

Lampel & Associates, P.C.

555 Skokie Blvd.
Suite 500
Northbrook, IL 60062

Ph.: (847)845-4345
Fax: (847)897-5834
www.lampellaw.com

Re: *New Intellectual Property Law Firm in Northbrook*

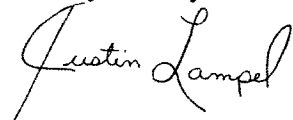
Dear Colleague:

We are proud to inform you of the opening of our new law firm, Lampel & Associates, P.C., in Northbrook, Illinois. Lampel & Associates, P.C. focuses in the area of intellectual property law including: filing patent, trademark and copyright applications, preparing novelty opinions, preparing infringement opinions, providing patent and trademark searches, and many other diverse intellectual property services. The purpose of this letter is to provide you with some basic information about our firm as well as provide you with some information about trademark law so you may better service the needs of your clients.

Our goal is to provide our clients with the easy accessibility and reasonable rates which are often not available from most large downtown intellectual property law firms. Of course, there is never any initial charge to discuss intellectual property issues with you or your clients.

Finally, please be aware that referring intellectual property clients to us may be a way for you to generate additional revenues through a referral arrangement with us. We look forward to working with you in the future.

Thank you for your time,



Justin Lampel
Registered patent attorney
jlampel@lampellaw.com

Trademarks

As you may know, a trademark is a name, symbol or other device (called a “mark”) used to identify a product or service which is legally restricted to use by the owner. If you advise clients on business formations, such as incorporating, forming LLCs, sole proprietorships or partnerships, then your client likely has trademark issues to consider during formation. Many attorneys believe that the name of their client’s corporation is protected by the fact that the state of Illinois approved their corporate name. Unfortunately, this is usually not the case. Approval by the Secretary of State’s Office often does *not* provide your client with the exclusive right to the name of their business. In fact, merely using the corporate name granted by the state of Illinois could subject your client to trademark infringement claims from other businesses.

In terms of how distinctive a business name can be, the Trademark Office is mainly concerned about “likelihood of confusion”, while the Secretary of State’s Office of Illinois is mainly concerned about “substantially the same” business names. The standards are completely different. More specifically, the Secretary of State of Illinois will approve a corporation name if it is “distinguishable” from other corporate names in Illinois. According to the Secretary of State, a corporate name is distinguishable when:

“...it is not *substantially* the same as a name on record, and second, when containing a *significant* difference from other names on the record which the corporate name distinguishability is plainly recognizable by the Secretary of State and his/her designee by means of sight or sound.”

The Secretary of State of Illinois does not take into account the standards for trademark registration determined by the United States Trademark Office when they review the name availability of newly filed Articles of Incorporation. Therefore, the name of your client’s corporation may not be protected.

In contrast, the United States Patent & Trademark Office will refuse trademark registration of a business name (or other mark) if there would be a “*likelihood of confusion*” between your client’s business name and another registered or pending

business name. According to the United States Trademark Office, an application may be rejected if "...the marks are *similar* and the goods and/or services *related*." For example, the Secretary of State of Illinois may approve Alex's Muffler Shop even though there is a corporation in Illinois called Alexander's Muffler Shop. This would almost certainly be denied by the United States Trademark Office. Therefore, in order to best protect the business name of one of your clients, an application for trademark registration may need to be filed in the United States Trademark Office.

Some of the Benefits of a Federal Trademark Registration:

- 1) Registration is constructive notice that the owner of the mark has the right to use the mark throughout the entire United States, even if the mark is not being used in a specific geographical area. This means that the owner may prevent a person or entity from using the same mark or a confusingly similar mark anywhere in the U.S., unless the other mark was used before the date of first use of the registered mark.
- 2) The right to use the ® symbol in connection with the mark, which may deter potential infringers.
- 3) In a successful trademark infringement action, the registrant may obtain increased statutory damages and attorney's fees.
- 4) The registrant may use the power of federal government (via the U.S. Customs Service) to prevent the importation of goods that contain infringing marks.
- 5) Registration is prima facie evidence that the registered mark is valid, the registrant owns the mark and has the exclusive right to use the mark in commerce.
- 6) After five years of continuous use in commerce, the mark becomes incontestable, which means that the registration of the mark cannot be attacked on the basis of prior use or descriptiveness.
- 7) The mark is easily discoverable by those doing trademark searches. This often prevents third parties from adopting confusingly similar marks.
- 8) The registrant of the mark may sue for trademark infringement in federal court when diversity does not exist.
- 9) Federal registration creates certain rights under the Paris Convention that assist overseas registration of the mark.
- 10) Registration is generally prima facie evidence that the mark has been used continuously in commerce since the filing date of the application.

We hope you found the above informative. Thank you for your time.