Trademark Counseling & Prosecution

Steptoe lawyers understand the importance of trademark registration in protecting a brand and actively help clients find cost-effective ways to protect and grow their IP assets, particularly as their businesses expand into new product lines, marketplaces, or services.

Meaningful trademark protection starts with thorough brand research in the earliest stages of brand development to understand a mark’s relative strength and potential position in the marketplace. Steptoe lawyers work with clients to educate internal business teams about the importance of diligence early in the clearance process when submitting new ideas for trademarks, slogans, and logos – preferably before significant investment has been made in new branding elements. This is a vital first step as we partner with clients to formulate a coherent strategy to establish and protect IP assets designed to make the prosecution and enforcement of their brands far easier and much more cost-effective.

As part of the branding process, Steptoe is able to advise clients on the current competitive landscape, how to select and position their brands, and how to protect those brands in order to maximize impact. Our analysis occurs on many levels. First, we analyze a mark to determine its inherent strength, based on the spectrum of distinctiveness. Second, we analyze a mark to determine its relative strength, based upon what is already in existence on the marketplace. We evaluate these factors in connection with every aspect of a customer’s experience — including websites, marketing materials, trade dress, as well as a mark’s ultimate presentation and appearance. When the time comes to pursue trademark clearance, we use proprietary tools developed to gather critical information about:

- The importance of the proposed mark(s) to a client’s overall portfolio.
- A client’s overall risk tolerance.
- The level of clearance we should undertake for a particular brand.
- The jurisdictions in which searches should be conducted.
- This information informs a series of searches to ensure the mark is available for use and registration. If necessary, we can provide guidance regarding how to make a proposed mark more distinctive and likely to achieve clearance, while minimizing changes to core branding elements.
- Steptoe emphasizes the implementation of a clearance strategy that is customized to meet a client’s business needs in order to achieve greater efficiencies in the subsequent aspects of the portfolio management process — especially prosecution and enforcement.
- Our team of trademark lawyers is skilled in the US trademark registration process and works with an elite network of international counsel to successfully register trademarks around the globe.

Following registration, Steptoe proactively continues to work with clients to maintain registrations for the life of the brand, ensuring that registrations are renewed in a timely manner and advising on any use of the marks that is necessary for maintenance. Our lawyers not only register and protect our clients’ trademarks, but strive to help develop and expand clients’ brands to meet their evolving business needs.

Noteworthy

News & Publications

PRESS RELEASES
Steptoe Receives 2020 China Law & Practice Firm of the Year Award in IP, Trade
October 15, 2020

PRESS RELEASES
Steptoe Receives Four Practice, 13 Individual Mentions in IAM Patent 1000
June 22, 2020

CLIENT ALERTS
COVID-19 and Protecting Against Counterfeits
April 7, 2020
By: Candice J. Kwark

MEDIA MENTIONS
Loyola Law Profiles Jay Nuttall
January 23, 2018

PRESS RELEASES
Steptoe Receives 28 Practice, 114 Individual Mentions in Legal 500 US 2017
June 2, 2017

PRESS RELEASES
Law360 Names Michael Allan an MVP in Intellectual Property
December 5, 2016

PRESS RELEASES
Steptoe Receives 26 Practice, 120 Individual Mentions in Legal 500 US 2016
June 15, 2016

PRESS RELEASES
National Law Journal Names Michael Allan, Charles Schill IP Trailblazers
June 1, 2016

PRESS RELEASES
Managing Intellectual Property Names Five Steptoe Partners to ‘Stars’ Lists
May 25, 2016

PRESS RELEASES
Steptoe Receives 26 Practice, 103 Individual Mentions in Legal 500 US 2015
June 4, 2015

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