

TUGGLE DUGGINS

ATTORNEYS AT LAW

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What is a Trademark?

News that Sarah Palin attempted to trademark her name has brought increased attention to trademark laws and have many people asking the question, “What is a trademark?” A trademark protects a “brand” used in connection with a particular manufacturer’s or seller’s products and distinguishes their products from the products of another. For instance, the use of the term “Apple” distinguishes computers made by Apple to those made by IBM or Dell. When a mark is used to describe a service then it is called a “service mark.” Trademarks indicate the source of the goods or services, guarantee the quality, and create or maintain consumer demand.

For a mark to become a trademark, the mark must be distinctive and capable of identifying the source of the product. There are four (4) types of marks, some types receiving legal protection, while others do not.

- 1) Arbitrary or fanciful marks These marks have no logical relationship to the underlying product. “Apple” and “Reebok” are good examples. Fanciful marks are those words that are invented solely for the purpose of identifying a product. Courts give these marks a high degree of protection.
- 2) Suggestive marks. These marks include some feature of the product, but some imagination is needed to associate the word with the product. For instance, “Coppertone” is suggestive of suntan lotion, but does not describe the underlying product. Courts also give these marks a high degree of protection.
- 3) Descriptive marks. These marks directly describe the product. For instance “Vision Center” for an eyewear store or “Park N Fly” for an airport parking lot. Generally, these marks are not protected, unless they have acquired a “secondary meaning.” A “secondary meaning” is acquired when the public associates a mark with a particular product.
- 4) Generic marks. These marks describe the general product. For instance, the word “computer” to describe a computer. These are afforded no protection.

I. Advantages of Registering Your Trademark

A mark is often a company's name or logo, which is a valuable asset to the company. Registering the mark with the Patent and Trademark Office (PTO) will help to preserve the value in the mark as an asset:

A. Registration protects the mark more than just use of the mark:

1. Registration gives the mark's owner the exclusive right to use the mark nationwide, limited only by where the mark is already being used by others within a specific geographic area.
2. Registration constitutes constructive notice to third parties of ownership of the mark. Third parties cannot then claim the good faith exception, or ignorance, that would otherwise allow a second person to use the mark, with superior rights, in a different market.
3. Registration decreases the likelihood that other parties will claim that this mark infringes on their trademark.
4. After five (5) years of registration, the mark becomes "incontestable," at which point the owner has the exclusive right to use the mark.
5. Registration can be a requirement to obtain trademark registration in a foreign country.
6. A registered mark can be recorded with U.S. Customs and used at U.S. borders to stop importation of goods bearing infringing marks

B. Registration deters others from using the trademark:

1. Registration allows the owner the right to a "®" after the mark, which alerts others of the registration.
2. Registered marks are in the PTO files, so parties looking for a new mark will find the registered mark when searching the records of the PTO.
3. Registration allows for the PTO to reject the registration of confusingly similar marks.

C. Registration provides the owner with greater remedies if someone infringes on the trademark:

1. Registration allows for the owner potentially to recover treble damages, attorneys fees and other remedies.
2. Registration enables a party to bring a lawsuit in federal court if others are infringing on their mark.
3. Registration is evidence by itself that the registrant owns the mark, if challenged in court.

For more information on trademarks, or for help registering a trademark, please contact Denis Jacobson at Tuggle Duggins & Meschan, P.A. at (336)378-1431 or DJacobson@tuggleduggins.com