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Can You Trademark A Band Name That Has Been Used In Commerce?

[Kristie Prinz](#)

Q. Is it possible to trademark a band name after it has been used in commerce, and if so, how does one go about doing this?

-- Sam

A.

Yes, "use in commerce" is absolutely a valid basis for registering a trademark.

Three possible grounds exist for registering a trademark:

1. "Use in Commerce," which is a bona fide use of the mark in the ordinary course of trade;
2. "Intent to Use," when you have a good faith or bona fide intention to use the mark in commerce but have not yet done so; and
3. "International Agreements," which refers to the fact that, if you qualify, you may file in the U.S. based on a foreign application or on a registration in your country of origin, based on certain international agreements.

Although a band name cannot be neatly characterized as either a "good" or a "service," which are the standard categories of acceptable uses that the USPTO references for "Use in Commerce," an excellent argument can be made that a band embodies elements of each category and therefore constitutes an acceptable "Use in Commerce."

So, once you have established that you have a valid basis for registering a trademark, what are your next steps?

Trademark registration is a five-step process, which is as follows:

1. Conducting a trademark search for currently registered marks in order to confirm that your mark is

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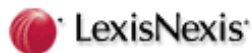
- not already in use, and also search for marks that are in use but not registered;
2. Preparing the application, filing either an "intent to use" application if the mark is going to be used in the future or a "use in commerce" application if the mark is already in use;
 3. Examining the application, including but not limited to checking the application for completeness, evaluating the registerability of the mark, and determining whether your mark is likely to be confused with a similar mark that has a superior claim to yours;
 4. Publishing in the Office Gazette, which enables members of the public to file an opposition and contest the validity of the mark; and
 5. Registering, where the registration certificate will be issued to the new owner of the trademark registration.

While I have definitely had clients who have used with success some of the online, do-it-yourself sites for filing trademarks and you may be able to successfully go that route, my recommendation is that you consult with an [intellectual property attorney](#) in your jurisdiction who specializes in trademark prosecution. Such attorney will know how to conduct a good trademark search and will be able to advise you on whether your mark is going to be eligible for trademark registration, before you go too far down the road of investing significant time or money in the process. Also, a trademark prosecutor is going to be able to advise you as to whether or not you should contemplate filing registrations on other marks that you might not have considered protecting and also will be able to provide advice on how to protect your trademark portfolio generally.

To get started with the registration process, you may want to check out the [United States Patent and Trademark Office website](#). The site provides an excellent summary about the trademark registration process, the fees required to register a trademark, and other matters related to the registration process, which you will likely find helpful to read about in more detail before you initiate the process.

-- Kristie Prinz

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