



Trademark Selection and Protection
for Technology Companies

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Our Offices

801 California Street
Mountain View, CA 94041
Tel: 650.988.8500
Fax: 650.938.5200

555 California Street, 12th floor
San Francisco, CA 94111
Tel: 415.875.2300
Fax: 415.281.1350

1191 Second Avenue, 10th floor
Seattle, WA 98101
Phone: 206.389.4510
Fax: 206.389.4511

950 W. Bannock Street, Suite 850
Boise, ID 83702
Tel: 208.331.0700
Fax: 208.331.7723

For more information about Fenwick & West LLP, please visit our Web site at: www.fenwick.com.

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Introduction To Trademarks

Among a company's most valuable assets are the symbols by which that company and its products or services are known to the public. These intangible assets, often collectively referred to as "trademarks," are the company's badges of quality, expertise and reputation. When carefully selected and properly protected, these marks should optimize a company's advertising efforts, generating valued consumer recognition and increased sales. One need only think of LOTUS 1-2-3® software, APPLE® computers or HAYES® modems to appreciate the significant contribution a trademark can make to a company's sales efforts.

Trademark law is the law of protecting these symbols and more. In addition to providing protection for product and service names, state and federal trademark law (*i.e.*, 15 U.S.C. §1125(a)) also protects more generally against "unfair competition, such as false advertising, infringement of trade dress (the unique appearance of a product or service), and rights of publicity (also known as rights of celebrity).

Although trademarks are a form of "intellectual property," trademarks differ significantly from patents, which protect invention; copyrights, which protect expression of ideas; and trade secrets, which protect a company's confidential processes and other information. Trademarks are brand names of products or services; trademarks are not those products or services themselves, nor do trademarks protect the technology underlying such products or services.

Understanding trademark law begins with identifying the various types of "intellectual property" that typically fall within the scope of the umbrella term "trademark." A "trademark" is a word, name, symbol or device used to identify a company's products and to distinguish those products from the competition. A "service mark" is the same as a trademark except that it is used to identify and distinguish services rather than products. A "trade name" likewise is similar, but it identifies a company, rather than that company's individual products or services. However, the same symbol might function as all three - a trademark, a service mark and a trade name - depending on the context in which it is used. Finally, "trade dress" protects the unique appearance of a product or service under the same principles as applied to protection of trademarks and service marks.

This booklet will refer to trademarks and service marks generally as "trademarks" or "marks." For the most part, protection is the same for both symbols, except that slightly fewer countries grant protection to service marks.

The purpose of this booklet is to provide an overview of the principles of trademark law and protection, as well as to provide practical tips and answer some of the most commonly asked questions concerning securing and maintaining such protection in the U.S. and abroad.

Creating A Strong Trademark

The first principle of creating a strong trademark is to select a mark that is “distinctive.” The more distinctive it is, the more successful a trademark will be in performing its function of distinguishing your company’s products or services from the competition. Conversely, a mark that appears to be little more than a descriptive term commonly.

There is, however, an inherent tension between common marketing practices and the law in this area. Marketeers generally like to choose a name for a product that says exactly what the product is, thereby making the initial sales job easier. Unfortunately, the more a mark describes the product or characteristics of the product, the less protectable it will be legally. The long-term effect of adopting a descriptive name all too often is that the competition jumps on the bandwagon and adopts very similar names for competing products, a phenomenon against which the original user has little or no legal recourse given its initial decision to use a legally weak mark.

Therefore, in selecting a mark, attention should be given to what is known as the “spectrum of distinctiveness.” The four categories of distinctiveness in which a trademark might fall are arrayed along a spectrum from nondistinctive, legally unprotectable trademarks to highly distinctive, protectable marks. The four categories are generic, descriptive, suggestive, and arbitrary or fanciful.

Generic Terms

A generic mark is a misnomer: A generic term is incapable of functioning as a mark. Since the name of the actual goods and the generic term are the same, a generic term can never distinguish the products of one company from those of any other company providing the same goods. Trademarks that have been held to be generic include: RISCOMPUTER for a RISC-based computer, 386 for a microprocessor and COMPUTER LEARNING CENTER for computer classes. Although there is no legal prohibition against adopting a generic term as the name of one’s product, there is no value to be gained in doing so. The mark can never be distinctive of any one company’s products and therefore is not protectable in any way against use by others.

Descriptive Marks

Descriptive marks, the second category on the distinctiveness spectrum, are considered, to be nondistinctive in that these marks directly describe a product, its characteristics, elements or qualities. The law presumes that such descriptive phrases must be reserved for use by all competitors to describe their goods to the public. However, such descriptive terms are legally protectable upon a showing of acquired distinctiveness. Such acquired distinctiveness, known as “secondary meaning,” occurs when consumers associate the otherwise descriptive term with the goods of one particular supplier (though it may be anonymous) rather than with the category of goods generally. CONTINUOUS PROCESSING

for a computer and PERSONAL PUBLISHING for a magazine about desktop publishing are examples of marks that have been held to be descriptive and therefore not protectable. An example of a descriptive mark held protectable due to acquired distinctiveness is COMPUTERWORLD for a computer industry newspaper.

Laudatory terms (*i.e.*, BEST SOFTWARE), proper names and geographical designations used in connection with products that one would expect to be produced in that particular geographic location (*i.e.*, Tahoe for water) also fall under the rubric of descriptive marks. These marks are not protectable absent a showing of significant consumer recognition.

Suggestive Marks

Suggestive marks are considered inherently distinctive and therefore entitled to protection immediately upon use. A suggestive mark is one that requires the consumer to exercise imagination in order to determine the nature of the goods. A suggestive mark does not immediately describe the goods or their features, but may suggest or allude to the same. Examples of marks found to be suggestive include QUEST for hardware and software and HARDCARD for pc hard disk drive expansion kits. Not surprisingly, the line between descriptive and suggestive marks is not a bright one: Even the courts sometimes have difficulty determining whether a mark is descriptive and therefore not protectable, or actually suggestive and protectable against use by others.

Arbitrary/Fanciful Marks

Arbitrary or fanciful marks are inherently distinctive and considered to be the strongest marks in terms of legal protectability. An arbitrary mark is a word or term that is in common linguistic use but not in connection with the particular goods at issue. APPLE for computers is a good example of such a mark. Fanciful marks are coined terms, such as XEROX, or archaic terms that are not particularly well-known.

Determining Trademark Availability

Having identified one or more potential trademarks, it is important to attempt to “clear” the mark or marks for your company’s intended use. Nothing can be more frustrating and potentially financially disastrous than to launch a product only to find out that another party owns superior rights in the name of that product and is prepared to enforce those rights in court absent a name change. While this scenario is not absolutely avoidable, prior searching of the mark provides the greatest possible insurance against finding yourself in such a predicament.

In the United States, trademark rights arise as a result of use, not registration. Therefore, it is imperative that any search strategy include a review of unregistered trademarks as well as those that have been registered or may be pending for registration in the U.S. Patent and Trademark Office and/or in the various state trademark offices. Given the explosion of

commerce on the now omnipresent Internet and World Wide Web, it may also be advisable to consider Domain Name queries and similar investigations.

When international marketing is anticipated, it is also advisable to search a mark for availability, at least in key markets. Conducting a full search in every foreign country would likely be cost-prohibitive, but more limited, cost-effective search strategies can be developed to provide some assurance that significant problems should not crop up in major markets.

Establishing Trademark Rights

Once the decision is made to adopt a particular mark, trademark rights must be established before the company will be in a position to prevent others from using similar marks in connection with related goods. A company does not establish trademark rights simply by choosing a trademark or even by advertising the company's intent to use the trademark in the future in connection with the particular product. Likewise, use of the chosen mark as an advertising slogan only will not establish trademark rights.

Different criteria apply for establishment of trademark rights in the many jurisdictions around the world. However, in most jurisdictions, the notable exception of which is the U.S., trademark rights are established only by registration of the trademark with the appropriate authorities. Actual use of the mark is not required. In the U.S. and in British law countries, trademark rights arise to a greater or lesser extent upon use of a mark; however, registration remains important for attaining the greatest possible protection for the mark.

Trademark Rights in the United States

As indicated above, contrary to the law in most of the remainder of the world, trademark rights in the United States arise as a result of use, not registration. It is possible, however, to essentially reserve a trademark for future use, by filing an "intent-to-use" trademark application with the United States Patent and Trademark Office. Although the Trademark Office will not actually register the mark until the mark is used, once the registration issues, rights in the mark will date back to the date the "intent-to-use" application was filed. Using this procedure avoids the all too common dilemma of belatedly learning at the time of product launch that another company, which began using a conflicting mark after your company came up with the name but before it was actually used, has superior rights in the mark and can keep you from bringing your product to market.

If a company does not take advantage of the "intent-to-use" process for establishing trademark rights in the United States, it may establish rights solely on the basis of use. Once a company affixes a distinctive trademark to a product and ships that product in commerce in a genuine commercial transaction, the company begins to accrue rights in that trademark in connection with those products. The company need never register the trademark with

the state or federal authorities: So long as use of the mark was continuous, the company would still have protectable rights it could assert against another's use of a similar mark on similar goods. Whether application of a mark to beta shipments constitutes use sufficient to establish trademark rights depends on the specific nature of the shipments.

Though registration is not mandatory in the United States, registration does offer particular benefits to the trademark owner that enhance rights established on the basis of use. Registration provides nationwide notice of the trademark owner's rights, eliminating a "good faith junior user" infringement defense that the offending party was unaware of the trademark owner's prior use of the mark. The registration also provides the owner an evidentiary "leg up" in infringement litigation by creating a presumption of the trademark owner's rights: The trademark owner need not go to the expense and trouble of trying to convince the court of its ownership rights in the mark, as would be necessary if the mark was unregistered; instead, the burden falls on the defendant to try to establish that despite the registration, the complaining party actually has no protectable rights in the mark. These benefits make the registration a powerful tool in convincing others not to use infringing marks.

Trademark registrations are also invaluable in enforcing rights against counterfeiters. Once a trademark registration is recorded with the U.S. Customs Service, Customs will assist the trademark owner by seizing goods entering the country bearing infringing trademarks. Likewise, the penalties, including significant monetary damages, available to a trademark owner under The Trademark Counterfeiting Act, are only available if the trademark in question is registered.

All trademark applications are examined by the Trademark Office for registrability (distinctiveness as discussed above) and for similarity to existing registrations or applications. Once the application clears the examination process, it is published for opposition. Any member of the public who believes it will be injured by registration of the mark may oppose the registration. If no opposition is filed, the mark is registered.

The entire registration process takes at least six months and may take more than a year depending on the objections encountered during the examination and opposition period. The cost of obtaining a trademark registration is approximately \$700 - \$1200, again depending on the difficulties that arise. Given the significant benefits to be obtained, both offensive and defensive, registration usually is highly recommended.

Trademark Notices in the United States

Once a mark is federally registered, prominent uses of that mark should be followed by the trademark notice symbol, ®. The ® provides notice to the public that the mark is registered, making it somewhat easier to obtain monetary damages in an infringement action. Unregistered marks should be followed by the superscript TM for a trademark or SM for a

service mark. Although not legally required, use of the TM or SM will provide public notice of a company's trademark claims as well as assist in establishing rights in descriptive marks. Regardless of which trademark notice is the proper one, it need not appear every time the mark is used in printed materials so long as prominent uses of the mark are so noticed.

Proper Trademark Usage

Whether or not a mark is registered, it is important to use the mark properly to prevent it from becoming a generic or descriptive term and losing its proprietary significance. In addition to using proper trademark notices, care should be taken to use the mark as an adjective modifying a noun identifying the type of goods in question, such as "DISTELL® database management software." Use of the mark as a noun ("DISTELL will make data available in different formats"), as a verb ("You can DISTELL duplicate records") or in the possessive ("DISTELL's windowing system requires little memory") runs the risk of the mark being perceived as synonymous with database management software rather than as a brand name used by one vendor of that software. Once that line is crossed, the mark may be considered to be generic and available for use by all. Such was the fate of such familiar household "names" as ASPIRIN, SHREDDED WHEAT, THERMOS and CELLOPHANE. Once protectable marks, each of these was lost to the public domain by the neglect of its owner.

Trademark Rights Abroad

While trademark registration is advisable in the United States, it is essential in other countries. Registration in the United States does not confer ownership rights abroad.

Virtually every country has its own trademark registry and law, and application, and virtually most countries award trademark rights to the first to file a trademark application, not the first to use a mark in that country. A company that uses its trademarks overseas without completing the relatively inexpensive registration process (approximately \$1700 per mark per country) is courting disaster. This is particularly true in the licensing context: All too often the U.S. trademark owner who has not bothered registering finds that its former distributor has registered the mark in the territory in its own name and can prevent, or at least significantly impede, distribution of the U.S. company's goods in that country. Likewise, it may be impossible to collect royalties on existing licenses if the licensed mark is not registered and the license agreement recorded with the proper authorities.

Under the terms of the Paris Convention, of which the United States and most other developed countries are members, U.S. companies are entitled to a six-month priority period for filing in other member countries after filing an initial application to register the trademark. This grace period is designed to give the true owner of the mark time to complete its filing program ahead of "trademark pirates" who watch the registries and then try to register interesting or famous marks in other-jurisdictions.

Unfortunately, with only limited exception such as the Benelux countries, there is no central registry where the U.S. owner of a mark can simply file one application for protection overseas. However, beginning in early 1996 the EC Community trademark registration system goes into effect, making it possible to register a mark in all member states with a single filing. Currently, a U.S. company with a subsidiary or other significant presence in a country belonging to the Madrid Arrangement may make a single filing for protection in the twenty-four member countries (the United States is not a member country). Finally, a similar agreement covering additional countries, referred to as the Madrid Protocol, should be implemented in the near future; as the U.S. does not contemplate agreeing to the protocol as currently drafted, the protocol's benefit to U.S. trademark owners is limited.

The registration process varies from country to country. Some countries examine the mark for both distinctiveness and possible conflict with prior registrations, others consider only the question of distinctiveness and still others conduct virtually no examination of the application. Likewise, some jurisdictions allow members of the public to oppose registration of a mark that might conflict with existing rights, other countries do not. The entire registration process may take anywhere from only a matter of months in those countries without examination or opposition practice, to four years and more in some of the less developed and even some of the more developed countries (*i.e.*, Australia).

Trademark Notices Abroad

In most countries, trademark notices are not required. However, where such notices are required or suggested, the notices rarely take the form of the ®, ™ and ™ used in this country. Instead other forms of notice are common, such as “MR” for “Marca Registrada” used in many Spanish-speaking countries.

Trademark Infringement

The question of what constitutes trademark infringement arises with great frequency in managing a trademark portfolio. Whether it arises in the context of determining whether a proposed mark is available for use, whether to pursue an infringement claim against a competitor or how to respond to an infringement demand, it is important to assess the situation in light of the factors a court would consider in an infringement lawsuit. As the test for infringement varies from country to country (and even within jurisdictions), a survey of all applicable laws is beyond the scope of this booklet. The following discussion focuses on trademark infringement in the United States.

Likelihood of Confusion Test

The standard for determining whether infringement exists is known as the “likelihood of confusion” test. The test is not whether the allegedly infringing mark actually has caused or will cause confusion in the marketplace, but whether there is a “likelihood” that concurrent

use of the two trademarks in question will cause confusion as to the source, sponsorship or association of the goods on which the marks appear.

In assessing whether a likelihood of confusion exists, the courts consider several factors, no single one of which is necessarily determinative of infringement. It is not necessary that the marks be identical, that the goods be the same or that actual confusion has occurred. Each case is decided on its own unique set of facts.

Although the various state and federal courts may conduct the likelihood of confusion analysis somewhat differently, the following eight factors generally are considered by the courts:

Strength of Mark: The “distinctiveness” of the mark, discussed in part above, determines the scope of protection the trademark will be granted. The stronger the mark, the less similar the marks and the goods need be for a finding of infringement.

Similarity of Marks: The marks need not be identical, but will be compared in terms of sight, sound and meaning.

Similarity of Goods: The goods need not be identical. The more related the goods are, the more likely a court will consider a similar mark infringing.

Similarity of Marketing Channels: The greater the similarity between the marketing methods and channels used to distribute goods bearing similar marks, the greater the potential likelihood of confusion.

Sophistication of Purchasers: The more sophisticated the purchasers, the greater the degree of care exercised in the purchasing decision, the more similar the marks may be without a finding of likelihood of confusion.

Actual Confusion: Evidence that use of the two marks has already led to consumer confusion may be persuasive proof to a court that future confusion is likely. However, actual confusion may be difficult to prove: Courts often discount isolated instances of confusion as insubstantial.

Wrongful Intent: Most courts will presume a likelihood of confusion where it is shown that the infringing party deliberately intended to trade off of the goodwill associated with the other party’s mark by adopting a similar mark. Knowledge of the other party’s prior use, will not alone establish wrongful intent, so long as the allegedly infringing party believes in good faith that the marks/goods are distinguishable.

Likelihood of Expansion: Where the trademark owner intends to expand use of the mark into the alleged infringer's market or where consumers are likely to assume such expansion will occur, a finding of infringement is more likely.

Litigation

The vast majority of trademark disputes are settled short of litigation. Once a dispute arises, there are several alternatives to litigation: The alleged infringer may cease use of the mark, one party may buy out the other party's rights, the parties may enter into a consent agreement under which both can continue to use their marks in their respective markets or the matter may simply end in a standoff.

Nonetheless, many trademark disputes end up in the courts. Typically, these cases are resolved at the "preliminary injunction" stage, before trial, when the trademark owner asks the court to bar use of the allegedly infringing mark pending trial. To obtain the injunction, the trademark owner must demonstrate to the court's satisfaction that the trademark owner is likely to prevail at trial on the question of likelihood of confusion and that the trademark owner will suffer irreparable harm if the injunction is not granted. Given the intangible nature of trademarks, many courts will presume irreparable harm if the trademark owner makes a sufficient showing as to likelihood of confusion.

Injunction - an order barring continued use of the infringing mark - is the remedy commonly granted in infringement cases. Monetary damages and reimbursement for attorneys' fees generally are reserved for only the most egregious cases, such as counterfeiting and willful infringement.

Trademark Licensing

The 1980s heralded a veritable explosion in trademark licensing and merchandising. Everything from cartoon characters to restaurant logos, software names and celebrities' monikers have been licensed in connection with almost any imaginable goods and services. In this way, a trademark can take on a significance never anticipated at the time of its initial adoption for use in connection with specific goods: The trademark can be a direct source of capital generation.

Although U.S. law previously frowned on trademark licensing, that is no longer the case. Now, a trademark owner need never actually use a mark itself in order to acquire protectable rights, so long as whatever use is made is through an authorized licensee. It is critical, however, that the trademark owner exercise control over the quality of the goods with which the mark is used. Failure to exercise quality control may result in an abandonment, of the licensed trademark because the trademark will be considered to have lost its significance as a source and quality identifier.

Many trademark licenses today are the result of settlement of a trademark dispute between two unrelated companies. For example, it is common for the parties to agree that one will assign its rights in the disputed trademark to the other and then take a license back so that it may continue to use the mark, but it no longer claims ownership rights in the mark. The danger in such a situation is that both parties' rights in the mark are jeopardized if the trademark owner does not exercise a modicum of control over the licensee's activities in relation to the mark. While the control exercised need not be particularly intrusive, often any such oversight is unpalatable to one or both parties.

Trademark licenses should be recorded in writing, although an oral license may be enforceable. The agreement should specify the goods with which the mark may be used and any other use restrictions, the territory of such use, royalties, quality control provisions, termination provisions and the like. The licensee should be precluded from registering the mark in its own name or from taking any other action adverse to the licensor's ownership interest in the mark.

Just as each country has its own trademark law, each country also imposes its own requirements and restrictions on trademark licensing. Further, licensing in European Community countries carries with it additional problems with regard to enforcement of territorial restrictions. Many countries also require that trademark licenses be recorded with the trademark authorities to be effective against third parties and/ or for the trademark owner to be in a position to collect royalty payments. Accordingly, it is prudent to have all trademark licenses either drafted or reviewed-by trademark counsel prior to entering into such an agreement.

Trade Dress

In addition to trademark protection, federal trademark law provides relief more generally against false or misleading representations as to the source of goods or services. One important subset of this general unfair competition law is that of "trade dress" protection, protecting the visual appearance of products, product packaging, service establishments and the like. Historically, this theory of protection has been reserved for the unique appearance of product packaging. However, over the years the courts have extended protection beyond packaging to the look of a product as well as to the interior decoration of restaurants and other service establishments.

Trade dress protection covers the overall look or appearance of the goods in question, not isolated aspects of that look. To be protectable, trade dress must be 1) nonfunctional and 2) distinctive in the same manner as a trademark must be. In a case involving the interior decoration of competing Mexican restaurants, the United States Supreme Court recently decided that if the trade dress in question is inherently distinctive, it is not necessary to

demonstrate consumer recognition of that trade dress (“secondary meaning”) to satisfy the distinctiveness requirement of the test for protection.

Given the recent Supreme Court decision, trade dress protection is fast becoming a popular alternative to copyright law for seeking to protect the “look and feel” of computer programs. However, depending on the screen displays involved, the requirement that the trade dress be nonfunctional often proves a formidable stumbling block to obtaining protection under this theory.

False Advertising

Another aspect of unfair competition covered by federal law and the law of some states is false advertising. Under federal law, misrepresentations in advertising as to the nature, characteristics, qualities or origin of goods or services constitute false advertising.

To prevail on a false advertising claim, a party must show that the defendant made a false or misleading statement of fact that has the tendency to deceive a substantial part of the intended audience, that the deception likely will influence purchasing decisions and that the complaining party is likely to be injured as a result. Where false advertising can be demonstrated, courts are likely to award monetary damages and costs, in addition to injunctive relief.

Rights of Celebrity

A number of states have laws recognizing a celebrity’s right to prevent unauthorized use of his or her name, likeness and appearance. Although there is no federal law expressly acknowledging those rights, some courts have extended the general unfair competition provision of the trademark law barring misrepresentations as to source or origin to protect those rights against commercial exploitation by others.

As Bette Midler and Tom Waites recently proved in separate lawsuits, rights of celebrity even protect against unauthorized impersonation of a celebrity’s unique singing voice. Moreover, in many states, rights of celebrity survive the death of that celebrity. Care should be taken, therefore, to obtain permission before using the name, voice or likeness of any celebrity, whether living or deceased, in any product or promotional materials.

Trade Name Protection

Trade names or company names, like trademarks, are protectable against use of confusingly similar trade names or trademarks by others. Unlike trademarks, however, the United States has no central registry for recordation of trade names. In order to register a trade name on the trademark registry, it must be used as a trademark, as a symbol indicating the source of particular goods rather than as the name of a company. Often, the deciding factor as to whether a company name is being used as a trademark or as a trade name on packaging is whether the name is accompanied by the company's address. If so, it is an unregistrable trade name use; if not, it may be a registrable trademark use.

Trade name protection parallels trademark protection. The likelihood of confusion standard applies regardless of whether the names at issue are two trademarks, two trade names or one of each. When adopting a company name, therefore, it is important to perform a more global search of prior rights than simply checking the corporate names registry in the state of incorporation. We usually recommend a full trademark search be conducted before a company name is adopted.

Cyberspace

Commercialization of the Internet and World Wide Web has brought to the fore numerous issues concerning trademark protection in cyberspace. In addition to trademark or trade name infringement claims based on use of a deliberately co-opted or a confusingly similar Domain Name, questions of priority of use, and what constitutes use sufficient to establish trademark rights are becoming legion. The courts are only now beginning to address these issues, which may ultimately require a reformulation of traditional legal principles in step with the realities of an ever growing cyberspace marketplace.

Our Services

Fenwick & West provides a full range of trademark and trademark-related services to the firm's clients. We provide detailed counseling regarding the availability, and use and registration of trademarks at home and abroad, and prosecute hundreds of trademark applications each year for domestic and international clients of all sizes. In addition to assisting clients in designing individualized trademark protection strategies, we manage and coordinate extensive international trademark portfolios, provide licensing and customs recordation counseling and negotiate consent agreements where appropriate.

We have a broad base of experience in trademark/trade name dispute resolution. We handle infringement litigation in the courts, prosecute and defend oppositions and cancellation proceedings in the U.S. Patent and Trademark Office, and supervise similar proceedings overseas. The firm also provides counseling and handles litigation in the related areas of unfair competition, false advertising and trade dress infringement.

Our trademark practice is fully integrated with the other practice areas of the firm, most notably those involving copyright and patent, litigation and general corporate matters. Since Fenwick & West is a full service law firm, our attorneys have a somewhat broader perspective than attorneys from firms with more limited practices. For example, we have substantial experience providing advice and counseling on the maintenance of trademark rights in corporate mergers and acquisitions.

Fenwick & West also performs "audits" of companies' intellectual property. Such audits may range from a limited review of an existing trademark portfolio to a comprehensive investigation of all forms of intellectual property available for the client's technology. Clients who are considering investments in or acquisitions of other companies often request Fenwick & West attorneys to perform an intellectual property audit of the target company to help them assess the true ownership and worth of the target company's intangible assets. Other clients periodically request audits of their own intellectual property, especially where they have not had a well-defined, established policy of seeking such protection.

