HOW YOU CAN SELECT AND PROTECT THE BEST TRADEMARKS

A trademark is a proprietary adjective – a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs -- that identifies and distinguishes the source of the goods of one party from those of others – basically, it is the name of the product. A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product. In order to be protectable and enforceable, a term must qualify as a trademark. The more distinctive the mark, the stronger the protection. First, and probably most important to an understanding of trademarks, is that trademark law is highly subjective. While there are clear statutes and rules followed by the courts and United States Trademark Office ("USPTO"), determining whether and how they apply to a particular trademark in a particular situation can be very much a "grey area."

Trademarks are generally categorized in terms of their "strength" or "weakness". The strongest marks have no meaning at all or no meaning in relation to the goods or services for which they are used. The weakest marks are those that describe the goods or services in some way.

Trademarks tend to fall into the following categories:

1. Very Strong: Fanciful
   -- words that are made up and have no meaning other than as a brand name (XEROX for photocopiers) or abstract designs used as logos

2. Very Strong to Strong: Arbitrary
   -- words that have a common meaning (Apple for fruit) but not in relation to the goods or services for which they are used as brand names (APPLE for computers) or recognizable designs similarly used out of context (the Apple Logo for computers).

3. Strong to Weak: Suggestive
   -- words or designs that evoke the goods or services, but require some thought to make the connection (IVORY for soap); the less thought required, the less protection. The concept is you've chosen a word or design that is not required to describe the product or service, it only suggests the qualities and is considered inherently distinctive.

4. Weak to Not Protectable: Descriptive
   -- words or designs that describe some feature or aspect of the goods or services, including their features, characteristics, function, location, purpose and the like (Kool for menthol cigarettes; FRUIT LOOPS for fruit-flavored circular breakfast cereal). Descriptive marks are generally not protectable unless and until they have

been in use for at least a few years and have acquired distinctiveness as being recognized as a trademark of that owner, rather than a generally descriptive term.

5. Not Protectable: Generic
   -- words or designs that identify the actual product or service (such as wine, car, table or restaurant). Generic terms are never protectable because they are nouns (not adjectives), and therefore identify the product or service itself, not the source of those goods or services.

A strong mark is generally protectable and enforceable against any subsequent use of the same or similar mark for the same, similar, or related goods or services. Particularly strong marks may even be protectable against the same mark for unrelated goods or services. This is the category you want your trademark to be in. By selecting a strong mark you will have the best foundation for developing a valuable brand that is entitled to the broadest possible protection. A great place to begin!

A weak mark is generally protectable only against the same or substantially similar mark for the same or substantially similar goods or services. Particularly weak marks may be protectable only against the same mark for the same goods and services. Additionally, the weaker the mark, the more expensive it is to protect and enforce because there are likely to be far more users of the same or similar marks for the same or similar goods or services. You should stay clear of marks that fall into this category.

Use and Registration

Trademark rights in the United States arise on actual use of the mark on or in connection with the actual goods or services.

Use without registration is called “common law” use. Common law rights arise on first use of the mark and extend only to the actual scope, manner, and geographic location of the use. For example, use only in San Francisco is protectable only in San Francisco, not in Los Angeles.

There are two types of statutory trademarks – state and federal. These require that the trademarks be registered with the relevant agencies.

A state trademark registration is enforceable within the boundaries of the entire state. Once you have actual use anywhere in the state, you can obtain a state registration. With a California state registration, even if you only have use in San Francisco, you can enforce your trademark in Los Angeles. But you can’t enforce a California registration against an infringer in New York. A state registration is obtained by filing an application with proof of use and the statutory filing fee. State trademark applications generally are processed without objection, but occasionally require additional prosecution. A state registration is valid for ten years from registration, and can be renewed for subsequent ten year periods as long as the mark continues to be used.

A federal trademark registration is enforceable within the boundaries of the entire US, including DC, and the various US possessions and Territories. Before you can obtain a federal registration, the mark must be used in interstate commerce (between two or more states). However, you can file a federal application to register the mark before you have any use; it simply won't issue to registration until you have filed proof of the requisite use during the statutory period for doing so. A federal registration is not enforceable outside of the US.

The United States recognizes 45 different categories of goods and services, called International Classes – 34 for goods and 11 for services.

The process for filing a federal registration is fairly straightforward. An application identifying the mark and the goods or services to be filed in the relevant International Class is filed in the USPTO, along with a statutory filing fee. The application is reviewed by an Examiner approximately 8 or 9 months after filing. The Examiner will determine if the mark is registrable from a number of perspectives: (i) substantively (whether it meets legal requirements for registrability); (ii) procedurally (whether the various descriptions or information provided conform to USPTO requirements); and in terms of any prior filed or registered marks in the USPTO (state registrations and common law uses are not part of the process). If the Examiner has problems with the application, an Office Action will issue. Depending on the nature of the issue, the response may require legal research and the submission of a legal memorandum arguing the registrability of the mark as filed. If the Examiner accepts the arguments, the application will be approved. If not, one or more additional Office Actions may issue, up to a "Final" Office Action refusing registration (which then requires either a Request for Reconsideration and/or an appeal to the Trademark Trial and Appeal Board.)

Assuming the Examiner approves the mark for registration, it is then published in the Official Gazette for opposition purposes. Publication is a 30 day period in which anyone "believing they will be damaged by the registration" can oppose the application (or file an extension of time in which to do so). An opposition is an administrative action before the Trademark Trial and Appeal Board; it is similar to a civil action for infringement.

If no opposition is filed, the application will be registered if the relevant "proof of use" has been filed prior to publication. Otherwise, a Notice of Allowance will issue, giving the applicant approximately 3 more years in which to file its proof of use (6 month extensions of time are required to be filed in the interim). Once the proof of use is filed, the registration will issue. If no proof of use is filed, the application will go abandoned.

Once registered, a federal registration is valid for ten years from the date of registration, although proof of use must be filed between the fifth and sixth anniversary in order to maintain the registration for the duration of the ten year period. Thereafter, the registration can be renewed for subsequent ten year periods as long as the mark continues to be used.

Searches

A search is usually performed prior to filing an application (especially a federal application). A search is a computer generated report comprised of citations of prior federal applications and registrations, prior state registrations, and common law uses that are the same or substantially similar to the mark and goods or services being searched. The search is a tool to determine whether a mark is registrable and protectable, as well as potential obstacles and/or risks to use and registration of the proposed mark. It cannot (and does not) guarantee the availability of a mark.

The results of an availability opinion cannot be 100% guaranteed for many reasons, including the subjective nature of trademark searches; the subjective judgment of the searcher; incomplete data provided by the United States Trademark Office due to delays in processing applications filed shortly prior to the preparation date of this or any of the underlying search reports; etc. The search results do not take into account trademark applications filed or uses commenced subsequent to the preparation date of the relevant search. If the description of the products or services is incorrect, is too broad, or changes from the original description, the results of the search might be inapplicable.

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