

Make 2024 a “Brand” New Year by Lisa Holubar and Victoria Hanson

We are through the first month of 2024, and if you are anything like us, you are already questioning the overly ambitious nature of your personal New Year’s resolutions. What seemed doable in the wee hours of December 31st – Eat 60 grams of lean protein a day! Stop eating processed sugar! Keep a gratitude journal! – seems a bit more daunting in the grey light of a ceaseless Chicago slush storm. But hope springs eternal, and if we can’t quite step away from the cinnamon rolls, we can hopefully aid you in getting your trademarks in shape this year. Here are our top ten reminders for trademark owners as we move into 2024:

1. **Know Your Marks, Past and Present:** Do you maintain a single record of all company trademarks, or do you have to click through multiple files in various locations to review your trademark portfolio? Hopefully, not the latter, but regardless, it is a good idea to keep a summary of your trademarks and to audit your products and services at the start of each year to understand the marks your business is no longer using as well as the marks it is using and does want to protect both in the United States and abroad. Depending on the size of your trademark portfolio, this can be a simple bullet point list, or it might require a spreadsheet with multiple tabs. The record should note which of the marks are registered or pending, the goods/services the mark is used in connection with, and any other pertinent information. Trademark counsel can maintain this record with or for you.
2. **Licenses:** If you are a party to any licenses, as either the licensor or the licensee, hopefully you maintain a record of them similar to the record of all company trademarks. If not, it is time to create that record, and it should include the renewal or end dates for each license as well as royalty rates and due dates. If you are the licensor, you should also have counsel perform a quality control check of the terms of the license to avoid claims of naked licensing that may result in an abandonment of your rights.
3. **Accuracy at the United States Patent and Trademark Office:** Did your company recently reorganize? Did it transition from an LLP or an LLC or incorporate in a different state? Make sure to double check that the United States Patent and Trademark Office (USPTO) lists the correct owner of your marks. You may need to file assignments to keep the chain of title correct. Similarly, did you hire a new prosecution attorney? Make sure the correct attorney of record is on file with the USPTO.
4. **Brand Drift:** Once you have assembled or reviewed/revised your 2024 list of trademarks, it is time to hit the internet and see if your current marks are actually what you think they are. What does this mean? Sometimes your marketing team or web designer might alter your logo or shorten your trademark. Although minor variations of trademarks can “tack” onto prior versions for continued protection, changes that are more than minor might require new trademark applications altogether and may result in an abandonment of your old mark. For example, a mark owner abandoned the mark “Americana” by only using “Americana at Manhasset, and another mark owner could not

tack  onto  as the revised mark was too different.

5. **Ad Words and Other Infringers:** While you are online, check for infringers. If you search your trademarks online, what results do you get? Has anyone started using your

marks without permission in their ad text? Has someone started to use your mark without permission on their own or on a third-party website? Consider hiring a trademark search company to search your key marks or even to implement a monthly or quarterly watch service that will search your key marks and locate infringers. Budget is obviously a consideration here, and it may be that your key marks are the ones to search with a third party, while other marks can be searched in-house. Note that social media platforms should be included in any search for infringers.

6. **Cybersquatters:** If you do conduct a third-party search or initiate a watch notice, you will learn if anyone has registered your marks as domain names. There are more than 1500 top level domains, and it would be too costly to search them all, but even without a third-party search company, the most common top level domains should be checked. If they are available, register them. If they are not, and someone else has them, consider whether you can bring a Uniform Domain Name Dispute Resolution (UDRP), which is a relatively quick and inexpensive way to enforce and protect your brand by initiating an action to cancel, suspend, or transfer an infringing domain name.
7. **Third Party Protections:** If you sell products online and have a pending or registered trademark for your business, register that trademark with the Amazon brand registry. Having your trademark registered with Amazon allows Amazon to identify and stop infringing listings on its platform. If counterfeiting is an issue in your industry, register your marks with the U.S. Customs and Border Protection (CBP). Recording your trademark with CBP permits CBP to detain and seize imported goods if they appear to violate the recorded trademark.
8. **Marks On the Horizon:** Chances are, your marketing department has ideas for 2024, and those ideas likely include new trademarks or twists on current trademarks. Schedule a meeting with the marketing team to see what they have in the works. Get involved sooner rather than later in the process of brand selection, conduct searches to confirm the name or something similar is not being used by others, and avoid infringing prior users. Consider whether to file Intent to Use (ITU) applications and whether any nontraditional trademarks (color, sound, trade dress) may warrant protection too.
9. **Trademarks 101:** It is a good idea to hold a yearly “Trademarks 101” session with your marketing department to educate them on trademark best practices. This session should cover everything from what a trademark is, to when to use a ® or a ™ symbol, to whether and when you can mention another company’s trademark in ads or online.
10. **Brand Guidelines:** Similarly, the start of the new year is a good time to review (or draft for the first time) your brand guidelines. Make sure to include links to the company’s approved logos, colors, sizing, font, and instructions as to how to use a mark properly and consistently. Brand guidelines will be covered in your Trademarks 101, but having the guidelines accessible throughout the year is important as well.

Irwin IP trademark attorneys are here to help you protect your marks. Please contact us if you have any questions about or need help making 2024 a “Brand” New Year.