

Trademark Rearing — Life After U.S. Registration

Hey everyone, and welcome back to our video series where we break down trademark law so that you can make the best trademark choices.

Previously in this series, we've talked about the history of US trademarks and everything you need to get registered with the USPTO.

Today we're going to deal with what happens AFTER registration. You've finally got your trademark and you're ready to take your baby home; but just like with any child, your trademark will need a lot of TLC from this point on. So join us as we teach you how to be a responsible trademark "parent."

First off, you need to keep using your trademark. If you're unable to show proof of use for your trademark over three years, this will be used as evidence of abandonment. If you abandon your trademark, the USPTO will issue a non-use cancellation on your mark.

Depending on how old your trademark is, you'll also need to protect it cancellation. If your mark hasn't reached its 5th birthday, it can be revoked cancelled for any of the reasons it could have failed to register in the first place or if the continued use of your trademark will be damaging to an already existing trademark.

I know what you're thinking: if there are issues with my trademark then why on earth did the USPTO issue my registration at all? This just shows that in the busy, complex, thousands-filed world of US trademarking, things can get overlooked and there really are no guarantees. The best thing you can do is make sure your application is as solid as possible before filing.

Now, if your trademark has reached its 5th birthday, things are a little different in terms of what constitutes a cancellation. The grounds for cancellation are:

1. Your mark has become generic. Think about escalators and zippers--these were actually trademark names for those items but the trademark was lost once people started using these terms as the actual name for the product.
2. Your mark is functional. It just describes what your product does, like "window wipers."
3. Or, as discussed, your trademark has not been used for a long time.

There are other reasons too — such as your application was fraudulent, or your trademark is deceptive, immoral, or comprises of a name, etcetera. But we assume good faith on the part of our listeners, so most likely you would be dealing with the first three.

If there is an issue with your trademark, here's what will happen next: the other party will file an electronic petition for cancellation with the Trademark Trial and Appeal Board, the TTAB.

The petition must be signed by the petitioner or their legal representation. It must also outline the ways the petitioner's trademark will be damaged by your trademark and the grounds for cancellation.

The other party need only send you fair notice of their filing unless they are accusing you of fraud in which case they need to provide you with the particulars. You will have a chance to respond to the petition before the commencement of discovery, trial, rebuttal, and expert analysis.

Let's say the worst happens; your trademark has been cancelled, your baby has been ripped from your arms.

Wow, that was a depressing image. Snap out of it! There is something you can do! You can head straight to the US Court of Appeals for the Federal Circuit or a federal district court that has jurisdiction over both parties. Well, don't head *straight* there, there *is* a bit of procedure to follow, as usual.

In general, you have 60 days from the time of cancellation to appeal the decision. If you choose to appeal to the Federal Circuit, the other party has 20 days to file to have the decision re-examined by civil action. If you appeal via a new civil action, the court may decide that your trademark should not be cancelled. So there's always hope, people!

Remember, the best defense in this situation is to not have done anything wrong in the first place, so make sure you work with experts like Witmart when you file your trademark.

So you've done the changing and the burping and the pacing at 3 a.m. You've fed, cuddled, tucked in and soothed your trademark in its infancy. Now your trademark has developed their own personality and is doing so much more on their own. But then another disaster strikes: someone has infringed on your trademark and you're in a full on custody battle.

Next you have to move to protect your trademark. You need to head to the federal or state courts to file a suit for trademark infringement. You will need to prove:

1. That you are the bona fide holder of your trademark and therefore within the "zone of interest."
2. That the other party has been using the trademark in the sale, distribution, and advertising of goods and services
3. That their trademark can be confused with your own
4. And that this confusion/infringement is damaging to your business

If you are successful — and if your case is strong you will be — there are various compensations you can receive. The most common is injunctive relief, if your business has suffered a permanent injury that cannot be fixed with monetary compensation only. This will prevent the other party from continuing to use the infringing mark in business.

As for monetary relief, there are a few different kinds you can get depending on the particulars of your case. There's:

- Repayment of losses

- The profits made by the defendant using the infringing mark
- Court costs
- And corrective advertising

One thing you have to keep an eye on is timing. The Federal courts in the United States do not provide a specific statute of limitations for infringement cases but they will refer to state statutes of limitations.

If the court finds you guilty of laches, having delayed your lawsuit for an unreasonable amount of time, they may determine that this was an attempt by you to create prejudice against the defendant and you could lose the case.

Also on the subject of time, court proceedings tend to be long and drawn out affairs. It can take anywhere between 6 months and several years to reach a verdict.

In the meantime, you can protect yourself by filing for a preliminary injunction or, in urgent situations, a temporary restraining order. This will prevent the other party from conducting business under the trademark for the duration of the lawsuit.

Now let's put the shoe on the other foot for a minute and say that you are the one who has, according to the plaintiff, infringed on their trademark. There are a few defences available to you, including:

1. Laches — as we said, this is an unreasonable delay of the plaintiff in filing the lawsuit.
2. Unclean hands — this defense is used when you can prove that the plaintiff has acted inequitably or illegally during the case.
3. Fair use — You can claim classic fair use by saying the plaintiff's trademarks are merely functional and descriptive, or you can claim nominative fair use by asserting that you only used the trademark to advertise the plaintiff's goods and services and not your own.
4. Amendment Free Speech — while not a legal defense, this is a way to argue against likelihood of confusion if your products are meant as a parody or self-expression.

If you lose the case you can appeal, but if you really are in the wrong, it's unlikely they will reach a different decision. The best thing, of course, is to be extremely careful to avoid infringing on anyone else's marks.

Raising and taking care of your trademark is exhausting but also fulfilling and in your golden years you will reap the rewards when your trademark takes care of *you*.

Legal action is a nuanced subject and you will always have questions. For more information or for a free consultation, visit our website at tm.witmart.com, or give us a call at 1-877-948-6278.

