

TRADEMARK BASICS

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Trademark Considerations and Procedures

The following is a summary of procedures for considering, selecting and adopting a new Trademark and procedure for obtaining and maintaining a Federal trademark registration. Although I refer to "trademark" below, my comments include service marks, which are trademarks that are associated with services. The following is a brief synopsis of procedures.

There are further issues that may arise during the steps described below, if you have any questions, please contact me at howard@cohnpatents.com or at 1-800-613-0955.

Considering a Trademark

You have developed a new product and you want to select a trademark under which you would sell the product. A trademark is a brand or name which identifies the source or origin of goods or services and usually is associated with good will which already exists or is expected to be developed when the trademark is used with the product or service. REMEMBER, a trademark is a BRAND — it is not your company name; your company name is a trade name.

A trademark is a PROPER ADJECTIVE. Keep in mind the parts of speech; a trademark is an adjective — it is not a noun. An adjective is a modifier. Consider BAND-AID bandages and CURAD bandages; the word bandages is the noun and the other word is the modifier that indicates source of origin of the bandages. Since a trademark is an adjective, it is not a "thing," and, therefore, a trademark cannot own or possess something else; DO NOT USE A TRADEMARK IN A POSSESSIVE FORM. DO NOT USE A TRADEMARK AS A NOUN. Wrongful use of a trademark can dilute the trademark and lead to complete loss of trademark rights, as was the case for former trademarks ASPIRIN, ZIPPER, and others.

The trademark you select may be (a) **arbitrary**, (b) **suggestive**, or (c) **descriptive**. An arbitrary trademark is unrelated to the goods, it does not describe the goods, a characteristic of the goods, or some geographical relation of the goods. A suggestive trademark suggests the goods or a characteristic of the goods; an example is HALO for shampoo — it suggests brightness, for example. A descriptive trademark describes a characteristic of the goods; an example might be TRAVELFAST for travel agency services.

Usually a descriptive trademark is easiest to advertise and is the fastest to acquire recognition; a suggestive trademark less so; and an arbitrary trademark least so. However, the strength and scope of a trademark usually is inversely related to the ease of advertising and acquiring recognition. For example, the trademark KODAK® did not have a meaning

prior to its use in the photography field — it was a coined word with no prior meaning; it is a strong trademark that is recognized worldwide. In contrast, the descriptive trademark TRAVELFAST probably would be relatively weak because other travel agencies may write in literature that people who use their services are able to "travel" quite "fast" to the intended destination.

With the above in mind, I advise considering arbitrary trademarks for your goods/services.

Selecting A Trademark

The primary test for determining whether a proposed trademark would conflict with an existing trademark is based on likelihood of confusion. Would a consumer seeing or seeking to purchase your product or another product which are offered under respective trademarks be confused as to the source or origin of the respective products? If so, then with no extenuating circumstances, there probably would be a conflict. Consider if there are any identical or similar trademarks for identical or similar goods; and if there are, are they limited to the narrow scope of the goods for which they are registered?

YOU can do a preliminary screening to check if a trademark you are considering is available to use for your goods/services. For example, **YOU** can use an on-line search engine, such as Google, Yahoo, Alta-Vista, MSN, etc.; put into the search engine various forms of the trademark you are considering and see whether any other people or companies are using the same or a similar trademark, trade name, domain name, etc.

There are several different types of searches. I initially do a preliminary on-line search in the free Federal trademarks database of the U.S. Patent and Trademark Office. I also do a more extensive search in a "pay" Dialog database of Federal and State trademarks. I usually advise having a full trademark search done. A full trademark search includes the Federal and State trademark databases I can search on-line, and also includes a number of common law trademarks and trade names databases which I cannot search on-line. A complete search includes the federal and state trademarks databases for homonyms and/or synonyms, which I cannot do economically.

Although a full search is not a guarantee of availability, it is the best way we have to determine the availability of a proposed trademark.

A favorable opinion based on a full trademark search would be based on the facts as we know them from the search results. It is possible that the previous owner of a trademark may assert a claim for an infringement, seeking injunctive relief and/or monetary damages. In our experience, it is unusual to encounter such a conflict after having had a full search made and not finding what appears to be any conflicting trademark in the search results.

Adopting a Trademark

To adopt a trademark, you apply the trademark to your goods or advertise your trademark in connection with your services. I advise that you print the trademark on

packaging, labels and/or tags that are applied to or fastened to the package or to the goods themselves. You may also print, emboss, mold, paint, etc., the trademark directly to the goods. In other words, the trademark must be applied to the goods. For a service mark, the mark may be on a sign at a store that offers retail services, or use may be in a printed advertisement that advertises the services that are offered under the trademark. Other types of trademark use may be possible. The trademark should be prominently shown.

It often is advisable to identify an unregistered trademark by the symbol "TM" or an unregistered service mark with the symbol "SM", e.g., SWEETIE PIETM Cakes, or SPARKLESM Window Cleaning Service. After a trademark has been registered, it is appropriate and advisable to use the registered trademark symbol with the trademark, such as XEROX[®] Copier. The registered trademark symbol should not be used unless the trademark already has been registered.

Trademark Registration

There are advantages to registering a trademark with the U.S. Patent and Trademark Office (USPTO). These advantages include presumption of ownership and right to use the trademark; enforcement rights, namely the right to litigate trademark infringement issues in Federal court and certain damage rights under Federal law; incontestability of a trademark after it has been registered and in continuous use for more than five years, provided an affidavit/declaration requesting incontestability is timely filed, (an incontestable trademark registration usually cannot be revoked absent a fraud issue); notice advantages (the registered mark can be found on the Principal or Supplemental Register); and priority rights. It usually is advantageous to apply to register a trademark as soon as a decision has been made to adopt it to obtain priority over other trademarks.

If you would like us to prepare an application to register a trademark for use in connection with your goods and/or services, please let me know and I will be glad to prepare the application.

An application for Federal trademark registration can be filed based on actual use of the trademark in interstate commerce. It can also be filed based on *bona fide* intent to use the trademark in interstate commerce even though the trademark is not yet being used. In the latter case, the registration process cannot be completed until the trademark has been used and specimens showing use are filed with the USPTO. Exemplary specimens would be packaging on which the trademark is printed, labels that are applied to the goods, etc.; exemplary specimens for service marks would be a photograph of a sign showing the trademark in front of a store, an advertising brochure, a newspaper or magazine advertisement, etc.

Please note that trademark rights are national in scope. For business reasons, it might be desirable to obtain a regional Community Trademark Mark (CTM) to protect the Trademark in the countries included in the European Community or to obtain a trademark in other foreign countries of interest. United States companies contemplating foreign business are well advised to protect the right to use the trademark in the foreign countries

of interest by filing in each foreign country (or in the CTM), preferably within six months of the U.S. Trademark filing to obtain the benefit of the United States Trademark filing date.

Trademark Application Filing Procedure

A trademark application can be signed by an authorized officer of the applicant or by the applicant's attorney.

If the trademark is in use, I advise that I prepare the trademark application for you. I will fill in the dates, that you provide to me, for first use and first use in interstate commerce and (b) sign the application. You would complete a Trademark Order Form which would include all the necessary requirements for filing the Trademark along with two identical specimens showing the trademark as used.

If you have a *bona fide* intent to use trademark, but it is not yet in use, you can phone me with instructions to file the trademark application. I usually am able to file the trademark application electronically on-line the same day I receive your instructions. We could file specimens (along with an additional specimen filing fee) at a later date.

Trademark Application Prosecution Procedure

After the trademark application has been filed, it will be assigned to a Trademark Examining Attorney at the USPTO. The Trademark Examining Attorney will review the application to determine whether any formal revisions have to be made. For example, the Examining Attorney may require a more specific or clearer identification of the goods/services statement in the application. The Examining Attorney also will review other trademark registrations and pending applications for trademark registration to determine whether there appears to be any conflict with your trademark. If there is a conflict, the Examining Attorney will advise us. The test to determine whether there is a conflict is the "likelihood of confusion" test; namely, would a user of your goods/services be likely to be confused between your goods/services and those offered by another who use the same or similar trademark.

If the Examining Attorney refuses registration based on such a conflict, we would have the opportunity to respond to the refusal by arguing why the use of your trademark would not result in a "likelihood of confusion". It is possible that such an argument would be successful. It is also possible that the argument would not be successful, in which case the refusal to register would become final.

If the application is approved for registration, the USPTO will publish the trademark for opposition. Interested third parties may, within 30 days immediately following the publication date, oppose issuance of a registration, i.e., grounds of conflict with the opposer's trademark. The 30 day period can be extended by the third party upon a request filed with the USPTO.

If no opposition is filed, the USPTO will issue a Federal trademark registration certificate.

The normal time frame for completing the registration process is approximately one year, depending on the backlog of the Trademark Examining Attorney to whom the application is assigned for examination.

I keep my client closely informed of all issues and activity pertaining to their trademark application. I do so by sending copies of all correspondence received from the U.S. Patent and Trademark Office and the Trademark Examining Attorney. I also forward copies of all correspondence sent to the U.S. Patent and Trademark Office on your behalf.

Post Trademark Registration

To keep a Federal trademark registration enforce an Affidavit/Declaration of Use under Section 8 of the Trademark Act must be filed within the time period between the 5th and 6th anniversaries following the issue date of the Federal trademark registration (the registration date). If such use has been continuous and exclusive, we can also apply at the same time for the registration to become incontestable under Section 15 of the Trademark Act. On most occasions, we prepare a joint Affidavit/Declaration for both Section 8 (use) and Section 15 (incontestability) for our clients. However, if a trademark has not been in continuous exclusive use then we would prepare only the Section 8 Affidavit/Declaration.

Renewal of a Trademark Registration

The term of a trademark registration under the current law is ten (10) years. However, a trademark registration can be renewed at the end of each ten year term for an additional ten year term, provided the trademark is still in use.

If you have any questions regarding Trademarks, contact Howard Cohn at howard@cohnpatents.com or at 1-800-613-0955.