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**THE TRADEMARK GUIDE
FOR BEGINNERS**



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Supercharge your business with legal expert guidance!

A business attorney provides legal services and advice that affect almost every aspect of a company.

A federal trademark registration is obtained by filing an application, along with the requisite fee, with the U.S. Patent and Trademark Office (USPTO).

An application may be filed on either the Principal Register or Supplemental Register and is

examined/prosecuted in the USPTO by one of many staff trademark attorneys.

If there are any grounds for refusing an application, the examiner will raise them in an Office Action. The examiner's objections must be fully resolved or withdrawn for the application to proceed to publication.

Once a Principal Register application is published, third parties may object to the application by filing a notice of opposition with the Trademark Trial and Appeal Board (TTAB). The application will proceed to registration if no opposition is filed or if an opposition is withdrawn or successfully defended. Supplemental Register applications proceed directly to registration once published.

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The Examination Process

The application is examined in the USPTO by one of many staff trademark attorneys. An examiner can reject the application on various grounds:

- Likelihood of Confusion
- Sound
- Appearance
- Meaning
- Commercial Impression
- Broad Description of Goods
- Broad Description of Services
- Merely Descriptive
- Primarily Geographically Descriptive
- Primarily Geographically Deceptively Misdescriptive
- Primarily Merely a Surname
- Ornamentation
- Failure to include a disclaimer
- Lack of a good Specimen

The application proceeds to registration only if the examiner approves the application. Note, however, that a Principal Register application must be published for opposition following the examiner's approval and proceeds to registration only if:

- No one files an opposition proceeding –or–
- An opposition is filed but is withdrawn or successfully defended.

If the application is filed on the base of an intent to use, it proceeds to registration only after proof of use is filed. Otherwise, the application proceeds to registration promptly after it is published and not opposed.

Registrations that are successful provide useful trademark protection that goes beyond the protection afforded by common law rights derived from the mere use of the mark.



Is the Mark Registrable?

Marks must be distinctive to be registered on the Principal Register, either inherently or through acquired distinctiveness. Acquired distinctiveness exists for marks that have become well known to consumers. In this case, the application must be supported with strong evidence. Marks that do not meet the necessary level of distinctiveness will be rejected.

Arbitrary, fanciful, and suggestive marks are inherently distinctive.

- **Descriptive terms** are not inherently distinctive but may acquire distinctiveness. Then, they might be registered on the Principal Register.
- **Generic terms** are not distinctive and can never be registered.

The following marks are often difficult to register, for the reasons stated:

Generic terms.

Generic terms for the goods or services identified in an application are not distinctive and thus are never registrable.

Descriptive terms.

Descriptive terms for the goods or services identified in an application, while not considered inherently distinctive, may be registered on the Principal Register if they have acquired distinctiveness.

Otherwise, they are registrable on the Supplemental Register. Note, however, that suggestive terms that imply some information about the product or service but which do not directly describe it are inherently distinctive and registrable on the Principal Register.



Geographically descriptive terms.

Geographically descriptive terms are terms that identify a place where the goods or services originate. These terms are not considered inherently distinctive but may register on the Principal Register upon acquiring distinctiveness. Otherwise, they are registrable on the Supplemental Register.

Surnames.

Surnames are generally not inherently distinctive but may acquire distinctiveness. If acquired distinctiveness is demonstrated these marks may be registered on the Principal Register. Otherwise, they are registrable on the Supplemental Register.

Deceptive terms.

Deceptive terms are not registrable material.

Certain slogans or taglines.

Multi-word slogans or taglines may be rejected as insufficiently distinctive, even if they are not literally descriptive if they consist of common phrases.

Certain logos or designs.

Logos or designs consisting of simplified depictions of the product or a product feature may be deemed descriptive.

Product configurations.

Three-dimensional configurations of entire products are always deemed inherently nondistinctive and are only registrable on the Principal Register with proof that they have acquired distinctiveness.

Trademark Act Section 2(e)(5) (15 U.S.C. § 1052(e)(5)) also requires that product configuration marks not be "functional," that is, one of the few best utilitarian configurations for that type of product.

Will the Application Be Blocked by Prior Marks?

During the examination process, the USPTO trademark attorney is required to perform a search of the USPTO database of existing registrations and pending applications for prior similar marks or blocking citations and to cite such marks as bars to registration of the applied-for mark.

The test is whether a typical purchaser is likely to be confused that the respective goods/services originate with or are sponsored by the same party, based mainly on:



- Similarity of the marks in sound, sight, or meaning.
- Degree of relatedness of the goods or services

The USPTO attorney only looks at the information listed within the applications and registrations. The examining attorney does not consider real-world factors not identified in the USPTO filings, for instance:

- That the marks are always used together with other marks.
- That the products are actually sold in very narrow trade channels not stated in the application or registration.
- That the mark owners use the respective marks in widely separated geographic areas.

While these additional confusion-avoiding factors are considered by a court applying the likelihood of confusion test in a trademark infringement suit, they are not considered in the USPTO. Accordingly, a mark may be unavailable for registration but available for use.

Trademark Clearance Searches

To assess the likelihood that an application or registration will be cited against a client's proposed mark and to also confirm that the mark is available for use without infringing prior rights of others, it is necessary to conduct a trademark clearance search prior to filing an application.

The search is designed to identify third-party trademarks, both common law and registered, that are identical or similar to the proposed trademark for the same or related goods and/or services. Conducting such searches can help avoid unnecessary costs, objections, and possibly lawsuits down the line by parties with similar or identical marks.

There are two types of trademark clearance searches:

- Preliminary (or knock-out) searches
- Comprehensive searches

Preliminary Searches

A preliminary search, sometimes called a database or knock-out search, is an inexpensive search to disclose obvious blocks to use or registration of a mark. This type of search identifies identical or near-identical marks in a computer database of federal trademark applications and registrations.



The database can be searched for all the following:

- Words
- Marks consisting of:
 - Letters
 - Numbers
 - Punctuation marks
 - Any combination of the above
- Design matter (such as a logo featuring an alligator or a design of interlocking circles)

It is possible to search for designs because the USPTO assigns one or more numerical codes to each application or registration for design marks, or for a mark that contains a word and design, to identify the design matter in the mark.

A skilled searcher can query the database by entering relevant design codes and Restricting the search results.

- International class number
- Particular keywords in the goods or services list

Comprehensive Searches

If a preliminary search yields no potential issues, then you should advise the client to proceed with a full and comprehensive search. A full search, includes a broad search of USPTO applications and registrations, as well as searches of:

- State registrations
- Trade names (i.e., company names and DBAs)
- Domain names
- Other common law mark sources

Gather Information from Client Before a Full Search

Before proceeding with a full search, it is necessary as much information as possible about the marks and how the proposed mark will be used given.

Review the Search Report and Draft an Opinion Letter

A search report is usually about 200–400 pages in length. The review of the report allows to identify any references that could be confusingly similar to the client's proposed mark.



The Likelihood of Confusion Inquiry

A number of factors are pertinent to the likelihood of confusion inquiry, including, but not limited to, the following:

- The strength of the proposed mark
- The degree of similarity between the respective marks
- The degree of relatedness of the respective products/services
- The sophistication of the relevant consumers
- The channels of trade in which the products/services are sold or offered for sale
- Whether the proposed mark will be used with another mark (such as a house mark)
- Whether prior similar marks are:
 - Diluted (i.e., many prior similar marks coexist in a crowded field)
 - Inherently weak (e.g., marks with a prefix NUTRI for dietetic foods or DURA for durable products)

In evaluating search results, it is useful to know if the owner of a fairly close prior mark has policed its mark aggressively, such as by filing:

- Opposition proceedings against applications for similar marks at the Trademark Trial and Appeal Board (TTAB)
- Cancellation proceedings against registrations for similar marks at the TTAB
- Lawsuits in federal court

Other legal research tools can identify reported or unreported cases in which a party sued for infringement of its mark, such as:

- The print or online versions of Shepard's citations
- The PACER database of federal civil actions (which can be queried for cases filed by particular parties under the trademark infringement code).

In addition, conducting internet research about relevant references revealed in a search may help to assess the risk a reference may present. In some cases, it may be helpful to instruct an investigator to research a particular reference in order to learn more about whether, where, and how the mark is in use.

It is also important to keep in mind that, since trademark rights can be derived from use without registration, **there is no way to ensure that a search report will include every potentially conflicting mark.** You should thus advise your client that it is possible that potentially conflicting marks



may exist but may not be picked up in the search report, but that searches usually disclose the vast majority of such marks.

Crowded Field Considerations

If there are many prior similar marks, they are only entitled to a narrow scope of protection and, as such, you might be able to avoid a blocking citation based on such marks (or remove a blocking citation by argument). At the same time, if a crowded field exists an applicant obtains a registration, the client's registration will likewise be weak and only entitled to a narrow scope of protection. Such a registration may be of little value and not worth the cost of obtaining it.

Timing / Length of Use Considerations

If an applicant has not yet used its mark but intends to use the mark in U.S. commerce within the next several years, it may take advantage of the intent-to-use application. This allows an applicant to reserve a mark for future use in the United States, well prior to launch, while market research and product development are ongoing. The filing date is deemed the constructive first use date, giving the applicant an earlier date on which to rely for priority purposes. This locks in the applicant's rights at the time of filing (so long as the application matures to registration) in case there is an intervening filer or user between the time the applicant files and starts using its mark.

An intent-to-use application will not mature to registration unless and until the mark is actually used in connection with commercial products or services in the United States and the applicant files proof of use—including a specimen of use—in the USPTO.

An applicant has until three years after the application is allowed (following publication) to prove use of the mark, provided that the applicant files an extension of that deadline every six months, and it usually takes roughly one year or more before an application is allowed. Thus, the average intent-to-use applicant will have about four years to prove use of the mark; otherwise, the application will be deemed abandoned.

Will the Mark Be Used in a Trademark Manner?

The USPTO will reject registration of a mark that is not used in a trademark manner. For example, the mark AJAX CORPORATION would be considered an unregistrable "trade name" if, in fact, that is the company name of the applicant and it appears on the required specimen of use only above the applicant's address. Terms used as model numbers or grade designations, usually following another trademark, are also considered unregistrable.



Other notable examples of non-trademark use

Titles of single works of authorship.

Trademark registrations cannot be obtained for the names of single books, movies, or other works of authorship. However, the USPTO allows the titles of single video games and single mobile apps to be registered.

Titles of a series of books or movies, however, such as STAR WARS, are eligible for trademark registration. Similarly, titles of continuing television shows, such as THE BIG BANG THEORY, are considered service marks for a type of entertainment service and are eligible for registration.

Although the USPTO generally will not grant a trademark registration for the title of a single work, note that such a title can be protected under common law if it has acquired secondary meaning.

Ornamental matter.

Marks which constitute a prominent part of a product, such as words on a bumper sticker or a design or phrase prominently printed on the front of a T-shirt, may be rejected on grounds that they are "merely ornamental," rather than trademarks.

To the great relief of the licensing industry, however, a prominent logo or word mark on a T-shirt, cap, lunch box, or on other typical licensing products usually is considered a trademark if the mark is already in use or is registered as a mark for some other product or service such that consumers already perceive it as a mark.

Will the Application Provoke a Claim?

Filing a trademark application puts the world on notice that the applicant is using or intends to use a mark on specific goods and/or services and may put the applicant at risk of a third-party claim.

Because a registration creates nationwide rights, many prior owners view another party's application for a similar mark as particularly threatening, even though the prior owner might not try to police every small use.

A prior owner may request that the applicant withdraw the application or even object to the applicant's use (not just registration) of the mark. Indeed, there are trademark watching services that review all of the applications filed and published for opposition in the USPTO and generate watch notices of potentially conflicting applications for their subscribers. Thus, filing an application may wake a sleeping dragon.



By contrast, a mark that is merely used, without an application, is much more difficult to detect and might not come to the attention of a prior trademark owner. A small or local user, who has no strong interest in obtaining a registration, might find it prudent to fly under the radar and not file an application for that reason, especially if a clearance search identified a prior party with a close registration. Prior parties with famous marks are especially likely to react aggressively.

Benefits of Federal Trademark Registration

Obtaining a U.S. federal trademark registration on the Principal Register provides numerous benefits for a trademark owner, including:

Nationwide exclusive rights.

A registration gives the owner the exclusive right to use the mark nationwide for the goods/services listed in the registration (absent a federal registration, trademark rights are limited to the geographic area in which the owner sells or distributes the products/services). 15 U.S.C. §§ 1057(b) and 1115(a).

If the owner actually uses the mark in a small geographic location (as opposed to nationwide), the owner will reap the benefit of a priority date calculated from the filing date of the application (rather than the actual later first use date of the mark in an expanded geographic area). 15 U.S.C. § 1057(c). However, the owner might not be able to win an infringement suit until it actually sells in the infringer's geographic area.

Leverage in disputes.

A registration makes demand letters to infringers and lawsuits against infringers more convincing. For guidance on demand letters and a sample letter, see [Cease and Desist Letters in Trademark Disputes: Drafting the Letter and Cease and Desist Letter \(Trademark Infringement\)](#). For an overview of federal trademark litigation, see [Trademark Infringement and False Designation of Origin Claims, Remedies, and Defenses](#).

Easier online enforcement.

Similarly, owners of federal registrations have an easier time enforcing their rights over the Internet, including actions against cybersquatters and infringement on social media sites. For guidance on cybersquatting claims and domain name disputes, see [Domain Name Disputes](#). For a sample cease and desist letter, see [Domain Name Cease and Desist Letter](#).



Inclusion in USPTO's online database.

Registered marks are included in the USPTO's online database, which makes the mark likelier to appear in search reports and deters third party adoption of a confusingly similar mark, and which also allows the USPTO to cite the mark as a bar against another party's application. See *Will the Application Be Blocked by Prior Marks?* above.

Constructive priority for intent-to-use applications.

During the gap between the time an application is filed and the time use begins, an intent-to-use application locks in rights to the mark at the time of filing, assuming that the application matures to registration (by preventing third parties from obtaining prior rights if they begin use or file an application after you have filed).

Registration symbol.

Having a registration allows you to use the federal trademark registration symbol (®) to deter copying (or the words "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off."). 15 U.S.C. § 1111.

Collateral for securing loans.

A registration can be used as collateral for securing a loan and also makes the mark more valuable and saleable. For guidance on trademark security interests and a sample agreement, see *Perfection Outside Article 9: Vessels, Aircraft, Intellectual Property, and Life Insurance Policies and Trademark Security Agreement (Short Form)*.

Incontestability (after five years).

A trademark may become incontestable (i.e., immune to challenge on inherent registrability and some other grounds) if the mark has been used continuously for five years after registration and the owner files a claim to incontestability under Section 15 of the Lanham Act in the USPTO. 15 U.S.C. §§ 1065 and 1115(b). See *Trademark Registrations: Maintenance and Renewal — Claim of Incontestability*.

Customs enforcement.

Under Customs regulations, 19 C.F.R. § 133, federal registration allows the owner to record the mark with U.S. Customs to help prevent the importation of any infringing or counterfeit goods from abroad



(at least to the extent that Customs detects them and then seizes the goods). See Policing and Enforcing Trademarks — United States Customs and Border Protection.

Basis for foreign registration and priority.

A U.S. trademark application or registration can be used as a basis to obtain registration in many foreign countries, including possible earlier rights by claiming priority (if the U.S. application was the owner's first filing for the mark and the foreign application is filed within six months of the U.S. application).

A federal trademark registration on the Supplemental Register (the register for inherently non-distinctive marks) also provides some limited benefits. Specifically, the owner of a Supplemental Registration can:

- Use the trademark symbol "®"
- Block another party's application for an identical or near identical mark.

However, a Supplemental Registration is an acknowledgement that the mark is not inherently distinctive, and the mark is not protectable in a cancellation proceeding or in an infringement suit unless and until it acquires distinctiveness through long use.

Federal registration can be contrasted with Common law protection and State registration.

Federal Registration vs. Common Law Protection

A common law trademark is a mark that is in use in the United States but is not registered. Common law trademark owners have legitimate rights in their marks, as registration is not a requirement for ownership or protection in the United States. Under Section 43(a) of the Lanham Act, a common law trademark user can sue for infringement. Prior use is also a basis for an opposition proceeding against an application in the USPTO.

However, common law protection, in an infringement suit, is limited to the geographic area in which the mark is used (thus, a good faith user in a distant geographic area can develop its own independent rights in the same mark). A federal registration, by contrast, reserves nationwide rights in the mark and provides various other benefits, as discussed above.



Federal Registration vs. State Registration

Trademark owners can obtain a federal registration and/or state registration(s) for their marks. State registration systems in the 50 states, the District of Columbia, and Puerto Rico coexist with the federal registration system. State registrations are usually obtained by filing an application with the appropriate office in the state government (typically in the Office of the Secretary of State) for a much smaller fee than with the USPTO. State registrations are granted with little or no examination.

However, state registrations usually create no substantive rights beyond those created under the common law by use of the mark. A federal registration is thus generally far preferable, if available. There are situations, though, where having a state registration in addition to a federal registration provides material benefits. Furthermore, if a federal registration is unavailable (e.g., because the USPTO will not register marks for marijuana), obtaining a state registration (or a registration in a U.S. territory) is one way to make sure that the owner's mark appears in full search reports.