

The article on the right - "If assets need protecting, your best course may be a trademark" appeared in the Boston Business Journal, Issue May 2-8, 2008, page 12 of the BBJ supplement "Law & Accounting Directory".

- If you have any questions or comments on this article

- If you or your company would like help to protect the brand name for a business, product or service, a slogan, logo or design or packaging

- If your trade association or non-profit group would like to file a collective mark for the group or your members or to certify goods or services

- Or if you have other questions or issues involving trademarks or a service marks or copyrights, trade secrets or other intellectual property

The author can be reached as follows:

Robert A. Adelson, Esq.
Engel & Schultz LLP
 265 Franklin Street, Suite 1801
 Boston, MA 02110
 Tel: (617) 951-9980
 E-mail: radelson@engelschultz.com
 Website: www.engelschultz.com

If assets need protecting, your best course may be a trademark

Your brand name can be an important asset.

As such, trademarks and service marks are recognized in common law and by statute to protect the goodwill in a brand name developed for a business, product or service.

Some brand names are just coined words — such as Kodak or Xerox — that take on great value as brand names because of millions of dollars spent in their promotion. Others can have value right from the start.



INSIDER VIEW

Robert
A. Adelson

For example, say Jo Jones repairs APPLE computers.

If Jo calls the business MacBetter Inc., instead of Jo Jones Inc., it tells about the business, suggests the nature of the business, without Jo ever meeting a customer.

That saves him money on advertising, as well enabling potential customers to find and remember his business.

Suggestive trademarks along with associated goodwill can become valuable to consulting and service businesses as well as to businesses that market products.

Sometimes business acquisitions occur simply to obtain the rights to trademarks.

This happens where the acquirer desires to utilize the goodwill already associated in the trademark. It also occurs where the acquirer believes a specially suggestive or memorable mark is one consumers or clients will remember and help the acquirer sell products or services.

ITU — To preempt your trademark

It's wise to first search and verify trademark availability, which is defined as nonuse by competitors.

If the name is available, consider filing an ITU, that is an Intent-To-Use application for registration with the United States Patent and Trademark Office. For this filing, it is sufficient that you've thought of a brand name and intend to use it and represent that intention in your filing with the trademark office.

An Intent-to-Use registration application can hold a mark for several years before you actually market a product or service.

The ITU filing reserves exclusive rights to the mark.

Someone else might later decide to use the name and invest thousands, even millions of dollars in promotion, yet be barred from use because their new use of the trademark conflicts with and thus infringes on your earlier filing.

Benefits in all 50 states

If you plan to spend much time and money to promote your product, business or service, you should conduct the search and file the ITU.

Also think about including any catchy slogan or attractive logo you plan to use. These too can be part of your goodwill and may justify protection.

In addition, you will need to identify the products and services your mark covers or will cover.

In taking a trademark from the intent to use stage, also known as the reservation stage, to a final registration, where you have an enforceable mark, you must show use in interstate commerce — filing a specimen of use in two or more states.

Commerce in only two states or between the U.S. and a foreign state will suffice.

The federal registration would then make the mark yours exclusively in the classes of goods and services identified in all 50 states.

Prosecution costs and requirements

Federal trademark registration is not cheap. Filing costs are \$325 per class or per mark.

The PTO currently recognizes 46 classes of goods and services. Filings frequently involve juggling several classes as you seek broad coverage. Attorney fees can be \$1,000 or more.

Registration is not quick or automatic.

The PTO bars registrations for "generic" or "descriptive" marks.

It also bars marks if there is a likelihood of confusion with an existing mark

or for various "informalities," such as unclear wording or need to disclaim common words.

The "prosecution" process of obtaining approval can take a year or longer. Still more filings and fee payments are required after registration.

Marks are for 10 years — and subject to renewals — but filings are needed after five years to assure the PTO that the mark is still in use.

Yet patience in prosecuting a mark is vindicated by value added to your business as a whole.

ROBERT A. ADELSON is an intellectual property expert and law partner at Engel & Schultz LLP in Boston.

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601 Edgewater Drive, Suite 200
 Wakefield, MA 01880
 781-279-7788
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