



Trademarking your Business:

The ins and outs of protecting your name

By Amanda N. Wegner

Have a business idea brewing? You might want to protect your fledgling business with a trademark. Here, attorney Erin Ogden of Murphy Desmond S.C., offers her expertise on the need and process of trademarking your business.



Erin Ogden
Murphy
Desmond, S.C.

Q: What are the steps for obtaining a trademark?

A: There are three approaches.

- Common law protection gives you protection just by using the mark. There is no registration process. Any protection is based on use alone. Therefore it is the easiest, but also the weakest. A mark owner has to prove that customers recognize it as their mark and that they had prior rights to it compared to any infringer.
- State law protection is based on state statutes; here in Wisconsin, it is a slightly more formalized common law. An owner files a form with the Secretary of State claiming use of the mark and pays a small fee, currently \$15. The Secretary of State then returns a certificate of registration. The Secretary of State does not perform any examination of the mark, and no rights are acquired from registration. It is simply a public record showing the date of first use of the mark and possible continued use. It is not required to register the mark to use it in the state.

- Federal trademarks are a bit more complex; visit the United States Patent and Trademark Office Web site for a great primer.

My biggest advice is to get advice at the beginning. Many clients start out too narrow and then cannot expand. It is better to start out expansive and narrow down than vice versa.

Q: Under what circumstances might you obtain a trademark at only the state level or vice versa?

A: Four reasons for certain:

1. Federal trademarks require interstate commerce, which means something about your mark must reach over state lines.
2. Budget may be a concern. Federal marks come with a filing fee of at least \$275 and possible attorney's fees.
3. A descriptive mark may not be federally registered because the potential customer does not recognize it as a mark yet. This is called gaining "secondary meaning." You need several years of use before a descriptive mark gains secondary meaning, so a state mark might be a good idea until it is.
4. It takes quite a while to get a federal mark (plan at least one year). If you are doing a short-term campaign, a federal mark may not be worth the expense.
5. Now if a company is doing national roll-out or is concerned about copycats, the federal mark may make sense because you get many presumptions with a federal registration.

Q: When and why you conduct a trademark search beyond checking the state

and federal search engines?

A: If expansion is likely, either by you or a competitor. If a company expects to expand into other states, it is a good idea to check to where they are expanding. Also, if what they are doing lends itself to chains or expansion, even if the company doesn't see itself doing so, it might be a good idea so they have a choice later. Or if a competitor is likely to come in, it might be a good idea to consider just avoiding a debate as to who was first and who has more rights. Don't forget the Internet may cause you to reach out into other lands. And check "border towns;" if your business is located on a state (or country) line, check for businesses with a similar name or product on either side of that boundary to avoid problems.

However, those databases don't cover everything. A company is not required to register a mark. Therefore, pick your favorite search engine and check. I also like checking the white and yellow pages. You will never pick up everything, but this at least gives you a fighting chance.

Q: Are there restrictions regarding general vs. specific terms and names?

A: Trademarks live on a spectrum from generic to fanciful, with generic being least protectable and fanciful being most protectable.

Generic terms are never registerable because you would be taking away the public's ability to talk about something; think "beer" or "soap." What else would you call them?

Descriptive terms may be registerable once secondary meaning is reached. Descriptive terms include "Toys R Us" or "CompuUSA." You know exactly what the mark is doing, but you can differentiate it after

enough time of it being used.

Suggestive marks hint at the goods or services but are not as explicit as descriptive. "L'eggs" pantyhose is my favorite example.

Arbitrary marks use unrelated words as marks. They may have something in common, but you aren't going to get there thinking too quickly. "Ivory" soap is one.

Fanciful, also called inherently distinctive, are made-up words. The word doesn't mean anything other than the mark. Exxon and Kodak don't mean anything other than the marks. Suggestive, arbitrary, and fanciful marks are all protectable as long as they are not easily confused with a pre-existing mark. Don't bust out Kobak films and expect not to be stopped.

Q: When and why should you engage legal assistance in the trademark process?

A: Sooner is better than later. I am a huge fan of the saying that an ounce of prevention is worth a pound of cure, and that is very true here.

What can a company do to help themselves? Do the searches that you can do. I may repeat them, but if you find the mark you wanted is already taken before you even talk to a lawyer, that saves everyone time and money. Also, the company can often do state registrations.

Trademark attorneys have experience with both the prosecution of applications and suits of infringement. I advise that a company talk to an attorney to determine what level of protection they need at the very least. There is a lot of confusion between copyright and trademark. Make sure you know which you need. Then to figure out if state and federal is the best bet.



Amanda N. Wegner, amandawegner.com, is a freelance writer and editor in Madison.

Online resources

State of Wisconsin:

www.sos.state.wi.us/trademark.htm

**United States Patent &
Trademark Office:**

[www.uspto.gov/web/trademarks/
workflow/start.htm](http://www.uspto.gov/web/trademarks/workflow/start.htm)