

You successfully registered your trademark. What's next?

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JUNE 21, 2016

You finally receive your Certificate of Registration from the U.S. Patent and Trademark Office (USPTO). So what's next?

Successfully **registering** your trademark on the USPTO's Principal Register is just the first step in protecting the value of your brand.

Federal registration confers many benefits on the **trademark** owner, but registration alone will not suffice in protecting your brand. By understanding and leveraging the benefits of trademark registration with the USPTO, trademark owners can add valuable weapons to their overall brand protection strategy.

Federal registration on the USPTO's Principal Register offers a variety of benefits for the trademark owner, including:

- Constructive notice to the public of your claim of ownership of the mark;
- The right to use the federal registration symbol "®" with the mark when used in connection with the designated goods or services;
- A legal presumption of ownership of the mark and the exclusive right to use the mark nationwide in connection with the designated goods and/or services;
- The ability to use the registration as the basis to obtain registration in other jurisdictions around the world;
- The ability to record the registered mark with U.S. Customs and Border Protection (CBP) to stop the importation of infringing or counterfeit goods into the U.S.;
- The right to bring an action in federal court for infringement of the mark;
- The ability to recover statutory damages, treble damages, attorneys' fees, and various other remedies for violations of the registered mark; and
- The possibility that the mark may become "incontestable" if certain requirements are met.

Trademark owners must maintain and renew their registrations as well as monitor and police potential infringers to maximize the benefits that come with a federal registration. To better

leverage the advantages of federal registration, trademark owners should heed these post-registration tips.

Use it or lose it

Rights in a federally registered trademark can last indefinitely if the owner (1) continues to use the mark in commerce in connection with the designated goods or services, and (2) timely files all necessary renewal documents with the USPTO. In general, to maintain a registration the owner must file a one-time Declaration of Continued Use, or Excusable Nonuse, and periodically file an Application for Renewal with the USPTO with the associated fees.

The first such filing and fee is required between the fifth and sixth years after the registration date. Subsequent renewal filings and fees are required between the ninth and tenth years after the registration date and every 10 years thereafter. Failure to timely file these post-registration documents will result in cancellation of the registration.

The key to punctual post-registration filings is continued use. If the owner stops using the **trademark** in connection with any or all of the designated goods or services, the owner risks abandonment of the mark, and certain filings may need to be made with the USPTO to preserve ownership and maintain registration of the mark.

Utilize the “®” symbol

After a mark is federally registered, the trademark owner should add the registered trademark symbol “®” to the mark whenever it is used in connection with the designated goods or services. The “®” symbol indicates that the mark is registered with the USPTO.

Use of the “®” symbol puts the public on notice that the mark is federally-registered and that the owner has exclusive nationwide rights in the mark. Consistent use of the “®” symbol with the mark creates awareness in the marketplace about the federal protection of the mark.

Creating awareness about the mark’s registration status is sometimes enough to deter a competitor or a would-be competitor from using a similar mark.

Don’t sleep on your rights

Trademark owners must be proactive with enforcement of their rights because the USPTO does not “police” the use of marks. While the USPTO attempts to ensure that no other party receives a registration for an identical or confusingly similar mark for related goods or services, the owner of the registered mark is responsible for asserting its rights to stop the use of an infringing mark.

Failure to police your trademark, or simply belated enforcement of your trademark rights, can result in limited or complete loss of your rights.

In addition, unauthorized use of a registered mark, or a highly similar mark, makes the registered mark less valuable – since it may not function as an indicator of the source of the owner’s goods and services – and might even damage the reputation of the owner’s business. Accordingly, after a trademark is registered, the owner must monitor for potential infringers.

Because vigilance is the only surefire way to head off potential infringers, trademark owners should consider implementing some of the following strategies to monitor for potential infringers:

- Conduct regular internet searches for the registered mark and similar marks using various search engines;
- Create Google Alerts for the registered mark and similar marks;
- Periodically search social media sites for content containing the registered mark;
- Test domain names containing the registered mark; and
- Hire an attorney or a professional service that will monitor activity at the USPTO and trademark offices around the world and notify the owner of any potentially infringing marks; some professional search services can also monitor for newly registered domain names incorporating the mark.

Upon discovering a potentially infringing mark, trademark owners must be prepared to enforce their rights. Trademark owners should consult with a trademark attorney to determine what enforcement strategy should be pursued under the circumstances of any potential infringement.

Customs official can help with enforcement

While the USPTO does not assist trademark owners with enforcement, U.S. Customs and Border Protection has the legal authority to do so with respect to the importation of infringing goods. CBP can detain, seize, examine, and destroy infringing goods.

For trademark owners to reap the benefit from CBP's enforcement assistance, they must record their federal trademark registration with the CBP. Once recorded, the registration information is posted in a national database available at all ports of entry.

CBP's enforcement policy focuses on protection of recorded rights, so recording your federally-registered trademarks increases the chances that CBP will intercept infringing goods.

Obtaining a federal trademark registration is only the first step in safeguarding your brand. Trademark owners should leverage the benefits of federal registration and implement a brand protection strategy using the tips outlined above to maintain their trademark rights, stop potential infringers, and enhance the value of their brand.

About the Author

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