



IP Law Fundamentals

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Why Register Trademarks with the USPTO?

The United States Patent and Trademark Office (“USPTO” or “PTO”) oversees the registration of trademarks at the federal level and a federally registered trademark can be a very valuable intellectual property asset. Anyone who produces goods or provides services in interstate commerce, including services provided through a web site, should consider applying for and obtaining a federal trademark or service mark. Such marks allow consumers to identify a business as a source of particular goods or services and federal registration affords the owner of a mark significant benefits.

While there are important nuances and differences between the Principal Register and the Supplemental Register and registrations under Section 1A versus those under Section 1B, active trademark registrations on the Principal Register enjoy the following advantages:

1. Registration acts as constructive notice that the owner of the mark has the exclusive right to use the mark throughout the United States and anyone else using the same mark or a confusingly similar one can be prevented from using it.
2. Registration acts as prima facie evidence that the registered mark is valid, the registrant owns it, and the registrant has the exclusive right to use it.
3. Registration is prima facie evidence that a mark has been in continuous use in commerce since the registration application was filed.
4. After 5 years of continuous use, the mark becomes incontestable.
5. The owner may sue in federal court for trademark infringement if there is no diversity jurisdiction (i.e., the parties do not live in different states).
6. In a trademark infringement lawsuit, the owner may be entitled to statutory damages - a measurement that may exceed actual damages.
7. The owner may use the U.S. Customs Service to prevent goods from being imported if they bear infringing marks.
8. Foreign registrations of the same mark can be simplified.

Federal trademark registration is not especially expensive (most registration fees total under \$1,000), but it is important that an experienced intellectual property oversee or actually handle the registration to avoid complications.

KEY CONCEPTS

- 1 Registration conveys important benefits
- 2 Registration is done through the USPTO
- 3 Proper registration can make a mark incontestable
- 4 Statutory damages can be a very persuasive negotiating tool
- 5 A good IP attorney should be consulted for most trademark registrations

“Often times, the success of a federal trademark registration depends on the capabilities of the handling attorney..”



Partner David Baker

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