

# What's in a Name? Trademarks and Construction

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Every company, no matter the industry, relies on its name and reputation to develop customers and generate revenue. Think about the brands that dominate American culture such as Nike, Wal-Mart, Amazon, or McDonald's, then imagine those businesses without the ability to adequately protect their names, slogans, and logos. No doubt the vultures would circle and brand power would most likely become short lived or otherwise diluted to the point of non-existence. The construction industry is not exempt, and the industry leaders benefit from identifiable names and logos, built over years of reputation and brand building. While the tools necessary to protect your company's brand exist at the state and federal level, many business owners or leaders are unfamiliar with the trademark process and unaware of the consequences of not utilizing those tools.

## TRADEMARK REGISTRATION

Trademarks are "concise and unequivocal identifiers" that provide potential customers with essential information about your business. With a single word, tagline, logo, color - essentially anything that can carry meaning - potential customers learn to associate particular product or service characteristics and expected quality level with a particular source. That is, your mark is the way that consumers connect your expertise and reputation to your business and nobody else's. It serves a critical role in reducing consumer search costs and capturing your hard-earned business opportunities.

A trademark registration is the most effective way to secure your investment in your name and the reputation it symbolizes. It is the only filing that confers legal rights and benefits of trademark ownership. The formation of a company under a certain name, registration to do business with a secretary of state, filing of an assumed name certificate, registration of a domain name, and the



like do not create exclusive rights in a name or mark. In fact, your registered company name or assumed name or domain name could actually infringe another party's trademark rights.

## FEDERAL REGISTRATION PROCESS

A trademark can be registered at the state or federal level. A federal filing in the United States Patent and Trademark Office (USPTO) is preferred because of its nationwide reach, but a state registration with the secretary of state may confer some of the same benefits within that state. In the USPTO, the process is as follows:

1. An application is filed for a mark that is already in use or a mark that you plan to use in the future (called an intent-to-use or ITU application), which is a nice mechanism to secure your claim while you are ramping up the launch of the new mark.
2. The application undergoes a substantive examination, in which the examiner looks for any substantive or technical bases for

refusing the application. If there are issues to be addressed, you have an opportunity to respond.

3. When all issues are resolved, the application is approved for publication, which is a 30-day period in which third parties may come forward with any objection to the application.
4. If nobody comes forward, a use-based application will proceed to registration and an ITU application will receive a notice of allowance. An ITU application will not mature to registration until the applicant files a document notifying the USPTO that it has begun using the mark. This statement of use may be filed up to three years after the notice of allowance is issued. When the statement of use is filed, the registration will issue.

Regardless of how long the process takes, all rights and priorities arising from an issued registration will date back to the filing date of the application.

## **BENEFITS OF REGISTRATION**

When a trademark registration issues, it provides significant evidentiary advantages in the registrant's favor, including prima facie evidence of the validity of the mark and of the registrant's ownership and exclusive right to use the mark, either throughout the entire United States or potentially throughout a particular state, depending upon where you filed. Validity, ownership, and exclusive right to use are essential elements for any effort to stop an infringement of your mark. A registration establishes them from the outset. Without a registration, you will be required to prove each element individually with specific evidence, which is much more difficult, costly, and uncertain.

Your trademark registration will block others from registering the same or similar mark for the same or related goods and services. For parties who conduct clearance searches before adopting new marks, your registration would likely discourage them from picking

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