



IP ESSENTIALS

A Toolkit for Entrepreneurs,
Innovators, and Business Owners

TRADEMARKS



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A trademark is a source identifier that can be a word, name, symbol, design, combination of a word or design, a slogan, a catch phrase, or even a distinctive sound, color, or fragrance.

It identifies and distinguishes the goods and services of one manufacturer from those of another.

Q What is the difference between “©” and “TM”?

A In the United States, trademark rights are created through use of the mark. Registered trademarks use the familiar symbol “®” and adopted, but unregistered marks use the symbol “™” to notify the public.

In text, trademarks should always be used as they are registered. Word marks must always be used as adjectives, never as nouns or verbs, and never in the possessive. A word mark should stand out from the text and not be coupled with the manufacturer’s name.

Q What are service/certification marks?

A A service mark identifies a service, such as accounting, engineering, education, consulting, retail/wholesale store services, and others. A certification mark is a trademark that is owned by a certifying organization that uses the mark to certify that goods meet pre-defined criteria, typically regarding quality, such as “Florida Oranges” or “Energy Star.”

Q What is trademark strength?

A The nature of a mark, particularly its relative strength or weakness, will have a direct bearing on its performance in the market and the scope of legal protection to which the mark is entitled. In general, the stronger a mark is, the easier it is for the mark to be registered and protected from unauthorized use by others.

Q How are trademark strengths determined?

A The strongest trademarks are made of words that are not descriptive of the goods or services being offered under that particular trademark.

- Made up words (such as Google for search services, or Rolex for watches) provide the strongest trademark
- Words that are taken out of context (such as Apple for computers).
- Words that are not descriptive but are suggestive of the good or service can generally be registered, but they are not quite as strong (such as LinkedIn for networking community or Netflix for streaming services).
- Words that are descriptive of a product or services that are being offered may receive trademark protection only if it acquires secondary meaning (Burger King for burgers, Coca Cola for a cola drink made from coca leaves).
- Generic words are not registerable to trademark for those goods or services associated with that particular generic word (e.g. “Apple” for a business selling apples is too generic).

Q Why should I register my trademark?

A Under the common law, a trademark may be protectable, locally, as soon as it is adopted by the user (assuming there are no prior users). However, federal registration of a trademark gives the owner a nation-wide right of priority in the trademark, access to federal jurisdiction, and provides the owner a presumption of trademark validity. Registration requires an application and examination to confirm that there are no prior, confusingly similar uses of the trademark.

Q My business has one physical location—should I register my trademark federally?

A Federal registration is only available for trademarks that have been used in interstate commerce (across state or national boundaries). However, an applicant who intends to use a trademark in interstate commerce may apply for registration. You may apply for a federal registration, if you are conducting your business online. The application is examined and may become registered once the mark has been used in interstate commerce.

Q What is trademark infringement?

A Trademark infringement occurs when another party uses the same or similar trademark in a manner that causes a “likelihood of consumer confusion.” Courts look at several factors to assess the

Q How long will my trademark registration last?

A A common law trademark will last as long as the trademark continues to serve as a source identifier to the relevant population. A trademark registration is potentially perpetual as well, but it must be renewed every ten years.

likelihood of consumer confusion, including: the similarity of the marks, the similarity of the goods and services, the relevant market and channels of trade, the sophistication of the relevant buyers, and any evidence of actual confusion.

Q What is a “clearance search”?

A Before adopting a new trademark, it may be prudent to perform a “clearance search.” This pre-adoption search and review allows for consideration of any potentially similar trademarks, as well as an evaluation of any potential likelihood of consumer confusion, to assist in the determination as to whether the proposed mark is suitable for use and/or registration.

Q Do I need to consider international registration of my trademark?

A Trademark rights in the United States are based on “first to use.” The trademark rights in the rest of the world are based on “first to file” an application. If you are planning to conduct business abroad and want to take advantage of your U.S. priority date, you need to register your mark internationally within six months of filing the trademark registration in the U.S. You can still register your mark internationally later, but you would lose the advantage of your earlier priority date.

Q What if I don’t do anything with my registered mark?

A Trademarks may be abandoned through non-use or misuse. Trademark owners should be careful to continue use of their marks in a proper manner, and to police any and all unauthorized uses, to avoid any unintended consequences. If the mark will be temporarily discontinued (for example in connection with a business reorganization or relocation), efforts should be made to document the fact that the period of non-use is only temporary and that the trademark owner intends to begin use again on a certain date.

Q What are the potential consequences of improper use of a trademark?

A Improperly using a trademark (e.g. as a noun) may lead to the mark becoming generic for the goods and/or services associated with that mark. The following are a few examples of trademarks having become ‘genericized’:

- Escalator
- Kleenex
- Xerox
- Zipper
- Dumpster
- Taser

This IP Essentials Topic is one of a series:

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