

Disclaimer:

The information contained in this checklist and supplemental material is for **informational purposes only**.

Your download and reading of this material **does not** establish an attorney-client relationship.

This information is **not** a substitute for a private, independent consultation with an attorney selected to advise you after a full investigation of the facts and law relevant to your matter.

Users of this checklist and supplemental information are advised to do their own due diligence when it comes to making business decisions and all information that has been provided should be **independently verified** by your own qualified professionals.

Game Development Trademark Checklist

- Brainstorm a list of **several** potential trademarks.¹
- Evaluate the **distinctiveness** of the proposed trademarks.²
- Search www.uspto.gov for **exact matches, plurals and sound-alikes**.³
- Search** Google, Bing and other common Internet search engines.⁴
- Search** relevant state trademark databases, if possible.⁵
- Eliminate** those that are either exactly the same or **confusingly similar** to existing properties.⁶
- Enlist a **professional trademark search company** to conduct a thorough search for your narrowed-down list.⁷
- Ensure that your use will be through **interstate commerce**.⁸
- Ensure that you are **actually using** the mark, or have a bona fide intent to use the mark.⁹
- Determine** whether your mark will be a trademark or service mark.¹⁰
- Determine** whether you will be using a “standard character” mark (plain text) or a stylized/design mark.¹¹
- Research and decide on the **class or classes of goods** that encompass your use of the mark.¹²
- Research and decide what **particular goods and services** your mark belongs to.¹³
- Gather the necessary specimens that **show your use** of the mark, appropriate for whether your mark is a trademark or a service mark.¹⁴
- Prepare the **necessary fees** for your trademark filing.¹⁵

Notes

¹ Don't fall in love with any particular one, either. This may blind you to confusing similarity or some other issue with that potential choice. You need to think long-term here and be brutally honest with yourselves about both distinctiveness of your future brand and the possibility of legal trouble, however remote.

² See my post at <http://bit.ly/1hJX4AO> for more info on evaluating distinctiveness.

³ Cast a wide net, try lots of variations and put yourself in the shoes of a consumer when evaluating sound-alikes and other similar names.

⁴ Same advice as Note 3. Also, be sure to try different search engines should they produce different results.

⁵ Some state trademark searches, such as California, require that you call or submit a written request for the search rather than doing it yourself.

⁶ As with Note 3, be judicious in your approach to likelihood of confusion. If necessary, consult an attorney to do an analysis or do some research on various trademark cases and how they have come down on similar decisions.

⁷ While this entails a cost, the knowledge gained from a thorough professional search can save your business a lot of money and hassle in the long run by eliminating the chance of a confusingly similar competitor. Additionally, this search could potentially be evidence of a good faith attempt at avoiding confusion should there be litigation over the mark.

⁸ A federal trademark requires interstate commerce under the U.S. Constitution.

⁹ A federal trademark requires either actual use or a bona fide intent to use. The filing basis will change depending on which situation you are in.

¹⁰ Trademarks are those that allow consumers to determine the source of goods, and Service marks are those that determine the source of a service. This distinction comes into play when producing specimens of the use of the mark. They both have the same level of protection, though.

¹¹ When filing the mark, you can either file plain text as the mark, or a designed logo of some kind (you can even file a sound mark, if you'd like).

¹² These broad classes determine the fees that must be paid and the particular goods and services that can be claimed as part of the mark. See <http://1.usa.gov/1kZklyO> for more information and a list of available classes.

¹³ Within each class are predetermined goods and services. If you need to create your own, the filing fees will be \$50 higher. Generally, you should only choose the ones that exactly describe your mark. Failure to do so could lead to others being able

to use your mark in slightly different classes. Choosing too many categories of goods and services could bar registration due because your claim is overbroad.

¹⁴ Proper specimens must show that you are using the mark in commerce. For goods, as an example, they are looking more for your branding on the tag of the shirt than the shirt itself. See the USPTO's video at <http://bit.ly/1ctlbmu> for a good overview of what to include as a specimen.

¹⁵ The fees vary depending on whether or not you file electronically, whether you use predetermined classes of goods and services and other issues. For a complete fee schedule, check this link - <http://1.usa.gov/OZK2FI>