

# Take These 5 Steps to Protect Your Brand Under Trademarks Law

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## KEY POINTS

- Federal trademark registration with the USPTO provides constructive nationwide notice, statutory infringement remedies, and access to online marketplace enforcement tools.
- State trademark registrations are required in most states to bring claims under state trademark statutes and may provide additional remedies, including punitive damages.
- Trademark owners have an affirmative duty to police marketplace uses of their marks; failure to do so weakens the mark as public association with a single source diminishes.
- A prominent online presence creates a traceable history of continuous trademark use and demonstrates shared channels of trade — a factor weighed in trademark infringement litigation.
- Varying the placement and size of both house marks and secondary marks strengthens protection for each mark independently.

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Businesses can proactively protect their valuable brands and intellectual property (IP) rights — much like building a fence around your house to keep intruders out. The practical tips below draw from decades of trademark litigation and dispute resolution experience, offering steps business owners can take to protect their hard-earned reputation and brands. A trademark is what many think of as a brand, in legal jargon, a word, name, symbol, or device, or any combination of these items that indicates the source of goods or services.<sup>[i]</sup>

## 1. REGISTER WITH THE U.S. PATENT AND TRADEMARK OFFICE.

It is a common misbelief that the U.S. Patent and Trademark Office (USPTO) grants companies their trademarks. It does not. Trademarks exist from the moment they are used in commerce.<sup>[ii]</sup> However, the USPTO and the trademark registration process can significantly strengthen and broaden the rights a trademark enjoys. For example:

- Registration can serve as evidence of nationwide ownership and validity of the trademark;<sup>[iii]</sup>
- Registration provides constructive nationwide notice to all potential competitors of the use of the trademark;
- Registration provides additional statutory remedies available in the case of trademark infringement;<sup>[iv]</sup>
- Online marketplaces — like Amazon — often require a federal trademark registration before allowing the submission of an infringement complaint or “takedown.”<sup>[v]</sup>

However significant these benefits may seem, rest assured there is a reason the first exhibit in most trademark infringement lawsuits is a USPTO registration. For further examples of the benefits of trademark registration, see

our colleague's [article](#) and [post here](#).

## **2. REGISTER YOUR TRADEMARKS WITH STRATEGIC STATE GOVERNMENTS.**

Unlike other forms of IP, such as patents and copyrights, trademarks retain a presence in both federal law and state law.<sup>[vi]</sup> This means state governments enforce eligible trademarks under their own trademark law, not just the federal law.

You might ask, if I follow your suggestion and get a nationwide USPTO registration, then why do I need a state-level registration as well? First, the majority of states require you to have their state's specific registration to proceed with a claim under that state's trademark statute. Second, certain states provide additional remedies beyond those which can be received under federal law, or protect more local brands against dilution. These additional remedies can include a greater ability to recover your attorney's fees or the availability to seek punitive damages.<sup>[vii]</sup>

## **3. CONDUCT PERIODIC MARKETPLACE SEARCHES.**

Performing frequent sweeps of the marketplace can greatly benefit your trademark strategy.

Prior to using or adopting a trademark, you would do well to search the marketplace. Nothing can be worse than expending time and effort developing a brand only to later discover that someone else beat you to it. A few minutes of research now can save weeks or months of headaches, or costly rebranding, down the line.

Once trademark rights are established, frequent searching assists in keeping the trademark strong. Trademark law gives holders the opportunity to exclude others from using similar names or phrases, but it also places on the trademark holder the duty to police such uses. The more uses that appear in the market, the weaker the trademark becomes, as the public is less likely to relate any given use of the trademark with a single source.<sup>[viii]</sup>

## **4. PROMOTE YOUR BRAND AND UTILIZE YOUR TRADEMARKS ON THE INTERNET.**

We live in the digital age. Regardless of how your business operates, the exposure through the internet is at an all-time high. Odds are that your consumers are constantly using the internet to find you. However, consumers will not always remember the product or company's name when performing internet searches, but they may remember the catchy slogan or trademark you utilized. Your online presence should reflect those same slogans and trademarks in order to capture and recapture consumers.

Further, consumers are not alone on the internet. Rather your competitors are likely to be there as well. Thus, prominence of your trademarks and brands on the internet strengthens your brand and acts as a deterrent in many ways. First, internet presence provides an easily traceable history of continuous use of your trademark and brand. Second, it provides clear and obvious notice of your use and ownership of the trademarks and brands. Third, presence on the internet can provide an easy comparison to show that your business and a competitor operate through the same channels of trade, a factor considered in almost all trademark lawsuits.<sup>[ix]</sup>

## **5. USE YOUR TRADEMARK IN VARIOUS MANNERS.**

While you should keep the visual structure of your trademark consistent, you should vary its placement and size.

For instance, some trademarks represent your company's name, which are referred to as "house marks." Other trademarks may promote only a single product or line of advertising, known as "secondary marks" or "product marks". By adjusting the placement, respective size, and presence of both your "house mark" and "secondary marks," you can increase protection for both. For instance, if your "secondary mark" is always utilized alongside your "house mark," a competitor might argue that the "secondary mark" requires the use of the "house mark" (your company's name) in order to violate your trademark rights, undermining the benefit of your "secondary mark."

In other instances, if your trademark only ever appears in small sizes or in obscure locations, there can be arguments that consumers are not actually referring to or recognizing your brand based on the trademark.

This list is not comprehensive, but it is meant to help companies and trademark owners identify advantages they may be missing. Working with counsel early in developing your branding and trademark portfolios can save money and increase the likelihood of maximizing your brand's strength and protection. An experienced IP attorney can walk you through the analysis to provide better insights into your unique brands.

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[i] <https://www.uspto.gov/trademarks/basics/what-trademark>

[ii] *Columbia Mill Co. v. Alcorn*, 150 U.S. 460, 463–64, 14 S.Ct. 151, 37 L.Ed. 1144 (1893)

[iii] 15 U.S.C. §1057

[iv] 15 U.S.C. §1117

[v] <https://sell.amazon.com/brand-registry>

[vi] *Matal v. Tam*, 137 S. Ct. 1744, 1753, 198 L. Ed. 2d 366, 45 Media L. Rep. (BNA) 1849, 122 U.S.P.Q.2d 1757 (2017)

[vii] See e.g., *JCW Investments, Inc. v. Novelty, Inc.*, 482 F.3d 910, 919, 82 U.S.P.Q.2d 1001 (7th Cir. 2007) (allowing punitive damages); *Attrezzi, LLC v. Maytag Corp.*, 436 F.3d 32, 40–42, 77 U.S.P.Q.2d 1641 (1st Cir. 2006) (Federal Lanham Act did not stop New Hampshire state law allowing easier recovery for attorney fees.). See *Tonka Corp. v. Tonk-A-Phone, Inc.*, 805 F.2d 793, 794–795, 231 U.S.P.Q. 872 (8th Cir. 1986) (Same for Minnesota).

[viii] *Morningside Group Ltd. v. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 51 U.S.P.Q.2d 1183 (2d Cir. 1999) ("[T]he successful policing of a mark adds to its strength to the extent that it prevents weakening of the mark's distinctiveness in the relevant market.").

[ix] See e.g., *Checkpoint Sys. v. Check Point Software Techs.*, 269 F.3d 270, 291 (3d Cir. 2001) (website and single local store can favor likely confusion); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1057 (9th Cir. 1999) (internet allows for increased overlap and confusion).

## RELATED INDUSTRIES + PRACTICES

- Intellectual Property
- Trademark + Copyright