

TRADEMARK GUIDE

The names, logos and slogans a company uses are extremely valuable assets that should be protected. A successful product or service is synonymous with a strong, memorable identity. We instantly identify legendary marks with their products, such as Pepsi for soda, Kodak for film, and Microsoft for computer software. Fortunately, trademark law provides for protection of these names, logos and slogans and allows a business the exclusive use of its trademarks on its goods and services.

This guide will give you a broad overview of trademark law and the proper usage of trademarks in your business so that you can create a strong, lasting identity for your products or services.

WHAT IS A TRADEMARK OR SERVICE MARK?

A **trademark** is a word, phrase, symbol or design (or a combination of these) used by a business that identifies it as the source of the goods and distinguishes its goods from those of other businesses.

A **service mark** is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product. Throughout this guide, the terms “trademark” and “mark” refer to both trademarks and service marks.

WHAT MAKES A GOOD MARK?

Selecting a good word or phrase is the trickiest part of the trademark process. Not all words can be protected as trademarks, so you want to make sure that the one you choose can be protected to distinguish you as the source of the product or service.

There are four categories of trademarks, which increase in strength and determine the level of protection the mark may be afforded: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.

Generic: a common name for a product or service. Generic terms can never be a trademark. For instance, the word “automobile” cannot function as a trademark to sell cars.

Descriptive: a mark that describes some aspect, quality or characteristic of a product or service. A descriptive word or phrase, such as “electricmobile” cannot function as a trademark to sell electric cars. A descriptive mark can be registered and protected only if it has acquired a secondary meaning in the minds of the consumer; that is, through its continuous and substantial use in the marketplace, a mark has come to have a new and secondary meaning of indicating only one source and quality of goods or services. Descriptive marks may be easier to market, but they are often difficult to register.

Suggestive: a mark that tends to indicate some aspect, quality or characteristic of a product or service, such as “Sunkist” or “Chicken of the Sea”. Suggestive marks are easier to register, but require a little education for consumers to recognize what it is (e.g., marketing “Sunkist” as “Sunkist citrus”).

Arbitrary or fanciful: these are the strongest marks. They are made up words or words that bear no apparent relationship to the source of a product or service. For instance, “Kodak” and “Xerox” are fanciful marks because they were created for the sole purpose of functioning as a trademark. “Apple” and “Baby Ruth” are arbitrary because they have some meaning to the public, but do not suggest the products or services that they are used in connection with. These marks require additional marketing investment to tell the consumer what the product is. Once established, however, the mark has more value.

HOW DO I SHOW THAT I AM USING THE MARK?

In order to have any rights in a mark, you actually have to use the mark in connection with the goods or services it distinguishes. Provided you are the first user of the mark with those goods or services, you obtain trademark rights as soon as you use the mark. These are known as “common law” rights and what you have is an unregistered trademark. Any time you claim rights in a mark, you may use the “TM” (trademark) or “SM” (service mark) designation to alert the public to your claim.

Your common law rights, however, only extend to the geographic territory in which you have used the mark. In order to have broader or national rights, you have to register the mark with the United States Patent and Trademark Office (“USPTO”), which you can do once you have used the mark in interstate commerce (for example, by selling and shipping the goods to another State). Before you apply for a trademark registration based on use, you should be prepared to identify the date of first use in commerce. Invoices or other documents showing the first shipment of the goods to out of state customers should be saved to evidence the date of first use in commerce. You may use the federal registration symbol “®” only after the USPTO actually registers a mark, not while the application is pending.

To show that you are using the mark with the goods or services, the mark has to appear on the goods, the container for the goods, or displays associated with goods, or be used or displayed in the sale or advertising of the services.

CAN I RESERVE THE MARK FOR FUTURE USE?

Say you have a great name for a new product that you have not finished developing. One other way to obtain federal trademark protection is to file an application based on the bona fide intent to use the mark in commerce. You do not have to use the mark before you file your application.

If you file based on intent to use, you must begin actual use of the mark in commerce before the USPTO will register the mark; that is, after filing an application based on your intent to use, you must later file another form to demonstrate your use in interstate commerce.

SHOULD I REGISTER MY MARK?

Since we’ve already said that you do not have to register your mark, you might be wondering whether you should spend the time and money to apply for registration of the mark. Consider that owning a federal trademark registration can provide several advantages, e.g.,

- constructive notice to the public of the registrant’s claim of ownership of the mark;

- a legal presumption of the registrant’s ownership of the mark and the registrant’s exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;
- the ability to bring an action concerning the mark in federal court;
- the use of the U.S. registration as a basis to obtain registration in foreign countries; and
- the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

HOW LONG DOES MY TRADEMARK LAST?

Trademark rights can last as long as you are properly using the mark and maintain the registration with the USPTO by filing required forms between the fifth and sixth years following registration, again between the ninth and tenth years following the registration, and then every tenth year following registration.

The other important aspect to keeping your registration is to make sure that you don’t allow your mark to become generic. A few helpful rules to follow are:

- Don’t use a trademark as a noun. Always use a trademark as an adjective modifying a noun (e.g., “Oreo cookie”).
- Don’t use the plural form. Instead, change the generic word from singular to plural (e.g., not “Oreos”, but “Oreo cookies”).
- Don’t use a trademark as a verb. Remember, trademarks are products or services, not actions (e.g., you are not Xeroxing, but are photocopying on a Xerox photocopier).

When in doubt, a trademark attorney should review your advertising copy before it is submitted for publication or printing. After all, you have spent considerable time and effort to develop your brand identity. You want to take care to protect your investment.

Attorney Advertising.

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call: o: 716.218.0781 • m: 716.868.6664
email: lisa@lisaprimerano.com
visit: www.primeranolaw.com
write: 2645 sheridan drive • buffalo, new york 14150
connect: linkedin.com/in/primerano
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