

# TRADEMARK REGISTRATION

This paper briefly explains US trademark law. It describes how to search for trademarks and register a trademark in the US and internationally. It also discusses considerations in choosing and using a trademark.

## What is a trademark

Technically speaking, the owner of a registered trademark has the legal right to prevent others from using this mark in a way as to cause confusion about the products or services that the trademark owner provides. This does not give the "owner" of the trademark a total monopoly on its use. For example, if one trademarks the word *Lotus* to refer to a brand name for a car, this does not prevent someone else from using *Lotus 1-2-3* to refer to a computer program, since these are in two different fields of use and unlikely to create any confusion.

Trademarks are used to describe products. Service marks are used to describe services. Service marks are treated the same as trademarks from a legal standpoint. "Trade dress" is the overall appearance of a product and or its packaging. This may also be protected in a way similar to trademarks, but the law on this is quite complex. It appears that in some cases, trade dress law may be used to protect graphical user interface designs. It is also possible to protect the aesthetic appearance of a product using a design patent. This is covered in a related article on Patent Strategy at <http://www.corp21.com>.

## The Characteristics of a good trademark

For marketing reasons, it is best to have a trademark that is memorable to customers. A trademark that is more distinctive or memorable is considered "strong" and gets stronger legal protection than a mark that is less unique or more difficult to remember. However, with strong market presence and advertising, a weak mark can be made stronger. For example, *Windows* had relatively weak claims on being a trademark. However, with millions of copies being sold by Microsoft and lots of promotion, it is now a relatively strong mark.

Some types of trademarks are considered to be inherently strong. This includes fancy designed graphics, made-up words (like *Google*), and words that have historically have had nothing to do together (like *Virtue Technology*). A direct description (like *Personal Report Writer*), reference to a geographic location (like *Omaha Steak*), or mark that uses a person's last name (like *Dell Computer*), is

considered to be a weak mark, but can become strong through continuous use.

Generic words or symbols that have a history of being used to describe an entire category or class of products cannot be trademarked by themselves. Examples are: "hiking boot", "programming language", "scrollbar", "stethoscope", "apple", and "computer". A fanciful combination of these, like *Apple Computer*, can be trademarked.

## Basic US trademark law

Generally, the first user of a trademark owns it. One can qualify as the first user either by:

- Being the first to actually use a trademark on a product or in marketing a product. This should be done by using the mark and a superscript "TM" ("SM" for service marks) whenever you use this name, to let others know you consider this to be a trademark.
- By registering the trademark in the federal or a state register.

The advantages of registering a trademark in the federal register are:

- The owner of the mark is presumed to have the exclusive right to use this mark nationwide.
- Everyone in the US is presumed to know that this mark is already taken.
- The trademark owner gets the right to use the symbol ® after the trademark.
- Anyone who begins to use the mark after the mark has been registered is presumed to be a "willful infringer" and the trademark owner can collect more damages than if the trademark was not in the federal register.
- The trademark owner obtains the right to make the trademark "incontestable" by keeping it in continuous use for five years. This reduces the possibility that others can legally challenge the mark on the grounds that it was insufficiently distinctive to warrant protection.

## How to search a trademark

There are two primary places to conduct a trademark search:

1. On the internet. I usually search by typing the proposed trade name into Google and seeing how many and what references come up. For example, when I typed the name "Tridget" into the internet for the potential name of a software product, I discovered that tridget.com had been taken for a personal website and that there were over ten references to a pornographic movie having a character in it named "Tridget". This meant that it was probably distinctive enough to use as a registered trademark for this product, but probably not a great choice.

2. By checking the federal register. This is located at <http://www.uspto.gov>.

If you would like to do a further search, there are companies that will perform this search, but make no guarantees. One of these that is more highly recommended than others because it grew out of an offshoot of the US Patent and Trademark office is the Sunnyvale Center on Innovation and Ideas which can be found at <http://www.sci3.com>.

#### **How to register a trademark in the US**

Once you have done a search and feel comfortable that (1) you are not infringing on anyone else who might have already registered the mark you intend to use and (2) feel that this mark will not be disallowed because it is already in common use, then you can register this mark for \$335 (as of November 2003) by making an electronic filing at <http://www.uspto.gov>. You cannot register a trademark until you actually are using it on your product. However, for a \$100 fee you can file an "Intent to Use" to give you six months before you actually use the mark on a product. This is useful if you are concerned that someone might "steal" your mark. You can apply to extend this "intent to use" for up to five more six month periods by paying \$100 each time.

#### **How to register a trademark internationally**

In general, getting trademark protection in the US is sufficient. However, if you would like to get international protection, there is a Madrid Convention that covers this. More information about this is available at <http://www.wipo.int/madrid>.

#### **Other considerations**

Unlike patents and copyrights, there is no outside limit on how long trademark ownership lasts. You lose ownership if the trademark is abandoned if:

- You don't use the trademark for an extended period of time;
- You fail to protest the unauthorized use of the trademark by others; or

- You authorize others to use the trademark without properly supervising how it is used.

#### **Conclusions:**

This paper provides a brief practical overview of what I know about trademarks. However, I am not a trademark expert and make no claims to know all of the details or nuances of the law.

I hope that you have found overview helpful. Please let me know if you have any comments, corrections, questions or suggestions for areas that should be covered in more depth.

The following are three references if you'd like to explore this topic in greater depth:

- Elias, Stephan and Richard Storm. *Patent, Copyright and Trademarks: An Intellectual Property Desk Reference*. (c) 2003 Stephan Elias and Richard Storm. Nolo Press. Part 4, Trademark Law. Pages 379-512.
- Fishman, Stephan. *Web and Software Development, a Legal Guide*. (c) 1994-2002 Stephan Fishman. Nolo Press. Chapter 10, Trademarks and Domain Names.
- Loberg, Kristin et al. *The Value of a Good Idea: Protecting Intellectual Property in an Information Economy*. (c) 2002 Silver Lake Publishing. Section 2: Trademarks. Pages 133-257.