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## SEARCH BEFORE YOU START

*By Darryl J. Horowitz*

Picture this scenario: You are ready to start your business and you have picked what you think is a great, catchy name that is sure to propel your business to the stratosphere from day one. You file a fictitious business name statement, prepare business cards, marketing materials, and letterhead, all with the new name that you are so proud of. Within days or weeks after you start using the new business name, you get a letter out of the blue that tells you that you are infringing on the trademark or trade name of a competitor with a similar name. You are incensed. This other company is in another state and certainly should not be threatened by your new company. What can you do? What should you do? This article will discuss this issue.

First, it is important to understand that with certain limitations, a company's name and brand can be trademarked. Where a national trademark is issued, the company that registers its mark first has a right to use that name in all 50 states and can prevent others from using the same name or a substantially similar name. A company can also obtain a trademark in California and that company will have similar protections, but only within the State of California, assuming, of course, that it registers its name before another company attempts to use the name.

In addition to having a mark that is registered federally or with the State of California, a company that has a long history of the use of a trade name can also protect it without the need to register the mark. To do so, however, the company must be able to show a prior, continuous use of the mark that precedes your attempt to do so. If that happens, however, the company that first used the mark, and can show continuous use of the mark, has a right to use it to the exclusion of a trademark or trade name that you want to use.

Trademark protections do not only apply to the same name. They can also apply to a mark that is "substantially similar" to the protected trademark or trade name or one which will lead to substantial confusion with an existing mark. For example, a company seeking to use the name "Toys Are Us" would run afoul of the "Toys R Us" trade name. The same would hold true for a mark that is the same as or substantially similar to a design or logo used by a company that has received previous protection.

How can this be avoided? Easy. You check to see if the mark has already been secured by another company by checking the database found at the United States Patent and Trademark office ("USPTO") to be found at <http://www.uspto.gov/trademarks-application-process/search-trademark-database>. In addition, the California Secretary of State's Office allows

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you to search names of existing corporations and LLC's. Lastly, do a search using Google or another reliable search engine to see if that name is already in use. If so, rather than being wedded to a name that already seems to be taken, you should look for an alternative name that would not be confused, but is still acceptable to you. Doing so could save you time, money, and headaches.

*This article was written by Darryl J. Horowitz, the managing partner of Coleman & Horowitz, LLP. Darryl practices in the litigation department of the firm where he represents clients in complex business, construction, banking and real estate litigation, consumer finance litigation, commercial collections, professional liability defense, insurance coverage, and alternative dispute resolution. He was named one of the Top 100 California litigators by the American Society of Legal Advocates (an invitation-only association of the top lawyers) and a Top 100 Northern California*

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