

# An Introduction to Trademark Law

Trademark rights generally derive from use of the mark in connection with the sale of goods, or displaying the mark in the sale or advertising of services. The first user of a trademark typically has ownership priority rights over later users, at least in its geographic area of use. However, national rights may also be established through the filing of an application for registration based upon an intent to use the mark in commerce in the future.

- A **trademark** is a word, name, phrase, symbol, sound, color, smell, product configuration, or design that identifies and distinguishes the source of goods of one party from those of other parties.
- A **service mark** is essentially the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.
- A **trade name** is a company name. Registration of a corporate name with a Secretary of State office doesn't mean a company has acquired trademark rights.

Sometimes, the same symbol can function as a trademark, trade name, and even a service mark. For example, one could say that Reebok Ltd. (trade name) makes REEBOK® (trademark) shoes.

## Step 1: Selecting a Trademark

The first step to creating a trademark is selecting a name or symbol to identify the product or service in the marketplace. There are a number of important considerations that should be taken into account before selecting a trademark. Trademarks should be distinctive and memorable. The more distinctive a mark, the greater protection it is afforded.

**Coined Marks** have no dictionary meaning and are created for the sole purpose of identifying a product or service, such as KODAK® or XEROX®. These are the most distinctive types of marks, and therefore, are entitled to the highest degree of protection.

**Arbitrary Marks** are words that have a common meaning but are applied to a product or service unrelated to that meaning. For example, APPLE® is an arbitrary mark when used to identify computer equipment.

**Suggestive Marks** require imagination, thought or perception to evoke a quality of the product or service being offered, but do not directly impart information as to the product or service. L'EGGS® for women's hosiery or GREYHOUND® for a bus line are examples of suggestive marks.

**Descriptive Marks** and **Geographic Marks** describe the goods or services offered or the location where they are offered. Examples of descriptive marks include RICH 'N CHIPS chocolate chip cookies and WORLD BOOK® encyclopedia. An example of a geographic mark is NEW YORK TRAVEL MAGAZINE. Descriptive marks are only entitled to protection if the owner of the mark can demonstrate that the mark has acquired sufficient consumer recognition as a brand name.

**Marks to Avoid** - Generic terms such as DOG FOOD brand dog food are not entitled to any protection under trademark law. Also, if the mark is to be used internationally, be aware of cultural and linguistic translations that may be undesirable. For example, the use of the mark NOVA for automobiles was unsuccessful in Spanish-speaking countries because the term means "it doesn't go" in that language.

## Step 2: Screening

The second step to creating a trademark is determining whether the mark is available vis-à-vis other parties. This process is typically a preliminary search of U.S. federal and state trademark directories. Following the screening search, any marks that conflict with existing marks may be eliminated. For those marks that remain, a more extensive trademark search is recommended.

## Step 3: Clearance

A company specializing in trademark research can conduct a comprehensive search of PTO and common law records on each mark surviving the screening process and prepares a research report. Legal counsel then reviews the completed report to determine whether the Patent and Trademark Office will likely approve the mark for registration. This review identifies marks that may be considered confusingly similar used in the same market categories relevant to your product or service.

A confusingly similar mark is one that is so close in sight, sound and/or meaning to the intended mark as to create a likelihood of confusion among consumers between the two. This can be the case where two marks are synonyms, homonyms, phonetic equivalents, or have the same or similar root word, prefix or suffix, including foreign translations.



JOHNSON LEGAL PLLC

12545 White Drive  
Fairfax, VA 22030

Tel: (202) 445-2000

Fax: (888) 492-1303

[www.LGJLegal.com](http://www.LGJLegal.com)

## Step 4: Opinion

Based on the information gathered in Steps 1-3, an experienced trademark attorney can advise you on the availability of your potential mark for use and registration. If the opinion is favorable, an application to federally register the mark is recommended because of the significant legal protections that registration provides. Without federal registration, a product or service may face difficulties expanding nationwide or via the Internet.

Marks may also be registered under state law, which is typically less expensive and quicker than obtaining a federal registration. However, the protection under state law is not as strong as federal registration and a federal registration will always trump a state registration for the identical mark.

## Step 5: Filing and Registration

**Filing** - An application is filed with the U.S. Patent and Trademark Office (USPTO). Federal trademarks and service marks are registered according to a classification system that groups merchandise and services into classes based on similar characteristics. There are 34 classes for products and 8 classes for services. The application fee is per class.

**Specimens** - In addition to the filing fee, the registrant must submit a specimen, or an example of how the mark is actually used on goods or in the offer of services.

**Registration** - Trademark applications are examined to determine if a mark has a “likelihood of confusion” with a previously registered mark or if the mark is merely descriptive.

If no conflicting marks or other defects are found, the mark will be published for opposition in the USPTO’s *Official Gazette*. This publication provides parties who believe they may be harmed by registration of a mark an opportunity to oppose the proposed registration.

**Intent to Use Application** - A party may apply for federal registration of a mark even if it is not yet in use, based on a bona fide intention to use it in the future. The applicant must file a statement verifying that the mark is in actual use within six months of the Notice of Allowance.

### An application must include:

- The name of the applicant
- A name/address for correspondence
- A clear drawing of the mark
- A detailed listing of the goods or services
- The filing fee for at least one class

The federal registration process typically takes at least one year to complete.

Alternatively, the applicant can file for an extension of time (every six months for up to three years or five 6-month extensions). The registration is granted when the applicant submits proof of actual use.

## Step 6: Trademark Protection and Monitoring

The ongoing task of protecting a mark is important to maintaining and enhancing its value. The process of protecting a mark includes monitoring the *Official Gazette* and the marketplace to determine whether any infringing marks are being filed, or are in use.

**Proper Usage** - In addition to monitoring, it is important to ensure that your mark is properly used in the marketplace. Improper use of a mark can diminish its distinctiveness, and therefore, its value.

The registered trademark symbol ® should only be used in connection with registered marks. The notations “TM” for trademarks and “SM” for service marks should be used to indicate a claim of common-law trademark rights for marks that are not federally registered.

When typewritten, trademarks should be CAPITALIZED completely, or at the very least, with Initial Caps. The trademark should be properly used as an adjective and followed by a generic term, such as KLEENEX tissues.

**International Considerations** - Trademark rights are specific to each country. Consequently, trademark owners should consider registering their marks in each applicable country.

Closer to home, recording a registered trademark with the U.S. Customs Service will assist in the confiscation of infringing products being imported into the U.S.

**Infringement** - Trademark infringement occurs when the use of a mark by one party creates a likelihood of confusion with the use of a mark by someone with prior rights. A number of factors determine whether there is an infringement, such as whether the goods or services of the two parties are the same or related, whether the marks are identical or closely similar, whether the prior user has strong or weak mark, whether the parties sell and advertise their products or services through the same channels, whether members of the public are actually confused, and the second user’s intent in adopting the same or similar mark.

## Step 7: Maintenance

A federal registration must be renewed every 10 years. In order to prevent the registration from being cancelled, an affidavit attesting to the continued use of the mark must be filed between the fifth and sixth year of the first term of registration.

-----  
This brochure is for informational purposes only and is not intended to be individualized legal advice.