

## **I Picked a Brand Name, Now What Do I Do?**

### **Is It Protectable?**

Not all choices are worth the investment. Words and phrases are recognized as trademarks only if they are “distinctive.” The more distinctive the word, in the context of particular products or services, the broader the scope of protection it is accorded under the trademark laws.

**Arbitrary** or **fanciful** marks are terms which either have no independent meaning whatsoever or, if they have a recognized meaning, that meaning has no significance in the field in which the mark is used.

**Suggestive** marks are words which have some meaning in the context of the goods or services to which they are applied, but do not directly describe any quality, feature, characteristic, or nature of the goods. Instead they require some imagination on the part of the consumer to make a connection.

**Descriptive** terms are words which directly describe an ingredient, quality, characteristic, function, feature, purpose or use of the goods or services.

**Generic** terms are those which serve as a common name for a category or sub-category of goods, such as “furniture,” “soft drinks,” “crackers,” and “clothing.”

### **Consequences For Registration**

Fanciful, arbitrary and suggestive marks are considered to be “inherently distinctive,” and are registerable as trademarks simply upon proof that they have been or will be used on specific goods.

A descriptive term or phrase, by contrast, may not be registered on the Principal Register unless it has been used, advertised and promoted for a substantial period of time, so that consumers have grown to recognize the descriptive phrase as a trademark. Through such use, the descriptive term is considered to have developed a secondary meaning apart from its descriptive meaning, and has developed “acquired distinctiveness.”

A term that is generic in the area in which the goods/services are offered is not registerable under any circumstances.

### **Consequences for Enforcement of Rights**

Arbitrary or fanciful marks are presumed to be strong and will be afforded a wide scope of protection against infringing marks. Suggestive marks also are protected against infringing use, but the scope of protection is more limited.

Descriptive terms are protected against infringing use only if they have acquired distinctiveness. The descriptive character of the mark creates a substantial additional obstacle to successful enforcement.

Generic terms are inherently incapable of serving as trademarks and are always available for competitive use.

### **Is It Already Taken?**

Before investing in a mark it is prudent to conduct a clearance search to rule out the risk that prior rights exist.

There are different types of U.S. searches (foreign clearance and registration is a different topic) that can be conducted. One option is a limited search of the U.S. Patent and Trademark Office records, which discloses only marks for which federal registration has been sought. Because of the limited information available, this type of search should not be relied upon as a full clearance for use of a mark, or to rule out potential infringement liability.

Another option is a comprehensive clearance search of federal, state, and some international registers, as well as of domain name and internet uses, business names, trade journals, and other unregistered marks that are in use. The search identifies marks that are visually, phonetically or conceptually the same or similar to the trademark to be adopted and that cover the same or similar goods or services. Even the comprehensive search may not disclose absolutely everything that might pose a risk, however, it provides the broadest universe of information available.

### **Its Protectable and Clear, Now What?**

In the U.S., trademark rights arise from actual use of a mark in commerce. Federal registration is not required to establish rights in a mark, but the rights established through use may be enhanced by registering the mark in the Patent and Trademark Office (PTO). Among other things, federal trademark registration provides:

- constructive notice of the registered mark
- presumptions regarding the mark's validity and ownership
- rights dating from the filing of an application for registration
- exclusive nationwide rights
- after five years, "incontestability" of rights in the registered mark
- the right to use the federal registration symbol ® with the mark
- for recordation of the registration with the U. S. Customs Service to prevent importation of counterfeit or infringing products.

### **Filing an Application for Federal Trademark Registration**

An application for registration can be filed after a mark has been used in commerce. An application also can be filed before use is commenced if a party has a bona fide intent to use the mark in commerce in the U.S. The basis for such an application is known as “intent-to-use” (ITU). The mark will not register until the applicant submits, and the Trademark Office accepts, evidence of actual use of the mark. Under either filing basis, the filing of a trademark registration application establishes nationwide priority, subject to prior use by other parties.

### **Registration of Trademarks**

In the U.S., the process to register a trademark can take anywhere from one year to several years, depending on the basis for filing and the legal issues which may arise in the examination of the application.

Once registered, the term of a federal trademark registration is 10 years. However, between the fifth and sixth year after the date of initial registration, the registrant must file an affidavit declaring that the mark is still used for the goods/services in the registration. The affidavit cannot be filed if the mark is no longer used. If no affidavit is filed, the registration will be canceled. As long as the trademark owner continues to use the mark to identify its goods or services, the registration can be renewed and the trademark rights can last indefinitely.

### **Proper Use of a Mark**

Proper use of a trademark is essential for its continued protection. The following are some suggested guidelines for the proper use of trademarks:

- Always distinguish trademarks from surrounding text with initial capital letters, or all capital letters, or in a different font, or in quotes
- Be consistent in using the mark; always use it in the same style and spelling
- Never use a trademark as a noun, rather, use the mark as an adjective modifying a noun. For example: “a Jacuzzi brand spa,” not “a Jacuzzi”.
- Never modify a trademark to the plural form. Instead, change the descriptive product word from singular to plural. For example: OREO cookies, not OREOS.
- Never use a trademark as a verb. EXAMPLE: One does not do “Xeroxing”, but rather photocopying on a Xerox copier machine.