

The Game of the Name: Making Sure Your Trademark Is Available

August 29, 2019

Back to Basics: A Primer on Intellectual Property Rights in Video Games In this series, we discuss some of the fundamental concepts of intellectual property law as they relate specifically to video game companies and other unique players in the space, including esports teams and content creators. The intention of these articles is to provide a basic understanding of the various intellectual property rights important to the industry—from the differences between a trademark and a copyright, to what's behind a DMCA takedown notice. These articles are not legal advice, nor should they be relied upon as such, as the particular facts of each unique circumstance determine how the legal issues will play out. If you have any questions concerning the content of any article, or want to know more about any of the topics we discuss, we encourage you to contact the authors. We promise, we don't bite. Before reading Part II below, be sure to check out [Part I](#).

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PART II: The Game of the Name: Making Sure Your Trademark is Available

The last time we met, you had just come up with a great new concept for a video game — to get as many characters as possible to walk and chew gum at the same time. After our discussion about the various types of trademarks, you picked "**YOWZA!!**" as the name. A great choice, because it says absolutely nothing about the game, so it's a strong mark. We'll bet that your next impulse may be to start designing the logo and cover art, using the name in the game itself, and begin the marketing and advertising. After all, now that you've chosen a name, why wait? Can you move forward with using the name now? Yes. Should you? Probably not. The problem is, at this point, you don't know if someone else is already using a mark that could cause you problems if you use or try to register **YOWZA!!** Ideally, you want to know that no one is going to get in the way of your using your trademark. Realistically, you at least want to know what, if any, risks you'll encounter *before* you decide to use and register your mark. This is the point where you want to retain an experienced intellectual property attorney who specializes in trademarks. Your IP attorney will perform a trademark availability search, which is no simple Google search. It's a sophisticated computerized

search that goes through all the records of the U.S. and state trademark office databases, trade and industry journals, newswires and press releases, websites, and other databases, looking for any prior mark that could even remotely cause you trouble (and cost you a lot of time and money) down the line. Your IP attorney will review and analyze the search results and then advise you if there are any potential risks in using your trademark. Sometimes the search results show nothing to worry about (at least nothing that showed up in the search; remember the only things guaranteed in life — and trademark searches — are death and taxes). Other times they show prior uses that could pose *some* risk of objection — for example, you might receive a nasty letter from a prior user, but you could still have a chance of getting them to go away. Or you might find a prior application or registration that could cause issues with getting your application approved by the trademark office. But sometimes the results reveal prior uses that could cause you significant problems. In that event, you're taking a real risk if you go ahead — including the risk of attorneys' fees and litigation in your future, and possibly even losing your new trademark. It is always better to know the risks beforehand. Once you know what's out there, you can make an educated business decision whether to proceed with the mark. You might decide that, on balance, it would be better to come up with a new name rather than dealing with the baggage that your trademark search reveals.

Assessing the Risk of Proceeding With a Mark

Performing a trademark search is not a prerequisite to using or registering your mark. You don't *have* to do one. It just makes good business sense to find out if you might have some big problems down the road before you start putting significant time and money into production, advertising, and marketing. It's a lot cheaper to change the mark before all that happens rather than afterward. Or, if you decide to go ahead knowing there's a real risk out there, at least you know you'll need to budget for some major legal fees (if you get sued), or if you decide to try to buy that pesky prior mark to get it out of your way. It all comes down to your own risk-benefit analysis based on your business judgment, informed by the advice of your IP attorney. What we can tell you, though, is that the upfront investment in doing a trademark availability search is more than worth it because it will help you to minimize the likelihood (or at least know in advance) that you will have to spend time and money later on extremely costly, stressful litigation to protect (or defend) your trademark. In this case, you picked a strong mark and your trademark search came back clean, your application was successful, you've started using your mark, and you've got your trademark registered.

Congratulations! **Now that you've secured your trademark, it's time to talk about copyrights. That heady topic is the subject of our next *Back to Basics* article - [available here!](#)]]>**

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