



Trademark

Hinshaw's trademark practice focuses on the areas of: brand selection; domain name dispute resolution; domestic and foreign trademark clearance and prosecution; right of publicity; trademark litigation; and unfair competition. We also assist businesses and individuals on matters such as: counseling and monitoring to confirm that intellectual property rights are used properly and effectively; creating enforcement programs and procedures that promote effective use of the intellectual property; identifying, defining and maximizing the intellectual property that has or needs protection; negotiation and drafting of licenses, assignments, and other agreements related to the intellectual property rights obtained; policing against improper use of the intellectual property rights of others; and trademark clearance opinions and searches. We represent clients in of the following industries, among others: charitable services, commercial, consumer products, cosmetic, education, entertainment, financial, food products, health care, manufacturing, pharmaceutical, restaurant, retail, sports and technology.

Trademark Portfolio Management

Global expansion, the internet and complex regulatory requirements have made it increasingly difficult for companies with large trademark portfolios to monitor and protect their intellectual property assets. We assist clients in managing their trademark portfolios and safeguarding the misuse of their assets.

Our Intellectual Property practice attorneys have significant experience in managing trademark portfolios consisting of registered and unregistered trademarks, service marks and domain names. We work with entrepreneurs and start-up companies as well as multinational companies with hundreds of trademarks.

We offer a comprehensive approach to trademark portfolio management, from prosecution to maintenance, monitoring and enhancing our client's trademark protection. This provides our clients with a single point of contact for virtually all of their trademark portfolio needs.

Trademark Maintenance Program and Portfolio Management

Hinshaw uses the CPI Trademark Management System (CPI)—the gold standard in the market for portfolio management—for managing trademark and domain name portfolios. The use of CPI adds another level of efficiency and organization to how we can access, track and manage trademark information.

With CPI, each domain name and pending and registered trademark has its own CPI record, identified by a docket number. Each record provides all relevant information pertaining to the particular domain name, trademark application or registration—from the basics such as trademark application

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number, filing date and country location, to more detailed data such as assignment history, prosecution details and required deadlines. Trademark deadlines are calculated automatically based on the prosecution dates for each trademark, the country and type of filing. Domain name deadlines are calculated automatically based on the date the domain is due to expire.

The system is programmed with the required deadlines in each country. Hinshaw receives deadline reminders six times throughout the year—at one year, six months, three months, one month, two weeks and one week. CPi also allows us to view the status of an entire family of domains and marks, link to corresponding trademark office records, track upcoming deadlines, and generate reports and status charts. Additionally, CPi provides a single location for our client and foreign associate contact information. This means that contact information can be updated quickly for all related dockets with the editing of a single contact record.

Trademark Monitoring, Protection and Enforcement

Hinshaw has the in-depth knowledge and capability to protect an organization's entire trademark portfolio investment. We do this through the following monitoring programs:

Domain Name Review

The unauthorized registration of domain names that include the well-known trademark or registered trademark of an owner is considered cybersquatting and is a violation of the Trademark Act. Cybersquatters routinely register domain names consisting of well-known or registered trademarks to redirect consumers looking for the trademark owner to their own sites. Such activity often confuses customers, resulting in potential lost sales and/or diminished recognition for the trademark. To prevent cybersquatting, we can conduct a quarterly search of domain name registrations to determine if third parties are registering domain names that include our client's trademarks. If such unauthorized registrations are found, we discuss with our client whether to initiate proceedings that will transfer the infringing domains to its organization.

Internet Searches

Google's AdWords program is the keyword-triggered advertising program that generates the "Sponsored Links" section on the search-results screen. Advertisers participating in AdWords purchase or bid on certain keywords, paying Google to have links to their websites displayed in the Sponsored Links section whenever an internet user searches for those words. Other search engine sites—such as Yahoo! and Bing—employ similar systems of keyword advertising.

A common practice is for a company to purchase the name of a competitor or competing product as a keyword so that when an internet user types in a search of that competitor, the other company's Sponsored Link appears. Results returned from keyword searches can cause consumer confusion, loss of sales and reduced brand recognition. To prevent such competitor's actions, we can conduct quarterly internet searches to determine if competitors are using our client's trademarks in confusing Sponsored Links. If such Sponsored Links are found, we can discuss with our client whether to initiate proceedings that will remove the Sponsored Links.

Watch Service

For marks used domestically or abroad, we help ensure that competitors do not use similar marks for similar products by retaining a "watch service," such as Thomson CompuMark, to monitor trademark filings in countries of interest. The monitoring service would provide Hinshaw with weekly watch notices for marks that may be considered similar to our client's marks. With the receipt of these watch notices, we have the opportunity to object to the similar mark's registration during the opposition period.



Licenses

Marks also may be subject to license agreements domestically and abroad. In certain countries, such as Mexico and Brazil, trademark licenses must be recorded with the appropriate trademark office to be an effective license and proper use of the mark in the country. We review license agreements to confirm that the licenses are properly recorded. In addition, we can help ensure that each licensee is using the trademark appropriately, because the failure to monitor the licensees' use of the trademark could result in a loss of trademark rights. Moreover, certain critical license terms can be entered into the CPI system to make sure that: the license is renewed on time; royalties are paid according to the schedule; and the termination of the licensees' uses of the mark are timely.

New Trademark Applications

Hinshaw assists clients in filing new trademark applications to protect our client's trademark rights in foreign countries. Filing additional applications could enhance a company's trademark protection. However, some foreign countries, such as those in Latin America, are "first-to-file" countries where trademark rights are granted to the party that first files the trademark application. In addition, and unlike the United States, some Asian, European and Latin American countries do not require the mark to be "used" prior to registration.

U.S. Customs and Border Protection

To prevent the possible importation of merchandise that violates certain trademark and trade name rights, companies can also register their marks with U.S. Customs and Border Protections (CBP) in addition to registering their trademarks with the U.S. Patent and Trademark Office (USPTO). The CBP is vested with the authority to: (1) exclude from entry; (2) detain; and/or (3) seize violative trademarked goods. To provide protection against such violative imports, the CBP has established an intellectual property rights enforcement system, which offers rights holders a two-tiered enforcement option.

The first tier is for trademark owners to record their marks that have been placed on the Principal Register with the CBP to assist the agency in its efforts to prevent importation of goods that infringe on the registered trademarks. The recordation database includes information related to the owner of the marks, product information and any images associated with these registered marks (e.g., design components).

The second tier is the CBP's enforcement process. The CBP officers monitor imports to prevent the importation of goods bearing infringing marks and can access the recordation database at each of the United States' 327 ports of entry. In addition to CBP officers' proactive monitoring of all incoming goods into the country, trademark owners can provide CBP with information relative to the importation of infringing imports so that Customs can prevent such importation.

The recordation of trademarks with the CBP can be done by providing the necessary documentation related to the registered mark.

News

[Hinshaw Adds Seasoned Intellectual Property/Insurance Partner in Minneapolis](#)
December 9, 2020

[Client Success: Hinshaw's Jane Schlicht Helps Vindicate Trademark Rights Belonging to Storied Wisconsin Ice Cream Shop](#)
February 18, 2020

[David Levitt Discusses SCOTUS Ruling that Disparaging Trademarks are Protected Speech](#)
October 19, 2017



[Hinshaw's Rockford Seminar Series](#)

October 9, 2017

[David H. Levitt Honored as Immediate Past President of Illinois Association of Defense Trial Counsel](#)

June 27, 2015

[Hinshaw & Culbertson LLP Adds Comprehensive Patent Prosecution and Intellectual Property Practice from Ryndak & Suri LLP](#)

January 14, 2014

Events

[Hinshaw Attorneys to Discuss IP Protections at State Bar of Wisconsin Conference](#)

January 12, 2021

Virtual Event

[What Business and Technology Professionals Need to Know about Intellectual Property](#)

January 24, 2018

Hinshaw's Rockford Office

[Roger Masson to Present on Intellectual Property and Advertising for Brewpubs, Breweries and Distilleries](#)

March 21, 2017

Live Seminar

[Alan Kaufman, Russell Klingaman, Roger Masson and Jane Schlicht to Present at NBI Advanced Intellectual Property Law Program](#)

December 1, 2014

[Hinshaw Attorneys to Present on Joint Development Agreements and Protecting Intellectual Property](#)

May 15, 2014

National (Webinar)