

## MAINTAINING AND STRENGTHENING REGISTERED TRADEMARK RIGHTS

The following are some of the considerations which become relevant once a trademark registration issues.

### I. **REGISTRATION NOTICE**

We recommend providing notice of trademark registration, as failure to provide notice of registration can effect the award of damages in the trademark infringement context. Trademark notice need be made only once, in the first instance of trademark use, in any single publication and registered marks are preferably noticed with the symbol ® appearing in close proximity to the mark. In addition, a notice to the effect of "MARK is a registered trademark of Mark Industries, Inc. or its subsidiaries" should be provided somewhere, such as 1) the last page, of a publication in which marks appear; 2) in small type on product packaging; 3) at the bottom of an advertisement; or 4) on a "legal notices" page of a website. Please advise if we can be of assistance in reviewing registration notification.

### II. **TRADEMARK WATCH**

Registration notwithstanding, trademark rights are not absolute or static. Failing to police unauthorized use of identical or infringing marks can result in the dilution, circumscription, and even termination of valuable trademark rights. On the other hand, actively policing one's trademark rights can strengthen marks and increase their value. We employ the services of several vendors who provide numerous watch services that monitor different commercial arenas for marks of concern. There are services available that report: 1) publication of marks in US federal, state and/or foreign Trademark Offices, 2) registration of domain names, 3) business name recordation, 4) use of specific wording on the Internet in general and 5) use of specific wording on social networking cites like FACEBOOK and TWITTER. Please advise if you are interested in policing your trademark rights and we will help you design a suitable watch program that is tailored to the circumstances surrounding your mark.

### III. **RECORDATION WITH U.S. CUSTOMS & BORDER PROTECTION**

In addition to watching for unauthorized use and registration of a mark, the owner of a registered mark or trade name may record that mark or name with the U.S. Department of Homeland Security's U.S. Customs & Border Protection. USCBP then monitors imported goods in an effort to protect intellectual property that has been recorded with the department by excluding from entry, detaining, and/or seizing violative trademarked goods. Please advise if you are interested in recording your registered mark with USCBP and we can handle the recordation process and act as your liaison with USCBP in the event that relevant goods are seized.

### IV. **PROPER USE OF MARK REQUIRED**

Trademarks can be abandoned altogether if not used. Under U.S. law, nonuse of a mark for three years creates a presumption of abandonment. This presumption can be overcome, however, and as such, it is worthwhile to maintain evidence of any intent to resume use of a mark. For example, if a needed resource for a particular product becomes scarce and, as a result, the trademark for that product goes unused for three years, evidence of steps being taken to resume manufacture of the product and use of the mark could overcome the presumption of abandonment created by three years of nonuse. Please consult us if you intend to temporarily discontinue use of the mark so that we can advise you how to best protect trademark rights.

In addition to abandonment, misuse of a trademark can result in loss of rights. Basic rules of the proper use of a trademark must be followed to avoid loss of the mark:

| The Rule  | Wrong                      | Right                    |
|---|----------------------------|--------------------------|
| Use as an adjective modifying a generic term (noun) | Cars of MARK are           | MARK cars are            |
| Do not use in possessive form                       | MARK's medical research is | MARK medical research is |
| Do not use in plural form                           | The MARKs are              | MARK televisions are     |

| <b>The Rule</b>   | <b>Wrong</b>                   | <b>Right</b>                       |
|---|--------------------------------|------------------------------------|
| Do not use as a noun  | MARKs save plant owners        | MARK pumps save plant owners       |
| Do not punctuate between trademark and generic name of the product      | Get a MARK, the best bicycle   | Get the best, a MARK bicycle       |
| Always capitalize, Italicize, or otherwise Distinguish the mark In text | mark shampoo                   | MARK shampoo<br>or<br>Mark shampoo |
| Do not capitalize the Generic name or first Letter of product           | MARK Computers assist          | MARK computers assist              |
| Do not use a trademark To describe the products of others               | ABC's MARK ovens will not heat | ABC's ovens will not heat          |

These rules apply to all use of a mark, and not just use on products or in advertising. Please advise if we can be of assistance in reviewing the use of your marks.

V. **EVOLUTION OF MARK AND EXPANSION OF SCOPE OF GOODS/SERVICES**

Just as products and services change with the market, owners often modify their marks over time. When changes are made, it is important to consider the impact of those changes on existing trademark rights. If the change results in a different overall commercial impression, adoption of the changed mark could effectively abandon the old. The changed mark may warrant a new availability search and/or registration application, or in some cases existing registrations may be amended to reflect the change to the mark, depending upon whether the change is considered a "material alteration" of the original mark. Use of a mark in connection with new goods/services warrants similar consideration. Please advise us of any changes in the form of the mark or the goods/services used in connection therewith so that we may consider whether action is required in the form of a new application or an amendment to the mark in the current registration.

VI. **FOREIGN PROTECTION**

In many foreign countries one may register a trademark without prior use and the first to register a trademark is considered to be the official or recognized owner of a trademark. In this regard, some countries will register a mark based solely on registration of the same mark in the U.S. Please let us know if you are interested in exploring trademark protection outside of the U.S.

VII. **SECTIONS 8 AND 15 DECLARATION AND RENEWAL**

The subject registration will be effective for ten years if a Declaration of Continued Use (under Section 8 of the Trademark Act) is filed between the fifth and sixth anniversaries of registration. We have docketed the deadline and will endeavor to remind you of it as the date nears. Filing a Declaration of Continued Use will maintain the registration and allow it to continue in force for its full ten-year term. At the same time, it may also be appropriate to file a Declaration of Incontestability (under Section 15 of the Trademark Act), depending on the circumstances. An "incontestable" registration can only be challenged on a limited number of grounds. If the registration is kept alive by the filing of the required Declaration of Continued Use, then, at the end of its ten-year term, the registration may be renewed for another ten-year period if the mark is still in use. Again, we have docketed the deadline and will endeavor to remind you of it as the date nears. **To assist us in notifying you of these important dates, please let us know of any changes to your contact information.**