

“Do I need to register the [trademarks](#) I use for my products or services?”

This question is asked by many business owners. However, chances are that your business has already acquired common law trademark rights in the names for its products or services. Does it make business sense for you to register the mark with the United States Patent and Trademark Office? As discussed here, there are often very real business reasons why you should apply for federal trademark registration.

## **COMMON LAW TRADEMARK RIGHTS**

Your common law rights in a trademark accrue once you begin to use it in connection with a product or service, so long as no one else was using the same or a confusingly similar mark prior to the time you began use of your mark. However, those common law rights only extend to the specific geographic area in which you are using your mark.

For example, if Company A is the first to use the mark VIKING in connection with a line of coffee beans sold in Southern California, Company A's common law rights will likely be sufficient to stop others from using the VIKING mark on similar coffee products. However, those common law rights will not be sufficient to stop Company B from selling VIKING-branded coffee products in Texas.

This means that if you have no intention to expand your business to other locales or to sell your products or services beyond your immediate geographic location, then federal registration is not necessary. Likewise, if you are not set on the name for your product or service, and are merely exploring product names, relying on your common law rights may be the right course of action.

But, if you intend to market and sell on the Internet or expand your sales beyond your immediate location, then a federal registration can save you the hassle and expense of costly lawsuits and possible rebranding.

## **BENEFITS OF A FEDERAL TRADEMARK REGISTRATION**

As you can see, common law rights can provide you with a reasonable level of protection. However, those common law rights do not approach the level of protection you can get from a federal registration.

Owning a federal trademark registration on the Principal Register provides a number of significant advantages over common law rights alone, including:

1. Registration serves as evidence that your mark is valid for the goods and services listed in the registration;
2. Conveys the exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;
3. The right to use the federal registration symbol “®” which gives your products additional marketing cachet;
4. Gives public notice of your claim of ownership of the mark and your priority of use dating back at least as early as the date of filing, which discourages others from using confusingly similar marks by making your mark easy to find in a trademark search;
5. Acts as a bar to registration by another of a confusingly similar mark;
6. Grants the right to sue others in federal court for infringement, and in certain cases, to obtain treble damages and attorneys’ fees for that infringement;
7. Entitles you to certain statutory damages if someone counterfeits your mark, which would relieve you of the burden of proving actual damages;
8. Provides a basis for obtaining registration in foreign countries, which gives you additional protections as your business expands;
9. Allows you the ability to record the U.S. Registration with U.S. Customs and Border Protection to block imports of foreign goods bearing infringing marks, which enables Customs to prevent infringement at no additional cost to you.

If you know you will be serving populations outside of your state (now or in the future), don’t delay federal trademark registration. Seeking federal registration early can save you future

## Do I Need to Register My Trademark? by Matt Barlow

headaches, as it will solidify your branding (or potentially help you determine at an early stage to rebrand to avoid another's similar mark).