

AN OVERVIEW OF FEDERAL TRADEMARKS

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GENERAL PROCEDURE. A trademark is any name, logo, symbol, or device that serves to identify the source of a good or service. To secure a federal trademark, it is necessary to file a trademark application with the United States Patent and Trademark Office and use the mark in association with sales of a good or service in interstate commerce. The trademark application is assigned to an examining attorney who evaluates the application for compliance with various rules; the examining attorney can either reject or allow the trademark application. An allowed trademark application results in a federally registered trademark and confers on the owner the right to prevent confusingly similar uses of the trademark throughout the United States. There are also state and common law trademark rights.

TRADEMARK SELECTION. The first step in the trademark process is selecting a distinctive and non-descriptive mark, which is one that will receive strong protection by the courts. There are generally four types of marks including coined, arbitrary, suggestive, and descriptive and the degree of trademark protection afforded depends on the type of mark that is being used. Coined marks have no meaning, examples of which include Xerox®, Exxon®, and Barbasol®. Arbitrary marks have meaning, but the meaning is not related to the product or service for which they are associated. Examples of arbitrary marks include Apple® computers, Amazon® books, and Ivory® soap. Suggestive marks use ordinary words having meaning in a clever manner to create a desirable idea or feeling about a product or service, but stay away from literally describing the product or service for which they are associated. Examples of suggestive marks include Greyhound® bus, Verbatim® disks, and Coppertone® tanning lotion. In contrast with coined, arbitrary, and suggestive marks, descriptive marks actually describe the product or service for which they are associated. Examples of descriptive marks include 10-Minute Lube, Hi-Tech Computers, and Char-broiler hamburgers. Descriptive marks also include geographic locations, names, and laudatory comments. Courts provide more protection to non-descriptive types of marks, including coined, arbitrary, and suggestive marks, primarily because such protection does not prevent others from using words to communicate or to sell other goods or services.

TRADEMARK SEARCH. Before filing a federal trademark application or using a mark, it is good practice to conduct a trademark search for at least two reasons. First, during examination of a trademark application an examining attorney will conduct his or her own trademark search to determine whether to allow or reject a trademark application; thus, a trademark search can save time and resources. Second, use of a mark may infringe on another's trademark rights, so conducting a search can avoid a potential dispute. The sources for a trademark search include phone books, internet sites, magazines, publications, and state and federal trademark registers; indeed, both registered and unregistered trademarks should be searched. The test that is used when performing a trademark search is not whether a trademark is identical, but whether a trademark is confusingly similar by way of sound, appearance, or meaning. Trademark searches do not provide certainty that a trademark application will be allowed or that use of a mark won't result in an infringement suit.

FEDERAL TRADEMARK APPLICATION FILING. After selecting a mark and searching for confusingly similar marks, a mark can be used in association with sales of goods or services in interstate commerce even before a federal trademark application is filed. Unregistered use of a

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mark results in automatic common law trademark rights vesting in the mark owner and the ™ symbol should be used; however, common law rights aren't as robust as federally registered trademark rights. Accordingly, an unregistered use should be diligently followed up with a federal trademark application. Once filed, the federal trademark application is assigned to an examining attorney who evaluates the distinctiveness of a mark, searches for confusingly similar marks, and ensures that the application complies with various rules and formalities. An examining attorney can reject or allow the trademark application, with an allowed trademark application resulting in a federally registered trademark. Alternatively, when it is desirable to know the outcome of federal trademark examination before using a mark, an intent-to-use (ITU) federal trademark application can be immediately filed without having first used the mark in interstate commerce. The ITU application will undergo a similar examination, but will not result in a federally registered trademark until the mark is actually used in commerce. Foreign trademark applications require different procedures.

REGISTERED FEDERAL TRADEMARKS. An allowed federal trademark application results in a federally registered trademark that confers in the owner the right to prevent confusingly similar uses across the United States and to use the ® symbol. Furthermore, a federally registered trademark includes a presumption of ownership and validity. Importantly, ongoing care of a federally registered trademark is required to ensure that these rights continue. Such care includes timely filing of renewal declarations, continuously using the trademark in association with the goods or services, and avoiding genericide.

IMPORTANT NOTICE: THIS OUTLINE IS NOT A SUBSTITUTE FOR LEGAL ADVICE. THE READER SHOULD SEEK COUNSEL FROM AN ATTORNEY.