

Protecting Your Trademarks *After* Registration

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After you've spent time and money on arriving at the ideal brand name or trademark, determining its availability, prosecuting the mark, and finally, obtaining registration with the U.S. Patent and Trademark Office, you are relieved to receive your Certificate of Registration. But is registration the last word on trademark protection? The U.S. Government estimates the cost of counterfeiting and theft of intellectual property – including product bearing registered trademarks – costs U.S. industries around \$250 billion and 750,000 jobs per year.¹ Registration of a trademark is indeed significant to informing the public of one's ownership in the mark, and affords the owner distinct evidentiary advantages when one goes to enforce those ownership rights in court. However, there is another important and perhaps less well-known weapon available to the trademark registrant to fend off the counterfeiter-infringer: recordation of your registration with U.S. Customs and Border Protection (CBP).

U.S. Customs & Border Protection is a bureau within the Department of Homeland Security (DHS). U.S. Customs has the authority to seize infringing articles at any of its ports. Armed with information in U.S. Customs' database regarding recorded intellectual property rights (IPR), Customs officers around the country can stop the importation of infringing products. While end-of-year statistics are not yet reported for IPR seizures in 2007, DHS has published statistics for mid-year 2007, showing that the total number of seizures was 7,245, representing a 21% increase from FY 2006 when the total number of seizures at mid-year was 5,940. An even sharper increase occurred in that same time period for the value of the merchandise: from over \$45 million worth of goods by mid-year 2006 compared to over \$110 million worth of goods by mid-year 2007, representing a 140% increase in value of goods seized. Footwear tops the list of IPR commodities seized by mid-year 2007, followed by wearing apparel, watches/parts, pharmaceuticals, and then consumer electronics.²

So how do you apply for this extra protection? Trademark and copyright registrants may electronically record their intellectual property with CBP through an online application. The application asks for information about (1) the trademark, including a description of the mark, the registration number, an image of the mark, the classes of goods and services covered by the registration, and a description of the goods and/or services; and (2) the trademark owner, including any parent or other company that may claim any ownership interest with the trademark owner or be authorized to use the IPR. Please note that only trademarks registered on the Principal, as opposed to Supplemental Register, are eligible to be recorded with CBP. Recordation of a trademark will last as long as the registration exists, and can be renewed thereafter with CBP concurrent with renewal of the registration. In addition to seizure of the merchandise, U.S. Customs can impose civil fines on those who attempted to import the infringing articles seized.

Your trademarks are too valuable an investment not to take all action necessary for protection from infringers. And while suing the infringing company or individual may be the appropriate action to take, finding the manufacturer or

¹ <http://www.uspto.gov/smallbusiness/>

² <http://cbp.gov/xp/cgov>

importer of the offending product may not always be possible. Thus recordation of your trademark with payment of CBP's modest filing fee of \$190 per trademark classification is well worth the additional investment.

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