



Protecting The Brand- Trademark 101

A brand or trademark is the way one business distinguishes its products or services from other businesses' products or services. It might be a word, a phrase, a logo, or even a combination of any or all those things. Developing a strong trademark is key to protecting the value of the brand.

Examples of well-known trademarks include NIKE, CHANEL and COKE. The name of your product or service doesn't have to be famous to be protected by trademark law. But, not every name is protected as a trademark.

In selecting a trademark, resist the temptation to pick a mark that is generic or describes the goods or services. Generic names cannot be protected and it is difficult, if not impossible, to protect a mark that is descriptive. Trademarks are subject to varying degrees of protection. The stronger the mark, the greater protection it will receive.

While we may all have a box of facial tissues in our office, some of us will have Kleenex brand and others may have Puffs brand. Facial tissue is an example of a generic term.

Guiding clients through the process of selecting a strong product name can be challenging. Here's an example we often discuss with clients to highlight the difference in a generic/weak trademark and a fanciful/strong trademark. If you open a men's clothing store and name it "Men's Clothing," you cannot secure trademark protection for the name. If you open a place to cut men's hair and call it the "Barber Shop" you cannot have a trademark. In both examples the name of the store is generic for the product or service sold inside.

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— Tamera H. Bennett

But, consider a men's clothing store where you have barber chairs as props and a barber pole at the front door. In that case, "Barber Shop" for a men's clothing store is not generic or descriptive. It might just be a very strong brand name because it does not describe the product sold in the store.



Likelihood of consumer confusion is the standard used to determine trademark infringement.

After identifying a strong brand name, the next step is a trademark search to determine if anyone else is using a similar name for the same products/services or for related items. These searches are performed at the [United State Patent and Trademark Office](#), the Internet and other third-party search services. Trademark law is designed as a

consumer protection act, not a business owner protection act. The key of the search is determining if this new mark might be so similar to an existing brand in the marketplace that there is a likelihood of consumer confusion as to the source of the product or service. Likelihood of consumer confusion is the standard used to determine trademark infringement.

A trademark is protected by common law from the moment the mark is attached to a product that is sold or to a service that is provided. While no registration is required to be protected, there are benefits to registration including presumptions of ownership and dates of first use. A state law application can be filed as soon as the brand name is used within the state. A newly revised Texas Trademark law grants statutory trademark protection for 5 years from the time the application is approved and may be renewed for consecutive 5 year periods.

If you believe you will use your mark in interstate commerce, that means in more than one state, you may file a federal application based upon intent to use the mark. If you are already using your mark on a product or service in more than one state, you can file a federal application based upon use. Once the mark is in use and proper filings are made with the USPTO, a federal registration lasts for ten years from the date of registration and may be renewed for consecutive ten year periods. But, it's very important to know certain maintenance filings are due between the fifth and sixth year after registration in order to keep the registration active.



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Ask any business owner and they will tell you the importance of their brand name. Helping those business owners navigate the [trademark selection, search and registration process](#) is key to protecting this asset.