

MAKING YOUR MARK AND PROTECTING YOUR RIGHTS

When to Consider Federal Trademark Registration

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Have you made your mark in the world of business? Whether you realize it or not, as a business owner, you most likely have established a trademark or service mark for your business that distinguishes your goods and services from those of your competitors. Your trademarks may include your business or product name, menu items, logos, slogans, unique packaging or other brand identifiers.

As you review your website and marketing materials, note the trademarks that have worked well for you and that you feel add value to your business. Do customers recognize your business based on a certain name, phrase or design? Do your trademarks draw customers? Do they provide a positive impression? If a competitor began using the same or similar trademark, would you risk losing customers? If so, you should consider registration of your trademarks with the United States Patent and Trademark Office (USPTO).

Your mark must be distinctive

In order to register a federal trademark with the USPTO, you must have a trademark that is capable of distinguishing your product or service from those of others. The best marks are fanciful words with no meaning like “Xerox” for copiers or arbitrary marks like “Apple” for computers. Suggestive marks like “Heat King” for an oven can also be strong marks.

Generic and descriptive marks will be denied registration...usually

Words and phrases that do not distinguish your product or service are not trademarks and cannot be registered. Generic terms, such as “Candy Shop” for the name of a store that sells sweets, would not constitute a trademark. Likewise, descriptive terms, such as “crunchy and sweet” would not be appropriate as a trademark for peanut brittle.

Keep in mind, however, that for every rule, there is an exception. If your descriptive term has acquired distinctiveness over time, then you may be able to register your descriptive term after all. If your descriptive or generic term is accompanied by a logo, the entire mark can be registered with a disclaimer of the generic or descriptive terms.

Marks may be impermissible for other reasons

Even if a mark seems appropriate for trademark purposes, there are a number of reasons why it might be refused registration. Deceptive terms like “Rhine Wine” for a non-alcoholic fruit drink from Florida would not be permissible. Surnames, like “Smith’s Diner,” are generally not permissible except when they acquire a secondary meaning. Geographic terms are also problematic because they tend to be descriptive.

One of the most common grounds for refusal to register a trademark is that it is the same as or too similar to an existing registered mark. For example, “Victor’s Secret” for lingerie is too similar to “Victoria’s Secret” and could mislead consumers. To avoid conflicts with other registered or pending trademarks, it is important to do a trademark search before filing.

Already have a registered trademark?

If you already have a trademark, you should nevertheless pay attention to your new products or marketing programs to determine if there are new marks to protect. Successful companies with famous trademarks constantly reinvent their marketing plans and try new trademarks.

“Coca-Cola,” for example was registered as a trademark in 1893 for goods described as “nutrient or tonic beverage,” but the company has since registered hundreds of trademarks in many classes of goods.

“APPLE” was registered as a trademark by Apple, Inc, in 1977 to identify goods described as “computers and computer programs recorded on paper and tape.” Technology advanced, and thirty years later the company registered “IPOD NANO” and “IPOD TOUCH” for “portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files.”

Businesses evolve and grow for a variety of reasons. As you take your company through transitions and implement new marketing plans, remember to protect the new trademarks that result.

Protect your marks with federal registration

Once you have identified the trademarks that you wish to protect, the next step is typically federal registration. To qualify for federal registration, you must use your trademark across state lines or international borders. Marks that are used in only one state will be limited to state trademark registration. State registration provides fewer benefits than federal registration. If you are unsure whether your trademark qualifies for federal registration, give me a call to discuss your situation.

Registering your trademark with the USPTO provides a number of benefits including:

1. The right to use the ® symbol in conjunction with your mark;
2. Constructive notice nationwide of your claim of ownership of the trademark or service mark;
3. Evidence of ownership of the trademark or service mark;
4. Availability of federal court jurisdiction in cases of infringement;
5. Use of the federal registration as a basis for obtaining registration in foreign countries; and
6. Filing of the federal registration with the US Customs Service to prevent importation of infringing foreign goods.

Federal registration takes time

Federal registration of a trademark takes about one year unless obstacles arise during the registration process, such as a refusal by the trademark examiner or an opposition by another trademark owner. In such cases, additional time will be required to file a response.

If you have not yet begun using your mark, you can apply for registration under an “Intent-to-Use” (ITU) application. If the USPTO examiner finds no conflict, the examiner will issue a Notice of Allowance. This can be useful if you need some assurance that you will own the mark before you launch an expensive marketing campaign. Some clients also prefer to file an ITU application before announcing a new trademark to preclude competitors from filing first. The first to file has prior rights.

If the timing of your trademark registration is important to you, you will need to plan ahead.



For more information:

United States Patent and Trademark Office

www.uspto.gov

California Secretary of State-Trademarks

<http://www.sos.ca.gov/business/ts/faqs.htm>

Trademark FAQs

http://www.herranenlaw.com/LAW/TRADEMARK_FAQ.html

Trademark Fee Schedule

http://www.herranenlaw.com/LAW/TM_FEE_SCHEDULE.html

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