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# CERTIFICATION OF CEASE AND DESIST & GUIDE

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Sample Certification of Cease and Desist

## 1. Overview

You've started a business, established a brand name, and built a strong reputation for quality and service. Unfortunately, your competitors may not be willing to let you walk away with the solid market position you've earned. 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, it 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. Sending a formal cease and desist letter is good first step. It shows that you are monitoring your trademarks and protecting your brand. But how can you be sure that the company agrees with you and the infringement will stop? Although some organizations may offer verbal promises, a formal written confirmation from the company can provide assurance of its intent. The enclosed document is designed to provide you with that assurance, and to provide further evidence of your company's commitment to its brand.

## 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.
- If your trademark is not registered, send a sample of your mark with the certification. If your trademark is registered, attach a copy of your USPTO registration.
- Contact the infringing company before providing the certification. Try to agree in advance on whom in their organization will complete and sign it. Make sure that a high-level officer (i.e., someone with authority to bind the company) is signing on their behalf.

- 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.
- If you do receive the signed certification, keep an eye on the company, their website, and their advertisements to see if they are in fact complying with that document. Make and keep copies of any infringing documents that you find.
- If infringement continues or recurs, consider sending a second cease and desist letter with language referencing the signed certificate and the additional infringing actions. At this point, it might be a good idea to meet with an intellectual property attorney to prevent further injury to your trademark and to obtain compensation for the damage that may have already been done.

### 3. Certification of Cease and Desist Instructions

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

1. Insert the name of the person at the infringing company who you have agreed will be signing the certification.
2. Enter the title of the person signing the document (for example, President, Chief Executive Officer, or General Counsel).
3. Enter the full legal name of the infringing company. The legal name of your organization is the name registered with the state. For example, the legal name of LegalZoom is "LegalZoom.com, Inc." If you operate under a different name (a DBA, a trade name or a fictitious business name), do not write that name here.
4. Write the public name (or trade name) of the infringing company.
5. List all of the infringing marks that the company was using.
6. Enter the name of the company that owns the trademarks.
7. Describe how the company was using the infringing mark. In other words, was it being used to sell the company's clothing? To advertise the company?

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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CERTIFICATION OF CEASE AND DESIST

I, \_\_\_\_\_ ❶, do hereby certify that I am the  
\_\_\_\_\_ ❷ of \_\_\_\_\_ ❸, doing business as  
\_\_\_\_\_ ❹ (the “Company”), and that as such I have the authority to execute  
and deliver this certificate on behalf of the Company.

On behalf of the Company, I further certify that:

1. In the promotion, marketing, distribution, or identification of products or services of the Company and/or its affiliates, the Company was using the following trademarks or logos:  
\_\_\_\_\_  
\_\_\_\_\_ ❺ (collectively, the  
“Infringing Marks”).
2. The Company shall immediately cease and desist any use of the Infringing Marks or any other marks that are confusingly similar to marks used, owned, or registered by  
\_\_\_\_\_ ❻ (the “TM Holder”) or any of its affiliates without the prior  
written consent of a duly authorized officer of the TM Holder. In particular, the Company shall  
cease and desist using the Infringing Marks to promote, market, distribute, or identify  
\_\_\_\_\_  
\_\_\_\_\_
3. Notwithstanding the generality of the foregoing, the Company shall not  
to be created or released into the public and shall not be used in the promotion,  
of products or services of the Company or its affiliates, or in the promotion,  
Internet or other digital marketing activities.