

Make Your Mark in the World with a Great Brand!

By David Roy Ellis and Sharon R. Ellis



*Who steals my purse steals trash,
But he that filches from me my good name
Robs me of that which not enriches him,
And makes me poor indeed.*

– Shakespeare's *Othello*. Act III, Scene 3

Although Shakespeare never updated his Facebook profile while sitting at Starbucks in his Nike shoes or ordered an iPhone on Amazon while sipping a Coke, he did know the value of a good name. Today, a good name, embodied in a distinctive brand for a company's product or service, can be worth billions of dollars by providing instant name recognition and assurances of quality and uniformity to consumers throughout the world.

When a business selects a new brand name for its product or service, it can secure the right to prevent others from using the same or similar mark in a manner that could confuse, deceive or mislead the public by obtaining a federal or state trademark registration.

If a trademark is used in interstate commerce, the owner may register it with the U.S. Patent and Trademark Office (USPTO) in Washington. A federal trademark is good for ten years and may be renewed every ten years thereafter as long as it is used. The owner of a trademark has the exclusive right to prevent others from using the mark in a way that could confuse consumers and to sue infringers in federal or state court.

If a company is selling its goods or services only in Florida, it may register the trademark with the Department of State under Florida Statutes Chapter 495. A Florida registration is good for five years and is renewable for additional terms of five years.

A business often has to decide whether to register its mark federally with the USPTO or just in Florida. While a state application costs less and takes less time to be approved, there are benefits for a business to register at the federal level. Because of the Supremacy Clause, a federal registration will preempt a state registration even when there is a conflict between the two.

Before adopting a trademark and applying to register it on the state or federal level, the records of the USPTO and other databases should be searched to make sure there are no prior registrations or pending applications for the same

or similar mark for similar goods or services. The search should examine the word portion of the mark, the class and description of the goods or services, and if there is a design element, the design code in order to eliminate the likelihood of conflict with another's prior mark.

Although individuals and businesses can apply on their own, it is recommended that an experienced trademark attorney be retained to prepare, file, and prosecute a federal trademark application. It can take a year or more for the USPTO to issue the registration.

After a trademark is registered, the owner can sue anyone who infringes it. Infringement is the unauthorized use of the trademark on goods, services or advertising which is likely to cause confusion or mistake or to deceive consumers as to the true source of the goods or services.

In addition, both the federal and state trademark statutes protect a trademark owner against the "dilution" of a distinctive trademark, where the use might blur, tarnish or whittle away the mark's distinctiveness. Trademark dilution is different from trademark infringement, which occurs when a subsequent user adopts the same or similar trademark on competing or closely related goods, so that consumers are likely to be confused as to the source of the goods. Trademark dilution can occur when a famous trademark is used by another on non-competing goods even when there is no likelihood of confusion between the uses of the marks.

In a case of either trademark infringement or dilution, the court may order the violator to cease its unauthorized use of the trademark. In an infringement case, the court can also order all infringing products destroyed and award money damages to the trademark owner, which can sometimes be trebled. The court may also order the infringer to pay the trademark owner all profits derived from the wrongful use, plus court costs.

In federal infringement cases, the court may also award attorney's fees in "exceptional cases." Under the Florida statute, the court may award attorney's fees without a showing that the case is exceptional. Thus trademark owners may want to register their marks under state law in addition to registering under the federal act. Another advantage of registering in Florida is that a registration can be obtained quickly, typically in a week or two, compared to the 9 - 12 months or more that it may take to secure a federal registration.

Copyright © 2016 David R. Ellis and Sharon R. Ellis All rights reserved

David R. Ellis is a Largo attorney practicing trademarks, copyrights, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and Board Certified in Intellectual Property Law by the Florida Bar. He is the author of the book, *A Computer Law Primer*, and has taught Intellectual Property and Computer Law as an Adjunct Professor at the law schools of the University of Florida and Stetson University. He can be reached at 727-531-1111 and ellislaw@alum.mit.edu. For more information, see www.davidellislaw.com.

Sharon R. Ellis is a Florida licensed attorney and a commercial real estate professional in Miami. She practices intellectual property law and handles cases with her attorney father where she advises business on their trademark and intellectual property related matters. She also works in commercial real estate as a tenant representative where she represents law firms and businesses in lease negotiations for office, retail, and industrial space and handles lease renewals and relocations, as well as investment sales. She can be reached at 305-962-9452 and sharonellispalmer@gmail.com.



Executive Reporting Service®

JUST ARRIVED

Your New Favorite DEPOSITION DESTINATION

Introducing **Executive Reporting Service's** Newest Location:

**Sun Bank Building
300 1st Ave South, Suite 402
St. Petersburg, FL**

**Prestigious, full-service executive conference suites –
Designed with your every possible need in mind.**

- Impeccable, comprehensive support
- State-of-the-art technology
- Litigation specialists
- High caliber court reporting

CALL TODAY TO ARRANGE A TOUR!

727-823-4155

YOUR DEPOSITION DESTINATION®

ExecutiveReporting.com

You Care.

We Care.

For over 15 years, we have provided practical care solutions for Older or Disabled Persons & their families.

Aging Wisely Professional Care Management and EasyLiving Home Care are here to help your clients with their home care needs in the Tampa Bay area.

Whether the need is to help caregivers navigate an increasingly complex system of elder care or provide private home health care, we are available 24/7 to help.

We can arrange on-site free consultations at your office. Contact us to learn more at

727.447.5845

Aging Wisely
Professional Care Management and Patient Advocacy

www.agingwisely.com

EASYLIVING™ INC.
HHA#299992282

www.easylivingfl.com

