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Protecting Intellectual Property

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Abstract

This article provides an overview of trademark registration with the United States Patent and Trademark Office (USPTO). It is advisable to retain an experienced US trademark attorney to aid in trademark filing to ensure maximum success and the broadest protection possible for a company's trademarks. An understanding of the process can help your attorney ensure a successful application outcome, while saving time and money.

Keywords: intellectual property; trademarks; protection; how to

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INTRODUCTION

A trademark is a word, phrase, design, or combination thereof that is used to indicate the source of origin of goods and services, and to distinguish those goods and services in the marketplace. In the US, protection is extended to unregistered trademarks under common law and to registered trademarks under Federal Law. This article provides an overview of trademark registration with the United States Patent and Trademark Office (USPTO). Careful planning prior to filing for trademark protection can save time and money, thus aid in a successful registration.

Selecting a Trademark

In the US, the strength of a trademark is based on a four point spectrum that goes from least protectable to most protectable. Generally, a mark higher up on the spectrum will have the least amount of obstacles to registration. The spectrum is as follows:

A. Generic

Generic trademarks cannot be protected. They do not function as trademarks but rather as common names for the goods or services. An example is “*COFFEE*” brand coffee. If “*COFFEE*” were registered as a trademark for coffee, it would effectively preclude others from using coffee as a common name for coffee.

B. Descriptive

Like generic marks, descriptive marks also cannot be registered. A descriptive mark merely describes the goods it is protecting. However, descriptive marks that acquire secondary meaning through use are protectable. Secondary meaning occurs when a trademark is established in the mind of consumers as having originated from a particular source. For example, “*AMERICAN AIRLINES*” describes an airline from America, but through acquired secondary meaning has come to mean a specific airline.

C. Suggestive

A suggestive trademark evokes the goods or services that it designates, usually by describing a characteristic of that good or service. Unlike descriptive marks, suggestive marks do not require secondary meaning to be protected. Examples of suggestive marks are “*7-ELEVEN*” for a store open from 7 to 11, “*COPPERTONE*” for suntan lotion, and “*LIQUID PAPER*” for correction fluid.

Arbitrary or Fanciful

Arbitrary trademarks use common names that have no logical association to the designated goods or services. “*APPLE*” used to designate computers is arbitrary, but when used in connection with apples or apple sauce, it may be either generic or descriptive.

Fanciful trademarks are invented words used solely as trademarks and have no connection to the good or services that they designate. Examples include “*GOOGLE*” for a search engine, “*XEROX*” for photocopiers, and “*KODAK*” for cameras. A fanciful trademark is the least likely to be rejected by the USPTO for likelihood of confusion or to face opposition from another trademark holder.

A Note on Foreign Language Trademarks

When the trademark is a word in a foreign language, the USPTO will first translate the word into its English equivalent before classifying the mark. Therefore, foreign words can be rejected for being generic or descriptive.

Goods and Services

A trademark designates goods and services. All goods and services represented by the trademark must be divided into two categories: “currently being used in US commerce” and “intended to be used within the next three years in US

commerce." It is possible to have a trademark application with goods and services that include both 'use' and 'intent to use', however, this is not desirable, as the trademark will not register until all the goods and services are being used.

Goods and services are divided into categories known as *classes*. For example, clothing and shoes are in one class, while books and magazines are in a different class. The USPTO filing fee includes one class, and each separate class requires the payment of an additional fee. Goods and services can be divided into classes at the filing stage, or later by the USPTO Trademark Examiner.

THE VALUE OF A SEARCH

To determine whether a proposed mark is a good business risk, a search of existing trademarks should be conducted prior to filing a trademark and spending money on marketing and product packaging. Although not mandatory, a search can help prevent investment in a trademark that is likely to be rejected by the USPTO or opposed by someone with the same or similar trademark rights.

A basic search is limited to investigating the USPTO's trademark database for the proposed trademark and any analogous goods and services. A full search also discloses state trademarks, state business names, entries in specialized databases, the Internet and domain names.

In either a basic search or a full search, an attorney should analyze the search results and issue an opinion on the advisability of filing for trademark protection. It is prudent to prepare a list of alternatives, in the event that the desired mark is not a good business risk.

Once the proposed trademark has received a favorable search opinion, the trademark attorney can prepare an application.

APPLICATION REQUIREMENTS

Trademark applications may be based on use in commerce ("use") or based on intent to use in commerce ("intent to use").

Use in Commerce

A use based application affirms to the USPTO that the trademark is currently being used in interstate commerce in the US. Use is demonstrated by providing the date of first use anywhere in the world, the date of first use in US interstate commerce, and a suitable specimen for each class in the application.

Specimens are evidence of use. They are generally submitted as digital photos and must show the trademark being used in conjunction with the goods or services. Appropriate specimens for goods include product labels, packaging or

displays. Appropriate specimens for services range from a web site screenshots, business cards, stationary, to marketing and promotional materials.

Intent to Use

An intent to use application allows an applicant to *reserve* a trademark that they are not currently using in commerce, but for which they have a bona fide intent to use the trademark within a three year period. Intent to use applications have additional requirements, which are beyond the scope of this article and should be addressed by a trademark attorney.

Filing for Protection

Prior to filing a trademark, the following basic information is required:

- The name and address of the owner of the mark. A non-US citizen or non-resident can apply for trademark protection, but must provide the address of a “domestic representative”, generally an attorney in the US.
- The state or country of formation (if the applicant is a company).
- A representation of the trademark. A trademark that includes a design or special font requires submission of a clear image.
- The list of goods and services covered by the mark, and whether these are based on “use” or “intent to use”.
- The dates of first use in commerce for each class (for a use based application).
- A specimen for each class (for a use based application).

OFFICE ACTIONS

Applying for a trademark does not necessarily mean that it will proceed directly to registration. In some cases, trademarks will be issued an *office action*, which is a reply from a USPTO Trademark Examiner listing additional requirements that must be addressed before the application can proceed to registration. Office actions can be *non-substantive*, *substantive* or both. Non-substantive office actions are generally simple formalities, whereas substantive office actions require legal arguments to overcome. These include rejections based on likelihood of confusion with the applied-for trademark and the same or similar pre-existing marks, or rejection based on a mark's descriptiveness.

Non-substantive office actions are generally easy to comply with, whereas substantive office actions can be more difficult, and therefore expensive and are best avoided at the filing stage. Selecting a suggestive, arbitrary or fanciful trademark and conducting a search can help to avoid office actions that allege descriptiveness and likelihood of confusion.

PUBLICATION

Once all objections to the application have been overcome, the trademark is published in the Trademark Official Gazette for thirty days. Publication allows

third parties to object to the registration of a trademark that will damage their own, which they do by filing an opposition to the published trademark. If no opposition is filed, then a trademark based on use will proceed to registration, whereas a trademark based on intent to use will proceed to allowance.

REGISTRATION AND MAINTENANCE

After registration, a trademark must be maintained or it will become abandoned. The first maintenance date is due between the fifth and sixth years from the date of registration, at which time, a Declaration of Use (also known as a Section 8), along with a current specimen showing use (one per class) must be filed with the USPTO. If the mark has been used for five consecutive years, then a Declaration of Incontestability (also known as a Section 15) may also be filed. A Section 15 Declaration is optional but desirable, as it provides the trademark holder with additional benefits. After the five year maintenance is filed, the trademark can be renewed every ten years from the date of registration, provided it is still being used in commerce.

REFERENCES

The United States Patent and Trademark Office <http://www.uspto.gov>