

## FIVE FATAL TRADEMARK MISTAKES

By Elias Borges

Your trademark represents you, your company and your reputation in the market. As a result, your trademark may be your most important asset. By avoiding the following mistakes, you can help protect the value of that asset.

1. **Failing To Conduct a Trademark Search:** All of the time and money invested in a new trademark may be wasted if you receive a cease and desist letter from a lawyer after you introduce your trademark. A thorough trademark search is the only way to protect yourself. Don't limit the search to a simple Nuans or register search - insist on a full common law search in order to minimize your risk.
2. **Failing to Register:** A trademark that is not enforceable is of little value. Non registered trademarks can only be enforced if the trademark has become famous - which requires years of use. In contrast, a registered trademark does not have to be famous to be enforceable. In fact, a registered trademark is generally much stronger than a famous but non-registered trademark. Given the relatively modest costs of registering a trademark, the strong protection granted by a trademark registration is a bargain.
3. **Adopting a Weak Trademark:** If your going to invest a lot of time and money into a trademark, it only makes sense to select a trademark which is as inherently strong as possible. Avoid incorporating generic or descriptive terms into a trade mark (e.g. Enviro, Micro, Super, Gold, Maximum, Tron, Canadian, etc.). A trademark which is too generic or descriptive cannot be registered. Also, the more generic a trademark, the weaker the registration will be (assuming it can be registered at all). Try to pick a trademark which is as distinctive as possible. See the document *Selecting a Trademark* for some useful information on how to choose a good trademark.
4. **Changing a Trademark:** Changing a trademark may render the trademark registration void and the trademark unenforceable. The change does not have to be great. Simply adding a word may be enough; for example, "VOLCANO" and "VOLCANO HOT" are two separate trademarks. Likewise, a chubby snowman in a hat and a thin snowman in the same type of hat are two different trademarks. Changing a trademark in this way can result in voiding any registrations for the older trademark (assuming the old trademark is no longer used). If its necessary to change a trademark, then make sure to apply for a registered trademark for the new mark before giving up the old mark.
5. **United States Trademarks:** If there is a possibility that you may enter the United States market (or if you have competitors from the United States), then consider a United States trademark search. The search may reveal potential conflicts, which if caught early, can be avoided.