

4 Trademark Protection and Enforcement

Businesses create trademarks, service marks, or trade dress, the distinctive marks associated with the business' goods, services or product packaging (collectively "trademarks"). Patent attorneys counsel clients regarding trademark ownership, registrations, and enforcement actions.

A. Trademark ownership

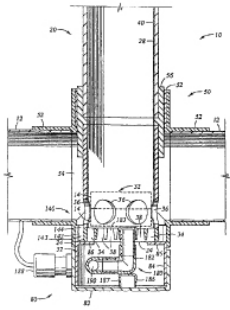
A business acquires common-law trademark rights by adoption and use of a distinctive mark in commerce in association with the goods or service. However, the rights and remedies associated with trademark ownership increase with registration. Patent attorneys counsel clients regarding trademark ownership and scope.

1. Trademark search and clearance

The first step in determining whether to use or register a trademark is a search. The business owner discloses the trademark and the goods or services associated or to be associated with the mark. The patent attorney then searches registered trademarks in the appropriate nationality, whether the United States or foreign countries. Based on the mark, its strength when compared to the associated goods or services, and existing registrations, the patent attorney advises the client whether the mark at issue is protectible or may infringe the rights of another.

Except as otherwise provided in [Title 35], whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

35 U.S.C. § 271(a).



U.S. Pat. No. 6,183,630

*Chlorinator for Aerobic
Waste Treatment Systems*

Inventor:

Gary R. Reeves

Patent Attorneys:

Keeling Patents & Trademarks, L.L.C.

2. Trademark registration

Trademarks may be registered in the various states of the United States, for the entire United States, or abroad. In the United States and its various states, Texas in particular, registration of a trademark has noticeable benefits.

a. Texas

Registration of a mark in Texas is made through the Texas Secretary of State. The patent attorney prepares trademark applications which identifies the mark, the international class into which the goods or services fall, the description of the goods, and the date of first use of the mark in association with the goods or services, and responds to any office action from the Secretary of State's Office.

In the event of litigation, the Texas trademark registration is prima facie evidence of trademark ownership. However the protection is limited to the State of Texas and actions under Texas law for trademark infringement are limited to recovery of lost profits, which may can be difficult to establish.

b. Federal

Nationwide rights, subject to the rights of senior users, is provided by federal registration through the United States Patent and Trademark Office. Under the federal system the trademark owner may elect to pursue registration under one of two different regimes – the actual use application (AU) or intent-to-use application (ITU).

Federal trademark registration has significant benefits. In addition to constituting prima facie evidence of trademark ownership, federal registration provides additional monetary remedies in cases of infringement, including the infringer's profits and the trademark owner's actual damages or statutory damages, as well as attorney's fees. After five years of use the mark acquires additional strength, becoming "incontestable" with respect to specific defenses.

i. Actual Use Application

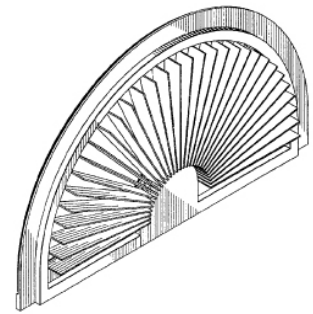
Under the actual use application, the patent attorney prepares a trademark application that identifies the mark, the international class into which the goods or services fall, the description of the goods, and the date of first use of the mark in association with the goods or services, and includes the specimens of use, then responds to any office action from the trademark examiner. Responses to office actions are typically performed on an hourly-rate basis.

ii. Intent to Use

Under the intent to use application, the patent attorney prepares a trademark application that identifies the mark, the international class into which the goods or services fall, the description of the goods, and responds to any office action from the trademark examiner. Actual use and intent to use applications have a significant difference – no actual use is required for intent to use applications. However within six months after issuance of the Notice of Allowance, the trademark owner must file a statement of use. Five extensions of six months to file the statement of use are permitted. Failure to timely file the statement of use or the extension results in loss of the mark.

c. Foreign Filing

The patent attorney may also work with attorneys in foreign countries to file for trademark registration in those countries designated.



*U.S. Des. Pat. No.
439,096*

Sunburst Window Blind

*Inventors:
John G. Clarson and
Troy D. Carlson*

*Patent Attorneys:
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Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

17 U.S.C. § 102(a)

B. Trademark infringement issues

Patent attorneys also participate in actions regarding trademarks. This participation may begin long prior to any litigation with infringement opinions. Thereafter the patent attorney may participate in litigation related to trademark infringement, trademark dilution, false advertising and cybersquatting actions. Such work is typically performed on an hourly rate basis.

1. Trademark infringement opinions

Where a trademark-related action is possible the patent attorney may be called upon to provide an opinion letter regarding the potential exposure.

2. Trademark-related Actions

Patent attorneys regularly participate in trademark-related actions, either as primary counsel or as co-counsel for other trial attorneys. The issue in trademark infringement actions, both in federal and state courts, is whether potential purchasers would likely be confused as to an association, connection or sponsorship between the two entities. The court typically looks to eight factors in reaching a determination. The issue in trademark dilution actions in Texas courts is whether the use by the junior user is likely to make the senior user's mark less distinctive as an indicator of source. In Texas state actions, only injunctive relief is available. In federal dilution actions brought in courts governed by the Fifth Circuit, liability requires actual harm. Patent attorneys also work to deter cybersquatting under federal law, which typically focuses on trademark rights.