

Top Ten Reasons Why US Trademark Searches are Important to Every Business

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As we ring in the new year, we thought we would remind everyone why the importance of a comprehensive trademark search for a new company name and for a new trademark cannot be overstated:

1. Any word in any language can function as a trademark depending on how it is used.
2. Every business has at least one company name, trade name, brand name, logo, or slogan it uses to advertise its goods or services, making it vulnerable to a claim of infringement if the use has not been cleared properly.
3. A Secretary of State's clearance and registration of a name for a corporation or other business entity is NOT a defense to a claim of trademark infringement.
4. Unlike copyright infringement, trademark infringement can be innocent. Prior knowledge of a preexisting trademark is not required for infringement liability to exist.
5. Domain names alone do not create trademark or similar protected rights, but can violate trademark rights.
6. Marks do not need to be identical or used competitively in order to be infringing.
7. Famous marks and names should never be used even for completely unrelated purposes.
8. Unregistered common law marks are valid and fully enforceable in the United States.
9. There is no such thing as international or worldwide trademark rights. Trademark rights exist on a country-by-country basis. In most countries, the first to file a trademark application and obtain a registration owns the rights in that country. Use without registration is irrelevant. Foreign rights should be searched and/or applied for before any public announcements of expansion plans.
10. Trademarks are a use-it-or-lose-it asset. Unlike patents and copyrights, trademarks can exist forever if they are being used. Intent-to-use applications can be filed for trademarks for which there are plans underway but which may not be placed into actual use for, at least, four years.

A thorough trademark search is one of the best investments a company can make in a new endeavor. No one wants to invest time, money, and effort in a new name or mark only to find out later that all is lost, including the initial goodwill and reputation developed under that new name and mark. So do not simply choose a new name or mark wisely, also search it well.

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Susan Neuberger Weller manages the Trademark & Copyright Practice at Mintz. Susan assists clients with securing and protecting IP assets across the globe. She's worked with clients in a variety of industries, including pharmaceuticals, medical devices, software, electronics, and entertainment.

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