

WALA
TRADEMARK BASICS

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WHAT IS TRADEMARK LAW?

Trademark law covers the following:

- Trademark
- Service Marks
- Certification Marks
- Collective Marks
- Slogans
- Trade Dress and Product Configuration
- Trade Name

WHAT IS A “TRADEMARK”?

A trademark is a word, phrase, symbol or design – or a combination of these, that identifies and distinguishes the source of goods of one party from those of another. Essentially, a “brand name.”

- Trademarks are important because if you make a quality product, you want to make sure that customers can quickly identify your product without confusing it with other products, especially other lower quality products
- Reputation is important, and trademarks help protect your reputation

WHAT IS A “SERVICE MARK”?

A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service, rather than a product.

- Service marks “officially” identify a service
- Service marks do not need to be included on packaging or labels of products
- Service marks are commonly found on vehicles, stationery, and marketing materials, or digital presentations (for example)

WHAT IS “TRADE DRESS”?

Trade dress refers to any design or décor that is unique to your business.

For example, if your restaurant has original décor, you may be able to register the style. If another restaurant uses your décor, whether by mistake or deception, you may be able to sue.



GENERIC MARKS

- **Words that cease to serve as trademarks**
- **Marks that are now identified with a category or type of product, rather than one company or source**
- **“Genericide” is where a mark is originally distinctive and protectable but becomes “generic” over time**
 - Jello, Kleenex, Xerox

HIERARCHY OF “DISTINCTIVENESS”

Fanciful

- Google
- Neutrogena

Arbitrary

- Apple Computer
- Dove

Suggestive

- Citibank
- Coppertone

Least Distinctive:

Descriptive

- Chapstick
- Vision Center
- Nutrasweet

Generic

- Zipper

CATEGORIES OF MARKS

Less Protection

More Protection

Generic

Denotes general class of products

Unprotectable



Descriptive

Describes some characteristic or quality

Protectable if secondary meaning



Suggestive

Suggests some characteristic

Automatically protectable



Arbitrary, Fanciful

Bears no relation to product

Automatically protectable

EXXON



WHY DO YOU NEED A TRADEMARK OR SERVICE MARK?

- Indicates the source of origin of goods or services
- Helps guarantee the quality of goods bearing the mark
- Creates and maintains a demand for the product
- Used as a marketing tool to build a brand
- Can have great monetary value to a company (i.e. intangible assets or “goodwill”)

WHY SHOULD YOU PROTECT YOUR MARK?

- **Trademarks are protected under federal and state law**
 - Trademarks are earned, not born
 - Trademarks come into being through actual use
- **You do not have to register a trademark to have it protected, but there are some advantages to doing so**
- **Trademark registration provides:**
 - **Constructive notice** to the public of the registrant's claim of ownership of the mark
 - Registrant's **exclusive right** to use the mark nationwide on or in connection with the goods and/or services listed in the registration

DO I HAVE TO REGISTER MY MARK?

No...

But federal registration has several advantages, including notice to the public of the registrant's claim of ownership of the mark, a legal presumption of ownership nationwide, and the exclusive right to use the mark on or in connection with the goods or services set forth in the registration.

BEFORE REGISTRATION

Before starting the application process, you should have a clear understanding about:

- (1) the mark you want to register;
- (2) the goods and/or services in connection with which you wish to register the mark; and
- (3) whether you will be filing the application based on actual existing use of the mark or a bona fide intention to use the mark in the future.

This will make your search of the USPTO database more useful and may simplify the application process.

HOW DOES REGISTRATION WORK?

Before you try to register your mark, consider conducting a free search on the USPTO's website using the Trademark Electronic Search System (TESS)

Only the owner of the trademark may file an application for its registration.

- An application filed by a person who is not the owner of the mark will be declared void.
- Generally, the person who uses or controls the use of the mark, and controls the nature and quality of the goods to which it is affixed, or the services for which it is used, is the owner of the mark.

Forms are available through the U.S. Patent & Trademark Office's "Trademark Electronic Application System" (TEAS)

WHY WOULD MY APPLICATION BE REJECTED?

Most common reasons your application may be rejected:

- There is a likelihood that consumers will confuse your mark with a mark already on the register or applied for or an unregistered well-known mark;
- Your mark only describes a product or service or a feature of the product or service;
- Your mark consists of a geographical term which is misleading or should not be monopolized by a single enterprise;
- Your mark violates public order or morality; or
- Your mark consists of or contains (without authorization) an element which is identical with or an imitation of a protected official sign, armorial bearing, flag or other emblem, or hallmark of a state or intergovernmental organization.

QUESTIONS?

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