



TRADEMARK CEASE AND DESIST LETTER PACKET

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Dos and Don'ts Checklist

Sample Trademark Cease and Desist Letter

1. Overview

You've started a business, established a brand name, and built up a strong reputation for quality and service. Unfortunately, your competitors may not be willing to let you walk away with a strong market position. In some cases, those companies may want to cash in on the hard work that you've put into growing your business, using a brand name or symbol that looks enough like yours to cause confusion among your customers and the public at large.

Your trademark is your marketplace signature, an indicator that your company produced the items for sale and a promise that those items will meet the quality standards you've worked to establish. If another company or individual attaches a similar mark to their goods or services, it's akin to a forgery, a use of your 'signature' to obtain customers or signal your approval of those products. This forgery will not only cause an immediate decrease in your sales by siphoning purchasers to a different company's merchandise, but will cause a long-run decrease as well, as the power of your brand will be diluted by association with lesser quality goods.

By law, you must challenge any infringement on your trademark to hold onto the protections you've earned: in other words, to keep your trademark you have to defend it. The letter included in this packet is constructed to help you get what is rightfully yours. Of course, you know your industry and competitors better than anyone else: this may be an intentional appropriation or an honest mistake. In any event, you may want to alter the sample letter to best suit your business needs.

2. Dos & Don'ts Checklist

- Even if your trademark is registered with your state or with the United States Patent & Trademark Office ("USPTO"), you do not have rights in that mark until you have actually used it in your business.
- Examine the mark you think is infringing on your trademark. It must be both confusingly similar to yours and used in a related product area. You may own "John's Body Works" for your car company, but you would have a hard time proving that a beauty salon with the same name would confuse your customers.
- Make sure you are the actual trademark owner before you start this process. Do you have priority rights in this mark? Did you start using it in connection with your business before the other company did? Confirm that you are not the infringing party before leveling any accusations.
- The language in the sample letter should be adapted to fit with the specific instance of infringement you've experienced. If a small company is just starting out and has not invested time or money into its mark, consider tempering the language of the letter. If a direct competitor is clearly and aggressively infringing on your mark, consider making the language more forceful. In some cases, a simple phone call might be a good starting point

- You can send out a cease and desist letter even if you haven't registered your trademark with the USPTO. However, you may be able to defend your unregistered mark only within certain geographic parameters.
- If your trademark is not registered, send a sample of your mark with the cease and desist letter. If your trademark is registered, attach a copy of your USPTO registration.
- All of your correspondence with infringing companies and individuals should be kept in an organized and accessible file. If the infringement continues, this will show your vigilant defense of your trademark and will provide evidence that the other company was intentionally infringing after receiving notice.
- Protecting your trademark isn't limited to guarding against infringement. You must continue to use that trademark in your business. The law will not protect your rights in an unused trademark.
- Be prepared to take additional steps if the company doesn't respond and/or continues to use the infringing materials. Failure to act in a reasonable period is called "acquiescence," and could lead to limitation or termination of your trademark rights.

3. Trademark Cease and Desist Letter Instructions

The following instructions will help you understand the terms of your sample cease and desist letter. The numbers below correspond to numbers in the letter. Please review the entire document before starting your step-by-step process.

1. Insert the name of the person at the infringing company to whom you think this letter should be addressed. If you do not know the actual name of this person, insert a title (for example, President, Chief Executive Officer, or General Counsel).
2. Use this language if your company has not registered your trademark, and attach a sample of your trademark to the letter. Delete this clause if you have registered your trademark.
3. Use this language if your company has registered its trademark, and attach a copy of the USPTO registration to the letter. Insert your trademark registration number into the blank space provided. Delete this clause if you have not registered your trademark.
4. You can increase or decrease the time frame within which the infringing party must respond to you. We have entered a default number of 14 days, since that allows enough time for a response while providing evidence that your company takes this matter seriously.
5. Since this letter requests a written response within a certain number of days, you must provide an address (either physical or e-mail) to which this response can be sent.

A company that uses the tools provided in this package can protect the brand it has worked so hard to build. If additional legal action needs to be taken, you can demonstrate your vigilant defense of the trademark and provide the documentation needed to protect your business from future dilution and infringement.

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Form Sample

COMPANY LETTERHEAD INFORMATION

[Date]

[Name of Infringing Company]
[Address]
[City, State Zip]

Attention: [Insert Name] ❶

RE: Trademark Infringement

Dear Sir or Madam:

[Insert name of company] (the "Company") owns and operates [Insert publicly known name of company]. The Company also owns trademarks associated with its business [, a sample of which is attached for your reference] ❷ [registered with the United States Patent and Trademark Office with the registration number "U.S. Reg. No. [registration no.]," attached hereto for your reference] ❸ ("Trademark").

It has come to our attention that your business, [Insert Name of Infringing Company], has been using our Trademark or a very similar mark ("Infringing Trademark") in association with the marketing, sale, distribution or identification of its products and/or services. This use is in violation of the name, goodwill and reputation earned by the Company. It is not our intent to be unaware of this conflict and we believe it is in our mutual interest to resolve it.

Our Tr