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AT A GLANCE GUIDE

US TRADEMARK REGISTRATION

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INTRODUCTION

This Guide covers the protection of U.S. marks, both trademarks and service marks. It relates to the protection of NGOs' brands under U.S. law.

NGOs have a variety of opportunities to own and exploit marks, which are integral to “branding” the organization in the mind of the public and industry. A mark can truly “define” your work, and you should it as one of your most valuable assets. Below you’ll find some of the keys to ensuring you preserve your rights in the States.

WHERE DOES MARK PROTECTION COME FROM?

Unlike the exclusive federal scheme for U.S. copyrights, U.S. marks are governed by both state and federal law. U.S. Federal marks are governed by the Lanham Act. Generally, you acquire a mark by putting your services or goods into commerce. For federal protection, the mark must be used in interstate U.S. commerce; intrastate or international use is not sufficient. While state and common law marks exist, their strength is limited compared to federally-registered marks, which provide protection across the entire nation.

WHAT IS A MARK?

A mark is a word, symbol, or other indicator that consumers recognize in the marketplace as indicating who is “behind” a product or a service, that is, who put it into commerce. For goods, the mark is called a trademark; for services, it is called a service mark. They are otherwise treated the same. Thus, the mark scheme is a consumer-protection effort that allows members of the public to anticipate the quality of the goods or services associated with the mark. A mark may take a number of forms, but for NGOs, it will usually be the name under which the organization publicly acts, its logo, and its slogan, if any. Each is a separate potential mark.

WHAT SHOULD I CONSIDER IN CHOOSING A MARK?

Not every proposed mark is protectible; it must be distinctive. Thus, if you are devising a new mark, consider that the more unusual it is, the stronger protection it will have. Marks are loosely categorized into four types: fanciful (or “coined”), arbitrary, suggestive, and descriptive, each less powerful than the one before it. Fanciful marks have no meaning other than the goods or services associated with the mark, such as “Kodak”. A generic term, no more than a common word, cannot be registered. Less distinguishable marks must acquire “secondary meaning” (i.e., distinctiveness) to be protectible.

Before investing much time, money, and good will in a mark, you should search the U.S. Patent and Trademark Office (USPTO) database for any registered marks that are confusingly similar. Because mark ownership generally depends on first use rather than first registration (other than an intent-to-use or “ITU” filing), a search is simply a best effort to establish no one else is using the mark. Competitors may not show in the USPTO database, and using a professional search service is well-advised. Early discovery of a conflicting mark will not only help you avoid investing time and money in a mark you cannot use, it may help you avoid an infringement suit. Most importantly, you may find that someone using a confusingly similar mark has a bad reputation or is otherwise an entity you would not want the public to confuse with you. At a minimum, scour the internet and any resources in your industry for marks that could create an issue.

FEDERAL MARK REGISTRATION

Like U.S. copyright, and unlike some European countries, you do not have to register a U.S. mark to own it. Still, there are many advantages to registration, including presumptions of mark ownership and validity.

You may register your mark for protection in every category (called “international classifications”) in which your organization operates. Fees are per international classification and per “type” of good or service (currently \$275.00 each when done online). The application must include a drawing of the mark as well as specimens demonstrating how the mark is being used in commerce. A word mark can be registered in “regular” block letter form, a particular style form, or both, and a logo can take any form. However you register the mark, you must use it that way in commerce, although not exclusively. A block letter registration provides broader protection, covering all versions of the words protected. A “supplemental register” is available for marks that are not yet sufficiently distinct for the principal register.

In an ITU application, the registrant claims a genuine intent to enter interstate commerce with the mark. It is good for six months and potentially renewable for up to three years in six month increments.

A U.S. federal mark owner may register in any country that is a member of the Madrid Protocol by filing a single “international application”. In addition, some treaties allow a U.S. mark to provide a basis for filing in other countries.

PROPER USE OR TRANSFER OF A MARK

There are three extremely significant yet unobvious steps a mark owner must take to retain its rights:

1. A mark is a “proper adjective” that should always be followed by a generic noun. Examples of this proper use of a mark include TIME *magazine*, Band-Aid *brand*, and Heinz *tomato ketchup*. The noun can be in small print but should be used as often as practical.

2. Because a mark is a proper adjective, a mark owner must diligently monitor to ensure the public does not begin to use the mark as a noun, verb, or otherwise. Xerox famously runs an occasional ad in business journals to remind people, *Do not say you “xerox” something; do not say you made a “xerox”. Rather say you made a copy on a Xerox machine.* Many famous marks that once indicated only one product or service became “genericized”; they were so popularly used that they came to mean the thing or service themselves instead of indicating a particular manufacturer or service provider. While that is a sign of commercial success, it is deadly to marks. A current example of this risk is the use of “google”, as people tend to say they “googled” something or “google” found something rather than say they used the google *search engine*.

3. A mark owner can not let others use its mark without retaining control over the quality of the goods or services being offered with it. Since the purpose of a mark is to let the public know they can count on a certain quality level, if the mark owner does not have the right to impose standards, the mark can no longer assuredly represent a certain quality. Granting a “naked” license can cause a mark to be lost.

Lastly, if you are buying assets that include a mark, you must ensure the “good will” associated with the mark is transferred also. Again, since the role of the mark is to indicate quality, you can not separate the mark from its reputation. Such an “assignment-in-gross” is void.

Exceptions to a mark owner’s exclusive rights include parody, news reporting and commentary, and comparative advertising. However, like copyright litigation, mark litigation is very expensive, and such uses should be made judiciously.

HOW LONG MARKS LAST

Five years after registration of a federal mark, you must file an affidavit of continued use called a “Section 8” affidavit. In the tenth year, and for every ten years thereafter, you must renew the mark and may do so indefinitely.

THE MARK NOTICE

Once you register a mark, you may note it with the ® symbol. A “TM” or “SM” symbol has no legal meaning in the federal system but are informal indicators that someone is claiming a mark.

RELATED RIGHTS

There are also a variety of other rights granted under the Lanham Act, such as laws preventing a party from “palming off” its goods or services as those of another; using a mark in a way that dilutes its value; engaging in false advertising; or violating another’s “trade dress”. Mark issues often are intermixed with cybersquatting and right of publicity claims as well. These closely-intertwined legal theories are complex, and you should consult with counsel if you find yourself in a mark controversy.

FURTHER INFORMATION

The USPTO website at www.uspto.gov/trademarks/index.jsp provides a wide variety of resources as well as a registration database and electronic filing system. It also has an assistance center at 1-800-786-9199