



Trademarks

Class 8

Trademarks™®

- Title 15, Chapter 22, §§1051-1141
- The Lanham Act (1946)
- 'Trademark' includes service marks, certification marks, collective marks
- Trademark ex: Selling hammers to local tool stores. The mark associated with "You Nailed It" is a trademark.
- Service mark ex: A home away from home for parakeets while the owners go on vacation. The mark associated with "For the Birds" is a service mark.

What is a Trademark?

- A trademark is (§1127) any word, name, symbol, or device, or any combination thereof
 - (1) used by a person, or
 - (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by the Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

What is a Trademark?

- Point to remember: The goal of trademark law is to PROTECT AGAINST CONSUMER CONFUSION
- We also want to prevent dilution of marks.

Trademarks Must Be Distinctive, Not Generic

- Must be distinctive enough to identify a single source
- If a term is generic, it cannot get trademark protection
 - Aspirin
 - Band Aid
 - Scotch Tape

Trademarks Must Be Distinctive, Not Generic

- 4 Different Categories:
 - 1. Generic
 - 2. Descriptive
 - 3. Suggestive
 - 4. Arbitrary or Fanciful



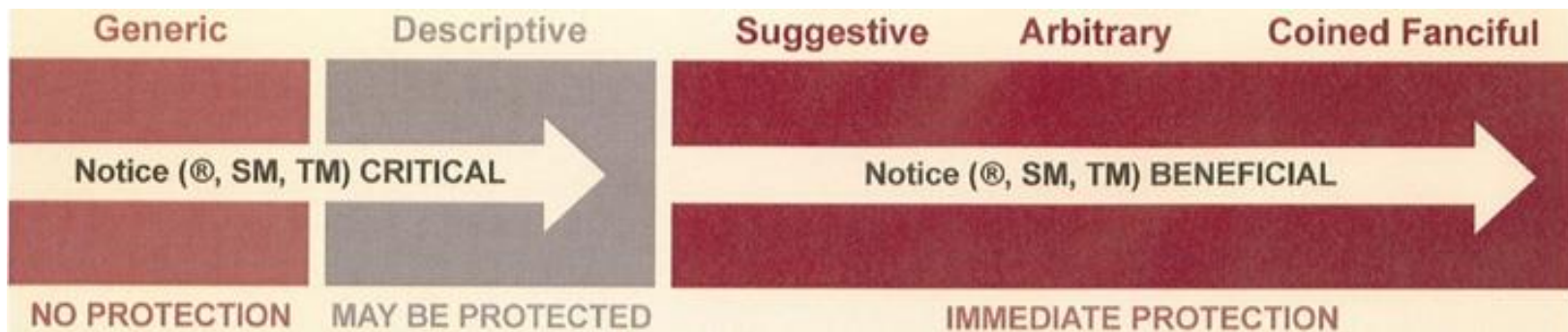
Trademark Categories/Spectrum

- Generic and descriptive terms
 - Generic terms = NEVER protected
 - Descriptive terms = SOMETIMES protected.
 - Sometimes? If it has secondary meaning.
- Suggestive terms
 - A term "is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods." (1995 1st Circuit Case)
 - If a term is considered 'suggestive,' it does not require a secondary meaning in order to merit trademark registration.
- Arbitrary and fanciful
 - Arbitrary - uses an existing word unrelated to the product or its description.
 - Fanciful - uses invented words.
 - Does NOT require proof of acquired meaning.

Trademark Categories/Spectrum

- A "term is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of goods."
- Suggestive marks are more distinctive than descriptive marks...[but] because they seek to suggest qualities of the product, they possess a low level of distinctiveness and are given less protection than is reserved for more distinctive marks--those that are "arbitrary" or "fanciful." In addition, recent case law has established that a suggestive mark with little acquired distinctiveness may be entitled to limited protection, but that it is not especially strong.
- [WE Media, Inc. v. Cablevision Sys. Corp., 94 Fed. Appx. 29 \(2d Cir. 2004\)](#)

Trademark Categories/Spectrum



Acquiring Trademark Rights

- Adoption and Use of a Mark
 - Requires that the mark be used in commerce
- Ownership of a Mark & Priority
 - Junior User v. Senior User
- Intent to Use
 - Meant to replace Token Use
 - Need a "bona fide" intention to use
- Once rights in a mark are established, those rights can be sold, licensed, or otherwise transferred.

Registration

- Not mandatory to register (as with copyright)
- The TM vs. the ®
- If you want to sue for infringement, must display a symbol to show that the defendant had actual notice of the trademark.
- Registration on the Principal Register

Registration

- Advantages to trademark registration
 - Permitted the use the 'registered' symbol
 - Provides constructive notice of user's claim to the mark
 - Serves as evidence of ownership
 - Permits claims to be brought in the federal courts
 - Permits parties to seek treble (triple) damages
 - Can serve as the basis for registering the mark abroad
 - Helps prevent infringing goods from being imported, by filing with customs

Registration

- The certificate issued when a trademark is registered with the PTO is prima facie evidence of:
 - the validity of the registered mark,
 - the registration of the mark,
 - the registrant's ownership, and
 - exclusive right to use the registered mark
- www.uspto.gov
 - USPTO = United States Patent & Trademark Office

Registration

- Registration on the Supplemental Register
 - Only has to be “capable of distinguishing” goods
 - Main benefits:
 - Ability to sue in federal courts
 - Treble damages
 - Presumption of Use



Maintaining a Registered Trademark

- Initial duration of 10 years
- Must file an affidavit of use during the 1-year window (required) otherwise the registration is cancelled at the one-year mark
- Can renew indefinitely

§1052 Bars to Registration

- Marks not approved for the primary registry
 - Immoral, deceptive, scandalous, or disparaging marks
 - Marks that resemble an insignia of the U.S. or foreign nation
 - Marks including the name of a living person without that person's consent.
 - Those marks confusingly similar to previously registered marks, or previously used marks that have not been abandoned.
 - Merely descriptive marks, deceptively misdescriptive marks, geographic terms, surnames, and functional terms.