



TRADEMARK LAW

By Douglas A. Park

What is a trademark?

A trademark is any name, symbol or device used in commerce to identify and distinguish goods or services. A trademark can be a word, a slogan, an image or even a design or a sound. Examples include the word “McDonald’s”, the slogan “What’s in Your Wallet”, the Nike swoosh, the design of a Coke bottle or the NBC jingle. Trademarks serve two primary purposes. First, they indicate that goods or services with the same trademark originate from the same source. Second, trademarks serve as an assurance of quality.

What are the advantages of registering your trademark with the United States Patent and Trademark Office (the “USPTO”)?

As soon as you start using your trademark in commerce, you obtain common law rights to use the trademark so long as you are the first to use that trademark in that location. These common law rights are limited, however. For example, you only obtain the rights to the trademark in the States where you actually use the trademark. Furthermore, common law rights depend on State law, and these laws differ dramatically from State to State. Consequently, registering your trademark with the USPTO bestows numerous advantages. These include:

- Registered trademarks are easier to find in a trademark availability search. As a result, it is less likely that someone else will use a confusingly similar trademark;
- Registered trademarks are entitled to nationwide protection;
- After five years of registration, the trademark will become “incontestable,” meaning the registration will become conclusive evidence that the trademark is valid and that you own the trademark;
- Owners of registered marks are entitled to sue in federal court and can be entitled to attorney’s fees, treble damages and statutory damages; and
- Registering with the USPTO serves as the basis for international registrations.

What are the requirements to obtain Federal trademark protection?

First, your trademark must be considered distinctive. Trademarks are classified in one of the following categories:

Fanciful: These trademarks are coined words created for purposes of being a trademark, such as “Kodak” or “Exxon.”

Arbitrary: These trademarks are words that have no inherent relationship to the good or service to which they apply. An example of an arbitrary mark is the word “Apple” for computers and electronic devices.

Suggestive: Suggestive trademarks suggest a quality or characteristic of the good or service but not in a specific manner. For example “Jaguar” is a suggestive trademark for a car.



Descriptive: Descriptive trademarks describe the purpose, quality or characteristic of the good or service. For example, “Vision Center” is a descriptive trademark for a designer of eyeglasses. Furthermore, most trademarks that sound like a person’s name are considered merely descriptive.

Generic: Generic marks are used by the public to identify the category of goods and services associated with the trademark. A restaurant called “*The Restaurant*” would be an example of a generic trademark.

Fanciful, arbitrary and suggestive marks are always considered distinctive. Generic trademarks are never considered distinctive. Descriptive trademarks can only obtain full trademark protection if you can demonstrate that consumers have learned to associate the trademark with a single source. This is typically done by showing that you have used the trademark continuously and exclusively for five years. As a result, it is always preferable to adopt a trademark that is fanciful, arbitrary or suggestive.

If your trademark is considered distinctive, the next step is to select the appropriate classification for your trademark. Trademarks are only considered distinct within the class of goods or services set forth in the trademark application. As a result, the same trademark can be used by different owners in different classes. For example, the word “Ace” is a trademark used by hardware stores, hotels and bandages. You must actually be using the trademark in commerce in the classification you select, and you must include evidence of such use as part of your application.

Finally, your trademark must not be confusingly similar to any existing registered trademark. A trademark is confusingly similar if the relevant consuming public would be confused or mistaken about the source of the product. As a result, you should conduct a search of existing trademarks before adopting a trademark for your business.

What is the process for registering your trademark?

The trademark process starts when you file an application with the USPTO. A trademark examiner will then be assigned to your application (this typically takes around three months). The trademark examiner will then approve the application for publication, reject the application because it fails to satisfy the minimum statutory requirements for trademark protection, or issue an office action in which the examiner will ask the applicant to amend the application or present additional evidence.

Once the trademark examiner has approved the application, the trademark will next be published in the *Official Gazette* for a period of at least three months. During the publication process, owners of other trademarks can oppose your application on the basis that the proposed trademark is confusingly similar to their own trademark. Following the publication process, you will receive a Registration Certificate stating that your trademark has been registered with the *Primary Register* with the USPTO.

Further questions?

If you have any further questions about trademarks, please contact one of the following attorneys:

Douglas Park Law
708 Church Street | Decatur, GA 30030
(404) 919-1957 | DPark@DouglasParkLaw.com

Law Office of Paige Arden Stanley
2025 Robson Place NE | Atlanta, GA 30317
(404) 386-9950 | Paige@StanleyLawOffice.com