusingly similar” and not “the same”](#). This is a really important distinction and if you know one thing about trademark law, this should be that thing.

So what makes two trademarks confusingly similar to one another?

There are a number of factors that the USPTO (and courts, when it comes to infringement) considers when determining if two trademarks are confusingly similar, but generally we focus on two: **the similarity of the marks themselves, and the similarity of the goods or services connected to the marks.**

**If we are thinking about the similarity of the actual marks**, we will be thinking of how the mark looks, how it sounds and the overall commercial impression made by each mark. So that means that even if a mark is not exactly the same as the mark that you want to protect, if it sounds the same or looks the same or gives the same impression, you might be running the risk of confusion.

If we are thinking of similarity of the goods, we are obviously thinking about how closely related the different goods are. That means that if you are offering packaged food, then restaurant services might be deemed to be pretty similar because it is not inconceivable that the same company would offer both products.

So that's why it is important to get help understanding if your mark will have any confusion issues with other trademarks. And you want to do that before those issues arise, as they can be incredibly expensive to fix later on.

[A comprehensive search \(generally done by a trademark attorney\) coupled with a legal analysis will help you to avoid any likelihood of confusion issues that could come up later on.](#) It is important to note that the lack of a comprehensive search is where a lot of the online trademark filing services fail - since they are not lawyers they cannot render advice on which marks will be confusing or not.

## Other Trademark Clearance Issues

Watching out for confusing trademarks is not the only thing that you need to be aware of when clearing a trademark. Additionally, here are a few things that can come up that might limit your ability to protect your trademark:

- **Geographically descriptive:** Just as it sounds, this means that your trademark simply describes the geographic reason where your product originates. For instance, a product called "California Oranges" for oranges grown in California might run into this problem.
- **Primarily a surname:** If your trademark is primarily a surname, say, Smith or Sanchez, you could run into this issue. Some names might have double meanings - they can be a name, but also mean something else - such as the name "Bird". But if the mark is mainly a surname, you will want to consider the impact.
- **Merely descriptive:** [Descriptive trademarks can run into trouble getting registered or getting full trademark protection.](#) If your mark just describes the product, say "Refreshing Beer", that might be a problem as such a mark does not serve to indicate your particular product. It just describes the qualities of your product. The best brands try to move away from simply describing their product in generic terms for this very reason. Also, definitely [try to understand the "trademark spectrum of distinctiveness"](#) when choosing a trademark.

- **Other random issues:** There are other random issues that will prevent your trademark from getting registered. Some of them come up rarely, but if they do they can jeopardize your ability to protect your trademark. So definitely get legal advice on this.

Ultimately, this all means that you should speak with a trademark attorney as soon as you can. Nothing is worse than investing time, money, and energy into a brand only to later learn that there are severe trademark problems.

We've seen it happen many times. We don't want it to happen to you.

***Confused? That was a lot of complicated material, but it's important. We'd be happy to get on the phone with you to help you understand it better. [Just pick a time for a phone call on our online calendar - it's free.](#)***

## Registering And Maintaining A Trademark

Once you have selected and cleared your trademark, the next step is to file an application for trademark registration with the United States Patent & Trademark Office (USPTO). [Trademarks registered with the USPTO have significant advantages over trademarks that are not registered.](#) These advantages make it much easier to take action when someone is infringing upon or misusing your trademark. Having a registered trademark also puts the world on notice of your rights as a brand owner.

### Creating Trademark Rights

Many people think that trademark rights are created by a trademark registration. However, this is not the case. [Trademark rights are created through usage.](#) A trademark registration simply helps you to protect the trademark rights that you generate through usage. So that means that a trademark registration without proper underlying usage is essentially useless.

An analogy would be that if the trademark rights are the car, the trademark registration is the vehicle registration. That means that a vehicle registration by itself doesn't confer much value if the vehicle doesn't exist. Same with trademark rights - if there is no underlying trademark usage, a trademark registration has little to no value.

That's why it is important to begin using your trademark as soon as you have cleared it. This way you can build up your trademark rights and create value for your business.

## Trademark Registration Benefits

So if a trademark registration is only as good as the rights it protects, what good is a trademark registration?

Every business should register their trademark. Trademark registration provides a number of benefits that will protect your business in the long run.

### National Priority

Remember how I said that a trademark registration is only as good as the rights that it protects? Well, that is true, but there is a caveat. When you use your trademark in the marketplace, your trademark rights extend only as far as the geographic region. So if you are using your trademark in Missoula, Montana and surrounding regions then your trademark rights only go that far.

This means that if someone else decides to use the same trademark in Los Angeles, you might not be able to stop them. So you could end up with more than one person using the same (or similar) trademarks in different locations around the United States and all of them may have the right to do so. This could lead to a mess!

Enter national priority.

National priority means that once you have a trademark registration, you get trademark rights all across the United States - even if you have not yet done business in that place. It's a pretty good deal because it means that you are free to expand all across the country.

However, it is important to note that if someone has already been using a trademark in a particular place (Missoula, Montana for instance) they might be able to exclude you from using your mark in that region. A good trademark search will clue you in to any such issues, so that's actually another reason to get it done.

### Enhanced Ability to Shut Down Infringers

If you have a trademark registration and someone does infringe on your trademark, a trademark registration gives you an excellent tool with which to shut them down. The reason is that trademark law gives you the right to increased damages and attorney fees should you need to bring someone to court. This provides a lot of leverage in getting things resolved quickly.

Also, if you have a registered trademark you get stronger rights online. Many [social media sites will allow you to do takedowns](#) of accounts that infringe on your trademark. You can also use the [Amazon Brand Registry to help protect your trademark on the Amazon platform](#).

[A more complete list of trademark registration benefits can be found on this blog post.](#)

## Filing A Trademark Application

Although filing a trademark application isn't brain surgery, there are some places where mistakes can be made. To help you avoid some of these mistakes, we explain some of the key parts of a trademark application below.

### International Class

Every trademark will be associated with an International Class (IC). In short, an IC identifies the broad category of goods or services that will be offered under your trademark. Each trademark will have one or more International Classes associated with it.

This means that if you are using your trademark to offer software, consulting services and books (for instance), you might file under 3 International Classes - one for each category of good or service.

### Description

In short, a description describes how your trademark will be used. The key thing here is to make sure that your description is broad enough to cover all of your usages, but not so broad as to be inaccurate.

### Specimens

As we discussed earlier, trademark rights are gained through usage. That means that before the USPTO will issue a registration, you must show usage of your trademark. The way that you show this usage is through the use of a specimen.

Specimens can take a variety of forms, depending upon the good or service in question. Typically, this will be a photograph of the product packaging, screenshots of websites or other marketing materials that show the trademark being used.

Note that specimens do have a specific requirements that must be met if they are to be accepted by the USPTO

### Use based vs. Intent to use application

There are two basic types of trademark applications: use-based and intent-to-use. A use-based application (also called a Section 1(a) application) is filed when you have already begun to use



your trademark in commerce. Conversely, [an intent to use application \(also known as a Section 1\(b\) application\) is filed when you have not yet used your trademark in commerce.](#)

Whether or not to file your trademark application as use-based or intent-to-use will depend upon your particular situation as there are factors to consider beyond whether or not you have begun to use the mark. But the important thing to know here is that there are options.

The key thing with intent-to-use applications is that you have a “bona fide intent” to use the trademark. That means that the USPTO will look unfavorably on applicants who are filing trademarks in an attempt to “warehouse” or “squat” on the mark. Applications like that generally will not get far and will typically be a waste of time and money.

Finally, with an intent-to-use application, you must show usage before your trademark registration can be issued. After the examiner reviews and approves your application they will issue a Notice of Allowance (NOA). After the NOA is issued, you will have an initial 6 month period to show that you have used the mark in commerce. If this is not possible, you are able to file for further 6 month extensions.

### **Responding to Office Actions**

An Office Action is a communication from the USPTO, generally about a problem with a trademark application. Some of these are easy to resolve and others can be more challenging. Avoid the challenging ones by doing proper trademark clearance. These can be expensive to fix.

Respond quickly so that your trademark application moves forward. You have six months, but should move right away so your application is not held up. [If you have received an Office Action and are not sure what to do, there is an easy way to get legal advice to get through it.](#)

### **Likelihood of Confusion and Descriptiveness Refusals**

There are two common types of Office Actions that can be difficult to overcome: likelihood of confusion refusals and descriptiveness refusals. Often, making the legal arguments to overcome these rejections will be more expensive than hiring an attorney to give you advice beforehand.

The goal of a comprehensive search and attorney analysis (see above) is to identify these possible risks and then create a plan to avoid them altogether.

## Specimen Refusals

The specimen should meet the USPTO requirements and should show the mark used in conjunction with goods and services. If it does not, then the USPTO will reject the specimen and ask for a new one. Some common reasons the USPTO might refuse your specimen include: your specimen is just a mockup, your specimen and the applied-for trademark do not match, the goods/services shown in the specimen do not match the description in your application, and a number of others.

Ultimately, you will want to determine early on whether or not you can produce a specimen

## Trademark Oppositions

As part of their brand protection efforts, many companies actively monitor the USPTO trademark database to watch for trademark applications that could conflict with their own. When they find one, they may file an opposition proceeding with the USPTO. An opposition proceeding is similar to a lawsuit in that two parties are using the legal system to resolve a conflict over legal rights.

If you receive [notice of a trademark opposition or an extension of time to oppose](#), it is crucial to get legal advice quickly so that you understand your rights in the situation and have a plan to move forward.

## Maintaining Your Trademark Registration at the USPTO

Once a trademark is registered, it must be maintained. This is not difficult, but missing deadlines could jeopardize your valuable trademark rights. The first time you will need to file any sort of maintenance document will typically be between the fifth and sixth year after your registration issues.

This first maintenance filing is called a Section 8 filing and simply tells the USPTO that you are continuing to use the trademark that you registered. At that time, you will also need to file a specimen showing how you are using your trademark. If you are working with an attorney, he or she will be able to advise you as to the proper timing and filing of the Section 8 declaration.

After the Section 8 filing is made, you will make follow up filings every ten years, in a manner similar to that of the 5-year filing.

Also, many trademark owners file for incontestability at the same time that they do their Section 8 filing. Incontestability prevents other people from cancelling your trademark for certain reasons.

***Confused? There are a lot of moving pieces when it comes to putting together a trademark application. We'd be happy to get on the phone with you to help you understand it better. [Just pick a time for a phone call on our online calendar - it's free.](#)***

## Enforcing and Protecting A Trademark

Maintaining a trademark registration at the USPTO is important, but it is just as important (maybe even more important) to actually enforce your trademark rights in public. If you fail to do this, your trademark rights will be seriously harmed or voided entirely.

**A trademark registration is only as good as the trademark rights that they protect. [And trademark rights are a "use it or lose it" proposition.](#)** This means that if you allow other people to infringe upon your trademark rights, you could lose them - even if you have a trademark registration.

**[The cornerstone of trademark enforcement is trademark monitoring.](#)** In short, that means watching what trademarks are filed at the USPTO. Doing this allows you to take prompt action in case someone tries to file a mark that is too close to your own.

Beyond trademark monitoring, you will also want to ensure that you are properly using your trademark and that you promptly send cease and desist letters to any potential infringers. And respond to anyone who accuses you of infringing upon their trademark.

### Trademark Monitoring

Owners of valuable brands watch the trademark database like a hawk. They are looking for trademark filings that could potentially interfere with their brand value. If they see one, they are generally pretty quick to act. This means either opposing a trademark or otherwise taking action against the other party.

Not every filing needs to be acted upon, but you should be aware of any filing that could cause a problem. One of the benefits of getting attorney help here is that they can advise you as to what actions you might want to take once you find a filing that is a problem. The choices vary depending upon the situation.

## **Sending Cease and Desist Letters**

Some people might feel that it is a little heavy-handed to send out cease and desist letters, especially if you have never done it before. But it is an essential part of the brand protection process. Just like you wouldn't want your neighbor to build something on your property, you don't want them to infringe on your trademark.

But sending a cease and desist letter must be carefully considered as you do want to make sure that you have all the facts and law in place. Sending out a letter without a full understanding of your legal position can lead to some serious mishaps.

## **Putting Brand Protection Into Practice**

Brand protection creates a foundation for business growth by securing trademark rights, avoiding branding conflicts and protecting against infringers. These things are essential for any business seeking to carve a unique space in the increasingly crowded brand marketplace.

Keep in mind that the goal with any type of brand protection is to grow and protect the value of your brand assets. Any company will put a great deal of time and energy into growing a brand, marketing to customers, generating leads and creating customer goodwill. Your brand encapsulates this value.

The chief benefits of a well-protected brand include:

- The ability to stop others from adopting a brand name that is too similar or confusing to yours.
- The ability to distinguish your goods and services in the marketplace and charge a premium.
- The ability to capture and to protect customer goodwill and reputation.

Companies with established brands spend big on brand protection.

The prevailing and traditional paradigm would be that companies would spend potentially upwards of \$5,000/month in legal fees to put a brand protection program into practice. Law firms have generally charged either on an hourly basis as fees are incurred or charge a monthly retainer. Either way, complete brand protection can be an expensive proposition, but for valuable brands it makes business sense.

While it may seem tempting to skip over some parts of this process (or attempt to do it yourself), it is not recommended. Maybe it seems confusing or out of reach, but you should start by

understanding the value that good brand protection can provide to your business and then have a plan to put everything into practice.

With an increasingly crowded marketplace, brand protection is an essential part of business growth. And no matter where you are in the process of protecting your brand, there are always things that you can do to improve.

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**Questions about anything you read here?** [We keep slots open every week to answer your questions about trademarks and how we can help you protect your brand.](#) The call is free.

***Remember:*** *This guide is not a substitute for legal advice. That's because everyone's situation varies. The only way to really get the benefits of brand protection right is to have a conversation with a trademark attorney. While we are happy to provide this information for free, that does not make us your attorney. If you want to work with us, [we are happy to continue the conversation.](#)*