

When to Fold and When to Hold

The Strategy Behind Sending a Cease and Desist Letter

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When should a Trademark owner send a cease & desist letter to a possible infringer?

Federal registration of a trademark is not mandatory. However, there are several advantages to obtaining a federal registration. Some advantages include notice to the public of the claim of ownership of the mark, legal presumption of ownership nationwide, and exclusive right to use the mark on or in connection with the goods/services listed in the registration.

When a trademark application is filed by an applicant, the United States Patent and Trademark Office (USPTO) Trademark Examining Attorneys search the federal database to determine if marks exist that are likely to cause confusion as to the source of the mark. In other words, the Examining Attorneys are determining if marks exist that are the same or similar to the applicant's mark and if the marks are used on similar products or related services. If there are confusing marks in the database, the applicant will receive an office action. The Applicant must show that likelihood of confusion does not exist. If the applicant can overcome the rejection and there are no other outstanding rejections or objections, the mark will be published in the Official Gazette. If a third party does not challenge the mark, the trademark will register. Once the trademark registers, it is up to the owner of the mark to monitor their mark and enforce

the federal registration against infringers. The decision to pursue enforcing the federal trademark should not be made without considering the consequences. The trademark owner must decide to fold or to hold. The owner must decide the best method to enforce his federal registration. As a cost effective method of enforcing federal trademark rights, many trademark owners send the infringer a cease and desist letter. A cease and desist letter informs the infringer of the trademark owner's rights, describes the infringement and sets forth legal claims. Most importantly, the letter request that the infringer stop using the confusingly similar mark. A cease and desist letter serves as actual notice of the owner's rights and if ignored, the infringer may be liable for intentional infringement.

Prior to sending a cease and desist letter, the trademark owner should seek the help of a trademark attorney to determine if the alleged infringing mark is likely to cause confusion. For example, multiple companies can have the same name provided consumers would not be confused as to the source of the services. Also, similar terms in the alleged infringer's mark do not guarantee infringement. Trademark owners cannot enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to them.

Many trademark owners make the mistake of sending a cease and desist letter without conducting a proper investigation. If the accused infringer's rights supersede the trademark owner's rights, the accused infringer may be able to cancel the registered trademark. If it is determined that the infringer is at fault, the trademark owner should research the infringer to determine if a cease and desist letter

should be sent. A phone call to the infringer can result in the infringer ceasing use of the mark. The phone call can also start necessary dialog with the infringer to learn more about their use of the mark and future uses of the mark and establish boundaries, if necessary. Researching the infringer can also help to determine the tone of the letter. A letter to an infringer that is clearly intentionally using the registered mark may be written harsher, since there is likely no room for negotiation. A gentler tone letter may be written to an infringer where it appears they are not using the mark but intending to use the mark.

Although the trademark owner can challenge an infringer for use of the registered mark on similar goods or related services, it is recommended to seek the assistance of a trademark attorney to determine the most effective method to enforce the trademark owner's rights and to determine if sending a cease and desist letter is a viable option.

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