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**SMALL BUSINESS
SERVICES**

DID YOU KNOW?

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TRADEMARKS: THE POWER OF A NAME

By Jeffrey A. Travis, Esq.

In our last newsletter, we discussed patents. Patents, however, and despite their benefits, are an anomaly to our economic system by allowing a patent holder to prevent others from competing in a market by using the patented product. This is an inherently anti-competitive activity. Trademarks are just the opposite. Trademarks reward the mark owner for their active participation in a market. Whereas, a patent holder may obtain a patent but never use it, a trademark may only be granted if it is actually used in commerce, and regardless of the goods or services being sold. Also unlike patents, so long as you continue to use your mark, file your paperwork, and pay your fees every ten years, you may retain the sole and exclusive use of that mark in perpetuity.

This is what makes trademarks so powerful. Frankly, you can have the worst product on the market, but if you brand yourself correctly, you can be eminently successful. Having a bad product is not encouraged, of course, but plenty of examples abound.

As defined by the United States Patent and Trademark Office (USPTO), a trademark is a word, phrase, symbol or design, or a combination of words, phrases,

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Jeffrey A. Travis



Jeffrey A. Travis is an associate in the Bakersfield Office of BORTON PETRINI, LLP. Mr. Travis did his undergraduate work at St. John's College in Annapolis, Maryland where he studied the "great books" for four years, double-majoring in math and science, and western philosophy. He received his J.D. from Whittier Law School in 2003 and is also a registered patent attorney with the United States Patent and Trademark Office.

Jeffrey, among other things, has assisted many businesses and individual inventors in obtaining patent, trademark, and copyright protection. He has also been directly involved in prosecuting and defending litigation cases involving intellectual property, and other business-related matters. In addition, he also works closely with both small and large businesses in a variety of corporate matters.

Jeffrey's successful practice is enhanced by his past involvement as a volunteer for the Greater Bakersfield Legal Assistance, a presenter at Kern County Library's "Law Week," and has made numerous presentations and written articles on intellectual property topics.

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symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others. Thus, a mark is a business name, identifying symbol, or even distinctive packaging that consumers



immediately identify with a particular business. A red soda can with a stylistic twisted ribbon, for example, immediately brings to mind Coca Cola. Say these three words, "online auction company" and the mind instantly thinks of eBay. Neither one of these two marks was known before they were heavily marketed to the world. It is only because of their uniqueness and the efforts of the businesses behind them that the names alone are worth billions of dollars.

If you are starting a business, this is a lesson best learned early. I continue to be amazed how many times I am approached by those ready to start a business, have a name for their new company, and want a federal trademark. Usually, the name they have chosen is an exact descriptor of the goods or services they intend to sell. For example, a produce wholesaler names his company Produce USA. Unfortunately, trademarks will generally not be granted by the USPTO for names that are descriptive or generic names for what is being sold in commerce. To avoid this, choose a unique and arbitrary name.

eBay meant nothing before it was marketed as an online auction. Even a suggestive name will work. The mark "Timex" suggests a product related to time but, without the mark owner telling the consumer what they do, it is an unknown. Compare this, however, with choosing a generic name like Apple to sell computers. In this way, even a generic name can

become unique and arbitrary for a field far removed from the word itself.

All of the above heavily suggests that, like patents, a name should be chosen with great care and an expert trademark search should be performed to ensure the name you may believe is unique and arbitrary is not already being used by someone else. Doing so can save you hundreds of thousands of dollars in litigation fees.

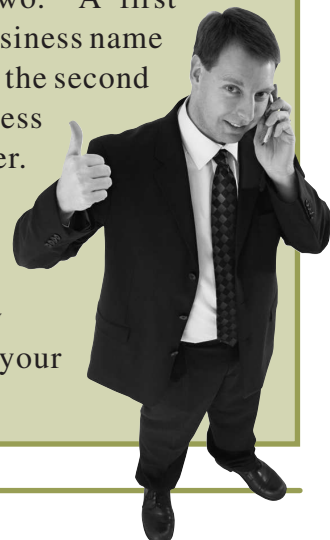
Nowadays, trademark protection extends from limited, local geographic regions to international protection. It is important to realize that simply using a name in commerce gives immediate birth to limited trademark protection in the locale where it is used, but only there. Beyond that, a mark holder can register it with a state to gain protection throughout the state. Registering a mark with the USPTO allows a mark holder to enforce the mark throughout the United States. And finally, international treaties now allow mark holders to more easily file in different countries for the broadest possible protection.

The caveat is that if you have a trademark, you must also be willing to enforce it. This rarely comes easily, or cheaply. Conversely, business owners must also be aware of their potential for infringing another's mark. This can result as easily as creating a new product with a new brand only to find that brand infringes another's mark.

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A RULE OF THUMB

When registering a domain name for your business, register at least two. A first registration should be your business name (e.g., BortonPetrini.com) and the second should be a descriptive business name (e.g., bakersfieldlawyer.com). The first will protect your protected trademark, the second will assist your online presence by driving internet searches to your website. ❖





small **business** services

By Jeffrey A. Travis, Esq.

We encourage you to check out the following local business services that can help you get started:

Weill Institute of Bakersfield College: (www.weill-sbdc.com).
Start your business wisely.

Lyles Center for Innovation and Entrepreneurship: (www.lylescenter.com).
Develop your business intelligently.

Anonymous, LLC (www.anonymousllc.com).
Market your business successfully.

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The essence of a trademark is consumer protection. To wit, trademark laws were originally created by the states and later the federal government to protect consumers from product confusion. If a mark confuses consumers as to a source of goods or services, there is a good chance there is trademark infringement. Of course, there are also numerous defenses which can prove powerful weapons to defend the alleged infringer in any trademark lawsuit.

At Borton Petrini, LLP, we can assist you in obtaining a trademark; advise you as to whether or not you need one; assist you in any potential or pending trademark litigation; and even provide an intellectual property audit of your business. With offices in Bakersfield and throughout California, Borton Petrini, LLP is ready to serve you. ❁

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Many businesses that currently advertise online could be using your trademark to drive businesses intended for your company to their website. To see if this is happening to you, type in your business name and see if a sponsored result listing appears.



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