Trademark Watching Service
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Your company’s trademark portfolio and company name are significant assets that build brand equity in your trading area and beyond. Businesses large and small must take steps necessary to protect and grow their brands. Implementing a trademark watching program is a cost-effective and powerful way to maintain brand strength and develop brand equity while monitoring the bottom line. Whether your company owns one trademark registration or application or hundreds, or merely relies on common law rights in a trademark or trade (corporate) name, subscribing to a trademark watching service can help to protect your brands against dilution and infringement.

Wiley Rein is pleased to introduce a trademark watching service that will assist in protecting and enforcing your valuable trademarks and company names. Our capabilities and qualifications for the service are detailed briefly below, and we welcome the opportunity to further discuss your company’s needs in this area.

Reasons to Watch

Systematic monitoring of trademark filings, business name filings and/or Internet usage provides information about potential infringement and dilution of your valuable brands. It is important to be proactive in protecting trademark assets because failure to oppose potentially conflicting marks may have significant business consequences—such as the inability to register your company’s marks or names, blocking out of new product lines or territories for expansion, and limiting enforcement of your mark against any but exact copies. A client’s recent plight illustrates the importance of diligently watching your marks: Having failed to register or watch its trade name, the company expanded into a new service area and suddenly found that it faced enforcement action from another company that had started using and had registered nearly the exact same name for its related services. This could have been avoided had the client watched its company name and taken immediate enforcement action to stave off a conflict.

Monitoring new marks and usages provides trademark owners with a chance to contact third-party owners of potentially conflicting marks and attempt to resolve issues before they rise to the level of formal trademark oppositions or litigation. If a trademark owner discovers a registration or common law use too late, it may be precluded from taking any action against the infringer. In addition, having a track record of enforcement efforts is persuasive to courts to expand the strength and reach of your marks, and may dissuade third parties from adopting similar marks in the first instance.

Likewise, a trademark watching service is an effective way to keep track of your competition. Companies often file “intent to use” trademark applications prior to introducing new products or services. By monitoring your close competition’s filings, you may gain an early insight into its marketing plans.
Our Trademark Watching Service

Trademark watching services often can serve up an overwhelming amount of data that needs to be sorted for relevance. Wiley Rein’s trademark team sifts through that data, based on your stated goals, to provide a timely, concise report and recommendations that allow you to make prudent business decisions.

We will work with you to develop the type of report that fits your needs, within your budget. We provide fixed-fee pricing, which includes Wiley Rein’s initial review and reporting of potentially conflicting references. Reports can include information on potentially conflicting references, such as:

- Pending and/or published U.S. applications.
- International filings.
- Domain names.
- Internet usage.

Our Qualifications

Wiley Rein’s full-service trademark group—led by a former Trademark Examining Attorney with the U.S. Patent and Trademark Office (USPTO) and a former in-house Trademark Counsel to a global entertainment company—routinely handles the entire gamut of trademark-related matters: From filing, prosecuting and maintaining applications and registrations, to acquisition and divestment of brand assets, to enforcement.

Our two lead attorneys have litigated over 100 inter partes proceedings before the USPTO’s Trademark Trial and Appeal Board. These longstanding dealings with the Board afford us in-depth knowledge of its procedures and strategies that actually work—our clients clearly do not subsidize a learning curve. We also represent our clients in civil and criminal enforcement actions in the U.S. and around the world, drawing on an established network of experienced local counsel worldwide with whom we coordinate and advise on strategy. We are experienced in finding compromise solutions where appropriate, and litigating when it is not, and have settled numerous potential enforcement cases without resorting to filing oppositions or litigation.

Trademark watching is a valuable way to ensure that your company is properly protecting and growing the value of your brands. We would be pleased to discuss this service with you at your convenience. For more information, please contact the attorneys below or your customary Wiley Rein attorney:

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