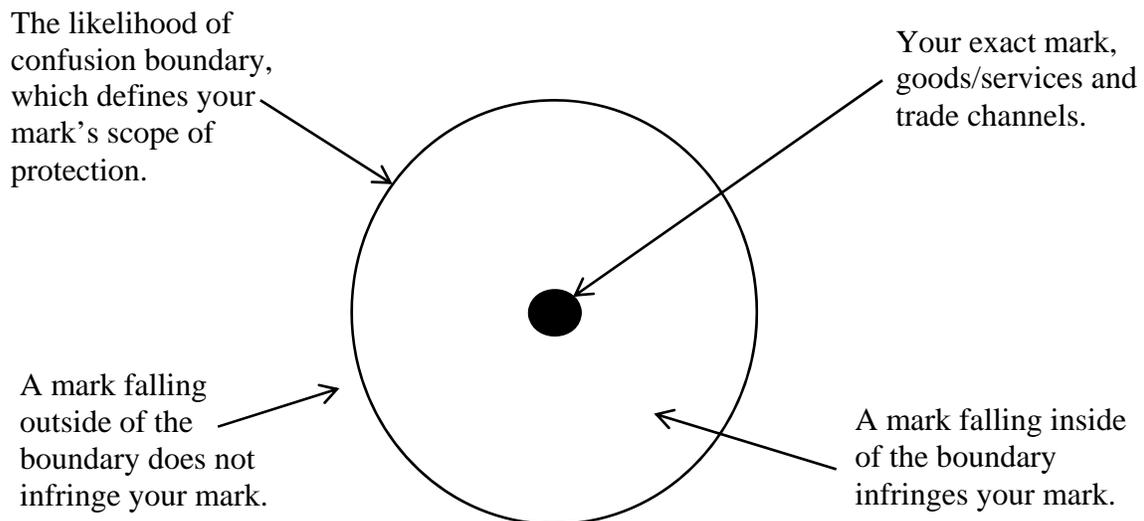


Maintaining Strong Trademark Rights

I. Determining the Strength of Your Mark.

The strength, or scope, of a trademark as *used in the marketplace* is determined by a multi-factored analysis called the *likelihood of confusion* test, and the scope can differ depending on the nature of the use that allegedly infringes your mark. In the analysis, the following factors are weighed: (1) the inherent and commercial strength of your mark; (2) the similarity of the parties' respective marks; (3) the similarity of the parties' respective goods or services; (4) the similarity of the parties' respective marketing and advertising channels; (5) third-party users of similar marks on similar goods or services; (6) the intent of the alleged infringer in selecting its mark (e.g., was it selected to trade off your reputation or selected randomly?); (7) the likelihood that one party may expand into the other's market; (8) evidence of actual confusion among relevant consumers due to the concurrent use of the marks; and (9) any other relevant evidence.

The relative weight given each factor varies in each case. A subset of the factors (and sometimes even one factor) may be so strong that they are dispositive of whether there is a likelihood of confusion, and hence infringement or no infringement. The scope of protection for a trademark used in the marketplace is illustrated below:



II. A Trademark's Scope Can Change Over Time.

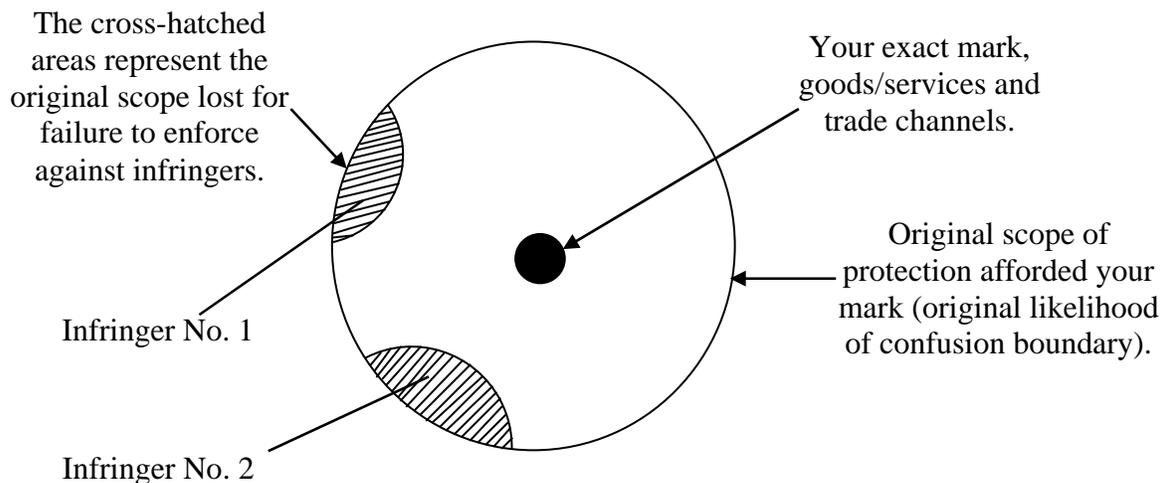
Unlike a patent, wherein its scope remains essentially unchanged and is determined largely by the written record established in the United States Patent and Trademark Office (“USPTO”), the perception of relevant consumers determines trademark scope, and that can change over time.

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Actions That Can Expand or Diminish Trademark Scope

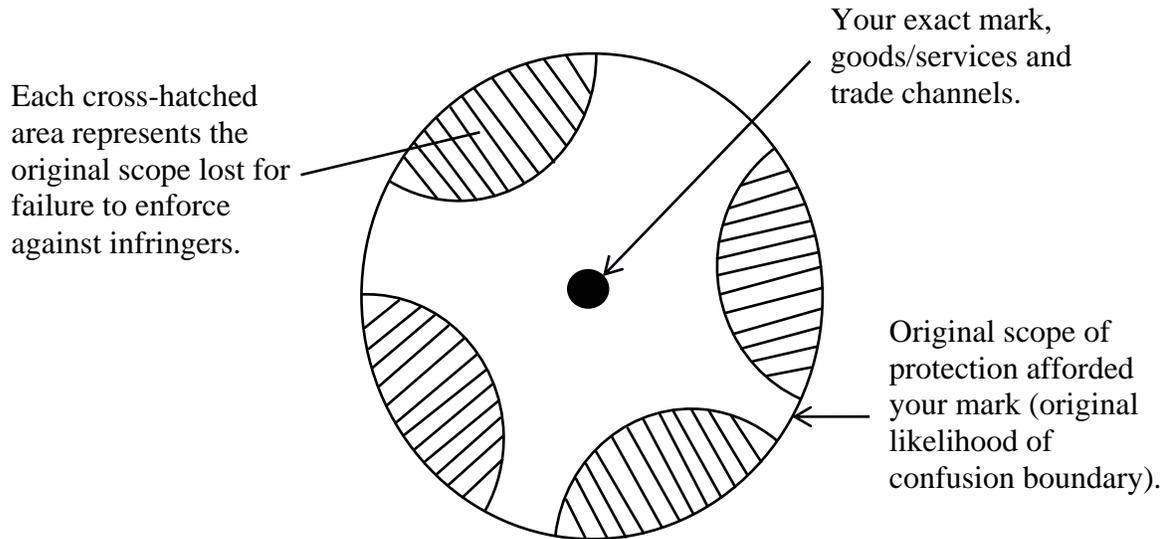
Actions that can expand trademark scope include: (1) using the mark with additional goods/services; (2) increased advertising using the mark; and (3) expanding the trade channels for goods/services provided under the mark. The primary action that can diminish trademark scope is failing to enforce against, i.e., failing to stop, known infringers. This increases the number of third-party users of similar marks for similar goods or services, and shrinks the likelihood of confusion boundary and your mark's scope of protection.

The figure below illustrates a situation in which two third parties, gone unchallenged, have taken pieces of your mark's original scope of protection.



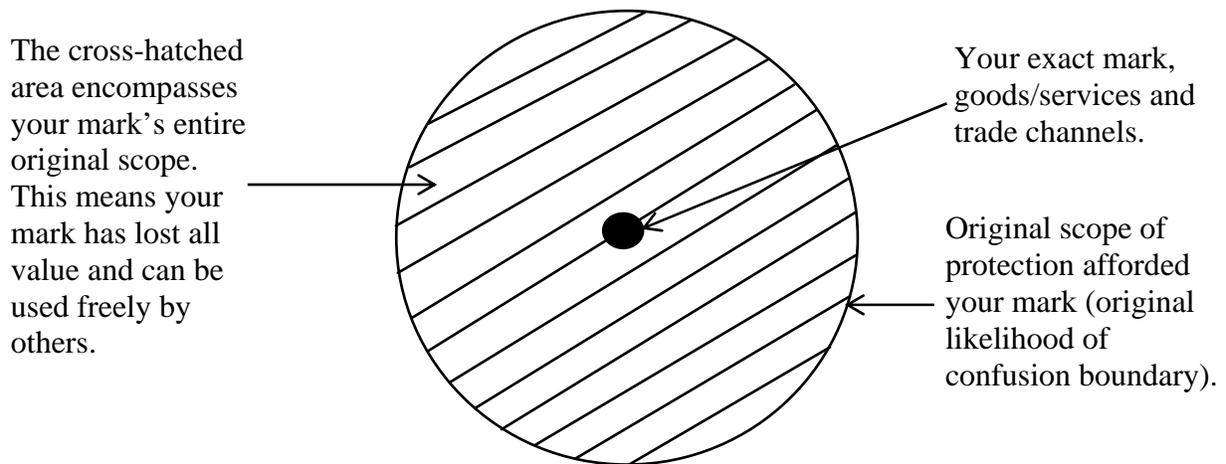
III. Your Mark's Scope of Protection Continues to Diminish if You Fail to Enforce.

If you continue to fail to enforce your rights, competitors may take more of your mark's original scope. As a result, the scope of protection continues to shrink.



IV. Your Mark's Entire Scope of Protection is Ultimately Lost If You Fail to Enforce.

At the final stage of failing to enforce, there is no protection for your mark. It has fallen into the *generic* category and has lost its entire value. Examples of once strong marks that lost their entire scope and are now generic are aspirin, cellophane, thermos and escalator.



V. **Conclusion.**

To maintain strong trademark rights you must enforce against known infringers. Otherwise the investment in selecting, advertising and promoting the mark may be partially or entirely lost.



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David Rogers practices patent, trademark and unfair competition law, including litigation; trademark oppositions, cancellations and internet domain name disputes; preparing and prosecuting patent and trademark applications; and preparing manufacturing, consulting and technology contracts.