

TRADEMARKS

by [Paul D. Supnik](#)

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1. A trademark is a designation of source or origin of a product.
2. In the United States, trademark rights are acquired essentially by use. Registration enhances those rights.
3. A federal trademark application may be filed based either on actual use or on a bona fide intent to use a mark in commerce. A trademark application based on bona fide intention to use still requires that there be actual use before registration is ultimately completed. Once the mark is registered, constructive use and thus priority is established as of the filing date of the federal trademark application.
4. Trademark applications are deceptively simple to complete.
5. Trademark searches are generally recommended before commencing use of a trademark whether or not one files an application for registration.
6. The symbol ® cannot be used unless a mark is federally registered in connection with the goods or services in connection with which the mark is used. The designation "TM" or "SM" may be used in connection with a mark whether or not the mark is federally registered and whether or not an application to register has been filed.
7. A trademark can be licensed to a third party, but any license requires quality control over the use of the mark by the licensor. Failure to monitor quality control may result in the loss of rights in the mark.
8. A trademark can be sold or assigned, but an assignment of trademark rights requires that it be accompanied by the goodwill represented by the mark.
9. The manner in which a trademark is used can significantly affect the scope of protection in the United States. Generally, marks should be used as an adjective, not as a noun, but then followed by the common descriptive term for the goods or services in connection with which the mark is used.

10. A federal trademark registration now obtained is valid for 10 years. However, an affidavit or declaration that the mark is still in use must be filed during the sixth year following registration.

11. A "Section 15" declaration may be filed if a mark has been in continuous use in commerce for a period of at least five years following the federal registration of the mark.

12. The more distinctive a mark, the better the opportunity for legal protection. The degree of distinctiveness may be classified in descending order of protection as arbitrary or fanciful, suggestive, descriptive, generic. Arbitrary or distinctive marks have the greatest opportunity for protection, broadest in scope. Examples are EXXON for gasoline. It has no meaning. APPLE for computers. Computers have nothing to do with apples. KODAK for film. KODAK is a made up mark. "Suggestive marks", that is marks which suggest but do not describe the nature or quality of goods or services, are protectable when they are first used, but the scope of such marks may be limited. Descriptive marks are not protectable or registrable initially, but only become registrable or protectable at such time as they have acquired a "secondary meaning" -- thus, the public comes to recognize the words as a mark, rather than as its primary meaning. Generic marks, e.g. "SWEET" for sugar, probably will never be protected.

13. Unless armed with a very large advertising budget, it may be best to millions for advertising, stay away from establishing marks which are merely descriptive.

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***Domestic and International Copyright and Trademark Law;
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Related Litigation
