

The National Trademark Expo

The United States Patent and Trademark Office has announced plans to hold a National Trademark Expo at its Alexandria, VA headquarters April 10 to 12, 2008. The deadline for applications to be a participating company is due **Dec. 15, 2007**.

The PTO expects the three day event to be well publicized, and to focus attention on the vital role trademarks play in the national and world economy. Any company with a registered trademark can apply to be an exhibitor.

Among the marks the PTO would like to highlight are those with high brand recognition, those which show the importance of trademarks, and those which help illustrate the diversity of trademarks and their uses. Successful applicants will be notified by Jan. 15, 2008.

For more information contact us or the PTO at www.uspto.gov.

China Needs Viagra?

Apparently so. Or at least Pfizer thinks they do.

As you may have heard, China is a major source of counterfeit drugs, and a lot of other counterfeit stuff too. Of course, makers of the genuine articles want the counterfeiting to stop. There have been major trade initiatives with that goal in mind. But so far the objective has been elusive.

Pfizer, the world's largest drugmaker, has tried a different approach. It has at last succeeded in registering its Viagra trademark in China, and using that registration to reverse a 2004 decision by a Chinese court that allowed Chinese drugmakers to sell Viagra copies.

So, once again trademarks come to the rescue. An active foreign registration program is always desirable, both to stop foreign marketers from registering and using a mark, and to reap the benefits abroad that accrue to U.S. manufacturers.

If you would like to discuss how to secure and protect your marks in foreign markets, contact us.

Watch That Mark

As products and services become popular, others are tempted to use either the same or similar marks to siphon some of the genuine mark's sales.

How can companies prevent such activities? One way is to use a watch service.

Various research services provide trademark watch services to monitor the marketplace for marks confusingly similar to a watched mark. Among the types of services available are: 1) application watch services – to watch for applications relating to similar marks; (2) market watch services – to watch a defined market for similar marks; (3) use watch services – to watch for improper uses by others of your mark; (4) internet watch services – to watch the internet for uses of marks similar to yours; and (5) company watch services – to watch for new marks by key competitors.

Each of these watch services can be tailored to specific companies or activities. For example, the application watch service can monitor new applications, or published marks, or new registrations, or all three, and in any defined market or country.

If you would like to look into this relatively inexpensive service, give us a call. Many consider such watch services a "must have" to protect brands and manage risk—similar to an "alarm system" against intellectual property theft.

Domain Names Are Registrable

As the internet has grown in recent years, the importance of proper selection and use of domain names has become apparent. With these activities, federal registration of domain names also has become important.

Not all domain names are registrable. For example, a domain name that is similar to another's popular brand name or mark may not be registered, and even its use on the internet may be stopped by the mark's rightful owner.

To be registrable, a domain name must be used as a mark, not just as a website identifier. It must be used in the way it is sought to be registered – for example, “Sneeze.com” used to identify a brand of facial tissues could be registered in that form but not just as “Sneeze.” The mark must be used on or in connection with a product or service, not just as a website title.

Also, when selecting a new domain name, a full trademark search should be conducted to make sure it is available to be registered. Then, as the new mark's program is coming together, we recommend filing an intent-to-use trademark application.

For these and other reasons, please keep us current with your new product or service development and marketing plans, so that we can help guide the program to strong marks with clearly enforceable rights.

Why Not Cheap Trademark Registrations?

There are a number of companies that today advertise to register your trademark for less than most trademark attorneys charge. Why not use one of them?

The simple answer is: you get what you pay for. We all know that.

To explain – cheap trademark registration companies rely on you to do everything. You have to know who should be the applicant, what the mark is and whether it should be presented in typed or stylized form, whether or not the mark has been used in commerce and if so what type of commerce, whether or not a right of priority should be claimed, what is an adequate specimen showing the mark, and what goods or services should be stated in the application, among many other things. You also have the option of selecting various types of searches, so you have to know which to use and why. All that and a fee of \$500 or more gets you an application filed with the PTO.

That's it. No subsequent help with calls from the PTO, or with either substantive or formal

rejections (or both) by a Trademark Attorney there, or with timely preparing and filing a response, or with inquiries, or with a lot of other things.

So if you are the kind of person who would who would prefer to fly the plane rather than use a pilot, then these do-it-all-yourself trademark registration services are for you. But if you fly commercial, then call us for intellectual property matters.

BEWARE: Intellectual Property Scams

If you've received official-looking forms requesting payment for “trademark registration” or “trademark monitoring,” you may be the target of IP scams. These notices are from official sounding entities such as the Trademark Protection Agency and Company for Publications and Information. The notices requests large fees to register or monitor your trademark and are targeted at trademark owners who have filed for federal registration of their mark in the U.S. Your trademark application is accessible from the government trademark database. Some solicitations for monitoring trademarks are legitimate, yet many are misleading if not fraudulent.

Similarly, beware of services by companies that offer to review, market, or submit your invention to manufacturers. These companies target small inventors and promise to market their inventions. Once they receive your money, to the tune of several thousands, you will be hard-pressed to hear from them again.

If you receive any of these types of notices or solicitations, please, check with us (no charge) before making any payment.

Announcements

The most recent update to my book *Trademark Registration Practice* was published by West Publishing in September 2007.

The current edition of my book *Practitioner's Trademark Manual of Examining Procedure* was published by West Publishing in August 2007.

Both are updated by me on a twice a year schedule.