

Trademark Basics Explained In Plain English

Sarah F. Hawkins

Attorney at Law

<http://sarafhawkins.com/trademark-laws-faq/>

What is a trademark?

Generally, a trademark is a word, phrase, logo, symbol, or character, or a combination thereof, used in connection with goods and services distributed in interstate commerce that serve to identify the source of the products or services and distinguish it from competitors.

What this means is that pretty much anything can be put forth as a trademark, so long as it is not obscene.

Colors and color patterns have received a federal registration (ex.: the pink for Owens Corning insulation, the plaid design of Scotch tape and blue color for painter's tape from 3M), as well as sounds which are known as sound marks (ex.: NBC chimes, Lucasfilms THX Deep Note).

Can any trademark get registered?

In theory the answer is “Yes.” However, in reality, the answer is “No.” You can submit a registration of your mark, but the US Patent and Trademark Office (USPTO) reviews registrations to ensure that they meet the requirements set forth in the Lanham Act. There are a host of guidelines that are followed to ensure that a mark meets all the defined criteria before it can be registered.

What is a service mark?

A service mark is a special designation for marks that are specifically related to the offering of a service rather than tangible goods.

What is the difference between the TM, SM, and ®?

The “TM”, which is an abbreviation for trademark, can be used at any time when you want to assert trademark rights to your word, phrase, logo, symbol, etc for goods. It does not have significant legal meaning since trademark rights can be asserted at any time prior to registration under the common law doctrine of trademark rights. By using the mark in the ordinary course of business, a business would obtain common law rights. Common law rights vary in degree and may or may not confer any significant protection.

The “SM” carries all the same rights as the “TM” except it’s used for services and not goods.

The ® means the mark has received federal registration from the USPTO and is in good standing. Keep in mind that if the registration is abandoned or cancelled the ® designation should no longer be used with the mark.

How are trademark rights obtained?

In the US, Canada, and United Kingdom (and most former British Commonwealth countries), the general rule is “first to use” whereas in most other countries they use the “first to file” rule. Keep in mind, though, that just because you were the first to use the mark it doesn’t mean someone else is prohibited from filing a registration with the USPTO before you and seek to register the same or similar mark. If that happens, be prepared to hire an attorney to begin the process of opposing their registration.

Where do I register my trademark?

Registration can be had at both the state and federal level. While federal registration with the USPTO is the highest level of registration, it requires that a mark be or intended to be used in interstate commerce. If the mark is only used within a single state, federal registration would not be permitted. In that case, a business or individual may find protection at the state level.

Is there such thing as Fair Use?

Short answer is yes. The long answer is, well, long.

Unlike copyright law which has a relatively well-established history and broad use under the doctrine of Fair Use, trademark law does not use the same four-prong test.

Under trademark law there are two fair use defenses:

- Nominative fair use (use of the mark to refer to the actual trademarked product, service, or owner),
- Classic fair use (use of the mark to accurately describe an aspect of your product or service)
- And parody

How long is my trademark valid?

Common law trademarks are valid as long as you use the mark, unless another determination ends that use.

Federal registrations are valid for 10 years, but can be renewed seemingly forever. You will want to keep track of all the important dates to keep your registration valid.