



Greg Butler Law

TRADEMARK

Primer

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Introduction

Scope

The intent of this Trademark Primer is to provide a useful introduction to trademark protection. It is necessarily limited in scope for the sake of complexity and brevity, so it is by no means exhaustive.

The scope of this guide includes trademark protection in the **United States** for traditional trademarks, including **words, designs, and logos**. It does not cover international trademark considerations, or protection of non-traditional trademarks, such as trade dress, smells, sounds, and the like (and in case you didn't know, yes...they're protectable.)

For a more detailed discussion of the topics covered, and not covered, in this primer, please contact us.

Disclaimer

As any good attorney should do, it is important to point out that the information presented in this guide is for **informational purposes only** and is **not specific legal advice**. Advice is only something that can be provided after a thorough review of your particular situation and by a licensed and experienced attorney.

What is a Trademark?

The starting point of trademark protection is to understand what a trademark is. A trademark is any word, phrase, symbol, or design, or combination thereof, that identifies and distinguishes the **source** of the goods or services of one party from those of others.

Technically the word “trademark” is used to identify goods, and “service” mark is used to identify services. However, the terms “trademark,” “service mark,” and simply “mark” are all used interchangeably to refer to both trademarks and service marks.

It is also important to keep in mind that: (1) there are other intellectual property rights that are protectable under different laws; (2) there are some other legal/business terms that can function as a trademark but only if you use them as a trademark. Understanding the difference between them can help you identify what can be protected under trademark law.

Trademark vs. Copyright vs. Patent

A trademark protects your brand or product identity. Names, logos, and slogans are common trademarks. A copyright protects “original works of authorship,” such as books, illustrations, and web pages. A patent protects an invention (something that is capable of doing something itself).

The primary distinction between trademark, copyright and patent is that: Trademarks protect your marks from someone else’s **use** of the same or similar mark. Copyright protects from the unauthorized **copying** of one’s work by another. Patent protects your invention from someone else’s **exploitation** of the invention.

For example: If you have invented a new automobile tire, a patent will protect the tire, a trademark protects the brand name of the tire, and copyright protects the website on which you sell it. Simple enough?

Trademark vs. Domain Names vs. Business Names vs. Trade Names

A domain name is, in simple words, the address used to access a website. Domain names may be trademarks, but not always. A domain name can function as a trademark if, like any trademark, it is capable of distinguishing your goods and services from that of another. Merely having a domain name does not itself create a trademark. If the domain name is only a name that users type to locate you on the internet, there is a good chance that the registration will be refused.

A business name is the legal name of your business. It is the name under which your business is identified with the government. . Like a domain name, a business name is only a trademark if it can serve to distinguish your goods or services. This essentially means that if you call your goods BRAND products, but your company is Company, LLC, then you are not using Company, LLC as a trademark. If, however, you offer COMPANY brand products to the public, then COMPANY is likely a trademark (assuming it meets the other requirements).

A trade name is the name that your business is commonly known by its customers. This essentially means that if you call your Company, LLC, but your customers know it by Company only, Company is its trade name. And, just like with domain names and business names, your trade name can function as a trademark if, like any trademark, it is capable of distinguishing your goods and services from that of another.

Obtaining Trademark Rights

Trademark protection exists in the first use of a mark as a trademark. There are some important distinctions to make here. First, it's about who is first to *use*, and not who is first to *register* a trademark. Second, the use has to be "as a trademark." This means that if you use it first, but incorrectly, you may not have priority over a later user who uses it correctly.

"Use as a trademark" means that the mark is capable of identifying the goods or services of one supplier from that of another. This essentially means that use of your mark will not be confused with another source of goods, and is a mark that is capable of distinction itself (it's not generic for or merely descriptive of your goods or services). Additionally, the use has to be "in commerce." This means that you have to actually be selling or offering to sell the goods and services represented by your trademark.

Although the general rule is that you will only acquire trademark protection through use, it is possible to "reserve your right" in a particular mark before actually using it in commerce through an "intent to use" application. You will have to allege use before the mark is approved by the U.S. Trademark Office, or within six months thereafter, before the mark will actually be a "registered" trademark and before using the "®" symbol.

For more details about trademark use please check Trademark Usage Guidelines.

Trademark Eligibility

To be eligible for trademark protection, a mark needs to be capable of distinguishing the goods or services from one source to another. Whether a mark is capable of doing this depends on whether the mark is ***inherently distinctive***.

Distinctiveness is evaluated along a spectrum ranging from highly distinctive marks to terms that are generic for the type of goods or services for which the mark is used, and therefore cannot be protected.

There are five categories along the spectrum:

Inherently Distinctive			Require Secondary Meaning	Cannot be Distinctive
Fanciful	Arbitrary	Suggestive	Descriptive	Generic

Inherently Distinctive

Fanciful, arbitrary, and suggestive marks are considered inherently distinctive, and can immediately identify the source of a specific product or service. These types of marks can be

registered on the USPTO's Principal Register without a showing that they are recognized as identifying the goods or services.

A *fanciful* mark is a made-up word. The mark only means something when it is related to a particular product.

Examples: XEROX (for copying machine); HAAGEN-DAZS (for ice cream).

An *arbitrary* mark is a commonly known word that has no connection to the class of products being sold.

Example: APPLE (for computers); BLACKBERRY (for smartphones)

A *suggestive* mark suggests something about the goods or services, but it does not immediately describe the goods or services.

Examples: COPPERTONE (for suntan lotion); MICROSOFT (for computer software).

Require Secondary Meaning

Descriptive terms can be protected as trademarks after they acquired distinctiveness, also known as "secondary meaning."

A *descriptive* mark is a mark that describes some characteristics, ingredients, features, or purpose of the product or service.

Cannot Be Distinctive

Generic terms can never obtain trademark protection.

A *generic* mark is a mark that uses a common term to name a product or service.

It's important to note that the categories are applied to marks as they relate to the good or services they represent. Thus, a mark that is generic for one good, such as an "apple," may be arbitrary or fanciful as applied to "personal computers."

Do I Need to Register my Mark to be Protected?

As we pointed out above, trademark protection is about use. With that said, registration is not necessary to get trademark protection when your mark is already in use. You will have common law trademark rights which can be enforced in the geographical area in which the mark is used.

However, federal registration gives a trademark owner several rights not available under common law and enhances the level of protection of the mark.

What Trademarks are Excluded from Registration?

Before you start the application to register your mark with the U.S. Patent & Trademark Office (USPTO), be aware that not every matter is eligible for registration as a trademark. The law can prohibit or restrict the registration of marks that consists of or comprises:

Deceptive matters

A mark cannot be registered if the mark falsely describes the material, content, quality, characteristic, function, composition, or use of a product, and the purchasers are likely to believe that the false description relates to the product and it will materially affect the decision to purchase the product for a significant portion of the relevant consumers. A deceptive mark cannot be registered on either the Principal Register or the Supplemental register; neither a disclaimer or a claim of acquired distinctiveness is enough to register a deceptive mark.

Example: SILKWEAR for clothes not made with silk.

Matters that falsely suggest an association with persons, institutions, beliefs, or national symbols

A mark cannot be registered if the mark falsely suggests a connection with persons, institutions, beliefs, or national symbols. A mark that falsely suggests a connection cannot be registered on either the Principal Register or the Supplemental Register.

A geographic term that identifies a place other than the origin of the goods (when related to wines or spirits)

A mark cannot use a geographic term to falsely suggest that wines or spirits are from a specific location if the purchasers would likely think that the wines or spirits come from that location, and this erroneous belief would be determinant to the purchaser's decision. This mark cannot be registered on either the Principal Register or the Supplemental Register; neither a disclaimer or a claim of acquired distinctiveness is enough to register a geographic deceptive mark.

Example: Coastal Cal Winery for a wine not made in California

The Flag, Coat of Arms, or insignia of the United States, or any State or Municipality, or Any Foreign Nation

This ban is self explanatory, and the mark cannot be registered on either the Principal Register or the Supplemental Register.

Names, portraits, or Signature of a particular living person or Deceased U.S. President during the life of his/her widow

A consent of the living person is necessary in order to register a mark that comprises a name, portrait, or signature of such living person, when the person is publicly connected with the business or is well known. In the case of the deceased U.S. president, a consent from his/her widow is required.

Example: Bündchen Dresses as reference to the supermodel Gisele Bündchen.

Confusingly similar marks

Marks are evaluated primarily based on both **appearance, sound and meaning**. The relatedness of the goods and services will also be considered in determining the similarity of the marks. The ban on confusingly similar marks applies to registrations on the Principal Register and Supplemental Register.

Example: Lyft and Lift.

Matters that are *primarily* geographically descriptive or primarily geographically deceptively misdescriptive

A geographically descriptive term is generally not capable of distinguishing the source of goods, as it is used to describe the place the goods or services come from. However, the registration of a mark will be refused only if the mark is "*primarily* geographically descriptive."

Couple caveats:

A mark is considered "*primarily* geographically descriptive" if the place is a generally known location, the goods and service come from the specified location, and consumers would likely make a connection that the goods or services come from this location.

Example: California Data Analytics for a software service that is from California.

Also, marks that are "*primarily* geographically descriptive" are not completely excluded from trademark protection, they're just not registrable on the principal register. Instead, they may

be registrable on the supplemental register, and may be elevated to the principal register if they become really well known.

On the other hand, a geographically deceptively misdescriptive term cannot be registered even if it becomes really well known. But a mark is only considered to be geographically deceptively misdescriptive if the place is a generally known location, the goods or services do not come from the specified location, the consumers would likely make a connection that the goods or services come from this location, and the misrepresentation is material factor in a relevant consumer's decision to buy the goods and services.

Example: Florida OJ for an orange juice that is not from Florida (considering all other requirements are met.)

Merely Descriptive

Marks that "merely describes" the material, content, quality, characteristic, function, composition, or use of the goods and the services cannot be registered on the Principal Register, unless it can show an acquired distinctiveness. Marks that "merely describes" the goods and the services may be registered on the Supplemental Register.

Example: Strawberry Creamy for ice cream made of strawberry.

It is important to remember that "descriptive terms" are different from "generic terms." Generic terms are the terms commonly used for a specific goods or services.

Example: Shoe, T-shirt.

Deceptive misdescriptive matter

Deceptive misdescriptive matters can be confused with d Vanillacream for ice cream not made with real vanilla.

Primarily Merely Surnames

A surname, or a family name, is generally not capable of distinguishing the source of goods since there are potentially any number of people with the same name. Also, it would be somewhat unfair if the first person named "Smith" was able to stop all the other Smith's from using their name to represent their business.

Example: Smith's Pizza

Couple caveats:

First, *primarily* and *merely* a surname implies that the name is generally known as a surname (and not an uncommon surname), and that the mark consists primarily of the surname. So names that are not generally recognized as surnames, or marks that consist of additional words, may be registrable.

Second, marks that are “primarily merely a surname” are not completely excluded from trademark protection, they’re just not registrable on the principal register. Instead, they may be registrable on the supplemental register, and may be elevated to the principal register if they become really well known (think of McDonalds®).

Statutory Protection

Federal Statutes and Regulations might prohibit or restrict the use of marks that contain words, names, symbols, etc., that are adopted by the United States Government, or a particular national or international organization.

Prohibitions Struck Down by the United States Supreme Court

In 2017 the United States Supreme Court held that prohibiting registration of marks that may disparage, or bring into contempt or disrepute, persons, institutions, beliefs, or national symbols is unconstitutional.

In 2019 the United States Supreme Court held that prohibiting registration of marks that are immoral or scandalous is unconstitutional.

Trademark Prosecution Process

(1) Trademark Analysis

Prior to registering a mark with the United States Patent and Trademark office, it is important to evaluate its registrability. A trademark needs to be evaluated to ensure its eligibility and that it will not be excluded from protection by the law.

(2) Trademark Search and Clearance

Once a legally protectable mark is selected, the next step is to conduct a search and clearance to ensure that the mark is available for use and registration.

(3) Trademark Use

Trademark protection exists in the first use of a mark as a trademark. This use requirement exists both at common law (without registration), and in obtaining a federal trademark registration from the U.S. Trademark Office.

(4) Application for Federal Registration of a Trademark

Once you have chosen a mark that you reasonably believe is available and registrable, the next step is to file for federal trademark protection through the USPTO's electronic filing system. The application consists of, among other things, identifying the goods and/or services, the mark format, the filing basis, and a specimen showing the use of the mark. You should also inform if you are seeking registration on the Principal Register or the Supplemental Register.

(5) Office Actions

After the trademark application is filed with the USPTO, an official USPTO file is created and an examining attorney is assigned to review the application. If there are any legal issues in the trademark application itself ("requirements") or with the chosen trademark ("refusals"), the assigned examining attorney will issue an office action. Generally, an office action must be responded to within six months. However some office actions have a shorter deadline.

(6) Publication in the Trademark Official Gazette

In a situation where there are no defects in a trademark application or where you can overcome an office action, the USPTO will approve the application for publication in the Official Gazette. The purpose of publication is to give the opportunity for the public to challenge the registration of the trademark.

(7) Trademark Registration

After your application is published in the Official Gazette and no opposition is filed by any third party (or if you win or settle the trademark opposition with the opposing party), the mark will be registered and a certification of registration will be issued. Now is the right time to celebrate and use the federal registration symbol ® !

If you would like to get more information on the trademark registration process with the United States Patent and Trademark Office please check our guide "Trademark Application Overview."

Trademark Post-Registration

The work is not done! There are important things that you need to do after you register your mark.

Maintain Your Trademark

Once you get your registration, you can't lose it, right?! These are a few things that you need to do to keep your registration alive: (1) keep using your mark as a trademark; (2) file the required maintenance documents with the USPTO; (3) delete from registration goods and/or services no longer in use; (4) monitor your registration status with the USPTO.

Monitor Your Trademark Use

Yes, you already know that you need to use your mark as a trademark. But the only way to do it right is monitoring your trademark use. You can lose your registration due to

abandonment of your mark or for failure to protect it. And don't forget, you are responsible for enforcing your own trademark rights.

Trademark Policing & Enforcement

We can't stress enough that you are responsible for policing and protecting your trademark. And you will need to act to enforce your trademark rights if you believe that a third party is infringing your trademark rights, or that you will be damaged by a third party registration of a mark.

If you would like to get more information on the trademark post registration please check our guide "Trademark Post-Registration Overview."