

## To Register or Not to Register How Registering a Trademark Can Protect Your Good Name

*By Bobby L. Hazelton, Esq.*

How comfortable are you with conducting business under your corporate name? How comfortable are you with the names that you have given to your products and services? If you are the principal shareholder of a corporation conducting business in the Commonwealth of Massachusetts, you have presumably filed your corporate name with the Secretary of State's office. At the time of your business filing, the Secretary of State conducted a search to ensure no other business was using that precise business name. However, the Secretary of State does not prevent anyone from using a similar name for their business. More importantly, the corporate registration does not guarantee that your use of your business name will not infringe on the rights of other companies with similar business names or similar business names for products and services. If you conduct business in a form other than a corporation, you may even have less security in your business names. To protect your business' good name, and to guard against lawsuits from other companies, you may need the benefit of trademark registration.

Trademarks are distinctive symbols, pictures, packaging, color combinations, building designs, product styles, words, sounds, motion elements or other types of presentations that businesses use to identify the origin of their products. The owner of a trademark has an exclusive right to use the trademark on the product it identifies, and from time to time, on related products. A service provider may register a service-mark that distinguishes the origin of certain services. Under Massachusetts common law, trademarks and service-marks are protected as part of the law of unfair competition. Registering your business's trademark will entitle you to additional benefits.

Trademark registration may be done at the state or federal level. State registrations are usually a simple matter involving the completion of a form affidavit and the submission of specimens of the mark at the appropriate state office. State registrations do not usually yield objections from the state registration authority; however, the state registration does not offer any benefits for commerce outside the state of registration. Federal registrations provide nationwide benefits, but they usually involve a more detailed registration process. Federal registrants must respond to requests for additional information or make arguments to the United States Patent and Trademark Office as to why their mark should be allowed registration.

The benefit of a state registration varies from state to state. In Massachusetts, the Secretary of the Commonwealth keeps a

central file, and your registration will appear on other companies' searches for existing trademarks. The registration also serves as proof of your company's first usage date of a trademark or service mark which may be of benefit in case of future litigation.

Federal registration provides additional benefits. A federal registration establishes a nationwide priority date, as of the date of filing, against everyone except those with prior rights. A business that previously used the trademark or service mark before your company would have acquired a prior right, but the other company would have to rebut your presumption of a federally valid trademark. Once a trademark is registered, the business owner gains a presumption that he has the exclusive right to use the mark and that the registration is valid. A business may only intend to use the trademark in the immediate future and still receive the same priority date. A company obtains their original priority date if the United States Patent and Trademark Office issues a registration.

After a brief period of time, a federal trademark registration becomes incontestable. If another company infringes on your trademark, the infringer will only have a limited number of defenses available for their use of the mark. A federal trademark registration also provides for additional legal remedies against a trademark infringer, and provides notice of your company's valid trademark to would-be infringers who may innocently adopt the trademark.

Registration may not be available for all trademarks. For instance, a trademark that merely describes a product or service cannot obtain registration unless it has acquired secondary meaning. A trademark has secondary meaning when the business has used the mark over a long period of time, and the public associates the mark with the company's product or service. Descriptive trademarks without secondary meaning are not technically allowed by most states or the federal government. In the event federal registration is not immediately available, your business may first want to apply for state registrations of trademarks; and then use the state registration as an argument for secondary meaning in a later federal registration application.

If you are considering registering a trademark, the first step would be to have a study conducted to determine whether a federal or state registration is prudent. You may find that you need to consider another name for your product or service due to potential conflict with another company's trademark. Once you decide to seek registration, it may be necessary to respond

to various requests and present arguments for registration with the applicable state and federal agencies. Following receipt of your registration, certain affidavits must be filed to retain the registration, and registrations must be renewed regularly. In addition, the federal trademark register should be monitored for the appearance of potential conflicting trademarks.

While registration of a trademark cannot insure that another company will not seek to use the same or a similar name for their business, it is one of the best methods for preventing others from misusing the good will you have built and provides a better means for combating anyone who might try.

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