



## 9 Common Mistakes Can Lead to Losing Your Company or Brand Names

Sometimes I feel like the sailor Ishmael on Captain Ahab's hunt for Moby Dick. Clients pursuing the perfect trademark can feel as tormented as Captain Ahab chasing the "White Whale" - and the process can be as brutal. Avoiding the issues below will ease the pain of the chase.

### 1. Your company/brand name is your family name.

Family names can be protected as trademarks only after they become well known and closely associated with a particular business (like "McDonald's"). Trademark law tries to create a balance between protecting family names that have become well known as brand names with protecting the ability of people to use their own name to go into business. Many companies are named after their founders, but you should be aware of the potential difficulty this can create in protecting your name.

### 2. Your company/brand name includes the name of the town/city/state where you work.

Geographic names are generally not protectable as trademarks because trademark law recognizes that companies should be able to advertise the name of the place where they operate. Some geographic names have particular significance (like "Vidalia onions" and "Washington apples") and can only be used for products originating from that territory.

### 3. Your company/brand name simply describes what you do.

Trademark law protects brand names that are distinct. If your brand name simply describes your product or your service then it is not considered distinct. Again, trademark law seeks a balance between protecting the trademark owner's ability to stop other people from using similar names and the ability of competing businesses to describe their goods or services.

### 4. Your company/brand name is generic.

Trademark law cannot be used to prohibit competitors from using generic terms for your goods or services. McDonald's can't stop Burger King from selling "hamburgers" (but they can stop them from selling "Big Macs").

### 5. Your company/brand name is already being used by someone else, and you don't know about it.

Trademark rights arise from using a brand name, and the first company to use the name has the strongest claim on trademark rights in the name. Even if you have been using the name for a long time, if someone has been using it longer than you somewhere in the country then they will be able to defeat your trademark registration application.

### 6. Your company/brand name is confusingly similar to a name that is already being used.

Even if your exact name has not already been used, your trademark application could be defeated if a confusingly similar name was already in use. Unlike patent law, trademark law protects against uses that are close enough to cause confusion. Under patent law even small changes can be enough to defeat infringement. The common adage should be revised to say "Close only counts in horseshoes, hand grenades and trademarks."

### 7. You didn't register your company/brand name as a federal trademark.

Registering your name as a federal trademark gives you nationwide priority. A federal registration gives you the presumption of nationwide senior rights in the mark. If anyone is going to attack your use they will have to overcome this presumption, which makes it much easier to expand into new territories. Probably the greatest benefit of being federally registered is that your name becomes easy to find and other people searching trademarks will avoid using it.

### 8. You think your name is registered because the state incorporated your company under that name.

Incorporating a business or forming an LLC does not give you trademark rights in that name. Many companies trade under names that are different from their legal names. Just having a legal name does not give you trademark rights in that name.

### 9. Somebody else is using a similar name and you don't tell them to stop.

Trademark rights can be lost or abandoned. Discontinuing a name will abandon your rights in the name. If you do not enforce your trademark rights against other people using similar names you could unintentionally abandon your trademark rights.

To discuss the scenario specific to your company or entity, please contact **Ian Titley** directly at 804-364-0405 or [idt@schrodlerfidlow.com](mailto:idt@schrodlerfidlow.com)