

SWATlaw® Series
Special Weapons And Tactics for Managing Risk
(Trademarks 101: What Every Business Owner Needs to Know)

What is a Trademark?

Trademarks convey source information about products and services. That is their *only* function. A properly chosen trademark can become one of your most important assets. The Coca-Cola trademark is estimated to be worth several *billion* dollars.

Rights are created through *use* of the mark in interstate commerce/trade. Paradoxically, you should be marking things with "TM" even before you register a trademark. This helps to show the world that you are claiming rights in those words or symbols as a brand/trademark.

Unfortunately, many companies fail to select strong and unique trademarks. Instead, they use descriptive words, which only have a narrow range of protection and are often not protectable. For example, Intel found that all its efforts to promote "386" were wasted, because the mark was considered generic and not capable of protection.

How Long Does Protection Last?

The protection of your "brand" can last indefinitely. To keep your federal "circle R", however, you do need to pay a fee periodically to the United States Patent and Trademark Office ("USPTO") — but so long as you do, you continue to have that registration forever. Examples of these fees are the *Section 8 fee* — after the first 5 years — at which point your mark becomes "incontestable" — and then a fee due every 10 years after that. It is important after you obtain your trademark that you schedule these fees into your calendar — as the USPTO will not remind you that the fees are due, and many a trademark has been deemed "abandoned" by failure to file! We also offer a trademark policing and registration service for a very affordable fee, to take these and other issues off your plate!

As a point of interest, the Peter Rabbit (Beatrix Potter) characters are now protected under trademark because of this "infinite" protection issue. Copyright protection for these characters (which is limited to the life of the author plus a number of years) expired, so they would have fallen into the "public domain." But the publisher was savvy enough to register each picture of each character as a "design trademark," and so can own them indefinitely. In contrast, the original "Alice in Wonderland" line drawings are in the public domain, as the copyright protection on these ran out, and the publisher did not trademark them. (We used the Beatrix Potter characters in software — therefore it was incredibly important for the publisher to have retained rights in the characters, or else "anyone" could have used them in any manner.)

What is the Difference Between a Service Mark and a Trade Mark?

Technically, nothing. A service mark is used in advertising and association with the services to be rendered by the holder of that mark. A "trade mark" is a mark used in advertising and association with goods. Both are really "brands."

As trademarks have been registered federally for decades, there are more trademark *classes* (the type of good upon which you are placing the mark) than for services. In fact, there are dozens of "trademark" classes (which range from tractors to teapots, food to fashion), but only a few "service mark" classes (for consultants, ecommerce, etc.) The idea of a service mark is therefore comparatively new – and sometimes difficult to grasp. While one can quite readily ascertain the "noun" for a trademark (more on this below), sometimes it's more difficult for a service.

What About The Name Of My Business?

A *trade name* is the technical term for the words adopted by you or your company for conducting business. A trade name can identify a business, trade, vocation or occupation. Trade names are not subject to federal procedures, though if you use your trade name as a trademark, you have trademark rights in that name that you should protect. You are expected to know how to search on the name of your business – and to be sure it does not infringe another company's trademark! We will discuss below how to use your "trade name" as a trade name, and also as a service or trade mark. The most important thing to know is that your state may allow you to call your company whatever you so desire, or you might be able to file a "d/b/a" under that name, but that will not save you if that name is an infringement of someone's trademark or service mark.

When should I search a trademark?

When you are using any words, symbols, "tag lines," etc. that you want to have associated with your company – search. In other words, trademarks and service marks denote a "brand" – and you need to be sure you are not infringing someone else's brand. Also, and more insidiously, if you have signed a client's contract that holds you are "liable" (via warranties/indemnities) if you suggest a tagline or draw a logo, then you *must* search any designs or work that you turn over to that client. If you do not, you might be coming up with a "perfect tagline" or "perfect logo" for that company – only to suddenly find it is infringing another party's mark – and you are responsible for paying your client's legal fees to fight it!

So when in doubt – search. And if you find something on the USPTO database, don't try to "convince yourself" you would "not really be infringing" that trademark. It's better to know on the front end that something isn't going to work (and start over) than to try to "qualify" your potential infringement. And if you find that your term or phrase is NOT taken – register it! If it's good, someone else will!

Finally, sometimes, the "best defense is an offense." If you find that your mark is "close to" another's mark, you may want to file, and argue with the USPTO as to why yours is "different enough" from their brand. If you get the trademark (and the

other owner doesn't oppose it), that owner cannot argue later that you are an infringer. The downside of this is that if the USPTO does *not* agree with you, then you will need to obtain the opinion of an experienced and unbiased trademark attorney to make sure there are strong arguments that there is no likelihood of confusion between the respective marks. Otherwise, you could be deemed a "willful" infringer (someone who continued to use an infringing mark, even though they were notified) — which can make you subject to serious penalties if the trademark owner discovers this and sends you a cease and desist letter.

How do I search?

There are a few main "lay person" methods – all of which can be performed for you, or which you can perform yourself. A law firm can also perform a more exhaustive search – it's just usually a lot more pricey.

1. Internet search/Google.
2. USPTO database.

You also need to search "synonyms" – the USPTO will not register a mark (or will find a mark to be infringing) if it "means the same thing" as another. As an example, a client's registration of "...Without Driving Yourself Crazy" (on his workbooks/book series) involved checking for "...Without Making Yourself Nuts," and other marks.

How Do You Use a Mark Correctly?

Trademarks (for products) and service marks (for services) are words, slogans or designs used to identify these products or services and *distinguish them* from those sold by others. They also serve as a guarantee of consistency and quality. If you buy, for example, an Apple® computer, you expect a certain quality and consistency in that product as you have found with other Apple®-branded computer products.

However, trademark rights can be lost through misuse. The manner you treat your trademark is very important. "Thermos," "Escalator," "Trampoline," "Kerosene," "Shredded wheat," "Cellophane," "Aspirin," "Yo-Yo," and "Mimeograph" were trademarks, but through misuse by their owners, they "became" generic. In the trade, we call this "committing genericide."

This misuse included using the trademarks as nouns, until the public believed that the trademark was the "term" for that object. This is what Kleenex and Xerox are fighting every day for their "copiers" and "tissue."

In short, a trademark is lost when it has come to mean the product itself, as distinguished from a certain *brand* of the type of product. The trademark owner also has a duty to prevent the use of other marks which are "confusingly similar" to its mark – otherwise known as "policing" the mark.

What Are Some Examples Of Correct and Incorrect Use?¹

1. *Marks are Always Adjectives.* As the “brand” of a product or service, a mark is an adjective, followed by the generic name for the product or service. IT IS NEVER A NOUN. It also should not be used as the finished products made from the ‘raw material’ you are marking with the trademark.

- i. Correct: “Go make a duplicate on our Xerox® copy machine.”
- ii. Incorrect: “Go make a Xerox® of this [on our Canon® copier].”

- i. Correct: “This flotation equipment made of Styrafoam® plastic foam can be readily installed.”
- ii. Incorrect: “This Styrafoam® flotation equipment can be readily installed.” [NOTE: If Styrafoam® *made* the flotation equipment, this would be OK.]

- i. Correct: “Acme® products are the best in the world.”
- ii. Incorrect: “If you want the best, buy an Acme®”

Because Trademarks are never nouns...

...they are never possessive terms.

- i. Correct: “Kleenex® tissue is durable”; “The fine quality of Pampers® diapers.”
- ii. Incorrect: “Kleenex®’s durability”; “Pampers®’ fine quality.”

...they can never be plural.

- i. Correct: “Thermos® vacuum containers keep your coffee hot.”
- ii. Incorrect: “Grab two Thermoses® and meet me in the parking lot.”

2. *Marks should be distinguished in your text/advertising.* A trademark should be distinguished from other words as much as possible. At a minimum, the first letter should be capitalized, and the first use should have a “mark” on it. Other methods include setting it off in quotes or in a different font. At the least, the adjective (trademark) and noun should be somehow different. If you’re not going to use the “TM” throughout the text, try to at least change the font. The U.S. Trademark Association states: “Trademarks are loners — They must be distinguished in print from other words and must appear in a distinctive manner.”

- i. Correct forms: Windows® software; WINDOWS software; *Windows* software.
- ii. Incorrect: WINDOWS® SOFTWARE; Windows Software.

¹ Note – this presumes that your trademark is not a “tagline” (for example, “Milk Does A Body Good” or “Got Milk?”) These are also trademarkable, but in general, clients are looking to trademark something attached to a good or service – so these will not be discussed here.

3. *Marks must be tied directly to the owner's products, only.* A trademark should only be used to identify the trademark holder's products. This can be difficult to teach marketing people, who love to "splash your mark all over." But you can lose a mark, if it's used incorrectly.

- i. Correct: "We use Acme™ security detection services."
- ii. Incorrect: "We provide Acme™ services."

4. *Make it obvious that you own a term.* The trademark or service mark needs to include the "TM" or "®" after it. (The "TM" can be utilized on a word, phrase, or logo that you are using as a brand without registering it, but only the USPTO can grant you the use of the "®".) Marking shows the public that the brand is the property of the holder. It needs to occur at a minimum once in each piece of printed matter or website, preferably the first time it's used. Again, unless you are *certain* you have a registered trademark, use the "TM" mark. This puts third parties on notice that you have a trademark, and therefore allows you to claim extra damages should they infringe upon your rights (they can't say "they didn't know").

- i. Correct: "We recommend you use our Xerox® copy machine."
- ii. Incorrect: "Use our Xerox copy machine®"; "Use our Xerox copy machine."

5. *A trademark is not a trade name – even if it's the same word – be sure you understand how to use each correctly.* A trademark or service mark should not be confused with a trade name. A trademark identifies the product or service. A trade name identifies the company. "Coca-Cola® soda" is sold by The Coca-Cola Company (no TM mark). Another way to denote a trademark is that a trademark is a "brand" – if you could use the word "brand" to describe what you are marking, you're on the right path. Examples would be "Band-Aid® brand adhesive bandages" or "Good Solutions® brand legal services."

- i. Correct: "Tax Express™ tax management services."
- ii. Incorrect: "Use Tax Express™ for your tax management needs."

If you actually own a trademark that is the same as your trade name, when in doubt, use the TM mark. However, don't forget that you must have checked the federal registration to be sure your use does not *infringe* another party's mark!

If you are only doing business in-state, you might also want to check the state trademark registry – but that is beyond the scope of this chat.

6. *Even Though You Think You Understand it All, Each Class Of Marks has its own Quirks.* As an example, with respect to titles for books, workbooks, etc., (Class 16 products), you cannot trademark "just one." You need to show a "series" of books/titles under that name or tagline – because otherwise you are butting up against copyright law, which states you can't copyright ('own') the title of a book. Although it seems deceptively simple, this is why we don't recommend clients "going it alone" when it comes to registering their trademarks. (Another reason is that the default choices on the USPTO registration page are generally not the choices you would want – but they are the choices that will guarantee the USPTO more money in

a year. We can discuss this later, but many clients who take this course and then go their own way rather than pay for us to help them find this out – to their dismay and chagrin – and then need to hire us to bail them out. And, of course, it's more expensive at that point!)

Why Should I Register a Mark, Anyway? I (a) have a business name already or (b) have a State trademark or (c) don't find it on the USPTO database, so it's OK to use it, right? So, why?

Trademark rights are always acquired through *use* of the trademark on your good or service. Registration on the federal registry ensures that your mark appears in the searches of others – discouraging their adoption or use of the mark. Registration also provides *prima facie* evidence of ownership of your mark, and your exclusive right to use it. After six years of registration and exclusive use, your rights can become “incontestable.” This narrowly limits the grounds on which they can be challenged. After registration, the law provides valuable remedies, such as treble damages and attorneys' fees, against users who infringe upon your rights. In sum, Federal registration gives “constructive notice” to the public of your claim of ownership of the mark (even though no one “knows” to check the USPTO website, it's still presumed that you will and should), and it gives you a presumption that your registration is valid, that you are the owner, and that you have the exclusive right to that mark in your trademark class.

Moreover, if you have a state trademark registration, it merely declares the ability to use that mark on your product/service in that state. And, registering a business name actually proves nothing. You, as a business owner, are *assumed by law* to have checked other companies' trademark filings on the federal register. By filing on the federal register, these companies are “declaring to the world” that they own the taglines or marks – and if you use them, you are likely to be considered an infringer.

Registration is not particularly difficult, if you do your homework, but it does take a long time. It's also important to know that the USPTO website “defaults” in a way that might not work best for you, and so utilizing an experienced trademark attorney and having at least a common law search done can save you money, time and heartache in the long run. After the application is filed, it will be examined by an Examining Attorney at the USPTO, who decides whether it meets the registration requirements. It takes about six months to receive that “Office Action” back from the USPTO (because they will *always* complain about something). Then you get an opportunity to answer and correct any issues, then they answer back, then if all the requirements are satisfied, they publish you in the Official Gazette and your mark is up for public opposition.² If no opposition is filed, the registration issues; if you filed

² Since the only people who actually read the Official Gazette are attorneys, it's unlikely that you will be opposed by a “regular Joe” who thinks you shouldn't get the trademark. This can be a problem, though, if your competition decides that it is going to register one of *your* products or services “on the sly” — it can actually make it through the opposition period and they will receive registration of that term without you even knowing about it. And after the opposition period, it's basically impossible to claim that they aren't the owner of that brand. They can't stop your use that “pre-dated” theirs; but they *can* stop you from expanding that use. So if you only had clients in/use the mark on products in California, that's as far as you can use it — they “own” the brand in the other 49 states.

an "Intent To Use" instead of a use-based trademark, you have six months to file your Statement of Use (and pay your fee) or file for an extension of time, or your trademark is abandoned. A speedy process, all told, takes about a year and a half, assuming no problems.

Registration is also a bit more of an art than a science. Even if you follow the procedures we will discuss in this seminar, it takes working with someone who has done more than a few filings, to help guide you through some of the pitfalls. And registration is not foolproof – often, even if you follow the procedures we suggest, you will get an Office Action and need to have a professional correspond with the USPTO on your behalf. However, getting off to the right foot will help make these Responses less lengthy – and pricey.

I Don't See my Mark/Tagline on the USPTO Website. So I can get it, right?

Not necessarily. A mark may be available, but still denied. The two most common reasons are (a) descriptiveness and (b) likelihood of confusion with other marks or trade names.

Descriptiveness: Even if a mark is found to be "merely descriptive" of a good or service (it just describes the good/service, its function or other characteristics), it may be registrable if the applicant can show "secondary meaning" (that the public thinks of their product/service when they hear or see the trademark). This can be shown by having used it for a number of years. This is a special filing we can make on your behalf – we need proof that you have been using the phrase, word or logo you would like to trademark for at least five years, but then we can make a filing to claim this "secondary meaning" on your behalf.

Likelihood of Confusion: The test for "likelihood of confusion" is applied between two marks, as each is used and applied to its respective goods/services. If the marks are not similar or are used on widely different products in different channels of trade, it is likely they will not confuse the public, so not only is there no infringement, but you can likely register the trademark yourself. An example of this might be Boise Cascade® paper products, and Cascade® dish soap, and Cascade® motocross bikes. If, however, the mark is substantially similar in sight, sound, meaning (including foreign language) to another mark, and used on similar goods in similar channels of trade, it is more likely that the second trademark will not be allowed – and is actually an infringement.

What About State Trademark Registration?

State registration is far more limited, and is “trumped” by federal registration that pre-dates it. If you have a state trademark registration that pre-dates a federal trademark registration, you will be able to continue to use your trademark . . . but it is only valid in intra-state (within your state) commerce. If you have a “common law” trademark (meaning, you haven’t registered anything, but you have used the “brand” for a while), if you can prove that your use pre-dates an actual registered filing, you can continue to use it – but only for the geographic region you have already used it (you cannot expand).

There are many more benefits to federal registration – it’s just more expensive, and not quite as quick to obtain. But federal registration is evidence of a valid mark throughout the entire United States – and after a handful of years using it on your product/service correctly, you receive an “incontestable” certification for that brand. You don’t get that from either state or “common law” useage – and if your state or common law use actually *post-dates* use by another party, you can be found to be an infringer. Other benefits of federal trademarks include the fact that counterfeiting of federal trademarks carry criminal penalties, and you can stop goods at the border (through U.S. Customs) that bear your mark incorrectly or are infringing, and have those goods destroyed. If you have a federal trademark and another party uses it in a URL that post-dates your trademark, you can petition to have them turn the mark over to you. (This recently happened to a client, who failed to renew their URL at Register.com. A consolidator picked it up, and was “holding the website hostage.” Because the client had not filed their trademark, we did not have an argument to get it back – however, we quickly filed the trademark, relating back to their first use of the trademark on their products in commerce – which was far before the website was hijacked. We then explained to the consolidator that the trademark WAS filed now, and the client’s use pre-dated the hijacking. The consolidator/highjacker gave up without a fight. This saved the client then many, many thousands of dollars for which the consolidator was holding the website “for ransom.”)

How Do I Decide What Mark To Use? How Do I Get Started?

From a lawyer’s perspective, it’s best to completely make up a word. There are different “types” of marks – and they range from the most desirable (and easiest to trademark, though hardest to market) to completely unregistrable (but usually very desirable from the marketing perspective!). Please note that in practice, these exist on a continuum. The idea here, once you have found a phrase that is not on the USPTO database or on an internet search, is to convince the USPTO you are “high enough on the spectrum” for them to let you register.

These mark types are:

1. *Fanciful marks*. These are “coined” terms (terms you make up). Examples include Xerox, Kodak, Sanka. They receive very broad protection – you’re more likely to be able to stop the use by others of marks that are less similar (and used on less related products) than the owner of any other mark. The “incongruity” of the brand words (or design) and the product or service they are used on is absolute, as

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there is no dictionary definition for that brand. BEWARE: This is often where trademark owners fail – they want consumers to use their brand “as” the noun, not the adjective. Their marketing department wants people to say “Sanka” (your brand) and mean “granulated decaffeinated coffee.” However, as you know from above, this is exactly how a company “commits genericide” and can lose the brand.

2. *Arbitrary marks.* This is your next best choice. These are common words, with a dictionary meaning, where the words do not link to what the product is. Examples include “Time” magazine or “Red Cross” food. In other words, the consumer can’t connect the dictionary word with the product. But while a fanciful mark has no competition from any mark anywhere close to it (Kodak is a good example), a mark like Burger King must endure competition from Burger Chef and quite a number of other fast food restaurants that feature a play on the word “Burger,” thereby detracting from the strength that might otherwise attach to the mark. In fact, it’s likely that a “burger joint” will even need to “disclaim” the word “Burger” in their mark – making it even weaker.

3. *Suggestive marks.* With suggestive marks, the words imply something about the good or service, but they are still clear trademarks that can identify a brand. The words might denote a color, quality, or desirable feature of the product or service. Examples might include “Bulldog” picture frame hooks, or “Purple Sparkle” window cleaner. In a suggestive term, the consumer can’t readily connect the common, dictionary meaning to the product. This doesn’t mean, of course, that you won’t receive an Office Action from a USPTO Examiner who has decided that your mark isn’t “suggestive,” but it is “merely descriptive.” Then – you have to fight! ☺

4. *Descriptive marks.* You don’t want to be here! ☺ These “brands” describe the exact characteristics of the product or service. These may *not be registered as trademarks*, unless it is established that the owner has used them to such an extent (for such a long time) that they have acquired “secondary meaning.” This means that the public associates the words (the trademark) with that company, only. While descriptive names are great for marketing, they are terrible for trademarks. “Hiking” magazine (about hiking) would be an example. These marks are also the “thinnest” – they receive the least broad application. If you have made up a term, you will likely be able to “bleed over” into other classes of protection (for example, if you register your mark, Xylzst® on beer, and someone starts to use Xylzst on T-shirts, or on software, you might actually be able to stop them even if you haven’t registered in the T-shirt or software class. However, if your mark is farther down the continuum, you will not be able to get as much benefit.) Marks that were originally considered descriptive include: Chap Stick, Raisin Bran, Tender Vittles, Holiday Inn, and even Ford, Marlboro, and McDonalds. (The latter three because they are surnames (Ford and McDonald) and the name of a town in Texas (Marlboro). Names, geographic names, etc. are not allowed to be “taken out of the vernacular” unless you can prove that when a consumer says the name, they think your brand.)

5. *Generic terms.* These can never be marks in the true sense. They are words that are in the public domain, free for all. For example you could not have a trademark on Chairs® for seating material, because that means that word could not be used to denote anything but your product. You can’t prevent people from using

it, or expect to do so. Other examples might be Client Manager® on services providing client management services; however, Client Manager® software might be registrable, if you can prove that it's at least suggestive (or perhaps descriptive, but you've used it for enough time that when people say it, they think of your product).

OK, you've convinced me. I've checked the database, and the internet, and I think I'm clear. What do I need to do to get the ball rolling?

1. You will need what is called a "specimen" of your trademark or service mark use, for each class you are filing. This means generally a .jpg or .gif showing "use" on your product or service. (This can be a snapshot of your website for a service mark – so long as your website "advertises" the services upon which you are filing the mark.)

2. You will need exemplars or "evidence" showing "first use" and "first use in commerce." "First use" is the first date you can prove you used the term as a brand. "First use in commerce" is the first date you can prove you used the term as a brand, and it crossed state lines. Note --you don't file these with the USPTO, but the date is key, and it is necessary to have this evidence in case the USPTO has questions.

You can also file an ITU ("intent to use") for a trade or service mark, but if you can actually put the brand on the product or service, then send it across state lines, you can save the money of ultimately "converting" the ITU to a "real" mark – and remembering to do it!

3. You will need to know that classes you need to file in, and also a description of your services. The best way to go about this is to see what your competitors have filed. What classes are they in? How have they described their services? Are their trademarks actually "Live"? (We will go into all this during the talk.) If you can "borrow" a description that has been accepted by the USPTO, you do not risk being "kicked out" in an Office Action for an incorrect description of your services or product. If the description is actually bad enough, the USPTO can just tell you to start over, and keep your money! So "borrowing" a competitor's description of services (*so long as their mark has been accepted!*) can be a great idea.

4. You need to use the trademark on your website, handouts, and all other materials, as soon as you file. If the USPTO pulls up your website, it needs to show that "TM" after your use of the brand, and also needs to contain words (or "show" the Examiner) that match the description of services you filed.

So What Are "Specimens" – will the USPTO ask me to mail these?

The USPTO won't actually ask you to mail them the specimens showing when you used your brand on your products the first time, but if there is ever litigation, you sure want to have these in a file. Because people and corporations like to purge files, make sure you keep a historical record of these documents, in case years from now someone decides to sue you (or you need to sue someone else). Often, it's impossible to find an "old" product showing your use, or an advertisement or yellow

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pages ad when you need one, because these things are pitched every day. Your legal files should contain the following, in anticipation of the day that you might need them in court:

1. historical records regarding choosing the mark – who created it (do you have a work for hire contract if it's an independent contractor?), various iterations of sketches (if a logo or drawing), search results, and (if available), survey or focus test group results showing that when people see/hear this trademark, they think of you as the "source" of the good or service. Also any documents that have an impact on your ownership of the mark (such as exclusive license agreements of that mark to other parties, work for hire agreements, and the like).
2. copies of the original product to prove your first use, and your first use in interstate commerce. The best way to prove this is through dated advertisements.
3. if use of the mark changes over time, or the products change, a historical record of the product/service changes. You definitely want to have a record of the first time you use the ®. If the trademark is used on a broader range of goods (e.g., it was used first only on mustard and now you're making jams and jellies), you will need to re-file a new application with the new first use/first use in commerce date for your new goods.
4. copies of any protests, cease and desist letters, and the like. Also copies of any letters or focus groups that show actual confusion of your brand with another brand, or where the group has "de-linked" a trademark from its source. (You might not want to keep these records if it is *your* trademark that the focus group is de-linking, but if it's a competitor's mark and you are using a similar brand, this might be ammunition you can utilize.)
5. records of sales and advertising figures for the product/service related to that mark, to rebut a claim that "no one" in the marketplace knows your product/service. (Slightly different than actual focus group documentation, but still valuable).

My Trademark Contains My Name. Any Issues?

As mentioned above, a trademark needs to function as a brand (indication of source). For this reason, the USPTO will not allow goods or services to be registered that are the generic name of the product/service to which they are attached. Additionally, Section 2 of the Trademark Act contains several of the most common grounds for refusing registration. These include the assertion in an Office Action, by the USPTO Examining Attorney, that the proposed mark:

- * contains immoral, deceptive or scandalous matter;
- * disparages or falsely suggests a connection with persons (living or dead), institutions, beliefs, or national symbols, or brings them into contempt or disrepute;
- * consists of the flag or coat of arms, or other insignia, of the United States, any state or municipality, or a foreign nation;
- * contains a name, portrait, or signature identifying a particular living individual, except by that individual's written consent, or the name, signature, or

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portrait of a deceased President during the life of his widow, except by written consent of the widow;

* resembles, in the Examining Attorney's mind, a mark already registered with the USPTO, such that it could cause confusion, mistake, or deception;

* is merely descriptive or deceptively misdescriptive of the branded goods or services;

* is primarily geographically descriptive or deceptively geographically misdescriptive;

* is primarily merely a surname; or

* is a generic or functional brand.

Therefore, if the main part of your mark is your name ("Shepard Purses" and your last name is Shepard), you will likely be rejected by the USPTO.

Can I get a refund from the USPTO of my filing fee, or if I make a mistake?

In a word, No.

How long does trademark registration last?

Basically indefinitely. However, for a trademark registration to remain valid, an "Declaration of Use" (also called a "Section 8" Affidavit) must be filed (1) between the 5th and 6th years following registration; and (2) within a year before the end of every 10-year period after the date of registration. The most important thing to know is that the USPTO will not notify you when your filing time is coming up – and if you don't file, you are deemed to have Abandoned your mark. You need to file an Affidavit to notify the USPTO that you are still using the mark on your product/service, and file a photograph showing that it's still in use in commerce. The USPTO made this requirement to clear its files of dead marks, and 'recycle' them.

Let me tell you a story of something that recently happened to a client. She had used the mark on her products for over a decade, and had had a Federal trademark registration for the past 6 years. She was trying to sell her business, and the buyer did some due diligence – and told her that her trademark was Dead. She was horrified – and in fact chewed out her office staff for "losing" the "paperwork from the Trademark Office." Of course, much to her chagrin, I explained they don't *send* any paperwork!

Worse, when we re-filed her trademark, she received an Office Action that the Examining Attorney felt that she was now "blocked" from using that trademark, by a trademark that was filed during the time that her trademark was actually live. What this means is another Examining Attorney had let that person file their mark (*that* Examining Attorney didn't think that it was confusing to have those two marks in commerce), but when my client filed her mark, *her* Examining Attorney felt that the marks were "too close" to let her (re-)file. We are still arguing this now – it seems completely insane, but this is one of the frustrations with the subjectivity of Examining Attorneys!

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Why can't I just use one of those cheap online registrations, or do it myself on the USPTO website?

The USPTO website form defaults to a registration that you likely don't want, and which could cost you more money in the long run. And online registration houses will let you register anything – even if it's infringing someone else's mark; even if it's a definite block (like the mark is your surname). Moreover, the class description that you file by yourself is more likely to lead to an Office Action than one that is reviewed by an attorney – it's usually best to have some guidance in this area.

I Got A Cease and Desist Letter! What Now?

If you used the brand on your goods and services before the party that sued you, you have what are known as "common law" rights in that mark. However, the most important restriction on common law rights is that they are limited to the actual geographic area of use. The most important advantage of registering a trademark with the USPTO is that it provides nationwide rights to the exclusive use of the mark, subject only to prior common law uses, if any, in their limited geographic area. So if you expanded your usage rights after someone filed the trademark in which you have common law rights, they can have an infringement claim on you. To disprove this claim, you need to assert that there is no "likelihood of confusion" between your mark and their mark. This involves an 8-factor test:

1. the strength of the mark under trademark law;
2. how similar the goods are to one another;
3. similarity of the sight, sound, meaning of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. type of goods and the degree of care likely to be exercised by the purchaser of those goods;
7. your intent in selecting the mark; and
8. the likelihood of expansion of the product lines of the party that holds the registered mark.

Because, in this case, you only had common law rights, you are on the defensive – you need to prove that you are not an infringer, or stop using the brand. A tactic used now with Yellow Pages coming online is that attorneys representing clients that have registered trademarks send cease and desist letters to small businesses in those Yellow Pages, stating that the business is now "advertising" outside their geographic region. This happened to a friend of mine, who owns a business that we can call "CPA Express." He had purchased the business with this name on it, and had operated for a number of years in his geographic region. Unfortunately, I purchasing the business, he didn't think to see if the name was blocked by a trademark – he "had a dba" and so he felt he was fine. Unfortunately, he received a cease and desist letter from the attorney for an Arkansas firm also called "CPA Express" – which had held the federally registered trademark in that name since *before* his business had even opened. This was bad news, since he couldn't even claim common law rights in his geographic region. They wanted him to either completely cease using the name and pay them damages, or pay a "licensing fee" for

the rest of his business's life, to use "their" trademark. He was between a rock and a hard place! You do not want to be in this position!