

TRADEMARK BASICS

A trademark is a word, name, symbol, or device that is used in trade with goods to indicate the source of the goods and to distinguish them from the goods of others.

There are 3 main types of trademarks with increasing levels of protection:

Common Law Trademark (™)

- No registration or fees
- Rights result from use of the mark with the product
- Little public notice of the use
- Owner may use the ™ symbol

State Trademark (™)

- Registration and small fee
- Public notice of use
- Protection varies by state, protection only *within* the state
- Owner may use the ™ symbol

Federal Trademark (®)

- More expensive fees and slower process
- Must use or have a genuine intent-to-use the mark in *interstate* commerce
- Presumption of ownership nationwide
- Exclusive right to use
- Public notice of use
- Trademark lasts indefinitely as long as renewal fees are paid and mark still in use
- Can be deposited with U.S. Customs to prevent importation of goods infringing mark
- Owner may use the ® symbol only after the mark has been fully registered with the U.S. Patent and Trademark Office

Some reasons a federal trademark may be refused:

- “Likelihood of confusion” with another trademark (most common reason)
- Immoral or scandalous
- Deceptive (e.g. misrepresents content or geographic region of product)
- Disparages or falsely suggests a connection to a person, institution, belief, or national symbol
- Mark protected by statute or convention (e.g. the American Red Cross, Olympic rings, NASA insignia, Smokey Bear)

TRADE NAMES

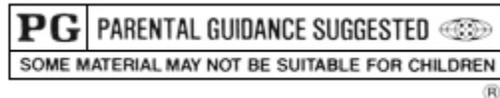
Trade names are not trademarks. Trademarks identify specific goods or services (service marks). A trade name is any name used by a person to identify his or her business or vocation. Federal law does not allow trade name registration and not all states offer it (Wyoming does).

For example, Proctor & Gamble sells many brand name products, including Crest[®] toothpaste and Pampers[®] diapers. Crest and Pampers are trademarks. Proctor & Gamble is the trade name.

OTHER MARKS

In addition to trademarks and service marks, the USPTO also registers certification marks, collective marks, and collective membership marks.

Certification Mark means any word, name, symbol, or device, used by a person other than its owner to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.



Collective Trademarks indicate commercial origin of goods or services, but as *collective* marks they indicate that the party providing the goods or services is a member of a certain group and meets its standards for admission.



Collective Membership Marks indicate that the user of the mark is a member of a particular organization.



For more information on these types of trademarks see Chapter 1300 of the Trademark Manual of Examining Procedure.

GEOGRAPHICAL INDICATORS

Geographical Indicators have recently become regulated as intellectual property around the world. GIs are associated with the reputation or characteristics of a region. Example GIs are Idaho potatoes and Roquefort cheese. GIs are generally registered as certification marks in the U.S.

TRADEMARKS CAN BE:

Word Marks: Hershey's, "Can you hear me now? Good.", Captain Jean-Luc Picard

Symbols or Designs:



The following types of trademarks are less common:

Color Marks: brown for delivery vehicles (UPS), pink for fiberglass insulation (Owens-Corning)

Configuration Marks: shape of Pizza Hut buildings, BMW grille

Sensory Marks: NBC chimes, MGM lion roar

STRENGTH OF TRADEMARKS

Trademarks also exist on a continuum of strength. The weakest marks are "generic" and "descriptive". Generic terms cannot be trademarked and descriptive marks can be registered only after long use creates a secondary meaning associated with it. Surnames are considered descriptive. Federal registrations often include terms disclaimed as being generic.

The next mark on the continuum would be the suggestive mark. These marks suggest a characteristic of the product and are slightly differently from descriptive marks because a little imagination is required to discern the type of product. An example would be Microsoft (software for microcomputers).

Next are arbitrary marks which are words that have a meaning already associated with them but not to the product. An example would be Apple for computers.

The strongest marks are coined marks. These are words invented only to be used as trademarks and have no prior meaning. Examples of coined marks are Xerox and Kodak. These marks are also the most difficult to get consumers to associate with a type of product.

It is the responsibility of the owner of a trademark to monitor possible infringement and to exercise the rights associated with a federal registration. The USPTO will not do it for you.