



Selecting and Protecting Your Trademark

One of the most frequently asked questions a trademark attorney hears is: “How do I get a trademark?” As a service to our friends and clients, we have written this document in a step-by-step fashion in order to make the trademark process easier to understand and follow.

Step 1: Selecting the Mark

Selecting a strong, registrable mark is the most important step. Trademarks can be categorized according to strength as follows:



GROUP 1	Fictitious – invented words (e.g., KODAK® for cameras or EXXON® for petroleum products)
GROUP 2	Arbitrary – marks that have no relationship to the goods (e.g., APPLE for computers)
GROUP 3	Suggestive – marks that suggest qualities of the goods (e.g., SAFEWAY™ for good stores, DOLPHIN™ for swimwear)
GROUP 4	Descriptive – marks that describe a characteristic of the goods (e.g., SUPERIOR, BEST, STRONG) Geographically Descriptive – (e.g., PEBBLE BEACH, CAMBRIDGE) Surnames – (e.g., TAYLOR, SMITH)
GROUP 5	Generic – words commonly used throughout an industry (e.g., SOFTWARE for computer programs, LITE for beer)

Trademark attorneys prefer marks that are *fictitious* or *arbitrary* (Groups 1 & 2) because the likelihood of trademark conflict is relatively low and marks of this type generally enjoy a broad scope of protection. It is very useful to remember that there are more than 2,000,000 federally registered U.S. trademarks, of which approximately 750,000 are still active, and that there are only about 30,000 words in the active English vocabulary. With that in mind, the potential of two people using the same common word as a trademark on similar goods or services is extremely high. Therefore, if possible, the client should seriously consider selecting a *fictitious* or *arbitrary* mark because those marks have a higher likelihood of becoming federally registered and a lower likelihood of infringing existing marks.

The preference for *fictitious* or *arbitrary* marks must often be balanced against the desires of advertising professionals who would rather select marks that tell what the product is or what it does. As a result, *suggestive* marks (Group 3) are often adopted as a compromise solution. *Suggestive* marks are more difficult to register than *fictitious* or *arbitrary* marks and their scope of protection more narrow, but they are still recognized as distinctive marks by the federal courts and the U.S. Trademark Office.

Every effort should be made to avoid a mark that falls into the generally *descriptive* category (Group 4). *Descriptive* marks are not registrable on the Principal Register without a special showing of distinctiveness and are, therefore, extremely difficult to protect. Names that are geographically *descriptive* (e.g., Pebble Beach, Cambridge) or primarily *surnames* (e.g., Taylor, Smith) should also be avoided because they are also considered inherently non-distinctive.

Generic terms (Group 5) cannot be registered under any circumstance. For this reason, they must be avoided. No person can prevent another person from using the same generic term to identify his or her goods or services.

In addition to determining if a mark is federally registrable and free of likely legal conflicts, a good trademark should also be able to pass the following marketing tests:

Memorability

Is it a trademark people can remember? Is the trademark too long and cumbersome?

Spellability

Will the average user spell it the same way twice? Is it Phish® or Fish? Is it Exxon® or Exon or Xon?

Pronouncability

Can people pronounce it easily, especially if they only see the trademark in print?

Associations

Do the words in the trademark have negative associations or meanings? Do the words have an unintended unpleasant meaning when translated into a foreign language?

The selection of a suitable trademark can be a major undertaking if the product has significant worldwide exposure. It is not uncommon for large corporations to spend hundreds of thousands of dollars on surveys, focus groups and multicountry legal opinions. While that level of heroic effort may not be necessary for most trademarks, it does demonstrate how sophisticated the trademark selection process can be if millions of dollars are riding on a successful product launch.

Step 2: Searching the Mark

The importance of a comprehensive, professional trademark search cannot be overemphasized. Rights in a trademark generally belong to the first party to use the mark. For this reason, one must be sure that there are no prior users of confusingly similar marks before making the final decision to adopt a mark. Nothing is more discouraging than changing trademarks six months or a year after beginning a new trademark promotion. The loss of good will and advertising can be devastating.

Approximately 60 percent of all trademark searches come back with recommendations that the client not use the particular mark under consideration. The likelihood of conflict, and, therefore, rejection is less for an *arbitrary* or *fictitious* mark and tends to increase as the proposed mark moves toward marks that are descriptive in nature.

A professional trademark search should go well beyond the records of the U.S. Trademark Office because a federal trademark application can be opposed by the owner of an unregistered trade name or trademark as well as the owner of a registered mark. For this reason, the trademark search should cover, at a minimum, the following:

- All current federal trademark registrations
- All pending federal trademark applications

- All abandoned federal trademark registrations
- All state trademark registrations in the 50 states
- All business names in the 50 states
- Marks found in trade directories, catalogs, etc., and otherwise not classified
- Internet addresses and URLs

Marks usually take one of three different forms:

1. Word mark only (i.e., mark with no design element)
2. Words and designs (e.g., logos)
3. Designs only (i.e., mark without a word component)

Word and design features should be separately searched and separately registered, where economically possible.

The trademark search is usually performed by one of several large organizations that employ professional trademark specialists to investigate a very large database of information. The search will identify all marks that the searcher believes might be relevant to the proposed mark. It is then the trademark attorney's job to review the unorganized data received from the professional trademark searcher and prepare a trademark search report. The typical trademark search report includes an opinion of the client's chances of obtaining a federal trademark registration, as well as an opinion of whether the proposed mark infringes existing trademarks. Even though care is exercised in searching a trademark, there is always a margin of error since no trademark database is ever 100 percent accurate or up-to-date.

Step 3: Registering the Mark with the U.S. Government

Once the mark has been chosen and cleared by a professional trademark search, an application should be filed in the United States Patent and Trademark Office to register the mark federally.

If the application is based upon actual use:

- The mark must be applied to the goods and services in the correct form.
- The goods or services must be sold in interstate commerce before the application can be filed.

A trademark application based upon actual use requires three specimens of the mark as actually used as well as a completed application, which includes information about the applicant, the goods and services and the dates of use. If an application is based upon actual use, the specimens are critical. If the mark is applied to the goods, the specimens usually comprise product labels that prominently display the mark as well as other relevant product information. Photographs of the mark as it appears on the goods are also acceptable specimens of use. If

the mark is applied to services, then brochures or advertisements offering the services under the mark are required. Certain items, such as stationery, are generally not considered to be acceptable as trademark or service mark specimens. If the trademark specimens do not conform to the strict requirements of the U.S. Trademark Office, then the application will be rejected.

Prior to November 16, 1989, actual use was the only basis upon which a U.S.-based company or U.S. citizen could file a trademark application. This, unfortunately, is no longer true. Applications can now be based upon a “good faith intention” to use the mark on goods or services in the future. The most significant feature of this new filing provision is that the filing date of the application becomes the applicant’s date of first use of the mark so long as the application ultimately results in the issuance of a registration.

An ***Intent to Use (ITU)*** application is similar to an actual use application except that the applicant need not submit dates of use information or specimens of use at the time the application is filed. Instead, the applicant has six months (extendible up to 30 more months on the payment of extension fees) after the mark has been allowed and successfully published or opposition, to use the mark and submit dates and specimens of actual use to the U.S. Trademark Office. It is only after actual use of the mark and submission of use dates and specimens to the U.S. Trademark Office that a federal trademark registration will issue.

The examination of a typical federal trademark application takes about one year. Once the application is considered to be in proper form by the U.S. Trademark Examiner to whom it has been assigned, it is published for opposition purposes in the OFFICIAL U.S. TRADEMARK GAZETTE. The OFFICIAL TRADEMARK GAZETTE is published weekly. If no third party files an opposition to the mark within 30 days of publication in the OFFICIAL TRADEMARK GAZETTE, then a U.S. Trademark Registration will issue (unless, of course, the mark is an ITU, in which case a Statement of Use and specimens have to be filed after the mark is allowed and published – as previously explained). The ® symbol can only be used **after** a federal trademark registration certificate has been issued. Prior to that time, the ™ symbol should appear whenever the mark is used.

By carefully following the foregoing three key steps – namely, careful selection, a comprehensive search and registration – a trademark user will be able to develop maximum legal rights in a new trademark. Once rights in a new trademark are firmly established, it is important to take further steps so that those rights are not subsequently lost.

Renewal of Federal Trademark Registration

A trademark registration must be renewed every 10 years. In addition, between the fifth and sixth years of the first 10-year

term of a U.S. trademark registration, it is necessary to file an Affidavit Under Section 8 of the Lanham Act, indicating that the mark continues to be in use. The purpose of the Section 8 Affidavit is to weed out marks that have been discontinued in order to keep the active files of the U.S. Trademark Office current. The mark should not change from the form initially registered. If the presentation of the mark does change, it is possible that the U.S. Trademark Office will not accept the Section 8 Affidavit or the 10-year renewal application, resulting in the cancellation or expiration of the trademark registration.

International Trademark Rights

Trademark rights in overseas countries are generally obtained on a country-by-country basis. As with U.S. trademark applications, it is highly desirable to perform an international trademark search before filing trademark applications overseas. Sometimes an abbreviated worldwide identity search (WISS) is sufficient. If an international trademark application is filed within six months of a U.S. trademark application, it will be given an effective filing date of the U.S. application in most industrialized countries. As of June 1995, it has become possible to file a single trademark application in Europe known as a Community Trademark Application. As of November 2003, the United States joined the Madrid Protocol, an international agreement between 61+ countries. It is now possible for U.S. trademark owners to submit an international application to the United States Patent and Trademark Office to forward to the International Bureau in Geneva, Switzerland. The international application would give a U.S. trademark owner the possibility to have his or her mark protected in a number of countries by simply filing one application, in one language with one set of fees in one currency. An international registration produces the same effects as an application for registration of the mark made in each of the countries designated. An extensive overseas trademark program can be expensive because it is necessary to pay regular maintenance fees to keep international marks in force. A careful return on investment analysis should be made before committing to an international trademark program.

Policing the Mark

It is important to aggressively police the activities of others once a federal trademark registration is obtained. If a registered mark is infringed by another party, it is necessary to resolve the problem at an early stage. If the infringement is caught soon enough, it is usually possible to settle the trademark dispute on an amicable basis. If, however, a trademark infringement is tolerated for a long period of time, then the matter becomes much more difficult to settle. At that point, the infringers may have invested so much money and effort into promoting the mark that it would be prohibitively difficult and expensive for them to discontinue. In addition, the courts may permit continuing use by the infringers if the original trademark owner waits too long to enforce his rights.

Consistent, continuous use of a mark coupled with aggressive policing is the best way to protect trademark rights once they have been established.

Conclusion

A strong trademark can be a very valuable asset. Consider how much the KODAK®, POLAROID®, XEROX®, EXXON® and COCA-COLA® marks are worth to their

respective owners. Trademarks form the backbone of many legal relationships, such as franchise agreements. A poorly chosen mark, however, especially if it is unregistered, is an invitation to serious legal and financial problems. The role of your trademark attorney is to make the trademark selection, searching and registration process as easy as possible. If you have any questions about trademarks, please do not hesitate to give us a call.



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