

Bringing Your Business Online: Protecting Your Brand

The current COVID-19 pandemic has forced many businesses online in order to survive. In many cases, businesses had no plans to be online. Others were forced to move online more quickly than planned. In order to assist these businesses, we have prepared a series of articles discussing some of the more important legal issues to address when moving your business online. [Website Terms](#) discusses online terms and conditions to protect your business. [Privacy Policy](#) discusses how your business collects, uses and discloses personal information of others. [Third Party Content](#) discusses the risks of copying photos, music, videos, and other content created by third parties onto your website. [E-Commerce Policies](#) discusses e-commerce policies that a website selling products or services should have in place. [Creating Enforceable Contracts](#) discusses the safest method to ensure that you can enforce your online terms and conditions protecting your business. [Written Information Security Programs \(WISPs\)](#) discusses several reasons why it is important for all businesses to prepare a WISP and to keep it updated.

Protecting Your Brand

The process of selecting and protecting a trademark in the United States consists of two steps. First, is the mark available to use without the risk of infringing the rights of others? Then, how do you protect the mark from being used by others? Each step is briefly discussed in further detail below.

Availability

When you move your business online, your brand becomes more visible. . Before investing substantial sums in promoting the brand, it is a prudent idea to conduct one or more trademark searches. These determine whether others are already using a mark, so you can avoid investing substantial sums in a mark in which you will not have strong trademark rights, or which you will have to change later. There are a number of ways to search, but the two most common are: (1) an online “screening search” of the mark submitted for registration to the U.S. Patent and Trademark Office (PTO); or (2) a broader search of the trademark records in addition to common law sources, databases, company name directories, trade publications, etc.

Because a search is not mandatory, it can be done before or after the applications are filed, or not at all, depending on your “risk-benefit” analysis. But it is always less expensive to undertake such a search than to have to rebrand and reprint physical marketing materials and reprogram websites and online marketing materials.

Protection/Registration

The most important marks or brands to protect vary from company to company. Typically, however, we recommend that the business protect the company name and logo, and any significant product or service brands, logos and tag lines.

Typically, rights in a trademark or brand in the United States are acquired by **use of the mark** on or in connection with providing goods or services in commerce, **not by registration**. If you choose not to apply to register a mark with the PTO, you can rely on common law trademark rights, but only to the extent the mark is actually being used, and then only in the area or areas where the goods or services are marketed or offered for sale. This is why there can be more than one company with the same or similar names in different parts of the country.

Thus, trademark registration in the U.S. is voluntary. However, owning a federal trademark registration provides several advantages, including:

- Notice to the entire nation of your claim of ownership of the mark;
- A legal presumption that you own the mark and you have the exclusive right to use the mark nationwide on or in connection with the goods or services listed in the registration (except against anyone else who is using the same or similar name before the registration), which reduces the amount of time and money you need to be spending in proving these issues in a legal dispute;
- The ability to use the U.S. registration as a basis to obtain registration in foreign countries;
- The ability to use the U.S. registration as a basis to object to the registration of confusingly similar domain names;
- The ability to use the U.S. registration to register the brand with the Amazon Brand Registry.

One thing to note is that registration of a mark provides the owner with **prospective** protection only. You may then enforce your rights against users who adopt the same or a similar mark after you do. However, even with a registration, you generally will be unable to stop a prior user of a similar name or mark.

The process with the United States Patent and Trademark Office (USPTO) typically takes 10-18 months until a mark is registered. For most organizations, this means that you should consider applying to protect only those marks of significant importance to the organization that are not “one-time” events or that are not going to change or be replaced frequently.

In many other countries, trademark rights are acquired by registration. This means that, if you are doing business or are considering doing business outside the United States in the future, you should consider applying to register the mark (at least in the most important countries). Otherwise, you could run into a situation where someone else has registered the mark and can prevent you from using the mark in that country.

If your business is only contemplating selling products or providing services locally, there is also the option of filing a trademark application at the state level. A state registration typically provides protection only within the geographic boundaries of a state. Filing for one or more state registrations is a cost-effective strategy sometimes for businesses just starting out that cannot afford the cost of a federal filing yet, or for businesses that are truly local in nature. One generally can apply to register a trademark in 2 or 3 states for about the same cost as a federal filing. After that, the nationwide advantages of obtaining a federal registration typically outweigh the cost disadvantages.

Until you actually receive a Certificate of Registration from the USPTO, you cannot use the registration symbol ® in connection with use of your mark in the United States. You can, however, use the designation ™ to inform the public of your claim of ownership. The ™ symbol has no legal significance but is commonly understood to mean that your company claims that symbol as a trademark. You can use this ™ symbol as soon as you start using the mark, even if you do not apply to register the mark at the state or federal level.

If your company would like assistance with selecting and protecting your trademarks, we would be happy to discuss your requirements and assist you. [Partridge Snow & Hahn](#) Partner [John Ottaviani](#) has over 25 years of experience bringing businesses online and can provide the guidance needed to make the transition as painless as possible. He can be reached at jottaviani@psh.com or 401-861-8253.

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