

Trademark Law Basics
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What is a trademark?

A trademark is a word, slogan, symbol, design, or combination of these elements, which identifies and distinguishes the goods or services of one party from those of another. The word “trademark” is frequently used to encompass other source identifiers such as service marks, trade dress and trade names. Trademarks help consumers identify the source of goods and services and make choices based on past experiences with the brand. For that reason it is important to advise your clients to choose strong, distinctive trademarks that allow them to build goodwill and brand reputation in the goods or services they sell.

What makes a trademark strong?

A common mistake clients make is to choose a trademark that describes a feature or characteristic of the goods or services to be offered under the brand. However, it is quite difficult to stop competitors from using a mark that is merely descriptive of products and services. The more distinctive a mark is, the wider the mark’s scope of protection will be. Trademarks can be categorized as having the following levels of strength:

Fanciful or coined marks: These are made up terms that have no meaning other than as a brand name, such as KODAK for cameras or EXXON for gasoline. Such marks generally receive the broadest scope of protection.

Arbitrary marks: These are words that have a common meaning but are used for unrelated goods or services, such as APPLE for computers or BLACKBERRY for smartphones.

Suggestive marks: These marks suggest an attribute of the goods or services, but do not describe them, such as COPPERTONE for suntan lotion or MICROSOFT for software for microcomputers.

Descriptive marks: These are terms that describe the good or services or their characteristics and cannot initially be protected as trademarks until they have “acquired distinctiveness” or “secondary meaning” through long and substantially exclusive use. Examples of descriptive marks that have acquired secondary meaning are INTERNATIONAL BUSINESS MACHINES for computers and other business machines, WINDOWS for windowing software and HOLIDAY INN for hotels.

Generic marks: The generic word for a type of product or service such as “paint” or “desk” can never be a trademark or service mark for that product or service. Trademark owners must be careful to properly use their trademarks to protect them from “genericide”, a fate suffered by former trademarks such as CELLOPHANE and ESCALATOR, and narrowly avoided by KLEENEX and XEROX.

Should a trademark be registered?

In the United States trademark rights are established by use of the mark. However registering a trademark with the United States Patent and Trademark Office increases the protection a

trademark receives by providing a legal presumption of ownership of the mark and the exclusive right to use the mark nationwide in connection with the goods or services listed in the registration. Once registered, the owner may use the registration symbol with the trademark, which provides public notice of the claim to ownership and prevents the defense of innocent infringement. The United States Patent and Trademark Office will refuse registration to any trademarks it deems confusingly similar to a previously filed or registered trademark. Registration also provides greater remedies for infringement such as the right to recover up to triple damages and attorney's fees. Additionally the owner of a registered trademark has an automatic right to sue in federal court. Further a United States Trademark Registration can be used as a basis for obtaining registration in foreign countries and for preventing importation of infringing foreign goods. Registration of a trademark with the Colorado Secretary of State does not afford any of these benefits, but it does provide notice of the common law trademark rights claimed in the registration within the state as of the date of filing.

What is involved in filing a trademark registration with the United States Patent and Trademark Office?

Applications for registration may be filed online at www.uspto.gov. The application can be filed based upon use or bona intent to use the trademark in the future. The filer must decide upon a description that most broadly identifies the goods and/or services for which the trademark will be used. A link to the Trademark Acceptable Identification of Goods and Services is provided in the online form. The filer must also choose among the 45 classifications of goods and services that best categorize the items included in the application. For a use-based application a specimen of use for each class as well as a date of first use anywhere and a date of first use in interstate commerce must be provided. These entries are deferred to a later filing of a Statement of Use for an application based upon intent to use. The application is examined within approximately 3 months of the filing date and an Office Action may be issued to resolve any issues with the application or any ground for a refusal to register. A response to an Office Action must be filed within 6 months. Once the application is approved it is published in the Official Gazette. If the application is not opposed within thirty days, the application will move toward issuance of a Certificate of Registration for a use-based application or a Notice of Allowance for an application based upon intent to use. The Notice of Allowance triggers a series of 6 month periods within which the Statement of Use must be filed or an extension of an additional 6 months may be requested. The average time between the filing of an application and the issuance of a Certificate of Registration or Notice of Allowance is currently just under a year. This period can be much longer for applications that face challenges such as refusals or oppositions.

Can a trademark be registered in other countries?

Yes. Trademark registration should be considered in countries in which your client is offering, or intends to offer, products and services. Use of a mark is not required before filing an application in the U.S. and in most other countries. It is now possible to file a trademark application in the United States through the Madrid Agreement and the Madrid Protocol for an international registration that will cover multiple member countries. It is important to keep in mind that, unlike the U.S., the majority of the world employs a "first to file" system whereby the first party to file an application for a trademark is the first who obtains rights to use the mark.

What other actions can be taken to enhance the value of a trademark?

The quality of the goods and services must be maintained to ensure consumer confidence and to strengthen the trademark. Do not weaken the trademark by using different variations and blurring its distinctiveness.

Following these rules for proper use will help protect the trademarks:

1. Use the trademark as an adjective with the generic name of the product following the mark, such as KLEENEX® tissues;
2. Distinguish the trademark from surrounding text by capitalizing the trademark, using a distinctive typeface, or at the very least, capitalizing the first letter of the trademark;
3. If the mark is registered use the registration symbol ® whenever it is used in connection with the registered goods or services;
4. Do not use the trademark in the possessive form or pluralize a singular mark;
5. Be on the lookout for potentially infringing uses and take steps to stop others from using the same or similar trademark for similar goods and services;
6. Do not let others use the trademark without a written license requiring quality assurances and proper usage guidelines.

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