

## Practical Advice for Protecting Your Trademark Rights

By Maureen E. Carr, Esq.

Have you ever discovered that someone is using your business's name (a.k.a. "mark") without your permission? It might be a competitor who is attempting to gain a business advantage. It might be an innocent with no knowledge that you also use the mark. Or it might be someone who routinely registers domain names using the marks of established businesses with an improper purpose.

All of these scenarios highlight the importance of protecting your trademark rights. If you registered your business's name as a trademark with the U.S. Patent and Trademark Office (PTO), you may have a host of remedies available under the federal Lanham Act, including trademark infringement, trademark dilution, and cybersquatting. Even if your mark is not registered, you may have a claim for unfair competition under the Lanham Act. And, regardless of whether your mark is registered, you may have common law rights to the mark if you used it before the other party.

The best way to protect your intellectual property rights in your business's name is to choose a name that is distinctive and is not likely to be confused with other marks. An *unregistered* mark is subject to federal trademark protection *only if it is distinctive*. Trademark law recognizes four degrees of distinctiveness: (1) generic (general category – i.e. Orange Juice Co.), which is entitled to no protection; (2) descriptive (describes characteristics of the product – i.e. Fresh Orange Juice Co.), which is only entitled to protection if it has acquired a secondary meaning; (3) suggestive (suggests a characteristic of the product – i.e. Squeeze!), which is entitled to a high level of protection; and (4) arbitrary and fanciful (bears no logical relationship to product – i.e. Del Monte), which is entitled to the most protection.

To provide an even higher level of protection, a business may protect its mark by registering it with the PTO. A business with a *registered* mark may assert a trademark infringement claim against a party who uses the mark in commerce in connection with the sale of goods in a manner that is likely to cause consumer confusion. A business with a *famous* registered mark may assert a trademark dilution claim without showing a likelihood of confusion by demonstrating that the other party's use of the mark dilutes the distinctive quality of the mark through "blurring" (similarity impairs distinctiveness of mark) or "tarnishment" (similarity harms reputation of mark). In federal trademark actions, a court may order an infringing party to stop infringing, award monetary damages to the mark owner (*treble* damages under certain circumstances), and award the mark owner its attorneys' fees in exceptional cases.

Federal trademark law provides further protections to combat cybersquatting. Where a party registers a domain name that is identical or confusingly similar to a *distinctive* mark or is dilutive of a *famous* mark, with a bad faith intent to profit from using the domain name, the mark owner may assert a claim under the Anticybersquatting Consumer Protection Act (ACPA). Because many cybersquatting cases involve foreign parties who register infringing domain names and are not subject to the jurisdiction of American courts, the ACPA allows the mark owner to sue the domain name directly in the event that the party that registered the domain

name cannot be located. If cybersquatting is proven, the court can order the forfeiture, cancellation or transfer of the domain name.

Businesses should educate themselves about their trademark rights and take appropriate actions to protect such rights – first by choosing distinctive names, then by registering their marks with the PTO (a relatively inexpensive and hassle-free process), and finally by asserting their rights through litigation if necessary.

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