

FEDERALLY REGISTERING A TRADEMARK

Word trademarks (as opposed to symbols, colors, etc.) are generally classified in one of four categories.

i) Arbitrary: A made up word such as Tylenol or Advil.

ii) Suggestive: A name that is suggestive of the goods or services represented, but does not specifically describe the services. Playboy and Coppertone are good examples.

iii) Descriptive: Specifically describes the goods/services represented. Examples are Speedy Messenger Service for a fast messenger service and American Furniture Warehouse for an American company that sells furniture from a warehouse.

iv) Generic: Describes a whole class of goods and services represented such as Gas Station or Grocery Store.

Generally, you can only obtain Federal registration for trademarks that are arbitrary or suggestive. The other 2 categories are not fully protectable. Obviously, it would be unfair to allow someone to register "Gas Station" and not allow any other gas stations to use that mark. However, it is important to note that you could use the name "Gas Station" for another type of business- for example a bar- because the name is not descriptive or generic in that instance.

Checking Adverse Usage

In deciding on a trademark there is always a balance between using a generic or descriptive trademark (which is easier to advertise) and using an arbitrary or suggestive mark (which is easier to protect). Once a name has been decided, you should check to see if anyone else is using it. You can start with the federal trademark database at www.uspto.gov, and the state databases where you will be using the mark. You may also want to do an internet search and domain name search to determine if anyone else may be claiming common law rights in the mark. Although these searches will probably not result in 100% assurance that your use of the mark is safe, you should be able to eliminate some choices.

Federal Trademark Priority

Priority rights in a registered trademark belong to the one who files first. However, you will not be granted rights superior to someone already using the mark for similar goods or services. For example, let's say you want to register "Red Oak" as a seafood restaurant that will be operating in several states. If someone else was already using that mark for a similar restaurant in St. Paul, Minnesota prior to your use in that area, they will be allowed to continue their use in St. Paul and you will be prevented from using it there. However, by Federally registering the mark, you will have effectively stopped them from expanding their use of the mark.

Once a trademark application is filed at the Federal level, it will generally be about 6 months before a trademark examiner responds. It will usually take a little more than a year before final registration is granted. At that time, the registration relates back to the day you filed the mark. Therefore, the filing date is the important date and if you think you might want to protect your mark, you should file as soon as possible.