

**NOLO**<sup>®</sup>

*"Excellent step-by-step instructions for registering a mark, written in plain English with clear examples. Recommended for all collections."*  
LIBRARY JOURNAL

9TH EDITION

# Trademark

## Legal Care for Your **Business & Product Name**

Attorneys Stephen Elias  
and Richard Stim

- Conduct a trademark search
- Choose a great name you can protect
- Fight back against infringers

**AMERICA'S  
NO. 1  
TRADEMARK  
LAW BOOK**

*Free Legal Updates at [Nolo.com](http://Nolo.com)*

# The **NOLO**® Story



*Dear friends,*

*Founded in 1971, and based in an old clock factory in Berkeley, California, [Nolo](#) has always strived to offer clear legal information and solutions. Today we are proud to offer a full range of plain-English law books, legal forms, software and an award-winning website.*

*Everything we publish is relentlessly researched and tested by a dedicated group of in-house legal editors, who together have more than 150 years' experience. And when legal changes occur after publication, we promptly post free [updates at Nolo.com](#).*

*Tens of millions of Americans have looked to Nolo to help solve their legal and business problems. We work every day to be worthy of this trust.*

*Ralph Warner  
Nolo co-founder*



### ***Books & Software***

---

**Get in-depth information.** Nolo publishes hundreds of great books and software programs for consumers and business owners. They're all available in print or as downloads at Nolo.com.



### ***Legal Encyclopedia***

---

**Free at Nolo.com.** Here are more than 1,400 free articles and answers to common questions about everyday legal issues including wills, bankruptcy, small business formation, divorce, patents, employment and much more.



### ***Plain-English Legal Dictionary***

---

**Free at Nolo.com.** Stumped by jargon? Look it up in America's most up-to-date source for definitions of legal terms.



### ***Online Legal Documents***

---

**Create documents at your computer.** Go online to make a will or living trust, form an LLC or corporation or obtain a trademark or provisional patent at Nolo.com. For simpler matters, download one of our hundreds of high-quality legal forms, including bills of sale, promissory notes, nondisclosure agreements and many more.



### ***Lawyer Directory***

---

**Find an attorney at Nolo.com.** Nolo's unique lawyer directory provides in-depth profiles of lawyers all over America. From fees and experience to legal philosophy, education and special expertise, you'll find all the information you need to pick a lawyer who's a good fit.



### ***Free Legal Updates***

---

**Keep up to date.** Check for free updates at Nolo.com. Under "Products," find [this book](#) and click "Legal Updates." You can also sign up for our free [e-newsletters](#) at [Nolo.com/newsletters/index.html](http://Nolo.com/newsletters/index.html).

**NOLO**<sup>®</sup>

## The Trusted Name

*(but don't take our word for it)*

*"In Nolo you can trust."*

**THE NEW YORK TIMES**

*"Nolo is always there in a jam as the nation's premier publisher of do-it-yourself legal books."*

**NEWSWEEK**

*"Nolo publications... guide people simply through the how, when, where and why of the law."*

**THE WASHINGTON POST**

*"[Nolo's]... material is developed by experienced attorneys who have a knack for making complicated material accessible."*

**LIBRARY JOURNAL**

*"When it comes to self-help legal stuff, nobody does a better job than Nolo..."*

**USA TODAY**

*"The most prominent U.S. publisher of self-help legal aids."*

**TIME MAGAZINE**

*"Nolo is a pioneer in both consumer and business self-help books and software."*

**LOS ANGELES TIMES**

9th edition

# Trademark

**Legal Care for Your Business  
& Product Name**

**by Attorneys Stephen Elias & Richard Stim**



NINTH EDITION    AUGUST 2010  
Editor                RICHARD STIM  
Cover Design        JALEH DOANE  
Book Design         TERRI HEARSH  
Proofreading        SUSAN CARLSON GREENE  
Index                 VICTORIA BAKER  
Printing              DELTA PRINTING SOLUTIONS, INC.

Stim, Richard.

Trademark : legal care for your business & product name / by Richard Stim & Stephen Elias. -- 9th ed.

p. cm.

Rev. ed. of: Trademark : legal care for your business & product name / by Stephen Elias & Richard Stim. 8th ed. 2007.

Includes index.

Summary: "A complete guide to all business name and trademark issues including choice of name, trademark registration, domain names, and dealing with infringement. This completely updated edition includes all of the latest trademark cases and rules regarding online registration. It also features an FAQ/Dear Rich questions and answer section"--Provided by publisher.

ISBN-13: 978-1-4133-1256-0 (pbk.)

ISBN-10: 1-4133-1256-X (pbk.)

I. Elias, Stephen. II. Elias, Stephen. III. Title.

KF3180.Z9E43 2010

346.7304'88--dc22

2010009267

Copyright © 2010 by Nolo. All rights reserved. The NOLO trademark is registered in the U.S. Patent and Trademark Office. Printed in the U.S.A.

No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without prior written permission. Reproduction prohibitions do not apply to the forms contained in this product when reproduced for personal use. For information on bulk purchases or corporate premium sales, please contact the Special Sales Department. Nolo, 950 Parker Street, Berkeley, California 94710.

***Please note***

We believe accurate, plain-English legal information should help you solve many of your own legal problems. But this text is not a substitute for personalized advice from a knowledgeable lawyer. If you want the help of a trained professional—and we'll always point out situations in which we think that's a good idea—consult an attorney licensed to practice in your state.

## **Dedication**

I dedicate this book to my mother, the late Edna Elias-Johnson, and to Stanley and Dorothy Pearson. They don't make 'em like they used to.

**Steve Elias**



# Table of Contents

	<b>20 Frequently Asked Trademark Questions.....</b>	<b>1</b>
	<b>Your Legal Companion for Trademarks.....</b>	<b>9</b>
	What's New Since the Last Edition?.....	10
<b>1</b>	<b>A Trademark Primer.....</b>	<b>15</b>
	Trademarks and Trademark Law .....	17
	Basic Principles of Trademark Law .....	22
	The Role of Federal Registration in Protecting Trademarks.....	31
	Not All Business Names Are Trademarks .....	35
	Trade Name Formalities.....	36
	Trade Dress and Product Designs.....	42
	Sources of Trademark Law.....	47
	The Difference Between Trademark and Copyright .....	50
	The Difference Between Trademark and Patent .....	51
<b>2</b>	<b>Trademark, Domain Names, and the Internet.....</b>	<b>53</b>
	How to Clear and Register Domain Names.....	54
	What to Do If the Domain Name You Want Is Already Registered .....	59
	Domain Names and Trademarks.....	63
	Other Trademark Issues in Cyberspace .....	64

<b>3</b>	<b>How to Choose a Good Name for Your Business, Product, or Service</b> .....	69
	Anatomy of a Product or Service Name Trademark.....	72
	Distinctive Names Make Legally Strong Trademarks.....	73
	How Trademark Law Treats Marks With Common Terms.....	74
	What Makes a Distinctive Trademark a Legally Strong Trademark?.....	77
	Guidelines for Making a Mark Distinctive.....	78
	Marketing Considerations When Choosing a Name Mark.....	88
<b>4</b>	<b>Trademark Searches—What They Are and Why You Should Do One</b> .....	95
	What Is a Trademark Search?.....	96
	Why Do a Trademark Search?.....	96
	What Resources Are Used in a Trademark Search?.....	97
	Where Are Trademark Search Resources Located?.....	97
	Different Levels of Trademark Searches—What They Are; When They're Appropriate.....	100
	Planning Your Trademark Search.....	104
	Using a Professional Search Service.....	109
	Using a Patent and Trademark Depository Library to Do Your Own Search.....	113
	Does Your Failure to Search Mean You Acted in Bad Faith?.....	114
<b>5</b>	<b>How to Do Your Own Trademark Search</b> .....	117
	Meet TESS—The Trademark Electronic Search System.....	119
	Getting Started With TESS.....	120
	Understanding the TESS Structured Form Search.....	123
	Tips on Using the TESS Structured Form Search.....	127
	Trademark Searching With TESS: An Example.....	132
	Understanding the TESS Free Form Search.....	134

Understanding the Results of Your Search.....	137
An Introduction to SAEGIS—A Fee-Based Search System .....	141
Searching for Designs.....	143
Searching State-Registered Trademarks and Trade Names .....	144
Searching for Trade Names and Unregistered Marks .....	145

## **6 How to Evaluate the Results of Your Trademark Search ..... 151**

What’s Involved in Evaluating Trademark Search Results?.....	153
What Is the Likelihood of Customer Confusion? .....	155
An Overview of How Marks Are Evaluated for Their Potential to Cause Customer Confusion.....	158
How Closely Related Are the Goods and Services?.....	160
Do the Goods or Services Compete?.....	170
How Similar Are the Marks? .....	170
Additional Factors.....	171
Final Factors.....	174
How to Read a Trademark Search Report .....	175

## **7 Federal Trademark Registration ..... 185**

Brief Overview of Federal Registration .....	188
What Marks Qualify for Federal Registration .....	189
If You Haven’t Started Using Your Mark, Should You File an Intent-to-Use Application? .....	194
What Examples of Your Mark Will You Submit With Your Application?.....	197
What International Class Is the Best Fit for Your Product or Service?.....	203
Deciding How Many Marks You Want to Register .....	205
Applying for Registration Online.....	206
If You Are Filing by Mail .....	226
What Happens Next?.....	227

Communicating With the PTO.....	228
If the Examiner Issues a Rejection Letter.....	230
Follow-Up Activity Required for Intent-to-Use Applications.....	236
Follow-Up Activity Required After Registration.....	240
<b>8 How to Use and Care for Your Trademark.....</b>	<b>241</b>
Use of the Trademark Registration ® Symbol.....	242
Use of the TM or SM Symbol for Unregistered Trademarks.....	244
File Your Section 8 and 15 Declarations.....	244
File Your Section 8 Declaration and Section 9 Application for Renewal.....	248
Use It or Risk Losing It.....	249
Maintain Tight Control of Your Mark.....	250
Use the Mark Properly—Avoid Genericide.....	252
Transferring Ownership of a Trademark.....	253
<b>9 Evaluating Trademark Strength.....</b>	<b>257</b>
A Brief Review of What Makes a Strong Mark.....	258
For Marks Consisting of Words, Identify the Distinctive Part of the Mark.....	259
Assess the Legal Strength of the Trademark Aspect of Your Word Mark.....	260
<b>10 Sorting Out Trademark Disputes.....</b>	<b>283</b>
Trademark Infringement.....	286
Determining Priority in an Infringement Dispute.....	298
Dilution.....	310
Cybersquatting.....	317

<b>11</b>	<b>If Someone Infringes Your Mark</b> .....	327
	What Litigation Costs .....	328
	How Much Is Your Mark Really Worth to You? .....	328
	Negotiate—Don't Litigate .....	332
	How to Handle an Infringer .....	335
<b>12</b>	<b>If Someone Claims That You Infringed a Trademark</b> .....	347
	What the Complaining Party Can Do to You .....	348
	Steps You Should Take .....	349
<b>13</b>	<b>International Trademark Protection</b> .....	353
	Where Will You Seek Protection? .....	355
	How Will You Register Abroad? .....	358
<b>14</b>	<b>Help Beyond This Book</b> .....	361
	Nolo: Your One-Stop Trademark Resource .....	362
	Finding Trademark Laws and Information on the Internet .....	363
	Doing Your Own Research in a Law Library .....	364
	Finding a Lawyer .....	366

## Appendixes

<b>A</b>	<b>International Classifications of Goods and Services</b> .....	375
<b>B</b>	<b>Glossary of Terms</b> .....	401
<b>C</b>	<b>Selected Pages From Thomson CompuMark Trademark Research Report</b> .....	411
	<b>Index</b> .....	429





## 20 Frequently Asked Trademark Questions

1. What does it mean to “trademark” a business or product name or logo? ..... 3
2. What is the difference between a trademark and a service mark? ..... 3
3. How long does it take to get a trademark registered? ..... 3
4. Suppose I register a trademark for a particular product. What happens when I want to use the same trademark for a different product? ..... 3
5. Can I apply to register a logo, name, and slogan all in one application? What happens if I want to use them separately? ..... 4
6. What happens if I register my mark and later find out that someone else was already using the mark but never got around to registering it? ..... 4
7. I’ve been told to do a trademark search before applying to register my mark. Why should I, if the PTO does one when it gets my application? ..... 4
8. What is a “common law” trademark, and what rights does it give me? ..... 5
9. Why should I bother to register a trademark I’m already using on my business or products if I already have rights under the common law? ..... 5
10. Can I do the application myself or should I hire an attorney? ..... 5
11. What if I find an exact match or near-exact match in a search? Can I still use my proposed trademark anyway? What’s the worst that can happen? ..... 6
12. Can I register my domain name/Internet website address as a trademark? ..... 6
13. What’s the difference between state and federal trademarks? ..... 6

14. If my trademark search finds a mark identical or similar to mine and I find out that the owner is no longer in business (or that the mark is no longer being used by that business), am I free to use it? Can I register it with the PTO? ..... 7
15. If I combine my business or product name with a logo, does the combination distinguish the name from other names that are already registered or in use? ..... 7
16. What materials should I search in order to feel like I've been thorough enough? ..... 7
17. What is the *Official Gazette*, published by the PTO, and who reads it? ..... 7
18. I've learned that I'll have to renew my trademark registration in a few years. Will the PTO notify me when the time comes, or do I have to keep track of this date myself? ..... 8
19. How do I get the official PTO form to apply for a federal trademark registration? ..... 8
20. How do I get an international trademark? ..... 8

**B**elow are brief answers to 20 of the most common questions about trademarks.

**1. What does it mean to “trademark” a business or product name or logo?**

When people say they plan to “trademark” a name or logo, they generally mean they intend to register the name or logo with the U.S. Patent and Trademark Office (PTO). Though federal registration provides important benefits, trademark ownership is actually determined by who uses the mark first in a commercial setting. So, by using a name, logo, or other symbol to identify goods or services in the marketplace, a trademark has been created and trademark ownership has been established.

**2. What is the difference between a trademark and a service mark?**

A trademark is any name, logo, symbol, or other device used to distinguish a product from competing products in the marketplace and to identify the product’s source. A service mark is any name, logo, symbol, or other device used to distinguish a service from others in the marketplace and to identify the source of the service. Legally, there is no difference between the two terms, and the terms “trademark” and “mark” are often used for all types of marks, including service marks.

**3. How long does it take to get a trademark registered?**

The typical time it takes to federally register a trademark is between 12 and 18 months.

**4. Suppose I register a trademark for a particular product. What happens when I want to use the same trademark for a different product?**

Each product or service is categorized within a class. If you begin using your trademark on a product or service in a different class than the one for which you originally registered your mark—for example, you used your logo on a paint product when you originally registered it for painting services—you should file another application to register the new use of the mark (in the appropriate class). However, you must check that the mark is not being used by another business for a similar product. If it is, you may need the assistance of a trademark attorney before proceeding.

**5. Can I apply to register a logo, name, and slogan all in one application?**

**What happens if I want to use them separately?**

If you want to use and protect each separately, you should register each separately. However, you can—if you wish—register them as one trademark and claim rights for the cumulative use.

**6. What happens if I register my mark and later find out that someone else was already using the mark but never got around to registering it?**

If the other mark was being used nationally, as is the case with most catalog and Internet sales, then your trademark registration may be subject to cancellation. In any event, the registration will not protect you from an infringement suit if the first user can establish that your use of the mark is creating the likelihood of customer confusion. If the other mark was only being used locally, you will probably be entitled to use the name in any region of the country where the first user had not established a presence.

**7. I've been told to do a trademark search before applying to register my mark. Why should I, if the PTO does one when it gets my application?**

There are three good reasons:

- Filing an application for federal trademark registration costs \$275 to \$325 if filing electronically (\$375 if filing a paper application). There is no point in filing an application for a name that the PTO will reject because it's already owned by someone else.
- It is up to you to decide whether the mark you eventually choose is both registrable and free from infringing an existing mark. The PTO may find a potentially confusing mark in the course of its search but still decide to register your mark on the basis of its internal guidelines. However, the PTO's decision to register your mark doesn't get you off the hook if the owner of the existing mark decides to take you to court.
- The PTO search primarily covers the federal trademark register, not trademarks that are in use but not registered. Because use, rather than registration, determines ownership, the PTO search will not be as complete as your own search of both registered and unregistered marks.

**8. What is a “common law” trademark, and what rights does it give me?**

A common law trademark is any device (name, logo, slogan, and so on.) that is being used to identify a business’s goods or services in the marketplace and has not been registered with a state government or with the federal government. The owner of a common law trademark that is used in more than one state can use the federal courts to enforce its rights in the parts of the country where the mark is being used.

**9. Why should I bother to register a trademark I’m already using on my business or products if I already have rights under the common law?**

It’s a lot easier to win a federal lawsuit against later users by establishing certain presumptions—facts that you don’t have to prove in court and the other side must rebut. Federal registration gives you two presumptions: that you are the mark’s owner, and that the later user deliberately copied the mark. These presumptions also make it easier to prove infringement and collect damages and attorneys’ fees.

**10. Can I do the application myself or should I hire an attorney?**

Most people can handle their own trademark applications without attorneys. The PTO provides easy-to-use instructions for filing your own trademark registration online using its Trademark Electronic Application System (TEAS) at its website ([www.uspto.gov](http://www.uspto.gov)).

If, however, you have questions that the PTO or online registration help files don’t answer, you should consult with an attorney. Also, if the mark you are planning to register is unusual (a color, sound, or scent, for example), or for some reason the PTO doesn’t want to accept your application, you will need to consult an attorney.

**Nolo’s Online Trademark Application**

[Nolo’s Online Trademark Application](#) is an automated system for assistance in filing your federal trademark application. Find it on Nolo’s homepage ([www.nolo.com](http://www.nolo.com)). Click “Trademark a Name” under Online Legal Forms.

**11. What if I find an exact match or near-exact match in a search? Can I still use my proposed trademark anyway? What's the worst that can happen?**

Practically, if you are able to keep the dispute out of court by immediately stopping your use of the mark, you may escape with only having to pay all or part of the trademark owner's attorneys' fees incurred up to that point. This is usually true if you are a small business, because the owner would have no reason to try to pick your pockets. However, the larger you are, or the more your business competes with the owner's, the more likely it is that any settlement will also involve some cash to make up for harm caused by your infringement, real or imagined.

If you are sued for damages, you may be ordered to:

- actual economic damages suffered by the owner as a result of your infringement or the amount of your profits earned while using the mark
- punitive damages in the amount of three times the amount of damages or profits awarded the owner, and
- attorneys' fees incurred by the owner in bringing the infringement suit.

In addition, of course, the court may order you to stop using the mark, which may result in additional expense as well as the need to rebuild goodwill around a new mark.

**12. Can I register my domain name/Internet website address as a trademark?**

Yes, you may apply to federally register your domain name as a trademark, provided that it is being used to market goods or services on the Internet. If, on the other hand, the domain name is not used to sell goods or services—for example, it is only being used for personal or family reasons—registration will be denied.

**13. What's the difference between state and federal trademarks?**

A state trademark is one that is used within the state and registered on the state's trademark list—unlike a federal trademark, which must be used in more than one state, or in any commerce regulated by Congress.

**14. If my trademark search finds a mark identical or similar to mine and I find out that the owner is no longer in business (or that the mark is no longer being used by that business), am I free to use it? Can I register it with the PTO?**

The answer to both questions is “not necessarily.” Even if the original owner is no longer in business, the mark itself may have been assigned to another business, which is using it. Similarly, even if the original owner is still in business but no longer using the mark, it may be in use by someone else under an assignment. Finally, if the mark is a creative graphic, such as a logo or trade dress, it may still be protected by copyright law (which protects creative works or expression).

**15. If I combine my business or product name with a logo, does the combination distinguish the name from other names that are already registered or in use?**

If the name accompanying your logo is the same as or very similar to a name that is federally registered or used, you will be precluded from using or registering the name/logo combination, even though the appearance of your name/logo combination and the other name are completely different.

**16. What materials should I search in order to feel like I’ve been thorough enough?**

At the very least, you should search the federal trademark register for names or other marks that possibly conflict with yours. In addition, you should search relevant trade publications, as well as the Internet.

**17. What is the *Official Gazette*, published by the PTO, and who reads it?**

The *Official Gazette* is read by anyone whose business involves keeping up with the latest PTO announcements and rules—mostly patent and trademark attorneys, patent agents, and others. One reason for its popularity is that all trademarks proposed for federal registration are published in the *Gazette*, alerting the public in the event that there is an objection to registration. You can read the *Gazette* for free online at the PTO website. It is no longer published in paper format.

**18. I've learned that I'll have to renew my trademark registration in a few years. Will the PTO notify me when the time comes, or do I have to keep track of this date myself?**

The PTO will not notify you. You are responsible for keeping track of the required renewal dates. If you miss the deadline, your trademark registration will be cancelled. This does not affect your ownership of the mark, assuming you are still using it, but you will have to reregister the mark to maintain the benefits of registration.

**19. How do I get the official PTO form to apply for a federal trademark registration?**

The PTO discourages the use of paper applications and has changed its rate to reflect this preference (see below). (In fact, the PTO no longer provides a paper form for trademark applications.) We have not included a blank paper application form in this book and we discourage its use. The online application process, with its interactive help, is less likely to result in errors for first-time filers. Filing electronically also gets you directly into the USPTO system and allows you to file an application anywhere. Currently, when applying for registration, you can:

- use the PTO's online TEAS program to fill in and file an application form online (currently \$325 per class for a regular TEAS application or \$275 per class for a TEAS Plus application), or
- prepare a paper application (currently \$375 per class).

**20. How do I get an international trademark?**

There is no such thing as an international trademark. It is possible to file one application for a group of countries using a procedure known as the Madrid Protocol. The Madrid Protocol includes 79 countries. In addition, you can file one application and obtain protection (known as a Community Trademark) in 27 European countries. Otherwise, you must seek protection on a country-by-country basis.



# Your Legal Companion for Trademarks

**T**wenty years ago, a local business could reasonably expect its marketing activities to be limited to a neighborhood, town, city, county, or even one state. As long as its name (usually its only trademark) didn't conflict with any in use by other local businesses, there was little likelihood of customer confusion and therefore of any legal conflict. Today—because of the Internet—the concept of local is rapidly disappearing for many types of businesses. Doing business on the Web increases the scope of your business from local to national and, because of that, there are new rights and responsibilities. Now, you must pay attention to how your name or other trademarks fit within the vast sea of trademarks that is U.S. commerce. In short, knowledge of trademarks (or branding, as it is fashionably known these days) has become a prerequisite for operating a business.

On the other hand, let's be realistic. Your trademark or name is only one of many concerns you have in your day-to-day business. You don't need to become a trademark expert—you only need the basic knowledge that protects your business name. Our goal in writing this book is to do just that—to give you everything your business needs to secure and protect your name efficiently and at a reasonable cost.

With that in mind, this book plots a course for small business owners. The first half of the book deals with choosing and registering a trademark and the second half deals with preserving your rights and staying out of trouble.

To achieve our goals, this book explains:

- how trademark rules affect business
- how to choose the best trademark for your business
- how to check to see whether other businesses are using similar trademarks
- how to federally register your trademark
- the relationship between domain names and trademarks

- how to maintain your trademark once you've got it
- how to evaluate claims of trademark infringement, and
- the basics of international trademark protection.

Because your chances of being sued over a trademark dispute are slim—fewer than 5,000 trademark-related lawsuits are filed in federal courts each year (and many of these are counterfeiting disputes)—we do not explain how to sue or defend a federal or state court lawsuit for trademark infringement. Nor do we explain the intricacies of handling a case brought in the U.S. Patent and Trademark Office (USPTO)—usually filed when someone opposes your trademark registration—although we do explain how to respond to the many minor issues that may arise in the course of navigating your trademark application.

Complex proceedings, such as lawsuits and USPTO disputes, will likely require the assistance of an attorney skilled in trademark law. There may be other situations when an attorney's help is needed and throughout the book we will alert you when you may have reached that point. In short, if things should become more complex, we advise you when and how to seek professional help.

Those pesky problems aside, you should be able to handle most trademark issues with the aid of this legal companion (and without the aid of an attorney). After you've chosen and secured your name and your business is operating smoothly, place this book among your other business references, ready to be pulled into action if you need more practical advice.

Although we've been harping on legal issues and concerns, keep in mind that our biggest goal of all is that your business prospers and that consumers associate your trademark with excellent quality and service.

## What's New Since the Last Edition?

Here are some of the changes to trademark law that have occurred since the last edition.

**Fraud on the USPTO requires intent.** If someone commits fraud when preparing a trademark application, the application will be denied (or the registration later revoked). The standards for judging fraud

were modified in 2009. The new standard is that an applicant is held to what is known, not what the applicant “should have known.” The changes resulted from a case in which an audio manufacturer renewed a trademark application for goods including “audio tape recorders” that the manufacturer serviced, but did not manufacture or sell. Because the manufacturer no longer made audio tape recorders, the Trademark Trial and Appeals Board (TTAB) maintained that the applicant should have known of its error—stating that fraud on the USPTO occurs when an applicant misrepresents facts he or she “knows or should know” to be false or misleading. On appeal, the Court of Appeals for the Federal Circuit (CAFC) reinstated the mark and terminated the “should have known” standard for alleging fraud. (*In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009).) Subsequent cases have followed this precedent—for example, when an applicant incorrectly listed “transmission of oil” as one of its services, the TTAB held that absent proof of “deceptive intent,” there was no fraud. (*Enbridge, Inc. v. Excelebrate Energy Limited Partnership*, 92 USPQ2d 1537 (TTAB 2009).) And in *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478 (TTAB 2009), the TTAB stated that a pleading of fraud must include “an allegation of intent.”

**Google keyword advertising constitutes “use in commerce.”** Rescuecom sued Google over its sale of the Rescue.com trademark as a keyword to trigger competitors’ ads. (Google sells keywords that trigger sponsored links in user searches.) The Second Circuit permitted the case to go forward because the Lanham Act (15 U.S.C. § 1127) defines “use in commerce” to include when “displayed in the sale or advertising of services.” However, despite the victory, Rescuecom settled the case, apparently on terms favorable to Google. (*Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009).) In a related keyword case, a district court ruled that a company could allege trademark infringement when a competitor’s sponsored link was triggered by its trademark and also included within the sponsored ad. (*Romeo & Juliette Laser Hair Removal, Inv. B. Assara I L.L.C.*, WL 750195 (S.D. NY March 20, 2009).)

**Federal registration provides nationwide priority.** The owner of the TOUCH trademark for a Florida nightclub restaurant was able to stop a New York City nightclub from using a similar name. The Florida owner

demonstrated that its mark was nationally known and its registration entitled it to national priority. (*S B ICE, LLC v. MGN LLC*, 2008 WL 4682152 (S.D. NY October 20, 2008).)

**Intent-to-use applicant must have “actual intent to use.”** An applicant for a federal registration using the intent-to-use application (ITU) was unable to provide any documents or other evidence of an actual intent to use a mark (ENYCE on custom auto accessories). On that basis, the TTAB ruled that the applicant could not claim rights as an ITU applicant. (*L.C. Licensing, Inc. v. Berman*, 86 USPQ 2d 1883 (TTAB 2008).) In a similar case involving a foreign registrant, the TTAB held that an applicant who “has not had activities in the United States and has not made or employed a business plan, strategy, arrangements or methods there,” and “has not identified channels of trade that will be used in the United States,” does not have a bona fide intent to use the mark. (*Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660 (TTAB 2009).)

**Songs can’t be trademarks.** The Romantics, a pop group from the 1980s, alleged that a song they popularized, “What I Like About You,” functioned as a trademark for the band and was therefore infringed by the use in connection with the video game, “Guitar Hero.” A district court rejected the trademark argument as being unsupported by case law and an “unwarranted extension into an area already protected by copyright law.” (*Romantics v. Activision Publishing Inc.*, 88 USPQ 2d 1243 (E.D. Mich. 2008).)

**Grand Theft Auto permitted to parody strip club.** The video game, “Grand Theft Auto: San Andreas” included a parody of the East Los Angeles strip club, The Play Pen, (referred to as the “Pig Pen” in the game). The court permitted the parody under First Amendment principles noting that artistic use of a mark is permitted when (1) the use has artistic relevance to the work at issue (the video game) and (2) it doesn’t explicitly mislead consumers as to the source of the mark or the work—a test adopted by the Ninth Circuit in *Mattel v. Walking Mountain*. (Note: the Ninth Circuit rejected the defense of nominative trademark fair use—when someone uses a mark to describe the product for purposes of comparison and criticism—because the video game did

not describe or comment on the Play Pen mark.) (*E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.* 547 F.3d 1095 (9th Cir. 2008).)

**Likelihood of confusion standard is simplified for counterfeits.** When goods are classified as counterfeit—that is, lookalike goods with fake trademarks—there is no need to conduct a factor-by-factor analysis of likelihood of confusion. In a case involving two merchandising companies, the district court ruled that by their very nature, counterfeit goods cause confusion. (*Bravado International Group Merchandising Services v. Ninna, Inc.*, U.S. Dist. LEXIS 78040 (E.D. NY October 6, 2008).)

**ISP that hosts websites selling counterfeit goods can be liable for contributory trademark infringement.** An Internet service provider (ISP) that hosted several websites selling fake Louis Vuitton merchandise could be liable for contributory trademark infringement. The district court likened the ISPs in this case to the proprietor of the flea market found liable for contributory infringement in *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996). (*Louis Vuitton Malletier v. Akanoc Solutions*, 591 F. Supp. 2d 1098 (N.D. Cal. 2008).)

**Adoption of mark after a refusal to register can indicate bad faith.** The USPTO refused to register the NOW trademark for watches because the applicant’s use was likely to infringe an existing trademark. Later, the applicant used the mark anyway. The applicant’s subsequent use of the rejected mark was shown to be bad faith. (*E. Gluck Corp. v. Rothenhaus*, 985 F. Supp. 2d 505 (S.D. NY 2008).)

**Competing use of generic term is not enough to claim likelihood of confusion.** The First Circuit determined that the term “duck tours” was a generic reference to land and water tours in World War II amphibious crafts known as DUKWs. As a result, Boston Duck Tours could not halt use of Super Duck Tours even though it advanced evidence of actual confusion. (*Boston Duck Tours L.P. v. Super Duck Tours, LLC*, 531 F. 3d 1 (1st Cir. 2008).)

**Bad faith demonstrated by registration of domain names for merging banks.** Expecting a merger, the defendant in a cybersquatting dispute registered domain names that combined elements of Bank of America and Merrill Lynch—for example bofaml.com. The defendant argued

that it had never sold a domain name. The court rejected that argument since the defendant earned considerable sums by “parking” the domains—that is, by generating pay-per-click revenue. (*Webadviso v. Bank of America Corp.*, S.D.N.Y., No. 09-cv-05769-DC, 2/16/09.)

**Temporary restraining order (TRO) not merited in battle of the “Joe’s.”**

Original Joe’s, an Italian restaurant in San Francisco, closed temporarily after a fire. The company that owned the mark discussed plans to construct a restaurant, Uptown Joe’s, in connection with a hotel. When those plans fell apart, the hotel proceeded with the restaurant, keeping the name. Original Joe’s sought a TRO against the hotel. The court refused to grant the TRO because of the presence of many other Italian restaurants with Joe in their titles and because the Original Joe’s had not reopened and therefore could not demonstrate immediate damage. (*Original Joe’s Inc. v. Pinsonneault Holdings LLC*, N.D. Cal., No. 3:09-cv-05203-CRB, 11/24/09.)

**“Cuffs and collar” trade dress not registrable for adult entertainment service.** The TTAB refused to register the cuffs and collar design mark used by the Chippendales exotic male dancers finding that when considered as trade dress, it was not inherently distinctive. (*In re Chippendales USA, Inc.*, 90 USPQ2d 1535 (TTAB 2009).)

**Alarm clock’s sound cannot be registered unless it acquires distinctiveness; alternately, an alarm is functional and not registrable.** The manufacturer of an alarm clock failed to demonstrate acquired distinctiveness for its alarm sound, and the TTAB found that the sound was functional and could not by its nature be inherently distinctive. (*In re Vertex Group LLC*, 89 USPQ2d 1694 (TTAB 2009).)

**Adding “.com” does not make generic term distinctive.** The TTAB refused to register the mark, MATTRESS.COM noting that the addition of the “.com” does not otherwise distinguish the generic use of the term mattress (for a website selling mattresses). (*In re 1800Mattress.com IP LLC substituted for Dial-A-Mattress Operating Corp* Fed. Cir., No. 2009-1188, 11/6/09.)



# A Trademark Primer

<b>Trademarks and Trademark Law</b> .....	17
What Are Trademarks?.....	18
What Is Trademark Law, and Why Do You Need to Know About It?.....	21
<b>Basic Principles of Trademark Law</b> .....	22
Strong Marks Versus Weak Marks: What Trademark Law Protects .....	25
Ownership of a Trademark: The First-to-Use Rule.....	25
The Role of Customer Confusion in Trademark Law .....	28
Special Treatment for Famous Marks: The Dilution Doctrine .....	29
How Trademark Law Protects Trademarks .....	30
<b>The Role of Federal Registration in Protecting Trademarks</b> .....	31
The Principal Register .....	32
The Supplemental Register.....	34
State Trademark Registers.....	34
<b>Not All Business Names Are Trademarks</b> .....	35
<b>Trade Name Formalities</b> .....	36
Trade Name Registration Requirements.....	37
The Legal Relationship Between Trade Names and Trademarks .....	41
<b>Trade Dress and Product Designs</b> .....	42
Distinctiveness .....	43
Trade Dress Can Be Registered With the PTO .....	45
Likelihood of Confusion Is Required.....	45
Functional Trade Dress Is Not Protected as a Trademark.....	45
If Your Product Design Is Both Functional and Novel .....	47
<b>Sources of Trademark Law</b> .....	47
The Federal Lanham Act.....	48
State Trademark and Unfair Competition Laws .....	48

Common Law of Trademarks.....	49
<b>The Difference Between Trademark and Copyright.....</b>	<b>50</b>
<b>The Difference Between Trademark and Patent.....</b>	<b>51</b>

This chapter provides an introduction to the basics of trademark law. It will give you the background necessary to understand your rights and obligations in choosing and using a trademark to identify your business and products in the marketplace.

## Trademarks and Trademark Law

What's in a name? To Shakespeare, "A rose by any other name would smell as sweet." But what is true in love can be the opposite in business. IBM would not smell half so sweet by another name, nor would Google, Apple, McDonald's, or Levi's. In the business world, the name of a successful product or service contributes greatly to its real worth. Every day, names such as Allendale Auto Parts or Building Blocks Day Care identify these businesses for their customers, help customers find them, and (assuming they provide a good product or service) keep the customers coming back again and again.

And it's not just a clever business or product name that pulls in the customers. Equally important in the vast U.S. consumer marketplace are the logos, packaging, innovative product shapes, cartoon characters, website address names (domain names), and unique product characteristics that businesses are using to hawk their wares. Even the look and feel of a business's website is important for a business to identify itself and its products in the marketplace.

All of these devices—business and product names, logos, sounds, shapes, smells, colors, packaging—carry one simple message to potential customers: Buy me because I come from XYZ Company. To the extent that these devices are unusual enough to distinguish their underlying products and services from those offered by competitors, they all qualify as trademarks.

If a small business owner were to remember only one point in this book, it should be this: The instant a business or product name or any other identifying device is used in the marketplace—be it in advertising, on a label, on an Internet site, or in any other way intended to reach out to potential customers—it falls within the reach of trademark law. Trademark law will determine who wins a dispute over the use of the

name. Few business owners can afford to disregard or run afoul of this body of law.

## What Are Trademarks?

Trademarks fall into two general categories: marks that identify goods or products (known as trademarks) and marks that identify services (known as service marks). Though you may occasionally see this distinction in action, these terms are, in fact, legally interchangeable, and the even more general term—mark—commonly is used to refer to both. In this book, we tilt towards the terms “trademark” and “mark” and seldom use “service mark.”

Technically speaking, a trademark is any word, design, slogan, sound, or symbol (including nonfunctional unique packaging) that serves to identify a specific product brand—for instance, Xerox (a name for a brand of photocopiers), Just Do It (a slogan for a brand of sport shoes and sportswear), Apple’s apple with a bite missing (a symbol for a brand of computers), and the name Coca-Cola in red cursive lettering (a logo for a brand of soft drink).

A service mark is any word, phrase, design, or symbol that operates to identify a specific brand of service—for instance, McDonald’s (a name for a brand of fast food service), ACLU (a name for a brand of legal organization), Blockbuster (a name for a brand of video rental service), the U.S. Postal Service’s eagle in profile (a symbol for a brand of package delivery service), CBS’s stylized eye in a circle (a symbol for a brand of television network service), and the Olympic Games’ multicolored interlocking circles (a symbol for a brand of international sporting event).

In addition to trademarks and service marks, federal trademark law protects two other types of marks—certification marks and collective marks.

Certification marks are only used to certify that products and services that are manufactured or provided by others have certain qualities associated with the marks. For example, Good Housekeeping Seal of Approval (a product approved by a homemaking magazine), Roquefort (a cheese from a specific region in France), and Harris Tweeds (a special

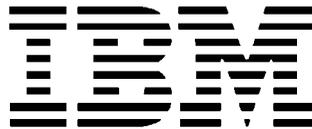
weave from a specific area in Scotland) are all certification marks. Among the characteristics that this type of mark may represent are regional origin, method of manufacture, product quality, and service accuracy.

A collective mark is a symbol, label, word, phrase, or other distinguishing mark that signifies membership in an organization (a collective membership mark) or that identifies goods or services that originate from the member organization (a collective trademark). For example, the letters ILGWU on a shirt are a collective mark identifying the shirt as a product of members of the International Ladies Garment Workers Union. It distinguishes that shirt from those made by nonunion shops.

Another example of a collective membership mark is the familiar FTD found in many flower shops. This mark means that the flower shop is part of a group that participates in a national flower delivery system. To belong to that group—and thus obtain authorization to use the FTD mark—the shop must pay steep membership fees and conform its practices to the rules set out by the group.

Because a small business's need for collective or certification marks is relatively rare, we don't address them further in this book. If you need help in creating and protecting this type of mark, consult a trademark attorney. (See Chapter 14, "Help Beyond This Book.")

Although most small businesses rely on their business names as their primary trademarks, there are many other ways for a business to inform consumers about itself, its services, and its products.



## Logos

Next to a name, the most popular commercial identifier is the logo, a pure graphic or a combination of a graphic and some aspect of the business name. Examples abound. The block-lettered Ford set against a blue oval, the distinctive blue lettering used for IBM, the gold

McDonald's arch, the universally recognized swirl used to denote Nike products, and the blue cross used to denote health care services all demonstrate how powerfully a logo can garner instant product or business recognition.

## **Slogans**

Another popular form of trademark is the marketing slogan. “Obey your thirst” (Sprite); “It’s everywhere you want to be” (Visa); “I love what you do for me” (Toyota); “Just Do It” (Nike); “Life is a sport; drink it up” (Gatorade), and “Life is a journey; enjoy the ride” (Nissan) are all devices designed to build customer recognition of the underlying businesses and their products, and therefore each qualifies as a trademark that deserves the same protection under trademark law as a business name.

## **Packaging, Decor, Product Shape, and Web Pages**

In recent decades, a type of trademark known as trade dress has become more important to businesses trying to build customer recognition. Trade dress includes product packaging, external and internal store decor, product shapes, and perhaps the look and feel of a business's Web page. As long as the appearance of the product or its packaging operates as a trademark, it will be treated and protected as a trademark, assuming it meets other trademark requirements, such as distinctiveness.

## **Colors**

Colors help to distinguish products and services. A box of film that is gold and black connotes a Kodak product. A yellow arch indicates McDonald's food services. When color is used with a name or graphic design of a trademark (such as the red lettering and blue star of Converse footwear or the yellow and black coloring of the Cliffs Notes book series) it is registered as an element of the trademark.

It was not until recently that the United States began to protect combinations of colors or single colors by themselves—that is, without any additional text or graphics. In the 1980s, Owens-Corning registered the color pink for its fiberglass insulation and, in 1995, the Supreme Court ruled that a manufacturer of dry-cleaning press pads could

claim registration for a green-gold color. (*Qualitex v. Jacobson Products*, 514 U.S. 159 (1995).) Also, a federal appeals court has ruled that a color combination (signifying different tensions in an exercise band) could be protected. (*Fabrication Enters. v. Hygenic Corp.*, 64 F.3d 53 (2d Cir. 1995).)

Colors may not be protected on the grounds that they are inherently distinctive. Rather, to obtain protection, the owner of a potential mark for color must establish that, given its use in the marketplace, consumers have come to associate the color with the owner's products or services, as indeed was the case with the Owens-Corning pink fiberglass and the green-gold color for the dry-cleaning pads.

### Internet Domain Names

Internet domain names are the names assigned to Internet sites for the purpose of uniquely identifying the sites and providing an intuitive way for potential visitors to locate them. (We discuss domain names separately in Chapter 2, "Trademarks, Domain Names, and the Internet.")

#### 'No' to Orange Flavor

Flavors, like odors and colors, can be federally registered as trademarks. The challenge is to demonstrate that flavor is identified with the source and is not functional. For example, the Trademark Trial and Appeals Board refused to permit federal registration of an orange flavor as a trademark for antidepressants. The Board stated that the orange flavor was functional and therefore incapable of serving as a trademark—it is a preferred flavor for orally administered pharmaceuticals. (*In re Organon N.V.*, 79 U.S.P.Q.2d 1639 (TTAB 2006).)

## What Is Trademark Law, and Why Do You Need to Know About It?

In the real world, once customers come to associate a mark with a particular business or product, would-be competitors frequently

copy some or all aspects of the mark—its sound, its appearance, its meaning—in an effort to lure customers away from the original business. Even a well-intentioned business owner may violate trademark laws by unwittingly picking a new business name, logo, or other type of trademark that conflicts in some way with a mark already in use somewhere in this large country of ours.

For these and other reasons, the U.S. marketplace is rife with trademark conflicts. It is the job of trademark law to sort out these conflicts in an equitable and consistent manner. It is this book's job to introduce you, the reader, to how trademark law works, so that you will know how to avoid legal trouble when deciding how to identify your business and products in the marketplace and what to do if, despite your best efforts, you end up in a trademark conflict anyway.

## Basic Principles of Trademark Law

Trademark law is the body of principles that the courts use to decide disputes regarding names or other devices being used to identify goods and services in the marketplace.

Trademark law comes from many sources: federal and state trademark statutes, federal and state statutes defining and prohibiting “unfair competition” between businesses, and federal and state cases interpreting these laws. (Unfair competition refers to the legal rulings and statutes that protect against unethical business practices.) The federal law that governs trademark rights and registration is known as the Lanham Act. Although there are subtle differences in all these sources of law dealing with how businesses use commercial identifiers, federal trademark statutes and cases govern most trademark disputes. (Later in this chapter, we provide more information on these sources of trademark law.)

Here, briefly, are some basic concepts of federal trademark law that you will need to understand before we go any farther (we provide more details as we go along):

- The first business to use a trademark in the marketplace owns it as against later users.

- To qualify as a trademark, a name, logo, or other device used by a business in its marketing activities must either: (1) be unique enough to earn customer recognition on its own (referred to in trademark law as inherent distinctiveness) or (2) have earned customer recognition through its continued use over time (known in the trade as “acquired distinctiveness” or “secondary meaning”).
- A trademark owner can sue in federal court to stop another business from using the same or similar trademark if the owner’s mark is famous or the use by the other business would cause potential customers to confuse one business or product with another.
- The more distinctive a trademark is, the easier it is for its owner to get the court to stop its use by others.
- The usual court remedy in trademark disputes is to order the loser to stop further use of the trademark in question. This can be painful, because business goodwill often is intimately connected with the business’s mark, and expensive because all of the items that carry the mark will have to be pulled from use.
- If the court finds that one business deliberately used a famous or distinctive mark belonging to another business, the offending business can be ordered to pay substantial money damages to the trademark owner.
- The court will usually find that a mark was deliberately copied if the mark was listed on the federal trademark Principal Register at the time it was copied.

Ideally, just knowing basic trademark principles should be enough to answer all your questions and get you started on the road to choosing a clever name for your business or product. But not so fast. The phrases “customer confusion” and “distinctive mark” need some definition. Unfortunately, Congress has avoided hard definitions and instead opted to let judges decide, on a case-by-case basis, whether a particular mark is famous or risks confusion by customers with an existing mark. Although we provide some guidelines in this book for you to use when you are

faced with interpreting these terms, the rock-bottom rules for dealing safely with the ambiguities in trademark law are these:

- Don't choose a business or product name that is the same as that used nationally by a large company. Even if you're in the right on some abstract level, the big company will most likely try to legally terrorize you into dropping the mark.
- Don't choose a trademark that is the same—in appearance, sound, or meaning—as a federally registered mark, unless the registered mark is used for a product or service that is definitely very different from the ones offered by your business.
- Don't try to piggyback your marketing efforts on a well-known trademark belonging to another business. For example, don't call your new Web design service “Jetscape.”
- Don't choose a domain name for your business that is the same as the trademark of an existing business; if you do, you may be accused of infringement (if you have similar products or services), dilution (if the existing business has a famous trademark), or cybersquatting (if you acquired the domain name in bad faith).

These rules are easy to understand. A fifth rule is not: Stay away from existing marks that resemble yours if there's a likelihood that customers would be confused by use of the two marks. Using the guidelines we lay out later in the book (see Chapter 3, “How to Choose a Good Name for Your Business, Product, or Service”), you should be able to select an appropriate name or to recognize when you need a professional opinion (see “When a Trademark Lawyer May Help,” just below).



#### SEE AN EXPERT

**When a trademark lawyer may help.** If any of these rules get in your way (you've got a hot name for your business and you want to run with it), a trademark lawyer can help you decide whether your situation is an exception to these rules and what you risk by going ahead with your proposed mark (see Chapter 14, “Help Beyond This Book,” for information on how to find a trademark lawyer).

## **Strong Marks Versus Weak Marks: What Trademark Law Protects**

Trademark protection is based on a “strength” classification system. Distinctive trademarks are strong and protectible. Trademarks that are not distinctive are considered weak and cannot be registered or protected unless the trademark owner creates consumer awareness.

Strong marks include coined words, such as Polaroid, arbitrary terms, such as Apple for computer products, or terms that have a suggestive quality without describing the goods or services, for example Roach Motel. These marks are all born strong and are so memorable or clever that they are classified as “inherently distinctive.”

Weak marks, such as Healthy Favorites, Beef & Brew, or Chap Stick, describe some quality, ingredient, or characteristic of the goods and services. Many businesses prefer to use weak trademarks because a descriptive mark provides information about the product to the consumer. For example, consumers know immediately that Food Fair is the name for a supermarket and Raisin Bran is the name for a cereal made with raisins and bran. A weak mark can acquire distinctiveness if, through extensive sales and advertising, the public becomes aware of the mark and associates it with a particular source.

In Chapter 3, the section “What Makes a Distinctive Trademark a Legally Strong Trademark?” revisits in more detail the subject of what makes an effective trademark. The question of what makes one mark strong and another mark weak often is the key to resolving trademark disputes and frequently must be understood to handle your own trademark issues.

## **Ownership of a Trademark: The First-to-Use Rule**

In the United States, the first business to use a trademark owns it.

### **Two Types of First Use**

There are two ways to qualify as a first user of a trademark:

- **actual use**—being the first to use the trademark on a product that is distributed in the marketplace or, in the case of a service mark, the first to use the mark in connection with advertising or marketing of a service available to the public, or
- **intent to use**—being the first to file an intent-to-use application with the U.S. Patent and Trademark Office provided that (1) the applicant files the application before the trademark is actually used by another party and (2) the applicant later puts the mark into actual use and completes the registration process by filing an additional form and paying an additional fee.

**EXAMPLE 1:** In 2008, Jonah begins publication of *Geezer Tennis*, a magazine for aging tennis players. In the year 2011, a business competitor sends Jonah a letter stating that Jonah is infringing its federally registered trademark Geezer Games. Jonah does a little investigating and learns that Geezer Games was first used as a mark in 2009, a full year after Jonah started using the mark. Jonah would be considered the owner of the Geezer mark and could in fact require Geezer Games to change its name, because the products of the two businesses compete and would therefore likely lead to customer confusion.

**EXAMPLE 2:** Assume now that in 2010, Geezer Games had applied for federal trademark registration on an intent-to-use basis, even though it hadn't actually put the mark in use commercially until 2011. If Jonah started actual use of the Geezer mark in March 2010, and Geezer Games filed its application for registration in April 2010, Jonah would still be considered the owner. However, if the application filing date preceded Jonah's actual use, Geezer Games would be the ultimate owner, once it put the mark into actual use.

What constitutes actual use and intended use is discussed in detail in Chapter 7, "Federal Trademark Registration."

## Two Different Businesses Can Own the Same Mark

It is possible for a mark to be “owned” by two or more separate businesses as long as no customer confusion is likely to result. If the underlying products or services of two businesses are quite different and don’t compete, then customer confusion is unlikely. Similarly, if the underlying products or services are distributed and marketed in different channels or parts of the country, then again there is little likelihood of customer confusion. For example, one U.S. district court ruled that the mark *Aisle Say* used for theater reviews could be owned by two different entities—one that published its reviews exclusively on the Internet and the other that published its reviews in print in the New York metropolitan area (*Albert v. Spencer*, 1998 U.S. Dist. LEXIS 12700 (S.D. N.Y. 1998).) But, as we pointed out earlier, the more famous or distinctive a mark is, the more likely it is that customer confusion will result (and the less likely it is there will be more than one owner).

## When Dual Users Come Into Conflict

What happens if a mark is owned by more than one business because of different geographical markets, and one of the businesses decides to move into the other business’s territory? Or suppose that dual ownership has been possible because one business used the mark on sportswear and another on lawn mowers, and both businesses decide to move into gardening clothes? In these situations, some rules kick in that help a court decide the respective rights of the owners. The rules revolve around such questions as:

- Did the second business to actually use the mark know of the first business’s previous use?
- Is the first user’s mark federally registered and, if so, did the second use begin before or after the registration?
- Is the second user’s mark federally registered?
- How broad were the first user’s marketing efforts when the second use began?

(Chapter 10, “Sorting Out Trademark Disputes,” deals with all these issues and tells you how the courts are likely to resolve them in specific fact situations.)

**CAUTION**

**The internet may render dual ownership obsolete.** As businesses use the Internet to market their goods and services, it will be harder and harder for two marks to coexist, since they will be sharing the same marketing channel, which happens to be national and even international. The risk of confusing customers who are using the Web to shop will be high. (Customer confusion is discussed in more detail in Chapters 6 and 10.)

## The Role of Customer Confusion in Trademark Law

As mentioned in the Introduction, virtually all trademark disputes that make it to court are resolved on the basis of the answer to this one simple question: Is simultaneous use of the marks likely to cause customer confusion? If there is no customer confusion, then the courts see no reason to intervene. (An exception to the customer confusion rule is sometimes made for famous marks, which, by law, are entitled to be free from other uses that would dilute their strength or tarnish their reputation for quality. See below for more on dilution.)

It's important to understand that two different marks can be confusingly similar for a number of reasons. Take, for example, the well-known mark Microsoft. Could a business avoid the likelihood of customer confusion by using a name that sounds the same as Microsoft but looks different, such as Mikkrowsought or Mike Crow Soft? Or that looks the same but sounds different, such as Macrosoft? Or that looks and sounds different but which means essentially the same thing, such as TinySoft? Or perhaps a fanciful arrangement of the words and letters, such as

MI  
CRO  
SOFT

The answer to all these questions is no. Why? A mark that is similar to another only in sound, appearance, or meaning is still similar and therefore likely to confuse potential customers. However, the weaker the original mark is, the less concerned the courts will be about possible

customer confusion and the more acceptable changes in appearance, sound, or meaning will be as a way to distinguish one ordinary mark from another.

Even if two marks are exactly the same, customer confusion will not be likely and infringement won't occur if the goods or services identified by the marks aren't related in some way. For instance, Delta Faucet and Delta Airlines can both use the Delta mark because customers just aren't likely to confuse one with the other. But clothing and items that are both sold in sporting goods stores may be considered related products—because they are marketed in the same channel—and therefore customer confusion could be found to result.

(Chapter 6, “How to Evaluate the Results of Your Trademark Search,” provides an explanation of what standards are used to measure customer confusion.)

## **Special Treatment for Famous Marks: The Dilution Doctrine**

In 1995, Congress passed the Federal Trademark Dilution Act (FTDA), a statute that gives the owners of certain famous marks protection against copycats even if there is no likelihood of customer confusion. This protection only applies if dilution of the famous mark's distinctive quality is shown. The act defines dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods or services.” Courts have extended this definition to include two factors:

- blurring of the famous mark (which means detracting from the mark's uniqueness), and
- tarnishment (which means negatively affecting the famous mark's reputation for quality).

In 2006, Congress enacted the Trademark Dilution Revision Act of 2006 which eliminated the need to demonstrate actual or likely confusion, competition, or actual economic injury when the owner of a famous mark seeks to stop dilution of a mark. The act also provided definitions for “famous,” “blurring,” and “tarnishment,” and it carved

out exceptions for activities such as parody and commentary. We provide more detail on the 2006 act in Chapter 10.

In addition to the FTDA, which has national application, about half of the states have their own dilution statutes that differ to a greater or lesser degree in how they define dilution. The main point you need to be aware of here is that famous marks may be protected against use by others even if consumers are not likely to be confused by the dual use. We explain dilution in more detail in Chapter 10.

## **How Trademark Law Protects Trademarks**

The trademark system is self-policing. If you don't do anything about your business name or other mark getting ripped off by a competitor, no one else will. And so, even though the law provides "protections," you will have to step forward and use what tools the law provides.

As a general rule, these tools are very limited. In some situations it is possible to resolve a dispute by filing an administrative petition or complaint with the PTO (see Chapter 7, "Federal Trademark Registration"), but the vast majority of trademark disputes that can't be settled by negotiations are resolved by filing a federal court lawsuit claiming trademark infringement or, in the case of a dispute between a mark and a domain name, by a federal lawsuit or an administrative arbitration.

Typically, an infringement lawsuit asks the court to immediately order a suspected infringer to stop using the mark in question and to award the business bringing the suit monetary damages for harm caused by the infringer. Once the judge rules on the request for immediate relief, the case is then typically settled. If the court grants the immediate relief requested by the plaintiff, the case usually is settled on terms favorable to the plaintiff. If the judge denies the relief, the defendant usually fares better. Few trademark cases make it all the way to trial and, consequently, few cases result in damage awards, although large amounts of money may change hands as part of the settlement.



## TIP

**Litigation can get expensive in a hurry, easily running into tens of thousands of dollars in legal fees.** The cost of litigation teaches one very important lesson when it comes to trademark disputes: Be flexible and don't get carried away by the right or wrong of the situation. Always treat the issue as a business decision—try to resolve it in the manner that will most benefit (and least harm) your business. Remember that negotiation is an option, and there are many ways to structure a settlement. Using a cease and desist letter if the law is on your side is a first step. (How to handle trademark disputes is covered in more detail in Chapters 11, “If Someone Infringes Your Mark,” and 12, “If Someone Claims that You Infringed a Trademark.”)

## The Role of Federal Registration in Protecting Trademarks

Trademarks can be registered with the PTO under a federal statute known as the Lanham Act. Trademarks are commonly registered with the PTO using one of two methods:

- The trademark owner files an application based upon use of the mark in commerce regulated by the federal government.
- The trademark owner files an application based on an intent to use the mark in commerce regulated by the federal government and subsequently uses it (known as an intent-to-use or ITU application).

In Chapter 7, “Federal Trademark Registration,” we tell you how to get the job done of registrations of business and product names.

Registration can increase a trademark owner's ability to win a lawsuit based on infringement of the registered mark and provide additional benefits as discussed below. Although registration increases protection, it's important to understand that in many cases it is possible for the owner of an unregistered trademark to stop someone from using a confusingly similar trademark. That's because, with the exception of ITU applications (discussed in Chapter 7, “Federal Trademark

Registration”), trademark rights are held by the party who first uses the mark in commerce, not who first files an application for registration with the PTO. In federal court, a holder of a registered trademark is presumed to own the mark, but this can be rebutted with proof of earlier use of the mark. Thus, registration provides a trademark user with the presumption of ownership, but not actual ownership, of the mark.

## **The Principal Register**

The PTO keeps two lists of all trademarks that it has decided to register—the Principal Register and the Supplemental Register. In addition to the trademarks themselves, these registers include the following information:

- the owners of the marks
- the dates the marks were registered
- the types of goods or services identified by the marks, and
- other potentially useful information, such as how the marks were described by their owners in the application process.

Of the two lists, the Principal Register is by far the more important. Placement on this list provides a trademark with the protection that makes it worthwhile to register the mark in the first place.

## **Qualifying for Placement on the Principal Register**

To be placed on the Principal Register:

- The mark must be in actual use in commerce involving two or more states or across territorial or international borders. Even if an application has been filed for registration based on intended use, the mark will not be registered until it is put into actual use.
- The mark must be sufficiently distinctive (inherently or acquired through use over time) to reasonably operate as a product or service identifier in the marketplace.
- The mark may not be confusingly similar to an existing mark in a context where the confusion of customers would be likely.

- The mark may not fit within one of the categories that Congress has deemed to be off limits for trademarks (such as using “U.S.” or the name of a living person without his or her consent).
- The mark may not consist primarily of a surname or a geographical name (unless the mark has become well known over time or the geographical term is clearly arbitrary but not deceptive).
- The mark may not consist of the title of a book, play, recording, or movie that is a single-issue artistic work (as opposed to a series or serial) unless the title has become well known over time.

### **Benefits of Registration on the Principal Register**

Registration on the Principal Register provides these protective benefits:

- exclusive nationwide ownership of the mark (except where the mark is already being used by prior users who may not have registered the mark)
- official notice to all would-be later users that the mark is unavailable
- the right to put an ® after the mark, which also puts users on notice that the mark has been registered
- the right to immunize the mark from certain challenges if the mark is kept in continuous use for five years after the registration date, and
- a legal presumption that the registrant is the owner of the mark (which means the registrant won’t have to prove ownership if a dispute over the mark ends up in court, although, as noted, the registrant may have to show prior use to rebut a contender’s claim of ownership based on first use).

Taken together, these benefits make it easier to win an infringement lawsuit and make it more likely that large damages can be collected for the infringement (which means there will be money to pay the attorneys and make it worthwhile to bring the lawsuit in the first place). (See Chapters 10 through 12 for more on infringement lawsuits.)

## The Supplemental Register

The Supplemental Register is an option for marks that aren't distinctive enough to qualify for placement on the Principal Register. This lack of distinctiveness means that the courts are unlikely to give the mark much protection in the event of a lawsuit.

As a general rule, placement of a mark on the Supplemental Register does not help much if a dispute over the mark ends up in court. However, anyone doing a standard trademark search to find out whether the same or a similar mark is available for their use will discover the registration and most likely will decide to choose another mark, just to be safe. Also, placement on the Supplemental Register entitles the mark's owner to use the ® that, to the public, signifies a registered trademark. And finally, if the mark continues in use and remains on the Supplemental Register for five years, it is easier to apply to have the mark placed on the Principal Register (because it has acquired distinctiveness through continued use over time). The bottom line is that the Supplemental Register provides some practical benefits and therefore provides a sensible alternative if placement on the Principal Register is denied because of the mark's lack of distinctiveness.

## State Trademark Registers

All states maintain separate trademark registers. The main function of these is to provide notice to would-be later users that a mark is already in use in a state. Unlike federal trademark registration, placement of a mark on most state registers confers few benefits other than an indication of when trademark rights in the mark were first claimed by the registrant. Because of the relative unimportance of state trademark registrations, we don't devote the space to explaining how to handle them. However, if you want more information on your state's trademark registration procedure and trademark laws, contact your state trademark registration office. You can also obtain more state trademark information at either Marksonline ([www.marksonline.com](http://www.marksonline.com)) or the All About Trademarks website ([www.ggmark.com](http://www.ggmark.com)).

## Not All Business Names Are Trademarks

The most common method adopted by a new business to identify itself in the marketplace is its name. For the purposes of trademark law, there are two main types of business names:

- the formal name of a business, called its trade name, and
- the name the business uses to market its products or services, alternatively referred to as a “trademark,” “service mark,” or just plain “mark.”

For most small businesses, this is a distinction without a difference. Almost all legal problems involving business names arise when a business name is used as a trademark—that is, used to build a customer base for the business—and not when the name is used as a trade name simply for billing, banking, and tax purposes.

The distinction between a trade name and a trademark can be a little confusing at first, because many businesses use at least a part of their trade name as the name they use to market their goods or services. For instance, every time a small business named something like Pete’s Graphic Designs, Elmwood Copymat, or Good Taste Organic Foods puts its name on a store sign, window display, or brochure, it is using its trade name as a trademark. On the other hand, large businesses often use different names for each type of subsidiary activity. For instance, Ford Motor Company puts its name on its cars but also uses a subsidiary mark for each type of car (for instance, Escort, Probe, and Thunderbird) and a different mark entirely for its auto parts division (Motorcraft).



## Corporate and Fictitious Names

A corporate name is simply the name of a corporation as registered at the time of incorporation. It must generally be approved by a state official, such as the secretary of state or corporations commissioner (the names vary from state to state), and followed by a corporate identifier, such as Inc. or Corp., as in Time, Inc., or Sony Corp. A corporate name is a trade name in that it identifies the corporation and not necessarily any product or service the corporation offers.

Another form of trade name is the fictitious business name, which is any assumed business name or alias. When a person or partnership does business under a name not its own (and this also applies to a corporation doing business under a name other than its corporate name), that person (or partnership) must usually file a fictitious business name statement with the county or state. For example, Laura Smiley uses a fictitious business name when she conducts her sole proprietorship business as Le Petite Cafe or Laura's Bookkeeping, but not if she operates under the name of Laura Smiley Enterprises. Similarly, if the partnership of Renauer, Randolph and Ihara operates the Reader's Corner Bookshop, it is using a fictitious business name.

## Trade Name Formalities

Almost all businesses are required to register their business names with a local or state agency charged with keeping track of business names. What agency this is usually depends on whether a business is a corporate entity or a sole proprietorship. Here we provide an overview of the steps you'll likely have to take to get your particular business name registered with the appropriate agency.

## Trade Name Registration Requirements

All names that identify business entities—corporate names; fictitious business names; assumed names; partnership names; the names of nonprofit, charitable, religious, and educational institutions; and the names of sole proprietorships—are trade names. With a few exceptions, every business is required by state law to take certain legal steps to list its trade name with a public agency. These vary somewhat depending on the form of the business—for instance, corporations must follow a different procedure than partnerships. Corporations usually must register with their state’s secretary of state or corporation commissioner’s office. Unincorporated businesses must usually register with an agency that keeps track of fictitious or assumed names.

In addition to providing a registry where members of the public can check on a business ownership, these name registration procedures are designed to screen out the use of identical or very similar names within the state or county where the business is based. However, as we will see, they don’t do a perfect job in accomplishing this. Rather than describe the specific requirements of all 50 states, we will explain generally the requirements for most of the states and give you enough information to easily find out the rest on your own.

### Corporate Name Registration

Corporations are creatures of state law. By a legal fiction, they are considered persons—artificial persons. When they are created, we say they are incorporated (literally translated, given a body).

This process involves filing articles of incorporation, paying a fee (and possibly an advance on corporate taxes), picking a board of directors, and, most important for our purposes, registering the corporate name with the secretary of state, state department of corporations, or corporations commissioner. Each state’s laws on this are a little different. Registering a corporate name involves three steps.

## Check Your Secretary of State's Website

Most corporate name registration agencies maintain websites on the Internet. A few states offer the opportunity to conduct your corporate name registration activities online and this is expected to increase, so make sure and check to see what services your state corporate name registration agency offers. You can find a listing of the website for each state's business name filing registry at [www.business.gov/register](http://www.business.gov/register).

### Step 1. Select a permissible name.

All but three states (Maine, Nevada, and Wyoming) require you to include a word or its abbreviation indicating corporate status, like "corporation," "incorporated," "company," or "limited." Several states also require that the name be in English or Roman characters. In addition, most states forbid including in your corporate name words that imply a purpose different from the one stated in the articles of incorporation or that mislead or deceive the public. For example, if you are forming a corporation that will help people fill out their medical insurance forms, you probably shouldn't call it Oil Drillers, Inc.

### Step 2. Clear your name.

Next, you will need to make sure that your corporate name is distinguishable from every corporate name already registered in your state. The reason is simple: Your state won't register a corporate name that too closely mimics a name already on file. To ease your task, the secretary of state or other corporate filing agency will do a search for you prior to authorizing the use of your name. In about half the states, you may phone to check on the availability of a name in advance. In the others, you must write to request a search. Often you may request a search of more than one name at a time. A corporation that is fairly confident that its name is unique may simply submit its articles of incorporation without a search and risk rejection if the name is already taken.

Generally, the state agency will compare your name with registered and reserved names of other corporations incorporated in your state and

with those incorporated elsewhere that have registered to do business in your state. How thorough the search is varies from state to state; each state's rules vary on how different your name must be from an existing name. In every state, however, if your name is found to be confusingly or deceptively similar to another name, you will have to change it so that it is distinguishable from the existing name. This is true even if the two corporations are in very different fields—unless the owner of the registered name gives written permission to use the similar name proposed for registration.

### **Step 3. Reserve your corporate name.**

A corporation can usually reserve a name prior to actual incorporation if the name otherwise qualifies for registration. This freezes out other would-be registrants of that name (or one deceptively similar) during the period of reservation, usually 60 to 120 days. Most, but not all, states permit you to extend the reservation for one or more additional periods for additional fees. Also, some states allow corporations to register their names without doing business in the state and even to renew those name registrations annually, which provides the equivalent of long-term name reservations for out-of-state corporations. Check with the secretary of state to discover more about these options if you wish to use them.



#### **CAUTION**

**Registering your corporate name with a state agency may give you far fewer legal rights than you think it does.** As discussed below, it does not necessarily give you the legal right to use that name to identify your products or services, only to identify the corporation.

### **Fictitious Business Name or Assumed Name Registration**

In all states, any person who uses a trade name other than his or her surname, and any organization that goes by a name other than the last names of the owners, must register the name with the state or county as a fictitious or assumed name.

This process, which is analogous to a corporate filing with the state, usually means paying a fee and filing with the county clerk a certificate that states who is doing business under that trade name. Many states also require a business owner to publish a statement, often called a DBA (doing business as), several times in a local newspaper. Such a statement allows creditors to find the people behind the business.

Not every type of business must file a fictitious business name—it varies with the state. In almost all states, fictitious business name laws apply principally to individuals (sole proprietorships) and general partnerships. Because corporations have their own regulations, fictitious business name laws do not apply to corporations, except in the fairly rare situation in which a corporation does business under a name different from its corporate name. In most states, fictitious business name laws also do not apply to limited partnerships because other laws govern their registration. In some states, the law also covers nonprofit organizations and corporations, including churches, labor unions, hospitals, and so on.

Contrary to the effect of registering a corporate name, registration of an assumed or fictitious business name does not necessarily prevent others from registering the same name. Because many states do not maintain a central register of fictitious business names, few states “clear” a fictitious business name by checking it against any other lists before registering it. As a result, several businesses might use the same trade name in the same state.

This means that if your state has no central fictitious name register, the only way to be sure that no one else in your state is using the name as a trade name is to check any proposed fictitious business name against the records of every county, not just your own. But, as we discuss below, whether someone else is using the same trade name as yours is of less practical importance than if they are using the same trademark or using the same trade name as a trademark as well. For this reason, we aren’t suggesting you check every county list if all you are concerned about is use of a trade name.

## The Legal Relationship Between Trade Names and Trademarks

As mentioned, people often think that once they have complied with all the registration requirements for their trade names, they have the right to use them for all purposes. Because this point is so important, let us again emphasize that this isn't so. As we have seen, there are two very different contexts in which a business's name may be used:

- the formal name of the business for purposes of bank accounts, creditors, and potential lawsuits (trade name)
- the name that the business uses to market its goods or services (trademark or service mark).

The registration requirements address the first context only. They don't address the second. That is, Backyard Fantasies, Inc., may be properly registered as a corporate or fictitious business name (trade name) but, because of the previous use of that name by someone else as a trademark, be legally unusable as the name the business puts on its signs, displays, advertising, and products (trademarks, service marks).

A trade name acts like a trademark when it is used in such a way that it creates a separate commercial impression or, put more directly, when it acts to identify a product or service. This can sometimes be a tricky determination, especially comparing trade names and service marks, because they often both appear in similar places—on letterheads, advertising copy, signs, and displays. But some general principles apply:

- If the trade name is used with its full name, address, and phone number, it's probably a trade name. For instance, consider "The Goodnight Meat Company." It appears with an address, and the eye scans it, registering it as information only. This impression is intensified if an obvious trademark that also belongs to the company ("Sunrise Sausage") is used alongside it. Sunrise Sausage serves as the identifier of goods, while the Goodnight Meat Company only identifies the company.
- If a shortened version of the trade name is used (for instance, "Goodnight Meats"), especially with a design or logo beside or incorporating it, the trade name becomes a mark. Large

companies, such as Consolidated Agriculture, often use a shortened version of their trade names (for instance, ConAgra) alongside marks for specific goods that they produce, including Swift Meats, Hunt-Wesson Oils, Peter Pan Peanut Butter, and Banquet Frozen Dinners. Used this way, the name ConAgra acts like a mark because it has a design surrounding it, and it is sufficiently different from the full corporate name, which is Consolidated Agriculture.

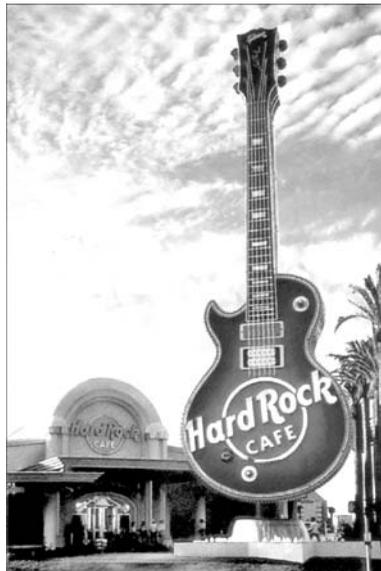
Simply put, if the name you have registered as a corporate or fictitious business name was already in use or federally registered as a trademark or service mark, you will have to limit your use of the corporate name to your checkbook and bank account. The minute you try to use the name in connection with marketing your goods or services, you risk infringing the existing trademark or service mark. (See Chapter 10 for more on infringement.) If your corporate name figures in your future marketing plans, you must search for use of the name as a trademark in addition to complying with the corporate name registration requirements. If you plan to market your goods or services on the Internet, then you'll also want to check to see whether your proposed name has already been taken as someone else's domain name, which would mean, at the least, that you'd have to use a slightly modified name (because every domain name is unique). (See Chapter 2, "Trademarks, Domain Names, and the Internet," for more about domain names.)

## Trade Dress and Product Designs

Trade dress refers to the total image of a product or service created with a combination of such features as size, shape, color or color combinations, texture, graphics, or even particular sales techniques. Product design, a subcategory of trade dress, refers to the shape and appearance of a product, for example, the appearance of a line of clothing or furniture.

To the extent that the decor of a business, the packaging of a product, or the shape of a product are distinctive and intended to operate as marks, these indicia will be treated as marks and can even be registered as

marks with the PTO. Visitors to a Hard Rock Cafe can identify various features that distinguish this chain of restaurants from competitors. In a liquor store, you can distinguish the bottles of Absolut vodka from those of its competitors. Most everyone can tell the difference between Kodak (yellow) and Fuji (green) film containers. Because each of these devices signals to customers that the product or service originates from a particular source, they are all examples of trade dress that qualify for trademark protection.



Basic legal principles that apply to trade dress are presented below and may be helpful, particularly in relation to the use of product and service names with trade dress elements.

## **Distinctiveness**

Whether or not a particular trade dress qualifies for protection as a trademark depends on several basic factors. First, is the trade dress distinctive?

## Inherent Distinctiveness

Some types of trade dress may be considered distinctive simply on the basis of the trade dress itself (inherent distinctiveness). For example, the U.S. Supreme Court found that a Mexican restaurant chain's decor could be considered inherently distinctive because, in addition to murals and brightly colored pottery, the chain also used a specific indoor and outdoor decor based upon neon-colored border stripes (primarily pink), distinctive outdoor umbrellas, and a novel buffet style of service. (*Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).) However, product designs such as the appearance of a line of children's clothing are not considered to be inherently distinctive and can only be protected if they acquire distinctiveness through sales or advertising. (*Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 120 S.Ct. 1339 (2000). See sidebar below, "*Wal-Mart v. Samara*: The Supreme Court Makes It Difficult to Protect Product Designs.") And speaking of trade dress (with the emphasis on the "dress" or lack of it), in 2009, the Trademark Trial and Appeals Board refused to register the cuffs and collar design mark used by Chippendale's exotic male dancers, finding that it was not inherently distinctive trade dress. (*In re Chippendales USA, Inc.*, 90 USPQ2d 1535 (TTAB 2009).)

## Acquired Distinctiveness (Secondary Meaning Rule)

Secondary meaning is a demonstration that the consuming public associates a mark with a single source, usually proved by advertising, promotion, and sales. If the trade dress is not inherently distinctive, distinctiveness can, with exceptions, still be acquired through extensive sales and advertising. A red star may not be inherently distinctive, but when it is used extensively in advertising for gasoline sales and automotive services ("Look For the Big Red Star") then it may have acquired secondary meaning.

Some types of trade dress—such as a single color or a product design—may never be considered inherently distinctive because customers would have no way of associating the trade dress with the

underlying products or services, or their source, without becoming familiar with them over time. For example, the use of a single color could not be inherently distinctive because consumers would not immediately associate a color with one product or company. In that case, the color sought to be protected must have acquired distinctiveness under the secondary meaning rule.

## **Trade Dress Can Be Registered With the PTO**

As a general matter, distinctive trade dress can be registered with the PTO and will receive extra protection as a result. However, as with trademarks generally, distinctive trade dress also qualifies for protection against copying even if it's not registered.

## **Likelihood of Confusion Is Required**

As with other types of trademarks, infringement of trade dress occurs only when there is a likelihood of customer confusion between the underlying goods or services, or their origins. Even when two different trade dress packages are similar in appearance, if customers have an easy way to tell one product or service from another, the courts have been reluctant to find that infringement has occurred. For example, a federal court found that there was no trade dress infringement in the case of two skin care products with similar lettering, colors, and graphic design. The court determined that the prominent use of each company's name on its own product would prevent consumers from being confused by the similar trade dress.

## **Functional Trade Dress Is Not Protected as a Trademark**

The trade dress feature for which you seek protection cannot have a functional purpose other than to distinguish the product or service in the marketplace. This may seem confusing, because all trade dress

features have at least some utilitarian function. For instance, packaging protects products against wear and tear, and a uniquely shaped bottle holds the bottle's contents. But if the design elements are not essential for the underlying product's purpose (for instance the curved shape of an Absolut or a Coca-Cola bottle isn't a necessary part of the product), then the trade dress is considered nonfunctional in a legal sense. On the other hand, the blue dot on Sylvania flashcubes was considered too functional to qualify for separate trademark status, because it served the utilitarian purpose of indicating when a bulb was used (when the blue dot turns black). Some examples of products that may have nonfunctional design features are furniture, automobiles, sweaters, and notebooks. If the design features of any of these items become well established as means of identifying their sources, and are nonfunctional, they may qualify as protectible trade dress.

### ***Wal-Mart v. Samara: The Supreme Court Makes It Difficult to Protect Product Designs***

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 120 S.Ct. 1339, 146 L.Ed. 2d 182 (2000), the Supreme Court ruled that product designs, like colors, are not inherently distinctive. Samara created a line of children's clothing that featured one-piece seersucker outfits decorated with appliques of hearts, flowers, and fruits. Wal-Mart asked another clothing company to copy Samara's designs and then sold the knock-offs at a lower price. Samara brought a federal lawsuit against Wal-Mart. The trial court ordered Wal-Mart to pay Samara \$1.6 million in damages, and the ruling was upheld on appeal. The Supreme Court overruled the appellate decision, stating that the Samara designs were not protected under trademark law because product designs were not inherently distinctive and Samara had not demonstrated secondary meaning. The result is that no matter how creative a designer makes a product's appearance or shape, it will only be protected under trademark law if the owner can demonstrate that the public associates that product design with a single source.

## If Your Product Design Is Both Functional and Novel

If your design is functional and novel, you should research whether it can be protected as a utility patent. For example, let's say you have created a unique method of packaging compact disk recordings. If it is functional and protected under trademark law, it may still be protectible under patent laws. For more information, review *Nolo's Patents for Beginners* (Nolo).

### Can Trade Dress Dilute a Famous Trademark?

As explained earlier in this chapter in the section, "Special Treatment for Famous Marks: The Dilution Doctrine," dilution occurs when a famous mark is tarnished or blurred by a similar mark. After the passage of the Trademark Revision Act of 2006, it's also possible to assert a claim of dilution based on unregistered trade dress. To do so under federal law the trade dress owner must prove, (1) the claimed trade dress, taken as a whole, is not functional and is famous; and (2) if the claimed trade dress includes any mark or marks registered on the Principal Register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

## Sources of Trademark Law

Three basic sources of law govern the use of trademarks:

- the federal Lanham Act
- state statutes governing trademarks, and
- the common law (based on court decisions, not statutes) of trademark and unfair competition.

The coverage of these laws overlaps frequently—in fact, an infringer may violate all of these at once. Below, we explain how to apply these sources of law for purposes of trademark registration and trademark-related disputes.

## The Federal Lanham Act

The federal statute known as the Lanham Act (17 U.S.C. §§ 1051 et seq.) provides for a system of registering trademarks. If your mark meets the requirements (see Chapter 7, “Federal Trademark Registration”), your application will be allowed and your trademark will be placed on the Principal Register.

In addition to providing for the registration of marks used “in commerce,” the Lanham Act includes a provision—17 U.S.C. § 1125(a), also known as 43(a)—that prohibits false advertising, trade libel, and trademark infringement for unregistered marks.

In 1996, Congress amended the Lanham Act to prohibit dilution of famous marks, an activity previously only prohibited by state laws. Dilution is the use of a famous mark in a way that would diminish the mark’s strength or tarnish its reputation for quality. (For more information on dilution, see Chapter 10.)

In 1999, Congress amended the Lanham Act to prevent cybersquatting, which it defined as registering, trafficking in, or using a domain name with the intent to profit—in bad faith—from the goodwill of a trademark belonging to someone else. Lawmakers were stepping in to end the practice of buying up domain names that were the exact name, or similar to the name, of an existing business with the intent of selling the names back to the business. (For more information on cybersquatting, see Chapter 10.)

In 2006, Congress enacted the Trademark Dilution Revision Act of 2006 which established dilution standards, clarified certain activities relating to dilution, and defined key dilution terms. We provide more detail on this act in Chapter 10.

## State Trademark and Unfair Competition Laws

States have four types of laws that deal with trademarks:

- A number of states have antidilution laws. Like the federal antidilution statute, these laws allow the owner of a well-known

mark to stop the use of a similar mark without having to establish the likelihood of customer confusion.

- All states have statutes providing for a trademark registration system.
- All states have statutes that govern trademark disputes.
- All states have statutes or bodies of court-developed common law that prohibits unfair competition.

State trademark statutes and the state rules against unfair competition usually dictate that the first to use a distinctive mark will have trademark precedence over a second user when the potential for customer confusion exists. State trademark rights apply on a statewide basis only.

State trademark registers are most useful when your mark is only used within your state. However, even if you plan to acquire a federal registration, it won't hurt to also register in your state. The fees are usually quite modest, and you never know when someone local who wants to use your mark will only search your state's trademark register. You can obtain state trademark registration application forms and other information about your state's trademark agency through the links provided at All About Trademarks ([www.ggmark.com](http://www.ggmark.com)).

## Common Law of Trademarks

Both state and federal courts have developed bodies of common law that cover trademarks. This law originated in judge-made decisions, but over the years, much of it has been placed in statutes (codified). In general, this court-made law applies to all trademarks, registered or not, and reflects the principles we set out in this chapter—that to be protected, a mark must be distinctive or must have developed secondary meaning. And for a legal conflict to exist, there must be a likelihood of customer confusion.

The common law is usually listed in the litany of claims when one trademark owner sues another. However, common law claims, by themselves, rarely provide the basis for modern trademark decisions—judges now make such decisions usually based on state or federal laws.

## The Difference Between Trademark and Copyright

The terms “trademark” and “copyright” are often used interchangeably by the general public. However, trademark and copyright protect different aspects of creative expression. Trademark protects expression that is used to identify and distinguish a product or service in the marketplace. Copyright protects all creative expression except for slogans, names, titles, and short phrases, the very things that are protected by trademark. Let’s take a closer look at what copyright does protect, because when it comes to logos, trade dress, and graphics used on Web pages, trademark and copyright may both apply.

Copyright provides writers, artists, photographers, musicians, software programmers, and other creators of expressive works the exclusive right to control how their works are used. But it is important to understand that only the expression itself is protected—not the ideas being expressed. For example, assume that Lloyd Sagal, a self-identified but unknown philosopher, writes a book exploring the religious implications of life on other planets. Under copyright law, other philosophers are free to use any or all of Lloyd’s ideas in their own books (and don’t even have to give him credit, although most would because of professional scruples). However, each of these other authors will have to do their own writing. They can’t just copy verbatim how Lloyd has expressed the ideas. (For a good explanation of the dichotomy between expression and ideas, see *The Copyright Handbook*, by Stephen Fishman (Nolo).)

A copyright attaches to a work of expression the instant the work takes a tangible form—for instance, on paper, tape, disk, CD, film, or canvas. It is common to give notice of the copyright by placing, next to the author’s name, a © and the year the work is published. The creator can optionally register the work with the U.S. Copyright Office to gain some additional protections. Whether registered or not, the copyright lasts for the life of the creator plus 70 years, with some exceptions.

Copyright covers the many types of creative expression, including: advertising copy, catalogs, directories, compilations of information,

fiction, interviews, lectures, speeches, leaflets, letters, magazines, newspapers, newsletters, periodicals, journals and other serial publications, nonfiction, plays, poetry, reference books and technical writings, screenplays, song lyrics, textbooks, music, art, graphic designs, motion pictures, sculptures, videos, websites, software of all types, architectural designs and blueprints, choreographic works, pantomimes, photographs, and slides.

Copyright law and trademark law commonly intersect in trademark logos, packaging, websites, and advertising copy. Trademark law protects the name of the product or service, any distinctive slogans used in the advertising or on a website, and distinctive features associated with the name or logo, such as its color or lettering style. Copyright law protects any additional literal expression that the ad or website contains, such as the text, artwork, music, or software. (For more information on the protection of trademarks in websites, see Chapter 2, “Trademarks, Domain Names, and the Internet.”)

## **The Difference Between Trademark and Patent**

By filing for and obtaining a patent from the PTO, an inventor is granted a monopoly on the use and commercial exploitation of the invention described in the patent for a limited time. There are several types of patents. The most common is what’s called a utility patent, which lasts for 20 years from the date the application is filed or at least 17 years from the date the patent issues. A utility patent protects the functional features of a machine, process, manufactured item, composition of matter, or new use for any such items. To qualify for a utility patent, an invention must be novel and surprising (nonobvious) to somebody who is familiar with the field of technology into which the invention falls. Although trademarks are used in conjunction with the sale of patented products or services, the types of protection offered by patent and trademark law is distinct with little, if any, overlap.

It is also possible to obtain a design patent on an innovative design of a manufactured item if the design serves an ornamental rather than a functional purpose. A design patent lasts for 14 years from the date it is issued. Because trademark protects a product shape that is intended to operate as a trademark rather than a functional part of the product, it is sometimes possible that a product design or shape can be protected under both patent and trademark law. For more information on patents and how to apply for them, see *Patent It Yourself*, by David Pressman (Nolo).

### **Book and Movie Names Can't Be Trademarked**

Can the name “Braveheart” be used by anyone, given its wide recognition as the title of a blockbuster Mel Gibson movie? As a general rule, the titles of books and movies, as used only on the book or movie, are not considered trademarks, because each title is unique to that particular item and not an indicator of the product’s source or a means to distinguish it from competitors. If a movie or book title is used as part of a series—for example, *The Matrix*—or if the title develops secondary meaning because of ancillary product sales—for example, *The Lion King*—then the title will be protected under trademark law.



# Trademark, Domain Names, and the Internet

<b>How to Clear and Register Domain Names .....</b>	<b>54</b>
Check Domain Name Availability .....	55
Check Domain Name Ownership.....	55
Register the Domain Name.....	57
Now That You Own a Domain Name ... ..	58
<b>What to Do If the Domain Name You Want Is Already Registered.....</b>	<b>59</b>
Choose a New Name .....	60
Buy or Share the Domain Name.....	60
Fight for the Name.....	61
<b>Domain Names and Trademarks.....</b>	<b>63</b>
Domain Name Registration Does Not Guarantee Trademark Rights.....	63
Trademark Owners Can Sue Over Your Domain Name Use.....	64
<b>Other Trademark Issues in Cyberspace .....</b>	<b>64</b>

**D**omain names have various functions. One can serve as an address (whitehouse.gov), as a trademark (amazon.com), or as an expression of free speech (governmentsucks.com). Unlike a trademark, a domain name is awarded to the first person to pay for it. That's why, for many businesses on the Web, acquiring the right domain name is more important than whether the name qualifies as a trademark. In this chapter, we'll explain how to acquire a domain name, and we'll discuss the relationship between your business, domain names, trademarks, and the Internet.



#### RELATED TOPIC

**Domain name disputes.** Disputes occasionally arise between domain name owners and trademark owners on the Internet. For information on these cyber disputes and how they are resolved, review Chapter 10, "Sorting Out Trademark Disputes."



#### RELATED TOPIC

**Registering a domain name as a trademark.** For information on registering a domain name as a trademark, see Chapter 7, "Federal Trademark Registration."

## How to Clear and Register Domain Names

A domain name is the unique Internet "address" that directs your computer to a website on the Internet. For example, typing in [www.nolo.com](http://www.nolo.com) takes you to the website for the publisher of this book. Most companies want domain names that are the same as or similar to their business or product names, for example, [fedex.com](http://fedex.com), [pbs.org](http://pbs.org), or [staples.com](http://staples.com).

Since domain names, unlike trademarks, are granted on a first-pay, first-serve basis, many businesses have been surprised to find that the domain names they want have already been purchased, either by those with a legitimate intention to use them, or by speculators who hopes to

make money selling them. How crowded is the world of domain names? One survey found that of 25,500 standard English words found in a dictionary, 90% had already been purchased as domain names. As this edition went to press, there were over 85 million active domain names, over two-thirds of which were for .com domains. Even more amazing, over 311 million domains are categorized as deleted which means that they were once registered but are no longer active. In other words, approximately 400 million domain names have existed since the Internet was popularized.

## Check Domain Name Availability

How do you find out if the domain name you want is already taken? The easiest way is to check availability at one of the dozens of online companies that have been approved to register domain names. You can access a listing of these registrars at either the InterNIC site ([www.internic.net](http://www.internic.net)) or at the ICANN site ([www.icann.org](http://www.icann.org)). ICANN is the organization that oversees the process of approving domain name registrars. Every registrar provides a searching system to determine if a domain name is available. Type in your domain name choice, and the registrar will tell you if it is available.

**EXAMPLE:** We accessed [www.internic.net](http://www.internic.net), clicked on “Search Accredited Registrar Directory,” and selected Register.com from the list. We typed in our choice for domain name, “goodgrammar.com,” and were informed that the domain name had been taken and was not available for registration.

## Check Domain Name Ownership

In addition to determining whether a domain name is available, you may want to locate information about the owner of the domain name. For example, if a domain name is taken, you may want to locate the owner to discuss acquiring, sharing, or disputing ownership of the name. You can check the WHOIS records (a database of domain name

information) at Network Solutions ([www.networksolutions.com/whois](http://www.networksolutions.com/whois)) or at [www.whois.net](http://www.whois.net). When you type in the domain, the site will provide registrant name or contact information.

**EXAMPLE:** We accessed the Network Solutions site ([www.networksolutions.com/whois](http://www.networksolutions.com/whois)), and typed in “nytimes.com.” Network Solutions reported that the site was owned by New York Times Digital and provided contact information that included a phone number for the registrant.

Beware that some registrants, especially those acting in bad faith, may supply false information about domain name ownership and, in these cases, there’s not much you can do to track down the domain name holder. Don’t let this stop you if you believe you are dealing with someone who is holding a domain name for ransom. As we explain in Chapter 10, “Sorting Out Trademark Disputes,” there are ways to wrestle a domain name from a bad-faith registrant even if you don’t know the identity of the registrant or where the registrant is located.

Keep in mind that if you have a federally registered trademark, someone else may still have the right to own the domain name. Many different companies can own the same trademark for different services and products, but only one company can obtain the domain name. For example, yours may be one of many different companies that have federally registered the trademark Executive for goods or services. Each of these companies may want [www.executive.com](http://www.executive.com), but the first one to purchase it—in this case, Executive Software—is the one that acquires the domain name.

## The Click-Through That Changed the Web

In 2003, Google began offering AdSense, a service that allowed any website to generate revenue through placement of targeted ads adjacent to website content.

For example, if you had an article about grammar at your website, the Google AdSense program would analyze the text in the article, realize it was about grammar, and deliver ads that were appropriate and relevant to the subject matter. An ad generates revenue to the website owner if a visitor to the website clicks on it (referred to as click-through revenue).

This innovation dramatically changed the way people perceived and used domain names. Previously, a website owner had to create a site and seek out and attract advertisers, usually cheesy banner advertisers that were not targeted to the website's visitors.

Now, anyone with a domain name (or a blog or any Web page) can generate targeted advertising revenue instantly through Google AdSense (or through one of Google's competitors).

You'll also see, when we discuss domain name disputes in Chapter 10, how click-through advertising has created a new type of cybersquatter, one who started earning advertising money immediately upon creating a Web page. Later in this chapter, we discuss keywords and how they are sometimes used to deceive consumers using search engines (see "The Controversy Over Keywords").

## Register the Domain Name

If the domain name you have chosen is available, you should consider acquiring it. But before you do so, you need to be sure that nobody else is using it as a trademark for similar goods and services. If another business is selling similar goods or services with a similar name, your use of the domain name can be terminated.

**EXAMPLE:** Bob registers the domain name ahab.com to sell artwork depicting whales. Jim has a catalog company, Ahab, that has been selling ocean-themed artwork and merchandise since 1990. Jim has registered the Ahab trademark with the PTO and can stop Bob's use of the domain name ahab.com.

If Bob had registered the domain name with the intention of selling fishing gear, his use of ahab.com would not infringe Jim's trademark, and he could proceed as shown by our discussion of the mark, Executive, above.

To check whether your choice of a domain name is being used as a trademark, review Chapter 5, "How to Do Your Own Trademark Search." Keep in mind, you only need to be concerned about using someone else's trademark if the trademark is famous (such as Wal-Mart or McDonald's) or if your company is selling or likely to sell similar goods or services.

Once you are confident that the domain name won't conflict with another's trademark for similar goods or services, you should register the domain name. Access any of the domain name registrars approved at either InterNIC ([www.internic.net](http://www.internic.net)) or ICANN ([www.icann.org](http://www.icann.org)) and complete the online form indicating basic contact information (name, telephone number, and address). The fee is usually \$25 (or less) per year, and you can pay online by credit card. The whole procedure takes a matter of minutes, and you are notified by email of your domain name ownership, which is effective immediately.

## **Now That You Own a Domain Name ...**

When you pay the annual fee for a domain name, all you acquire is an address on the Internet. To use it with your business, you must establish a Web hosting arrangement with an ISP (Internet service provider), usually for a fee of approximately \$20 or less per month. You must also construct and upload a website and coordinate the reassignment of the domain name from the domain name registrar (the company that sold you the domain name) to the ISP.

Domain name registration grants you exclusive title, and no one else can stop you from using it, with the following exceptions:

- **You fail to pay annual domain name fees.** Domain name ownership, unlike trademark ownership, must be renewed annually (or, in some cases, every two years). If you fail to pay the renewal fees, your domain name will be terminated and could be sold to another buyer.
- **You are a cybersquatter.** If you registered a domain name in bad faith—for example, for the purpose of selling it back to a company with a similar name, your domain name can be taken away from you under federal law or under international arbitration rules for domain name owners. (The standards and procedures for these domain name disputes are discussed in Chapter 10, “Sorting Out Trademark Disputes.”)
- **You are an infringer.** If your domain name is likely to confuse customers because it is similar to another trademark, you may have to stop such use. For example, if you registered `adoobie.com` for the purposes of selling software, it’s likely that the Adobe company, makers of graphics software, could sue successfully to stop your use.
- **You are a diluter.** If your domain name dilutes the power of a famous trademark, the owner of the famous mark can sue you under federal laws to stop your continued use. Dilution refers to the fact that your domain name is being used for commercial purposes, and it blurs or tarnishes the reputation of a famous trademark. For example, if you registered `guccigoo.com` for the purpose of selling baby clothes, the owners of the Gucci trademark could probably stop you from using the domain name. (The standards and procedures for these dilution disputes are discussed in Chapter 10, “Sorting Out Trademark Disputes.”)

## What to Do If the Domain Name You Want Is Already Registered

There are two reasons someone registers a domain name: The registrant may be using or have a good-faith intention to use the domain name;

or the registrant may have invested in the registration in the hopes of selling it.

Usually, it's easy to determine whether the domain name is for use or sale. Type the domain name into your Web browser. If a functioning website appears that bears some relationship to the domain name, the registrant is probably using the domain name in good faith. If a site comes up that says "This domain name is for sale" or something similar, then the name is for sale by the registrant. If a Web page appears that states, "Site is Currently Under Construction" or something similar, then the registrant's intentions are unclear, since many cybersquatters use this designation, as well as legitimate domain name owners who have not yet constructed a website. In these "under construction" cases, you should contact the person listed as the registrant.

## Choose a New Name

If the domain name you want is already registered, the easiest solution is to choose another domain name that's available. Many domain name companies will suggest alternatives if your domain name is taken. For example, a registrar informed us that "goodgrammar.com" was taken and suggested available alternatives such as:

- goodgrammar.info
- goodgrammar.org
- goodgrammar.biz, and
- grammaronline.tv.

## Buy or Share the Domain Name

If you have sufficient funds, you can try to buy the domain name rights from someone who acquired the domain name in good faith. For example, altavista.com was being used in good faith by a company with trademark rights to the term "alta vista." Compaq, the computer company, wanted to use the domain name for its Alta Vista search engine and was willing to pay \$3.3 million for the domain name.

Many people buy domain names through brokering services such as Great Domains.com ([www.greatdomains.com](http://www.greatdomains.com)), Afternic.com ([www.afternic.com](http://www.afternic.com)) and buydomains.com ([www.buydomains.com](http://www.buydomains.com)). Of course, as you can expect, the price of domains is much higher than purchasing through a domain name registrar. (For example, at BuyDomains, the domain name [digitalconsultgroup.com](http://digitalconsultgroup.com) was being offered for \$59,888; [digitalartsgroup.com](http://digitalartsgroup.com) had a lower price tag of \$2,488). In other cases, the domain holder may sell directly (some websites even have “for sale” signs on the web pages). Many domain names may have difficulty achieving protection under trademark law because they are highly descriptive of the services—for example [drugs.com](http://drugs.com), [loans.com](http://loans.com), or [cinema.com](http://cinema.com)—and this generic quality can prevent a term from acquiring trademark protection.

However, many Internet companies are prepared to sacrifice some trademark rights for an easy-to-remember domain name such as [forsalebyowner.com](http://forsalebyowner.com).

In rare cases, a company may agree to share the domain name. For example, if two companies in different states operate under the name First Washington Bank, they can share the domain name [firstwashingtonbank.com](http://firstwashingtonbank.com). An opening page at the website would allow a viewer to click on either bank to access its services.

## Fight for the Name

A registrant who has taken a domain name based upon your trademark primarily for the purposes of selling it to you is a cybersquatter and is violating the Lanham Act’s anticybersquatting provisions. You can pursue the cybersquatter in federal court or you can arbitrate against the cybersquatter (a less-expensive alternative) using procedures created by ICANN ([www.icann.org](http://www.icann.org)). (For an explanation of anticybersquatting rules, see Chapter 10.) You are also free to buy the domain name from a cybersquatter if you choose. There is nothing illegal with buying a domain name from someone who is unofficially blackmailing you. Many cybersquatters are aware that the cost for fighting a domain dispute averages between \$1,500 and \$3,000 and price the domain name accordingly.

## Should You Use .Net or .Org?

As you are probably aware, every domain name consists of two parts. The .com portion is termed a top-level domain name (TLD) while the section with the business name is termed a second-level domain name (SLD). The reason the .com part is called a top-level domain is that the Internet is organized into several broad categories including:

- com (for commercial groups)
- edu (for educational institutions)
- gov (for governmental institutions)
- org (for nonprofit organizations)
- net (for interactive discussion groups)
- biz (for use by businesses)
- info (for sites that offer information)
- jobs (reserved for human resource managers)
- tel (reserved for businesses and individuals to publish their contact data)
- travel (reserved for entities whose primary area of activity is the travel industry)
- name (for those maintaining personal name websites)
- aero (for the air transport industry)
- coop (for cooperative organizations)
- museum (for museum websites), and
- pro (for accountants, lawyers, physicians, and other professionals).

In addition, the .mil domain is reserved exclusively for the United States military, and the .int domain is used only for registering organizations established by international treaties between governments.

The .com extension is by far the most popular, primarily because it is the default extension when you are guessing at a company's domain name. The increasing success of Google AdSense and similar ad programs (see "The Click-Through That Changed the Web") has also inspired some companies to buy .org, .info, .biz and .net extensions as a defensive measure.

Some 30 additional top-level domain names known as national top levels, are available for countries and some states. For example, sony.be is the Web address for the Sony Company in Belgium. For a list of all of the foreign TLDs and their registrars, access the database at [www.iana.org](http://www.iana.org).

## Domain Names and Trademarks

The legal relationship between trademarks and domain names has not been completely sorted out. A few more years of lawsuits and new laws will probably make it clearer. Two things are certain:

- Registration of a domain name does not automatically grant trademark rights
- You can be sued by a trademark owner if your domain name is likely to dilute a famous trademark or to confuse customers.

### Domain Name Registration Does Not Guarantee Trademark Rights

Domain name registration, by itself, does not permit you to stop another business from using the name for its business or product. For example, if you acquire the domain name `greatgrammar.com`, that does not mean you can stop others from using Great Grammar for services or products online or off. It only means that you have the right to use that specific Internet address. Your domain name will function as a trademark only if you use in connection with the sale of goods or services, and customers associate the name with your business. When that happens, you can stop others from using a similar name so long as those others weren't using the term in the marketplace before you.

Consider `Amazon.com`, a domain name that functions as a trademark because customers associate the name with a certain company and its services. `Amazon.com` achieved trademark status because the company was the first to use this distinctive name for online retail sales, and the name has been promoted to customers through advertising and sales. If another company sold books online or offline under the name Amazon, the owners of `Amazon.com` could sue under trademark law to stop the use.

In short, to be protectible as a trademark, your domain name must meet the standards described in Chapter 1: The name must be distinctive or must achieve distinction through customer awareness, and you must be the first to use the name in connection with your type of services or products.

## Trademark Owners Can Sue Over Your Domain Name Use

You could run into a problem if your domain name legally conflicts with an existing trademark. For example, if you launched a website with the domain name Xon.com to sell automobile accessories, you might be asked to stop using the name by the owners of the Exxon trademark because Exxon has the right to stop look-alike and sound-alike business names that are likely to confuse customers of a wide range of auto products.

Whether your domain name would legally conflict with an existing trademark depends on (1) which was first put into actual use, (2) whether use of the domain name would confuse customers regarding the existing mark, or (3) whether the existing mark is famous. The legal standards used in these conflicts are no different than in other trademark disputes. (In Chapter 10, “Sorting Out Trademark Disputes,” we provide more detail on how these disputes are resolved.)

## Other Trademark Issues in Cyberspace

If you are establishing a website for your business, there are other trademark concerns besides domain names. Be careful about misusing other company’s trademarks within your links, programming code, or content. Deceptive and misleading uses can open the door to angry letters, lawyers, and lawsuits. The law on many of these issues has not been resolved. For current information on trademarks and websites, we recommend you consult the [Internet Law](#) section of the Nolo encyclopedia ([www.nolo.com](http://www.nolo.com)). Below we provide a summary of common website issues.

As a general rule, word links—where text such as the word Nike is used to link to another site—are not likely to create trademark problems. Graphic links—where a graphic trademark logo such as the Nike swoosh is used—may raise trademark issues. To minimize liability

for any trademark activities that occur when a visitor is taken to a linked website, you may want to include a prominent linking disclaimer.

### Sample Linking Disclaimer

By providing links to other sites, [*name of your website*] does not guarantee, approve, or endorse the information or products available at those sites, nor does a link indicate any association with or endorsement by the linked site to [*name of your website*].

In addition, we recommend that you do not use another company's trademark to misdirect customers to your website. This is commonly done by means of metadata and metatags—programming code used in the creation of a website. Even though an Internet user never sees this code, it's been the subject of trademark lawsuits because companies have used it to divert or confuse customers. We recommend avoiding the use of any other company's trademarks in your programming code because it can be easily uncovered, and many well-known trademark owners regularly troll the Internet searching for such violations.

You *are* permitted to use another company's trademark in your website if you are commenting upon or criticizing the other company. For example, if you have an Internet newsletter and write an article critical of Microsoft, you can use the Microsoft logo. Keep in mind that your right of free speech doesn't prevent a trademark owner from hassling you with a lawsuit. The economics of litigation often silence critics despite their free speech rights. Two factors may convert such commentary and criticism into a lawsuit based on trademark infringement or dilution: Your website is offering goods and services as part of its criticism, or your website is likely to confuse users as to its sponsorship.

## The Controversy Over Keywords

Most people find their Web destinations via search engines, which have two types of listings: relevant and sponsored. Relevant listings are the primary search results that appear on the search page. Relevance (the order in which results are listed) is determined by the search engine algorithm, a mathematical formula that uses factors such as the content in a site, its domain name, material in its header (the headline that appears in the bar on top of your browser), information in its metatags (information buried in the website code), and the number of sites that are linked to it.

Sponsored links usually appear at the top and in the right margin of the Web page. You can become a sponsored link by purchasing (or bidding on) keywords at a search company. For example, at Google.com, you can click on the “Advertising Programs” link and buy keywords (Google calls them “Adwords”) for a small setup fee (approximately \$5). Keywords are the terms that people type into the search engine. For example, if you had purchased the words “crochet” and “baby,” then your ad would pop up when a user searched for crocheted baby hats.

An issue has arisen when a company buys a keyword that is a competitor’s trademark. For example, several companies have purchased the keyword “Nolo” (the trademark for the publisher of this book). When a person types “Nolo” into their search engine, the competing business appears as a sponsored link. Does that use infringe Nolo’s trademark rights?

Probably not. In December 2004, a Virginia federal court, in a case involving the Geico Insurance trademark, ruled that selling the Geico trademark as a keyword search term doesn’t qualify as trademark infringement under current law.

In 2004, Google was sued by the American Blind and Wallpaper over Google’s sale of keywords such as “American Blind” and “American Wallpaper.” In 2005, the Ninth Circuit Court of Appeal ruled that American Blind could proceed with its trademark case against Google. Google argued that the trademarks at issue—American Wallpaper and American Blind—were merely descriptive, and on that basis, the sales of keywords cannot infringe. For example, consumers may be looking for window blinds made in America (or the American Foundation for the Blind). A district court

### The Controversy Over Keywords (continued)

disagreed with Google in 2005 and ruled in favor of American Blinds. Google eventually settled with American Blinds.

In a 2006 case, Mediaplan bought search engine ads for the trademark keyword “Zocor” and then used those ads to sell generic versions of drugs from Canada. The Second Circuit held that the purchase of ads based on Zocor was not an infringing “use” of the mark. (*Merck & Co. v. Mediaplan Health Consulting, Inc.*, 425 F.Supp.2d 402 (S.D.N.Y. 2006).) In another case Google was found not to have infringed the trademark Rescuecom by selling it as a keyword to Rescuecom competitors. (*Rescuecom Corp. v. Google, Inc.* (10/8/2006).) That decision was reversed by the Second Circuit which held that the sale of Google keywords *may* constitute infringement. (*Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123 (2d Cir. 2009).) Despite winning a reversal, Rescuecom eventually dropped the lawsuit. In summary, there is no clear court statement that Google’s practices in the United States constitute infringement.

In still another case, a typosquatter purchased domain names such as Inadsend.com and landswnd.com and then, after sending the customer to the legitimate Lands’ End website, charged Lands’ End, claiming that these were referrals under the Lands’ End referral program (for which the typosquatter belonged under another, legitimate domain). Lands’ End filed suit and the defendant’s attempt to dismiss the suit was rejected. (*Lands’ End, Inc. v. Remy*, 447 F.Supp.2d 941, 2006 WL 2521321 (W.D. Wis., September 1, 2006).)

The rules are unclear outside the United States. A French court, in a case involving the Louis Vuitton trademark, has ruled that the practice of purchasing another company’s trademark as a keyword is illegal.





# How to Choose a Good Name for Your Business, Product, or Service

<b>Anatomy of a Product or Service Name Trademark</b> .....	72
A Name Is Not a Trademark If It's the Generic Term for the Underlying Products or Services Offered by the Business.....	72
A Trademark Can Include Generic Terms .....	72
<b>Distinctive Names Make Legally Strong Trademarks</b> .....	73
<b>How Trademark Law Treats Marks With Common Terms</b> .....	74
Most Ordinary Words Are Not Protected .....	74
Even Undistinctive Marks May Be Entitled to Protection Once They Become Widely Recognized as Marks .....	75
<b>What Makes a Distinctive Trademark a Legally Strong Trademark?</b> .....	77
<b>Guidelines for Making a Mark Distinctive</b> .....	78
Marks Using Coined Terms—Such as Kodak, Exxon, and Rackafrax—And Terms Made Up of Parts of Different Words, Such as Unisys.....	79
Marks That Suggest but Don't Outright Describe the Product or Service, or Some Aspect of It (Such as Obsession Perfume, Sharp's Nonalcoholic Beer, Intuit Software) .....	80
Marks That Use Fanciful Terms in the Context of Their Use (Such as Bugle Boy Clothes, Double Rainbow Ice Cream, Yahoo! Internet Services, and Penguin Books).....	81
Marks That Use Arbitrary Terms in the Context of Their Use .....	81
Common Terms in Uncommon Arrangements.....	82
Ordinary Terms Combined With Novel Designs .....	82
Names to Avoid .....	83
<b>Marketing Considerations When Choosing a Name Mark</b> .....	88
General Advice.....	88
How to Come Up With a Good Name .....	89

Useful Concepts in Creating a Name Mark for Your Product or Service.....	90
Using a Professional Name Consultant .....	92

Now that you have absorbed some trademark basics in Chapter 1 and learned about the relationship between trademarks and domain names in Chapter 2, it's time to set about choosing a trademark for your business or its services and products. Because most developed trademark principles apply to names rather than other types of business and product identifiers, we focus on names in this chapter.

The goal of this chapter is to help you choose a name that will:

- do a good job of identifying your products and services in the marketplace, and
- have enough legal strength to give you the exclusive right to use it.

Not all readers will care about these goals. For instance, the name Rob's Pastry Center may be just the ticket for the bakery Rob Johnson plans to open, but the name certainly won't leap out and grab the average consumer's attention. Nor would the law give such a name much protection, because of its ordinary and descriptive nature. Nevertheless, Rob likes the name, and so he should use it despite what the lawyers say.

What follows, then, is the type of information you'll need if you do agree with our goals or at least want more information before you decide whether to pursue them.

Much of the information in this chapter is taken to greater depths in Chapter 9, "Evaluating Trademark Strength." Chapter 9 is intended for people who need to evaluate the legal strength of their marks in the context of conflicts between marks that trademark searches turn up or when real-world trademark disputes arise. This chapter, on the other hand, is intended as a brief introduction to the difference between strong and weak trademarks in the context of choosing a mark for a business or product. If you want to read everything this book has to offer on what separates legally strong marks (the ones the courts will fully protect) from legally weak ones, read both chapters.

## **Anatomy of a Product or Service Name Trademark**

It's always important to distinguish between the name you choose for your products or services and the name of the underlying class of goods or services. You can protect the former but not the latter. Here are some basic principles.

### **A Name Is Not a Trademark If It's the Generic Term for the Underlying Products or Services Offered by the Business**

As we have mentioned, for a name or other symbol to qualify as a mark, it must be unique enough to distinguish the underlying product or service from others in the marketplace. Sometimes, however, a mark chosen for a product or service is very close or identical to the generic name for the underlying type of product or service. For example, assume that a business names its new soft drink product Diet Cola. As it turns out, "diet cola" describes a group of carbonated soft drinks with cola flavoring and some form of sugar substitute. That fact makes the would-be Diet Cola mark generic and not a trademark at all, because it could refer to any of several brands of the underlying diet cola product. *Shasta*, however, qualifies as a trademark for diet cola because it specifies one particular brand of the several diet colas available on the market. Other examples of generic terms are lite beer, super glue, softsoap, matchbox cars, and supermarket.

In summary, the PTO will not register, and courts will not provide, protection for a mark that is essentially the generic name for an underlying product or service.

### **A Trademark Can Include Generic Terms**

Sometimes, a trademark includes a generic identifier of the goods or services. For example, Wildside Pet Shop has two elements: the term

Wildside that distinguishes this from other competing businesses, and the generic term pet shop that describes the class of services. Although the full name of the business can be protected as a trademark, the term describing the class of services (pet shop) will never be separately protectible. The applicant for registration must disclaim the separate use of the generic term. That way anyone is free to use the words “pet shop” as long as they are in combination with terms other than the term “wildside.”

## Distinctive Names Make Legally Strong Trademarks

As we stress throughout the book, the more unique a business, product, or service name is, the easier it is to protect the name from use by others. Because distinctive names make legally strong trademarks, it behooves you to choose a unique name. A product or service name can be unique for a number of reasons, including:

- The name may be coined (made up), as in Exxon petroleum products.
- The combination of words and letters in the name may be so creative that no one else has come up with it, as in Trader Joe’s food market chain.
- The name may carry a clever double meaning, as in Pea in a Pod maternity stores.
- The name may have a clever appearance, as in Toys ЯUs (with a backward facing “R”).
- Certain words in the name may be completely arbitrary in the context and therefore highly original, as in Diesel, a Bookstore.

Whatever the reason, a unique name is by nature considered to be a distinctive name, and a distinctive name is by law entitled to protection as a trademark. We explain how to make your mark distinctive later in this chapter.

## How Trademark Law Treats Marks With Common Terms

If unique trademarks are deserving of the most protection, then common or ordinary trademarks are entitled to little or no protection. But when deciding whether a trademark is legally strong or legally weak, you have to look to the whole mark. For example, many marks that the law will protect are completely made up of ordinary words. Consider the example of Pea in a Pod as a name for a maternity store. There is nothing terribly unusual about any of the words, but the phrase is clever—because of its double-meaning suggestiveness of a uterus (the pod) and an embryo (the pea)—and would definitely qualify as a distinctive mark.

Though this subject is taken up in detail in Chapter 9, the basic rules that apply to marks containing ordinary terms are these:

- If the overall mark is distinctive, it will be protected no matter how many ordinary terms are used.
- The owner of a trademark using ordinary terms cannot claim ownership to the terms themselves, but only to the overall mark.
- If the ordinary terms in a mark do not create a distinctive or clever whole, the mark will not be given protection unless (a) the terms are distinctive in the context of the product or service (for instance the ordinary word “apple” becomes distinctive in the context of computers) or (b) over time, consumers come to associate the mark with the underlying product or service, as in Best Buy (retail electronic products).

Let’s examine these rules in a little more detail.

### Most Ordinary Words Are Not Protected

So far, you should know that on a protection scale of one to ten, generic terms rate a zero while distinctive marks are near the ten end. Now let’s lump all the rest of the terms that businesses frequently like to use as names of services or products into a category we will call “ordinary names.”

Into this category are consigned all the sorts of words that aren't usually distinctive by themselves but that aren't generic either:

- place names (Downtown Barber)
- personal names (Harris Sales, Rubin's Assembly Service)
- words that describe a product or service (Slim-Fast Diet Food), and
- laudatory words or words of praise (Tip-Top Pet Shop).

Misspellings or alternative spellings (like "lite" for "light") cannot make an ordinary term distinctive. Nor do common foreign language equivalents, like "le" for "the" and "casa" for "house."

Because marks that use ordinary terms in ordinary ways are, by definition, not distinctive—that is, the terms aren't unusual or surprising in the context—they receive little legal protection at the outset of their use. That means that under the principles of trademark law, it's more difficult to keep others from using them or something similar.

For example, the mark Dependable Dry Cleaners merely describes the business, without distinguishing it from its rivals. In fact, some of the rivals might also need to advertise their services as reliable or efficient. If trademark law prevented such ordinary uses of common terms, our language would be seriously depleted. As a result, Dependable Dry Cleaners gets little protection as a mark from the courts. Does this mean you can't protect the trademark of a dry cleaner? Of course not. A fanciful name like Cinderella Dry Cleaners (if it's not already used by someone else) is a distinctive and therefore fully protectible trademark.

## **Even Undistinctive Marks May Be Entitled to Protection Once They Become Widely Recognized as Marks**

As mentioned in earlier chapters, there is an important exception to the general rule that weak marks are difficult to protect. It's this: Consumer familiarity with an ordinary mark can make the mark distinctive and therefore legally protectible. This is called the "secondary meaning" rule. Many of the most famous and effective marks, like McDonald's or American Airlines, originally consisted of ordinary terms that over time became widely recognized as product and service identifiers and thus

were transformed into strong marks (McDonald's is probably one of the strongest marks in the world).

Even Dependable Dry Cleaners might make it into the ranks of secondary meaning marks if a "Dependable" franchise became a household name through extensive marketing activities.

Using a mark that can't be protected until it has acquired secondary meaning can be a serious drawback to the small business owner. Either the business owner must accept the fact that the mark will be weak—and therefore subject to use by others—until the mark's reputation has been built up over time, or the owner must be prepared to spend a lot of money to promote the mark when it is first used, so that the public recognizes it sooner. Unless money is no object, it may be better to start out with an unusual word, phrase, or design that is protectible from the outset as a mark.

As with other topics touched on in this chapter, we discuss secondary meaning in detail in Chapter 9, "Evaluating Trademark Strength."

### **Real Ray's Best Famous Original Pizza**

Here's a Big Apple anecdote that illustrates the problem with trying to protect a name that's not distinctive. In New York City, which many view as pizza heaven (along with Chicago), there has been a proliferation of Ray's Pizzas, some of which are known for great pizza. There now are more than two dozen in the city, most of them under separate ownership. They call themselves Ray's Original Pizza, Real Ray's, Famous and Original Ray's, and variations on that theme. From a pizza lover's point of view, when two people set a date to meet at Ray's, no one knows which pizzeria anyone means. (Ray's on 7th Ave.? Ray's on Christopher St.? Which Ray's on 2nd Ave.? Or is it Ray's on Houston?) Consumers never know what quality to expect because they don't know which Ray's pizzerias are related. The pizza parlors get each other's mail and complaints, and none of the owners can sort it out. Resort to the courts has failed because, with so many Ray's, no owner can prove that consumers associate the name Ray's with any one pizzeria. So none is distinctive enough to be protected as a trademark.

## What Makes a Distinctive Trademark a Legally Strong Trademark?

Let's take our earlier discussion of distinctiveness a little farther to explore why distinctive marks make legally stronger marks. A distinctive mark has a greater ability to ward off copiers than does a common name, for three reasons:

- The more distinctive a mark is, like Kodak, the greater an impression it makes on the customer's memory, and the more likely it is that a similar mark, say Kodec, will remind the customer of the original mark. That can lead to confusion. The customer may think Kodak and Kodec are the same brand, or that they are related. They may buy one instead of the other, or they may be misled into thinking the reputation of one applies to the other. In either case, the customer is confused, and the rightful owner of the Kodak mark will have probably lost profits.
- The more distinctive a mark is, the more likely it is that potential customers will assume that all products and services carrying the mark originate from one source. This is the opposite of what consumers are likely to think when confronted with ordinary marks that are similar to each other. For instance, it's reasonable to assume that Double Rainbow Ice Cream is manufactured by one company, whereas you wouldn't make that same assumption for several ice cream outlets that use some combination of Tastee in their marks. The greater the likelihood that customers will associate a product or service carrying a particular mark with a particular source, the greater the need to protect against the confusion that would likely result if the same or a similar mark was adopted and used by another business.
- The more time, money, and creativity that goes into making a mark distinctive, the more sense it makes to provide the mark with adequate protection. And if the distinctiveness comes from widespread customer recognition over time (the secondary meaning rule), it also makes sense to protect the business goodwill that has been built up under the mark. Although

the main reason for the trademark laws is to prevent customer confusion, the dilution principle (mentioned in Chapter 1 and discussed in detail in Chapter 10) recognizes that the value of a well-known mark should be protected in its own right, whether or not customers are confused.

### **State and Federal Unfair Competition Laws Can Provide Limited Protection to Weak Trademarks**

There's one more important point to understand about descriptive and ordinary words or phrases used as trademarks. Though they are not effective as trademarks without secondary meaning, ordinary names can receive certain kinds of limited protection from confusing use by other businesses under state statutes or cases barring activities that amount to unfair competition.

Protection from unfair competition is most useful when the second user of your trade name or mark is trying to create the impression that their business is affiliated with your business. In other words, unfair competition laws can help you if someone isn't making it clear through a variety of ways that they are not connected to your business.

We discuss unfair competition more fully in Chapter 10, "Sorting Out Trademark Disputes."

## **Guidelines for Making a Mark Distinctive**

Short of words that have been coined for the precise purpose of operating as trademarks, such as Exxon, the quality of distinctiveness in a mark is most likely to arise from downright cleverness. For a name mark to be clever and therefore distinctive, it need not use words that are unusual or even weird. For example, distinctive trademarks often consist of ordinary words used creatively in an unusual context (example: Camel for cigarettes, Apple for computers), several ordinary words combined in an interesting way (Thistle Dew Inn) or with an innovative design

(Sc[i]3), and words that evoke fanciful associations (Double Rainbow Ice Cream).

Also commonly used for distinctive marks are ordinary words that indirectly suggest what the underlying product or service is all about without describing it outright. Examples of these suggestive marks are: Verbatim (for computer disks), Banana Republic (for a store that originally specialized in stylish rugged-wear clothes), or Bloomers (for a flower shop).

Clearly, whether a trademark is distinctive will depend on both its components and the context in which these components are used. Here we describe the sorts of marks that are routinely considered by the courts to be inherently distinctive and therefore legally strong. (Again, we go into much greater detail on this in Chapter 9, “Evaluating Trademark Strength.”) These, therefore, are the kinds of marks we advise you to use, taking into account the marketing considerations outlined later in this chapter.

### **Marks Using Coined Terms—Such as Kodak, Exxon, and Rackafrax—And Terms Made Up of Parts of Different Words, Such as Unisys**

These are wholly new, made-up words with no meaning and probably not even any connotation other than the one you will create for it with your advertising and other marketing activities. The key to a coined mark is making it pronounceable and appealing to both eye and ear, or at least suitable to the image you want to project for your product or service. To avoid coined terms that evoke unintended images, run your choices by a variety of people and note their responses to the sound and appearance of the mark. (Sample surveys of customers should be saved for marks that have passed the legal availability test.) As mentioned in Chapter 1, the best way to make a mark distinctive is to make it up.

Despite their legal strength, most coined words require extensive marketing efforts—and the attendant costs—to get established as product or service identifiers in the first place. More than any other kind

of mark, coined words require lots of initial advertising, because coined words don't mean anything to the general public without it. That's a major drawback for a small business with limited start-up capital.

Opting for a coined term as your trademark has a second drawback. With over 200,000 new trademarks being federally registered each year, the well of coinable words is fast being drained. Despite our rich Celtic, Anglo-Saxon, Norman, and Latin linguistic heritage, new combinations that sound good and look appropriate—that is, ones that are marketable and not already in use—are becoming harder to develop.

### **Marks That Suggest but Don't Outright Describe the Product or Service, or Some Aspect of It (Such as Obsession Perfume, Sharp's Nonalcoholic Beer, Intuit Software)**

A mark is usually considered suggestive when you need to take at least one more mental step to figure out what is being suggested. Suggestive marks are favored by marketing folks because they operate to evoke an image or idea to customers who associate it with the product or service being marketed. "Obsession," for example, creates the aura of irresistibility, certainly a desirable attribute for a perfume. This kind of mark is especially effective for the sorts of services or products that sell by affecting one's self-image, like beauty services, clothing, jewelry, sports businesses, or even cars. Again, test your ideas out on a number of people to see if they perceive the suggestion you hope to send.

Though suggestive marks may also require marketing to become broadly identified with a product, they are usually easier to promote than coined ones, because they connote something about the product or service. Some name consultants argue that suggestive names are the most useful, because of their comparative legal strength (customers remember them), and because the images they evoke make them very effective marketing tools. On the other hand, it takes lots of thought to come up with one that's appropriately evocative, suits your customer base, and hasn't been taken.

## **Marks That Use Fanciful Terms in the Context of Their Use (Such as Bugle Boy Clothes, Double Rainbow Ice Cream, Yahoo! Internet Services, and Penguin Books)**

These types of marks are fun to invent, because you can use any term or combination of terms that does not in fact describe your service or product in any way. The trick is to think up a term that is interesting, memorable, and somehow appropriate without literally describing some aspect of your service or product. For example, “Guess?” works for youthful sportswear—it carries the idea of a company/products that are innovative, unusual, and related to adventure. Of course, clothes by themselves have none of these attributes, but that doesn’t matter. Also, being the first to use such an original mark (a verb with a question mark) makes the company seem innovative. A company that comes along later and names its products “Why?” would only seem imitative.

Clearly, consumer responses to these types of marks are subjective and intuitive, and the creator of a fanciful or arbitrary mark must therefore try to consider all the possible evocations that a mark may have and make the most of them.

## **Marks That Use Arbitrary Terms in the Context of Their Use**

Words that are descriptive or ordinary when associated with one product or service (and thus, unprotectible altogether) can be very strong for another. For example, the trademark Apple Computer is distinctive and therefore strong because apples have nothing to do with computers, whereas the trademark Green Apple applesauce is weak because it literally describes the product. Similarly, the word Cherokee works well as a trademark on a four-wheel drive utility vehicle and on women’s apparel, because in each case the word is arbitrary in the context—that is, it doesn’t describe any aspect of the underlying products. But Cherokee wouldn’t work well as a trademark on Native American crafts, because in that context, it simply describes the expected origin of the

goods. Finally, Jellibears is a distinctive name for a skating rink, but is mundane (and probably generic) as the name of a line of oval, colored, chewy candies.

## **Common Terms in Uncommon Arrangements**

As mentioned earlier, the individual terms that make up strong marks need not themselves be inherently distinctive. So far, we have focused primarily on what are essentially one-word trademarks—such as Yahoo!, Exxon, and Apple. However, the distinctiveness of a trademark can also reside in a phrase, or in several words put together in an unusual way. Their common characteristic is that taken together they are somehow different from everyday words and names. For example, Taco John's has weak components—taco is a common food item, and there are millions of Johns in the world—but the way the two words combine make the whole trademark distinctive and therefore protectible.

When evaluating a phrase to see if it's a strong or weak trademark, it is the overall impression that counts. If the phrase as a whole has an original ring to it, the fact that some of its elements are ordinary won't matter. For example, Speedy Turtle Delivery Service is memorable for the contrast of speed and turtle. This makes it distinctive, despite the fact that Speedy Delivery Service without the "Turtle" would be purely descriptive and therefore weak.

## **Ordinary Terms Combined With Novel Designs**

Distinctive design elements can add distinctiveness to an otherwise trite name. Toys Я Us (with a backwards "R") is one example of a trademark where the words themselves incorporate a design that lends the name originality. More often, the words have a conventional design, but they are portrayed as part of a distinct design or type style that accompanies them. One example is the bell inside a circle that indicates one of the "Baby Bell" telephone companies. Others are the profiled eagle with red and blue bands signifying the U.S. Postal Service, the script letters

“G” and “E” inside a circle indicating General Electric, the red Texaco star, or the face of an Eskimo on the tail of Alaska Airlines planes.

Again, remember that what counts in evaluating a trademark’s strength is the overall impression that the trademark creates in the mind of the consumer, rather than the impact of any single word or design element.

### Sources of Marks That You Might Not Think Of

Though it may seem that all the good marks have been taken, there is, in fact, a virtually inexhaustible supply. But, like diamonds, they usually aren’t just lying on the ground for the taking; a little mining must take place, and like the diamond in the rough, some cutting and polishing may be required to make them shine. Some of the sources for finding a distinctive name for a trademark are:

- new combinations of existing words (Palmolive, Diehard)
- combinations of word roots (Navistar, Soloflex)
- distinctive foreign words (Sirocco car, Soleil watches), and
- abandoned marks that are no longer in use but that were once famous can make strong marks. They may bring a certain cachet to your product or service, if their former image corresponds to the one you now want to project.

If you do discover a mark you know has been in use at one time, you should find out if it is now available for your use by doing the sort of searches we describe in Chapter 4.

### Names to Avoid

Now that we’ve suggested what types of words make distinctive marks, it will help to describe the types of words that cut against distinctiveness (unless they obtain secondary meaning through use over time).

## Personal Names, Including Nicknames, First Names, Surnames, and Initials

Probably the most common type of name trademark used for a business is one that carries the owner's first or last name. Mary's Pizza (yes, it is owned by Mary), Thurlow's Web Designs, and Brian Loman Electronics are examples. For the most part, these personal name trademarks are legally weak and not much good for customer recognition outside the business's locale. But combined with a non-name term, such as Taco John's or Trader Joe's, a mark built around a personal name can be quite distinctive. And if you have a name like Orville Redenbacher, you have no distinctiveness worries at all.

### When Can You Use Your Own Name as a Trademark?

One of the reasons that personal names are not protectible is the idea that no one should have a monopoly on a personal name. Unless the name has already come to mean a particular service or product through the secondary meaning rule, it isn't fair for one Jones to prevent all the other Joneses from using their family name. For this reason, the courts used to say that anyone had an absolute right to use his or her own name to identify a product or service.

That's been qualified over the years. Now, individuals still have the right to use their own names, but not if it will confuse consumers or smack of an unfair attempt to ride on the coattails of their famous namesakes. Generally, that means you can use your own name but not in the same line of work as a trademark owner of the same name. So, for example, Prosper Champion (unrelated to the original spark plug Champion) was not allowed to make and market spark plugs under his name. Nor would anyone named Marriott be permitted to open a hotel under that name. For the same reasons, a person who sells his or her name as the mark for a business can't later go into the same field using that name again. Finally, you won't be able to use your own name as an Internet domain name if somebody else has beaten you to it (unless you have been using your name as a trademark and can establish bad faith on the part of the domain name registrant). For information about domain names and trademark law, see Chapter 2, "Trademarks, Domain Names, and the Internet."

### Practical Pointers on the Use of Personal Names as Trademarks

Now that you have a general idea of how personal names fit into the general rules regarding strong and weak marks, here are some pointers on using specific types of personal names.

**Surnames.** Using your surname (last name) as a trademark has a few drawbacks you might want to consider. You may want to sell the business someday, and it will be necessary, as a practical matter, to sell the name with it. This means a stranger will be operating under your name. And perhaps worst of all, the sale of your business may prevent your children or other relatives from capitalizing on the family expertise by opening their own similar businesses under their own name. Finally, as we saw, marks that are “primarily surnames” do not qualify for federal registration, absent a showing of secondary meaning or perhaps an association with another term that makes the combination inherently distinctive as a whole, such as Warner’s Wasteland for a line of stores specializing in recycled products.

**First Names and Nicknames.** First names are generally even weaker as trademarks than surnames, because most are so much more common. But, for the same reasons, they have fewer of the disadvantages that go with selling a business. And, as we have seen, they can also become unusual simply with the addition of an unusual modifier, like Trader Vic’s or Aca Joe.

As with surnames, anyone can use his or first name or nickname on a business unless it’s too close to a famous one. For example, “Sony” Florendo can’t call her restaurant Sony’s, and Mayo Priebe can’t call her drugstore Mayo’s Drugs. Sony Corp. and the Mayo Clinic objected to these uses and won, even though there was little likelihood of confusion between the local businesses and their more famous namesakes. Perhaps the judge felt that these were really attempts to capitalize on the more famous trademarks or that the second uses diluted the original marks. (See Chapter 1.) But one is tempted to conclude that the size and wealth of the complaining parties was a significant factor.

**Initials.** Use of initials won’t change the strength or weakness of the trademark if they are part of what is essentially a first or last name.

For example, the owners of P.T. Dann’s (as a trademark for a national clothing chain) won’t infringe on the rights of others using the Dann name. On the other hand, until the company develops a lot of public awareness of the name as a mark (that is, it acquires a secondary meaning), it probably can’t stop anyone else from using the same or similar trademark, except in the retail apparel business. But if another Dann opened up competing clothing stores, even without secondary meaning, P.T. Dann could probably stop them under unfair competition laws, as well as under trademark laws, once secondary meaning is shown.

A trademark consisting completely of letters that aren’t a person’s initials is not inherently weak. Rather, its trademark strength depends on the strength of the words the initials represent. If the initials do not stand for anything and are an uncommon arrangement of letters, the mark can be distinctive from the outset. For instance, ABC is not considered distinctive because this combination of letters is in such common use as a mark (except, of course, in the media world, where the network initials have secondary meaning). However, a mark consisting of XQE may be.

### **Marks That Describe Attributes of the Service or Product or Its Geographic Location**

The main reason to avoid these marks is that they are legally weak and therefore not extensively protectible until they have been in use long enough that they have become easily recognized by your customers. However, many business owners believe that if they use some words in their trademarks that either describe the types of businesses or some positive characteristics of the businesses, they will benefit far more by the marketing payoff than they risk from would-be copiers. (See Chapter 9, “Evaluating Trademark Strength,” for more on why these marks have such limited legal protectibility.)

## Be Careful About Deception When Using Geographic Marks

Earlier, we warned about using deceptive or misleading marks. This warning is especially appropriate for geographic terms that are used fancifully. There are really two types of possible deception in the use of geographic marks:

- actual deception in which a customer is induced to buy a product in the belief that the item comes from the region on the label
- deceptive misdescription in which the public might make a false geographic connection but wouldn't particularly rely on the geographic factor in buying the service or product.

For instance, a deceptive trademark would be the mark Limoges for china that was neither made in France nor of French clay; or American System, for clothing made in Italy. A deceptive trademark is not protectible and can never become so, even if it acquires secondary meaning. Further, using a deceptive mark may subject you to legal liability for false advertising.

On the other hand, using a mark like Neapolitan (especially with an Italian flag on the label) for Italian sausages made in Florida is seen as merely "deceptively misdescriptive." That is, some people might be confused into thinking the sausages come from Naples, but that's either unlikely or not the main reason they would buy the sausages. Another example is calling a chewing tobacco Durango even though it is not from the noted tobacco growing region of Durango, Mexico. Such marks are not protectible until they have developed secondary meaning. Once the mark has secondary meaning, the potential for confusing the public is lessened, because presumably the public knows the product for what it is and doesn't care where it comes from.

Obviously, the trademark implications of geographic terms can get a little muddier. We suggest this general rule: Don't use a geographical term, even if the place named has nothing to do with the origin of the product, as long as a reasonable consumer might think it does. If you decide that you absolutely have to use a geographic trademark, either make sure your mark has only a vague suggestive connection to your product or service (like Sedona, for a Portland, Maine, restaurant) or try combining it with other more inherently distinctive terms that make the trademark protectible from the outset, like The Abilene Albatross for a bar.

### **Names With Bad Translations, Unfortunate Homonyms (Sound-Alikes), or Unintended Connotations**

These you should avoid because they can easily backfire as advertising tools. A famous example is the French soft drink called Pschitt, which had to be renamed for sale in this country. Also the Chevy Nova is an unwise trademark for a car in Spanish-speaking countries (including perhaps our own because of the high proportion of Spanish speakers) because the mark means “it does not run” in Spanish.

### **Names That Closely Resemble Well-Known Marks**

If you definitely want to avoid being sued for trademark infringement, avoid using famous marks or obvious variations of them. Whether they succeed or not, claims of trademark infringement and dilution (a type of protection for well-known marks) are commonly brought by owners of famous marks in order to clear the field. McDonald’s regularly sues companies that use the “Mc” prefix or yellow arches. Often they succeed—preventing the use of “McSleep” for motels and yellow arches for a computer company. (See Chapter 11, “If Someone Infringes Your Mark.”)

## **Marketing Considerations When Choosing a Name Mark**

Now that we have dissected what makes a mark distinctive, here are a few practical pointers that combine the legal information just discussed with some marketing savvy that is part of picking the “right” name for your business, service, or product.

### **General Advice**

George Eastman, founder of Kodak and a man with an eye for a good trademark, suggested that trademarks should:

- be short
- be vigorous
- be easily spelled, and
- mean nothing.

Though this advice certainly worked for him, it may not apply to your situation. If not, heed the advice of other trademark experts who recommend that name marks be:

- pronounceable
- memorable
- graphically attractive (for instance, no hyphens), and
- legally available.

Chapters 4 and 5 explain how to find out whether your mark is legally available. Whether your mark meets the other criteria discussed in this section is a more subjective decision that you will have to make yourself. However, these lists of desirable trademark characteristics omit an important point: Your mark must also be tailored to meet the needs of your business and your customers.

## How to Come Up With a Good Name

Like most business decisions, your choice of how to select a good name mark will reflect your own personal style of decision making. Here are some alternative methods:

- Delegate the job to a committee.
- Throw a naming-brainstorming party and invite all your friends.
- Make lists yourself.
- Devise a contest to generate a name.
- Use all of the above methods.
- Hire a professional name consultant.

Whatever method you use, you will probably want to develop a long list and a short list. The long list would consist of likely possibilities that meet the criteria we discuss below for tailoring your mark to your needs. Then you can use any of the above methods again to narrow the list to five or ten of the most likely.

When you have your short list, you must find out how to tell which of your trademark possibilities can also be used as an Internet domain name (Chapter 2), and then turn to Chapters 4 through 6 to discover which possibilities meet the all-important criterion of legal availability. Only when you have searched and cleared each name for possible

conflicts with existing marks and Internet domain names (if you plan to use the Internet for marketing purposes) can you make a final decision based on aesthetics or marketability or whatever you decide is your ultimate criterion.

## **Useful Concepts in Creating a Name Mark for Your Product or Service**

The most useful concepts in creating a name mark are the same ones you or your advertising consultant would think about in devising a marketing scheme. Your mark is, after all, the most important aspect of your advertising plan. What will help you invent your mark are basic commonsense conclusions about what kinds of advertising will work best with your product or service, based on what you know about your customers.

Use the following questions to develop criteria that are specific to your needs and that you can then use, along with the suggestions above, to develop a list of potential marks. If you already have developed these criteria, this section tells you how to apply them to trademarks. And if you haven't, you might as well figure this stuff out now.

- What is your (projected) customer base? Is it a broad economic group, within a small region? Or is it a select group of professionals scattered nationwide? This is the most important factor, as it affects all of the other criteria below.
- What are your customers' demographics and income/educational level? This will tell you the tone and style of your advertising, as well as what sort of words to use in your mark—for example, whether to use words that are young and hip or older and more traditional, funny or serious, or highly literate or simple.
- What are your customers' buying habits? Are purchases typically made in a hurry or more carefully considered? If your customers tend to buy in a rushed manner, then your trademark needs to be simple with a high visual impact. If they tend to buy in a more considered manner, then your mark can be more subtle and complex.

- What aspect of your service/product will appeal to your potential customer base? This affects the image you want to project — if the main appeal of your service is convenience, then the trademark should somehow evoke that idea.
- Can you distill the essence of your product or service into a word or phrase? If there is a dominant idea connected with your service or product, then a mark that incorporates or reflects that idea will be easier for you to promote and for your customers to remember.
- What image do you want to associate with your service or product? If the image you have is not exactly the one you want, you can try to develop a mark that reflects better your vision of your service or product. A mark incorporating symbols popular with teenagers may not help you if you seek to appeal to stable young families.
- How is your service or product different from the competition's? Perhaps the main thing about your service or product is that it is unique—the mark should help identify that characteristic—or that it's cheaper, or fancier, or whatever sets you apart in the marketplace.
- How will the mark be advertised—in what media and with what level of visibility? This affects whether you need both a logo and a name, whether a short word is essential or a longer phrase will do, or whether you want to focus on trade dress (creative packaging, and so on). Also, how broadly and where you will advertise your mark—on business cards, letterhead, pamphlets, a storefront, signs, packaging, radio ads—affects what sort of mark to use. That's because a complicated logo may translate well to business cards, but you may not be able to see it clearly on a storefront.

The answers to some of these questions will also help you figure out what sources to use to create your mark, and what attributes the mark should have. For example, if your customer base is gourmet coffee drinkers, you could consider using foreign words, mythological names, or literary references in creating a mark that evokes sophistication/good taste. But if your customers comprise a broad section of the population

whose main concerns are value and convenience, you might want a more straightforward simple name using American roots or references.

## Using a Professional Name Consultant

Most name consulting firms cater to large corporations and are not likely to meet the needs or the budgets of small businesses. To find one that will help you on a smaller scale, take the advice of Ira Bachrach of Namelab ([www.namelab.com](http://www.namelab.com)), a corporate name consulting firm in San Francisco. He recommends calling a small to medium-sized ad agency and asking them to help you create a name as a discrete, time-limited project for a fixed fee.

He advises you to specify what they are expected to produce for that fee and to propose paying when you get the result, or paying half in advance, half at the end. Often, at ad agencies, creative people will have little gaps of free time in which they could work on your project. If you explain that you are not a potential client, they will treat you as a one-time project. Bachrach also says that he is often surprised at how many established agencies will sometimes help small businesses in naming their products or services.

A few well-established naming firms do routinely consult for smaller companies. One such is Name-It Creative Naming Company ([www.nameit.com](http://www.nameit.com)).

### Where to Find More on Trademark Strength

Now that we have taken a closer look at what makes an effective trademark, you may want to go on to Chapter 9, “Evaluating Trademark Strength.” That chapter teaches you how to classify your (or another’s) mark in terms of its legal strength. It discusses in much greater detail the varieties of distinctive and ordinary trademarks, including coined, fanciful, and suggestive categories of distinctive marks, and descriptive, geographic, personal name, and initial types of ordinary marks.



## FREQUENTLY ASKED QUESTION

**Creating a trademark based on PERL programming**

*"I want to create a trademark called AlchemicPerl. Perl is a programming language and the Perl Foundation, who owns the registered trademark has told me that I cannot use the word Perl. Does AlchemicPerl violate their trademark? AlchemicPerl will be used to market software and consulting services related to the Perl programming language. I know there is also a trademark called ActiveStatePerl which seems not to have a problem but I just wanted to be more certain."*

The short answer is that we're not sure what will happen if you proceed, but we have a feeling it's not going to be good. The Perl Foundation does have a federal registration for the word PERL combined with the image of an onion. The registration is for computer software among other things and the Perl Foundation warns others against using the word, Perl, as part of a software product (and even counsels about using an onion, the Perl mascot, too). The foundation's desire to protect this mark has something to do with its intention to maintain the Perl language as an authenticated open source language without worrying about commercial interlopers preventing others from using the name—a tactic that can have unexpected publicity consequences for those seeking open source freedom. You have a series of challenges ahead of you—for example, a trademark examiner may object to your use based upon the existing registrations; or the Perl Foundation may oppose the registrations as being likely to confuse. For these reasons, we'd probably back off the choice of AlchemicPerl.



# Trademark Searches—What They Are and Why You Should Do One

<b>What Is a Trademark Search?</b> .....	96
<b>Why Do a Trademark Search?</b> .....	96
<b>What Resources Are Used in a Trademark Search?</b> .....	97
<b>Where Are Trademark Search Resources Located?</b> .....	97
Trademarks on the Federal Trademark Register and in Pending Applications .....	98
Trademarks Registered With State Agencies.....	98
Unregistered Trademarks and Service Marks.....	99
<b>Different Levels of Trademark Searches—What They Are; When They’re Appropriate</b> .....	100
Direct-Hit Searches .....	100
Analytical Searches—Going Beyond a Direct-Hit Search .....	101
Comprehensive Trademark Searches.....	103
<b>Planning Your Trademark Search</b> .....	104
The Trademark Uncertainty Principle.....	104
Planning the Scope of Your Search.....	105
<b>Using a Professional Search Service</b> .....	109
Why Use a Search Service?.....	109
What Trademark Search Services Cost .....	110
How to Find and Use a Trademark Search Service.....	111
<b>Using a Patent and Trademark Depository Library to Do Your Own Search</b> .....	113
<b>Does Your Failure to Search Mean You Acted in Bad Faith?</b> .....	114

In this chapter, we introduce you to the process of finding out whether your choice for a mark is already being used by someone else—a task commonly referred to as a trademark search. Then, in Chapter 5, we tell you how to do it. If your search turns up an existing mark that is the same or similar to your proposed mark, you will then want to proceed to Chapter 6, “How to Evaluate the Results of Your Trademark Search,” which helps you decide whether the existing mark legally conflicts with yours.

## What Is a Trademark Search?

A trademark search is a systematic hunt for the existence of any registered or unregistered trademark or service mark that:

- is the same as or similar to a mark proposed for use by the searcher
- is being used anywhere in the country (or world if the proposed mark is to be used internationally), and
- is being used in a context that would likely result in customer confusion if the proposed mark is put into use.

## Why Do a Trademark Search?

There are two good reasons to search for potentially conflicting marks. If you are not the first user of the mark for the goods or services in the marketplace, you may have to change your mark and, in some cases, possibly pay damages to the first user if a judge concludes that your use creates a likelihood of customer confusion. In addition, if you are planning to apply for federal registration of the mark, you will save time and money by discovering whether your proposed mark is already registered for similar goods and services.

## What Resources Are Used in a Trademark Search?

A trademark search may involve some or all of these resources, depending on the scope of the search:

- **The federal trademark register:** a list of all trademarks and service marks that have been authorized for federal trademark registration
- **Pending trademark applications:** a list of all trademarks and service marks for which federal registration applications have been filed
- **State trademark registrations:** a list of all trademarks and service marks that have been registered at the state level (usually with a state's secretary of state)
- **Publications containing relevant product and service names:** trade magazines, print directories of commercial names, yellow pages, and electronic databases containing product and service names that are in use in the United States generally, or in respect to specific fields, for example, computers, biotechnology, or bicycles, and
- **The Internet:** domain names, Internet sites, and goods and services being offered on the Internet.

## Where Are Trademark Search Resources Located?

Many of the resources used in a typical trademark search are available online for free. Others are only available through proprietary databases that can be accessed directly or over the Internet by any member of the public who is willing to pay for the privilege. It is possible to do a free, reasonably competent trademark search by using workstations and print collections found in special public libraries known as Patent and Trademark Depository Libraries, or PTDLs.

## **Trademarks on the Federal Trademark Register and in Pending Applications**

Perhaps the most important resource for a trademark search is the list called the federal trademark register. It is also important to search the list of trademarks awaiting registration. Applications typically take a year to make it into the Federal Register. Although the federal trademark register obviously doesn't include nonfederally registered trademarks—which may cause trouble down the road if you don't know about them in advance—a search of the federal trademark register and pending applications is a necessary first step.

There are a number of different ways that the public can search the federal trademark register and its accompanying list of pending applications. Most important, the United States Patent and Trademark Office has put its own trademark database (called TESS, for Trademark Electronic Search Service) on its website ([www.uspto.gov](http://www.uspto.gov)), which can be searched for free. It's also possible to search USPTO records at sites including Trademarkia ([www.trademarkia.com](http://www.trademarkia.com)) which offer additional benefits such as simplified logo searching. Other Internet resources are Trademark.com ([www.trademark.com](http://www.trademark.com)) and SERION, both owned by Thomson. SERION offers online searching tools, including a search engine database known as SAEGIS, which involves some fees and a considerable learning curve. However, its search engine is better suited to what we later refer to as an analytical search. Our recommendation is that you first use TESS to search the federal trademark register for marks that are the same as or very similar to yours. Later, you may want to spend the money and time to run your proposed mark through the SAEGIS search engine.

## **Trademarks Registered With State Agencies**

Many trademark owners who use their trademarks solely within particular states register the marks with those states' trademark agencies. Because such a registration might block the use of a later proposed mark within that state, the owner of the proposed mark will often search for

instances of state registration. You can do this yourself by using the TrademarkScan State Database, available through SAEGIS, or by calling the secretary of states' offices for the states you are interested in. (For a list of state trademark agencies and statutes, access the state trademark links at [www.ggmark.com](http://www.ggmark.com).)

## Unregistered Trademarks and Service Marks

Because trademark ownership is based on who uses the mark first, it is important to search for marks in actual use if you wish to avoid a conflict somewhere down the line. To do this, you must hunt for the use of your proposed mark (or something very similar) on products and services that are similar to the products or services you plan to use the mark with. While this hunt will undoubtedly produce many marks that appear on the federal trademark register, it will also turn up marks that don't.

There are several approaches to performing this type of search (called a "common law search" because the importance of unregistered marks stems from court decisions, which are called the common law):

- Use an Internet search engine, such as Google ([www.google.com](http://www.google.com)), to search for use of your proposed mark on the Internet and as a domain name.
- Use SAEGIS on SERION ([www.serioninfo.com](http://www.serioninfo.com)) to search its common law database on the Internet and all domain name registries for a modest fee.
- Use SuperPages ([www.SuperPages.com](http://www.SuperPages.com)) or the Thomas Register of Products and Services at ([www.thomasregister.com](http://www.thomasregister.com)) to search for trade and corporate names for free on the Internet.
- Use the print resources in a PTDL or a large public library that contain listings of product and service names.
- Use DIALOG ([www.dialog.com](http://www.dialog.com)) to access a number of databases listing product and service names in use around the country (this service can be costly, and a learning curve is involved).

## Different Levels of Trademark Searches— What They Are; When They’re Appropriate

There are three different levels of trademark searching:

- direct-hit searching
- analytical searching, and
- comprehensive searching.

### Direct-Hit Searches

This type of search looks for marks on the federal trademark register that are the same as or very similar to the mark you propose to use. It is, in essence, the starting place for any trademark search. Its essential purpose is to get a quick fix on the marks that are most likely to cause your proposed mark trouble in the future. If you adopt and use a mark that clearly conflicts with one already on the Federal Register, whether or not you actually know of it, you will be considered a willful infringer of that mark and may be sued for substantial money damages. The obviousness of your infringement will greatly reduce your ability to negotiate an acceptable settlement with the existing mark’s owner. A direct-hit search prevents this sort of difficulty.

In addition, a direct-hit search tells you whether it’s worthwhile applying for a federal trademark registration. Your trademark won’t qualify for placement on the Federal Register if the PTO thinks customers are likely to confuse it with a mark already on the register. (See Chapter 7, “Federal Trademark Registration.”) This means that a direct-hit search can potentially expose marks that may conflict with yours and tell you whether or not an examiner is likely to approve your application.

A direct-hit search will tell you if your proposed mark has been registered for so many goods or services within the same class or classes as your mark that it would receive little protection under the federal trademark laws. You may want to use the mark anyway, but at least you’ll have a better idea of its relative strength. (See Chapter 9, “Evaluating Trademark Strength,” for what makes a mark legally weak.)

Practically speaking, a direct-hit search is especially helpful when you have several choices of potential trademarks and you wish to narrow the field by eliminating obviously unavailable marks.

Direct-hit searches are quick and easy to do. All it takes is to enter your mark into the search box in the PTO's TESS database and see what comes up. In addition, you can browse the registered marks that alphabetically come before and after your proposed name. (We tell you how to do all this in Chapter 5, "How to Do Your Own Trademark Search.") By using TESS, you will save approximately \$30 to \$50 per mark searched, the amount it typically costs to get a direct-hit search from a professional search service.

## **Analytical Searches—Going Beyond a Direct-Hit Search**

For most businesses, especially those that plan to operate regionally or nationally, direct-hit searching is only the first step to clearing a name. Especially if the proposed name is distinctive, a more thorough search will be in order. However, if you already know that your proposed name is legally weak, or your business is small and local and you can tolerate some risk that an undiscovered prior user will pop up at a later time, the direct-hit search is really all the searching for registered marks that you'll need to do.

Depending on the type and complexity of your mark, the analytical search compares your mark with all federally registered and pending marks that sound or look like your mark, plus all marks that mean the same or in some other way might lead to customer confusion between them and your mark. It frequently involves searching for homonyms, synonyms, phonetic equivalents, alternative spellings, anagrams (words with the same letters rearranged), marks with similar components, and marks that start or end the same, or that have any other similarity. This type of search is more thorough, or "deeper," than a direct-hit search, and consequently more expensive and time-consuming. However, it permits you to uncover more potential conflicts.

For example, an analytical search for the mark Bioscan might reasonably include a look at all the marks that immediately surround

Bioscan alphabetically, and then look up all bio-marks, then all -scan marks, then all marks with the sounds -io or -osc in the middle. Next, you would search for all synonyms you could think of. Then, you might want to check for anagrams (scaniob) and alternative spellings (bayou-skan). This degree of complexity might not be called for in the case of a more straightforward mark, such as Fish Head Graphics.

An analytical search is essential for any business that wants to make sure its proposed mark isn't likely to be challenged on the grounds it is confusingly similar to, or evocative of, an existing federally registered mark. For instance, assume the manufacturer of certain gas barbecue components wants to use the mark Flamethrower. Because the components will all be stamped with this mark, the manufacturer wants to make sure that no existing mark has priority. To do this, an analytical search would look for all marks with the word "flame," all marks with the word "thrower," and all marks with words that sound like or mean the same thing as either of these.

It is especially wise to do this level of search if your prospective mark is distinctive. Because a distinctive mark can be protected to a much greater degree than a mark that lacks distinctiveness, it's worth making sure the distinctive mark is clear of all conflicts. For instance, the maker of Raintree shampoos would want to do an analytical search before marketing their product regionally, as would the operator of an 800-number information service that had a distinctive name. For a company that expects to expand its use of a particular mark in the future, an analytical search reduces the likelihood of eventual problems due to customer confusion caused by marks that are not identical but are reminiscent of each other.

The PTO's TESS database is ideal for doing analytical searches. However, doing a competent analytical search involves a moderate learning curve. (We give you the basics in Chapter 5, "How to Do Your Own Trademark Search.") TESS provides good online help, but you should plan on spending at least half an hour familiarizing yourself with the system before launching a search. By using TESS, you will save approximately \$100 per mark searched, the amount it typically costs to get an analytical search from a professional search service.

In some ways, the SAEGIS on SERION search engine (that uses the proprietary Thompson CompuMark database) is even better than TESS in that it automatically provides an analytical search. However, it takes some time to learn how to use SAEGIS and may end up costing you as much as a professional search service. Of course, the better you get at doing a SAEGIS search, the more efficient your search will be and the less it will cost you. (We provide some tips on using SAEGIS in Chapter 5, “How to Do Your Own Trademark Search.”)

## Comprehensive Trademark Searches

A comprehensive trademark search includes both direct-hit and analytical searches of the federal trademark register and examines other resources where unregistered marks and state registered marks might be found, such as proprietary online databases, hardcopy and electronic telephone directories (yellow pages), trade directories, the Internet, product catalogs, business ratings services, and so on. The goal is to discover any actual use of your proposed mark, whether or not it is officially registered. As mentioned, the reason for this is that most disputes between marks are resolved in favor of the first user.

For local businesses, a comprehensive search should, at a minimum, consist of checking the relevant yellow pages, newspapers, trade and product journals, and any other resource that might show a possibly conflicting locally used mark. For businesses that have broader horizons in mind, including Internet start-ups and e-commerce enterprises, this type of search can involve many different hard copy and online resources and can therefore become costly.

So far, we have suggested that you can do direct-hit and analytical searches yourself. The same is true with comprehensive searching. The Internet, print resources in the major libraries, and collections in many PTDLs all provide ways to systematically search for unregistered marks that are in actual use in commerce. However, there is no current way of searching state registered trademark databases on the Internet unless you are willing to pay a fee to use TrademarkScan, available through SAEGIS. If you are planning on sinking a lot of money into your new

business or website that will carry your proposed mark, and your mark is inherently distinctive, you might do well to hire a professional search service to cover all the bases for you. Comprehensive searches run between \$300 and \$600 per mark searched.

Because of this price tag, you can save yourself a lot of money by using the direct-hit and analytical search techniques as a screening mechanism. That is, once you decide to spring for a comprehensive search, you should first assure yourself that your proposed mark does not legally conflict with registered or pending marks on the federal or state trademark registers. This will prevent you from paying for a comprehensive search for a mark that you most likely would decide not to use.

## **Planning Your Trademark Search**

Now that you have a good idea of what is involved in a trademark search, you need to decide on the appropriate search for you and your particular situation.

### **The Trademark Uncertainty Principle**

Let us start by saying that if time and money are no problem, you will be well advised to do a comprehensive trademark search for every mark you plan to use. You can only gain from being as careful and conscientious about clearing your mark as possible. But two warnings apply here.

#### **Your Results Will Be Incomplete No Matter How Thorough Your Search**

No search is going to uncover every possible conflict in the United States and certainly not internationally. It's just too difficult to know if there's a prior unregistered user of a similar mark in North Carolina when you are in South Dakota. The best you can do is to make sure that your proposed mark doesn't obviously conflict either with registered marks or

with any unregistered marks you can find by systematically examining pertinent sources of trademarks, service marks, or trade names.

This means no matter how thoroughly you search, you will have to live with a small degree of uncertainty that someone else began using your mark first. What does it mean, legally, if they did? Nothing, if the other user doesn't object. Even if they do object and sue you in court to force you to stop using the mark, you probably would be allowed to continue to use the mark in your present marketing territory (unless both marks are used to market related or competing goods or services on the Internet). However, you may be prevented from acquiring the nationwide exclusive rights to your mark that otherwise would be available to you by being the first to register it. (See Chapter 10, "Sorting Out Trademark Disputes, for a discussion of priorities among trademark users.")

### **Your Search Results Will Be Legally Uncertain**

As you are undoubtedly tired of hearing by now, there are no absolute answers in trademark law. Even the most extensive search will probably not end your uncertainty, because it will likely uncover at least a few somewhat similar marks used on products that are at least vaguely related to yours. Whether such a trademark definitively infringes on another is a decision that only a judge or jury can make when the dispute is brought before them. In other words, it's only after you have been sued and a ruling has been made that you will know with some certainty (every case can be appealed) whether your mark infringes. In many real-world situations, you can be sure that the other user is unlikely to sue. But a thorough search will give you as much assurance as possible under the circumstances.

### **Planning the Scope of Your Search**

Since the best you can do is weigh factors and estimate probabilities, it's important for you to decide what level of risk is acceptable to you now. That way you can tailor your search to minimize the risk in line with your decision. Below we set out some general rules to follow when planning the scope of your trademark search.

**Rule 1: Always check the Federal Register for a direct hit.**

All searches should check the federal trademark register first for the same or a very similar mark as the one you propose to use. As mentioned, it is relatively easy to do, it's free, and it is the best way to uncover conflicts that necessarily require you to pick another mark.

**Rule 2: A big advertising budget warrants a more extensive search.**

Because comprehensive searches—full analytical and common law searches—can cost time and money, it may not make sense for a small business to check for every possible conflict. Whether or not you should depends on the size of your business, your future goals, your mark, and how you plan to use it. A good general rule is that if you plan to spend a fair proportion of your budget on promoting your mark, you should first spend whatever it takes (perhaps hundreds of dollars) making sure the name is safe for you to use. Otherwise you risk wasting your advertising dollars if you have to change the mark later. On the other hand, if your advertising budget is small, it may make more sense to accept a more limited search as sufficient.

**Rule 3: A strong mark requires a thorough search.**

How extensive a search is appropriate for you will depend on how much protection you need or can get for your mark. With a strong mark, there is more to protect, and a thorough search process is a better investment than in the case of a weak mark, where the extent of your rights is likely to be more limited anyway. The more distinctive, and therefore the stronger, the mark, the greater degree of assurance you need that no one else is using a similar mark elsewhere. If you have a strong mark and your goal is to be able to use your mark exclusively regionally, nationwide, or even worldwide, that will entail thorough direct-hit, analytical, and common law searches.

One important reason you need a comprehensive search to protect a proposed strong mark is that the existence of similar marks may prove that your chosen mark is not as strong as you originally thought. Remember that marks are distinctive either because they are inherently memorable (fanciful, suggestive, or coined), or because they become well known to the public through widespread use over time. If existing marks

sound or mean the same thing as your proposed mark, or look like it while sounding different, or have elements in common with it, your proposed mark may not be as legally strong as you had hoped.

You want to be sure not to evoke unintended connotations because of a likeness to another mark in an unrelated field. For example, a sports fishing manufacturer would want to avoid the mark National Harpoon, because it evokes *National Lampoon*, the mark of a business specializing in satire. You can't avoid such unintended effects unless you uncover them through a deep search.

**Rule 4: Think long term.**

In determining your trademark search goals, consider the future. For example, if your local engineering consulting service is limited to one city now, but there is a possibility you'll want to expand later—perhaps through the Internet or franchising—you'll want to conduct a more extensive search than might otherwise be appropriate for a firm of your current size. Rather than facing the possibility of having to change your mark later, you should conduct your trademark searches with those long-term goals in mind. This involves doing both direct-hit and analytical trademark searches, as well as thorough common law searches. By contrast, if you run a local hobby or kitchenware shop and plan to stay small, a direct-hit search coupled with a local or statewide common law search should prove sufficient (unless, again, you plan to market on the Web).

**Rule 5: Geographic scope of the use affects the size of the search.**

As we said before, where you will use your mark will determine what kind of a search you need to perform. This makes each case a fact-specific determination. Nevertheless, the following general guides are reliable:

- **For a mark used only in one region of one state, and for which there is no expectation of expansion:** Generally speaking, the smaller the geographic area in which you market your goods or services, the less extensive the search needs to be. If you check federal and state registered trademarks for direct-hits and then do a thorough common law search for your area and type of business,

you should be relatively well protected. That's because if another similar mark is not registered federally or with the state, and is not in use in your geographic area or line of business, you will not likely cause customer confusion. The only potential concern you may have is dilution, and if the other mark is not famous enough for you to run across it through these searches, then it is not famous enough to get relief under the theory of dilution.

- **For a mark in use in two or more states:** Suppose you are clearing a mark for your new computer program, gardening supply catalog, or 800-number phone service. You can only clear such a mark with a comprehensive search. That ideally should include federal and state analytical searches and a thorough common law search. This more extensive search is necessary because other businesses may have rights through registration in marks that are not yet being used in your particular region. In addition, because such marks are marketed nationally, they will face a greater array of potentially conflicting marks and thus the greater potential for infringement claims. Thus, a more thorough search is necessary to clear them.

Remember that the Internet is rapidly eliminating the very concept of local marketing territories, and if you expect to do business on the Web some day, you'll want to do your search just as if you planned to do business on a national level.

**Rule 6: Marketing channels affect the size of the search.**

- **For a mark used in a narrow niche of the market:** It may be cleared with a search that is limited to direct hits on similar names used on related and competing goods. That's because with a narrow circle of competitors and limited marketing avenues, you can minimize the chances of a confusingly similar mark hurting your sales by looking only at similar marks in the same market. For example, a mark used only on industrial ball bearings probably need only clear conflicts within industries related to machinery and steel, along with the recommended direct-hit search of the federal trademark register.

- **For a mark used by one owner on a wide variety of goods or services:**  
If you plan to use one mark on several different services or products, then you must be careful to find all other marks that are even vaguely similar. That's because your investment in such a mark will be high, and because you will need to be sure it evokes no other connection than the one to your business. For example, if you intended to develop a mark for use on clothes, shoes, luggage, jewelry, and cosmetics, you would conduct the most thorough search possible.

## Using a Professional Search Service

Before you decide whether to do your searching or farm it out, let us suggest that a combination of approaches may give you the best legal protection for your time and money. For example, using your computer to access the TESS database on the trademark section of the PTO's Internet site ([www.uspto.gov](http://www.uspto.gov)) can be quick and easy and provide good preliminary information. And if you are willing to pay the fees and spend the time learning the system, SAEGIS on SERION gives you access to the state trademark databases and a good search of the Internet and domain name registries. But unless you have the opportunity to practice, you probably should not attempt a comprehensive search on your own. For that, you should pay someone who knows what he or she is doing. In Appendix C, we provide portions of a comprehensive search that Nolo commissioned from Thomson CompuMark a professional search service in 2007. Feel free to take a look, but don't get stuck there. The example assumes that you are familiar with the material in this chapter and Chapter 5.

## Why Use a Search Service?

Next to hiring a trademark attorney, paying a trademark search firm is the most expensive means of clearing your mark. However, except for a direct-hit search—which you can reliably do yourself—a search service is likely to provide more reliable results than you will produce on

your own. There are several reasons for this. Most important, analytical and comprehensive searches come with considerable learning curves, regardless of which database or resources are being used. Searching for possible conflicts is a kind of art form that involves a lot more than typing in a word or phrase and asking whether it appears on the source being searched. An additional benefit is that search services have access to databases that are not yet available to the public for free, such as proprietary databases used in doing common law searching.

## What Trademark Search Services Cost

The services provided by various trademark search firms, and the fees they charge for different types of searches, vary considerably. Often the cost of the service will depend on how much massaging of the information is done before it is delivered to you. Generally, the more raw the data you receive, the cheaper it will be. Only attorneys are allowed to offer opinions about potential trademark conflicts, and as a result, trademark search services offered by attorneys tend to cost the most because they come with legal advice.

What do search services charge? Firms that search (but do not give legal advice) generally charge as follows:

- direct-hit search (for identical marks)—from \$30 to \$100 per mark searched
- analytical federally registered trademark search (for similar or related marks) from \$85 to \$300 per mark searched
- common law search only—from \$100 to \$200 per mark searched, or
- comprehensive search (combining analytical federal, state, common law, and domain names)—between \$185 and \$500 per mark searched.

The difference in rates may reflect variations in the coverage of the search, the sort of report you get, the experience of the searchers, or simply economies of scale. On the other hand, some firms may advertise an unusually low price to draw in customers, but then add on charges

that end up exceeding another firm's total price (a professional version of bait and switch). For example, does one fee cover the whole cost, or is there also a per-page charge for the report? Obviously, to sensibly shop you need to know the total cost of each service.

### **The Role of Attorneys in Trademark Searches**

If you decide to hire a trademark attorney to advise you on the choice and registration of a trademark or service mark, the attorney will be able to arrange for the trademark search. Some attorneys do it themselves, but most farm the search out to a search firm, the same as they've always done. Once the report comes back from the search firm, the attorney will interpret it for you and advise you on whether to go ahead with your proposed mark. Although you are getting considerably more in this attorney package than you'll get from a search service, it will cost you.

## **How to Find and Use a Trademark Search Service**

There are many trademark search services in the country. Because trademark searching is a purely information-based business, you don't have to worry about where a particular service is located. Telephone, fax, and email make it possible for a customer in Bangor, Maine, to comfortably deal with a service in California, Texas, or Virginia. With this in mind, we have decided to feature only two trademark search services in this section:

- Trademark Express, and
- Thomson CompuMark.

Trademark search firms will not interpret their search results; that task is left to you. In Chapter 6, "How to Evaluate the Results of Your Trademark Search," we take you step by step through a sample search report.

**CAUTION**

**By featuring these search services, we don't guarantee their results or vouch for the quality of their services.** Rather, we intend them as examples of what search services cost and the types of services they provide. And all are completely accessible by fax, phone, and email.

If you don't like doing business at a distance, you can find trademark search services in your area by looking in the yellow pages of the nearest good-sized city under trademark consultants or information brokers. If that yields nothing, consult a legal journal or magazine for your area. You'll find the ads of a number of trademark search firms. Though these are aimed at lawyers, many of these companies will also do searches for individuals and businesses. Finally, if you are connected to the Internet, you can find a good list of trademark search firms at [www.ggmark.com](http://www.ggmark.com).

**Beware of Aggressive Marketing Techniques**

Some trademark search services will try to convince you that you are making a mistake if you don't search every corner of the globe for possible conflicts. Before taking the bait, review our remarks in "Different Levels of Trademark Searches," above, about the different levels of searching, and make an independent decision about what scope of search is appropriate for you. Also, some search services provide additional services—such as the preparation of applications for federal and state trademark registrations. As with trademark lawyers, these businesses have a vested interest in convincing you that you will be better served by paying them to handle the tasks in question than by doing them yourself. If you feel that this point of view—which may in some cases be perfectly reasonable—is being too aggressively pushed in your situation, get a firm hold on your wallet and consider finding another service.

## Trademark Express

Trademark Express ([www.tmexpress.com](http://www.tmexpress.com)) is a private company that, in addition to other trademark-related services, offers a full choice of trademark searches. The company can also do international and domain name searching. For more information on rates, check the Trademark Express website.



### CAUTION

**We make no guarantees.** We do not intend to guarantee the results of any particular search company or make any representation as to the quality of its services.

## Thomson CompuMark

Thomson CompuMark ([www.thomson-thomson.com](http://www.thomson-thomson.com)) is the trademark search service often chosen by legal professionals. As with the other services it varies its rates depending on the type of search and how soon you need the results. Pricing is hard to locate at the Thomson CompuMark website, so for current rates, you may find it easier to telephone the company at 800-692-8833 or email them at [support@t-t.com](mailto:support@t-t.com).

## Using a Patent and Trademark Depository Library to Do Your Own Search

Using a Patent and Trademark Depository Library (PTDL) to do your federal trademark search involves less cash outlay than hiring a search service, but it will cost you in time and transportation expenses unless you live or work close to one. Most PTDLs offer free access to the CASSIS CD-ROM. The CASSIS trademark list is a good way to search for a direct hit. It is possible to use CASSIS to do an analytical trademark search, but the results are not likely to be as reliable as would be the case if the TESS database were used.

If you are computer challenged, or the wait to use the PTDL CASSIS workstation is too long for comfort, every PTDL has print materials that let you search the federal registered trademark database.

Whether or not the use of a PTDL is cost-effective for you will depend on such factors as:

- how many potential marks you wish to search for
- how far you are from the nearest PTDL
- whether you can free up the time to visit a PTDL during regular working hours, and
- the time it takes you to learn the CASSIS system (library staff will provide help).

For those of you who opt to visit a PTDL, see Chapter 5, “How to Do Your Own Trademark Search,” which explains how to conduct a PTDL trademark search.

A list of the PTDLs can be found at the PTO website.



#### RELATED TOPIC

**By now you should have a good idea of what is involved in a trademark search**, and have made some decisions about what sort of search you want to undertake, what source of information you want to use, and whether you want to do the search yourself or have someone do it for you. If so, you are ready to go on to Chapter 5, “How to Do Your Own Trademark Search.”

## Does Your Failure to Search Mean You Acted in Bad Faith?

In 1998, designer Tommy Hilfiger was found to have acted in bad faith when adopting the mark “Star Class” for nautical sportswear. (*SCYRA v. Tommy Hilfiger, U.S.A., Inc.*, 80 F.3d 749 (2d Cir. 1996).) Mr. Hilfiger’s attorney performed a search of federally registered marks and found no conflicts, but Mr. Hilfiger disregarded his attorney’s advice to obtain a complete trademark search for state and common law trademarks, which would have revealed an unregistered trademark for Star Class owned

by an international yachting organization. The court ruled Mr. Hilfiger should have been aware of the need for a full search since star class was a common term in yachting. As a result, Mr. Hilfiger was assessed special damages for acting in bad faith. In other words, Mr. Hilfiger had to pay more than usual for infringing a trademark because of his failure to search.

In a subsequent case, a map company adopted the mark Streetsmart, without conducting a formal trademark search. A court of appeals ruled this was not bad faith because the company had not disregarded its attorney's advice, had previously used similar marks with the prefix "smart," and was aware of the conflicting mark, Streetwise, but believed the two terms were not confusing. (*Streetwise Maps, Inc. v. Vandam, Inc.* 159 F.3d 739 (2d Cir. 1998).)

In another case, a court summarized the standard by stating that a failure to search equals bad faith only if:

- The trademark owner had reason to believe it was infringing another mark.
  - Its attorney advised it to perform a more complete search.
- 



# How to Do Your Own Trademark Search

<b>Meet TESS—The Trademark Electronic Search System</b> .....	119
<b>Getting Started With TESS</b> .....	120
Choose the Type of Search .....	121
Browse the Dictionary .....	122
<b>Understanding the TESS Structured Form Search</b> .....	123
Search History.....	123
Records Returned .....	124
Plurals.....	124
Search Terms .....	124
Field.....	125
Logical Operators .....	125
<b>Tips on Using the TESS Structured Form Search</b> .....	127
Focus on the Most Distinctive Part of the Mark You’re Searching.....	127
Search for Distinctive Syllables .....	128
Don’t Use the .com in Your Search .....	128
Searching for Phrases.....	129
Use the Truncation Feature Where Appropriate .....	129
Search for Sound-Alikes .....	131
Search for Foreign Translations .....	131
<b>Trademark Searching With TESS: An Example</b> .....	132
<b>Understanding the TESS Free Form Search</b> .....	134
Using the Free Form Search Box.....	135
How to Use the Field Codes.....	136
<b>Understanding the Results of Your Search</b> .....	137
Understanding the Report Returned by a TESS Search .....	137
Determining a Mark’s Status .....	139

<b>An Introduction to SAEGIS—A Fee-Based Search System .....</b>	<b>141</b>
TrademarkScan Autoquery .....	141
TrademarkScan Custom Search.....	142
Browsing the Index .....	142
<b>Searching for Designs.....</b>	<b>143</b>
<b>Searching State-Registered Trademarks and Trade Names .....</b>	<b>144</b>
<b>Searching for Trade Names and Unregistered Marks .....</b>	<b>145</b>
Telephone Directories .....	146
Trade Associations/Directories .....	146
Business Directories.....	147
Google .....	147

Searching for registered or pending trademarks on your own by using the PTO's online search system is easy. A typical direct hit search takes only about 15 minutes. An analytical search using TESS takes longer but still can be accomplished in well under an hour once you have learned the basics. And if you learn to use SAEGIS (officially known as SAEGIS on SERION, [www.serioninfo.com](http://www.serioninfo.com)), an analytical search will be even faster but will involve costs that depend on the number of search results you wish to review (usually, \$2.50 per mark displayed). For either system, you can make best use of your time by downloading the PTO's help file and studying it before starting your search.

Both the PTO and SAEGIS searches allow you to compare your proposed mark with registered trademarks and trademarks that are pending registration with the PTO. The results you come up with will include a list of the trademarks that meet your search parameters and the names, addresses, and contact information for the owners of those trademarks. You'll also learn how the trademark is being used (on what products or for what services) and what international class (category of goods or services) the mark has been assigned to by the trademark owner or applicant. This information is key in deciding whether you can go ahead and use the name without creating the likelihood of customer confusion. (See Chapter 6 for more on evaluating the results of your trademark search and Chapter 4 for a basic understanding of available trademark search resources and trademark searching in general.)

## Meet TESS—The Trademark Electronic Search System

TESS is an acronym for Trademark Electronic Search System, the search system that the PTO has made available to the public for free on the PTO's website. It is about as good a system as you can find anywhere and is roughly equivalent to the PTO's internal trademark search system known as X-Search. It's updated every day, has enormous flexibility in terms of the type of search that may be performed, and, all in all, is a

most valuable gift from the federal government. TESS comes with its own comprehensive help file, and if you are doing your own trademark search, you will be wise to study it before beginning your search.

### The PTO's Four Ts: TESS, TEAS, TARR, and TDR

The PTO provides four powerful databases at its site, TESS, TEAS, TARR, and TDR. These databases are distinguished as follows:

- **TESS (Trademark Electronic Search System).** Use TESS when searching through federal trademark registrations and prior-filed applications.
- **TEAS (Trademark Electronic Application System).** Use TEAS when applying for a trademark, collective mark, certification mark, or filing a Statement of Use/Amendment to Allege Use, or other application and postregistration forms.
- **TARR (Trademark Application and Registration Retrieval).** Use TARR when you want to retrieve information about the status of your application (or other applications) or the status of registered marks.
- **TDR (Trademark Document Retrieval)** is the newest addition to the USPTO online services. Debuting in 2005, TDR offers the public an advanced electronic portal to PDF viewing, downloading, and printing of an array of information and documents for more than 460,000 trademark applications totaling more than eight million document pages. For example, copies of applications, assignments, and oppositions will all be available. As new applications are filed, they will be added to the database. It is expected that more than 300,000 application files will be added annually.

## Getting Started With TESS

The first step is to go to the PTO's website ([www.uspto.gov](http://www.uspto.gov)). Click "Search Trademarks" on the bottom right of the screen. You'll encounter the page set out below.

## Choose the Type of Search

TESS offers five basic approaches to searching:

- New User Form Search (Basic)
- Structured Form Search (Boolean)
- Free Form Search (Advanced Search)
- Browse Dictionary (View Indexes), and
- Search OG Publication Date or Registration Date.

The New User Form Search and Structured Form Search are similar. The main difference is a structured search allows for a more flexible search. In this chapter, we take you through the structured search, but by all means use the New User Form Search if you want less of a learning curve. As you become more skilled at using TESS, you may want the greater flexibility offered with the Free Form Search. Regardless of which of the first three approaches you take, you'll also want to do a quick browse through the dictionary.

The USPTO also offers the ability to search the USPTO's *Official Gazette*, the electronic publication in which trademarks are published for public comments or opposition. The *OG* also includes notices regarding

The screenshot displays the USPTO TESS interface. At the top, there is a navigation bar with the USPTO logo and the text 'United States Patent and Trademark Office'. To the right, it says 'through TEAS?' and features the TEAS logo with the tagline 'file online'. Below the navigation bar, the breadcrumb trail reads 'Trademarks > Trademark Electronic Search System(Tess)'. There is a 'HELP' button and a 'News!' link. A note states: 'NOTE: Click here for a description of changes to word mark entries for standard character marks submitted via TEAS Plus that you may wish to consider when constructing your TESS searches.' A 'Logout' button is present. Below the note, a message reads: 'Please logout when you are done to release system resources allocated for you.' The main content area is a dropdown menu titled 'Select The Search Form' with the following options:

- ▶ New User Form Search (Basic)
- ▶ Structured Form Search (Boolean)
- ▶ Free Form Search (Advanced Search)
- ▶ Browse Dictionary (View Indexes)
- ▶ Search OG Publication Date or Registration Date

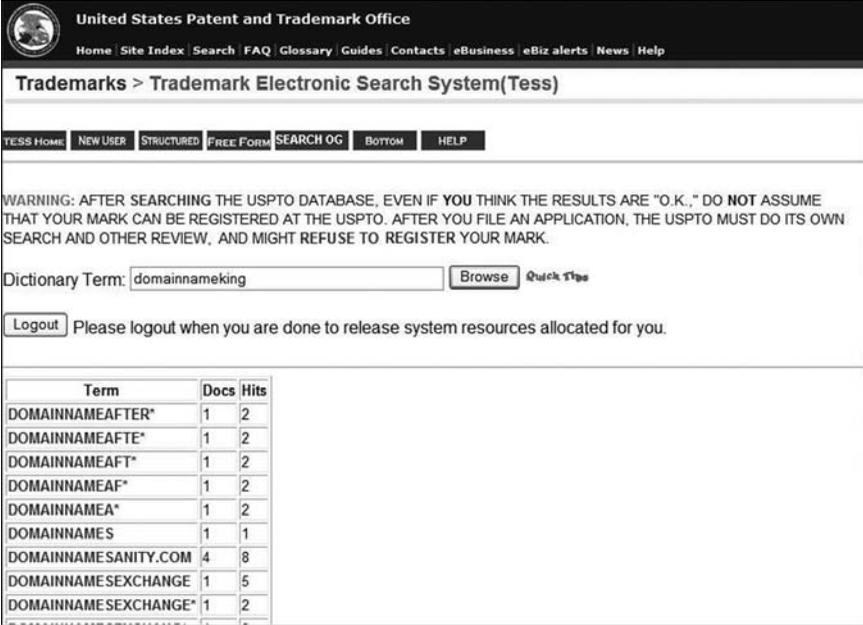
other interoffice trademark activity. As a final searching tool, you may wish to check your search terms within the *OG* to avoid any last-minute surprises.

## Browse the Dictionary

The dictionary is an alphabetical listing of all the marks that appear in the TESS database. Assume that you wish to search for the mark “Domain Name King.” Simply click the “Browse Dictionary” link and enter the name “domainnameking” as one word in the search box. Click the Browse button, and you’ll see the page set out below.

By obtaining a listing of marks that alphabetically precede and follow the name you’re searching, you can get a quick overview of marks that are alphabetically close to yours.

Sometimes you will encounter a list of marks in the dictionary that starts with the full word and then shows the same word several times with a decreasing number of letters at the end. For example, browsing for the word “domain” also shows domainalyzer, domainalyzer\*,



United States Patent and Trademark Office

Home Site Index Search FAQ Glossary Guides Contacts eBusiness eBiz alerts News Help

Trademarks > Trademark Electronic Search System(Tess)

TESS HOME NEW USER STRUCTURED FREE FORM SEARCH OG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

Dictionary Term:   [Quick Tips](#)

Please logout when you are done to release system resources allocated for you.

Term	Docs	Hits
DOMAINNAMEAFTER*	1	2
DOMAINNAMEAFTE*	1	2
DOMAINNAMEAFT*	1	2
DOMAINNAMEAF*	1	2
DOMAINNAMEA*	1	2
DOMAINNAMES	1	1
DOMAINNAMESANITY.COM	4	8
DOMAINNAMESEXCHANGE	1	5
DOMAINNAMESEXCHANGE*	1	2

domainalyze\*, Domainalyz\*, and domainaly\*. The terms with the asterisks in this example are not registered marks but rather are roots of the term “domainalyzer” and show up in the index for search purposes only. Terms with asterisks that follow a term without an asterisk may safely be ignored.

## Understanding the TESS Structured Form Search

First let’s look at the Structured Form Search page (below).

### Search History

The first active link is titled View Search History and is designed to keep track of your searches so you can easily go back over ground that you covered before. Each previous query is identified with a number, as in s1, s2, and so on. You can reproduce the search by simply entering the search number into the first Search Term box. But beware. The system

The screenshot displays the USPTO TESS search interface. At the top, there is a navigation bar with the USPTO logo and the text "United States Patent and Trademark Office". Below this, a secondary navigation bar contains links: Home, Site Index, Search, FAQ, Glossary, Guides, Contacts, eBusiness, eBiz alerts, News, Help. The main heading reads "Trademarks > Trademark Electronic Search System(Tess)".

A secondary navigation bar includes: TESS HOME, NEW USER, FREE FORM, BROWSE DICT, SEARCH OG, BOTTOM, HELP. Below this is a warning message: "WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE 'O.K.,' DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK."

The search form includes:
 

- View Search History:** A dropdown menu.
- Records Returned:** A dropdown menu set to "100".
- Plurals:** A dropdown menu set to "No", with a "Quick Tips" link.
- Search Term:** Two input fields.
- Field:** Two dropdown menus, both set to "ALL".
- Operator:** A dropdown menu set to "OR".
- Buttons:** "Submit Query" and "Clear Query".
- Logout:** A button with the text "Please logout when you are done to release system resources allocated for you."

A final navigation bar at the bottom contains: TESS HOME, NEW USER, FREE FORM, BROWSE DICT, SEARCH OG, TOP, HELP. At the very bottom, a footer link reads: | HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY.

will kick you off after 15 minutes of inaction, and when you are kicked off, your search history goes away. Unfortunately, you cannot save your search history from one session to another.

## Records Returned

This drop-down menu gives you the option of returning 50, 100, or 200 records as a result of your search. The default is 100, and there is little reason to change it unless your search results indicated a larger number of records meet your search specifications.

## Plurals

This drop-down menu allows you to automatically retrieve the plural as well as singular forms of words that you enter into the Search Term boxes. The default choice is No, but most searchers will want to change this to Yes unless using the truncation feature.

## Search Terms

The Structured Form Search lets you search for one or two terms. The terms can be individual words, or they can be phrases. You may only need to search for one term. For instance, if your proposed mark is Mandalay, initially to be used with your famous lemon pies, you might want to search only for the word “Mandalay,” the distinctive element of your name. If so, you would enter that word in the top search box and then click “Submit Query.” Or, if you want to see if there are any marks containing the phrase “lemon pie” in connection with Mandalay, you could enter “lemon pie” surrounded by quotation marks in the top search box and Mandalay in the bottom box. (See below for how to use the Operator feature.)

Incidentally, because you might want to expand the use of Mandalay to other types of pies or baked goods, the most appropriate search in this context would be Mandalay in Class 30 (baked goods). (See Chapter 6, “How to Evaluate the Results of Your Trademark Search,” for more on the trademark classification system.)

## Field

This drop-down menu lets you specify which specific fields of the TESS database records you want to search. Every trademark record has a number of fields, including the trademark's owner, its registration date, its registration number, the description of goods or services that the mark is used to market, and the classification assigned to the mark by the PTO. If you want to focus on records that show your search terms in the marks themselves, then you should choose the Basic Index field. However, if you wish to produce every record that contains your search terms regardless of which field they occur in, select the ALL fields option.

If you are searching for two terms, you can choose separate fields for each term. For instance, you might want to use the Description of Mark field for the term in the top box and the Basic Index field for the term in the lower box.

## Logical Operators

If you enter terms in both the top and bottom Search Term boxes, you'll need to pick what's called an "operator" to connect them. You can use the drop-down menu to choose among the available operators.

### The AND Operator

If you select AND from the pull-down menu of operators, you are telling TESS to pull up all trademark records that contain both of the search terms entered in the Search Term boxes. For example, the search query "mandalay AND lemon pie" will produce every record that contains both "mandalay" and "lemon pie." It will not produce a record that doesn't have both. The advantage of using AND is that you can narrow your search to only those marks that have both terms. The disadvantage to AND is that you won't get any marks that don't have both terms as you have entered them in the Search Term box, which means you might miss marks that you should know about. For example, if you require the search results to contain both "mandalay" and "lemon

pie,” you would miss all marks that contain “mandalay” but not “lemon pie” and likewise all marks that contain “lemon pie” but not “mandalay.”

### **The OR Operator**

If you enter these same search terms but select the OR operator—making your query “mandalay OR lemon pie”—your search will produce a list of all trademarks with the term “lemon pie,” all trademarks with the term “mandalay,” and all trademarks with both terms. Needless to say, that list would be very long, because so many trademarks are likely to have either term in them.

However, this approach can be very useful if your proposed mark contains two distinctive words and you want to review every trademark that has either word. For instance, suppose you’re considering the mark AnalogAstromaps for a website featuring a series of star charts. You would most likely want to use the OR operator to search for any trademarks containing either “analog” or “astromaps.” Any trademark with either term might knock out your proposed mark if the context showed a likelihood of customer confusion.

Although the OR operator has the advantage of inclusiveness—that is, you are less likely to miss a relevant mark than when you are using the AND operator—it can have the disadvantage of producing much too long a list of marks to intelligently assess. The more common the terms being searched, the greater the risk of an unwieldy list of results. Probably the best approach is to initially use the OR operator and see what turns up. If the resulting list is too long, you can retreat to the more restrictive AND operator.

### **The NOT Operator**

A third operator—NOT—can be used to exclude from the search results any term you enter in the lower Search Term box. For instance, you may decide that you want to see every trademark with the term “astromap” but no trademark with the term “starchart.” This search query would look like this: astromap NOT starchart.

## The XOR Operator

A fourth operator—XOR—lets you search for any trademark that has either the first Search Term or the second Search Term, but not both. For example, if you searched for “analog XOR astromap,” your search would turn up trademarks with either “analog” or “astromap,” but not trademarks that contain both terms. There is seldom a reason to exclude a combination of two terms.

## Additional Operators

TESS also provides additional operators that are most appropriate for searching fields in the trademark records that contain whole sentences or paragraphs. For instance, you can specify that the two terms you enter in the boxes be in the same sentence (WITH) or paragraph (SAME), or within a certain proximity of each other (for instance, within two words of each other in any order (NEAR), or in the order specified (ADJ)). You will find these operators most helpful if you want to search the “Goods and Services” or “Description of Mark” fields. For most trademark searching purposes, however, the AND, OR, and NOT operators should be sufficient.

## Tips on Using the TESS Structured Form Search

As mentioned, TESS provides help for each aspect of the Structured Form Search. However, there is always room for improvement. The tips we outline here are specifically intended for basic trademark searching. As you get more familiar with TESS, you should feel free to experiment with the many options it offers.

## Focus on the Most Distinctive Part of the Mark You’re Searching

You should focus on the part of your mark that is most distinctive because it is that part of your mark that would most likely cause

customers to confuse your name with an existing trademark using that same term. For instance, if your proposed mark is Zoroaster Designs, the word to use in your search is “Zoroaster,” because it is by far the more distinctive of the two words. “Designs” is a generic word that can be used in a lot of different trademarks without creating customer confusion. So, although you may wish to search for any mark that contains either “designs” or “Zoroaster”—just to see what’s out there—you are primarily interested in “Zoroaster.”

## Search for Distinctive Syllables

It is wise to go a step farther and search for marks that contain one or more of the distinctive syllables in your name. For example, if your proposed mark is Bioscan, you should search for trademarks that contain either “bio” or “scan,” because you might turn up something similar like “biosearch” or “cellscan.” But it wouldn’t make much sense to search for marks containing syllables that wouldn’t likely be used. For example, the syllables “ga,” “zoon,” and “tite” (as in the website gazoontite.com) are not nearly as likely to be used in existing marks as are “bio” or “scan.”

## Don’t Use the .com in Your Search

There are two reasons you may be searching for conflicts for your proposed domain name. You may be seeking to federally register your domain name, or you may be seeking to determine if your proposed domain name (regardless of whether you will federally register it) will conflict with a registered trademark. In either case, when checking for trademark conflicts with domain names, the best approach is to separate the domain name into its various components and search only for the distinctive components.

For instance, if your domain name were zoroasterdesigns.com, you should start your search with “Zoroaster.” That search would turn up all federally registered Zoroaster marks (including those with the .com or any other top-level domain name suffix such as .org or .net). This is especially important when choosing a domain name because the owner

of a federally registered mark can stop you from using a similar mark as your domain name if you are offering similar products or services. For example, the owner of the federally registered mark Zoroaster Furniture might be able to stop your use of zoroasterdesigns.com if your website offered furniture or similar goods.

Keep in mind that even though a large number of domain names are being registered as marks, for example, priceline.com, it is the portion of the name to the left of the dot that will create the trademark conflict. The PTO requires that the registrant disclaim the “.com” portion of the mark because it is a generic term. This is true for all top-level domains such as .org, .net, and the new top-level domains, such as .biz, .info, and .name. (For more information on registering domain names as trademarks, see Chapter 7, “Federal Trademark Registration.”)

## Searching for Phrases

As we saw with the lemon pie example, you can use two or more words as a single search term by enclosing them in quotation marks. For example, a sensible search for “Big Daddy’s Sweet Tooth Donuts” would include a search for the phrase “Big Daddy’s” and the phrase “Sweet Tooth.” You would do this by entering:

- “Big Daddy” in quotation marks in the upper Search Term box and
- “Sweet Tooth” in quotation marks in the lower Search Term box.

If you only want to search for a single phrase, as in “Sweet Tooth Munchies,” simply enter the phrase in quotation marks in the top Search Term box and run the search. Note that you cannot use the truncation feature described below, when enclosing a phrase in quotation marks.

## Use the Truncation Feature Where Appropriate

When you search for a particular term, it’s useful to also search for slight variations of the term—for instance, if you are searching for the word “saber,” you’ll want to know about trademarks using the British spelling, “sabre.” The computer won’t find these variants for you without special

instructions. Fortunately, it's easy to locate slight variations using TESS by using the truncation feature.

### **Right Truncation**

One of the options offered by TESS is what's called word truncation. There is right truncation and left truncation. Right truncation allows you to chop off as much of the right-hand portion of a word as you wish and have the computer search for all words that start with what remains. For instance, instead of wondering whether to search for "sabre" or "saber," you could search for all trademarks that contain the root segment "sab." This would pull up both variations of "saber" but would also produce unrelated terms, such as "sabbath." To create this truncation effect, simply put an asterisk at the end of the string of letters that you want to search, as in "sab\*."

If you are using right truncation, turn off the plural function. You can do this by choosing "No" from the drop-down menu above the Field box. Otherwise, the search engine will become confused. In addition, you cannot use the truncation feature when enclosing a phrase in quotation marks. For example, the TESS system will not retrieve truncations for the phrase "Big Daddy\*" when it is enclosed in quotation marks.

### **Left Truncation**

If you use left truncation, for example "\*time," the search results will produce all marks that have words to the left of "time," for example Drive Time, Doubletime, Bed Time Stories, and Comfy Time. Unlike right truncation, the plural function works fine with left truncation.

### **Using Both Left and Right Truncation**

TESS allows you to search for words that have both left truncations and right truncations. For instance, if you want to use the word "Geezer" in your mark, you might want to do a search for all marks that contain the "eez" portion of the word, because all marks with those three letters will resemble each other at least a little bit. You would get this result by truncating "eez" with an asterisk on both sides, as in \*eez\*. Again, remember to turn off the plural function.

## Wildcards

TESS also allows you to substitute “wildcard” characters for specific letters in a word. For instance, if you want to search for all occurrences of women or woman, you should enter the search term wom?n, which would retrieve both words because the question mark stands for any character in that particular position.

TESS comes with an entire set of wildcards, such as characters that stand for vowels, consonants, and the like. As you become more familiar with trademark searching in the TESS system, you’ll pick these up.

## Search for Sound-Alikes

In addition to searching for names that are similar to yours in appearance, it is also important to search for words that sound alike. For example, gazoontite.com and gesundheit.com don’t look that much alike, but they sound identical and might well confuse customers. The best approach to searching for sound-alikes is to focus on the most distinctive syllables in the proposed mark and search for these by themselves. You might pull up a longer list of marks than you want to deal with, but if you do find a mark that sounds like yours and is in use with goods or services that are commercially related to yours, you would do well to choose another mark.

If you are using the TrademarkScan Autoquery search that is available through SAEGIS, you will find that the search automatically searches for sound-alikes.

## Search for Foreign Translations

If your mark has exactly the same meaning as another mark in a different language, the owner of the other mark can challenge your mark if it can be shown that customers would likely be confused. For instance, if you wanted to name your restaurant The Milkhouse and somebody already had a mark for Casa de Leche, you have the potential for a trademark infringement charge. The bad news is that there is no do-it-yourself trademark search system that pulls up translations. The good news is that these types of conflicts are relatively rare. If you are

using distinctive terms in your mark that have an independent meaning (which would be the case with arbitrary or suggestive marks), consider using a foreign language dictionary to find translations and then search for those as well as your proposed mark.

## Trademark Searching With TESS: An Example

Here we provide an example of a typical search using TESS. In this case we are searching for the term “Hooky Wooky” for use as a trademark for crafts products, specifically crocheted clothing and accessories.

We start by using the Structured Form Search and enter “Hooky” in the top Search Term box and “Wooky” in the lower Search Term box. We choose “Yes” for plurals and choose “AND” from the pull-down menu of operators and change the drop-down menu for fields to “Basic Index.”

The search results show no registered trademarks using the combination of terms. Next, we search for each term separately. We perform a search just for “wooky” and get no results.

United States Patent and Trademark Office

Home Site Index Search FAQ Glossary Guides Contacts eBusiness eBiz alerts News Help

Trademarks > Trademark Electronic Search System(Tess)

TESS HOME NEW USER FREE FORM BROWSE DICT SEARCH OG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

View Search History:

Records Returned: 100 Plurals: Yes Quick Tips

Search Term: Hooky Field: Basic Index (combined MP+PM+MN) Operator AND

Search Term: Wooky Field: Basic Index (combined MP+PM+FM)

Please logout when you are done to release system resources allocated for you.

TESS HOME NEW USER FREE FORM BROWSE DICT SEARCH OG TOP HELP

| HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY

We perform another search, this time using “hooky” in the top Search Term box and leaving the lower Search Term box blank. This time, the search turns up 11 items that use the word “hooky.”

Of the 11 entries (at the time we did the search), five are listed as “live” and six are listed as “dead.” Live means that the mark is either registered or pending registration, whereas dead means that the mark used to be in the system as a registered or pending mark but has since been canceled or abandoned.

The classes of goods listed for the five live trademarks are as follows: hand knitted children’s clothing, wall hooks, spiral binding machinery, indoor and outdoor action games, and golf clubs.

Except for “Playing Hooky” for hand knitted children’s clothing, the other uses of “hooky” will not conflict with our intended use since they are for different goods. “Playing Hooky” is a red flag since it is for knitted clothing. The issue in making a final decision is whether consumers would be able to easily distinguish “Playing Hooky” from

The screenshot shows the USPTO TESS search results page. At the top, there is a navigation bar with links for Home, Site Index, Search, FAQ, Glossary, Guides, Contacts, eBusiness, eBiz alerts, News, and Help. Below this, the page title is "Trademarks > Trademark Electronic Search System(Tess)".

The search results are displayed in a table with the following columns: Serial Number, Reg. Number, Word Mark, Check Status, and Live/Dead. There are 11 records found, with 5 live and 6 dead.

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	78657928	PLAYING HOOKY	TARR	LIVE
2	78387207	LET'S PLAY HOOKY	TARR	DEAD
3	76522831	2960373 HOOKIES	TARR	LIVE
4	76406134	2784876 HOOKY	TARR	LIVE
5	76381978	2706635 WALLHOOKY.COM	TARR	LIVE
6	74045098	1631736 PLAYN HOOKY	TARR	DEAD
7	73650429	1460223 HOOKY	TARR	LIVE
8	73368437	1251682 HOOKY!	TARR	DEAD
9	73219313	1161650 HOOKY	TARR	DEAD
10	73178028	1162760 TIGER HOOKIES	TARR	DEAD
11	72157481	0766990 HOOKY	TARR	DEAD

Below the table, there is a navigation bar with links for TESS HOME, NEW USER, STRUCTURED, FREE FORM, BROWSE DICT, SEARCH OG, PREV LIST, NEXT LIST, TOP, and HELP.

“Hooky Wooky.” Considering that both trademarks are plays on the tools of knitting and crocheting (hooks), we conclude that the term is probably suitable for our intended use. In addition, our research shows that the Playing Hooky mark has not yet been registered by the USPTO (it’s been approved but not yet used in commerce). There is always the possibility that it may not proceed to registration, so more information is needed.

Finally, although it doesn’t necessarily reflect on federal registration, we check with Register.com ([www.register.com](http://www.register.com)) and find that the domain name [hookwooky.com](http://hookwooky.com) is unavailable for domain name registration. A company in Japan owns it although they are presently not using it. Alternates such as [hookywooky.net](http://hookywooky.net) and [hookywooky.org](http://hookywooky.org) are available.

### Timed Out by TESS

To maintain its system resources, the TESS program will terminate your searching session after 15 minutes of inactivity. All searches and results will be lost, and you will receive a message: “This search session has expired. Please start a search session again by clicking on the TRADEMARK icon, if you wish to continue.” You must exit and reenter TESS to continue searching. If you wish to save searches, you can use the “save” feature of your browser and save the results in an HTML file.

## Understanding the TESS Free Form Search

The TESS Free Form Search lacks the ease of the Structured Form Search but adds a substantial degree of flexibility. Let’s first take a look at the Free Form Search (see below).

The Free Form Search page resembles the Structured Form Search page, with two major differences:

- Instead of separate Search Term boxes, the page provides one box that permits the construction of complex search queries.

United States Patent and Trademark Office  
 Home Site Index Search FAQ Glossary Guides Contacts eBusiness eBiz alerts News Help

Trademarks > Trademark Electronic Search System(Tess)

TESS HOME NEW USER STRUCTURED Browse Dict SEARCH OG BOTTOM HELP

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

View Search History:

Records Returned: 100  Plurals: No  [Quick Tips](#)

Search Term:

Please logout when you are done to release system resources allocated for you.

**US Trademark Field Codes**

Code & Name	Code & Name	Code & Name
[AD] Abandonment Date	[IC] International Class	[RD] Registration Date
[AF] Affidavits	[IR] International Registration Number	[RE] Renewals
[AR] Assignment Recorded	[LD] Live/Dead	[RG] Register
[AT] Attorney of Record	[MD] Mark Drawing Code	[RN] <a href="#">Registration Number</a>
[BI] Basic Index	[MI] Mark Index	[SF] Section 44 Indicator
[CB] Current Filing Basis	[MN] Mark Non-Punctuated	[SD] Single Design Code
[CC] Coordinated Class	[MP] Mark Punctuated/Word Mark	[SN] Serial Number
[CD] Cancellation Date	[OB] Original Filing Basis	[SO] Serial - Other Formats
[CR] Change in Registration	[OD] Other Data	[ST] Standard Characters Claimed
[DC] Design Search Code	[ON] Owner Name	[SR] Supplemental Register Date
[DD] Design Description	[OW] Owner Name and Address	[TD] Total Designs
[DE] Description of Mark	[PD] Priority Date	[TF] Distinctiveness Limitation Statement
[DM] Decimal Mark	[PF] Physical Filing Date	[TI] Translation Index
[DS] Disclaimer	[PO] Published for Opposition	[TL] Translation
[FD] Filing Date	[PM] Pseudo Mark	[TM] Type of Mark
[FM] Full Mark	[PI] Pseudo Mark Index	[UD] Update/Load Date
[GS] Goods and Services	[PR] Prior Registrations	[US] US Class

TESS HOME NEW USER STRUCTURED Browse Dict SEARCH OG TOP HELP

- The bottom of the page sets out the various fields that are available for searching and provides hypertext links to descriptions of these fields.

## Using the Free Form Search Box

Probably the most important feature of the Free Form Search option is that you can combine Boolean operators (unlike the Structured Form Search that only gives you one Boolean operator for your entire query). For example, suppose your proposed domain name is MiracleMediations.com. You may have started out with the Structured

Form Search entering “mirac\*” in the top Search Term box and the term “mediat\*” in the bottom box. You choose the AND operator to search for trademarks that contain both terms.

This search is a good start, but as you review your search results, you realize that you want to search for trademarks that contain the word “arbitration” as well. To do this, you use the Free Form Search to create a new search query that looks like this:

“mirac\* [bi]” AND “mediat\* [bi]” OR  
“arbitrat\* [bi]”

This search expression tells the computer that you want all trademarks that appear in the Basic Index and that contain a variant of the truncated term “mirac\*” and either the term “mediat\*” or the term “arbitrat\*.”

## How to Use the Field Codes

The [bi] that follows the truncated terms is what’s known as a field code. The Free Form Search requires the use of these field codes if you want anything other than an “all fields” search. For instance, if you want to search for all marks owned by a particular company, you can use the field code [on] in connection with the company’s name. Similarly, use of the field code [gs] lets you search for all marks that are used on goods or services containing the terms you use in your search query.

You aren’t limited to one field code. You may search in as many fields as you wish. For instance, you will get a deeper search by combining the [bi] and [ti] fields. (The “ti” field contains English equivalents to foreign words or characters used in a trademark.) You combine fields for each term by separating the fields with a comma, as in geezer [bi,ti]. In fact, in the help it provides for TESS, the PTO seems to suggest that when you are using the Free Form Search to find occurrences of a term in a trademark (as opposed to one of the other types of fields in a trademark record), you search both the “bi” and “ti” fields.

For more on field codes, use the table that appears on the Free Form Search page and click whatever field code you wish to know more about.

## Understanding the Results of Your Search

It's one thing to search for marks using TESS; it's another to understand what is reported back to you. The screen shot below indicates one of the reported items from our Hooky Wooky search.

### Understanding the Report Returned by a TESS Search

Let's take a few moments to interpret the various lines of information on one record the screen shot above.

**Word Mark:** This shows the mark as registered (or as shown in the trademark application if the mark is pending).

**Goods and Services:** This line identifies the international classifications (the IC class) under which the mark is registered and provides brief descriptions of the underlying goods and/or services. In this case, the mark is registered under International Classification 007. The U.S. classifications following the international classification are artifacts of an earlier time when the United States had its own classification system. (See Chapter 6, "How to Evaluate the Results of Your Trademark

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DCT	BOTTOM	HELP	PREV LIST	CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC
LAST DOC														
Logout Please logout when you are done to release system resources allocated for you.														
Start List At: <input type="text"/> OR Jump to record: <input type="text"/> <b>Record 3 out of 10</b>														
<b>Check Status</b> (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)														
<b>Typed Drawing</b>														
Word Mark HOOKY														
Goods and Services IC 007, US 013 019 021 023 031 034 035, G & S: Machines for spiral, double-loop and elastic comb binding, FIRST USE: 19821031, FIRST USE														
Mark Drawing Code (1) TYPED DRAWING														
Serial Number 76406134														
Filing Date May 3, 2002														
Current Filing Basis 1A														
Original Filing Basis 1B														
Published for Opposition November 12, 2002														
Registration Number 2784876														
Registration Date November 18, 2003														
Owner (REGISTRANT) Boyadjian, Hratch INDIVIDUAL SWITZERLAND OBSTGARTENSTR. 8 CH-8703 ERELENBACH SWITZERLAND														
Attorney of Record Brian J. McNamara														
Type of Mark TRADEMARK														
Register PRINCIPAL														
Live/Dead Indicator LIVE														
PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DCT	TOP	HELP	PREV LIST	CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC
LAST DOC														

Search,” where we explain the importance of classes in deciding whether there is a likelihood of customer confusion.)

**Mark Drawing Code:** If the mark consists of words only (even if they are imaginatively arranged or come with stylistic fonts), this line says “Typed Drawing.” However, if your mark consists of a logo with graphical elements, this line will show a set of six numeric characters that reflect how the PTO has classified the logo.

**Serial Number:** This is the number that is assigned to the trademark application by the PTO.

**Filing Date:** This is the date that the application for registration was filed.

**Current Filing Basis and Original Filing Basis:** If, as here, the application was originally filed on an intent-to-use basis (1B), that fact will be indicated here. If the application was filed on an actual use basis (1A), that will be indicated as it is here for the “Current Filing Basis.”

**Published for Opposition:** This line indicates the date the PTO published the trademark application to give the public a chance to oppose the mark (usually on grounds that someone thinks the proposed registration legally conflicts with his or her trademark).

**Registration Number:** This line will only appear if the mark has, in fact, been registered. Pending marks, for instance, do not have a registration number.

**Registration Date:** This line will only appear if the mark has been registered.

**Owner:** This line identifies the person or entity that was named as owner of the trademark in the application and also provides the owner’s address.

**Attorney of Record:** This line indicates the name of the attorney, if any, managing the application.

**Type of Mark:** This line identifies the label given the mark by the PTO. For most purposes, this label makes little difference. However, if two potentially conflicting marks are very similar, but one is a service mark while the other is a trademark, the type of mark may make a difference in terms of whether a legal conflict exists.

**Register:** This line designates whether the mark has been registered on the Principal Register or the Supplemental Register. Marks on the Principal Register get more protection, and marks on the Supplemental Register are deemed by the PTO to be too descriptive to be placed on the Principal Register—which means that the likelihood of a successful infringement action being brought on behalf of that mark is small.

**Live/Dead Indicator:** This line indicates whether the mark is registered or pending, or whether it has been canceled (because of the owner's failure to renew or file statements of continued use) or abandoned in the course of the application.



#### CAUTION

**Even though a mark is labeled as dead, it may in fact be very much alive in the world of commerce** and can spell trouble for you if you adopt a legally conflicting mark. The dead/live label only refers to the mark's status in the PTO, not to whether it is or isn't in actual use in the economy.

## Determining a Mark's Status

Each item page has a link to the PTO's Trademark Application Registration Retrieval database (known as TARR). This database shows the status of the mark (registered, pending, canceled, published for opposition, and so on). When we clicked the Status link to the Hooky item page, we got the status report shown below.

The status report has some of the same information as the item page and also provides a chronological history of the mark's journey through the PTO. This status report is most helpful when you discover a pending mark and want to know where it is in the process.

**Thank you for your request. Here are the latest results from the [TARR web server](#).**

**This page was generated by the TARR system on**  
2005-05-28 19:46:36 ET

**Serial Number:** 76406134

**Registration Number:** 2784876

**Mark (words only):** HOOKY

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2003-11-18

**Filing Date:** 2002-05-03

**Transformed into a National Application:** No

**Registration Date:** 2003-11-18

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 114

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 -File Repository (Franconia)

**Date In Location:** 2004-01-21

---

#### GOODS AND/OR SERVICES

---

**International Class:** 007

Machines for spiral, double-loop and plastic comb binding

**First Use Date:** 1982-10-31

**First Use in Commerce Date:** 2001-09-30

**Basis:** 1(a)

---

#### PROSECUTION HISTORY

---

2003-11-18 - Registered - Principal Register

2003-09-25 - Allowed for Registration - Principal Register (SOU accepted)

2003-09-25 - Case file assigned to examining attorney

2003-09-24 - Case File in TICRS

2003-08-04 - Statement of use processing complete

2003-08-04 - Amendment to Use filed

2003-08-04 - PAPER RECEIVED

2003-02-04 - Notice of allowance - mailed

2002-11-12 - Published for opposition

2002-10-23 - Notice of publication

2002-09-10 - Approved for Pub - Principal Register (Initial exam)

2002-08-26 - Case file assigned to examining attorney

## An Introduction to SAEGIS— A Fee-Based Search System

Although it is officially known as SAEGIS on SERION ([www.serioninfo.com](http://www.serioninfo.com)), we'll refer to this service simply by its commonly known name, SAEGIS. Accessible via the Thomson CompuMark website or via Dialog or Westlaw, SAEGIS is a Web-based trademark search interface that provides access to a number of useful databases for a fee. In addition to the federal trademark database, which TESS also uses, SAEGIS lets you search state trademark databases and trademark databases of selected foreign countries. In addition, SAEGIS offers a search of Web pages and all domain name registries. The fees at SAEGIS depend on the type of search you do and the number of trademarks called up by your search that you decide to review.

Before you can use SAEGIS, you'll need to register online. Registration is free, but they will promptly ask you by phone for a credit card number in case there is a problem with the billing. You will then be sent a user name and password by email. Once you have those, you can get into the system, read the help and, short of actually finding trademarks, explore how the system works without charge. We recommend that you download the help and study it before you get on the system for real. Also, a few days after you register, SAEGIS sends you its Subscriber's Guide that will prove very helpful in understanding how to use this powerful tool.

There are two basic approaches to using SAEGIS for searching the U.S. and state trademark databases:

- TrademarkScan Autoquery, and
- TrademarkScan Custom Search.

### TrademarkScan Autoquery

TrademarkScan Autoquery will produce a competent analytical search for less than any of the professional search services we are familiar with.

To use TrademarkScan Autoquery, you:

1. Select the database you want to search (federal, federal and state, state, or one or more foreign databases).

2. Enter your trademark.
3. Enter one or more international classes.
4. Provide a description of your goods or services.

You can then preview what your entries will pull up. As you will see from this preview, TrademarkScan Autoquery will not only search for an exact match but also rotates prefixes and suffixes and breaks down your proposed mark in other ways that might produce registered marks of interest. You can use this preview to pare down the search to 75 marks or even modify the information you entered in the boxes to obtain a more precise search. For instance, if you were searching for Nolo, you could eliminate the search query that reports all instances of when Nolo occurs in the middle of the mark, as in “technology,” or at least limit the number of marks reported in that particular query by restricting your search to the most appropriate classes.

Though TrademarkScan Autoquery is thorough, this very thoroughness may end up costing you a bundle, because you will be charged per extra mark reviewed. Fortunately, at any time during the search, you can check your online account to review the charges associated with your current search session, so you can keep track of the costs and modify your search strategy accordingly.

## **TrademarkScan Custom Search**

The TrademarkScan Custom Search provides more flexibility per mark searched but requires more skill from you in crafting your search query. You will be charged per mark that your search produces for your review. To save money and use the TrademarkScan Custom Search efficiently, we recommend that you wait until you receive your Subscriber’s Guide and then use that resource to learn the ropes.

## **Browsing the Index**

Like TESS, you can browse the database alphabetically for free and see what comes before and after your proposed mark. While this can be useful, remember that you are only viewing marks where your term

comes at the beginning. For instance, if you search for Rabbit, you will see a list of marks that start with Rabbit, but you won't see marks such as Hip Rabbit or Run Rabbit Run.



#### CAUTION

**TrademarkScan Custom Search can empty your pockets fast.**

Make sure you spend adequate time learning how to use this tool and pay close attention to your search queries so that you don't pull up any extraneous marks. Each time you are about to take an action, TrademarkScan will alert you to the potential cost and give you the opportunity to pare your search back to an affordable level. As a general rule, we recommend that you use great caution when using this search engine.

## Searching for Designs

So far, we have focused on how to search the U.S. trademark database for marks made up of words. However, many trademarks consist of or contain graphic elements that word searches don't accommodate. Design marks, as these types of trademarks are referred to, must be searched by using a set of codes assigned to them by the PTO upon registration. The codes describe various types of graphical elements and are publicly available in a publication known as the *Design Search Code Manual*, available on the PTO's site.

To search for other possible instances of a design mark that you wish to use, you must first figure out the code for the design elements that your mark incorporates, and then enter this code in the search box (for either the Structured or Free Form Search) and select the Design Search Code field (DC).

Trademarkia ([www.trademarkia.com](http://www.trademarkia.com)) also offers a method of searching the USPTO database for logos. The interface is a little simpler and it can locate logos by identifying the elements (dog, tree, house) or the words used with the logo.

## Searching State-Registered Trademarks and Trade Names

To search for trademarks on state trademark registers, you must check the registers for each state. (For information about determining how many state registers to search, see Chapter 4.) Usually, you will only search in your own state. But if you plan to operate in several states, you would want to check each. If you decide to search in more than a few states, you would be smarter to have your trademark search done by a professional or to search state trademark databases by computer.

The method for doing a search for state-registered trademarks varies from state to state. Many states will do a preapplication search for you by phone, either for free or for a small charge. In other states, request a search by mail. In still others, the PTO will not search for you but will let you peruse the microfiche or loose-leaf lists of registered trademarks in person. The state agency in charge of trademarks is generally within the department of state, the department of corporations, or the department of revenue.

Regardless of who does it or how the search is performed, state trademark agencies provide limited types of search services—most commonly marks can only be searched in alphabetical order. Sometimes they are broken down by classes of goods or services. (In Chapter 6, “How to Evaluate the Results of Your Trademark Search,” we explain that all trademarks are assigned classes when registered.) If so, you will need to specify which class to search.

The main drawback to state searches is that state laws vary somewhat about what constitutes a conflict with a registered trademark. This means the criteria state uses to conduct its search may not be the same as federal or common law criteria. As a result, while obtaining a state clearance probably means there are no directly identical marks in your class, it may not give you any assurance that your trademark does not legally conflict with other marks in that state. When searching state trademarks, the same principles apply as for searching the

federal trademark register—look for synonyms, homonyms, phonetic equivalents, and so on, both in your class and in as many other classes as might be relevant.

## Searching for Trade Names and Unregistered Marks

The goal here is to make sure your mark won't conflict with a trade name or corporate name in use in your state. Although trade names, used solely to identify businesses, do not have all the same kinds of rights attached to trademarks (for instance, unlike trademarks, they cannot be registered), they can be protected by unfair competition law. For example, a company can sue you if you use their trade name as a mark in a way that causes the public (or suppliers) to confuse you with them. Also, if the trade name is being used as a mark but is not registered as such, a search of one of the trade name indexes we describe below may result in discovering a mark that no other search method would have brought to your attention. In short, you will need to make sure your mark is not going to conflict with a registered corporate name or unregistered trade name by searching all sources of trade names that you can reasonably find.

One good way to search for a trade name conflict is to make sure no corporation registered in your state already uses the name. You can do this via a phone call or letter to the agency in charge of corporations, usually the department of corporations or the secretary of state. (See Chapter 1 for more about corporate names.)

The fact that you have already incorporated and wish to use your corporate name as your mark does not mean you should skip a trade name search. When you incorporated, your proposed corporate name was checked against other corporate names, not against trademarks or any other trade names. So you still need to check how it compares to marks, other trade names, and perhaps even corporate names in other states if your mark will have a presence in those states.

## Telephone Directories

The purpose of this search is to find unregistered service marks and trade names acting as service marks that are currently in use. Telephone directories are excellent sources for these. Most of the major Internet search engines provide access to yellow page-type database, for instance, SuperPages or Google (www.google.com). Most large city public libraries also have a complete selection of white and yellow pages for all the major cities in the country and for all the areas in your state. If yours doesn't, enlist the aid of the librarian in finding a library that does. (In that case, you will also need his or her help in locating the other books you'll need for a trademark search.) At a minimum, you should consult all the phone books for your marketing area. This is a big task, recommended mostly for those who want the greatest degree of certainty possible that no conflicts exist, so decide if you really need to do it before starting, or hire a helper.

## Trade Associations/Directories

Trade associations are usually limited to a particular field. Find the association for the field you plan to use your mark in (your library's reference section will have a guide to associations), and examine its directory. This should provide you with a good idea of whether the mark is already in use. You may already be familiar with relevant trade associations or directories in your fields, or you may have to go to the library card catalog or computer index and look under several relevant subject headings to find them. Most types of businesses, from anchovy fishermen to zoo suppliers, will have them, but a few small or new endeavors won't. Contact the chamber of commerce or your librarian for further help in tracking them down. For example, the trade journals *Candy Industry* or *Candy Marketer* would help you find trademarks and names in use among candy manufacturers.

## Business Directories

Several publishers compile business directories that cover all businesses. They contain lists of as many business names and marks as the authors can find. One example is *Brands and Their Companies* (formerly the *Trade Name Dictionary*), published by Gale Research Co., a guide to over 220,000 consumer-oriented trade names, brands, and marks with the names and addresses of the companies to which they belong, compiled from trade journals and direct contact research. Another is the *Trade Name Index/Standard Directory of Advertisers*, published by the National Register Publishing Company, which contains over 62,000 of the better-known trade names and trademarks currently in use by national advertisers. A third is the *Thomas Register of American Manufacturers*, which has names and brands listed by business category, also available online at [www.thomasregister.com](http://www.thomasregister.com).

You will want to examine these in your class or field, for direct conflicts as well as similar-sounding or -looking names, applying the same criteria we discussed for online federal trademark searching. Because here you are working in alphabetical order, you will have to remember to make separate checks on synonyms, variations in spelling, and punctuation and other differences. (See Chapter 14, “Help Beyond This Book,” for other resources.)

## Google

Google ([www.google.com](http://www.google.com)) is an invaluable tool when searching for common law marks. Google offers two modes of search: basic and advanced. If you're using the Google Toolbar—a feature that provides a searching window on your Internet browser—you can access the Advanced Search mode by clicking the word “Google” and choosing Google Links, Advanced Search from the drop-down menu. If you're on the Google search page, click Advanced Search.

The Advanced Search mode relies on the same Boolean approach to keyword searches described in this chapter. As a general rule, you'll do a better search if you use the advanced mode rather than the basic mode (Google Search). However, because we want to give you a search methodology that doesn't require much of a learning curve, we'll use the Google Search mode for most of this section.

When performing searches with Google, here are some tips and tricks to keep in mind:

- **Google ignores many common words and characters.** Google disregards words such as “where,” “the,” “how,” “why,” and some single digits and letters. (Google believes these slow down your search without improving the results.) You can see which words are ignored on the search results page—for example, if you type this search: “Who is the owner of the Shasta trademark?” Google will tell you that the words “who is the” were not included in your search. So if the mark you are searching for contains a common word such as “the,” “what,” and so on, put a “+” sign in front of it. For example, if you were searching for Lover of Salsa, type “Lover +of Salsa.” (Be sure to include a space before the “+” sign.)
- **You can make Google search for synonyms.** If you want to search not only for your search term but also for its synonyms, place the tilde sign (“~”) immediately in front of the search term. For example, if searching for Lover of Salsa and you wanted to find similar or related products, you might type, “Lover +of ~Salsa”
- **You can search for a range of numbers.** If you want to obtain results within a numerical range—for example, you want to use *10 Decibels* as the name of your record company, but you want to check any other uses of numbers with the word “decibel,” just include the range of numbers, separated by two periods, with no spaces, into the search box along with your search terms. For example, type, “decibels 1..1000.”
- **Use quotation marks for phrases.** Often you'll want results that include an exact phrase, such as *Independence starts with I*. In

this case, put quotation marks around your search terms—for example, “Independence starts with I.”

- **Get rid of multimeaning terminology.** If your search term has more than one meaning, you can focus your search by putting a minus sign (“-”) in front of words related to the meaning you want to avoid. (Be sure to include a space before the minus sign.) For example, let’s say you’re searching for “Pot Luck” but want to avoid common results such as cooking pot, coffee pots, or melting pot. You would type “pot luck -cooking -coffee -melting” and it would eliminate many unnecessary common results.
- 



# How to Evaluate the Results of Your Trademark Search

<b>What's Involved in Evaluating Trademark Search Results?</b> .....	153
The Importance of Avoiding Customer Confusion in Trademark Law .....	153
Likelihood of Customer Confusion Is a Slippery Concept.....	154
Even a Lawyer's Opinion Can't Give You Certainty.....	154
<b>What Is the Likelihood of Customer Confusion?</b> .....	155
Understanding the Likelihood-of-Confusion Test .....	155
Do the Hypothetically Confused Customers Have to Be Reasonable Customers?.....	157
<b>An Overview of How Marks Are Evaluated for Their Potential to Cause Customer Confusion</b> .....	158
<b>How Closely Related Are the Goods or Services?</b> .....	160
An Overview of the International Trademark Classification System.....	161
Fitting Your Goods and Services Into the Appropriate Class .....	163
Marketing Channels .....	169
<b>Do the Goods or Services Compete?</b> .....	170
<b>How Similar Are the Marks?</b> .....	170
<b>Additional Factors</b> .....	171
How Strong Is Each Mark? .....	172
How Much Do the Goods or Services Cost?.....	172
Are the Two Marks Directed Toward the Same Customers?.....	172
Does One Owner Use the Mark on Several Different Products or Services? .....	173
<b>Final Factors</b> .....	174
History of Trademark Infringement Lawsuits.....	174
How Long Has the Allegedly Infringing Business Used the Mark? .....	175

What Did the Alleged Infringer Intend in Adopting and Using the Mark in Question?.....	175
<b>How to Read a Trademark Search Report.....</b>	<b>175</b>
Jump Right In .....	176
Federal Trademark Search.....	177
State Registration Search.....	182
Common Law Report.....	183
Our Conclusions.....	184

This chapter explains how to evaluate the results of your trademark search. It's one thing to search for marks that are the same as or similar to the mark you propose to use for your own business, goods, or services. It's quite another to decide how to proceed once you have the results of the search in your hands.

## What's Involved in Evaluating Trademark Search Results?

If you are choosing a mark, evaluating your trademark search results is essentially a preventive study. You are trying to make sure that your proposed mark qualifies for registration (if you choose to register it) and will be secure against attacks by other trademark owners. If the PTO decides that your mark is confusingly similar to an already-registered mark, registration will be denied your mark. And even if your mark is registered, a trademark owner can successfully sue you in the future if it discovers your mark and convinces a judge that the use of your mark creates a likelihood of customer confusion.

If you already have a mark but are involved in an infringement dispute, you will want to use the material in this chapter to help you sort out whether there is a likelihood of customer confusion caused by the use of the two marks. If not, and the other mark isn't famous, then you are in better legal shape than if the opposite were true.

## The Importance of Avoiding Customer Confusion in Trademark Law

As you probably gathered from previous chapters, the core decision you'll need to make here is whether the simultaneous commercial use of your mark and any marks that your search turns up would likely create customer confusion as to the underlying goods or services or their source. If you conclude that customer confusion would be likely, you'll want to pick another mark. If no customer confusion is likely, then you can feel reasonably confident about using the mark—unless it happens

to be identical or very similar to a mark that the courts would consider famous.

## **Likelihood of Customer Confusion Is a Slippery Concept**

Being able to assess whether customer confusion is likely in a particular situation is a skill that depends as much on experience and intuition as it does on any hard-and-fast principles. Though we can and do explain how the courts generally go about assessing the likelihood of confusion, each case is inevitably unique in some particular. Predicting the future outcome of any given case is definitely an art rather than a science. As we suggest in the book's Introduction, if you are uncertain about the correct course of action after applying our guidelines to your situation, you will be wise to consult with an experienced trademark lawyer. (See Chapter 14, "Help Beyond This Book.")

## **Even a Lawyer's Opinion Can't Give You Certainty**

Even if you consult with a lawyer, remember that trademark lawyers are subject to the same limitation as the authors of this book—that is, there is no firm way to predict the outcome of a trademark dispute should one erupt over your choice of a mark. All a trademark lawyer can do is give his or her professional opinion. But if that opinion turns out to be wrong, it is you and not the lawyer who will face the consequences, with one important exception. A lawyer's opinion that your mark doesn't conflict with a mark on the federal trademark register may save you from a stiff damage award if you go ahead and use the mark and are later sued for infringement.

Knowing that they aren't likely to get in trouble if they act conservatively, most lawyers won't give you the go-ahead if there is much of a chance of a trademark dispute in the future. In short, the lawyer's advice may be both a disservice in that it may be overly cautious and an important service in that you will feel more confident about your choice if it passes the lawyer test.

**CAUTION**

**The discussion in this chapter assumes that any mark you come across in a trademark search is currently being used** and was either (1) put into use or (2) the subject of an intent-to-use application before you started using your mark. In these instances, a conclusion that customer confusion is likely will also portend the results of any trademark infringement suit that is brought against you for going ahead with your proposed mark. If, however, you started using the mark first, or the would-be registrant fails to follow up on an intent-to-use application, the results may be quite different. In this chapter we primarily explore how likelihood of confusion is determined. (In Chapter 10, “Sorting Out Trademark Disputes,” we help you assess the legalities of any trademark disputes that might arise.)

## What Is the Likelihood of Customer Confusion?

You will most likely first encounter the issue of customer confusion if and when you do a trademark search and the results indicate that the same or a similar mark is already being used by another business. Whether or not you should go ahead with your mark depends on whether your use would create a likelihood of customer confusion.

### Understanding the Likelihood-of-Confusion Test

First let’s look at the term “likelihood.” In the trademark context, likelihood means that confusion is probable—not necessarily that it has happened, or that it will happen, but that it is more likely than not that a reasonable customer will be confused by the simultaneous use of two separate marks.

Confusion in this context can mean two different things. Most commonly, it means that the goods or services a customer buys are different than what the customer intended to buy. For instance, if a consumer wants to purchase the services of ABC Emergency Care on the basis of a friend’s recommendation, but he ends up going to ABD

Emergency Room by mistake because of the similarity of the two names, you have an example of customer confusion between the two services.

The other situation that creates customer confusion is where a misleading mark causes the customer to believe—wrongly—that a product or service is sponsored by, approved by, or somehow connected with a business that the customer already frequents or knows about. In other words, the customer is confused about the source of the product or service. This would be the case, for example, if a customer took a TV to a repair shop called IBM Electronics because she thought that IBM somehow sponsored the business.

Just to see how judges apply this likelihood-of-confusion standard, let's examine a hypothetical conflict between two uses of very similar trademarks.

**EXAMPLE:** Ethereal Fragrance Company produces a line of products, including perfume, carrying the distinctive and therefore strong registered trademark Ekbara Scents. These products are marketed in boutiques throughout California and several other western states primarily to women in the middle- and upper-income brackets. The Ekbara mark has been used in this manner by Ethereal for two years when Rubin Santiago of Oakland, California, opens a small printing company specializing in business cards, which he calls Ekbara Cards. The cards are marketed to small businesses in the San Francisco Bay Area. Ethereal claims infringement and demands that Rubin stop using the Ekbara mark on his cards. When Rubin refuses, Ethereal files a trademark infringement lawsuit and seeks a preliminary injunction (an order to bar Rubin from further using the Ekbara mark). There is no question in this case that Ethereal was first to use the Ekbara mark. There is also no question that if use of Ekbara on the cards creates a likelihood of customer confusion, Ethereal is entitled to a court order stopping use of the Ekbara mark in that context. The key point for the judge to decide in this example is, simply, whether Rubin's use of the Ekbara mark creates a likelihood of customer confusion.

In deciding this question, a knowledgeable judge would probably engage in something like the following analysis:

“It is not likely that purchasers of business cards will think a fragrance company is involved in the printing business. Neither business is likely to go into competition with the other. The purchasers of the two products as well as the distribution channels are likely to be quite different. There is no similarity between the two goods in terms of what they accomplish. Ethereal’s customers are unlikely to care who manufactures or distributes business cards. There is no indication Rubin Santiago intended to get a free marketing ride on Ethereal’s mark. By contrast, the only factor supporting Ethereal’s claim of infringement is the strength of the word Ekbara as a mark (it suggests the Middle East, which itself is suggestive of fragrances). This is simply not enough to overcome all the other factors that lean against the likelihood of customer confusion.”

**EXAMPLE:** Rubin Santiago creates a line of enamel earrings, calls them Ekbara Designs, and franchises them for sale in shopping malls that also feature boutiques that carry Ethereal’s products. In this case, the judge’s decision would be different because the likelihood of confusion is much higher due to the fact that the two marks are used on goods distributed in the same channels, the same consumers are exposed to both marks, and the underlying goods might actually compete with each other in the sense that customers searching for impulse gifts might buy the earrings instead of the fragrance, and vice versa.

## **Do the Hypothetically Confused Customers Have to Be Reasonable Customers?**

Before we go on to discuss all the factors that can help you assess a likelihood of confusion, let’s take a moment to examine who these hypothetically confused customers really are. The law imagines a “reasonable” customer who exercises ordinary care to distinguish among the products or services being purchased. This reasonable customer is neither someone

who confuses two products as a result of bizarre reasoning, nor someone who obsessively checks all references before buying a product or service, but rather, someone in between.

Courts recognize that a reasonable consumer will often make a snap judgment. If, after only a hurried glance, Mrs. Serrano is confused between Heartbeat and Heartlite cooking oils, then the marks are too similar. However, the law would surely not find it reasonable if a customer confused Heartbeat cooking oil with Esther's Cooking Oil because her Aunt Esther had recently died of a heart attack. Nor would a customer be reasonable in confusing Heartbeat with Esther's because of similar packaging, so long as the very different names are prominently displayed on the packaging.

The law says that in cases of conflicting trademarks, the challenger must show that a reasonable customer might be confused. How is this done? Typically, the challenger must somehow prove that a significant percentage of customers would likely be confused—anywhere between 5% and 50%, depending on the situation. A more exact number can't be given, because the number varies from one court decision to the next.

## An Overview of How Marks Are Evaluated for Their Potential to Cause Customer Confusion

Court decisions have produced a number of criteria to determine when there's a likelihood of confusion between two marks. As would a judge, you will want to ask the following questions:

- Question 1:** Are the goods and services represented by the marks related—that is, are they sold in the same marketing channels to the same general group of customers?
- Question 2:** Do the goods or services compete—that is, will the decision by customers to buy one business's product or service be made at the expense of the other business?
- Question 3:** How similar are the marks in sound, appearance, and meaning?

- Question 4:** How strong is each mark? (Is the mark in question very distinctive when compared to a competing mark?)
- Question 5:** How much do the underlying goods or services cost? (How carefully does the public usually decide whether to buy the goods or services offered by the two businesses?)
- Question 6:** Do the two marks share the same customer base?
- Question 7:** Does one owner use the mark on several different products or services, or is he or she likely to do so in the future?

Whether use of a trademark is likely to cause customer confusion depends on the exact facts of the case, how the criteria listed above are weighed in light of the facts, and the subjective perceptions of the judge, based on the evidence.

The three most important criteria to examine in deciding how likely it is that the use of a mark will cause customer confusion are the first three on our list.

- Criteria 1:** How closely related are the goods and services?

Two similar services or products with the same or similar names that are distributed in the same markets are far more likely to confuse the public than if very similar names were to grace dissimilar products. In this latter case, the confusion is more likely to come from confusion about the source of the products than from confusing one product with another.

- Criteria 2:** Do the goods or services compete?

If the underlying goods or services directly compete with each other, then the use of the same or similar marks on both is likely to cause the type of confusion that will lead to the customer purchasing the wrong product.

- Criteria 3:** How similar are the marks in terms of their appearance, meaning, or sound?

The more similarities two marks share, the more likely it is that they will confuse someone. This is known as the “sight, sound, and meaning” test for customer confusion.

You should apply these three factors first to your situation. In a borderline case, you will want to consider the four additional factors that we discuss later in this chapter. Or you can pick which of these seven factors seem most relevant to your situation and use them selectively to determine if your mark may cause a likelihood of confusion with another.



#### CAUTION

**Before you conclude that you are safe in going ahead with your chosen mark,** look at the final three factors in the section “Final Factors,” below. They do not predict a likelihood of confusion so much as a likelihood of success in a lawsuit, which may be a more practical determination anyway.

## How Closely Related Are the Goods and Services?

A good place to start when deciding whether one mark conflicts with another is to ask if the goods and services that the two marks promote are related—in a commercial sense. That’s because when products or services are considered to be totally unrelated, the courts will generally find that there is no likelihood of customer confusion and thus no infringement—unless the existing mark qualifies for special protection under the dilution doctrine.

If, on the other hand, a court finds the products or services to be related, it is also likely to find that a likelihood of customer confusion exists and to issue judgment for the owner of the existing mark should an infringement lawsuit be brought. This is because when similar marks are used on related marks, the risk of consumer confusion is high. You can determine whether the potentially conflicting marks are used on related goods or services by asking either of two questions:

- Do the goods or services belong to the same international “classes” of goods or services?
- Are the goods or services distributed through the same marketing channels?

We discuss these two questions in further detail below.

## An Overview of the International Trademark Classification System

International Classes are descriptive categories of goods or services used by the U.S. Patent and Trademark Office to help keep track of the many thousands of new marks that it registers every year. There are 45 classes in all, 34 for products and 11 for services. Appendix A contains a complete list of all 45 classes.

The purpose of the International Classification of Goods and Services is to group together in the same class goods or services that are offered through the same channels of trade and to the same general types of consumers. The International Classification helps the PTO determine whether or not the specific goods or services associated with conflicting marks are so closely related to each other, for example, they are likely to be marketed in the same channels and sold to the same consumer).

**EXAMPLE:** Mark is a jeweler with a line of handmade jewelry (necklaces, bracelets, and earrings) that feature small, black, rubber parts with an industrial look. He calls this special line of jewelry The Rub. Jackie's Tool Shop, Inc., has designed and manufactured a line of hand tools with rubber handles for three years and has a registered trademark for the name of the line, The Rub, under Class 8, for hand tools. Mark would like to register the mark, The Rub, for his line of jewelry. Can he still do so, even though Jackie's has already registered it?

Mark will likely succeed in registering his mark if Jackie's mark is the only obstacle to registration. Mark's line of jewelry would be registered under Class 14, for jewelry. The fact that Jackie's mark is registered under Class 8 and Mark's mark for the jewelry line would be registered under Class 14 indicates that these goods are not marketed in the same channels and to the same consumers. Jackie's hand tools are marketed to hardware stores, home improvement stores, and the hardware section of department stores. Mark's jewelry is marketed to jewelry and clothing boutiques. The fact that the marketing contexts do not overlap indicates that consumers would not likely be confused by the use of the same mark on both goods.



## CAUTION

**Even if your proposed mark falls into a different class than another mark**, we recommend that you not use your mark if it is very similar to the other mark and would appear in the same marketing channels. Keep in mind that the prohibitive cost of litigation usually makes all borderline decisions too risky.

If and when you search the list of registered trademarks (see Chapters 4 and 5) to see whether someone else got to your mark ahead of you, the search results will indicate the class for each similar mark that the search turns up. If your mark belongs in the same class as one or more of the existing marks, this is a good indication that the underlying products or services will be considered related. And if your search comes up with unregistered marks, you will want to try to assign a class to them, and then compare those classes with the probable class that your mark fits under.

Here are some examples to help familiarize you with how this classification system works:

- **CLASS 1 (Chemicals).** Chemicals used in industry, science and photography, as well as in agriculture, horticulture, and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry
- **CLASS 3 (Cosmetics and cleaning preparations).** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices
- **CLASS 5 (Pharmaceuticals).** Pharmaceutical, veterinary, and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
- **CLASS 14 (Jewelry).** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other

classes; jewelry, precious stones; horological and chronometric instruments

- **CLASS 16 (Paper goods and printed matter).** Paper, cardboard, and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks
- **CLASS 35 (Advertising and business).** Advertising; business management; business administration; office functions.

## Fitting Your Goods and Services Into the Appropriate Class

It may take a little study to determine the class to which a product or service fits best. For instance, does a belt made of woven cord belong under Class 22, which includes cordage and fibers? As it turns out, the answer is “no,” because the cord is made into clothing, which belongs in Class 25. Similarly, if a mark represents a new type of service or product, it may be difficult to decide how to categorize it. For example, if you are running an Internet-based store-to-home grocery ordering and delivery service, you may wish to register in a variety of classes, including International Classes 29 (meats and processed foods), 35 (advertising and business), 9 (electrical and scientific apparatus), and 39 (transportation and storage).

Because goods or services in the same class are usually considered related or competing, the use of the same or similar marks within the same class has a high potential for customer confusion. For example, the owner of Titan brand cigarettes was able to stop a cigar maker from using the Titan mark. Cigars and cigarettes are in the same PTO class, Class 34, which also encompasses “tobacco, raw or manufactured, smoker's articles, and matches.”

On the other hand, the owner of Titan cigarettes probably couldn't stop a maker of biodegradable soap, which is in Class 3, from using the same mark. That is because cigarettes and soap do not compete in any way; they are not considered related goods; and the Titan mark could be used on both without creating the likelihood of customer confusion.

It's important to understand that by itself the fact that two products or services are in the same or different classes does not conclusively establish whether two marks are legally in conflict. Because the international classification system has packed all goods and services into only 45 classes, combining, for example, abrasive cleansers and cosmetics, products within the same class may be marketed in totally different ways so as to avoid customer confusion. So, in evaluating a conflict, you may at least argue that a trademark for a scouring powder that is similar to a trademark for lipstick won't confuse customers. As we've pointed out, even if two goods or services are in separate classes, the actual means used to market them may create a likelihood of customer confusion. Simply put, the classification system should be used as an indicator of possible confusion rather than as a means to definitely determine its likelihood.

### Coordinated Classes

The PTO has grouped the various international classifications into what it calls "coordinated classes." If you search for a mark and designate a particular class for it, the search will return marks in the coordinated class group. For instance, if you designate the international class for software when you are performing your search, your results will also include marks in Classes 10, 16, 28, 35, 38, and 42. Although the PTO considers these classes "related" for the purpose of trademark searching, the goods and services described by the related classes are not necessarily related for the purpose of determining the likelihood of customer confusion.

To place a product or service within its appropriate class, follow these steps:

- Step 1:** Study the list of classes in Appendix A. See whether the goods or services for which the mark will be (or is being) used naturally fit into one of the groupings.
- Step 2:** If you are unsure, study the list in the appendix that provides examples of goods and services for each class. Does that help?
- Step 3:** If you are still not sure, use the *Acceptable Identification of Goods and Services Manual*.

### **The Acceptable Identification of Goods and Services Manual**

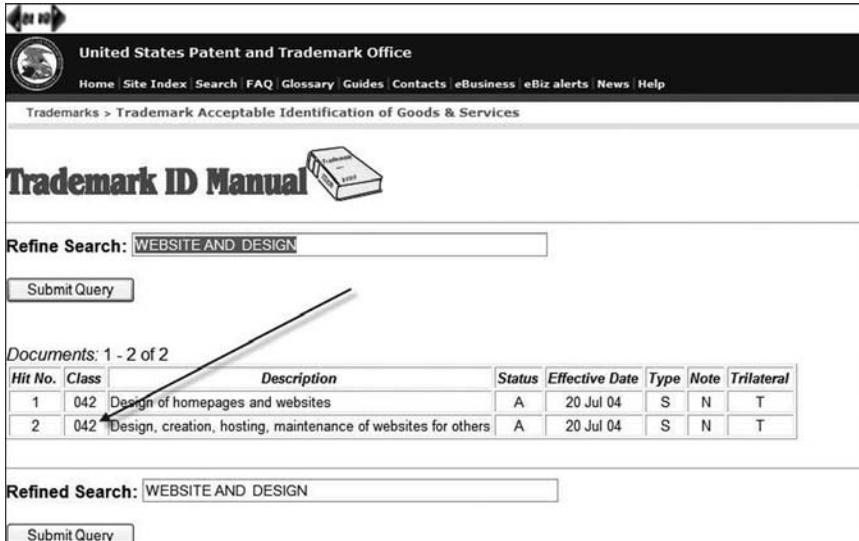
Probably the best source for finding the right class or classes for your goods or services is the list of approved descriptions the PTO has prepared for its examiners to use when reviewing applications. This list is found in the PTO's *Acceptable Identification of Goods and Services Manual*. This manual contains an alphabetical listing of goods and services; their descriptions; the proper class for each; a designation of "A," "D," or "M" indicating that the listing was either added, deleted, or modified; and the date of the change. The "added" designation means that the class is a new class on the list. The "deleted" designation means that the class is no longer available (so you can't use it). The "modified" designation means that the class was somehow changed recently. Perhaps it was broadened to include more types of goods or services, or perhaps its scope was pared down to include fewer goods or services.

The manual is available for browsing and searching on the PTO's website. Searching is recommended, because browsing can be cumbersome with such a large document. To search the manual:

- Step 1:** Go to the PTO website ([www.uspto.gov](http://www.uspto.gov)). Click "Trademark Basics" first, "Manuals, Guides, Official Gazette," and then "Acceptable Identification of Goods and Services Manual (ID Manual)."
- Step 2:** Enter a word or words in the "Enter Search Terms" box that you would use to identify your good or service—for example, "wrench," "accounting," or "telephone"—using the appropriate logical operator.

To remind you, by using the “and” between words, you search for listings in the manual that contain all of the words you type in. By using the “or” between words, you search for listings that contain any one of the words you type in, but not necessarily all of them. After you click on the Submit Query button on the left of the screen, the search engine will return a list of class information for the product or service you entered. (Samples appear below.)

For example, if you wanted to find the correct classification for your website design and hosting service, you could use the search words “website and design.” The results you would find are shown below. The appropriate class is Class 42.



The screenshot shows the United States Patent and Trademark Office website. The page title is "Trademarks > Trademark Acceptable Identification of Goods & Services". The main heading is "Trademark ID Manual" with a small icon of a book. Below the heading is a search box containing the text "WEBSITE AND DESIGN" and a "Submit Query" button. The search results are displayed as a table with the following data:

Documents: 1 - 2 of 2

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
1	042	Design of homepages and websites	A	20 Jul 04	S	N	T
2	042	Design, creation, hosting, maintenance of websites for others	A	20 Jul 04	S	N	T

Below the table is a "Refined Search" box containing the text "WEBSITE AND DESIGN" and a "Submit Query" button.

Suppose, as another example, that you have created a line of paper coffee filters for use in automatic drip coffee makers. Your filter paper is printed with retro, playful, and unique designs to make your coffee filters more interesting to look at and fun to use. You want to register the mark for your line of paper coffee filters, Zoo Filters. To find out what class the PTO deems correct for this product (goods) and what description to use for your application, you could simply do a search using the words “coffee and filter.”

**Trademark ID Manual**

Refine Search:

Documents: 1 - 1 of 1

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
1	016	Paper filters for coffee makers	A	02 Apr 91	G	N	N

Refined Search:

[Return to Search](#)

HOME SITE INDEX SEARCH eBUSINESS HELP PRIVACY POLICY

Your search would produce the results shown above. From this line item, you can see that the PTO considers Class 16 as the appropriate class for paper coffee filters.

### Search for Classes Used by Competitors

If the U.S. Patent and Trademark Office *Acceptable Identification of Goods and Services Manual* doesn't do the trick for you, you might consider examining the database of marks registered with the PTO to find out what classes have been assigned to the marks registered by your competitors. Also, once you conduct a trademark search in the course of adopting your mark, the report generated by that search may provide some good tips as to what class you should use.

As you know from Chapters 4 and 5, if you have access to the Internet, you also have access to a free database of marks (called TESS) that have already been registered with the PTO. (Go back to Chapter 5, where we explain how to access and use TESS.) For this type of search use the Free Form Search. Enter some terms that best describe the goods or services you and your competitors are offering the public, and put “gs” in brackets after each of the terms. For instance, if you want to start a delivery system that operates from an Internet website, enter “delivery [gs] and Internet [gs]” and click “Submit Query”. This will produce

a long list of marks that are used on goods or services that have been described with the terms “delivery” and “Internet.”

Another approach is to enter one or more terms that a competitor is using in its trademark and then examine the registrations to see what classes have been assigned to that mark.

**EXAMPLE:** You have created a new kind of coloring crayon that makes the colors brighter when applied to any type of paper or poster board. You know that Crayola has been making crayons for decades. You type in the word “Crayola” in the search box and click on the search button. you will get a long list of all the registered trademarks containing the term “Crayola.” If you look at Registration Number 1279429—Crayola, you will learn that crayons have been assigned to Class 16.

### **Related Goods and Product Expansion**

Each trademark has a net of protection defined by the channels of commerce and class of goods. In some cases, this net may be very broad if a court determines that the owner of the mark is likely to expand into new markets. For example, in the case of a famous mark, the net is very wide because the owner of a famous mark is likely to expand into many product areas. In other cases, the net is not too wide because a smaller company is not likely to move into other areas. For example, it is possible that the owners of the Gallo trademark will expand into the sale of cheese because the trademark is associated with wine, and the consuming public identifies wine with cheese. However, the net of protection may not extend to cheese for a lesser-known wine trademark. There is no simple method of predicting how either the PTO or the courts will measure the net of related goods. Sometimes product expansion can be determined by the actions of the company (for example, evidence that the company is considering new products) and sometimes it is determined by marketplace factors (for example, record companies often expand into producing films). In either case, attorneys and judges weigh the relevant case law when making decisions regarding registration and litigation.

## Trademark Assistance Center

If, after reading this section, you are still in doubt about the proper class or classes for your product or service, you can call the Trademark Assistance Center of the PTO (800-786-9199), describe the product or service, and ask them which class or classes may be involved. The trademark information specialist will answer your question and normally give you sound advice. Unfortunately, you don't have the legal right to rely on this opinion. For instance, if you later decide to register your mark, and you apply for registration in the class recommended by the Trademark Assistance Center, the person who eventually examines your application may disagree with the answer you were given. No big deal. You'll just have to assign a different class to the product or service—one that's acceptable to the examiner.

## Marketing Channels

In addition to using the classification system for determining whether two marks are related and thus might confuse customers in the marketplace, it is also useful to look at the marketing channels through which the goods or services reach the public.

Goods and services are considered related when they are sold in similar outlets, marketed in similar media, placed near each other in stores, and generally considered alike by the consumer. If they are marketed quite differently, then no likelihood of confusion can exist, regardless of what class they are in for registration purposes.

For example, you should determine if the same sorts of information sources (billboards, websites, television, newspapers, magazines, and radio) carry ads bearing both marks. Would both marks appear in ads in the same trade journals? Might the products or services be displayed or sold in the same store or catalog or under the same heading in a trade directory? Will they both target the same customer base? Do both marks appear in advertising on the same types of websites? In any of these cases, it's fair to say that the marks are being used in the same marketing channels, which increases the likelihood of customer confusion.

**CAUTION**

**To some extent, the Internet is one large marketing channel, and all goods and services moving through it are related to a degree.** This is partially because of the way people search out information by using a search engine to locate sites containing a set of they have words chosen. Unfortunately, cases dealing with the issue have not yet made their way up to the appellate level where law is made, so we can't be more specific about marketing channels on the Internet. In coming years, we will learn whether the courts view the Internet as one large channel (that is, the equivalent of a Wal-Mart on the Net) or a series of smaller channels (like specialty shops at a mall).

## Do the Goods or Services Compete?

Goods and services directly compete if the purchase of one negatively affects the purchase of the other. Two brands of bacon sitting side by side in a grocery display compete. So do airlines, fast food restaurants, personal computers, mobile telephones, and computer game stations.

## How Similar Are the Marks?

The third factor in determining whether using similar marks will cause a likelihood of confusion is how similar the marks are. Do they sound or look alike, and if so, how much? Do they convey the same meaning? The closer two marks are in sight, sound, and meaning, the more likely it is that a legal problem will arise.

In comparing marks, remember that variations in spelling or punctuation do not make marks different if they sound the same. Thus, Phanseepants is the same as Fancy Pants, and Duncan Doughnuts duplicates Dunkin Donuts. Even using foreign language equivalents can't make a mark different enough, if most of the public could tell they mean the same. So La Petite Boulangerie would infringe on The Little Bakery, and El Sombrero Blanco probably infringes on The White Hat.

Even marks with more definitive differences may be confusingly similar, in the same market. So courts have found Quirst is too close to Squirt, Sarnoff too much like Smirnoff, and Lorraine too reminiscent of La Touraine. Each of these pairs of marks was used on nearly identical goods. Probably the use of such duplicate marks would have passed legal muster if they had been on very different kinds of products. Again, that's because the more competitive marks are in a class or market channels, the less similar the marks have to be to cause confusion.

### **Are Two Marks Confusing? Use the Golden Rule and Get Some Feedback!**

Telling whether the simultaneous use of two marks risks customer confusion can be a very subjective exercise, heavily influenced by the experience and mind-set of the person doing the analyzing. Nevertheless, there are two ways to get a handle on the question of potential confusion. First, ask yourself how you would feel if you were out there using your proposed mark and the other business came along with theirs. If you think you'd become energized to take some action, you have your answer. Second, if you are able to arrange for several objective friends or relatives to eyeball the two marks and give their honest impression of how they would react as customers, you'll probably have a good idea of how a judge would react. If even one of your friends or relatives thinks he or she might be confused by the marks, then chances are a judge would reach the same conclusion as to hypothetical customers and rule that the simultaneous use of the two marks would create the likelihood of customer confusion. Because this is a risk you don't want to take, chances are you'll want to pick another name.

## **Additional Factors**

The next four factors from our list also affect whether likelihood of customer confusion exists between any given pair of marks.

## How Strong Is Each Mark?

A strong mark is generally given a wider range of protection than a weak one. Remember from Chapter 2 that a mark is considered strong if either of the following is true:

- The words, phrases, or symbols it consists of are distinctive (arbitrary, coined, or suggestive).
- Long and continuous use has made the public recognize it as the symbol of a particular product or service (the secondary meaning rule).

The point is, the stronger the original mark, the more likely it is that the second mark will be found to be confusingly similar if it has any similarities to the original mark at all. Conversely, the weaker a mark is, the less legal protection it is given and the more likely it is that a second mark will be found to not be confusingly similar, even if it has many similarities. This means you are safer in using a mark that is similar to an existing weak mark than a mark that is similar to an existing strong mark.

## How Much Do the Goods or Services Cost?

Cost will also affect the likelihood of customer confusion. Because customers tend to take their time and consider carefully when buying an expensive item, the more expensive the item, the less chance of confusing customers. Conversely, an item that is cheap or subject to impulse buying is more likely to result in customer confusion if sold with a mark that is similar to another on goods that are even slightly related.

## Are the Two Marks Directed Toward the Same Customers?

Two businesses that use similar marks to sell to the same customers are highly likely to cause customer confusion. Conversely, if businesses have separate customer bases, then the use of similar marks is unlikely to confuse anyone. For example, the market for replacement wood

windows is likely to be limited to contractors and homeowners. As a result, a window manufacturer who uses the mark Walls of Light in its advertising probably won't confuse the customers of a magician who calls his show the Wall of Lights, because the two groups of customers won't often overlap.

It's useful to look at how large a sector of the market uses your product or service. If a small sector of the market knows and purchases a service, a similar mark used by a different small group is unlikely to confuse the two sets of consumers. But if a large segment of the public knows one mark, use of a similar mark is more likely to cause customer confusion, even if aimed at a slightly different market, because of the greater potential for overlap between the two groups.

## **Does One Owner Use the Mark on Several Different Products or Services?**

A red flag should go up when you see a potentially conflicting mark that has already been used on a variety of products or services by the same mark owner, even if you wish to use it on a product that is unrelated to any of these uses. The problem is that because the first mark owner has already begun to use the mark on several products or services, it has asserted what is called in legal lingo the “right of expansion.” Some examples of businesses that do this are Calvin Klein or Pierre Cardin (although the dilution rule would also keep anyone from using an identical mark or marks—see Chapter 1).

Once this right of expansion is asserted (by using the mark on a number of different products), the courts will assume that the first user may wish to expand its use further and protect this right of expansion by permitting very few other uses of the same mark. So a second user seeking to use such a mark even on greatly dissimilar products will have less luck than if the mark were being used in a more limited fashion. By the same token, the public, having seen the mark on a variety of goods by the same owner, is more likely to assume that any new uses also belong to that owner, and thus are likely to be confused. Thus, the public would expect the mark Yamaha, which already appears on

motorcycles, lawnmowers, and guitars, to represent the same company if it also appeared on computers or musical recordings.

## Final Factors

After you have determined whether there is a likelihood of customer confusion between the marks you are evaluating, look at the following additional factors. They will help you determine the likelihood of getting into a lawsuit or of prevailing if you are mired in one. Then you will have a very clear idea of whether it's wise to use a particular mark.

## History of Trademark Infringement Lawsuits

This is the most practical factor in predicting the likelihood of a lawsuit. It makes great sense to be wary of using a mark if the owner of a similar mark has a history of bringing trademark infringement suits. This generally means that the other mark owner will vigorously challenge any uses that are potentially confusing—and perhaps even some that are clearly not. Even if you eventually win such a suit, the cost, averaging \$100,000, is rarely worth it in the long run. For example, anyone who follows these matters knows that McDonald's vigorously protects its golden arch and the prefix "Mc" when it comes to any type of fast, efficient, and low-cost service business. For this reason, you should stay away from using anything that might get up the ire of McDonald's.

One way to discover a company's litigation history is to look up some of the secondary sources of trademark law listed in Chapter 14. Those books have tables in the back that list cases by the names of the litigants (parties to a lawsuit). If you don't find the name of the business with which you may have a conflict there, the records of the county and federal courthouses nearest their corporate headquarters will probably list cases in which they have been litigants (not all of which will be trademark cases). Or, you can consult an attorney, who will search for the company name on one of several comprehensive legal databases that list all cases in a given field. Consulting an attorney is likely to be the most expensive, but also the most effective, method.

## How Long Has the Allegedly Infringing Business Used the Mark?

If an alleged infringer has used a mark for a long time without complaint from the owner, that may establish two things:

- It makes it look as though the alleged infringement has not harmed the true owner very much. This is known in legalese as “sleeping on your rights,” and a court is less likely to give the owner any relief if it has not taken action to protect its rights despite another’s use of the same mark for a long time.
- The alleged infringer has established some rights in the mark that may be superior to the true owner’s rights, if only in the geographic area in which it has been used. (See Chapter 10, “Sorting Out Trademark Disputes,” for more on legal priorities in such situations.)

## What Did the Alleged Infringer Intend in Adopting and Using the Mark in Question?

The intent of the alleged infringer also affects the question of whether one mark infringes on another. If it appears probable to the court that a business could only have chosen its mark in order to take advantage of its similarity to another mark, then the court is very likely to find an infringement to exist. If, for example, a successful and well-known marketer of French bread uses Staff of Life as a trademark, and a new rival calls its product Stuff of Life, the court will be very suspicious about the intent of the rival—and it may be hard to persuade the judge or jury that the owner of the Stuff of Life mark did not intentionally copy the first mark.

## How to Read a Trademark Search Report

In previous sections, we advised you what to look for when evaluating a trademark search. In this section, we’ll walk you through a typical search report, and we’ll answer some common questions. In Appendix C

to this book, we have included relevant sections from a search report generated by Thomson CompuMark. We requested the Thomson CompuMark search for the name Incorporator Pro, which Nolo (the publisher of this book) intended to use as the name for a software program that assists users forming a corporation.

The Thomson CompuMark search is the broadest type of search report in which a searcher trolls through three groups of trademarks—those that are federally registered, those registered with state governments, and those that are not registered (common law). The major search report companies generate similarly comprehensive searches.



#### CAUTION

**No guarantees.** Trademark searchers and database inputters make mistakes. But don't be deterred from getting a report just because search companies won't guarantee their results. These reports are still the established legal standard for prejudging a trademark choice.

## Jump Right In

Before starting any search, you must know what you're seeking. In our case, we're looking for marks that are:

- identical to Incorporator Pro on similar or related goods or services
- similar to Incorporator Pro on similar or related goods or services, or
- famous and similar to Incorporator Pro.

The easiest way to start is to pick up the report and start reading. This task might seem overwhelming considering the bewildering number of entries. Don't worry. For now, you can disregard the information about search strategies, databases, or other explanatory text and just look at the actual entries. You'll notice that each section usually starts with a list of possible matches, followed by individual analysis of each relevant entry.

Page through the report and make a cursory review. We did this with the report in Appendix C. (Note: Not all of the report is reproduced in

the appendix, just those portions relevant to our discussion.) Initially we noted that there are no marks—federal, state, or common law—that are identical to our proposed mark, Incorporator Pro. There was, however, one abandoned application for Incorporator Pro. That application was filed by Nolo, the publisher of this book, in 2004, and later abandoned for business reasons. There were also no marks that included both the words “Pro” and “Incorporator,” such as “Legal Pro Incorporator.” We also didn’t recognize any of the marks in the report as being famous. We made a table as shown below.

Standard	Mark
Identical to Incorporator Pro (on similar or related goods or services)	Incorporator Pro (previously filed and abandoned by Nolo)
Similar to Incorporator Pro (on similar or related goods or services)	Internet Incorporators Incorporators USA Incorporate Corpro The Incorporator Pros Incorporated California Incorporators Pro Incorporated
Famous and similar to Incorporator Pro	None

After completing this first pass, we took a second tour of the search report, examining more of the search details.

## Federal Trademark Search

Search reports are usually divided into tabbed sections for federal, state, and common law. As noted, each section usually starts with a list of entries, followed by details relevant to each entry. These individual entries provide the most helpful decision-making data, for example, whether the mark is live or dead, the type of goods, the class of goods,

the owners, and the length of registration. The federal trademark search portion is always first.

Below we provide some questions and answers describing how this data affects your trademark decisions.

- **Am I free to use dead (cancelled or abandoned) marks?** Trademark search reports always indicate whether a mark is live (active and currently registered) or dead (abandoned by the owner or canceled by the PTO). For example, the search report provides information about the mark Pros Incorporated. An application was filed for this mark in May 1997 on the Supplemental Register but the application was abandoned in March 2000. There are various reasons why an applicant may abandon an application—for example, the applicant may believe that registration is unlikely, or perhaps the applicant decides to discontinue the product or service because of the marketplace. If a similar mark shows up as being abandoned during the application process, it often pays to dig deeper in the application

<p>PROS INCORPORATED</p>	<p><b>PROS INCORPORATED</b></p> <p><b>Status:</b> ABANDONED SUPPLEMENTAL REGISTER AMENDED TO USE APPLICATION</p> <p>USPTO Status: ABANDONED-FAILURE TO RESPOND USPTO Status Date: MAR 28, 2000</p> <p><b>Goods/Services:</b> International Class 35: PROVIDING BUSINESS AGENT SERVICES FOR PROFESSIONAL ATHLETES AND OTHER CELEBRITIES First Used: MAR 02, 1973 (INTL. CL. 35) In Commerce: APR 01, 1973</p> <p><b>Last Reported Owner:</b> PROS INCORPORATED VIRGINIA CORPORATION 9 SOUTH 12TH STREET P.O. BOX 673 RICHMOND, VIRGINIA 23218</p> <p><b>Chronology:</b> Filed: MAY 08, 1997      Serial Number: 75-288,910 Abandoned: MAR 28, 2000</p> <hr/> <p><b>Ownership Details:</b> <b>Applicant:</b> PROS INCORPORATED VIRGINIA CORPORATION 9 SOUTH 12TH STREET P.O. BOX 673 RICHMOND, VIRGINIA 23218</p>
------------------------------	---

file to find out if the reason was due to an examiner objection. That may foretell what's in store for your application.

There is a different type of abandonment if a mark has been registered but then later abandoned or canceled. For example, the mark Capro Incorporated was cancelled because the owner failed to file a Section 8 affidavit. In this case, the owner likely used the mark on goods and services and then later, for one reason or another, failed to file a statement of continued use.

Keep in mind that when a mark shows up as “dead” like this on the Federal Register, it's possible that the mark is still being used, albeit in an unregistered status.

As long as the mark is still in use, no one else can use it (in a way that would create the likelihood of customer confusion) without infringing it. There are many ways to determine if a trademark is no longer being used. The simplest method is to call the company and ask if the product can be purchased. If the response is something like, “No, we haven't sold that product in years,” then there is a chance that the trademark is truly abandoned. A presumption of abandonment arises after three years. If you can afford additional expenses, professional investigators can help you determine the extent of the company's use. If you believe that a mark has been abandoned, even if it is showing up as live on the search report, you may file a Petition for Cancellation based upon abandonment with the Patent and Trademark Office.

- **What importance should I place on trademarks on the Supplemental Register?** That depends on the similarity of the marks and how long the mark has been on the Supplemental Register. As you may remember from Chapter 1, the Supplemental Register is used to register weak or descriptive marks. These marks get very limited rights. After five years on the Supplemental Register, however, the mark becomes eligible for the Principal Register. Consider the trademark Internet Incorporators: The services are similar to those for Incorporator Pro. The names are similar, though perhaps not confusingly similar. The mark is registered

	<b>INTERNET INCORPORATORS</b>			
	<b>Status:</b> REGISTERED SUPPLEMENTAL REGISTER			
	USPTO Status: SECTION 8 - ACCEPTED USPTO Status Date: NOV 18, 2006			
	<b>Goods/Services:</b> International Class 42: LEGAL SERVICES, NAMELY, FORMATION OF CORPORATIONS, RESIDENT AGENT SERVICES AND OFFICE HEADQUARTERS SERVICES FOR OTHERS First Used: APR 11, 1998 (INTL. CL. 42) In Commerce: APR 11, 1998			
	<b>Disclaimers:</b> "INTERNET INCORPORATORS"			
	<b>Last Reported Owner:</b> WICKFORD EQUITIES, LLC. NEVADA LIMITED LIABILITY COMPANY 1151 AIRPORT RD., STE. 02 MINDEN, NEW YORK 89423			
	<u>We Have Located Other Marks With This Owner</u> <table border="0"> <tr> <td><u>INTERNET INCORPORATORS</u></td> <td>USPTO</td> <td>Page 62</td> </tr> </table>	<u>INTERNET INCORPORATORS</u>	USPTO	Page 62
<u>INTERNET INCORPORATORS</u>	USPTO	Page 62		
	<b>Chronology:</b> Filed: DEC 11, 1997      Serial Number: 75-404,152 Application Amended: SEP 13, 1999 Registered: JUN 05, 2001      Registration Number: 2,458,702 Affidavit Section: REGISTERED - SEC. 8 (6-YR) ACCEPTED NOV 18, 2006			
	<b>Ownership Details:</b> <b>Registrant:</b> SIERRA HOLDINGS LIMITED			

on the Supplemental Register, not the Principal Register, and the five-year period has passed. We need to perform more research, if possible, to find out if the product is still available, and if possible, whether the trademark will move to the Principal Register. Since marks registered on the Supplemental Register are, by their nature, too weak to be registered on the Principal Register, we also realize that it's possible that our proposed mark Incorporator Pro may also be considered to be weak by the USPTO.

- **What if the report indicates that the trademark owner has disclaimed some portion of the trademark? Does that mean I'm free to use it?** Yes and no. You're free to use the disclaimed terms without infringing, but if you attempt to register your mark, you'll probably have to disclaim the same terms. In other words, you won't be able to stop anyone else from using those terms either.

As explained in Chapter 7, a disclaimer is a statement that a trademark owner asserts no exclusive right in a specific portion of a mark, apart from its use within the mark. Disclaimers are required by PTO examiners as a condition of registration. For example, in the Incorporator Pro search in Appendix C, you will note Disclaimer Statements for terms such as “Nationwide Incorporators” and “Internet Incorporators.” You may wonder, how can the owner of the Internet Incorporators trademark claim any trademark rights, if its whole name has been disclaimed? In the case of this and many other marks, the owner claims limited rights to the stylized appearance of the mark and the accompanying graphics. By reading disclaimers, you will learn what will have to be disclaimed when applying for your trademark.

- **What if a mark is pending but has not yet been registered?** The trademark search report always informs you as to the status of the mark, whether it’s presently registered, or if it’s a pending application. As explained in Chapter 7, pending applications, including intent-to-use applications (assuming they issue as registrations), will have priority over owners who commence use after the earlier application filing date. So, if there’s a pending mark that’s similar and will be used on similar goods, that’s an important strike against your proposed use.
- **What if the search report indicates that a company has assigned the mark to another business. Should that affect my determination?** No, the assignee (the company that has purchased the mark) acquires all of the rights of the original owner and can enforce those rights and stop you from using a similar mark.
- **Which matters more, whether the mark is used on similar goods or in the same class?** Generally, your first concern should be whether the goods and services are similar. This is especially true in crowded classes like Class 9, in which the Incorporator Pro trademark will be registered. That’s because Class 9 is the class for most scientific, technical, computer, and Internet marks, and it’s the class in which 20% of all trademark applications are

filed. In Class 9, for example, it's possible for similar marks to be registered for different goods, say, video games or nautical equipment. For our purposes, therefore, we're much more concerned with companies that offer similar goods (whether books or software) or similar services. (Note, this distinction between goods and classes may not be as dramatic in less-crowded classes.)

## State Registration Search

If you are having a trademark search done for you, it's always a good idea to have the search firm include a search of the state trademark registration database. The state search report section, like the federal search section, starts with a list of state registered marks that is followed by details on each relevant listing. Almost all such reports, regardless of the searching company, are performed using the TrademarkScan database owned by Thomson CompuMark.

How do you quantify the effect of a state trademark registration versus a federal registration? A federal registration creates a presumption of national priority. Not so with a state registration or a common law mark. The impact of these types of marks is quite often local. Nonetheless, a local user can obstruct you if you attempt to sell goods or services in their geographic area. For that reason, you need to determine the extent of the use. Are the products distributed or services offered over a wide geographic area? Does the company's trademark have an Internet presence? Obviously, the less of a presence and the more localized the use, the less of a threat there is to your proposed use.

Also, it's important to keep in mind that claiming state and common law rights does not require the same standardized scrutiny as federal registration. Consider the data provided for the state registration for "California Incorporators The Professional Solution" in the Incorporator Pro search. The "Goods/Services" are vaguely described as "new business in California," even though the mark was first used in 1996. Because many state trademark offices simply rubber stamp applications without a thorough analysis, these marks are sometimes more susceptible to challenges on the basis of descriptiveness or genericness.

	<b>CALIFORNIA INCORPORATORS THE PROFESSIONAL SOLUTION</b>	
	<b>State:</b>	CALIFORNIA
	<b>Status:</b>	REGISTERED
	<b>Date Registered:</b>	MAR 20, 1997
	<b>Registration No.:</b>	47569
	<b>Goods/Services:</b>	International Class: 42 NEW BUSINESS IN CALIFORNIA State Class: 42 First Use In State: FEB, 1996 First Use Anywhere: FEB, 1996
	<b>Design Phrase:</b>	THE WORDS "CALIFORNIA INCORPORATORS" WITH THE FIRST LETTERS OF EACH NAME IN A DROP CAP STYLE, THE NAME IS ACCOMPANIED WITH A LOGO IN THE STYLE OF TWO CRESCENTS FACING EACH OTHER (LOCATED ABOVE THE NAME) AND THE WORDS "THE PROFESSIONAL SOLUTION" (LOCATED BELOW THE NAME)
	<b>Registrant:</b>	CALIFORNIA INCORPORATORS CALIFORNIA CORPORATION 15928 VENTURA BOULEVARD, SUITE 108 ENCINO, CALIFORNIA 91436
		<u>We Have Located Other Marks With This Owner</u>
		<u>NATIONWIDE INCORPORATORS THE INCORPORATION PROFESSIONALS</u> USPTO Page 19
	<b>Manner Of Display:</b>	USED ON ADVERTISING BROCHURES, ON ADVERTISING LEAFLETS, ON BUSINESS CARDS, ON LETTERHEADS.

## Common Law Report

The common law trademarks section includes trademarks that aren't registered anywhere, as well as company names and other names that may not actually be used as trademarks. The search companies waded through many sources, including public databases, product announcements, business products databases, and proprietary database records. The rules for state registrations apply for common law marks: If you are concerned about an identical or similar mark, do more research to determine whether the name is actually (and currently) used as a trademark.

## Our Conclusions

We made two conclusions after reviewing the Incorporator Pro search. First, we did not find any marks so similar in appearance or phonetics to merit serious concern of infringement. In other words, the coast was clear. The reason that the coast was clear, however, led to our second conclusion that terms such as “Incorporator” or “Incorporate” and “Pro” may be considered descriptive and may have to be disclaimed or may require registration on the Supplemental Register. In short, even though Nolo is free to use the term, it may run into problems if the company attempts to register it on the Principal Register.

Your trademark search results, obviously, will differ. If in doubt about your conclusions or the search report data, your best course of action would be to consult with a trademark attorney for help.



# Federal Trademark Registration

<b>Brief Overview of Federal Registration</b> .....	188
<b>What Marks Qualify for Federal Registration</b> .....	189
Is the Mark in Actual Use? .....	189
Are You Using the Mark in Commerce That Congress May Regulate?.....	191
Is Your Mark Immoral, Deceptive, or Scandalous?.....	193
<b>If You Haven't Started Using Your Mark, Should You File an Intent-to-Use Application?</b> .....	194
<b>What Examples of Your Mark Will You Submit With Your Application?</b> .....	197
Specimens for Marks on Goods (Trademarks) .....	197
Specimens for Marks Used for Services (Service Marks) .....	201
<b>What International Class Is the Best Fit for Your Product or Service?</b> .....	203
<b>Deciding How Many Marks You Want to Register</b> .....	205
Name Marks Combined With Unusual Typefaces.....	206
Name Marks Combined With Graphic Designs.....	206
<b>Applying for Registration Online</b> .....	206
How to Use TEAS to Register Online.....	208
<b>If You Are Filing by Mail</b> .....	226
<b>What Happens Next?</b> .....	227
<b>Communicating With the PTO</b> .....	228
<b>If the Examiner Issues a Rejection Letter</b> .....	230
Responding to an Objection Yourself.....	231
Hire a Trademark Attorney to Prepare a Response.....	233
Abandon Your Application .....	234
Final Rejection: An Objection That Cannot Be Overcome .....	235

<b>Follow-Up Activity Required for Intent-to-Use Applications</b> .....	236
The Allegation of Use for Intent-to-Use Application .....	236
When to Divide Your Application.....	238
Getting a Six-Month Extension to File Your Statement of Use.....	239
<b>Follow-Up Activity Required After Registration</b> .....	240

This chapter helps you register your trademark with the U.S. Patent and Trademark Office (PTO). Registration is optional, but it provides a number of significant advantages to the trademark owner. Registration on the Principal Register provides you with exclusive nationwide ownership of the mark (except where the mark is already being used by prior users who haven't registered the mark) and official notice to all would-be later users that the mark is unavailable. In addition, registration provides a legal presumption that you are the owner of the mark, which means it's easier for you to prove ownership if a dispute over the mark ends up in court.

Taken together, these benefits make it easier to win an infringement lawsuit and make it more likely that damages can be collected for the infringement. That may mean more money to pay the attorneys, which often makes it worthwhile to bring the lawsuit in the first place.

To use this chapter, you should first have a basic understanding of:

- how trademark law works on and off the Internet (Chapter 1)
- how to choose a legally strong trademark (Chapter 3)
- how to find out whether other marks exist that might conflict with yours (Chapters 4 and 5), and
- how to tell whether your mark is confusingly similar to another (Chapter 6).

### Register Marks Using Nolo's Online Trademark Application

If you find procedures described in this chapter to be confusing, you may want to use the [online trademark application](#) form provided by Nolo, the publisher of this book. For a fee, the system enables you to fill out a questionnaire (aided by help screens) and Nolo's staff will forward it to the USPTO for filing. Go to Nolo's website ([www.nolo.com](http://www.nolo.com)) and choose Online Legal Forms.

### **New Fees: Use Paper, Pay More!**

The USPTO has adopted a two-tiered fee system—applicants filing electronically using TEAS pay \$325 per class for a regular TEAS application (or \$275 per class for a TEAS Plus application) while applicants filing with paper applications pay \$375 per class. Check the USPTO website for current fees.

## **Brief Overview of Federal Registration**

If you are already using the mark, here are the four steps required for federal registration:

1. Gather the necessary information, such as the date you first starting using the mark anywhere, the date you first used it in commerce that Congress may regulate (for example, interstate commerce), and a specimen showing how the mark is actually being used.
2. Complete an application—either online or on hard copy.
3. File the application with the PTO—either online or by mail—accompanied by a specimen of how your mark is being used and a fee of \$325 per class for a regular TEAS application (or \$275 per class for a TEAS Plus application) or \$375 per class of good (if filing by mail).
4. If required, modify the application in response to the trademark examiner's comments.

If you are not using the mark but wish to reserve it for future use, apply on an intent-to-use basis. You will not have to supply a specimen, but once you start using the mark you'll have to:

- file an additional form notifying the PTO that you are now using the mark
- provide a specimen of the use, and
- pay an additional \$100.

More fees and forms are required if you delay getting the mark into use within six months after the PTO approves the mark for registration.

## What Marks Qualify for Federal Registration

Now that you have an overview of the trademark registration process, let's start by examining the basic qualifications for placement of a mark on the federal trademark register. There are, in fact, two trademark registers—the Principal Register and the Supplemental Register. Your goal is to get your mark placed on the Principal Register, because it provides most of the benefits of federal registration. However, if your mark doesn't qualify for the Principal Register, you may have it placed on the Supplemental Register—which does provide a few benefits. (See Chapter 1 for more on the Supplemental Register.)

From this point on, when we speak of federal registration, we are referring to registration on the Principal Register.

In Chapter 1, we spoke about qualifications for federal trademark registration. To review, a mark qualifies for placement on the Principal Register if:

- The PTO considers the mark distinctive, either inherently so or because it has obtained a secondary meaning through use over time.
- The mark does not legally conflict with an existing registered mark.
- The mark is in actual use.
- Its use is in commerce that Congress may regulate (that is, it moves across state, territorial, or international borders, or affects commerce across these borders).
- The mark is not scandalous, immoral, or deceptive.

The first two qualifications—distinctiveness and nonconflicting marks—have been explained in Chapters 3 and 6, respectively. Now we will cover the last three.

### Is the Mark in Actual Use?

A mark must be in actual use before it can be placed on the Federal Register. This doesn't mean that you have to be using the mark when you apply for registration (see below, on intent-to-use applications) but

only that the mark will not be registered until you notify the PTO that the mark has been put into actual use, provide a sample, and pay an extra fee.

What constitutes actual use? As a general rule, “in use” means that the mark is being utilized in the marketplace to identify your goods or services. The criteria used to determine whether a trademark is in use are different, depending on whether the trademark is being used for a product or a service.

For products (tangible goods), your mark is in use if the mark appears on the goods or on labels or tags attached to them, and the goods have either been sold or been shipped to a store for resale purchase. However, a token sale made only for the purpose of getting your mark “in use” doesn’t count. The following examples show legitimate uses of the marks for purposes of registration.

**EXAMPLE 1:** Ben sent a sample of his No-Knees pants to a department store that will resell them.

**EXAMPLE 2:** Emily’s earrings were shipped in a box carrying the label All Ears, for resale by a local street vendor.

**EXAMPLE 3:** Peter developed software for recording podcasts, and he sold four copies of his software online. He used the mark Bearware prominently on his website and on the software.

For services, your mark is in use if the services are actually being marketed under the mark and you can legitimately deliver the services to customers.

**EXAMPLE 1:** Toby purchased a 900 number phone line for providing sports trivia under the name Sportorific. As soon as his lines were up and running and he had advertised his services under the name Sportorific, his mark was in use.

**EXAMPLE 2:** Helen decided to call her housecleaning service Mistress Tidy. When she first advertised her services under that name on a bulletin board at a local market, she put her mark into use.

**EXAMPLE 3:** Alice started her own Internet service provider business under the mark CosmoNet. She set up her system and prepared all of the equipment she would need to offer her services. The day she first started advertising her services under her mark and with all of her systems in place and ready to go, she put her mark into use.

## **Are You Using the Mark in Commerce That Congress May Regulate?**

Even if the mark is in actual use, it won't qualify for federal registration unless it is in use "in commerce that Congress may regulate." To satisfy this requirement, you must do one or more of the following:

- ship a product to which the mark is attached across a state line (most manufacturers, wholesalers, and mail-order businesses do this regularly)
- ship a product to which the mark is attached between a state and a territory or between a territory and another territory (for instance, between New York and Puerto Rico, or between Puerto Rico and the Virgin Islands)
- ship a product to which the mark is attached between a state or territory and another country (for instance, between California and Hong Kong, or between Puerto Rico and Cuba)
- use the mark in advertising in which your business offers services outside the state (many businesses that have sites on the Internet and other businesses, such as Disneyland, do this regularly) provided that you can offer those services at the time of the advertisement
- use the mark in the course of conducting a service business across a state line (such as most trucking operations, many 900 numbers, and, increasingly, businesses that offer e-commerce over the Internet)
- use the mark to identify a service business in more than one state (such as McDonald's, Holiday Inn, or Hilton Hotels) or across international or territorial borders

- use the mark in the course of operating a business that caters to interstate or international travelers (such as a hotel, restaurant, tour guide service, or ski resort), or
- use the mark in a business that is regulated by the federal government.

The basic reason for this commerce requirement is that the federal government has no constitutional authority to regulate marks that are used only within one state's borders.

Here are examples of marks used in commerce that Congress may regulate:

- **Goods**
  - Alan's mousetrap is sold in three states under the mark MiceNoMore, and the mark appears on the packaging.
  - Rosebud, Inc., distributes a computer program called Rosecare to nurseries throughout the country. The mark appears on the packaging and opening screen of the software.
  - Ruth lives in White River Junction, Vermont, a town just across the river from Hanover, New Hampshire, where Dartmouth University is located. She sells a brand of baked goods in both towns—under the label Ruth's Bakery Delights.
  - Travelers come to Berkeley, California, from around the world to buy Peet's Coffee. Peet's doesn't advertise, but it draws a national and international trade under the service mark Peet's and the trademark Peet's Coffee. Peet's also operates a brisk international mail-order business and has a website.
- **Services**
  - Etta's computer consulting services are marketed by telephone and direct mail to potential customers in Canada, California, and Nevada under the mark Quick-Bytes.
  - Toby Drysdale's 900 phone number for sports trivia, Sportorific, is marketed through ads on national radio and television networks and is also available to purchasers in Puerto Rico and Mexico.

- Rose’s newspaper advice column is syndicated in three Northeastern states under the name Rosie to the Rescue.
- Doug’s mail-order shoe repair service is marketed under the name Sole Security via ads in national magazines and newspapers.
- Ninth Wave Surfing provides lessons in Hawaii to vacationers from all over the world.

This last example shows an “effect” that a business can have on interstate commerce. Though the “effect” may also qualify a mark for federal registration, it is not as clear-cut a case as when the mark actually appears in more than one state—for instance, in advertising or mail-order catalogs.



#### CAUTION

**As a general rule, the PTO trademark examiners do not investigate whether the mark for which registration is being sought is being used in “commerce that Congress may regulate.”** Nor is there any place in the application to describe exactly where, geographically, the mark is being used. So, applications are seldom, if ever, rejected because the commerce requirement hasn’t been satisfied. However, if you ever have to defend your registration—in court or before the PTO—you may be required to prove that the mark was in fact being used in commerce at the time of its registration.

## Is Your Mark Immoral, Deceptive, or Scandalous?

You may not register a mark if it:

- contains “immoral,” “deceptive,” or “scandalous” matter. For example, a mark resembling a sex organ would be considered immoral; a mark suggesting miracle properties in a product that are not substantiated would be deceptive; and a mark showing a mutilated corpse would be scandalous.
- disparages or falsely suggests a connection with persons (living or dead), institutions, beliefs, or national symbols (see examples, below)

- includes the flag or coat of arms or other insignia of the United States, any state or municipality, or any foreign nation, or includes any simulation of such flag or insignia
- consists of or contains a name, portrait, or signature of a particular living individual (except with his or her written consent) or the name, signature, or portrait of a deceased president of the United States during the life of his widow, if any (except with the written consent of the widow)
- is already taken by an organization that has been granted the exclusive right by statute to use the marks or symbol (such organizations include the Boy Scouts and the U.S. Olympic Committee, and the Department of the Interior for the character name Smokey the Bear)
- is misleading or just plain false (such as a trademark that suggests chocolate in a product that contains no chocolate), or
- is primarily a geographic name or a surname (see Chapter 3 for a discussion of these types of names and when they are and are not considered distinctive).

Examples of disparaging or unauthorized marks include:

- a mark showing a picture of the United States president standing on the American flag
- a baseball-related mark suggesting a connection with Babe Ruth (unless authorization was given by Babe Ruth's heirs), or
- a silhouette of a defecating dog (*Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635 (TTAB 1988)).

## If You Haven't Started Using Your Mark, Should You File an Intent-to-Use Application?

If you are not yet using your mark, you can wait until you put it into use before filing a trademark application, or you can file an application on the grounds that you intend to use it within six months of the date the

mark is approved for registration by the PTO. If you are unable to put the mark into use within that period, you can purchase additional six-month extensions, one at a time until three years have passed, if you are able to convince the PTO that the reasons for the delays are legitimate.

The advantage of filing an intent-to-use application is that your filing date will serve as the date of your first use of the mark—assuming you go on to put the mark in actual use and take the other steps necessary to get the mark placed on the federal trademark register. This first-use date can be very important in the event a conflict develops with another mark—in the PTO or in the marketplace. (See Chapter 1 for the importance of the date of first use.) Once you decide to file on this basis, you should do so as quickly as possible, to obtain the earliest possible date of first use.

As mentioned, the intent-to-use approach is more expensive than filing an actual use application—at least \$100 more expensive, plus \$150 for each additional six-month extension that is needed. Therefore, it is most appropriate to use the intent-to-use application when you have come up with a truly distinctive mark (see Chapter 3, “How to Choose a Good Name for Your Business, Product, or Service”) or you plan to spend big bucks “tooling up” to use the mark and you don’t want to lay out the cash until you know that the mark will be yours.

If your mark is legally weak—for instance, it uses common words in a common way or is descriptive of the products or services—you will have little choice but to wait until you have put the mark into use and can demonstrate that the public associates the mark with your product or service. Keep in mind that the PTO will only issue a Notice of Allowance for marks that are distinctive, either inherently or under the secondary meaning rule.



## FREQUENTLY ASKED QUESTION

### Why pay more for an intent-to-use application?

*“I’m starting a business and the domain has been registered. I’m looking into registering the trademark and thought about using an intent-to-use application (ITU) to reserve the name until we are up and running. I realized it costs more for ITU than regular registration. What is the benefit of ITU?”*

ITUs are relatively new on the trademark scene—debuting back in the late eighties. Before that you could only file if you were actually using the mark. With an ITU, you can now file if you have a bona fide intention to use the mark within six months of the date the mark is approved for registration by the USPTO. If you are unable to put the mark into use within that period, you can purchase additional six-month extensions, one at a time until three years have passed (provided you are able to convince the USPTO that the reasons for the delays are legitimate).

**The advantage of filing an intent-to-use application.** Besides the fact that you get to reserve a mark, your filing date will serve as the date of your first use of the mark—assuming you go on to put the mark in actual use and take the other steps necessary to get the mark placed on the federal trademark register. This first-use date can be very important in the event a conflict develops with another mark—in the USPTO or in the marketplace.

**Ready to go?** Once you decide to file on this basis and you are certain that you intend to use the mark, you should file as quickly as possible, to obtain the earliest possible date of first use. As you mentioned, the intent-to-use approach is more expensive than filing an actual use application—at least \$100 more expensive, plus \$150 for each additional six-month extension that is needed. Therefore, it is most appropriate to use the intent-to-use application when you have come up with a truly distinctive mark or you plan to spend big bucks “tooling up” to use your mark and you don’t want to prepare branding materials, and so on, until you know that the mark will be yours.

**Don’t do ITU if ...** We recommend against using the ITU process for a mark that is legally weak—for instance, it uses common words in a common way or is descriptive of the products or services. In those cases, you will have little choice but to wait until you have put the mark into use and can demonstrate that the public associates the mark with your product or service. Keep in mind that the USPTO will only okay an ITU application for a mark that is distinctive.

## What Examples of Your Mark Will You Submit With Your Application?



### SKIP AHEAD

**If you are filing an intent-to-use application, you will not yet have specimens and need not deal with this information at this time;** you should skip ahead to the next section. However, if and when you put the mark into use and file the proper documents necessary to complete the registration process, you will need the information in this section.

When applying for federal registration on an actual-use basis, you must submit an example of how your mark is being used in commerce, known as a specimen. If you plan to apply for registration under more than one trademark class, you will need to submit a separate specimen showing use for each class.

Most likely, you will be filing online using TEAS. In that case, you will need to submit the specimen as a JPEG file that can be “attached” to your online application. You should prepare this photographic or graphic file before beginning the application process. It must be under two megabytes file size and should be scanned at 300 DPI or higher.

If you are using the printed forms, you will need to include a physical specimen in your mailing to the PTO. The specimen may not exceed 8½ inches (21.6 cm) wide and 13 inches (33 cm) long, and it must be flat. There is no minimum size. As we emphasize later, the specimen must portray the exact same mark as appears in the drawing you will be submitting with the application.

### Specimens for Marks on Goods (Trademarks)

Specimens of how the mark is used with goods must show a very close association between the mark and the goods. Acceptable specimens usually include labels, tags, or containers showing the mark.

## Displays as Specimens for Goods

Displays, such as banners and window displays, may also be used, but with caution. The display must be meant to catch the buyer's attention where the sale is made (for instance, at the store), and the mark must be prominent and clearly connected to the goods. For example, a window sign in a drugstore that reads "See our All Ears earrings special!" would probably qualify as an appropriate specimen. However, the line between displays and advertising can be fuzzy, and advertising is not sufficient for specimens of marks used for goods. If you have a choice, use another type of specimen.

## Marks on Goods as Specimens

If you place your mark on your goods by using a rubber stamp or stencil, you may submit a specimen of an impression of the stamp or stencil on a piece of paper.

## Photographing Your Specimens

If your Solve-it Solvent mark is used in connection with 55-gallon drums of solvent and printed only on the drums, you would submit a photograph (in JPEG format, when filing electronically) of a drum or drums clearly showing the whole mark. The photograph must show the whole item, or enough of it so the examiner can clearly see what is shown in the picture, and all writing on the item must be visible. If a photograph of the whole item does not show the mark in enough detail, send one photo of the whole item and another close-up photo of the writing including the mark (the two photos together would constitute one specimen). If there is writing on more than one side, either send more than one photo or place several items in one photo so they show all sides of the item on which writing appears.

**EXAMPLE:** Suppose your mark Solve-it Solvent appears on the front and back of the drum in large type, surrounded by other writing describing the contents. Your first photo should portray three or four drums, each showing a different part of all the writing (Solve-it Solvent and the description). You would then want a few

more photos, from a closer range, so that by looking at them the examiner could see all the writing that appears on a typical drum. (Again, all the photos together would constitute one specimen.) If the writing could not be made legible for some reason (maybe too small to photograph well), a separate piece of paper including all text on the drum should also be submitted.

The reason all the writing has to be visible is that the PTO wants to see the context in which your mark is used to be sure it is consistent with the class under which you are registering the mark.

### **Domain Name Specimens**

If you are registering your entire domain name, the specimen should be a JPEG of your Web page showing your domain name. This can be done using the screen capture feature in Windows (try hitting Control and Print Screen simultaneously and then pasting that into a graphics program file) or by using a software program such as *Snag-It*. If you are just registering the unique part of your domain name (without the .com), your specimen may be an advertisement of your services. Either way, make sure your specimen shows your name exactly as you portray it in the “mark drawing” box in the application.

Your domain name specimen must show two things:

- You are using your domain name as a trademark. A specimen that shows your website and the domain name typed into the address line of your browser is not sufficient. Your domain name should be a prominent part of the design of your home page. Ideally, it should be at the very top of the page, easy to spot and easy to read, and it should dominate the quadrant of the page in which it is located.
- The services being offered on your website match the description of the services in your application. If you are providing financial information as your service, for example, make sure your specimen shows that you are doing so.

### If I Registered My Trademark, Do I Need to Register My Trademark.com?

Let's say you have been using the name Loudness as a trademark for a line of menswear. You registered Loudness with the PTO. Now you're going online and selling the same menswear on your website with the domain name Loudness.com. Do you need to register Loudness.com with the PTO?

In this case, there's little to be gained from registering Loudness.com with the PTO because you already have the ability to stop anyone from using Loudness for menswear whether they are selling it online or off. Another reason not to bother is that you cannot claim any separate trademark rights in ".com," because the PTO considers top-level domain terms such as ".com," ".org," and ".edu" unprotectible.

You should consider registering Loudness.com if you will be establishing some services or products unique to your Internet business. For example, if you are establishing an online store that will offer a fashion newsletter as well as your menswear, then you should consider registering Loudness.com.

### Unacceptable Specimens for Marks on Goods

The following are *unacceptable* specimens for marks on goods:

- advertising material, including anything that is produced for the sole purpose of telling potential buyers about your product, even if you package it with the goods (such as cards packaged with a new pen telling how wonderful it is and what it's made of)
- price lists, catalogs, trade directories, and publicity releases
- instruction sheets
- internal company documents, including invoices and memos sent within an applicant company
- specimens showing the mark with the ® symbol—it is illegal to use the ® symbol until after your mark is officially registered with the PTO (see Chapter 8, "How to Use and Care for Your Trademark"). Specimens with a TM next to the mark are okay.

- any use of the mark merely to identify your business (not in direct connection with particular goods or services), including letterhead stationery, labels carrying only a company name and return address, and bags and boxes used at store cash registers to carry sold merchandise.

## Specimens for Marks Used for Services (Service Marks)

When you are offering a service, you have no product to which you can affix a label. Acceptable specimens for services include a variety of materials that can't be used for product marks. This includes scanned copies of advertising and marketing materials, such as newspaper and magazine ads, brochures, billboards, direct mail pieces, and menus (for restaurants).

Letterhead stationery and business cards showing the mark may be used if the services are plainly reflected on them, because the name or symbol being claimed as a mark would, in that context, be used to identify the services provided—that is, as a mark rather than as a trade name (remember, trade names as such may not be registered—see the sidebar, “Trade Names,” below).

**EXAMPLE 1:** Etta's business cards for her personal computer consulting services include her mark Quick-Bytes and the text, “consulting services for the PC user.”

**EXAMPLE 2:** Toby's sports trivia 900 line grew and he had stationery printed, including the line, “Sportorific Gives You The Latest Sports Trivia 24 Hours A Day.” The stationery would be accepted as a specimen.

A letter on stationery will even be accepted as a specimen for a service mark if the mark appears and the services are described in the letter. Assume Toby's letterhead only said “Gen-X Sports” and gave the address and phone number. He could submit a copy of a letter sent to a national sports magazine asking that his 900 number be listed in its directory, as long as the letter described the services.

Gen-X Sports  
555 First Street, West  
Sonoma, CA 95476

Dear Sir or Madam:

As you may know, our sports trivia line, *Sportorific*, 900-555-7777, has been providing customers with sports trivia 24 hours a day for the past year. We would be honored if you would consider listing our line in your directory.

## Audio

Most marks appear in writing somewhere. If your mark represents a service, and it appears only on radio ads or in some other audio form, you may submit a sound file of the audio. This can be done through the TEAS application. The sound mark specimen, consisting of a WAV file or MP3 file, can be sent as an email attachment directly to the TEAS Support Team, at [teas@uspto.gov](mailto:teas@uspto.gov). However, because the TEAS form will require a JPEG attachment for the specimen, the applicant must still create a JPEG file for this purpose, but it will merely consist of a statement that “A WAV file (or MP3 file) has been sent directly to the TEAS Support Team for processing.” For easier association of the WAV (or MP3) file with the proper application, the applicant should submit the actual application first and then reference in the email to the TEAS Support Team the assigned serial number and an indication that this is a “new application.” All other filings (e.g., an Allegation of Use or a Section 8.) should be done in the same manner, with the serial number or registration number referenced in the email and a clear indication of the type of filing.

## Internet Pages

A screen shot of the full Web page should be fine. As noted, this can be done using the screen capture feature in Windows (hitting Control and Print Screen simultaneously and then pasting that into a graphics

program file) or by using a software program such as *Snag-It*. If the mark is being prominently displayed on the home page, so much the better.

### Unacceptable Specimens for Services

The following are unacceptable specimens for marks for services:

- news releases or articles based on news releases
- documents showing trademark rather than service mark usage (use of the mark in connection with goods rather than services)
- invoices and similar documents such as packing slips
- specimens showing trade name usage only (use of the mark to identify a company, such as on letterhead). As discussed earlier, one exception to this is if the letterhead or the text of the letter identifies the services represented by the mark.

#### Trade Names

A trade name is the name of a company and is not registrable as a trademark or service mark unless it is used for more than identification purposes. To be registrable, the trade name must also be used to identify goods the company sells (trademark) or to market or promote services (service mark). However, it is common for a company's trade name and the trademark used in providing the company's services to be the same, which makes the trade name registrable in its capacity as a mark.

## What International Class Is the Best Fit for Your Product or Service?

Part of the trademark registration process involves assigning your product or service to one or more international classes. A list of these classes is in Appendix A. We explain the classification system in Chapter 6.

If, after reading the material in Chapter 6, you are in doubt about the proper class or classes for your product or service, you can always

call the Applications section of the PTO and ask which class or classes may be appropriate for you. The clerk will answer your question and normally give you sound advice. Unfortunately, you don't have the legal right to rely on this opinion. If the person who eventually examines your application in the PTO disagrees with the answer you were given, you will have to assign a different class to the product or service.

It's possible to apply for registration of a mark under more than one class. The reason you would do this is that the class you register under can be an important determinant of the scope of protection you receive.

**EXAMPLE:** Etta, who both sells computer software and offers consulting services under the mark Quick-Bytes, registers the mark under Class 9 (electrical and scientific apparatus). This registration should go far to protect Etta against the same or similar marks used on computer software and other related products. But it may not protect her against uses of the mark in connection with computer services. Only if she also registers the Quick-Bytes mark under the appropriate service class (Class 35 or Class 41) will she obtain the maximum possible protection of her mark.



#### CAUTION

**The classification system is designed more for the convenience of the PTO when making registration decisions than as a means for the courts to determine whether infringement exists.** Quite simply, courts may find a likelihood of customer confusion (and thus infringement) where two marks are in different classes and find no likelihood of customer confusion where two marks are within the same class. Still, the more classes a mark is registered in, the wider the protection the courts are likely to give its owner.

The number of classes you should include in your initial application depends on your circumstances. The downside of registering under more than one class is that an additional application fee (currently \$325, if filing electronically) must be paid for each additional class. For this reason, applicants sometimes apply under one class and then wait to see

if the mark (and their business) is successful enough to warrant applying under other classes as well.

Some applicants who can afford the fees register under several classes in their initial application with the idea that this will preserve future rights in those classes and broaden the scope of protection by the courts. But the classes you can register under are restricted to those which encompass the goods or services you are already offering (as shown by the specimens you submit) or that you plan to offer (if you are registering on an intent-to-use basis). (See Chapter 6 for how to assign your product or service to the appropriate class.)

## Deciding How Many Marks You Want to Register

So far, we have assumed that you have one mark to register—typically a business or product name. However, what may seem like only one mark may in fact be viewed as several different marks. The most common examples of this are marks that combine graphic designs or distinctive typefaces with a business or product name and marks that combine a business or product name with a slogan. In these situations, the name can be considered as one mark while the combination of a graphic design or a slogan with the name may be viewed as a separate and distinct mark. On the front, back cover, and spine of this book you may find several manifestations of the word “Nolo”—for instance, Nolo with the scales of justice, or Nolo in connection with the website [nolo.com](http://nolo.com). Each of these manifestations using the word Nolo is really a separate mark.

The fact that you may be technically dealing with more than one mark doesn't mean that you have to register more than one mark. After all, the registration fee for each mark is \$325 if filing electronically, and funds may be too scarce to accomplish all possible registrations. Also, if you want to register a mark in more than one class, the combination of multiple marks and multiple classes can make it prohibitively expensive to cover all bases. Below, we suggest some ways to think about this issue for the most common multiple mark situations.

## **Name Marks Combined With Unusual Typefaces**

If your name mark uses an unusual typeface (the Nolo example described above), your mark has two important aspects—the words that constitute the name and the look and feel of the typeface. If money is no object, register both separately. But if funds are short—as they usually are—you probably will want to choose one or the other. As a general rule, you will be better off registering the unadorned name. This gives you the flexibility of using the name in many different configurations in the future without having to effect new registrations.

## **Name Marks Combined With Graphic Designs**

If you use your name with a graphic image—for example, the word Nolo with an image of the scales of justice—you will have several choices when it is time to register:

- Register the name alone.
- Register the combined name and graphic image.
- Register both the name and the combination of the name and graphic image.

Again, if money is no object, the last option is the best. But if every dollar counts, you should probably start with the combination name/graphic image, assuming the graphic image is distinctive. If the graphics are not particularly distinctive, however, register the name by itself. The idea is to get the most mileage for your initial registration, and if you are limited to one mark, it is wise to register the mark that has the most distinctive elements.

## **Applying for Registration Online**

Filling out and filing a trademark application for your mark with the PTO is a snap. The PTO website offers TEAS, an acronym for Trademark Electronic Application System. The TEAS program lets you complete and file the application online. According to the PTO,

it shouldn't take more than 20 minutes to complete the application, assuming you have the necessary information at your fingertips.

Although it's easy and quick to apply for trademark registration, the processing of your application by the PTO can take a year or more due to the fact that the PTO is swamped and understaffed. In the meantime, your actual or intended mark will appear (a few months after the filing date) in the PTO's trademark database as pending registration. This means that anyone doing a trademark search will likely find your mark and know that you are claiming it as yours. This in itself gives you a lot of protection because it will scare off potential copiers.



#### CAUTION

**Once you decide to register your mark with the PTO, get it done quickly.** If the PTO receives two or more applications for the same mark, the one filed first will be examined (reviewed by the PTO) and published for opposition first. All conflicting applications will wait in line until the outcome of the first application is known. Also, if you are filing an intent-to-use application (and you follow up by putting the mark into actual use and getting it placed on the federal trademark register), your date of filing will be the date of first use of your mark, which may prove very important in the event of a later conflict. Though it's impossible to say whether a particular filing date will make a difference in your particular situation, yours might be the one case in a thousand where a day's difference in filing date will mean that your rights are senior to another filer's.

#### But Wait ... There's More

Created in 1997, TEAS really only provided one service during the first four years of its existence—the ability to automate the preparation of a trademark application for the Principal Register. But, gradually, the PTO rolled out more online services and now offers a wide range of automated forms, including a Preliminary Amendment, Allegation of Use, Request for an Extension of Time, Request to Divide, Certification Mark applications, Collective Trademark/Service Mark applications, Collective Membership Mark applications, and application for filing on the Supplemental Register.

### The PTO Disfavors Hard Copy

For a variety of reasons, some people will prefer to work strictly with print copies of the trademark application and file them by mail. That is, instead of filling out an application on your computer, you may wish to complete the application by hand or by typing in the details. Unfortunately, the PTO has discontinued providing blank downloadable application forms. The PTO's reluctance to supply blank forms is part of its attempt to make the TEAS program the standardized format for filing. We support the use of TEAS instead of paper as the online filing procedure is less likely to result in errors, particularly for first-time filers.

## How to Use TEAS to Register Online

Using TEAS can be a pleasant experience. Just follow along with our step-by-step instructions below. If you need additional help, the PTO provides its own help system.

Your first step is to go to the PTO's website ([www.uspto.gov](http://www.uspto.gov)). On the home page, in the center, under "Trademarks," click "File Forms Online." This will take you to the Trademark Electronic Application System (TEAS) home page, entitled "TEAS Forms." (see Figure 1). Click "Initial Application Form" and that takes you to a new page (see Figure 2). Click "Trademark/Service Mark Application, Principal Register," and that takes you to a page entitled "Selection of Application Type" (see Figure 3) in which you must choose between the regular TEAS form and the TEAS Plus form.

The newer TEAS Plus form has a lower filing fee of \$275 per class of goods and/or services but has stricter requirements than the TEAS form. The idea behind TEAS Plus is to get you to use, as much as possible, preset choices and not, for example, enter free form text entries when selecting the listing of goods and services.

If you cannot meet any of the TEAS Plus requirements, you must pay an additional fee of \$50 per class. In a sense, this isn't really a penalty


United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

## Trademark Electronic Application System (TEAS) file online

### WARNING

Filing a trademark application is a legal proceeding that requires you to satisfy many legal requirements within strict time deadlines, all based on Eastern Standard Time. Click [here](#) for more information BEFORE you begin this process.

All trademark information you submit to the USPTO, including any information you enter in the electronic forms, will be available to the public.

### TEAS Forms

"Click" on the form category below to access a page for selection of a specific online form. To view an initial listing of all form titles within a specific category, simply "scroll over" the category heading.

- **INITIAL APPLICATION FORM**  
To apply to register a trademark/servicemark, Principal Register, or other type of mark
- **RESPONSE FORMS**  
To respond to a Law Office examining attorney letter (an "Office action") (a non-final or final action, including a suspension inquiry/letter of suspension or a request to submit a "substitute form" where the wrong form type was initially filed); an Intent-to-Use Unit Office action; a Post-Registration Division Office action; a Petitions Office letter
- **INTENT-TO-USE (ITU) FORMS ("File a PRE-registration form")**  
To file a Statement of Use (SOU) and convert an ITU application to actual use after a notice of allowance (NOA) issues; or to file an extension request after a NOA issues; or to file an Amendment to Allege Use (AAU) and convert an ITU application to actual use before a NOA issues; or to respond to an Intent-to-Use Unit Office action
- **POST-PUBLICATION/POST NOTICE OF ALLOWANCE (NOA) FORMS**  
To request amendment soon after an application has published or a notice of allowance (NOA) has issued; or to delete a Section 1(b) basis after a NOA issues
- **CORRESPONDENCE AND ATTORNEY/DOMESTIC REPRESENTATIVE FORMS**  
To file: a change of correspondence address, a change of owner's address, or a change of domestic representative's address; a withdrawal of attorney or domestic representative; a revocation/appointment of attorney/domestic representative; a request to replace attorney of record with another already-appointed attorney
- **PETITION FORMS**  
To file: a petition to revive an abandoned application; a petition to amend the basis of an application after publication; a petition to the Director under Trademark Rules 2.146 and 2.148; a letter of protest and similar matters; a response to a Petitions Office letter
- **MISCELLANEOUS FORMS**  
To file: a voluntary amendment not in response to USPTO Office action/Letter; a request that the application examination process be terminated (an "express abandonment"); a request to divide an application *NOT* filed with an allegation of use (to file WITH an allegation of use, see the overall category "Intent-to-Use (ITU) Forms," above)
- **REGISTRATION MAINTENANCE/RENEWAL FORMS**  
To make required maintenance filings between the 5th and 6th year after the registration date (Section 8) and between the 9th and 10th year after the registration date (Section 8 & 9); to claim that a mark is now incontestable (Section 15); to request amendment or correction of a registration certificate (Section 7); to surrender a registration; to request to divide a registration; to file a Section 12(c) affidavit; to submit the required maintenance filings under Section 71 for a registered extension of protection (Madrid Protocol); to respond to a Post-Registration Division Office action
- **ASSIGNMENT FORMS**  
To file: assignments; change of name; other conveyances of title
- **TRADEMARK TRIAL AND APPEAL BOARD FORMS**  
To file all submissions to the Trademark Trial and Appeal Board; e.g., oppositions, cancellations, notices of appeal after final actions
- **MADRID PROTOCOL FORMS**  
To file: an application for International Registration; a subsequent designation; a response to notice of irregularity; a request for replacement or transformation

### OTHER RESOURCES

- TEAS Technical Information: background technical help
- TEAS Tutorial: step-by-step approach for a new application
- Preview Pages: screenshots of all new application pages
- Electronic Filing Tips: best practices for filing electronically
- TEAS FAQs: most commonly asked questions/answers
- TEAS Up-Coming Enhancements: highlight of future plans

Figure 1

## Trademark Electronic Application System file online

### INITIAL APPLICATION FORMS

**Please click on the following to access a form for:**

■ **1. Trademark/Service Mark Application, Principal Register**  
 Use this form to file an initial application to register a TRADEMARK for "goods" and/or a SERVICEMARK for "providing services" (note that this form is appropriate for either, and that you will not actually specify the "type" of mark when filing). Only **one mark** is permissible per application, although a mark may consist of several elements that are joined to form a composite whole (e.g., words plus a design).

**NOTE:** If you file this application based only on an intent to use the mark in commerce *in the future*, rather than actual use in commerce now, you must later file another form (and additional fee) to establish use before we can register the mark, even if the mark has otherwise been approved based on the information in the original Trademark/Service Mark application. See listings under the overall category "INTENT-TO-USE (ITU) FORMS" on the TEAS front page.

**FEES:** The filing fee for the application is based on the following:  
 1. Number of classes of goods and/or services in the application. *i.e.*, if an application is for one mark, but the mark is used on goods and/or services in two different classes, *e.g.*, computer software in Class 9 and t-shirts in Class 25, then payment for two classes is required before the application could be approved.  
 2. Version of the form being used, *i.e.*, either the "TEAS Plus" form or the "regular TEAS" form. The application filing fee for the TEAS form is \$325 per class of goods and/or services, while the TEAS Plus is \$275 per class, but has **stricter** filing requirements, than the regular TEAS form. Clicking on the "Trademark/Service Mark Application, Principal Register" link above will take you to the page offering the two form versions, with more detailed instructions as to which version of the form may be most appropriate for your specific filing.

**WARNING:** The filing fee is a processing fee that the USPTO will **NOT** refund, even if the USPTO does not ultimately issue you a registration for your mark. Because approval is based on a legal determination by an examining attorney and is **NOT** automatic, please take all necessary steps to ensure your mark is registrable before filing an application.

**NOTE:** If you wish to apply for another type of mark or on a different register, click [here](#).

Figure 2

United States Patent and Trademark Office  
 Trademark Electronic Application System - TEAS

TEAS

**Trademark/Service Mark Application, Principal Register**

#### Selection of Application Type

Which type of form do you wish to use? Select from one of the two versions, below, and then click on the CONTINUE button at the bottom of the page.  
 WARNING: If attaching an image file, it MUST be in the JPG/PDF format (except for a mark image, which may only be JPG). NO OTHER IMAGE FILE TYPES ARE ACCEPTED.

**TEAS Plus Form**

This form has a lower filing fee of \$275 per class of goods and/or services, but has **stricter** requirements, than the TEAS form, below. Select this option **ONLY** if you agree to:

- file a "complete" application that satisfies all requirements set forth in [Rule 2.22\(a\)](#), not only the regular "minimum requirements" for obtaining a filing date. Almost all fields in this form are mandatory;
- select the listing of goods and/or services for this application directly from the USPTO's [Acceptable Identification of Goods and Services Manual](#). While certain listings will allow for "customization," total "free-text" entries for identifications **CANNOT** be made.  
*NOTE:* We strongly recommend that you confirm that your identifications appear in the Manual (using the provided link, above) **BEFORE** even entering the TEAS Plus form; otherwise, you may spend time completing some of the application, only to discover you were not eligible for a TEAS Plus filing once you reach the Goods/Services section of the form. If the terms) does not appear, you can request that an identification be added, by e-mailing [TMDSUGGEST@uspto.gov](mailto:TMDSUGGEST@uspto.gov); however, this would not enable you to file immediately. For more information on this process, click [here](#). The TEAS Plus version of the Manual intentionally does not include items classified in Classes A, B, or 200, because those marks are not eligible for filing under TEAS Plus. Also missing are any listings that appear in the "regular" manual under "000," because correct classification is required under TEAS Plus, and classification for these listings varies according to the additional information provided within the listing.
- attach all required image files, where applicable, in the .jpg format (for specimens, foreign registration certificates, consents, evidence) (except for sounds marks, for which a .wav or .mp3 file can be submitted separately);
- pay the fees for ALL classes at the time of filing;
- file certain later communications regarding the application, such as a response to an Office action, through TEAS. See [Rule 2.22\(a\)\(1\)](#) for the listing of forms that must be filed through TEAS; and
- receive communications concerning the application by electronic mail (e-mail) during the pendency of the application.

**NOTE:** If you use the TEAS Plus version of the form, you must pay an additional fee of \$50 per class if, at any time during the examination of the application, the Office determines that (1) the application did not meet the filing requirements for a TEAS Plus application as of the filing date, as set forth in [Rule 2.22\(a\)](#); (2) the applicant files a paper form after the initial application, but a TEAS form existed for that purpose, e.g., a response to an Office action, and/or (3) the applicant refuses to receive correspondence from the Office by [electronic mail \(e-mail\)](mailto:electronic_mail) during the pendency of the application.

**TEAS Form**

You must select this option, having a filing fee of \$325 per class of goods and/or services, if you:

- cannot file a "complete" application at this time, satisfying all requirements as set forth in [Rule 2.22\(a\)](#), but instead can meet only the "minimum requirements" for obtaining a filing date. Only certain fields on this version of the form are mandatory;
- wish to make a "free-text" entry for the listing of goods and/or services for this application, rather than selecting the listing directly from the USPTO's [Acceptable Identification of Goods and Services Manual](#) (except from any permissible "customization" within certain listings);
- are unable either to create or successfully attach in the designated portion(s) of the form a proper .jpg image file, if applicable for the application (for specimens, foreign registration certificates, consents, evidence);
- wish to pay for only one class at the time of filing, although the application as filed will consist of multiple classes;
- plan later to file certain communications regarding the application, such as a response to an Office action, in paper rather than through TEAS. See [Rule 2.22\(a\)\(1\)](#); and
- do not agree to receive communications concerning the application by electronic mail (e-mail) during the pendency of the application.

CONTINUE

Figure 3

since that's how much you would have to pay to file a typical TEAS application.

So, for that reason, if you have everything ready to go, try the TEAS Plus as your first choice for filing.

We'll proceed through the rest of the section as if you were filing a typical TEAS application since that is the most commonly used application form (the TEAS and TEAS Plus applications are nearly identical). Choose the TEAS form by clicking on the button and then click "Continue" on the bottom of the page.

After you choose the TEAS form, you will arrive at a page entitled "Trademark/ Servicemark Application, Principal Register" (see Figure 4, below) that contains filing instructions.

Carefully read the information at the top of the screen. The first block explains the help system and lets you turn off the help text that automatically appears at the bottom of the page. It also explains that only the blanks marked with an asterisk are mandatory. We recommend that you leave the help on and read the help for each step. We also recommend that you be as complete as possible in your responses; even if the information isn't mandatory, supplying it may save you time and trouble down the line.

Some of the nonmandatory information may be useful to the examiner in evaluating your application and expeditiously communicating with you if a problem arises. For example, your phone number isn't mandatory, but how will the examiner call you if you don't include it?

Near the bottom of the page is the first question in the process—whether an attorney is filing the application. If the answer is "No," click that button.

Beneath that question, the PTO gives you the option to import any previously saved data, if you have any. (First-time filers won't need this option.) Click "Continue."

United States Patent and Trademark Office  
Trademark Electronic Application System - TEAS Application

Navigation History: [Introduction](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Con. Req./Correspondence](#) > [Fee/Signature](#)

PTO Form 1478 (Rev. 1/2006)

### Trademark/Service Mark Application, Principal Register TEAS Plus Application (Version 4.6)

To file the application electronically, please complete the following steps:

1. Answer the first question below to create an application form showing only sections relevant to your specific filing.
2. For help at any point, click on any underlined word on any page.
3. After answering the first wizard question, click on the CONTINUE button at bottom of the page.
4. Once in the actual form, complete all fields with a \* symbol, since they are mandatory fields for TEAS filing purposes.
5. Validate the form, using the "Validate" button at the end of the form. If there are errors, return to the form to make the correction. A "Warning" may be corrected or by-passed.
6. Double-check all entries through the links displayed on the Validation page.
7. You may save your work for submission at a later time by clicking on the Download Portable Data button at the bottom of the Validation page.
8. When ready to file, use the Pay/Submit button at the bottom of the Validation page. This will allow you to choose from three (3) different payment methods: credit card, automated deposit account, or electronic funds transfer.
9. After accessing the proper screen for payment, and making the appropriate entries, you will receive a confirmation screen if your transmission is successful. This screen will say SUCCESS! and will provide your assigned serial number.
10. You will receive an e-mail acknowledgement of your submission, which will repeat the assigned serial number and provide a summary of your submission.

Once you submit this application, we will not cancel the filing or refund your fee. The fee is a processing fee, which we do not refund even if we cannot issue a registration after our substantive review.

**Important:** ONCE YOU SUBMIT AN APPLICATION ELECTRONICALLY, THE USPTO WILL IMMEDIATELY ISSUE AN ELECTRONIC ACKNOWLEDGMENT OF RECEIPT. Please contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov) if you do not receive this acknowledgment within 24 hours of transmission.

**Contact Points:**

- **General trademark information:** Please review the information posted at [Where Do I Start](#). If you have remaining questions, e-mail [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov), or telephone 1-800-786-9199.
- **Help:** For instructions on how to use the electronic forms, or help in resolving technical glitches, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). Please include your telephone number in your e-mail, so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.

NOTE: The TEAS Support Team focuses on problems related to the process of completing the electronic forms, not on what information would be correct for entry within a form, or other broader trademark issues. Please route those types of inquiries to the Trademark Assistance Center. However, please be aware that neither group can provide any sort of information in the nature of "legal advice." For legal advice, please consider contacting an attorney who specializes in intellectual property.

- **Bug Report:** If you think there is a "bug" within one of the electronic forms, please click [Bug Report](#).
- **Status Information:** For an application with an assigned serial number, check [Trademark Applications and Registrations Retrieval](#) to view current status information, as well as the complete prosecution history. Do not attempt to check status until at least 7-10 days after submission of a filing, to allow sufficient time for all USPTO databases to be updated. You can view all items listed in the prosecution history section online at [Trademark Document Retrieval](#), including all office actions sent by the USPTO.

WARNING: This form has a session time limit of 60 minutes. Your "session" began as soon as you accessed this initial Form Wizard page. If you exceed the 60-minute time limit, the form will not validate and you must begin the entire process again; you can, however, extend the time limit. You should always try to have all information required to complete the form prior to starting any session.

**1. Is an attorney filing this application?**

Yes  No

**2. [OPTIONAL] To access previously-saved data, use the "Browse/Choose File" button below to access the file from your local drive. NOTE: For specific instructions, please click here. FAILURE TO FOLLOW THESE NEW INSTRUCTIONS WILL RESULT IN THE DISPLAY OF YOUR DATA IN AN XML FORMAT THAT CANNOT BE EDITED. NOTE: Do NOT attempt to use the button below to upload an image file (for example, a specimen). You must use the button that will be presented for that purpose within the proper section of the actual form.**

no file selected

Figure 4

This will take you to the page where you enter “Applicant Information” (see Figure 5).

**Applicant Information.** Provide the name of the owner (your business or you), choose your Entity Type, and complete the relevant associated drop-down information—country of citizenship, and so on. Provide your street address, city, state, country, zip code, phone number, fax number, and email address. All of these information blanks come with excellent help should you need it.

United States Patent and Trademark Office  
 Trademark Electronic Application System - TEAS Application

Navigation History: [Instruction](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Con. Rep./Correspondence](#) > [Fee/Signature](#)

### Trademark/Service Mark Application, Principal Register

**Applicant Information**

**Note:** This identifies who owns the mark, not necessarily who is filing the application.  
**Note:** If there is more than one owner of the mark, complete the information for the first owner, and then click on the "Add Owner" button at the bottom of this page.  
**Repeat,** as necessary, for the appropriate listing of all owners. **Warning:** It is important to determine whether, in fact, the applicants are joint applicants, or some other entity type listed below.

<b>* Owner of Mark</b>	Richard Stim <small>(If an individual, use the following format: Last Name, First Name Middle Initial or Name, if applicable)</small>
<input type="checkbox"/> DBA (doing business as) <input type="checkbox"/> AKA (also known as) <input type="checkbox"/> TA (trading as) <input type="checkbox"/> Formerly	
<b>* Entity Type</b>	<input checked="" type="radio"/> Individual <input type="radio"/> Corporation <input type="radio"/> Limited Liability Company <input type="radio"/> Partnership <input type="radio"/> Limited Partnership <input type="radio"/> Joint Venture <input type="radio"/> Sole Proprietorship <input type="radio"/> Trust <input type="radio"/> Estate <input type="radio"/> Other
<b>* Country of Citizenship</b>	United States
<b>* Street Address</b>	950 Parker Street <small><b>NOTE:</b> You must limit your entry here, and for all remaining fields within this overall section (except City, see below), to no more than 40 characters (the storage limit for the USPTO database). You may need to abbreviate some words, e.g., St. instead of Street. Failure to do so may result in an undeliverable address, due to truncation at the 40-character limit.</small>
<b>Internal Address</b>	
<b>* City</b>	Berkeley <small><b>NOTE:</b> You must limit your entry here to no more than 22 characters.</small>
<b>* State</b> <small>(Required for U.S. applicants)</small>	California <small><b>NOTE:</b> You must include as part of the "city" entry any information related to geographical regions (e.g., provinces) not found in the dropdown lists for "States" or "Countries." Enter the city and then the geographical region, separated by a comma (e.g., Toronto, Ontario). In most instances, you will then also have to select the country within which the region is found, below.</small>
<b>* Country or U.S. Territory</b>	United States
<b>* Zip/Postal Code</b> <small>(Required for U.S. applicants only)</small>	94710
<b>Phone Number</b>	510-704-1976
<b>Fax Number</b>	
<b>Internet E-mail Address</b>	richstim@nolo.com <small>While the application may list an e-mail address for the applicant, only the e-mail address of applicant's attorney or domestic representative will be used for actual correspondence purpose, in accordance with Office policy.</small>

Figure 5

When finished, click “Continue.” This will take you to a Web page where you will enter information about your mark (see Figure 6).

**Mark Information.** Here you have a choice. If your mark consists of unstylized words or numbers (or both), click the button next to the words “Standard Characters.” In the box just below the words “Enter the mark here,” enter your mark. If your mark is a domain name, you can enter the complete domain name, including the .com, or just the unique part of your name. For instance, Nolo might choose to register its domain name as Nolo.com or just Nolo. Because domain names are

United States Patent and Trademark Office  
Trademark Electronic Application System - TEAS Application

Navigation History: [Instruction](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Dom. Rep./Correspondence](#) > [Fee/Signature](#)

### Trademark/Service Mark Application, Principal Register

#### Mark Information

Before the USPTO can register your mark, we must know exactly what the mark is. You may present your mark either as: (1) standard characters; or (2) special form (stylized and/or design). In this section of the form, you must present the mark *by itself*. If you are already using the mark in commerce, do **not** show here how the mark appears on a specimen (sample of actual use, e.g., a label or advertisement. This will be required in a different part of the form, if appropriate.) Also, you may submit only **one** mark per application. An application that includes multiple marks may be denied a filing date or refused registration.

When you click on one of the two circles presented below, and follow the specific instructions, the system will automatically create a separate page that displays your mark. Please carefully review this page prior to final submission to the USPTO, to ensure that it accurately identifies your mark. You may not be able to change or correct your mark after filing this application. While minor changes in the mark are *sometimes* permitted, any material alteration will not be permitted and will result in the examining attorney issuing a refusal on that ground.

**WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED. AFTER YOU FILE AN APPLICATION, THE USPTO WILL PERFORM ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.**

\* Click the appropriate circle to indicate the Mark type:  Standard Characters  Special Form (Stylized and/or Design)

Enter the mark here: (Note: The entry can be in capital letters, lower case letters, or a combination thereof. Do **not** include the "™," "®," or "©" symbols after the mark entry, because they are **not** part of the actual mark. If using Internet Explorer, the entry cannot exceed 2038 characters; otherwise, you must switch to another browser.)

Hooky Wooky

NOTE: For how the USPTO determines what the display of the entered mark will be, click [here](#).

Check here if you need to enter an additional statement, e.g., a disclaimer, translation, or claim of ownership. The full range of possible statements will then be displayed. If, upon review of all of the statements, you realize that no statement is needed, you must click on the box to "uncheck" it, and the entire Additional Statement section will be removed.

NOTE: You **MUST** enter certain additional statements (those designated within the section with an asterisk (\*)) at the time you file this application, if applicable under the specific application facts, to qualify as a TEAS Plus filing. Failure to do so will result in the examining attorney requiring the payment of an additional \$50 fee per class, because the application will lose its TEAS Plus status; therefore, you are encouraged to review the additional statement section in its entirety before proceeding to the next section.

Figure 6

such a new species of trademark, there are no firm rules. If your mark is stylized or in design format (such as a logo or trade dress), read the help and attach a JPEG file showing the mark. Keep in mind that there is a two-megabyte limitation on each graphic file submitted to the USPTO. By clicking the button “Preview USPTO-Generated Image” you can view how your mark will be entered into the USPTO system (see Figure 7). When done, click “Continue” on the bottom of the page.

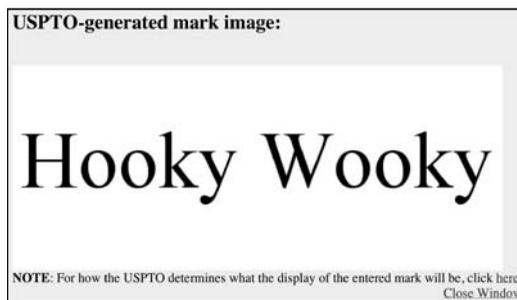


Figure 7



## CAUTION

**If you are filing for a stylized mark (you want the word to appear in a specific graphic manner) or design mark, you must submit two types of image files:** One is the graphic file showing the mark, the other is the specimen—the mark as used in commerce (see below). Be careful not to confuse the images, by attaching an image meant to be a specimen as the mark image because in most instances this is often difficult to correct.



## CAUTION

**If scanning any image that is to be a black-and-white image, the scanner must be set specifically for black and white, not color.** If the improper setting is used, the produced image may appear to be black and white, but will actually consist of thousands of colors, and it will result in an image of unacceptable quality when received at the USPTO. In addition, images with thousands of colors may exceed the two-megabyte limitation.

Next you will see the page where you enter “Goods and/or Services Information” (see Figure 8).

If you are unsure of your goods or services (or if you are using TEAS Plus), you will need to search the IDManual. Click the “Add Goods/ Services” button and that will take you to a search page where you can type in your goods to get the proper International Classification (see Figure 9). We typed in “crochet hats” and then checked Class 25. Then we clicked “Insert Checked Entries.”

Next you will be taken to the page seeking your “Basis for Filing” (see Figure 10).

**Filing Basis.** If you are already using the mark on goods or services, select the button for “Section 1(a).” If you are not yet up and running with your mark, select “Section 1(b)” to file an Intent to Use mark.

The procedures for each filing basis are somewhat different, and the intent-to-use basis will cost an additional \$100 when you do put the trademark into actual use.

United States Patent and Trademark Office  
 Trademark Electronic Application System - TEAS Application

Navigation History: Instruction > Applicant > Mark > Goods/Services/Filing Basis > Attorney/Dom. Rep./Correspondence > Fee/Signature

### Trademark/Service Mark Application, Principal Register

#### Goods and/or Services Information

**Instructions:**  
 Step 1: Click on the "Add Goods/Services by Searching IDManual" button below to select goods and/or services from the *Manual of Trademark Acceptable Identifications of Goods & Services* (IDManual).  
 Step 2: After creating the complete list of goods and/or services for this application, you will then be able in the next section of the form to designate the filing basis (or bases) appropriate for each listed item.

**NOTE:**

- The desired term(s) must appear in the IDManual for you to use the TEAS Plus form. If the term(s) does not appear, you can request that an identification be added, by e-mailing [TMIDSUGGEST@uspto.gov](mailto:TMIDSUGGEST@uspto.gov); however, this would not enable you to file immediately. For more information on this process, click [here](#).
- The TEAS Plus version of the IDManual intentionally does not include the following: (1) items classified in Classes A, B, or 200, because those marks are not eligible for filing under TEAS Plus; (2) any listings that appear in the "regular" manual under "000," because correct classification is required under TEAS Plus, and classification for these listings varies according to the additional information provided within the listing; and (3) the Class 25 listing of "Clothing, namely, ...", because this entry is too open-ended, and could result in items being listed that do not truly fall within this class. Since specific clothing items must be listed anyway, the TEAS Plus version of the form requires the *initial* selection of those specific items.
- If you cannot access the IDManual through the "Add Goods/Services by Searching IDManual" button, try switching to another browser. If after changing browsers you still cannot access the IDManual through the "Add Goods/Services by Searching IDManual" button, please contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**WARNING:** This form has a session time limit of 60 minutes. Your "session" began as soon as you accessed the initial Form Wizard page. If you exceed the 60-minute time limit, the form will not validate and you must begin the entire process again; you can, however, extend the time limit. You should always try to have all information required to complete the form prior to starting any session.

**NOTE:** Clicking "Go Back" will take you directly back to the MARK section of the form.

Figure 8

United States Patent and Trademark Office  
 Trademark Electronic Application System - Trademark ID Manual

Search for:

Found 41 entries in 3 page(s) for [crochet hat]: (For instructions on how to build the complete goods/services list, click [here](#).)

International Class	Description
<input type="checkbox"/> 006	Hat-hanging hooks of metal
<input type="checkbox"/> 009	Hard hats
<input type="checkbox"/> 014	Hat ornaments of precious metal
<input type="checkbox"/> 014	Jewelry pins for use on hats
<input type="checkbox"/> 016	Hat boxes of cardboard
<input type="checkbox"/> 016	Hat boxes of paper
<input type="checkbox"/> 018	Hat boxes for travel not of paper or cardboard
<input type="checkbox"/> 018	Hat boxes of leather
<input type="checkbox"/> 020	Hand-painted plastic foam display heads used to display merchandise such as hats, wigs, glasses and similar items for the human head
<input type="checkbox"/> 020	Hat boxes for storage made of plastic
<input type="checkbox"/> 020	Hat racks
<input type="checkbox"/> 020	Hat stands
<input type="checkbox"/> 025	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms
<input type="checkbox"/> 025	Baseball caps and hats
<input type="checkbox"/> 025	Chef's hats
<input type="checkbox"/> 025	Fur hats
<input type="checkbox"/> 025	Hat bands
<input type="checkbox"/> 025	Hats
<input type="checkbox"/> 025	Hats for infants, babies, toddlers and children
<input type="checkbox"/> 025	Headgear, namely, (specify type, e.g., hats, caps)

1 2 3 Next >

Figure 9

United States Patent and Trademark Office  
 Trademark Electronic Application System - TEAS Application

Navigation History: [Instructor](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Com. Rep./Correspondence](#) > [File/Signature](#)

PTO Form 1478 (Rev. 9/2005)  
 DHB No. 0651-0009 (Rev. 12/31/2011)

### Trademark/Service Mark Application, Principal Register TEAS Plus Application (Version 4.6)

#### Basis for Filing

Applicant requests registration of the trademark/service mark identified previously with the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 *et seq.*) for the Class(es) and Goods and/or Services displayed below, and asserts herein the specific basis(es) that covers the listed Goods and/or Services.

**Instructions for assigning filing basis(es):**  
 For each of the items listed in the chart below, you can assign a specific filing basis, or if appropriate, multiple bases. If the list is incorrect, you can either add or delete items, using the appropriate buttons, *below*. For an explanation of the possible filing basis(es), as identified by the 4 buttons beneath the listing of goods/services, click *here*.

For complete step-by-step instructions on how correctly to assign the filing basis(es), click on the heading that corresponds to the factual scenario for this specific filing, *below*. For examples of filings corresponding to each of the heading descriptions, click on the link "Examples."

- One class or multiple classes, with ONE filing basis for ALL listed items *Examples*

**NOTE:** This is the most common correct choice for any filing. The following are other options, but are much less likely to be appropriate:

- One class or multiple classes, with same multiple filing bases for ALL listed items in class(es) *Examples*
- One class or multiple classes, with different filing basis(es) for different goods/services within the same class, and/or for different overall classes *Examples*

For instructions on how to add item(s) to the list displayed below, click *here*. For instructions on how to remove any item(s), click *here*.

<input checked="" type="checkbox"/> Select All	International Class	Goods and/or Services	Assigned Filing Basis(es)
<input checked="" type="checkbox"/>	025	Hats	

**NOTE:** The 4 BUTTONS below identify the choices of filing basis to be assigned to the items listed in the table, *above*. For an explanation of each basis, click *here*. Because assignment of the correct basis to each item is critical, please read the explanations if you have any questions as to which basis(es) to select, before clicking the button(s), *below*, to begin the assignment of the basis(es).

**WARNING: Registration Subject to Cancellation for Fraudulent Statements**  
 You must ensure that statements made in filings to the USPTO are accurate, as inaccuracies may result in the cancellation of a trademark registration. The lack of a bona fide intention to use the mark with all goods and/or services included in an application, or the lack of use on all goods and/or services for which you claim use, could jeopardize the validity of the registration and result in its cancellation.

Actually using mark in commerce now      No use of mark yet, intending to use      Foreign application exists for same goods/services      Foreign registration exists for same goods/services

**NOTE:** Clicking "Go Back" will take you directly back to the MARK section of the form. Clicking "Continue" prior to assigning a filing basis will result in an error.

Figure 10



**CAUTION**

**Previous foreign registration.** If you are filing in the United States on the basis of a previous foreign registration, see a lawyer before continuing. This book doesn't cover U.S. registrations based on foreign registrations.

After you click the button for your basis for filing, you will need to enter additional information and attach a specimen (see Figure 11).

**Attach Specimen.** If you're filing under Section 1(a), you'll need to provide a specimen image file in JPEG format as well as a description of the specimen in the next box. The file should be scanned at least at 300 DPI and should be less than two megabytes. When you click to attach the specimen you will be shown a typical upload screen (see Figure 12) that you can use to find the file and upload it from your computer.

United States Patent and Trademark Office  
 Trademark Electronic Application System - TEAS Application

Navigation History: [Introduction](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Don. Rep./Correspondence](#) > [Fee/Signature](#)

PTO Form 1478 (Rev. 1/2006)  
 OMB No. 0651-0009 (Exp. 12/31/2011)

### Trademark/Service Mark Application, Principal Register

#### TEAS Plus Application (Version 4.6)

**Basis for Filing**

Applicant requests registration of the trademark/service mark identified previously with the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 *et seq.*) for the Class(es) and Goods and/or Services displayed below, and asserts herein the specific basis(es) that covers the listed Goods and/or Services.

Instructions for assigning filing basis(es):  
 For each of the items listed in the chart below, you can assign a specific filing basis, or if appropriate, multiple bases. If the list is incorrect, you can either add or delete items, using the appropriate buttons, *below*. For an explanation of the possible filing basis(es), as identified by the 4 buttons beneath the listing of goods/services, click *here*.

For complete step-by-step instructions on how correctly to assign the filing basis(es), click on the heading that corresponds to the factual scenario for this specific filing, *below*. For examples of filings corresponding to each of the heading descriptions, click on the link "Examples."

- **One class or multiple classes, with ONE filing basis for ALL listed items** *Examples*
- NOTE: This is the most common correct choice for any filing. The following are other options, but are much less likely to be appropriate:
- **One class or multiple classes, with same multiple filing bases for ALL listed items in class(es)** *Examples*
- **One class or multiple classes, with different filing basis(es) for different goods/services within the same class, and/or for different overall classes** *Examples*

For instructions on how to add item(s) to the list displayed below, click *here*. For instructions on how to remove any item(s), click *here*.

	International Class	Goods and/or Services	Assigned Filing Basis(es)
<input checked="" type="checkbox"/>	025	Hats	

**Section 1(a). Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, or the applicant's predecessor in interest used the mark in commerce, or in connection with the identified goods and/or services. 15 U.S.C. §1051(a), as amended. Applicant attaches, or will later submit, one specimen as a JPG/PDF image file showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, regardless of whether the mark itself is in the standard character format or is a stylized or design mark. The specimen image file may be in color, and the image must be in color if color is being claimed as a feature of the mark.

NOTE: For attachment, the JPG/PDF image file(s) showing the specimen(s) must be on your local drive. The specimen image file must show the overall context of how the mark is used, e.g., on the packaging for the goods or in an advertisement for services, with the mark clearly displayed thereon or within. This image file should NOT be either (1) the same file used in the mark section; or (2) a newly-created image that nonetheless shows only the mark by itself. (Reminder: Within the earlier mark section, if you attached an image file for a stylized/design mark, you must ensure that it only shows the mark by itself, and does not display anything that would not truly be considered part of the actual mark, e.g., a scan of a complete business card would not be an acceptable mark image, although it may be an acceptable specimen).

* Attach Specimen	<div style="text-align: center; border: 1px solid black; padding: 2px; margin-bottom: 5px;"> <input type="button" value="Attach/Remove Specimen"/> </div> <input type="checkbox"/> Check this box if you are attaching a color specimen. NOTE: Check only if you believe your specimen is in color, yet you received after clicking the "CONTINUE" button a WARNING about lack of color within the specimen. Otherwise, do not check this box, because the attached image was automatically accepted as color.
Description of Specimen	<input style="width: 100%;" type="text" value="a label applied to the goods"/>
* Date of First Use of Mark Anywhere	By the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as <input style="width: 100%;" type="text" value="11/01/2001"/> (MM/DD/YYYY)
* Date of First Use of the Mark in Commerce	By the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as <input style="width: 100%;" type="text" value="12/01/2001"/> (MM/DD/YYYY)

Foreign application exists for same goods/services
  
Foreign registration exists for same goods/services

NOTE: To assign the selected filing basis, click on "Assign Filing Basis" button, below. If you selected the wrong basis, click on the "Remove this [basis]" button, above, and start over. To assign multiple bases, click on another basis button and complete the section (and repeat process again, if appropriate) before clicking on the "Assign Filing Basis" button.

Figure 11

United States Patent and Trademark Office  
Trademark Electronic Application System - TEAS Application

**Trademark/Service Mark Application, Principal Register**  
**TEAS Plus Application**

**NOTE:** You must **"Browse/Choose File"** AND **"Attach"** each file, as described in Steps 1 and 2 below. If you do NOT click on the **"Attach"** button after selecting the correct file via the **"Browse/Choose File"** button, the file will not be attached to the form.  
**WARNING:** The file **MUST** be in the JPG/PDF format, and the size cannot exceed 5 megabytes per attachment.

**Click on the "Browse/Choose File" button to select a file you wish to upload:**

C:\Documents and Settings\Ricky\My Document

Status:  
File Uploaded:

To attach an image, please complete the following steps:

1. Click on **"Browse/Choose File"** button to select the scanned file (JPG/PDF format only) from your local drive.
2. Click on **"Attach"** button to attach the selected file.
3. To attach additional file(s), return to step 1.
4. To remove unwanted file(s), simply clicking **"Remove"** button right below the file(s).
5. Click on **"Return to Application"** and return back to the form, but **ONLY** once you see the file(s) loaded above.

**WARNING:** A submission must be complete within the "4 corners" of the actual transmitted document. Information only accessible through a link, but not part of the submission itself, will **NOT** be considered to be made of record. E.g., if you wish a catalogue to be considered as evidence, you must present the actual pages of the catalogue, and not merely reference that the catalogue is available for viewing at a particular url. The url will **NOT** be independently accessed as part of the examination process, and any materials presented only "by reference" will not constitute part of the actual file.

Figure 12

When you are done, click “Return to Application.”

If you’re an intent-to-use applicant, you will not have a specimen information section on your application and should go to the next step.

**Description of Specimen.** The next part of the specimen box asks you to describe the specimen. See the help topic for what is required.



#### CAUTION

**As you fill in the form, make sure that your specimen, mark information, and description of goods and services are all consistent with each other.** That is, if your specimen shows a different mark than what you enter in the Mark Information box (or submit in a JPEG file), you’ll have some explaining to do. Similarly, if your specimen shows a different product or service than you describe in the application, you’ll have to submit another specimen or change your product/service description. If you are filing an intent-to-use application, you won’t be worried about the specimen requirement at this stage in the process, but you will ultimately have to submit a specimen (once you begin using the mark) to complete your registration.

### Fraudulent Statements Can Result in Loss of Your Trademark Registration

The Trademark Trial Appeal Board cancelled three trademark registrations after receiving evidence from a competitor that the trademark owner had made fraudulent statements regarding its dates of use. (*Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917 (TTAB 2006).)

Note that not every false statement made on a trademark application amounts to fraud. A misstatement regarding whether commerce was intrastate or interstate did not amount to a fraudulent statement. (*Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 U.S.P.Q.2d 1899 (TTAB 2006).)

**Date of First Use of Mark Anywhere.** Here you are asked to provide the date you first started using the mark in connection with your product or service in the marketplace.

**Date of First Use of the Mark in Commerce.** Enter the date when you first used the mark in commerce across state, territorial, or international borders. If you have an existing business, this date may be different than the date of first use that you just entered. For example, you may have first used the name to market your local business and later gone national or international. The first date would be your use anywhere, and the second date would be the date the scope of your business expanded.

If you've been using a mark for years and don't remember the exact date of its first use anywhere or across state lines, make your best estimate. Use dated documents that you have gathered over the years, such as old advertisements or business licenses, to help jog your memory. If necessary, use imprecise dates, such as "before March 25, 1998," "on or about January 16, 1975," "in 1966," or "in February 1984." Use the earliest possible date that you can reasonably assert as correct.

**Correspondence Information.** Next you will be taken to a Web page where you provide information that enables the USPTO to contact you regarding the application (see Figure 13.) Note: This information becomes part of the public record. You can also use this page of the form to indicate whether you want the USPTO to communicate with you

**United States Patent and Trademark Office**  
Trademark Electronic Application System - TEAS Application

Navigation History: [Instruction](#) > [Applicant](#) > [Marks](#) > [Goods/Services/Filing Basis](#) > [Attorney/Dom. Rep./Correspondence](#) > [Fee/Signature](#)

PTO Form 1478 (Rev 9/2006)  
OMB No. 0651-0009 (Exp 12/31/2011)

### Trademark/Service Mark Application, Principal Register

#### TEAS Plus Application (Version 4.7)

Check here if an attorney is filing this form on behalf of applicant(s). If an attorney is not filing, simply click on the box if currently checked to "uncheck" that box.

Check here if the applicant wishes to appoint a Domestic Representative. A Domestic Representative is OPTIONAL if the applicant's address is outside the United States. Once checked, a separate section of the form will appear to enter the Domestic Representative information.

**Correspondence Information**

**Note:** If both boxes above are unchecked, the owner of the mark's address will be listed as the correspondence address. If a different address should be used for correspondence purposes, simply delete the information currently displayed below by entering the cursor in each field to be changed, removing the current information, and typing in the new data.

<b>* Name</b>	Rich Stim
<b>Docket/Reference Number</b>	
<b>Firm Name</b>	
<b>Internal Address</b>	
<b>* Street Address</b>	950 Parker Street <small><b>NOTE:</b> You must limit your entry here, and for all remaining fields within this overall section (except City, see below), to no more than 40 characters (the storage limit for the USPTO database). You may need to abbreviate some words, e.g., St. instead of Street. Failure to do so may result in an undeliverable address, due to truncation at the 40 character limit.</small>
<b>* City</b>	Berkeley <small><b>NOTE:</b> You must limit your entry here to no more than 22 characters.</small>
<b>* State</b> <small>(Required for U.S. applicants)</small>	California <small><b>NOTE:</b> You must include as part of the "city" entry any information related to geographical regions (e.g., provinces) not found in the dropdown lists for "States" or "Countries." Enter the city and then the geographical region, separated by a comma (e.g., Toronto, Ontario). In most instances, you will then also have to select the country within which the region is found, below.</small>
<b>* Country or U.S. Territory</b>	United States
<b>* Zip/Postal Code</b> <small>(Required for U.S. applicants only)</small>	94710
<b>Phone Number</b>	510-527-1976
<b>Fax Number</b>	
<b>* Internet E-mail Address</b>	richstim@nolo.com <small>Only one e-mail address may be used for correspondence, in accordance with Office policy. The applicant must keep this address current in the Office's records.</small>
	<input checked="" type="checkbox"/> Check here to authorize the USPTO to communicate with the applicant via e-mail. <small><b>NOTE:</b> By checking this box, the applicant acknowledges that it is solely responsible for receipt of USPTO documents sent via e-mail. The applicant should periodically check the status of its application through the <a href="#">Trademark Applications and Registrations Retrieval (TARR)</a> database, to see if the assigned examining attorney has e-mailed an Office Action. If an action has been sent to the provided e-mail address, the USPTO is not responsible for any e-mail not received due to the applicant's security or anti-spam software, or any problems within the applicant's e-mail system. All sent actions can be viewed on-line, from <a href="#">Trademark Document Retrieval</a>.</small>

Go Back
Continue

Figure 13

via email. Next, you will be taken to a page where you will verify fee information and provide an electronic signature. (See Figure 14.)

**What signature approach do you want to use?** Here you have several choices: sign electronically directly on this application (the easiest choice), email text form to second party for electronic signature, provide a handwritten pen-and-ink signature, or submit your application unsigned (a signature must be supplied later).

United States Patent and Trademark Office  
Trademark Electronic Application System - TEAS Application

Navigation History: [Introduction](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Dom. Rep./Correspondence](#) > [Fee/Signature](#)

PFD Form 1478 (Rev. 9/2006)  
OPB No. 0651-0029 (Exp. 12/31/2011)

### Trademark/Service Mark Application, Principal Register

#### TEAS Plus Application (Version 4.6)

**Fee Information**

**Note:** The total fee is computed based on the Number of Classes in which the goods and/or services associated with the mark are classified. If the free-text approach for the goods/services has been used, and different filing bases exist within the same class, neither the displayed Number of Classes nor Total Fee Due will be correct. You must manually adjust the Total Fee Paid amount, using the pull-down box to select the correct fee amount.

**Note:** Three payment options (credit card, automated deposit account, and Electronic Funds Transfer) will appear after clicking on the Pay/Submit button, which is available on the bottom of the Validation Page after completing and validating this form.

Number of Classes	1 (Class: 025)
Fee per class	\$275
Total Fee Due	\$275

**Signature Information**

Click to choose ONE signature method:

Sign directly
  E-mail Text Form to second party for signature
  Handwritten pen-and-ink signature

**Electronic Signature**

The application will not be "signed" in the sense of a traditional paper document. To verify the contents of the application, the signatory must enter any alpha/numeric character(s) or combination thereof of his or her choosing, preceded and followed by the forward slash (/) symbol. The USPTO does not determine or pre-approve what the entry should be, but simply presumes that this specific entry has been adopted to serve the function of the signature. Most signatories simply enter their names between the two forward slashes, although acceptable "signatures" could include /John doe/, /j/; or /123-4567/. The application may still be validated to check for missing information or errors even if the signature and date signed fields are left blank; however, you must specifically click the button for "Submit application unsigned," above.

**DECLARATION**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the form is being filed under 18 U.S.C. Section 1126(d) or (e), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to cause damage; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

* Signature: /Richard Stim/	* Date Signed: 02/09/2010 (MM/DD/YYYY)
* Signatory's Name: Richard Stim	
* Signatory's Position:	

**NOTE:** Enter the appropriate title or the relationship to the applicant, e.g., "President," "General Partner," "Manager," or "Trademark Administrator." If an individual, enter "Owner." If an attorney, enter "Attorney of record." (Specify at least one state bar member.)

NOTE: If there are multiple signatories, click on the "Add Signatory" button below, and repeat signatory process. Otherwise, click on the Validate button, or if necessary, the Go Back button.

Figure 14

**Amount.** If you are registering in just one class and using regular TEAS, as most people do, the fee will be \$325. If you are using TEAS Plus, your fee will be \$275.

**Declaration.** The declaration is a statement that the facts in the trademark application are true. Read it carefully. If there are statements in the declaration that raise serious doubts or questions in your mind, do not file the application until you see a trademark lawyer. (For information on finding a lawyer, see Chapter 14, "Help Beyond This Book.")

**Signature.** The information box right above the signature section provides the surprising information that your electronic "signature" can be any combination of letters, numbers, or other characters. Each signature must begin and end with a forward slash (/). For example, /pat smith/; /ps/; and /268-3421/ are all acceptable signatures. There's

no trick here. Unless you've developed some special internal system for tracking electronic signatures in your office, entering your own name is the simplest option. Click the signature link just below the information box for the PTO's own words on this subject.

**Validate.** Once you click the "Validate" button, you will be taken to a "Validation Page" (see Figure 15). This page alerts you if you forgot to



United States Patent and Trademark Office

Trademark Electronic Application System - TEAS Application



---

Navigation History: [Instruction](#) > [Applicant](#) > [Mark](#) > [Goods/Services/Filing Basis](#) > [Attorney/Don. Rep./Correspondence](#) > [Fee/Signature](#)

PTO Form 1478 (Rev 9/2006)  
OMB No. 0651-0009 (Exp 12/31/2011)



### Trademark/Service Mark Application, Principal Register

TEAS Plus Application (Version 4.7) - Validation Page

---

**On Thu Jul 22 18:05:14 EDT 2010 You completed all mandatory fields and successfully validated the form. It has NOT been filed to the USPTO at this point. Please complete all steps below to submit the application.**

■ **STEP 1:** Review the application data in various formats, by clicking on the phrases under Application Data. Use the print function within your browser to print these pages for your own records. If the Mark and Specimens appear huge, click here.

**Note:** It is important that you review this information for accuracy and completeness now. Corrections after submission may not be permissible, thereby possibly affecting your legal rights.

Application Data				
<a href="#">Input</a>	<a href="#">Mark</a>	<a href="#">Specimen</a>	<a href="#">XML File</a>	<a href="#">Text Form</a>

■ **STEP 2:** If there are no errors and you are ready to file this application electronically, confirm the e-mail address for acknowledgment. Once you submit the form electronically, we will send an electronic acknowledgment of receipt to the e-mail address entered below. If no e-mail address appears, you must enter one. If we should send the acknowledgment to a different e-mail address, or to an additional address(es), please enter the proper address or additional address(es). For multiple addresses/receipts, please separate e-mail addresses by either a semicolon or a comma.

**NOTE:** This e-mail address is only for the purpose of receiving the acknowledgment that the transmission reached the USPTO, and is not related to the e-mail that will be used for correspondence purposes (although it could be the same address). The official e-mail address that the USPTO will use for any future communication is whatever appears in the specific correspondence section of the form.)

\* E-mail for acknowledgment

To ensure we can deliver your e-mail confirmation successfully, please re-enter your e-mail address(es) here:

\* E-mail for acknowledgment

■ **STEP 3:** To download and save the form data, click on the **Download Portable Data** button at the bottom of this page. The information will be saved to your local drive. To begin the submission process with saved data, you must open a new form, and click on the "Browse/Choose File" button displayed on the initial form wizard page, at "[OPTIONAL] To access previously-saved data, use the "Browse/Choose File" button below to access the file from your local drive." REMINDER: Do NOT try to open the saved .obj.xml form directly. You must return to the very first page of the form, as if starting a brand new form, and then use the specific "Browse/Choose File" button on that page to import the saved file. Clicking on the "Continue" button at the bottom of that first page will then properly open the saved version of your form.

■ **STEP 4:** Read and check the following:

**Important Notice:**

Once you submit this application, we will not cancel the filing or refund your fee. The fee is a processing fee, which we do not refund even if we cannot issue a registration after our substantive review. This is true regardless of how soon after submission you might attempt to request cancellation of the filing. Therefore, please review ALL information carefully prior to transmission.

If you have read and understand the above notice, please check the box before you click on the **Pay/Submit** button.

■ **STEP 5:** If you are ready to file electronically:

Click on the **Pay/Submit** button below, to access the site where you will select one of three possible payment methods. After successful entry of payment information, you can complete the submission to the USPTO. A valid transaction will result in a screen that says **SUCCESS!** Also, we will send an e-mail acknowledgment within 24 hours.

**WARNING:** Click on the Pay/Submit button **ONLY** if you are now entirely prepared to complete the Pay/Submit process. After clicking the button, you can NOT return to the form, since you will have left the TEAS site entirely. Once in the separate payment site, you must complete the Pay/Submit process within 30 minutes. If you are not prepared to complete the process now, you should select the "Download Portable Data" option to save your form, and then complete the Pay/Submit process later. Or, if you have discovered any error, use the "Go Back to Modify" button to make a correction.

**WARNING:** Fee payments by credit card may not be made from 2 a.m. to 6 a.m. Sunday, Eastern Standard Time. If you are attempting to file during that specific period, you must use either (1) the deposit account or electronic funds transfer payment method; or (2) the "Download Portable Data" option to save your form, and then complete the Pay/Submit process later for a credit card payment.

Go Back to Modify
Download Portable Data
Pay/Submit

Figure 15

include any information that is mandatory. You will then have a chance to go back and fill in the missing information. A warning message will also appear for nonmandatory missing information, but you are not required to go back and include that information.

Once the validation is done, click “Pay/Submit” at the bottom of the validation screen. Because you are using a credit card for payment, you will next be asked to enter payment information (see Figure 16). If your transaction is successful, you will receive a confirmation screen.

Later, you will receive an email acknowledging the submission of your application. Hold on to that email, because it is the only proof you’ll have that the PTO has your application. It is also proof of your filing date and contains the serial number assigned to your application.

**United States Patent and Trademark Office**

*The U.S. Patent and Trademark Office supports Secure Sockets Layer (SSL) for the security of all transactions. If you would like to read more about the security of your transaction click [here](#).*

**Credit Card Payment**

The USPTO accepts the following credit cards for payment:  
 Visa®, MasterCard®, Discover® and American Express®.



[Pay by Credit Card](#)

**Deposit Account Payment**

A USPTO Deposit Account is required to pay using this method.  
 For information about USPTO Deposit Accounts, click [here](#).

[Pay by Deposit Account](#)

**EFT Payment**

An active EFT User Account is required to pay using this method.  
 For information about the EFT payment method, click [here](#).  
 To sign up for an EFT User Account, click [here](#).  
**Note:** For a new EFT User Account, we must verify your banking information before you can pay by EFT.

[Pay by EFT](#)

[Click here to cancel this transaction](#)



Figure 16

### Disclaimers—Do It Now or Later?

If, as part of your mark, you are using a word or phrase that cannot be protected under trademark law, the PTO will want you to disclaim (give up) trademark rights in those specific words, even though you have a trademark in the name as a whole. For example, suppose you manufacture a highly successful line of perfume called Candor, and you wish to register the trademark Candor Perfume. The PTO will likely ask you to disclaim the word “perfume” because it is generic. Similarly, if you had a gossip website called candor.com, the PTO would require that you disclaim the “.com.” In both cases, the word “candor” is still registrable as a trademark respectively for a line of perfume and for Internet services. That’s okay, because these generic terms “perfume” and “.com” can’t be registered or protected anyway. Disclaiming a term doesn’t mean that you lose part of your trademark, it only means that you cannot stop a competitor from using a similar generic term as part of their mark. For example, in the case of Candor Perfume, you have the exclusive right to use “perfume” with the mark “Candor,” but you cannot stop others from using “perfume” with their marks as well.

If you are positive you will have to disclaim part of your mark—for example, you know that all of your competitors have had to disclaim the word “sauce” or “shuttle”—then you may as well make the disclaimer now. Check the “Additional Statement” box (see Figure 6) and enter the term you are disclaiming. If you are not absolutely positive, we recommend that you not disclaim anything until required to do so during the examination process. If this should be necessary, the trademark examiner will tell you what you should disclaim.

## If You Are Filing by Mail

If filing your application by mail, you must pay a filing fee of \$375 per class (versus \$325 per class when filing electronically). Mail your application to Commissioner of Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. The PTO keeps track of all applications by assigning them serial numbers. Once your application is filed, all your communication with the PTO must include this serial number. The fastest way to be sure your application reached the PTO and to get your serial number is to include with your application a self-addressed, postage-paid postcard with your mark printed clearly on it. The PTO will stamp the card with your serial number and the date your application was received and return it to you. You should receive it within two weeks after you mailed the application. Keep the card in a safe place, as you may need to refer to your serial number frequently during the process.

We recommend using the mailing method that will get your application to the PTO in the shortest amount of time so that you may obtain the earliest possible filing date. Express Mail sent “Post Office to Post Office” is your best option.

About six to eight weeks after mailing your application, you should receive the PTO’s filing receipt. The current form is an 8½" x 11" white form titled “Filing Receipt for Trademark Application.” The filing receipt includes your application serial number, the date of filing, the mark, the applicant’s name and address, and other information. The information on the receipt should be checked carefully. If there is a mistake, you should send a correcting letter to the PTO immediately.

The PTO filing receipt will explain that you should not expect to hear anything about your application for approximately three months. If you have not heard anything in three and a half months, it is wise to inquire as to the status of your application. There are three ways to do this:

- Check TARR. The online Trademark Applications and Registrations Retrieval system page (<http://tarr.uspto.gov>) allows you to access information about pending trademarks obtained

from the PTO's internal database by entering a valid trademark serial number.

- TRAM automated system. TRAM stands for trademark reporting and monitoring. From any touch-tone phone, Monday through Friday, from 6:30 a.m. to midnight, Eastern time, dial 703-305-8747. After the welcome message and tone, enter your mark's eight-digit serial number and the pound symbol. You should immediately hear the computer give you the current status of your mark along with the effective date of the status.
- If you want additional information or would prefer talking with a human, call the Trademark Assistance Center at 703-308-9400 and request a status check.

## What Happens Next?

You will likely receive some communication from the PTO within three to six months. If there is a problem with your application, you will receive what's called an "action letter." This is a letter from your examiner explaining what the problems are. Most problems can be resolved with a phone call to the examiner.

When the examiner approves your application for publication, you will receive a Notice of Publication in the mail. Your mark will then be published in the *Official Gazette*. For 30 days following publication, anyone may oppose your registration. Only 3% of all published marks are opposed, so it is very unlikely you will run into trouble.

Once your mark has made it through the 30-day publication period, and you are filing on an actual-use basis, you will receive a Certificate of Registration. The PTO sometimes has a difficult time moving applications through this long process. As a result, it may take a year or more to process your application.



### CAUTION

**Once you accomplish your registration, you'll still have some paperwork to do five years down the line.** See Chapter 8 for more on what awaits you.

If you filed on an intent-to-use basis, your mark will not be placed on the trademark register until you file an additional document with the PTO when you put it into actual use. This form is called the Statement of Use/Amendment to Allege Use for Intent-to-Use Application. It tells the PTO the date you started using the mark and completes the registration process. You must also provide a specimen at that time, showing how you are using the mark.

## Communicating With the PTO

The chances are great that you will be communicating with the PTO after you have filed your application. Few applications sail through completely unscathed.

You are required to be diligent in pursuing your application. If you are expecting some action from the PTO (the ball is in their court) and more than six months have elapsed without your hearing from them, immediately check the TARR system or call the PTO Status Line (the TRAM automated system, described above). If you discover a problem, bring it to the PTO's attention. If you fail to respond in a timely manner to a request from a PTO examining attorney, your application may be considered abandoned. If that happens, you may petition the commissioner for trademarks within 60 days to reactivate your application.

If the examiner wants you to change your application, such as claiming a different description of services or goods, there is usually some room for negotiation.

**EXAMPLE:** Frieda claimed her mark was used in connection with buying services for nonprofit institutions and organizations and submitted a specimen showing an advertisement of food products aimed at schools. That description was found to be too indefinite, and the examiner suggested “buying services for nonprofit organizations and institutions in the field of food products.” If Frieda's services extended beyond food products to include items such as medical and automotive supplies, she probably wouldn't

want to agree to the examiner's suggestion. However, after talking with the examiner, she should be able to arrive at a description inclusive enough for her, yet definite enough for the examiner. In this instance, perhaps this would be "buying services for nonprofit institutions and organizations in the fields of food products, medical supplies, and automotive parts."

An examiner with a brief question might call you and then issue and mail you an Examiner's Amendment. This is a form on which the examiner records in handwriting a phone conversation or meeting with an applicant. Read the amendment carefully to make sure it matches your understanding of the conversation. If you disagree, or don't understand the amendment, first call the examiner, and then, if necessary, write the examiner a letter with your concerns, explaining your point of view on the communication.

One common example of an Examiner's Amendment is when you use words as part of your mark that, by themselves, don't qualify for registration. The examiner will ask you to formally disclaim those words (see sidebar, "Disclaimers—Do It Now or Later?" above). After making the disclaimer, your mark will be registered in its entirety, but you cannot prevent your competitors from using the disclaimed terms as parts of their trademarks.

**EXAMPLE:** The Exotic Perfume Company manufactures a line of fragrances fancifully named after various wildflowers that themselves don't carry any particular fragrance. One of these is called Violet Snapdragon Parfum. If Exotic wants to register this mark, it will have to disclaim "parfum"—a foreign-language term for perfume—because it is a descriptive term and thus not registrable. If Exotic refuses to disclaim "parfum," the PTO will probably refuse registration. If a disclaimer is made, however, the entire mark can be registered and the company will be able to stop others from using the combination of terms "violet," "snapdragon," and "parfum." However, the company will not be able to stop someone that is only using "parfum." For example, if a competing

fragrance company comes out with Wild Rose Parfum, there will be no infringement. On the other hand, if a competitor produces Purple Snapdragon Fragrance or Dragon Snap Parfum, it is likely that a court will find infringement.

## If the Examiner Issues a Rejection Letter

An examiner may write three kinds of action letters that constitute trademark application rejections:

- **Technical rejections.** These usually involve minor or procedural matters that can be corrected by amendment as described earlier.
- **Substantive rejections.** These usually involve issues such as potential confusion with another mark. Responding to these takes more effort and may well require the help of a trademark lawyer.
- **Final rejections.** These usually are written only after you have been given at least one chance to respond to a technical or substantive rejection.

The examining attorney may notify the applicant of the basis for the rejection by telephone or mail. Often, smaller issues are resolved over the phone while more substantive issues require mail notification. PTO correspondence usually includes an adhesive-label caption with a mailing date. This caption can be peeled off and placed on applicant's reply.

Rejections always specify how much time you have to respond (usually six months). If your response is not received within the time specified, you risk having your application deemed abandoned (which means you have to start over if you wish to pursue registration of the mark), so always send the response as early as possible.

If you receive a rejection, you have three choices:

- respond to it yourself,
- hire a trademark attorney to prepare the response, or
- abandon your application.

## Responding to an Objection Yourself

Whether you should respond to a rejection yourself depends on the nature of the problem and your comfort level in dealing with a trademark examiner. You'll have to weigh both issues and make your decision.

In the event of an objection by the examining attorney, it may be necessary to amend the application or provide a response to a rejection. An amendment is a correction usually made in response to a request by the PTO. A response is a legal argument advanced by the applicant to overcome an objection. The reply should include the caption (an adhesive label peeled off the examining attorney's letter). A response *must* be provided to the PTO within six months of the date of mailing of the office action. If not, the application will be deemed abandoned.

### Common Rejections That Are Easy to Correct

Below are some common correctable errors that most applicants can rectify easily:

- **Incorrect name of applicant.** The application lists the wrong trademark owner. For example, the founder of a company may mistakenly believe that he owns the mark, not the company.
- **Ambiguous authority for applicant.** The authority and position of the person signing the application is ambiguous. Officers of a corporation, for example, should be specifically identified by their titles.
- **Using the class heading as listing of goods.** Instead of identifying and describing the specific goods or services in the application, an applicant describes the goods by the International Class heading.
- **Scattered listing of goods.** Applicant filed for a trademark in several classes but did not clearly group the goods in appropriate classes. The PTO prefers that goods be grouped according to class in the description of goods and in the drawing.
- **Incorrect or inadequate description of goods.** The application does not accurately describe or reflect the goods or services. For example, the applicant describes the goods as “computer

programs” instead of “computer programs and accompanying manual intended for use in instructional applications.”

### **Substantive Rejections Are More Challenging to Correct**

The errors in the previous section were fairly easily to correct. However, certain objections by a trademark examining attorney require substantial effort to overcome. These objections are usually based on the statutory bars to registration established in Section 2 of the Lanham Act. These bars include:

- **Likelihood of confusion.** The trademark examining attorney determines that the mark—when used on the identified goods—is likely to be confused with a registered mark. For example, a shoe manufacturer attempts to register Knike for shoes.
- **Generic or other disclaimed material.** The trademark examining attorney determines that a portion of the mark is generic and must be disclaimed. For example, the owner of the trademark Nebraska Opry may have to disclaim the word Opry, as it is a generic term for country and western music entertainment.

If the examining attorney determines that the complete mark is generic, then overcoming the objection is much more difficult. For example, in 2006, registration was refused for the term Fresh Organics on the basis that the term was a generic reference to “variety of fresh, unprocessed, and/or raw food items that have been grown organically.” (*In re Nutraceutical Corp.*, Serial No. 78975072 (March 13, 2006).)

- **Descriptive mark.** The trademark examining attorney determines that the mark—when used on the identified goods—is merely descriptive of the goods. For example, the mark Nasal No-Hair for a nose-hair clipper.

Sometimes extensive legal and factual arguments must be prepared to overcome objections. Since these arguments are often similar to the arguments made in infringement lawsuits (for example, likelihood of confusion or descriptiveness), the bases for such responses are discussed in various chapters throughout this book. (For example, Chapter 6 discusses likelihood of confusion.) The procedure for preparing responses

is also documented in treatises such as *Trademark Registration Practice*, by James E. Hawes (West), and *McCarthy on Trademarks* (West).

## Hire a Trademark Attorney to Prepare a Response

It is almost never necessary to use an attorney to successfully respond to a technical rejection. Because this type of rejection usually is based on a clerical deficiency in your application, it does not take a legal education to figure out the correct response. Substantive rejections are another matter. This type of rejection is based on an examiner's assessment that the mark itself doesn't qualify for registration. Changing the examiner's mind on this point requires advocacy skills and a good working knowledge of trademark law—both attributes of competent trademark attorneys. (See Chapter 14, "Help Beyond This Book," for information on how to find a good trademark attorney.)

As desirable as it may be to use an attorney to help push your application through the PTO, this is almost always an expensive option. If you have a significant amount of money or business goodwill already tied up in your mark, then the expense may be justified. However, if you don't have a lot invested in your mark, it may be the wiser course to handle the matter yourself, even though an attorney might get better results. Why? Pure economics. Keep in mind that you are only out \$325 if you don't succeed in your first application and need to file a new one.

This amount is roughly the same as the normal hourly fee charged by trademark attorneys—and fighting with the PTO can easily end up costing you \$4,000 to \$5,000 worth of an attorney's time. Though you may not be able to register your chosen mark, there are plenty of other potential marks in the world. Let your answer to this question be your guide: Would you be willing to sell your mark for an estimated minimum attorney's fee of \$3,000 to \$5,000 and use the money to develop a different mark?

### Responding to the PTO Just Got Easier

The PTO provides an automated method of responding to office actions. You may find it easier to use this automated response system, rather than the traditional “snail mail” response, when replying to a PTO rejection or other office action. To access this automated response system, click “File Forms” under the word “Trademarks” at the PTO website ([www.uspto.gov](http://www.uspto.gov)). On the next page choose “Response Forms,” then click “Response to Office Action.” Supply your serial number and then follow instructions to provide a response.

## Abandon Your Application

If your application is based on actual use of your mark, your ownership of the mark will depend on the first date of that use. Registration itself does not confer ownership except when the application is based on an intent to use (in which case the filing date becomes the date of first use). If you already own your trademark, all registration accomplishes is giving the world notice of your mark and giving you a leg up (in terms of what you have to prove) if you end up in court in an ownership or infringement dispute.

Rather than pay an attorney or spend dozens of hours of your own time haggling with the PTO, you may be better off dropping your application and continuing to use your mark as you have before. This is especially true in the case of a descriptiveness rejection. If your mark is, in truth, descriptive, getting it registered will not offer much in the way of additional protection. If, however, the rejection is based on “confusion” grounds, then you should take a stern eye to the reasons for the rejection and decide whether you might be sued for infringement if you continue to use your chosen mark.



## TIP

You can expressly abandon your application by filing a Request For Express Abandonment (Withdrawal) of Application using TEAS. Click “File Forms Online” under “Trademarks” on the PTO home page.



## CAUTION

**All abandonments are not equal.** Here we are talking about abandoning an application, which will only result in the loss of whatever rights you would have obtained by completing the application. If, however, you stop using a mark over a period of time, or fail to maintain quality control over how the mark is used, you may be considered to have abandoned the mark itself, and therefore lose the exclusive right to use it. (See Chapter 8, “How to Use and Care for Your Trademark,” for more on how to avoid abandoning the mark itself.)

Also, if you filed an intent-to-use application, abandonment of the application may affect your ownership of the mark. For example, assume a business starts using the same or similar mark after you file your intent-to-use application but before you put your mark into actual use. If you follow through with your registration, then you can claim the original filing date as the date of first use and be considered the owner of the mark. If, on the other hand, you abandon the application, the other user will be considered the owner—because you will no longer be entitled to the filing date as your date of first use.

## Final Rejection: An Objection That Cannot Be Overcome

If the PTO determines that a mark is not registrable, a final rejection will be mailed to the applicant. In the event of a final rejection, the applicant can:

- **Appeal to the Trademark Trial and Appeal Board (TTAB).** An appeal to the TTAB is made when the basis for the final rejection is *substantive*, for example, a statutory bar to registration such as descriptiveness or likelihood of confusion.

- **File a Petition to the Director.** A Petition to the Director is used when the basis for the rejection is that the applicant or the PTO failed to adhere to procedural rules. For example, a final rejection that is based upon an improper time limit for response would be a procedural basis for a Petition to the Director.
- **Request further reconsideration.** The applicant can request that the examining attorney make another examination of the mark.
- **Abandon or suspend the application.** Abandonment of the application terminates the application process. Suspension of the application permits more time to prepare a response.
- **Amend the application to seek registration on the Supplemental Register** (37 C.F.R. § 2.75). If the basis for rejection is that the mark is descriptive, the mark may still qualify for registration on the Supplemental Register.

## Follow-Up Activity Required for Intent-to-Use Applications



### SKIP AHEAD

**If you are filing an actual-use application, skip this section.** An intent-to-use application involves more steps than an actual-use application. This is because to complete your registration and own the mark, you must actually get it into use in commerce, tell the PTO about it, and pay an additional fee.

## The Allegation of Use for Intent-to-Use Application

To actually get your mark registered, you will use a form called Allegation of Use for Intent-to-Use Application. This form may be filed at any time prior to the date the PTO authorizes the publication of your proposed mark and any time after the PTO issues a Notice of Allowance. It may not be filed between those two dates, which has come to be known as the “blackout” period.

### Intent-to-Use Applicant Must Have Actual Intent to Use

Don't file an ITU application if you just want to put a trademark on hold until you decide whether to go ahead with it. You must have a bona fide intent to use the mark at the time you file. For example, an applicant who was unable to provide any documents or other evidence of an actual intent to use a mark (ENYCE on custom auto accessories) was denied trademark rights by the Trademark Trial and Appeals Board (TTAB) (*L.C. Licensing, Inc. v. Berman*, 86 USPQ 2d 1883 (TTAB 2008).) In a similar case involving a foreign registrant, the TTAB held that an applicant who "has not had activities in the United States and has not made or employed a business plan, strategy, arrangements or methods there," and "has not identified channels of trade that will be used in the United States," does not have a bona fide intent to use the mark. (*Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660 (TTAB 2009).)

The Allegation of Use can be prepared and filed online using TEAS.

You do not need to supply specimens with an intent-to-use application, but you'll have to include one with your Allegation of Use. In addition to the information in this chapter, the PTO's help system should easily get you through this form.



#### CAUTION

**Remember that your specimen, mark drawing, and description of goods and services must all be consistent.** That is, if your specimen shows a different mark than what you put in your original application, you'll have some explaining to do. Similarly, if your specimen shows a different product or service than that described in your application, you'll have to submit another specimen or change your product/service description.

## When to Divide Your Application

When using TEAS, you will be asked whether you wish to divide your application. You would only want to divide your application if the following are true:

- Your original application designated your mark to apply to more than one good or service.
- You have used the mark in connection with one or some, but not all, of those goods or services.
- You still intend to use the mark in connection with one or more additional good(s) and service(s).

In that event, you should consider dividing your application so that one application now claims usage for one or more of the goods or services while the other application remains on an intent-to-use status with respect to the other goods or services.

**EXAMPLE:** Suppose Etta's intent-to-use application claimed she was going to use Quick-Bytes in connection with computer consulting services and computer programs. If she began offering services two months after her application was filed, she may want to amend her application to claim use of Quick-Bytes in connection with the services. When she divides the application, she will then have two applications: one in which she alleges actual use of the mark for her services; and one in which she plans to use the mark for computer programs in the future.

The benefit of dividing an application, rather than waiting until the mark is in use for all goods or services originally contemplated, is that the mark in use can be placed on the Federal Register more quickly.

The downside of dividing the application is that additional paperwork is involved (another Allegation of Use), and you will have to pay an additional filing fee each time you claim usage under an additional classification. If money is scarce, or you soon expect to have the mark in use with all the goods or services you claimed, it's probably best not to divide your application. Just wait until you are using the mark in all the ways you intend and then file one Allegation of Use.

If you decide to divide your application, TEAS has a form for this purpose. However, we recommend that you not file it with the PTO until your work is reviewed by a trademark attorney.



#### CAUTION

**Even if you are filing a Request to Divide, you must respond to any office actions on time, or risk giving up your application.**

## Getting a Six-Month Extension to File Your Statement of Use

As long as you still intend to use your mark on at least one of the goods or services mentioned in your application and are willing to pay \$150 per class as a filing fee, you can request an extension and get an extra six months before you have to file your Statement of Use. As stated earlier, the request must be filed before your six months run out.

You can request six-month extensions up to five times, as long as each is filed before the last extension runs out. After the first request (for which no reason need be given), you must convince the PTO that there is a good reason why your mark hasn't been used yet, as explained below. No extension of time will be granted beyond 36 months after the Notice of Allowance was issued. If it is your second, third, fourth, or fifth request, you will need to explain what you have done to get ready to use the mark in commerce. Your explanation need not be lengthy; a sentence or two will do. Some possible explanations include the following:

- the need for more research or development of your product or service
- the need for more research about your market, including where and how to sell the product or service
- a delay in efforts to arrange for product manufacturing
- the need for more time to develop advertising or promotional activities
- attempts to get government approval are still in progress

- attempts to set up marketing networks are still in progress, and
- any other reasonable explanation (for instance, a prolonged illness or destruction of vital records of your factory due to fire or other disaster).

You may be tempted not to seek these extensions but to abandon the application and file a new application when the mark is finally put into use in commerce. Although this may save you money, it will lose you the date of first use (your original filing date) that you will be able to claim if you get your mark into actual use within the 36-month period.

If you are mailing these forms, see the section “If You Are Filing by Mail,” above, regarding mailing information to the PTO. Your Allegation of Use and fees should be mailed to this address:

Commissioner for Trademarks  
BOX AAU/SOU  
P.O. Box 1451  
Alexandria, VA 22313-1451

## Follow-Up Activity Required After Registration

While you are entitled to hearty congratulations upon receiving your Certificate of Registration, your efforts will be for naught if you forget to file with the PTO some additional paperwork known as the Section 8 and Section 15 Declarations (which tells the PTO that you are still using the mark). (We cover this in Chapter 8.) Because this declaration must be filed between the fifth and sixth year after your original registration date (unless you purchase a six-month grace period), it’s easy to let the deadline slip by, especially because the PTO doesn’t remind you, and very few people have calendars that last beyond the current year.

You will also have to renew your registration prior to ten years after your registration date and submit both a renewal form and a Section 8 Declaration that again proves that your mark is still in use. (The combined filing is called a Section 8/9 Declaration and Renewal and is explained in Chapter 8.)



## How to Use and Care for Your Trademark

<b>Use of the Trademark Registration ® Symbol</b> .....	242
<b>Use of the TM or SM Symbol for Unregistered Trademarks</b> .....	244
<b>File Your Section 8 and 15 Declarations</b> .....	244
Is Your Mark Still in Use?.....	245
Has Your Mark Been in Continuous Use for Five Years?.....	245
Can You File on Time?.....	247
Filing Section 8 and 15 Declarations Online.....	248
<b>File Your Section 8 Declaration and Section 9 Application for Renewal</b> .....	248
<b>Use It or Risk Losing It</b> .....	249
<b>Maintain Tight Control of Your Mark</b> .....	250
<b>Use the Mark Properly—Avoid Genericide</b> .....	252
<b>Transferring Ownership of a Trademark</b> .....	253

**H**ere, we assume that you are a trademark owner who wants to take all the right steps to keep your mark legally healthy. Trademark ownership can be lost if you don't use the mark correctly. And if you have registered the mark with the PTO (see Chapter 7, "Federal Trademark Registration"), your registration may lapse if you fail to take certain required follow-up steps. This chapter identifies the major pitfalls that owners of marks—registered or unregistered—can encounter and suggests some easy steps for keeping your mark strong against all potential copiers.

## Use of the Trademark Registration ® Symbol

If your mark is federally registered—on either the Principal or Supplemental Register—you have the right to use the symbol ® with your mark and should begin doing so immediately. If your mark is not on either of the federal trademark registers, you may not use the ® symbol.

The ® symbol, which lets others know that the mark is federally registered, is usually printed in a very tiny type—next to the mark. By placing the ® next to your mark, you place potential infringers on notice as to your federal registration and improve your chances of collecting damages or a defendant's profits if it is ever necessary to take an infringer to court. However, you won't lose ownership of the mark by omitting this notice.

**EXAMPLE:** While searching for a name for his new word-processing program, Phil Programmer sees an advertisement in a trade magazine for a new program called Sorcerer's Apprentice that allows the user to construct databases for hobby collections. No notice of registration is displayed in the advertisement, so Phil foolishly decides the mark is probably not registered and proceeds to use it as a trademark for his program. The work, is in fact, registered. Although the owners of the mark Sorcerer's Apprentice could sue Phil for infringement because the goods are so closely

related (they're both software) and can probably force him to stop using the mark, they might have trouble collecting the damages allowed for willful infringement (triple damages, the defendant's profits, and possibly attorneys' fees) because they didn't use the ®.

It is enough that the symbol appears at least once on each label, tag, or advertisement. You don't need to use the symbol on every occurrence of your mark. Incidentally, instead of using the ® symbol, you may state that “[your mark] is a registered trademark of [your name].” This has the same legal effect as the ® symbol, but it takes up much more space.

Be sure to specify how you want the symbol used when hiring advertising services or printers or when you allow others to use your mark—for example, on a website or in conjunction with another product or service. It is your responsibility to make sure the world knows your mark is registered. However, it isn't necessary to include the symbol when your mark is being referred to for reasons that have nothing to do with the underlying goods and services. For instance, this book refers to many marks, including McDonald's, without an accompanying registration symbol, because the reason we are referring to the marks is to discuss their characteristics as marks and not to sell the goods or services associated with them.

### **Use of ® If Your Federal Registration Is Canceled**

The PTO will cancel your federal trademark registration if you fail to file certain required follow-up documents after your initial registration. However, you won't receive notice of this fact from the PTO. It is easy, therefore, to inadvertently continue using the ® on a mark that is no longer technically registered. Obviously, the easiest way to prevent this from happening is to meet the follow-up requirements. But if you slip up—and many do—use your best efforts to stop using the ® unless and until you reregister the mark.

## Use of the TM or SM Symbol for Unregistered Trademarks

You may use TM (for trademark) or SM (for service mark) alongside an unregistered mark to show that you claim ownership of the mark and intend to assert your rights against imitators. These symbols are usually placed in smaller type to the right of the mark, as in The Purple World™. Use of the TM or SM symbol provides no statutory legal benefits, but it warns would-be copiers that the name or other device is already being claimed as a mark, and in most instances this will keep others away from the mark. As with the © symbol, you don't need to place the TM or SM symbol next to every appearance of your trademark. Nothing can be more distracting than seeing the same word appear over and over again on a page with a little TM mark appearing next to it. The principle in using these symbols is to make sure you get the “lay off—this is a trademark” message across once, or if there are many pages, at most once on every page. There is no rule for how often the symbol should be used; common sense should do fine.

## File Your Section 8 and 15 Declarations

Between the fifth and sixth year after federally registering your mark, you should complete and file two important forms with the PTO: the Section 8 Declaration and the Section 15 Declaration. You can file each declaration separately, or you can use one form that combines both the Section 8 and 15 Declarations and can be filled out online using the PTO's TEAS program. You can access the form at [www.uspto.gov/teas/eTEASforms.htm](http://www.uspto.gov/teas/eTEASforms.htm).

By filing these declarations, you'll protect your mark in two extremely important ways. The Section 8 Declaration officially advises the PTO that your mark is still in use and that your registration should continue in force. The Section 15 Declaration advises the PTO that your mark has been in continuous use from the date of registration and therefore deserves extra protection against potential challengers. In PTO jargon,

you're requesting "incontestability status" for your mark. You'll need to briefly evaluate the use of your mark to make sure you're eligible to file these declarations. Here's how.

## Is Your Mark Still in Use?

To file the Section 8 and Section 15 Declarations, you must still be using your mark in the manner described in your registration certificate. This means that you must still be using it, at a minimum, on the same products or services and in the same way (on packaging or pamphlets, and so on) as you originally stated and be able to come up with samples that demonstrate your continued use.



### CAUTION

**File in the name of the current owner.** The Section 8 and 15 Declarations must be filed by the current owner of the federal trademark registrations. (The current owner should calculate the filing period from the date of registration, not the date the mark was transferred or acquired.) If you have acquired the trademark registration by an assignment, or if your company has changed its business name or form, for example, from a sole proprietorship to a corporation, you will also need to file a record of the transfer of ownership with the PTO.

## Has Your Mark Been in Continuous Use for Five Years?

As mentioned, you'll qualify for incontestable status (the Section 15 Declaration) if your mark is in continuous use for five years after being placed on the Principal Register. More specifically, your mark can become incontestable if all of the following apply:

- Your mark was placed on the Principal Register at least five years ago and you have used the mark continuously—without a lapse—since that registration date in the same manner and on the same goods or services for which it was originally registered. (If you are using the mark for some of those original goods or services but not for others, it may become incontestable for the goods and services you are still using it for.)

- No court has rendered a final decision that affects your ownership claim since the date of registration.
- There is no pending court or PTO challenge to your right to use the trademark.
- You file the Section 8 and 15 Declarations on time.
- The mark is not and has not become generic (that is, synonymous with the underlying product or service).

Incontestability status makes it more difficult—but not impossible—for anyone to challenge the validity of your mark. The result is that it will be easier for you to protect your mark from infringement. Even though an incontestable mark can still be challenged on a number of grounds in an infringement lawsuit (see sidebar, “Incontestable’ Really Means ‘Harder to Contest’”), it is safe from attack on the basis that it lacks distinctiveness. This is a key benefit—once a mark is considered distinctive beyond argument, it gets very strong protection.

**EXAMPLE:** Park ’N Fly, Inc., sued Dollar Park and Fly, Inc., for trademark infringement. Dollar Park and Fly defended on the ground that the Park ’N Fly mark was too weak to deserve protection. But the U.S. Supreme Court ruled that the Park ’N Fly mark had obtained incontestability status and couldn’t be challenged on that ground. (*Park ’N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985).)

Of course, even after a mark attains incontestability status, the mark can be deemed abandoned and dropped from the Federal Register if you stop using it for a sufficiently long time.

**EXAMPLE:** In 2005, Frank Brown invents an inexpensive but highly accurate blood pressure testing kit and starts distributing it under the trademark F/B Stresstest. The mark is registered on the Principal Register in 2006. In 2011, the mark is entitled to incontestable status if Frank has kept the mark in continuous use for this five-year period. But if he later stops using it for three years or more, he will risk losing his incontestable status as well as his federal registration altogether.

### “Incontestable” Really Means “Harder to Contest”

Paradoxically, you can contest an incontestable trademark in quite a few ways. The upshot is that “incontestable” really means “harder to contest.”

If accused of infringing a particular mark that has achieved incontestability status, you can defend on any of the following grounds:

- The registration or its incontestability was obtained fraudulently.
- The mark has been abandoned by the registrant.
- The mark is being used to misrepresent the source of the goods or services with which it is being used (for instance, a mark is used to deceive consumers into believing they are buying another company’s products or services).
- Your mark is your own name being used in your own business or is descriptive of your goods or services or geographic locale.
- Your mark was used in interstate commerce before the incontestable mark was used and registered.
- Your mark was registered before the incontestable mark.
- the incontestable mark is being used to violate the antitrust laws of the United States. (37 U.S.C. § 1115(b).)

### Can You File on Time?

Both the Section 8 and Section 15 Declarations must be signed and filed with the PTO between the fifth and sixth years of registration. The fee for the combined filing is currently \$300 per mark per class (\$100 for the Section 8 Declaration, \$200 for the Section 15 Declaration). Your timing is crucial, because if you miss the deadline you’ll have to pay an extra \$100 and file within the six-month grace period. For that reason, file these declarations well before the six-year deadline so that you’ll have time to clear up questions or provide the PTO with more information, if needed.

**EXAMPLE:** If your mark was registered on May 15, 2005, you must sign and file your Section 8 and 15 Declarations between May 15, 2010, and May 14, 2011. It would be best to file them in June or July of 2010 so there is plenty of time to make corrections.

Failure to file the Section 8 Declaration on time will result in your federal registration being canceled unless you pay the \$100 fee and file within the six-month grace period. If the mark is canceled, you will have to reregister if you still want the benefit of federal registration. In addition, the failure to file the Section 8 Declaration means that you will not be able to obtain incontestable status for the mark until an additional five years has passed from your reregistration date. It is in your interest to make sure this document is filed on time.

## **Filing Section 8 and 15 Declarations Online**

The Section 8 and 15 Declarations (whether filed separately or as one application) are available for filing online through the PTO's TEAS program. On the PTO home page, under "Trademarks," click "File Forms Online." Then, under "Registration Maintenance/Renewal Forms," choose either the combined 8 and 15 form or the Section 8 form, depending on your needs. After that, you must answer a series of questions similar to those asked of applicants under the TEAS new trademark application (see Chapter 7). Like other TEAS forms, you can pay by credit card at the end of the procedure.

## **File Your Section 8 Declaration and Section 9 Application for Renewal**

If your mark was registered on or after November 16, 1989, it must be renewed within ten years from the date of registration. If your mark was registered before November 16, 1989, it must be renewed 20 years from date of registration. In addition to filing a renewal application (Section 9), you also must file another Section 8 Declaration at the same time. These two documents have been combined into one document and can be filled out online using the PTO's eTEAS program. You can access the form at [www.uspto.gov](http://www.uspto.gov).

The renewal application should be filed within the six-month period directly preceding the ten- (or 20-) year anniversary of your mark's

registration. Currently the fee for the combined filing is \$500 per mark per class (\$100 for the Section 8 Declaration, \$400 for the Section 9 renewal application). For an additional \$100 per-class fee, the renewal may be filed within a six-month grace period after the anniversary date. No renewal application will be accepted after that date. For instance, if your registration expires on May 15, 2010, your renewal application (1) must be dated after November 15, 2009, and (2) may be filed between November 16, 2009, and May 15, 2010 (or between May 16 and December 15, 2010, with the \$100 grace period fee). We strongly recommend that you file your renewal application as soon as you are able, to allow the maximum time possible for curing glitches.

## Use It or Risk Losing It

The adage “use it or lose it” applies to trademark protection. A mark must be in continuous use for the owner to keep others from using it. If the mark falls out of use for a long enough period of time, it may be considered abandoned. A mark that has been registered with the PTO, if not used for three years or more, will be presumed abandoned. A “presumption” is a legal standard that means it is more likely than not that something has happened. Every presumption can be rebutted by credible evidence to the contrary. For example, a company challenges the validity of a trademark arguing that it has not been used for three years. If the trademark owner can present a good explanation of why the nonuse does not constitute an “intent to abandon,” the mark will not be abandoned.

Despite the “use it or lose it” rule, the law often permits nonuse for a considerable amount of time. Such contingencies as temporary financial difficulty, bankruptcy proceedings, and the need for a product revision may all qualify as satisfactory explanations for nonuse of a mark. There is no particular time period that the mark must be out of use to be considered abandoned (other than the three-year presumption mentioned above). Rather, abandonment will be decided on a case-by-case basis.

## Maintain Tight Control of Your Mark

As we explain in other parts of the book, trademarks serve the primary function of identifying a particular product or service in the marketplace. If an owner allows others to use its trademark without restriction, the mark will no longer serve as a meaningful indicator of a particular product's or service's origin. If this occurs, the mark can be considered abandoned. For instance, if a fast food hamburger chain allows its franchise operators to have complete discretion as to the food, decor, and type of service they offer under the company logo, the logo quickly loses its ability to indicate a particular type of food service. In this situation, the logo can be abandoned—it no longer serves its original function of product or service identification—and anyone will be free to use it.

The way that McDonald's controls its marks exemplifies the type of vigilance over the product or service that is necessary to avoid the possibility of abandonment. This company uses its service mark not only to distinguish its service from its competitors generally but also to call to a consumer's mind such characteristics as a specific level of service, a specific type of meal at a specific price, and a specific level of cleanliness. It does this by requiring every owner of a McDonald's franchise to operate the franchise under tight rules and restrictions, designed to ensure that the characteristics associated with the McDonald's mark are always present. Without such restrictions, the McDonald's mark soon would stand for nothing; a McDonald's franchise operation would cease to provide the consumer with meaningful information about its products based on its usage of the McDonald's mark.

Another aspect of controlling your mark is to police its use by others. Even if you don't particularly care whether others use your mark, your failure to assert your exclusive ownership rights means that the mark may be considered abandoned. Policing your mark might mean annual checks of the trade literature applicable to your business, weekly scrutiny of the *Official Gazette* for new trademark applications, or even periodic full trademark searches.

You can also hire a third party to police your trademark. Most trademark search companies (see Chapter 4) offer trademark-watching services for a monthly or annual fee. In addition, companies such as TrademarkTracker ([www.trademarktracker.com](http://www.trademarktracker.com)) will watch for use of your trademark in online databases, Web pages, and even online auction sites.

If you do discover other businesses using your mark, you can respond in the ways we suggest in Chapter 11, “If Someone Infringes Your Mark.” Or you could hire a lawyer to sue if necessary. To maintain your rights, you don’t have to take an unauthorized user to court, but you should send a letter protesting the use of the mark and asserting your claim of ownership. If their use goes on for a long time—for example, several years—your delay may provide them a defense against your legal action, or you may lose your right to obtain an injunction (to order them to stop using the mark) once you finally do sue.

### **Beware Naked Licenses**

If you grant others the right to use your trademark (known as a trademark license), you must always supervise the nature and quality of the goods or services being produced using that trademark. For example, if you are the owner of a trademark for clothing and license its use to a shoe company, you must supervise the quality of the shoe company’s products using your trademark. Your failure to supervise is referred to as a “naked license,” and the results can be disastrous. For example, in a 2002 case, a court cancelled the trademark rights of a licensor (the owner) of a wine trademark because the company failed to supervise a company that had licensed the trademark. (*Barcamerica International USA Trust v. Tyfield Importers Inc.*, 289 F.3d 589 (9th Cir. 2002).) Most trademark licenses are drafted to avoid this result by requiring that samples of all licensed trademark goods be periodically submitted to the trademark owner for approval and quality control.

### Authorized Uses of Your Trademark

Not all uses of your trademark by others place it in jeopardy. For example, it is common for stores to use marks belonging to other companies to tell their customers that the goods or services identified by the marks can be purchased at that store. When using marks in this way, however, the stores must make it clear that the marks belong to their owners, not to the store. Usually this fact is clear from the context (“Levi’s sold here” or “An authorized distributor of Apple Computer products”). Often, you will see—on labels of goods that incorporate others’ products, like a sofa—a message like “Wear-Dated ® is a trademark of the Monsanto Company,” indicating that the name of the sofa’s fabric is a trademark of another company. Such uses become a problem only when it is not clear that the trademark belongs to the rightful trademark owner.

Generally, textual use of a trademark—simply typed—is not a problem. However, if used in a comparative advertisement, the mark must have the same typeface and logo as used by the original mark owner. If the trademark does not look like it normally does, the use of the mark may be confusing or diluting.

## Use the Mark Properly—Avoid Genericide

A few businesses—mostly large ones—have the apparent good fortune of owning a mark that has become a household word. But, paradoxically, once the mark becomes so much of a household word that it becomes synonymous with any product or service of the sort it originally represented, it ceases to be a mark—it becomes generic. For example, some people refer to all facial paper tissues as Kleenex, and all acetaminophen analgesics as Tylenol. These marks would be in danger of becoming lost through “genericide” if the companies did not protest such improper uses of the marks.

The problem is this: The more well-known a particular mark becomes, the more the public is prone to equate the mark with the

underlying product rather than view it as one brand name among many. This is just another way of saying that the mark loses its ability to identify a particular brand and becomes generic. Only a tiny number of companies will face this problem—it tends to arise with revolutionary new products that the public comes to associate with the name their first manufacturer gives them, like Rollerblades for in-line skates. But because genericide is avoidable, you ought to know how to prevent your mark from going generic if that seems to be even a remote possibility.

The best ways to keep a mark from becoming generic are:

- Accompany every use of the mark with the generic product or service (for example, Kleenex tissues).
- Never use the mark as a verb (for instance, you never go “roller blading,” you skate on Rollerblade skates).
- Always capitalize your mark (Tylenol).
- Never use the mark as a general noun (for instance, don’t call a photocopy a “Xerox”).

## Transferring Ownership of a Trademark

You should consider your registered mark as property with a title, the same as a house or car. The title document is your Certificate of Registration. If for any reason you sell your business or the rights in products you manufacture or distribute, you will also need to sell the marks used to identify the business and products in the marketplace. The complete transfer of ownership in a mark to another person or entity is called an “assignment.” An assignment of a registered mark must be in writing to be valid. It can—and should—be filed with the PTO. The new owner can obtain a new Certificate of Registration in his or her name. If you anticipate a sale (assignment) of your mark, see a trademark attorney. A sample assignment form is set forth below. When filing an assignment of trademark ownership with the PTO, you can use the Electronic Trademark Assignment System (ETAS) which permits you to create and submit a Trademark Assignment Recordation Coversheet online. Click “File Forms Online” under “Trademarks” on the USPTO

home page. Then click “Assignments Forms.” You can also use Form 1594, Recordation Form Cover Sheet (trademarks only), which can be downloaded from the PTO website ([www.uspto.gov](http://www.uspto.gov)).

If you are selling a business, chances are you are also selling any trademarks associated with it. If so, it makes sense to assign your ownership of the marks in a document that is separate from the contract of sale. This enables the new mark owner to record only the transfer of mark ownership with the PTO, while keeping private the many details of the deal that do not affect the transfer of trademark rights.



#### CAUTION

**Note that in the sample assignment form, below, the trademark owner transfers ownership of the business’s “goodwill” as well as the mark itself.** Goodwill is an intangible asset measured in large part by customer recognition of—and loyalty to—the mark in question. Any transfer of ownership in the mark must include a transfer of the goodwill associated with the mark.



#### FREQUENTLY ASKED QUESTION

##### **Transferring TMs to new corporation**

*“I have two trademarks registered to a corporation and will be transferring the rights to use these trademarks to a new corporation. Do I have to notify the Patent and Trademark Office and how would I do that? Also, I notice that someone asked about renewing a patent. Is that also necessary for trademarks?”*

You need to do two things: (1) assign the marks to your corporation; and (2) file the assignment along with a Trademark Assignment Recordation Coversheet, at the USPTO website.

**What about renewal?** You must file a renewal and declaration of continued use between the ninth and tenth anniversaries of registration and you should file a declaration of continued use and (optionally but recommended) a statement of incontestability between the fifth and sixth years of registration. The failure to file the declaration of continued use will result in the loss of the registration.

## Assignment

\_\_\_\_\_ [*name of registrant*] \_\_\_\_\_ (Assignor),  
 of \_\_\_\_\_ [*mailing address*] \_\_\_\_\_,  
 has adopted, used, and is using a mark that is registered in the United States Patent  
 and Trademark Office, Registration No. [*get number from registration certificate*],  
 dated \_\_\_\_\_ [*get date from registration certificate*].

[Name of person (and citizenship) or company that will be the owner of the mark\*]  
 (Assignee) of \_\_\_\_\_ [*mailing address*] \_\_\_\_\_,  
 wants to acquire the mark and the registration thereof.

For good and valuable consideration, receipt of which is hereby acknowledged,  
 Assignor hereby assigns to Assignee all right, title, and interest in and to the mark,  
 together with the goodwill of the business symbolized by the mark, and the above-  
 identified registration.

\_\_\_\_\_  
 Signature of Assignor

[if assignor is a business, list official title of person signing]  
 Title

State of \_\_\_\_\_ )  
 \_\_\_\_\_ )  
 County of \_\_\_\_\_ )

On this \_\_\_\_\_ day of \_\_\_\_\_ [*month*] \_\_\_\_\_, [*year*] \_\_\_\_\_, before me  
 appeared \_\_\_\_\_ [*assignor's name*] \_\_\_\_\_, the person  
 who signed this instrument, who acknowledged that he/she signed it as a free act  
 on his/her own behalf (or on behalf of the identified entity with authority to do so).

\_\_\_\_\_  
 Signature of notary public

NOTE: This form is valid only when the assignee is a United States resident or company.

\* If the assignee is a domestic general partnership or domestic joint venture, you must also provide the names, legal entity type, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.



## Evaluating Trademark Strength

<b>A Brief Review of What Makes a Strong Mark</b> .....	258
<b>For Marks Consisting of Words, Identify the Distinctive Part of the Mark</b> .....	259
<b>Assess the Legal Strength of the Trademark Aspect of Your Word Mark</b> .....	260
Varieties of Distinctive Marks.....	261
Varieties of Nondistinctive (Ordinary) Marks.....	265
Generic Labels.....	275
Composite Terms and Slogans.....	277

This chapter helps you evaluate a particular mark’s legal strength—that is, the degree to which the courts will protect it or something similar against use or misuse by others. You will want to read this chapter if you feel the need for a deeper understanding of the material in Chapter 3, or if you have:

- been accused of violating someone else’s mark, or
- think that someone else is treading on your mark.

Assuming you are involved in a conflict situation, once you digest this material you should read Chapter 10, which discusses who has priority in case two marks—or a mark and an Internet domain name—come into conflict. Then you should go to Chapter 11 (if your mark is being infringed) or Chapter 12 (if you are accused of infringement) for suggestions on how to deal with the dispute.

In Chapter 3, “How to Choose a Good Name for Your Business, Product, or Service,” we have already touched on the basics of what makes a mark legally strong—inherent distinctiveness or distinctiveness acquired through secondary meaning. This teaches you how to classify your mark by type (for instance, geographic names and personal names) and explains how far the courts are willing to go to protect that type of mark in case of a dispute.

## A Brief Review of What Makes a Strong Mark

A legally strong trademark meets two basic tests:

- It successfully identifies your goods or services in the consumer’s mind.
- Because of your prior usage (and maybe registration), competitors can’t use it or anything like it in any context where customers might (1) be confused about the source of goods or services, or (2) might, because of the similarity of the marks, erroneously conclude your business is associated in some way with the goods or services being marketed under the conflicting mark.

How your mark measures up to these tests helps determine your mark’s strength in relation to any other mark. Below, we set out an approach that will help you apply these tests in the real world.



## CAUTION

**As you have heard repeatedly by now, the tools we give you to evaluate a trademark’s strength are guidelines, not guarantees.** These rules represent the best guesses that most lawyers would be likely to make based on the relevant court decisions. But we don’t promise specific results for a specific mark because that depends on many factors, including use, timing, and how the facts strike the judge who decides the particular dispute.

## For Marks Consisting of Words, Identify the Distinctive Part of the Mark

To evaluate the strength of your product or service mark, first separate its distinctive component from the part of the mark that identifies the type of product or service it identifies. For example, the mark Apple Computers contains a distinctive element—Apple—and a product/service identifier, Computers. Another example: The distinctive aspect of the name Guess? jeans is the word “Guess” followed by a “?”.

Sometimes all or most of the individual words of a mark are equally distinctive (or nondistinctive), and it is the combination of the words that is distinctive. Examples: include Trader Joe’s (food market) and Music Now and Then (a disk jockey service). Even when there is no specific distinctive part of a word mark, the mark will still have a tail that identifies the underlying product or service. So, it’s still important to understand where the words that give the mark at least some distinctiveness drop off and common identifiers of goods or services kick in. Because the nondistinctive aspect of a word mark can never be protected, we simply disregard it in evaluating the legal strength of the name as a mark.

After you have isolated the word or phrase that forms the distinctive aspect of your mark, match it with one or more of the categories listed below to understand why your mark does or doesn’t have legal strength.

## Assess the Legal Strength of the Trademark Aspect of Your Word Mark

Earlier, we spoke of the distinctive part of your word mark. That distinctive part is, in fact, the trademark aspect of your mark. Here, we place the different categories of trademarks on a spectrum. We start with the most distinctive marks—the ones with the greatest legal strength. We then move to more ordinary marks, which may be easier to promote but harder to protect legally, and finally conclude with generic marks, which can't be protected at all because they utterly lack distinctiveness. Along the way, we provide lists of examples of each category and discuss why various names are classified as they are.

Remember to consider the whole effect of your mark—its sound, its look, and all the meanings of the individual elements of the mark—before drawing conclusions about its legal strength. This includes the style of the typeface, as well as its color, shape, size, and any other aspect of the overall impression the mark makes. In addition, how the mark is used and the timing of its first use are all relevant in determining relative trademark strengths.

Some of the distinctions that place a mark in one category or another may appear arbitrary and even, at times, hairsplitting. At first you may feel that it is impossible to tell the difference. If you take your time with this material, however, the better you know it, the more it will make sense.



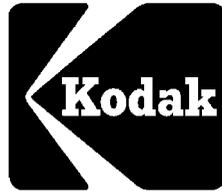
### CAUTION

**Remember: We're all human.** Do keep in mind that live human beings—with their individual strengths and weaknesses—are the ultimate arbiters of whether a particular mark is to be considered strong or weak. Whether the person is a trademark examiner (employee of the U.S. Patent and Trademark Office), a judge, a juror, or one of the authors of this book, his or her analysis of a particular mark is based on a subjective response to mostly visual stimuli, which makes for fuzzy decision making. So, if you find yourself disagreeing with the category a particular mark has been consigned to by the

PTO, courts, or even the authors of this book (in the many made-up examples provided), try to understand (if not accept) the rationale rather than dissent in the name of some absolute truth.

## Varieties of Distinctive Marks

Distinctive marks fall into three basic categories—coined, arbitrary, and suggestive. All are strong, but coined and arbitrary marks are considered stronger than suggestive marks and therefore receive more protection.



### Coined Trademarks

These are words that you won't find in any dictionary; they have been made up just to serve as trademarks, so they have no other meaning. Words such as Blistex, Kodak, Exxon, Tylenol, and Actifed are the marks lawyers like best. They are inarguably distinctive, and therefore legally strong. Such household words as Kodak, Kleenex, and Reebok were all coined specifically as marks. Whether it is registered or not, chances are that a coined mark will automatically entitle you to the strongest protection against copying that courts can provide.

In practice, coined marks can't be used by others in any commercial context. By contrast, most other types of marks can be used by more than one owner as long as:

- The goods and services they are used on are not related and don't compete with each other.
- It is unlikely that customers will be confused by the multiple use of the mark.

The reason for the special treatment afforded a coined mark is its uniqueness. Because a coined mark's exclusive role is to identify a

specific product or service (or product line) in the marketplace, most consumers would expect linkage between all businesses who use the mark, and would therefore be confused as to the origins of the products or services carrying it. So it is highly unwise to borrow a famous coined trademark even for a vastly different product or service.

Not all made-up marks fall into this strongest-of-all category. Marks that are coined wholly new, like Maalox, are treated differently and are given more protection than are marks that are composites of recognizable elements of words, like Accuride. Maalox is automatically strong because it is not like anything we have heard before. But Accuride is too close to “accurate ride” to be considered a purely coined term. Such a mark is therefore usually considered suggestive rather than coined. We discuss suggestive marks below.

### **Fanciful or Arbitrary Marks**

Fanciful or arbitrary names, such as Penguin books, Arrow shirts, and Camel cigarettes, also make distinctive and legally strong marks. These marks use common words in an unexpected or arbitrary way, so that their normal meanings have nothing to do with the nature of the product or service they identify. They creatively juxtapose unexpected combinations of words and products or services. That’s how a skating rink came up with the appealing name Jellibeans. Another wonderful example of a fanciful name is We Be Bop for women’s clothing, and it’s difficult to think of a more arbitrary name than Diesel, A Bookstore.

These arbitrary or fanciful marks have almost as broad a scope of exclusive use as do coined marks. Most of the time, using an arbitrary or fanciful mark for one type of product or service will prevent the use of the same mark on similar or related services or products. However, unlike a coined mark, arbitrary or fanciful marks may be used if the context of use is entirely different and the original mark is not too well known. If, on the other hand, the arbitrary or fanciful mark has become famous, then—under a principle known as trademark dilution—the mark may be protected against use by others, no matter what the context of use. (See Chapter 1, “A Trademark Primer.”)



### Suggestive Marks

A close relative of the arbitrary mark is the suggestive mark. This type of mark uses ordinary words in a clever manner to create a desirable idea or feeling about a product or service but stays away from literally describing any aspect of the product or service. Examples of suggestive marks are Verbatim (for computer disks), Banana Republic (for a style of clothing), Greyhound (for bus service), Thistle Dew Inn (for a bed and breakfast service), and Panache (for a beauty salon).

Suggestive marks are considered distinctive and therefore legally strong because they indirectly associate favorable qualities with specific goods and services in a creative way. For example, a Jaguar car conveys the idea of aggressiveness, beauty, and speed, desirable attributes for a car; Dove soap conveys softness and gentleness; Greyhound implies speed and sleekness—not adjectives normally associated with bus lines but desirable ones nonetheless.

Sunkist is an interesting example of a suggestive mark. Although it is just a novel spelling of the adjective “sun-kissed,” its creative use on fruit and juices evokes a wonderfully fresh and healthy image. It is the originality of the mark that makes it legally strong.

An excellent example of a suggestive mark is Thistle Dew Inn, used by a quaint bed and breakfast establishment just off the town square in Sonoma, California. The composite term Thistle Dew evokes both a ubiquitous local purple-flowered plant and a feeling of freshness and renewal that people in Northern California seek when they visit Sonoma, the heart of the wine country. (It also—perhaps unintentionally—echoes the sentiment, “This’ll do.”)

And finally, Panache, a French word that means spirited self-confidence, style, flamboyance, and daring elegance of manner, suggests the qualities that customers might hope to obtain from an upscale beauty shop located in Lakeport, California.

Categories of Distinctive Trademarks		
Suggestive	Fanciful/Arbitrary	Coined
Accuride tires	Ajax cleanser	Actifed
Chicken of the Sea tuna	Apple computers	Amtrak
Coppertone tanning lotion	Arrow shirts	Barbasol shaving lotion
Esprit clothes	Banana Republic clothes	Blistex lip balm
Glacier ice	Beefeater gin	Curel hand lotion
Greyhound bus	Camel cigarettes	Exxon
Liquid Paper	Domino sugar	Kodak
Maternally Yours clothes	Double Rainbow ice cream	Maalox
Q-tips	Hang Ten clothes	Nyquil
Roach Motel insect trap	Hard Rock Cafe	Reebok shoes
7-Eleven stores	Ivory soap	Tylenol
Suave shampoo	Jellibeans skating rink	
Verbatim computer discs	Nova TV series	
Wearever cookware	Penguin books	

### More Examples of Distinctive Marks by Category

The line between arbitrary or fanciful and suggestive marks is often a fine one. A mark that might appear to be fanciful or arbitrary may in fact be derived from a little-known source and might, therefore, be suggestive to those in the know. For example, some marks employ mythical or fantasy allusions to suggest desirable connotations, like the Janus investment fund (Janus = Roman god of beginnings) or Midas Muffler (King Midas = the golden touch). A clever mark of this sort is Prints Valiant for a copy shop, which combines the name of a cartoon hero with a pun on the kind of shop it is and implies heroic effort.

Above is a chart showing examples of the different categories of distinctive trademarks. Examine it carefully to see if these distinctions make sense to you.

Perplexed? Don't be. Many of these examples can go either way. For example, while some trademark authorities consider Ivory soap to be

an arbitrary trademark, others argue that it describes the color of the soap, or that it suggests the desirable qualities of ivory—smooth, clean, white, valuable. Nyquil, a cold remedy, can be seen either as a coined term, or a composite suggestive mark, combining “night” and “tranquil” to evoke peaceful sleep. Cachet, for a women’s clothing store, rides the border between suggestive and descriptive, because it means a mark of distinction or individuality, thus promising unique style to the customer. Banana Republic could be either arbitrary, because it has nothing to do with clothes, or it could be suggestive of adventure and travel.

As long as your mark is distinctive in the sense of its being unique, clever, or just plain memorable, the practical importance of what category it fits in is nil—until you find yourself in a conflict with another mark. Then, to the extent that your mark qualifies as a coined term, it will get the widest scope of protection. We explained more about what this means in Chapter 6, “How to Evaluate the Results of Your Trademark Search.” For now, it’s enough to understand what category your mark falls in and why.

## Varieties of Nondistinctive (Ordinary) Marks

In Chapter 3, we lumped all the marks that aren’t distinctive into a category called ordinary marks. An ordinary mark is one that communicates in a descriptive or otherwise mundane way something about the product or service to which it is attached. It includes five sorts of terms:

- descriptive, describing the nature of the service or product (Self-Help Divorce Center for a consulting service helping people file their own divorce forms)
- geographic, describing the geographic area it’s in (Downtown Auto Service, if it’s really downtown)
- laudatory, praising the business or the customer (Pretty Nails, for a manicurist; Fast Feet, for athletic shoes)
- personal names, consisting primarily of first names, surnames, personal initials, or nicknames (Maury’s Deli, Gooden Chevrolet), and
- business name initials.

While these types of word marks ordinarily are considered to be legally weak, they can each become distinctive through long use and customer recognition, via the secondary meaning rule that we discussed in Chapter 3. For example, IBM, the acronym for International Business Machines, originally was a legally weak mark until it became well known over time, thereby acquiring legal strength under the secondary-meaning rule.

In the following four subsections we detail the pros and cons of each kind of ordinary mark and give you rules about when a term will be considered strong enough to qualify for protection in the courts.

**TIP**

**Generic name note.** We discuss generic marks—names that have become synonymous with the products themselves, such as aspirin and cellophane—below.

## Descriptive Words and Words of Praise

We lump marks using these kinds of words together because there is little practical difference between them. As long as you know your mark is one or the other, you'd be wasting your time trying to decide which. So, let's briefly recap what these marks are before we try distinguishing them from marks that are legally strong.

Descriptive marks are those that literally describe a feature or attribute of a product or service, such as 10-Minute Lube (auto care), Hi-Tech Computers, Char-broiler hamburgers, FindUHome (real estate broker), or Nuts and Bolts (hardware store).

Laudatory marks (words of praise) hype a product or service's quality or quantity, using common words like Original Blend (cat food), America's Freshest Ice Cream (ice cream), Maple Rich (syrup), Blue Ribbon (bakeries), or Best Foods (organic food distributors); or they describe the qualities of the product or service the business hopes to deliver, like Joy detergent or Pride furniture polish.

Descriptive marks make very weak trademarks for two reasons:

- Consumers are so used to commercial hype that a descriptive term doesn't make the kind of impact on them that would help them to effectively distinguish one product or service from another. For example, the name Canine Clipping Centers doesn't by itself clearly differentiate that pet care shop from any other.
- Descriptive terms need to remain freely available for everyone's commercial or everyday use. Trademark law will only protect terms that are unique to a particular product or service brand and that aren't, therefore, necessary for another business to use if it wishes to describe or hype its business in advertising or marketing copy.

You may think that changing the spelling or language—from English to French, for example—makes an otherwise weak mark strong. It usually doesn't work that way. So La Bread Shoppe or Tastee Kookie remain weak marks despite the spelling/language variations. But a relatively obscure foreign term, or one that most consumers wouldn't recognize as a foreign language equivalent of a descriptive term, can create a strong mark. So, although “xerox” is the ancient Greek word for dry, and dry describes the photocopying process Xerox invented, Xerox was a strong mark from the beginning—because only a few Greek scholars knew its meaning. In addition, La Posada Inns, directed at English speakers, is considered a distinctive mark although the Spanish translation (The Inn) is descriptive.

### **How Xerox Almost Became a Generic Mark**

Over a number of years, Xerox became more and more synonymous with photocopy machines and the photocopying process (“I need a xerox” or “I'm going to xerox that”). This common usage put the Xerox mark in danger of becoming generic and therefore not protectible at all. To prevent this, Xerox undertook an aggressive and expensive advertising campaign to encourage people to use Xerox properly, as a proper adjective, and not as a generic term (a verb or a noun).

As we have emphasized in earlier chapters, even descriptive names can become legally strong enough to get full trademark protection, through the secondary meaning rule. That's when a trademark becomes so closely identified with a specific product or service that the public no longer thinks first of the original ordinary meaning of the words. Then the mark is said to have taken on a new secondary—and distinctive—meaning, and rivals can no longer use it to identify their products or services.

But even after descriptive marks have acquired distinctiveness through the secondary-meaning rule, others still can use the ordinary words that make up such marks in nontrademark ways—that is, to legitimately describe their products or services in advertising. This is known as “fair use” of a trademark, and it is a valid defense in court if a mark owner challenges the use of your words in a mark.

For example, once Standard Brands acquired secondary meaning and became protectible as a trademark, others could not use those words as a trademark on goods, but a store could advertise that they carry “all standard brands” of paint, or tools, or whatever they sell, without fear of infringing.

**TIP**

**Continuous use for five years.** If the owner of a weak mark can prove that the mark has been in continuous use for a five-year period, it will be presumed to have acquired a secondary meaning and be eligible for placement on the federal Principal Register. (See Chapter 7.)

One final point: Even without secondary meaning, ordinary trademarks can get limited protection—under unfair competition laws—from a rival with a confusingly similar name in the same area and the same line of business. (See Chapter 10, “Sorting Out Trademark Disputes.”)

## Deceptive and Misleading Marks Get No Protection

Marks that describe a product or service misleadingly get no protection at all. So neither Neo-Hide nor Softhide can be protected as marks for imitation leather. Most state and federal trademark laws specifically bar these types of marks from registration both to protect consumers from being ripped off and to protect businesses that accurately describe their products from unfair competition by those who don't.

A second category of marks that are only slightly misleading—called “deceptively misdescriptive”—are viewed as less seriously deceptive. American Beauty as a mark for a Japanese sewing machine is one example of this type of mark. When first used, this type of mark does not receive legal protection either. But once it acquires secondary meaning, then it becomes distinctive, and protectible as a mark, on the theory that it is no longer considered misleading. That's because the public no longer thinks of the literal meaning of the words and instead only associates the words in the mark with the product or service.

## Geographic Marks

These are marks with a geographic term in them, such as Eastern, Miami, Indiana, English, or any other place names, from streets to continents, or regions to rivers. There are several subspecies of marks containing geographic terms:

- **Literal geographic descriptors.** Like other ordinary marks, the general rule is that if you use a geographic term descriptively (for example, if the product or service is really connected to the place name), it can't be protected as a mark, absent a showing of secondary meaning. That's because everyone has a right to use accurate geographic words to describe the origin of their services or products. So marks like Manhasset Drugs, Central Realty, North Moline Hardware, or Chestnut Street Pub (if it's on Chestnut Street) are weak and can't be protected, unless, of course, they gain secondary meaning in connection with the

particular product or service for which they're used. Examples of geographic marks that got protection by acquiring secondary meaning are American Airlines, Continental Can Corp., and The New Yorker magazine.



#### CAUTION

**Although not protectible as marks, these extremely common types of business names may be entitled to some relief in court** if a competitor uses the same name in a manner that would be highly likely to confuse customers. For example, Manhasset Drugs could stop a competitor from using that exact name in Manhasset. (See Chapter 1, "A Trademark Primer," for a discussion of unfair competition principles.)

- **Indirect geographic descriptors.** Even if your service or product is not factually associated with the place named in your mark, the mark may still be if the public is likely to assume that such a link exists. For example, Chicago is famous for a kind of pizza, so it's descriptive, not distinctive, to call a Dallas pizzeria Chicago Pizza. Likewise, Thai Videos is weak if it sells videos from Thailand, even though it does so in Los Angeles. So, too, Phnom Penh is weak for a Cambodian restaurant located in Trenton, New Jersey.
- **General geographic descriptors.** Some words like "world," "globe," and places in outer space may be far too broad to suggest any specific place of origin, but they are still weak because they operate like laudatory or descriptive marks. Thus, American Engineer on an engineering trade magazine is descriptive and weak because it's aimed at a readership made up of American engineers.
- **Ambiguous geographic descriptors.** Some geographic terms are ambiguous in meaning when used in a trademark. For instance, the term "continental" can be interpreted as referring to a literal continental land mass or, more quaintly, to the European continent. "National" may indicate nationwide scope or patriotism, again depending on how it is used. Whether it's a weak or a strong mark would depend on which meaning applies.

## Geographic Terms as Strong Marks

As with all marks consisting of ordinary terms, there are times when geographic marks are protectible, apart from acquiring secondary meaning. The best way to make a geographic term distinctive as a mark is to use it in an arbitrary or fanciful way. For example, American Express (for travel and credit services) and California Girl (for clothes) don't really describe either the service or the product or imply their origins. Instead, these words project an image that is fanciful and distinctive for the items on which they are used. So, they are protectible as marks.

Likewise, English Leather is a distinctive (suggestive) mark, as long as it does not describe a leather product. If it did, it would be either descriptive, if it comes from Britain, or deceptive, if it does not. (See below for more on why deceptive terms can't be marks.) And a fabric store called Taos Fabrics has a weak mark if it's in New Mexico but a strong one if it is in Chattanooga.

This makes sense. The sellers of products or services have a right to truthfully tell where an item came from without infringing another's mark. It would be unfair to all other New York businesses to give any one company in that city a monopoly on the name. But if an entrepreneur elsewhere wants to evoke the Big Apple in Fargo, North Dakota, for example, that's fair. (If the owner of the Fargo-based Big Apple decided later to market its products in New York City, it's possible that its rights would be greater than if the business had started there from the beginning. This would depend on how well-known the Big Apple mark had become in the meantime, whether the mark had been placed on the federal register, and what competing uses of the mark already existed in New York City at the time of the desired expansion.)

## Personal Names

Words in this category refer to persons, whether their first names, last names, whole names, nicknames, or initials. Examples are Juan's, Houlihan's, Larry Blake's, C.J.'s, and H&R Block. As a general rule, anyone can use their personal name as a mark for a service or product, unless the same name is already in use on directly competing products or services.

This means that personal names (at least common ones) make weak marks. But as we discovered in an informal study of the yellow pages, more small businesses use a surname or first name as their marks than any other kind of name. Marks using personal initials are also popular. It's understandable why businesspeople are drawn to these types of names; they demonstrate pride of ownership. But using a personal name or initials has potentially serious drawbacks from a trademark point of view.

First, most personal names are legally weak because they are not particularly memorable, especially if they are used in one or more competing businesses. We saw this problem with Ray's Pizza in New York (see Chapter 3, "How to Choose a Good Name for Your Business, Product, or Service"). When someone there says "Ray's Pizza," no one can tell which of the 24 Ray's in the city is the right one. Nor does adding an initial make a personal name inherently distinctive enough to become a legally strong trademark. On the other hand, the odder your name, the less likely others will use it on a similar business and the more memorable it will be. Will the real Orville Redenbacher please stand up?

Second, as with other ordinary marks, a personal name trademark must usually acquire secondary meaning through being identified with your business to be protected as a strong trademark. However, many personal names have garnered such a large degree of public recognition that the courts permit only very limited other uses of them. McDonald's and Levi's are two good examples.

Despite the general principles governing personal name marks just described, a few personal name marks do manage to get strong trademark protection without secondary meaning. The general rule is that if the public would not view the mark primarily as a personal name, then it can be protected outright. Put another way, a personal name only works as a trademark if it is so unusual that no one recognizes it as a personal name, like Garan. Other personal names that can be distinctive trademarks are ones that have additional meanings, like Bird, Kent, or Fairbanks, which also have common descriptive or geographic significance. The distinctiveness of such marks would depend on how they are used.

Another exception to the general rule that personal names make weak trademarks is well-known historical names, like Da Vinci, Lincoln, Rameses, and Robin Hood, which are considered fanciful and distinctive. The use of such marks clearly does not imply that the person named is commercially connected to the product or service—so their trademark use is not primarily as a personal name. On the other hand, some historical names, like Webster and Longfellow, have been treated as weak marks. What’s the difference? Perhaps because the latter names are less mythic—Daniel Webster and Henry Wadsworth Longfellow are less famous by far than Da Vinci or Abraham Lincoln—they carry more of a personal name meaning than do the former. This is another of those gray areas of the law, where the differences are slim.

### **The Right of Publicity**

There is a related but separate right that protects people’s names and personas from commercial use by others. It’s called the right of publicity, and it allows celebrities to prevent others from making money by the unauthorized use of their names. Although the right of publicity is commonly associated with celebrities, every person, regardless of how famous, has a right to prevent unauthorized use of a name or image to sell products. The right of publicity extends beyond the commercial use of a person’s name or image and includes the use of any personal element that implies an individual’s endorsement of a product, provided that the public can identify the individual based upon the use. In many states, the right of publicity survives death and can be exercised by the person’s estate.

Even using a famous name on unrelated services or products can be a problem. John Walker probably can’t operate a motel under the name Johnny Walker Inn, but he might be able to use a name that sounds sufficiently different, like John M. Walker Inn. Often, in order to resolve such potentially confusing uses, a disclaimer such as “not associated with ...” is required. For example, Hyatt Corp. sued Hyatt Legal Services over the use of that surname. The suit was eventually resolved

when the defendant agreed to use the statement: “Hyatt Legal Services is named after its founder, Joel Z. Hyatt.”

Some names are so famous and applied to such a variety of products that any additional use of them would be confusing to the public, even on a completely unrelated product or service. DuPont or Yves St. Laurent are examples.

Other names may be equally famous but are associated so exclusively with specific products or services that even though the public would recognize any use of a similar name, no actual confusion is likely to result where the mark is used on a totally different type of product or service. If such is the case, then you can use your name even if it’s also a famous mark. That’s why Bob Fanta won a suit by Coca-Cola over his use of “Keep Tab with Fanta” to advertise his tax return service: His business is so logically remote from soft drinks that actual confusion is unlikely.

In one famous case detailed by Calvin Trillin in the *The New Yorker* magazine (1988), a small bar opened up in Milwaukee under the name of Mike Houlihan’s (the first name of one of the owners and the last name of the other owner). W.R. Grace, a conglomerate, already owned a chain of family restaurants called Houlihan’s Old Place, one of which was in Milwaukee.

The two concerns coexisted peaceably in the same city for a couple of years. It was only when Mike Houlihan’s opened a second pub in St. Louis, where there was another Houlihan’s Old Place, that the conglomerate protested the bar’s use of a similar mark and threatened to sue. The pub owners were furious and refused to back down: “What do you mean I can’t use my surname?” fumed John Houlihan to his lawyer.

The lawyer knew that W.R. Grace appeared to have the law on its side—the Houlihan name was first used and first federally registered in connection with Houlihan’s Old Place. (How first use and federal registration affects conflicts between marks is discussed in detail in Chapter 10, “Sorting Out Trademark Disputes.”) But then luck intervened.

It turned out that there really was a Mr. Houlihan, after which Houlihan’s Old Place was named, and that his written consent for the use of his name had never been obtained—a prerequisite to registering

a mark using the name of a living person. For this omission, the court canceled Grace's trademark registration of Houlihan's Old Place. And yet the restaurant eventually succeeded in barring the bar's use of the mark in Missouri based on unfair competition, common law trademark rights, and state dilution laws. Moral of the story: Using personal names in a mark can be tricky, so always get permission when using the name of a living person.

## Generic Labels

In Chapter 3, "How to Choose a Good Name for Your Business, Product, or Service," we introduced you to the concept of generic labels—words that are synonymous with the underlying product or service and that therefore can't be distinguished from others. Examples of generic terms are "aspirin," "linoleum," and "lite beer." Here we follow up on that discussion to help you distinguish generic labels from marks that are merely weak. It's an important distinction, because while weak marks can gain protection once they acquire secondary meaning, generic labels will never receive any protection at all.

You will see problems with generic words in three different trademark contexts:

- when you try to protect your weak mark against an infringer, and they defend by saying your mark is generic and therefore freely copyable.
- when you adopt a mark and seek to have it registered under the secondary meaning rule, but it is rejected because the term is generic rather than merely weak.
- when a mark that was once distinctive (and perhaps even registered) loses all legal protection because it has become synonymous with the product and not just one brand of it. An example of a distinctive mark that is in danger of becoming generic is Rollerblades, which many people use for the product itself (more accurately called in-line skates).

We are more concerned with the first circumstance than with the second or third, but most of our examples are drawn from court cases

in which a mark was denied protection because it always was or had become synonymous with the product. For example, Thermos was once a trademark, but is now seen as a kind of insulated bottle. Although they emerge from a different context, such examples are useful because they illustrate the thinking of a judge or trademark examiner in determining if a mark is protectible at all or simply generic.

Distinguishing generic labels from weak marks may not always be easy to do. Courts ask what a buyer is likely to think of when he or she hears the term—a product or a specific source for that product? Another approach is to try to come up with a generic label for the underlying type of product or service that is different from the mark itself. As long as a generic label for a product or service can be articulated, a name that is different from the label will qualify for treatment as a mark, no matter how weak it is. Only if the name and the generic label merge over time will the mark suffer genericide.

It usually takes some market research to discover what a term's generally accepted meaning is and some legal advocacy to convince a court of this point of view.

Here's a list of generic labels. Examine them to see if they clarify the concept.

Generic Labels		
aspirin	dry ice	montessori method
baby oil	escalator	shredded wheat
bath oil beads	hoagie sandwich	softsoap
brassiere	jujubes candy	superglue
cellophane	lite beer	thermos
cola	matchbox toys	yo-yo
copperclad	monopoly game	

Why, you may ask, is matchbox on this list but not Tinkertoy? Perhaps the public associates Tinkertoy more specifically with one company, whereas matchbox indicates a variety of small toy. Why is

copperclad generic but not *Teflon*? Again, *Teflon* is a material that the public associates with a company, whereas copperclad is more of a process.

Let's take one example a little farther. Montessori has been ruled a generic term for a variety of child care centers that share a general philosophy of early childhood education based on the teachings of Maria Montessori. Even though the American Montessori Society certifies certain Montessori schools but not others, any school is free to use the Montessori name to describe the kind of education it provides.

But what makes the name Montessori generic instead of being descriptive of the philosophy of the school? The bottom line is, what does the public think when it hears such a term? It thinks, "Montessori—that's an educational method." Put simply, since the name describes the kind of thing involved, it's generic. By contrast, if the name tells you which thing is involved—even if it does so very descriptively—it has the potential for being a trademark.

Does this mean that no Montessori school can ever have a protectible trademark? Not at all. Many protectible marks have generic terms in them. As long as the trademark contains a nongeneric part that distinguishes the service or product from others, in addition to the generic part, then the whole is not generic and may be protected. So to have a protectible name, any Montessori school can simply add a distinguishing modifier to its name, such as Big Trees Montessori School. The modifier, Big Trees, becomes the mark.

## Composite Terms and Slogans

In this section, we discuss composite terms, slogans, designs, shapes, and containers. These types of marks also can be distinctive or ordinary, so we discuss them at some length to help you evaluate what makes them weak or strong.

### Composite Terms

These marks can also be called cross-category marks. They are made up of one or more of the different sorts of words discussed above. Examples

are: Shorty's Mean Motorcycles, Gino's New York Pizza, Stormy Weather Home Rehab Services, and Kmart.

Composite marks are not easy to analyze. They usually consist of weak components but still may be considered strong marks. As a general rule, if all the components of a mark are descriptive, the trademark as a whole is also descriptive, and therefore weak. But this is by no means always true. In some circumstances, the kind of service or product a mark is attached to, the context of the mark's use, and even the public's reaction to the mark can result in weak words combining to form a strong mark.

### Composites of Whole Words

This type of composite mark consists of individual words with different trademark strengths, like *Gino's chicago style pizza*, which contains a personal name and a geographic term. The first rule about these types of marks is that the whole name is stronger than the sum of its parts. So, for example, *such a business* is a strong mark for a children's store. It consists of ordinary words, but they are not used descriptively: that is, "such a business" tells you nothing about what the business is or what it hopes to purvey. It's the combination of the phrase and the nature of the service that makes it funny, surprising, unique, and memorable. The same could be said of *pea in a pod* for a maternity store.

Another recent example is a line of books that uses "Don't Know Much About" as a prefix to the subject matter of the book, as in *Don't Know Much About the Civil War*. This prefix is a well-known line from an old Sam Cooke song. The line is sure to grab the attention of most prospective readers over the age of 50 and therefore serves admirably as a trademark, even though it consists entirely of ordinary words. Incidentally, book titles are not, by themselves, entitled to trademark status, but a name that indicates a series of books (*Hardy Boys*, *Nancy Drew*, *Dummies*) is entitled to protection.

Other composites of weak elements can also make a stronger whole. For example, Houlihan's Old Place is an effective trademark for a restaurant. This composite of two sorts of names is much more

suggestive than simply Houlihan's (which as a personal name can get no trademark protection without secondary meaning), or The Old Place (which, although not necessarily descriptive, is vague and not particularly memorable). Again, taken together, the elements of this mark are more distinctive than either is alone.

On the other hand, Bette's Oceanview Diner, in the Oceanview section of Berkeley, California, is a moderately weak composite mark. That's because it combines two ordinary terms, a personal name and a geographic term, and uses them descriptively. As we have learned, this is not a recipe for a strong mark. Unless such a mark can show secondary meaning, the only protection Bette is likely to get is under state unfair competition laws, and then only if a rival restaurant uses a similar mark in the same local area, and if customers are likely to be confused by it.

Now consider the composite mark, I Can't Believe It's Not Butter! For the uninitiated, this is a brand of margarine, not just a promotional slogan. It is descriptive because it conveys the information that the product is a close imitation of butter. Furthermore, it's exactly the kind of phrase that a rival margarine producer might want to use in advertising. But the fact that the brand name is a complete sentence with an exclamation point at the end makes it unusual, and even memorable, which means it's distinctive, which gives it legal strength.

Take another example. Colin Moriarity runs a chimney cleaning service called The Irish Sweep. The mark is a composite of descriptive terms, because he is in fact an Irish chimney sweeper. But we bet you'd remember the name. Why? Because it plays on a famous horse race, the Irish Sweepstakes. Also, one word, "sweep," is an archaic term for a chimney sweeper and gives the whole trademark a more evocative feel. To some extent, the strength of this trademark depends on whether many people recognize "sweep" as equivalent to chimney cleaner. If they do, it's descriptive. And yet, people can know what it means and still recognize it as archaic. On the other hand, if the mark's key feature, "sweep," is just a term in common use, then the trademark using it is just descriptive and too ordinary to be a protectible mark, without secondary meaning.

## Composites of Elements of Words

These are one-word marks, such as Ultraswim, Bushhawk, and Microsoft, made up of recognizable separate words. These marks are different from those consisting of coined words. Coined terms are wholly new words that mean nothing. But because composite marks contain elements of words, they carry meaning, even if it is only to evoke an image. That makes them more akin to suggestive or descriptive marks than to coined terms. What makes this kind of composite mark strong or weak is not what its elements are, but how it is used. For example, Ultraswim as a trademark for a piece of swimming equipment would be descriptive, and therefore weak. But as used on a shampoo designed for swimmers, it is suggestive, and thus stronger. On the other hand, Bufferin is considered a descriptive mark, even though it's a composite that's not in the dictionary. That's because it's simply a contraction of "buffered aspirin," and the result is too close to the descriptive word "buffered" and the generic term "aspirin" to be distinctive.

Many businesses have latched on to the idea of creating a mark out of word fragments. Unfortunately, they often select terms, at least in computer and technological fields, that are so overused that they have become hackneyed and therefore descriptive. The result is that trademarks using elements like web-, laser-, super-, macro-, -tech, -soft, data-, and compu-, even though they are made up, are not unusual and, so not very distinctive or memorable. This is really an instance where the early bird got the worm. Only the first ones to pick such marks, like Microsoft, who got in before the genre became so common, had a strong mark even before they built up extensive public recognition.

## Slogans

Slogans such as "When it absolutely, positively has to be there overnight" (FedEx), "Because I'm worth it" (L'Oréal), and "the ultimate driving machine" (BMW) are valuable trademarks because they create indelible consumer impressions. Distinctive (or strong) slogans can be registered as trademarks with the PTO. Some slogans are inherently distinctive—that is, by their very nature they create a memorable association with

a particular product or service. For example, “Reach Out and Touch Someone” is inherently distinctive because it does not describe phone services; rather, it cleverly suggests or promotes a quality of life enhanced by phone communication. The same is true of “Just Do It,” a slogan that connotes the active life without describing any aspect of Nike or its products. An inherently distinctive slogan is usually a pithy, short phrase that does more than inform or describe—it promotes.

By contrast, a slogan such as “Extra Strength Pain Reliever” is merely informative and does not, by itself, distinguish Excedrin from other analgesics. However, even though this particular slogan is not inherently distinctive, it has become distinctive by acquiring a secondary meaning through sales and advertising. This was also the case with “Hair Color So Natural Only Your Hairdresser Knows For Sure” for Miss Clairol hair products.

As with other types of marks, slogans that are inherently descriptive or that have become distinctive under the secondary meaning rule may be federally registered and protected nationwide. (See Chapter 7, “Federal Trademark Registration.”)

Some slogans, like some generic terms, can never function as marks. For example, the phrases “Why Pay More!” and “Proudly Made in the U.S.A.” were both rejected for registration because they were common commercial phrases and failed to distinguish the goods or services to which they were attached.

If your mark is a combination of a business or product name and a slogan, such as Happy Clown —America’s Favorite Ice Cream, the slogan part must meet the same standards for distinctiveness as if the slogan stood alone. For example, if you attempted to federally register Happy Clown—America’s Favorite Ice Cream as a mark, the trademark examiner would break the mark into two parts—Happy Clown and America’s Favorite Ice Cream. Although “Happy Clown” would by itself probably qualify as a distinctive mark, “America’s Favorite Ice Cream” would not be considered distinctive, primarily because it uses a common phrase to describe rather than promote the product. For that reason, the trademark examiner would require you to disclaim the slogan as a condition of having “Happy Clown” placed on the Principal Register.

See Chapter 7 for more on what it means to disclaim a word or phrase.

### **Tips for Selecting a Slogan**

- Avoid using common commercial phrases, especially if the phrase is part of the trade language (“Think Green” for recycled paper).
- Avoid describing the product or service (“Finest Salsa That Money Can Buy”).
- Keep it short and pithy (“Just Do It”).
- Use the slogan vigorously on the product, in conjunction with the service and with all advertising.



## Sorting Out Trademark Disputes

<b>Trademark Infringement</b> .....	286
Customer Confusion.....	286
Priority of Use: Who Used the Mark First?.....	293
Domain Names and Trademark Infringement.....	294
<b>Determining Priority in an Infringement Dispute</b> .....	298
Your Unregistered Mark Conflicts With a Federally Registered Mark.....	298
Your Unregistered Mark Conflicts With Another Unregistered Mark.....	303
Your Federally Registered Mark Conflicts With Another Federally Registered Mark.....	305
Your Federally Registered Mark Conflicts With an Unregistered Mark....	307
<b>Dilution</b> .....	310
Federal Dilution Laws.....	311
Tarnishment and Blurring.....	313
Federal Dilution Defenses.....	315
Relief for Dilution.....	316
<b>Cybersquatting</b> .....	317
Federal Anticybersquatting Protection Act.....	318
The Uniform Domain Name Dispute Resolution Policy.....	320

**M**ost commonly, a business first becomes aware of trademark principles when:

- The business learns—usually from a customer or trade journal—that a competitor is using a copycat name for a similar product or service in a situation where money may be lost as a result of customer confusion.
- The business receives a stiff letter from another company’s lawyer alleging that the business is improperly using a name or other type of trademark that belongs to the lawyer’s client and demanding that the business stop using the mark or suffer the legal consequences.
- The business’s application to register a trademark or use its business name as its Internet domain name is denied because the name is already being used.

Few things disturb a business owner quite as much as a dispute over the exclusive right to use the business’s chosen name to identify its goods or services. A business’s mark is normally intimately linked with the recognition and goodwill the business enjoys in the marketplace. So, a dispute over that mark sets off alarm bells. In this chapter, we provide information on sorting out these types of squabbles.

The world of trademark disputes can be boiled down to three main types of disagreements:

- infringement
- dilution, and
- cybersquatting.

Infringement disputes arise when the simultaneous use of the same or similar marks by two different businesses is likely to confuse customers.

Two main issues underlie an infringement dispute:

- Who first used the mark?
- Are customers of the first trademark user likely to be confused by the second user’s use of a similar trademark on similar goods or services?

Dilution involves the wrongful use of a famous mark, either by weakening the famous mark or tarnishing its reputation. The primary

inquiry in a dilution dispute is whether the mark is famous. If the mark is found to be famous, the owner of the mark has the power to stop certain uses of the mark that dilute the strength of the mark or that harm the mark's reputation for quality.

Traditionally, infringement and dilution were the only two types of trademark disputes. With the rise of the Internet, however, a third main type of dispute has arisen—cybersquatting. Cybersquatting involves holding domain names hostage. It is the registering and owning of a domain name that mirrors a valuable trademark for the sole purpose of selling the domain name to the owner of the mark. Cybersquatting was made illegal in the United States by the passage of the Anticybersquatting Consumer Protection Act by Congress in 1999, and cybersquatting also has been found to violate the rules of the Internet Corporation for Assigned Names and Numbers, the international committee that regulates the Internet.

Your particular trademark dispute could involve one or more of these main types of conflicts. For example, you could find that someone has registered your trademark as a domain name and, at the address, has set up a website selling goods that are similar to yours under the same name. You contact the scoundrel, and he says that if you want him to stop, you can just buy the domain name from him. This person is infringing your trademark by using the mark in a manner likely to confuse your customers. He also may be cybersquatting, because he is holding the domain name of your trademark hostage. Thus, it is important to keep in mind that your dispute could involve a number of types of wrongful activity. The first two sections of this chapter deal with infringement, including the main issues underlying infringement and the common types of disputes. The third section covers dilution, and the last section describes cybersquatting and arbitration of cybersquatting disputes.



#### RELATED TOPIC

**If you are not familiar with basic trademark principles,** we recommend that you review Chapter 1, “A Trademark Primer,” in which we explain trademark basics and the sources of trademark law.

**CAUTION**

**The rules in this chapter are based on the premise that the business complaining of infringement, dilution, or cybersquatting has a valid trademark.** If a trademark is not distinctive, has been abandoned, or has become generic, the owner has no rights to enforce and will not prevail in a trademark dispute.

## Trademark Infringement

As a general rule, the first user of a trademark in a marketing territory (known as the “senior user”) will be able to stop a subsequent user (called the “junior user”) from using the same or a similar mark on similar goods and services. Below, we discuss the most important elements used when a court sorts out an infringement dispute between a senior and junior user.

### Customer Confusion

When courts attempt to sort out trademark disputes, the most important issue is often whether customers are likely to be confused. Will the purchaser of goods or services likely be confused as to the source of the goods or services? Or will the purchaser of goods or services likely be confused as to which product or service is being purchased?

**EXAMPLE 1:** Sally Lee Humbold sells frozen pizzas under the name Sally Lee’s Italian. Because customers might think that the pizzas are a Sara Lee product, chances are excellent a judge would prevent her from using the name, even though pizzas and baked goods don’t directly compete with each other. In addition, because Sara Lee is used on such a wide variety of frozen foods that it’s reasonable to foresee a Sara Lee frozen pizza in the future, Sally Lee’s use will likely cause confusion.

**EXAMPLE 2:** Oliver LaRocque of Sedona, Arizona, markets a brand of garlic-stuffed olives to several Sedona markets under the name

Ollie's Stinking Olives. Pollie Jones, an unfriendly neighbor, decides to compete with Oliver and names her product Pollie's Garlic Olives. Because Ollie and Pollie have competing products under marks that could easily be confused by customers (they might mistakenly buy Pollie's olives thinking they are Ollie's olives), the marks legally conflict.

Generally, it's fair to say that customer confusion will be a factor in each of these disputes:

- You believe that customers might currently confuse your goods or services with a competitor's because of a physical or perceptible similarity between the two marks and an overlapping of marketing territories or channels
- You purposely selected your mark because of its similarity to another mark, and the owner of the other mark is now calling you on it.

The purposes of the customer confusion rule are to ensure that a business that invests in a mark benefits from the resulting goodwill that attaches to the mark and to protect consumers from marketplace confusion that would result from overlapping marks.

We briefly discuss here three of the main factors in a customer confusion inquiry. These include the similarity of the goods or services, the marketing territories, and the intent of the junior user of the mark. (In Chapter 6, we provide all of the factors used to evaluate customer confusion.)

### Answers Are Hard to Come By

No book can give you the definitive answer as to when customer confusion is likely in a given case. Even an attorney can only give you an educated guess. Many trademark cases involve attorneys on opposite sides who are seriously convinced that customers both would and would not be confused by a simultaneous use of the disputed marks. The bottom line is, it is very difficult to tell who is right in any given trademark dispute.

### No Proof of Confusion Required for Counterfeits

A district court ruled in 2008 that the likelihood of confusion standard is simplified for counterfeits. When goods are classified as counterfeit—that is, lookalike goods with fake trademarks—there is no need to conduct a factor-by-factor analysis of likelihood of confusion. In a case involving two merchandising companies, the district court ruled that by their very nature, counterfeit goods cause confusion. (*Bravado International Group Merchandising Services v. Ninna, Inc.*, U.S. Dist. LEXIS 78040 (E.D. NY October 6, 2008).)

### Similar Goods and Services

As a general rule, a junior user is permitted to use a similar mark on dissimilar goods. That's because customers are less likely to be confused when similar marks are used on different goods and services. Therefore, when courts are considering the likelihood of confusion in a given case, they ask whether the products or services are similar to each other. If the goods or services in question are not similar or even related, confusion is not likely to result, so no infringement will be found. For example, many similar names coexist legally as marks on different goods, like Cascade, which separately identifies a whiskey, a baking mix, and a dishwashing detergent—all of which are names owned by different companies. Dunhill cigarettes and Dunhill shoes, and Sunkist fruits and Sunkist baked goods, are other examples of identical names used to identify goods in product categories that are sufficiently different to avoid the likelihood that customers will be confused as to the products or their sources. One exception to the principle of similarity of goods is if the senior user is likely to expand into the junior user's product area (see "Bridging the Gap," below).

Similarity of goods is not a factor in dilution cases.

### **Bridging the Gap**

Even though the two parties in an infringement dispute have dissimilar products, a court may consider whether consumers would reasonably expect that the senior user would expand its product line into that of the junior user. This potential expansion of the product base is referred to as “bridging the gap.” For example, a federal court determined that consumers would be likely to be confused by the McDonald’s trademark for food establishments with McSleep for motel services because the “Mc” prefix has been used so extensively by the McDonald’s Corporation that its expansion into non-food categories is expected by consumers. “Bridging the gap” is usually only an issue in disputes involving a popular mark, because the customers of a well-known company, such as Microsoft, McDonald’s, or Nike, are more likely to expect an expansion of the company’s product base.

### **Marketing Territories**

Two marks come into legal conflict only if they are used in the same market or marketing territory. Trademark law as it exists today developed at a time when geography played an important role in resolving trademark conflicts. If the same trademark was used by different businesses in different parts of the country, there was no likelihood of customer confusion and, therefore, no need for intervention by a court unless and until one of the users expanded into the other user’s territory.

In the age of modern communications and the Internet, the definition of what constitutes a marketing territory is rapidly changing. Because of cable TV superstations, the Internet, online computer services such as YouTube, national newspapers and periodicals, and syndicated radio and TV programs, the producers of more and more goods and services are able to claim a national marketing territory.

Still, many businesses in the United States are local in nature, and unless they are doing business on the Internet and reaching out to a wider customer base, they may reasonably claim only a relatively small

portion of a city or county as their marketing territory. For instance, two video rental businesses using the same name are likely to have completely different marketing territories if one of them is in Pasadena and the other is in Manhattan Beach, which are separate cities 30 miles apart yet still within the greater Los Angeles area. And even if both businesses have sites on the Internet, their customer bases will almost certainly remain local.

But what if you are operating a business online and offline that can deliver goods or services on a mail-order basis? As the use of the Internet increases, the chances are greater that you and any other user of the same mark in the country or the world will be offering goods and services that will compete in that new territory we call cyberspace. This competition will put your marks in conflict, a state of affairs that can only lead to trademark infringement issues.

Though a marketing territory is impossible to define with precision, it is relatively easy to recognize. It is the rough geographic area from which a business of your type can reasonably expect to attract its customers. If anyone anywhere can order products or services from you through your website, or your mail-order business is advertised in national periodicals, or your products are regularly reviewed in national trade magazines, your marketing territory is the entire country. If your only marketing is done in your local yellow pages, the phone company has, in effect, defined your marketing territory for you.

Rules for evaluating marketing territories are evolving with the development of the Internet and, in coming years, there may be clearer standards to judge the size and scope of any particular cybermarketing territory.

### **Intent of the Junior User: Good Faith/Bad Faith**

The outcome of a likelihood-of-confusion analysis is often influenced by the junior user's intent. In an infringement dispute, courts will inquire as to whether the junior user initiated use of its mark in good faith.

Good faith involves two issues:

- Did the junior user know of the existing mark at the time it began using the mark in commerce?

- Was the existing mark known in the junior user’s marketing territory at that time?

If either question can be answered “yes,” then good faith is not present, and the junior user must stop use of the mark upon a challenge by the senior user. Let’s take a closer look at these questions.

### How Most Disputes Are Resolved

If you can’t tell for sure who is in the right, then how should you proceed if you are locked in a trademark dispute? The only way to force a resolution is to go to court and find out what a judge has to say. But courts are expensive. It may be possible—if both parties agree—to resolve the dispute through mediation or by submitting the issue to arbitration. However, most trademark disputes are resolved through negotiation and typically end up with the economically weaker party agreeing to back down, regardless of who was first to use the mark. If, however, the economically weaker party has a strong legal claim to ownership of the mark, the larger company usually will be willing to pay something in exchange for the weaker party’s acquiescence. Please understand that the authors aren’t endorsing what appears to be a cynical view of how trademark disputes get resolved. It’s just the way things are.



#### CAUTION

**A fine legal point.** Technically, the good-faith issue only extends to whether the junior user knew of the existing mark. The issue of whether the existing mark was known in the junior user’s marketing territory is usually discussed in terms of remoteness—that is, the junior user must qualify as a distant user, separated in distance from the marketing territory of the senior user, in order to preserve some rights. We have combined the good-faith and remoteness factors under the good-faith label for greater simplicity of presentation. It should cause no problem in understanding your rights as we discuss them in this chapter.

## The Concept of Reverse Confusion

In traditional trademark infringement cases, the junior user of a trademark confuses consumers into believing that they are buying goods from the senior user. In the 1970s, a federal court created a variation on this principle, known as “reverse confusion.”

In early 1974, Big O Tires, a midsized regional tire distributor, began marketing a bias, belted tire under the unregistered mark BigFoot. The tire giant Goodyear coincidentally decided to market a radial tire under the BigFoot mark in late 1974. The larger company pumped millions of dollars into its advertising effort, which overlapped Big O’s advertising effort to some extent. As a result, the public began coming to Big O asking for Goodyear’s tire. Angry and disappointed, consumers suspected Big O of stealing the idea from Goodyear.

But, in fact, Goodyear had become aware of Big O’s prior use of the same mark midway into its marketing plans and had unsuccessfully negotiated to buy the mark from them. Nevertheless, Goodyear continued to use the mark. In this case, Goodyear spent so much money on advertising in such a short period of time (including expensive Super Bowl advertisements), that the public associated Goodyear with the trademark and believed that Big O was the junior user (and thus an infringer). This resulted in a judgment for Big O of \$4.7 million and the debut of a new type of infringement based on reverse confusion.

If the junior user knew of the first use before adopting the mark, the dispute will be resolved entirely in favor of the senior user. However, if the junior user didn’t know of the first use, that user may have some rights—although limited—in case of a dispute, unless the mark was known to the customers in the junior user’s marketing territory. If it was, it won’t make any difference that the junior user didn’t actually know of the mark. The senior user will be given priority on the ground that its marketing territory was already established when the junior use was initiated. If, on the other hand, neither the junior user’s customer base

nor the junior user had knowledge of the existing mark, the junior user may continue to use the mark in its current marketing territory, but nowhere else.

As we'll see in the rest of this chapter, the junior user will be presumed to know about any mark that is on the Principal Register. This, of course, means that a search of the federal trademark register is always wise before adopting and using a new business name or other device as a service mark or trademark. Although there is no similar presumption that a junior user ought to know of an unregistered mark just because it is well known, we are fast becoming a global village, and more and more marks can be said to have a nationwide exposure. And, as we explained above, if the senior user can establish this fact, the senior user will prevail over the junior user.

## **Priority of Use: Who Used the Mark First?**

As a general rule, if a legal conflict erupts between two businesses using the same or a similar mark, the business that first used the mark is considered the owner of the mark and will prevail against the junior user. Therefore, it should not be surprising that most of the rules for resolving trademark disputes that we use in this chapter turn on the question of who used the mark first. "Use" is defined as either:

- actual use in commerce, or
- constructive use through an application to the PTO to register the mark on an intent-to-use basis.

### **Actual Use in Commerce**

A mark is in actual use when it is attached to a product that is being sold in the marketplace or is used in a business's marketing materials for the purpose of selling the business's service. Actual use must be a commercial use, not simply a token use to obtain trademark priority. (See Chapter 7, "Federal Trademark Registration," for more on what constitutes actual use.)

## Constructive Use

It is possible to apply to have a mark placed on the federal Principal Register on the basis of intended use—even though the mark is not yet in actual use. The date an intent-to-use application is filed with the PTO is considered the date the mark was first used, assuming the applicant goes on to actually use the mark at a later time and files the necessary documents to place the mark on the Principal Register. This type of use is termed a constructive use because it is created by the law rather than by real events.

**EXAMPLE:** In March 2009, Paul begins distributing a line of distinctive jewelry (bracelets and earrings) called Cleopatra Designs. Unknown to him, Oscar had previously applied to register Cleopatra Designs on the Principal Register in connection with his intended use on a line of women’s clothing. Even though Paul actually began using the mark first, and Oscar’s application is still pending, Oscar will have priority on the basis of first use if his application is ultimately approved and a legal conflict develops between the two marks.

Priority of use is a crucial question in infringement disputes and often turns on the status of the mark (federally registered or unregistered) and the territory. We discuss various priority scenarios in the next section.

## Domain Names and Trademark Infringement

If a domain name is used as a trademark—that is, it’s being used to identify goods or services in the marketplace—it is subject to the same rules regarding infringement as any other trademark. If the domain name is not being used for a commercial purpose, then it would not be subject to a claim of infringement.

**EXAMPLE 1:** Jonah Ishmael creates a personal website with the domain name Ahab.com. Jonah uses the site to post pictures of his family, some poems he writes from time to time, and a statement of his political philosophy. Because Jonah is not using the term

“Ahab” as a means to identify goods or services or an entity doing business on the Web, the domain name isn’t being used as a trademark. If Ahab Tours, a business that offers whale-sighting tours and a collection of historically famous whale art, decided to accuse Jonah of trademark infringement, Jonah would respond that because he isn’t using the name as a trademark, there is no likelihood of customer confusion and therefore no infringement.

**EXAMPLE 2:** Jonah becomes interested in whale art and decides to open a cyberart gallery featuring contributions by various contemporary artists who like to feature whales as part of their art. At this point, there is little question that Jonah is using ahab.com as a trademark, and Ahab Tours would have a basis to sue for trademark infringement.

As with any trademark owner, a domain name registrant uses its new domain name at its peril if it doesn’t first conduct its own thorough trademark search. If someone else is already using the proposed domain name as a mark, and the context of the two uses—the other mark and the domain name—would likely lead to customer confusion, the business seeking to register a domain name should pick a different name at the outset.



#### FREQUENTLY ASKED QUESTION

##### Can we copy logos to save money on company shirts?

*“I work for a corporation that requires us to wear uniform shirts with the company logo. The boss supplies the shirt at what we believe to be an elevated cost, and we were wondering about finding shirts on our own. Would it be legal for an embroiderer to use the company’s trademark to produce shirts for the employees of that company to wear, or would we need to obtain permission to use the trademark?”*

The answer to that question may be in your company’s employee handbook (assuming your company has one). In other words this would be a case of your employment rules taking precedence over trademark rules.

**What state do you live in?** Even if your employee handbook proscribes rules where to buy your shirt, you should still check your state's labor laws. Many states regulate costs of company uniforms or other dictated dress codes. For example, in California, your employer must pay for your uniforms or other required on-the-job dress.

**If it comes down to trademarks ...** If your employee handbook doesn't address the issue and your state laws don't help, then the question is: "Does it violate your company's trademark rights to create unauthorized T-shirts with the company logo?" We're pretty sure you will run into a problem. We think your unauthorized use of the corporate logo is likely to cause confusion (and if done badly, it may dilute the company mark, assuming the mark is famous). And of course, unlike other types of infringement, the company is very likely to learn about the infringement.

## Defensive Maneuvers

In addition to disproving priority and likelihood of confusion, a junior user accused of infringement has other potential defenses, most of which have been introduced in previous chapters. Below, we provide a brief summary of the available defenses, most of which will apply to infringement, dilution, and cybersquatting. For more information on these legal defenses, review the related chapters or, in the case of more obscure defenses, such as laches, estoppel, unclean hands, trademark misuse, and fair use, consult an attorney versed in trademark law. The possible defenses include:

- **The mark is descriptive.** A junior user can defend its use if a senior user's mark is weak and lacks secondary meaning (see Chapter 1).
- **Abandonment.** A junior user can defend its use if the senior user has abandoned its mark (see Chapter 8).
- **Genericness.** A junior user can defend its use if the senior user's mark has become the generic term for the goods or services (see Chapter 8).
- **Trademark misuse.** A senior user may be prohibited from recovering damages for infringement if it has violated antitrust laws or used fraud to obtain a registration.

### Defensive Maneuvers (continued)

- **Fair use.** Can you run an ad for your company selling dishwashing machines that refers to the “joy of dishwashing” without infringing the trademark “Joy” as used for dishwashing soap? Yes. A company may defend its use of a trademarked term (owned by someone else) when the term is used to describe products or services. In 2005, the U.S. Supreme Court ruled that the fair-use defense can be made even when the use results in consumer confusion.
- **Free speech and parody.** In certain cases, a junior user can defend its use under First Amendment principles. For example, the makers of the video game, “Grand Theft Auto: San Andreas” were permitted to parody an East Los Angeles strip club, “The Play Pen,” (referred to as the “Pig Pen” in the game). The court permitted the parody under First Amendment principles noting that artistic use of a mark is permitted when: (1) the use has artistic relevance to the work at issue (the video game), and (2) it doesn’t explicitly mislead consumers as to the source of the mark or the work. (*E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.* 547 F.3d 1095 (9th Cir. 2008).)
- **Unclean hands.** A junior user can defend its use by claiming that the senior user acted in bad faith.
- **Estoppel.** A junior user can defend its use if the junior user has justifiably relied on the senior user’s behavior.
- **Laches.** A junior user can defend its use if the senior user waited too long to file the lawsuit.
- **Trade dress and product configuration defenses.** In cases of trade dress infringement, two defenses are particularly important: functionality and distinctiveness. If a senior user’s trade dress or product shape is functional or lacks distinctiveness, it is not protectible and cannot be infringed. (See Chapter 1.)

## Determining Priority in an Infringement Dispute

Now that you have some general information about trademark disputes under your belt, it's time to get specific. The rest of this guide will give you a pretty good idea of who has legal priority over the use of a mark in case a legal conflict develops between you and another business. But to apply the discussion to your particular situation, you will need to answer the following questions (except in dilution claims—see the next section):

- Is the other mark registered on the federal register?
- If the other mark is federally registered, what is the date of registration?
- Was the federal registration based on actual use or intended use?
- When was the other mark first used, if the federal registration is based on actual use?

If you don't know the answers to these questions, they can be obtained through a trademark search. See Chapters 4 and 5 for more on trademark searching. Below are some of the common scenarios found when determining priority.

### Your Unregistered Mark Conflicts With a Federally Registered Mark

Here we discuss who has priority in case your mark is *not* registered on the Principal Register and the other mark is.

Assume you receive a letter from a lawyer informing you that your unregistered mark conflicts with another mark that is on the federal Principal Register and demanding that you cease and desist from any further use of your mark. The fact that the other mark is on the federal Principal Register while yours is not may be pretty scary. And in truth, the other mark's owner holds some high cards. But as you will see from the discussion and examples below, despite the other claimant's federal registration, you may still have some rights, depending on the timing of events.

## If You Are the Senior User

If you used your mark before the other party used its mark and can prove it, you have a right to continue using your mark based on the rules discussed below.

### In your existing marketing territory

You may use your mark in the same part of the country where you were using it when the junior user applied for federal registration.

**EXAMPLE:** You opened the Date Palm Restaurant in Kansas City in 2005. In 2007, a chain, Date Palm Inn, opens hotels in four Southeastern states. The Date Palm Inn mark was registered with the PTO that same year. In 2010, the Date Palm Inn chain discovers your Date Palm Restaurant and a lawyer sends you a cease and desist letter, citing the Date Palm Inn's registration of the Date Palm Inn mark on the Principal Register. The lawyer demands that you immediately change the name of your restaurant. You may continue operating in Kansas City on an exclusive basis under your existing name because you were the senior user of the Date Palm mark in that territory.

### In all other areas

You may claim the exclusive right to use your mark in all other parts of the country if you can prove that the owner of the registered mark actually knew of your mark's use at the time of the registration application and failed to disclose this fact to the PTO. The deliberate failure of a junior user registration applicant to disclose the existence of a conflicting mark can lead to cancellation of the trademark registration.

If the owner of the registered mark didn't know of your unregistered mark's use, however, the registered owner will be given priority (that is, the right to exclusive use) in all other parts of the country where a later simultaneous use of the two marks would create the likelihood of customer confusion.

**EXAMPLE 1:** Continuing the Date Palm example, assume you can prove that the Date Palm Inn owners actually knew of your use

of the Date Palm mark prior to 2007, the year it registered the mark with the PTO. This fact would allow you to continue using the Date Palm mark in Kansas City on an exclusive basis and to expand your right of exclusive use to the rest of the country, even to the four states in which the Date Palm Inn currently operates. That's right. If the owner of the Date Palm Inn trademark knew of your mark's prior use on a restaurant when it registered its mark and failed to disclose the fact to the PTO, you would most likely be able to have the federal registration canceled, and the company would have to change its name if you decided to enter its marketing territory.

**EXAMPLE 2:** Continuing the Date Palm example, assume you can't show that the Date Palm Inn knew of your mark prior to the time it registered its mark. In this situation, you can remain in your current marketing territory, but the Date Palm Inn will have the exclusive right in the future to use the mark in any other part of the country it chooses to expand into, even if later you have expanded into that area ahead of the Date Palm Inn. This is because the Date Palm Inn's registration was in good faith (neither it nor the PTO knew of your mark, and your mark wasn't known in the Date Palm Inn's original marketing territory).

### **If the Registered Owner Is the Senior User**

If the owner of the federally registered mark is the senior user (actual use or constructive use through the filing of an intent-to-use application), the rules discussed below apply.

#### **In your marketing territory—without knowledge of the senior user's mark**

If neither you nor the customers in your marketing territory had knowledge of the senior user's mark when you first used your mark, and your first use was before the senior user's mark was placed on the federal trademark register, you can continue using the mark in your marketing territory on an exclusive basis.

**EXAMPLE:** Modifying our Date Palm example, after the Date Palm Inn chain starts operating in 2007, and, without knowledge of that earlier use, you open the Date Palm Restaurant in Shreveport, Louisiana, in 2008, an area in which the Date Palm Inn is unknown. The Date Palm Inn then places its mark on the federal register in 2009. You may continue using the Date Palm mark in Shreveport on an exclusive basis in your marketing territory. This is probably only Shreveport, but could be argued to include nearby areas of Louisiana.

**In your marketing territory—with knowledge of the senior user’s mark**

If you knew that the senior user’s mark was in use prior to yours, or if the senior user’s mark was known in your marketing territory even though you didn’t know of it, the senior user may expand into your marketing area and force you to stop using your mark. If you first used your mark after the senior user’s mark was registered, knowledge of the senior user’s first use will be presumed. In either situation—actual or presumed knowledge—you may only continue using the mark in your area until the senior user decides to expand its market into your area. Then you will have to stop using the mark altogether. Otherwise, you may be liable for large damages as a willful infringer.

**EXAMPLE:** Assume that you know of the Date Palm Inn’s registered mark when you open your restaurant in 2008, and the Date Palm Inn can prove it. (In this situation, all the Date Palm Inn would have to do to prove your knowledge is to show that their federal registration occurred prior to your first use of the mark.) If and when the Date Palm Inn decides to expand into Shreveport, you can be forced to change your restaurant’s name. Your name may also be at risk if the Date Palm Inn expands into any area that draws its customers from Shreveport, because Shreveport would then be part of its marketing territory, and it would have a right to exclude your use of the name. If the Date Palm Inn launches an advertising campaign designed to draw customers from all over the country—or creates and maintains a site on the Internet—its marketing territory will be national, even if it doesn’t move into Shreveport.

### What If You Are Asked to Change Your Mark?

In fact, many marks used by small and medium-sized businesses can be modified without significant damage, especially if there is time to plan the change. While some customers may be lost when a new mark is introduced, most will continue patronizing a business or using a product that has served them well. And a name change can even provide a convenient opportunity for a business to draw attention to its goods or services by announcing the change in the media and direct mail pieces. Also, if a big company is challenging a small company's mark, the small company can often get a lot of mileage in the media if it emphasizes how it has been bullied into making the change.

#### In other marketing areas

If the other company is the senior user but did not federally register the mark until after you started using your mark, the other company will have priority wherever the two marks come into conflict.

**EXAMPLE:** You start using the Date Palm mark before Date Palm Inn's registration of the mark. You can use the mark as long as it doesn't come into conflict with the Date Palm Inn's registered mark. In territories where conflicts do develop, you will have to withdraw, and Date Palm Inn will be able to use the mark.

If the registered mark is being used nationwide and you started using your mark after the date of registration, you may be subject to heavy damages as a willful infringer.

**EXAMPLE:** A San Francisco Bay Area comedy group puts together a satirical review called Lawbonics, a series of skits about lawyers and their bizarre professional speech patterns. The comedy group places Lawbonics on the federal register and seeks national bookings. A year later, without actual knowledge of the California group, you start a similar act in Vermont. Because the California Lawbonics group first used and federally registered it prior to your use of the

mark, you have infringed the California group's service mark. And, because that group's registration gave you "constructive notice" of its prior ownership of the mark, you will be considered a deliberate infringer if the matter gets to court, even though you really were unaware of the prior use.

## Your Unregistered Mark Conflicts With Another Unregistered Mark

Conflicts between unregistered marks are the most common types of business name disputes small businesses are likely to face. These types of disputes are usually between business names that are also being used as service marks. They are usually governed by state trademark and unfair competition principles, which are designed to combat customer confusion in the marketplace and protect the first user of a mark because of fairness considerations. However, you may also invoke the federal unfair competition provision of the Lanham Act if one of the unregistered marks is used in interstate, interterritorial, or international commerce.

As a general rule, the more distinctive the mark in issue, the more willing the courts are to find the likelihood of customer confusion and protect the senior user's right of exclusive use.

**EXAMPLE 1:** You open a day care center for the elderly in St. Paul, Minnesota, named *The Seniors Club*. Several years later, in the same part of town, another day care center called *The Senior Citizen's Club* opens its doors. You will be able to get the second business to change its name if you can convince a court that customer confusion between the two names is likely—that is, the other center is likely to draw from your customer base and the court believes your name is distinctive enough to protect. In this example, however, the court may find that your name is ordinary and weak rather than distinctive, and rule that *The Senior Citizen's Club* is different enough to not risk customer confusion (because customers attach little significance to weak marks). It is also possible that a court may invoke the state's unfair competition laws (see Chapter 1)

to order the second user to alter its name in some respect to protect the first user.

**EXAMPLE 2:** Since 2005, you have sold your ready-to-eat barbecued ribs to a number of Missoula, Montana, supermarkets under the mark Clarence’s Rockin’ Ribs. They are very popular throughout the Missoula area. In 2010, Steve starts selling Steve’s Rockin’ Ribs to markets in a three-state area, including Missoula. You can force Steve to adopt another mark for his ribs, since “Rockin’” as applied to ribs has become a distinctive mark over time and belongs exclusively to you, at least in the Missoula area.

If your mark and another unregistered mark have been used in different geographical areas without coming into conflict, but then simultaneously (more or less) come into conflict in a new marketplace, unfair competition principles may resolve the conflict in several ways. Dual use may be authorized with certain conditions attached:

- One of you may prevail on the grounds that the area in question was a natural part of your original marketing territory.
- One of you may be ordered to change your mark somewhat to distinguish it from the other.

**EXAMPLE:** You start a sign business in Newport, New Hampshire, that specializes in magnetic signs for trucks (they stick to the truck panel). You call your business Sign Up but don’t register the name, even though you do a little business across state lines with Massachusetts and Vermont customers. Within the next several years, similar sign businesses are started by other entrepreneurs in San Francisco, Dallas, Chicago, and Miami, using the same name. They also don’t register the name. Because the name is used in different marketing areas, there is no legal conflict.

What happens, however, if you and one of the other businesses simultaneously decide to operate a national mail-order sign business under Sign Up by creating a site on the Internet? Because both businesses would be in conflict everywhere in the country, and because

both businesses would be in conflict with the other regional users of the name, even if those regional businesses weren't on the Web, clearly something would have to give.

Theoretically, of the two companies that were using the Web to market the sign service, the senior user would have priority and could stop the other Web-based company (the junior user) from using it. As for the other regional companies, it's possible that they also could be prevented from further use of the mark on the ground that when they adopted their names, they did so at the risk of being forced to stop using them if and when one of the senior users decided to go national.

Traditionally, these regional companies might have been able to continue using the mark in their regions on an exclusive basis, but the way the Internet works, regional markets are becoming less feasible.

The solution ultimately favored by the courts in this type of scenario is an adjustment of one of the marks so that both businesses can continue their operations with a minimum of disruption without creating customer confusion. But if it appears that the junior user is deliberately trying to piggyback on the senior user's goodwill, the junior user may be forced to choose a completely different name and even pay some damages as punishment.

## **Your Federally Registered Mark Conflicts With Another Federally Registered Mark**

Here we explain what your rights are if your mark and the other mark are both registered on the federal trademark register.

It occasionally happens that two marks that both have been placed on the federal trademark register come into conflict with each other in the marketplace. This can occur for a variety of reasons. The PTO may approve two identical or very similar marks for registration because:

- The registration applications state that the marks will be used on goods and services in different classes, and it appears that the goods or services won't compete in the marketplace and aren't related enough to create the likelihood of customer confusion.

- An examiner honestly but mistakenly believes the two marks are sufficiently different to eliminate the likelihood of customer confusion.

As stated earlier, once a trademark is placed on the federal register, its owner is presumed to be the rightful nationwide owner of the mark. When you have two presumed rightful nationwide owners claiming title to the same (or very similar mark), the conflict can be difficult to unravel. Sometimes, this can be accomplished in proceedings brought in the PTO itself, while other times, court action may be necessary. The result will depend on why and when the conflict developed.

**EXAMPLE 1:** You use the mark TeeTotaler on a brand of fruit juice, while Julie uses this same mark on her chain of vegetable juice bars. Although unlikely, it is possible that you and Julie will both get your respective marks onto the federal trademark register because one is a trademark being used on a juice product sold in supermarkets while the other is a service mark used on a health drink service business. Though there is no direct competition between you and Julie, it's easy to see that consumers might think that your product is really being marketed by Julie's business or vice versa. In short, customer confusion is likely if the mark is used in a context where consumers might experience both uses. In this instance, you and Julie might be restricted by a court in the use of your marks to your respective and distinct marketing territories, and whoever can prove first use might be given priority when expanding to areas where the mark is not in use.

**EXAMPLE 2:** Assume now that you originally applied to register the mark TeeTotaler for use on a brand of biodegradable golf tee but later changed your mind and used the mark on your fruit juice line. Because your use of the mark was vastly different than that described on your registration application, your registration would not count when resolving the conflict with Julie's mark. In other words, Julie would be treated as a registered owner of the mark, and you would be an unregistered owner for purposes of resolving the dispute.

## Your Federally Registered Mark Conflicts With an Unregistered Mark

You're in a strong position if your mark is registered and the other mark is not. You are presumed to be the nationwide exclusive owner, and the other owner is definitely on the defensive. However, the fact of registration doesn't mean you'll win a trademark dispute. It depends, as with other disputes over your mark, on the principles discussed below.

### If You Were First to Use the Mark Anywhere and Registered the Mark Before the Second Use Began

If you used your mark and federally registered it before the other business used its mark, you have the exclusive nationwide right to use the mark and can stop the other owner from using the mark in any geographic market in which you decide to market your goods or services. If you maintain a site on the Internet or otherwise nationally market your goods or services, you can require the other business to stop using the mark immediately. However, if your use is local or regional and the other user's local or regional market is completely separate from yours, you will have to wait until you are on the verge of entering the other market to require your competition to adopt another mark.

**EXAMPLE:** You are a Rhode Island publisher of travel guides that specialize in the Northeastern states and carry the mark Yankee Visions. You successfully obtain a federal registration for the mark. Two years later you learn that a travel guide publisher for the Northwestern states began using the same mark for its publications after the date of your registration but has not registered it. Because of your registration, the competitor will be deemed to have had knowledge of your mark's previous use, which means you can force the competitor to stop using the mark if and when you decide to market your guides in the Northwest. But if your marketing efforts remain restricted to one portion of the country—say the Northeast and Eastern Seaboard—and the competitor stays in the Northwest, you won't win a trademark infringement case unless you can show

that you want to enter the Northwestern market and are prepared to do so.

As we emphasize throughout this material, the Internet and other national marketing techniques make a collision between marketing territories more and more likely.

### **If You Were First to Use the Mark Anywhere but Registered the Mark After the Second Use Began**

It is possible that the other user started to use the mark after your first use but before your mark was placed on the federal register. In this situation, the rights of the second (junior) user will turn on the answers to these two questions:

- Did the junior user have actual knowledge of your mark's use?
- Was your mark known in the junior user's marketing territory?

If the junior user had actual knowledge of your mark's previous use (and you can prove it), the junior user has no rights and must give way if and when your mark and its mark come into conflict in a marketing territory.

And regardless of the junior user's knowledge, if your mark was known within the marketing territory from which the junior user's customer base was being drawn, the junior user will have to give way if you decide to use your mark in that territory.

**EXAMPLE:** Continuing our Yankee Visions example, assume you can show that the Northwest competitor knew of your mark before it started using its mark. If you later decide to market your guides in that area, you can force the competitor to drop the name. Similarly, if your guides were being distributed in the Northwest prior to the junior use, you can force the competitor to stop using the mark if you now decide to market the guides in the Northwest.

If, however, neither the competitor nor its customer base knew of your Yankee Visions mark when the competitor's use of the mark began, and your product wasn't being sold in your competitor's marketing territory, the competitor can continue using the mark in the Northwest

and freeze you out of that market. This result stems from the fact that the competitor would be deemed to be a good-faith junior user (no actual knowledge of your mark) in a remote marketing territory (conducting no marketing or other activity that would make the customers aware of your mark when the junior use began).

### **If the Other Owner Used the Mark Both Before You Used It and Before You Registered It**

If the owner of the unregistered mark was the senior user, you may continue to use your registered mark in the marketing territory where you are currently using it if the following two statements are true:

- You didn't know of the senior use when your use began.
- The senior use was largely unknown in your marketing territory when your second use began.

**EXAMPLE:** You invent a digital device that attaches to a tennis racquet handle and keeps track of the score during the game. You attach the trademark Total Recall to your invention and register it with the PTO. Test marketing is initiated in California and Arizona. Unknown to you, Felix had earlier been using this same mark on a product designed to keep track of the score of ping pong games he is test marketing in Miami, Florida. Because you had no knowledge of Felix's earlier use when you registered the mark, and because knowledge of Felix's device had not penetrated into your test markets, you may continue using it in your test markets.

However, you cannot use the mark in any area of the country where the senior user was using it as of the date of your registration.

**EXAMPLE:** Because Felix was the senior user, he has the exclusive right to use the Total Recall mark in Miami, and you would be excluded from marketing your invention in that area.

If you didn't know of the other mark's previous use when you registered your mark, you will have priority over the senior user in all areas of the country that he or she has not yet entered. In other words,

you will be rewarded for promptly registering your mark, and the senior user will stay frozen in his or her territory.

**EXAMPLE:** Assuming that you didn't know of Felix's use of the Total Recall mark when you registered, Felix's use will be limited to the Miami area, and you can market your product nationwide.

If any of the following statements is true, the senior user will be given priority in case conflict between the two marks develops:

- You knew of the senior use when you first used your mark.
- Your customer base knew of the previous mark when you first used your mark.
- You knew of the senior use when you registered your mark.

**EXAMPLE:** If you knew that Felix was using the Total Recall mark when you first used yours, or you knew of the use when you registered the mark, or if Felix's test marketing had been going on in the area where you first used your mark, Felix would be given priority in all parts of the country, including your test area.

## Dilution

Famous trademarks acquire additional rights compared to their not-so-famous cousins. Famous marks that may be tarnished or degraded, regardless of whether customers are confused, can halt another company's use of a similar mark. This rule, known as dilution, permits the owner of a famous trademark to sue because the famous trademark will lose its distinctive character and legal strength if degrading or diluting uses of the mark are permitted. Also, according to some courts, the public would be confused in any event by the use of a famous mark in that they would necessarily expect the business owning the famous mark to be associated in some way with the second user.

In 1996, Congress added the Federal Trademark Dilution Act (FTDA) to the Lanham Act, prohibiting activity that leads to the dilution of famous marks (42 U.S.C. § 1125(a)(c)). Ten years later, Congress enacted the Trademark Dilution Revision Act of 2006 which

provided additional remedies and clarified and reinforced provisions of the 1996 act. About half the states also have antidilution laws.

## Federal Dilution Laws

The Federal Trademark Dilution Act provides that the owner of a famous mark shall be entitled to protection against a junior user's commercial use of a mark if the use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. The act defines dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services" regardless of whether the dual use would likely confuse customers or involve competing goods. So, to prevail under the FTDA, a senior user must prove all of the following:

- The senior mark is famous.
- The senior mark is distinctive.
- The junior use is commercial in nature.
- The junior use began after the senior mark became famous.
- The junior use lessens the senior mark's capacity to identify and distinguish goods and services.

The Trademark Dilution Revision Act of 2006 establishes that the owner of a famous mark does not need to demonstrate actual or likely confusion, competition, or actual economic injury when the owner seeks to stop dilution.

### What Makes a Mark Famous?

The Trademark Dilution Revision Act of 2006 defines a mark as "famous" if it is widely recognized by the general consuming public as a designation of the source of the goods or services of the mark's owner. The revision generally does away with a concept known as "niche fame" in which a mark owner argued that its mark was not well known by the public but was famous within its niche industry. Courts are instructed to consider "all relevant factors" when determining whether a mark is famous, including:

- the duration, extent, and geographic reach of advertising and publicity of the mark

- the amount, volume, and geographic extent of sales of goods or services offered under the mark
- the extent of actual recognition of the mark, and
- whether the mark was registered on the Principal Register.

None of these factors is weighted, and the list is not exclusive. As a practical matter, this means that courts have discretion in deciding whether a particular mark is famous for purposes of protection under federal law. Federal law, by associating fame with the factors listed above, has created analogies between fame and distinctiveness. (We covered distinctiveness in Chapters 3 and 9.)

### **In Harm's Way: Dilution After Victoria's Secret**

Victor's Secret, a New Jersey store, sold adult videos, adult novelties, hosiery, temporary tattoos, and lingerie. The company that owns Victoria's Secret—which distributes over 400 million catalogs annually—asked the New Jersey store to change its name, and the store complied, altering its name to “Victor's Little Secret.” When the store refused to modify the name further, the owners of the Victoria's Secret trademark sued for dilution, arguing that Victor's Little Secret tarnished and blurred their famous mark. The Supreme Court ruled that the Victoria's Secret trademark was a valuable and famous mark and that consumers made a mental association when seeing the two trademarks—Victoria's Secret and Victor's Little Secret. But the mental association, by itself, was not enough to prove dilution. Under the Victoria's Secret ruling, the trademark owner must demonstrate *actual* harm to prove dilution (although the Supreme Court suggested that no proof of actual harm is needed to stop a use of an identical mark). (*Moseley v. Secret Catalogue, Inc.*, 537 U.S. 418 (2003).) However, three years later, Congress reversed this decision when it enacted the Trademark Dilution Revision Act of 2006. Under that Act, the owner of a famous mark does *not* need to demonstrate actual or likely confusion, competition, or actual economic injury when the owner wants to stop dilution. All that needs to be shown is the *likelihood* of dilution.

## Tarnishment and Blurring

In 1996, Hasbro, the owner of the trademark Candyland (used on children's games) stopped a company providing adult sex services and products from using the name "Candyland" for its website. (*Hasbro Inc. v. Internet Entertainment Group, Ltd.*, 40 U.S.P.Q.2d 1479 (W.D. Wa. 1996).) In 1999, the National Basketball Association stopped a rap music company from using an altered version of its logo featuring a silhouette of a basketball player. (The rap company's silhouetted basketball player held a gun.) (*NBA Properties v. Untertainment Records LLC*, 1999 U.S. Dist. LEXIS 7780 (S.D. N.Y. 1999).) In both cases, it was unlikely that consumers would confuse the junior and senior users' goods, yet both Hasbro and the NBA prevailed because the junior use tarnished and blurred their famous marks. The Trademark Dilution Revision Act of 2006 clarified the importance and meaning of these two types of dilution. In general, blurring occurs when someone chips away at a mark's distinctiveness. Tarnishment occurs when someone chips away at a mark's reputation for quality.

### Blurring a Mark's Distinctiveness

Part of what makes a famous mark actually famous is that it stands out in the minds of consumers for any one product or service. So when a similar mark appears that makes the mark *less* distinctive because of an unrelated association, blurring has occurred. Bacardi, for example, stands out in the minds of consumers as a source of rum. The use of the same mark for a jewelry store blurred its power and distinctiveness for consumers. In the same way, a Boston restaurant's use of Tiffany's blurred the consumer connotation with the famous jewelry store. In each of these cases, the two marks were identical or very similar, the goods/services did not compete, and no likelihood of confusion existed. Rather, the question was whether the distinctive and famous mark in each of those cases was made less distinctive by the second use of the mark—a question decided in favor of the famous mark owners.

Legislators, when they enacted the Trademark Dilution Revision Act of 2006, defined “dilution by blurring” as an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. When determining whether blurring has occurred, a court can consider factors such as:

- the degree of similarity
- the degree of inherent or acquired distinctiveness of the famous mark
- the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark
- the degree of recognition of the famous mark
- whether the user of the mark or trade name intended to create an association with the famous mark, and
- any actual association between the mark or trade name and the famous mark.

### **Tarnishment, or Injury to Reputation for Quality**

The Trademark Dilution Revision Act of 2006 defines “dilution by tarnishment” as an association that harms the reputation of a famous mark. Tarnishment is usually some unsavory association. For example, the phrase “Where there’s life there’s Bud” may be tarnished by an insecticide maker’s use of the phrase, “Where there’s life, there’s bugs.” In other words, an association with bugs can tarnish a beer maker’s image.

Courts are especially likely to find tarnishment—and trademark owners are more likely to sue—when the offending marks are attached to products that are “unwholesome or unsavory.” Examples of marks that have been enjoined under this prong of the dilution theory are the fake American Express card shown with a condom that said, “Never Leave Home Without It,” the use of Dallas Cowboy cheerleader uniforms in a pornographic film, and the “Enjoy Cocaine” poster that used a script and coloring identical to Coca-Cola’s.

### Parody and Satire Are Not Dilution

Satirical uses or parodies of marks might appear as obvious examples of tarnishment. Nevertheless, our Constitution’s First Amendment (as well as the Trademark Dilution Revision Act of 2006) protects satires and parodies that clearly aren’t using a mark to market goods or services commercially. In addition, federal law excludes from its definition of dilution the use of a famous mark for noncommercial purposes, such as parodies, advertising (including comparative advertising), consumer product reviews, and news coverage. For example, in one case dealing with a website titled “Bally sucks,” a U.S. District Court ruled that because the website was operated for a noncommercial purpose—to criticize Bally’s (a health club)—the use of the Bally mark did not offend the Lanham Act’s antidilution provisions. (*Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998).)

But what about parodies in the form of marks used on commercial products? In the case of federally registered marks, commercial parodies of such marks must meet the standards of federal dilution law, described above.

## Federal Dilution Defenses

The Federal Dilution Act and Trademark Dilution Revision Act of 2006 provide that certain actions won’t give rise to dilution under federal law including:

- **Comparative advertising.** It is not dilution to use a famous mark in comparative advertising. However, the mark should not be altered or modified.

**EXAMPLE:** In a comparative advertisement, a tractor company modified and animated the John Deere “leaping deer” logo and gradually diminished its proportional size in a comparative advertisement. This was determined to be dilution and was not excused under the comparative advertising defense. (*Deere & Company v. MTD Prods. Inc.*, 34 U.S.P.Q. 1706 (S.D. N.Y. 1995).)

- **Noncommercial use of a mark.** There is no dilution unless the junior use is commercial. Because all uses usually have some commercial aspect, a “commercial use” is considered to be one that is primarily to help sell a product or service.

**EXAMPLE:** A pro-life minister used the Internet domain name *plannedparenthood.com* and included a misleading opening screen entitled “Welcome to the Planned Parenthood Home Page.” The site provided antiabortion information and services. A court determined that the use was commercial because it was primarily being used to identify the source of a product or service, not simply to criticize Planned Parenthood. (*Planned Parenthood v. Bucci*, 42 U.S.P.Q. 2d 1430 (S.D. N.Y. 1997) affirmed 152 F.3d 920 (2d Cir. 1998).)

- **News reporting.** Use of a trademark in journalism or news commentary is exempt from dilution claims.
- **Federal registration.** There can be no dilution if the junior user has a federally registered mark. Federal registration also bars state claims of dilution, providing even more incentive to federally register a mark.

## Relief for Dilution

Prior to passage of the 2006 revision act, the main relief the courts were authorized to provide under the Lanham Act provision was injunctive relief—that is, a court would order a company to stop further diluting of the famous mark. Now, a successful trademark owner in a dilution case can collect monetary damages (and attorney’s fees) in cases of willful dilution. This factor provides the antidilution law with considerable punch, because dilution cases are often willful—deliberately intended to trade off of and blur or tarnish a famous mark—for example McClaim and McSleep in the case of McDonald’s. In summary, do not get caught trying to ride on the coattails of a famous mark belonging to someone else. It may end up costing you a bundle.

### State Trademark Dilution Laws

Since 1996, dilution lawsuits have relied primarily on the federal dilution statute (rather than state laws). The revision act of 2006 further enhanced the power of federal registration by barring any state dilution claims against the owner of a federally registered mark. In other words, after 2006, the owner of a federally registered mark cannot be sued for federal or state dilution claims. The states that have dilution statutes are: Alabama, Arizona, Arkansas, California, Connecticut, Delaware, Florida, Georgia, Hawaii, Idaho, Illinois, Indiana, Iowa, Kansas, Louisiana, Maine, Massachusetts, Minnesota, Missouri, Montana, Nebraska, New Hampshire, New Mexico, New York, Oregon, Pennsylvania, Puerto Rico, Rhode Island, Tennessee, Texas, and Washington. An additional five states recognize the dilution doctrine under cases decided by their courts: Kentucky, Maryland, Michigan, New Jersey, and Ohio.

You can find the dilution statutes of most states by visiting the All About Trademarks website ([www.ggmark.com](http://www.ggmark.com)) and clicking on “U.S. State Trademark Laws.”

## Cybersquatting

A cybersquatter is a person who registers a well-known trademark as a domain name hoping to later profit by selling the domain name to the trademark owner. The practice of cybersquatting originated at a time when most businesses were not savvy about the commercial opportunities on the Internet. Some entrepreneurial souls registered the names of well-known companies as domain names—the now familiar [www.companyname.com](http://www.companyname.com)—with the intent of selling the names back to the companies when they finally realized the economic potential of the Internet. Panasonic, Fry’s Electronics, Hertz, and Avon were among the “victims” of cybersquatters. Opportunities for cybersquatters are rapidly

diminishing, because most businesses now know that registering and protecting their domain names is essential.

Keep in mind that, in some instances, a conflict over the use of a domain name is due to an honest mistake and may not involve the degree of bad faith to prove cybersquatting. When we talk about cybersquatters, we are referring to those who deliberately stake out domain names with the intent of profiting from use of someone else's trademark.



#### RELATED TOPIC

**For more information about domain names, see Chapter 2.**

## Federal Anticybersquatting Protection Act

The new federal anticybersquatting law authorizes a trademark owner to sue an alleged cybersquatter in federal court and obtain a court order transferring the domain name back to the mark's owner. In some cases, the cybersquatter must pay money damages. To stop a cybersquatter, the mark's true owner must prove all of the following:

- The domain name registrant had a bad-faith intent to profit from the mark.
- The mark was distinctive at the time the domain name was first registered.
- The domain name is identical to or confusingly similar to the mark,
- The mark qualifies for protection under federal trademark laws—that is, the mark is distinctive and its owner was the first to use the mark in commerce.

If the person or company that registered the domain name had reasonable grounds to believe that the use of the domain name was fair and lawful, it would avoid a court decision that it had acted in bad faith. In other words, if the accused cybersquatter can show a judge that it had reason to register the domain name other than to sell it back to you, the trademark owner, for a profit, then a court will probably allow the person or company to keep the domain name. That's because the name was not acquired in bad faith.

Congress has developed some guidelines for the courts to use in looking for bad faith. They include:

- Is the registrant using the domain name to divert users from the mark owner's site to another site, where customer confusion is likely to result or the mark's reputation for quality is harmed? In other words, is the domain name being used in a way that negatively affects the mark owner's website or the value of its trademark?
- Has the registrant offered to sell the domain name to the mark owner without ever legitimately using the domain name on a commercial website?
- Has the registrant provided false or misleading contact information to the domain name registrar or failed to keep this information up to date?
- Has the registrant registered multiple names that are the same or confusingly similar to distinctive marks? In other words, is there an apparent pattern of cybersquatting?
- Is the mark in question famous or highly distinctive? The more distinctive or famous the mark, the more the court is likely to conclude that the registrant acted in bad faith.

### The Long Reach of the ACPA

One nice feature of the federal Anticybersquatting Consumer Protection Act (ACPA) is that a trademark owner does not need to obtain personal jurisdiction over the cybersquatter. Personal jurisdiction refers to the court's right to bind the cybersquatter. For example, it is often difficult to obtain personal jurisdiction over out-of-state or foreign cybersquatters. Instead, the trademark owner can proceed under a legal principle known as "in rem," in which the court has control over the property—in this case, the domain name—and the court can award the domain name to the winning party. In a 2002 case involving Harrods and 60 domain names filed by an Argentinean company, this right was further expanded when a federal court ruled that the in rem provisions could also be used for adding claims of infringement and dilution against cybersquatters. (*Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214 (4th Cir. 2002).)

### The Uniform Domain Name Dispute Resolution Policy

All domain name registrars require their registrants to agree that any dispute between a trademark owner and a domain name registrant over the right to use the domain name may be submitted to arbitration. The arbitration system was created and is run by the Internet Corporation for Assigned Names and Numbers (ICANN), the same international organization that is now in general charge of domain name registrations. The arbitration system is referred to as the Uniform Domain Name Dispute Resolution Policy, or UDRP.

Under the UDRP, the arbitrator is authorized to order the domain name transferred to the trademark owner if the owner proves the following elements:

- The domain name at issue is identical or confusingly similar to the trademark in question.
- The registrant has no rights or legitimate interests in the domain name.

- The domain name was registered and/or is being used in bad faith.

Similar proof is required to prevail in a lawsuit based on the federal Anticybersquatting Consumer Protection Act. The Anticybersquatting Act is only enforceable in the United States. The ICANN procedure, on the other hand, can be used against domain name registrants inside and outside the United States.

Here's a look at each of the three elements that must be established by a trademark owner if he or she is to prevail under the UDRP:

- **The domain name is confusingly similar to the trademark.** The trademark owner must prove ownership (the exclusive right to use the mark) and must also establish that the domain name is confusingly similar to the mark (see Chapter 6 for more on likelihood of customer confusion). If the domain name at issue is preventing the trademark owner from using its mark as its own domain name, the “identical or confusingly similar” test will probably be satisfied.
- **The domain name registrant has no rights or legitimate interests in the domain name.** To prove this element, the trademark owner must show three things:
  - The registrant has never tried to use the domain name (or a similar one) in connection with legitimate commerce, on or off the Web.
  - The registrant was never generally known by the domain name, even if the name wasn't used in commerce as a trademark.
  - The registrant isn't using the domain name in any legitimate way.

A legitimate use would, for example, consist of use on a noncommercial website that engages in satire or criticism. But the use would not be legitimate if the registrant's actual intent is to divert consumers from the mark owner's website or business location, or to tarnish the mark by lessening its reputation for quality.

- **The domain name registrant acted in bad faith when registering or using the domain name.** This one is really the flip side of the second item. The registrant has acted in bad faith if any of the following is shown:
  - The registrant acquired the domain name with the intent to sell it back to the mark’s owner—or to a competitor of the mark’s owner—for profit. This wouldn’t apply to those who acquire domain names with the intent to auction them off to the highest bidder later, because such a plan is not directed specifically at a mark’s owner.
  - The registrant has a pattern of acquiring domain names with the intent to block their use by legitimate trademark owners. That is, the registrant is a true cybersquatter.
  - The registrant is a competitor who acquired the domain name primarily to disrupt the mark owner’s business.
  - The registrant is using the domain name to attract users to the registrant’s website by creating customer confusion. (See Chapter 6.)

For example, bad faith was demonstrated by a cybersquatter who purchased domain names in anticipation of a major bank merger. The defendant in a cybersquatting dispute registered domain names that combined elements of Bank of America and Merrill Lynch—for example, bofaml.com. The defendant argued that it had never profited from the sale of any of the domain names. The court rejected that argument since the defendant earned considerable sums by “parking” the domains—that is, by generating pay-per-click revenue. (*Webadviso v. Bank of America Corp.*, S.D.N.Y., No. 09-cv-05769-DC, 2/16/09.)

The procedure for initiating and prosecuting a complaint under the UDRP is for the trademark owner to choose a dispute resolution “provider,” which is an organization approved by ICANN. So far, ICANN has approved four providers. Each provider has its own supplemental rules for dispute resolution, so in addition to ICANN’s procedural rules (available

on the ICANN website at [www.icann.com](http://www.icann.com)), you must follow the provider's rules. You can check them out at each provider's website, which may be reached through the ICANN website. These sites offer detailed discussions about how to navigate the UDRP.

To begin a case, the mark owner sends a complaint to the provider, setting out specific facts that prove the three elements discussed above. As a general rule, the mark owner (the initiator of the process) will be responsible for payment of the provider's fees, although the fees will be shared if the domain name registrant asks for three arbitrators instead of allowing the case to be presented to a single arbitrator.

After reviewing the complaint for completeness, the provider will send the registrant a copy of the complaint, along with directions on how the registrant can respond and within how much time. The domain name registrant can continue to use the name until the dispute is resolved.

The provider will usually issue a decision based solely on the complaint and the response. If unhappy with the decision, either party may go to court. However, if the decision is in the trademark owner's favor, the domain name will be transferred to the owner unless the registrant promptly files a lawsuit to prevent it.

### **When It's Cheaper Not to Fight**

The fees for the UDRP procedure are typically in the \$1,000 to \$1,500 range for one arbitrator adjudicating one domain name. For that reason, many cybersquatters offer domain names at a price in the \$1,500 range. It's a tough call, especially when a trademark owner prefers not to pay off a speculator. But there's an appealing aspect to buying off the cybersquatter; you get the domain name immediately and without any guesswork as to the final decision. If you do pay off a cybersquatter make sure you use an online escrow service to avoid any funny business.



## FREQUENTLY ASKED QUESTION

### Infringing Domain Name?

*“My wife sells handmade jewelry and recently started putting it up for sale in a local shop and asked me to help her get an e-mail address. Knowing a bit or two about the Internet, I decided the best way to do this was to register a domain name and then set up a Google account to host the mail. Everything was set up and fine and then last week, I received an e-mail from a law firm saying that the domain I had registered was an “infringing domain” and that the use of such a domain name incorporates their trademark. Now they say that I have seven days to respond and transfer the domain name to them and provide a sworn affidavit attesting that I ceased selling any goods that infringe on their trademark. If my wife’s little side business is not related to anything that the other company sells, do they have any right to order me to turn over my domain name etc.? I didn’t think that anyone could come after you for just requesting a domain name.*

The short answer to your question is “More information is needed.” You’re correct about the basic trademark principles—if you’re not likely to confuse consumers, then there’s no trademark infringement. That’s why, for example, different companies can use Arrow as a trademark for shirts and staplers and electronics (although only one company can have the domain name, [www.arrow.com](http://www.arrow.com)). Under another theory (dilution), a company with a famous trademark can stop you from using a similar trademark even if the goods or services are not related—for example, Microsoft could stop a company from selling Microsoft Vista dog food.

If you acquired the domain name in bad faith—most notably if you intended to hold the domain hostage in the hopes of selling it back to the trademark owner—then the trademark owner can pursue you in federal court under anti-cybersquatting laws (or can force you to arbitrate under international domain name rules). We’re not saying you’re doing any of these things (and it appears from your letter that you’re not). But if the big company is hassling you, we’re not sure where that will lead. Keep in mind that there’s a financial benefit for the law firm if you fight. (Law firms love people who drive up their billables.) We don’t want you to cave to a bullying law firm but we’re not sure of all the facts in your case and we’re not sure that a \$10 domain name is worth the hassle. (Unfortunately, it would cost you at least ten times that amount for a half-hour consultation with a trademark attorney.)

### The Odds of Success Under ICANN

In a review of over 14,000 proceedings involving domain names brought under the ICANN UDRP system, more than 85% of cases were decided in favor of the petitioner (which is almost always the trademark owner). The ICANN website offers a searchable database of all decisions rendered under the UDRP as well as a statistical summary. You can access this information at [www.icann.org/udrp/udrp.htm](http://www.icann.org/udrp/udrp.htm). Another helpful resource for UDRP proceedings is the Harvard Cyber Law website at <http://cyber.law.harvard.edu/udrp/>.





## If Someone Infringes Your Mark

<b>What Litigation Costs</b> .....	328
<b>How Much Is Your Mark Really Worth to You?</b> .....	328
Can You Recover Attorneys' Fees in State Court?.....	328
Can You Recover Attorneys' Fees in Federal Court?.....	329
Litigation Short of Trial.....	330
Beware of Being Right.....	331
<b>Negotiate—Don't Litigate</b> .....	332
<b>How to Handle an Infringer</b> .....	335
Step 1: Discover the Registration and Use Status of Your Opponent's Mark.....	336
Step 2: Read Chapter 10, "Sorting Out Trademark Disputes, to Discover Who Is the Infringer" .....	336
Step 3: Research as Much as You Can About the Business With Which You Will Be Negotiating .....	336
Step 4: Write a Letter .....	337
Step 5: Negotiate.....	340
Step 6: Consider Other Dispute Resolution Options.....	342
Step 7: Consult an Attorney.....	345

**Y**ou have encountered another business that is using a name for its product or service that is identical or very similar to yours, and you feel you are losing customers and profits as a result. How can you stop them?

Before you pick up the phone to call an attorney, let us take a minute to look at how and whether a lawsuit is likely to solve your problems. If, at the end of this chapter, you still feel you want to litigate, then grab that phone—after reading Chapter 14, “Help Beyond This Book,” for suggestions on finding a lawyer—and good luck!

## What Litigation Costs

Start by reminding yourself that lawsuits usually cost a bundle—a big bundle. Typically, lawyers who handle trademark cases charge \$200 per hour and up. It doesn't take a genius to understand that if you hire a lawyer for a month's worth of work (surely a low estimate for a full-blown trademark fight) it will cost you close to \$40,000. From start to finish, a trademark infringement lawsuit averages about \$120,000 in attorneys' fees for each party.

Perhaps these figures will help you understand why we have great respect for the ancient Gypsy curse that says, “May you be involved in a lawsuit in which you know you are right.”

## How Much Is Your Mark Really Worth to You?

Given the horrendous costs, it pays to carefully consider whether a particular dispute over a mark is worth litigating. Let's look at this issue a little closer.

## Can You Recover Attorneys' Fees in State Court?

If your mark is being used in one state only, your infringement suit will most likely be brought in state court, and the laws of your state will determine how attorneys' fees will be paid. In most states, the courts will not require the loser of a lawsuit to pay the winner's attorneys' fees. Or

stated bluntly, even if you win, you'll have to pay your own lawyer and risk ending up in the poorhouse. However, in a few jurisdictions, such as Colorado, North Carolina, Wisconsin, and Puerto Rico, the prevailing party is awarded attorneys' fees as a matter of course, and in a few others (Alaska, Iowa, Maine, Minnesota, Missouri, Oklahoma, Texas, and Washington), the court has discretion to award attorneys' fees, usually in exceptional cases only.

## Can You Recover Attorneys' Fees in Federal Court?

If your mark is used across state, territorial, or international boundaries, you will probably end up in federal court. Federal law permits an award of attorneys' fees to a victorious plaintiff, but only when the trademark infringement is exceptional—that is, obviously intentional. The bottom line is this: Unless you are dealing with a clear case of bad intentions, don't count on attorneys' fees in federal trademark litigation.

### How Treble Damages Can Help Pay Attorneys' Fees

Although courts have discretion to award attorneys' fees in unusual cases, they are required to award treble (or triple) damages—and order the defendant to disgorge any profits caused by the infringement—in cases where willful infringement is proven. Willful infringement cases therefore have the potential to generate a considerable sum of money over and beyond what the true trademark owner actually suffered from the infringement. Since the goal in most cases is to stop the infringing use—which will happen if the court finds that infringement occurred—the trademark owner can use the damages to pay whatever legal fees are incurred. Trademark lawyers understand this and may therefore be willing to represent plaintiffs in willful infringement cases and defer payment of their fees until the case settles or a judgment is obtained. This is not a contingency fee, because the fee isn't based on the outcome of the case. It's only a method of deferring fees until the plaintiff is in a better position to pay them.

## Litigation Short of Trial

A common strategy is to file an infringement lawsuit and ask the court to grant emergency relief until the case can be fully litigated and decided in a trial. This type of relief—termed a preliminary or temporary injunction—typically orders the alleged infringer to stop using the mark in question pending the outcome of the lawsuit. Because, as a practical matter, getting slapped with an order of this type puts the alleged infringer in an untenable position from the outset, the party bringing the suit usually reaches a settlement on very favorable terms.

To obtain a preliminary injunction, you must convince the court of two basic facts:

- If the emergency relief isn't granted, your business will suffer irreparable injury.
- Your case is strong enough on the face of things to make it probable that you'll win if and when a trial eventually takes place.

The first fact is very easy to show. The mere existence and use of an infringing mark daily robs the owner of the infringed mark of its customer base and the business goodwill that the mark represents. Because there is no real way to measure the loss of goodwill in monetary terms, this type of injury is usually considered irreparable as a matter of course.

The second fact—probable success—is another matter. Here the judge has to be convinced that the plaintiff's infringement claim is strong enough to warrant depriving the infringer of the right to use its mark without first holding a trial. Some judges are more willing to do this than others, and it is impossible to predict whether an attempt to get a preliminary injunction will be successful.

Once the court rules on a request for a preliminary injunction, the losing party has a powerful incentive to settle. If the defendant is enjoined from using the disputed mark pending trial, it means that the judge has found it probable that infringement has occurred. Furthermore, the injunction leaves the defendant little choice but to

adopt a new mark to use during the pendency of the case. These facts usually drive the defendant to cave in unless the plaintiff is seeking treble damages and refuses to settle the case (which is unusual). Conversely, if the plaintiff loses, it means that the defendant will be able to continue using the disputed mark during the pendency of the trial, and that the judge has concluded that infringement probably hasn't occurred. Most plaintiffs are willing to settle rather than pursue the case on such facts.

Because the outcome of the preliminary injunction request usually results in an early termination of the case, the legal fees associated with the normal trademark case often are much less than if the case were fully litigated. But they may still be high—routinely at least \$10,000—because it takes a lot of preparation to successfully handle the preliminary injunction proceeding.

## **Beware of Being Right**

Whether a preliminary injunction and settlement are obtained or the case goes to trial (tack on at least another \$50,000), using the courts to resolve an infringement claim clearly can be, and usually is, very costly. But many otherwise reasonable people insist on it. Why? Probably for the same reason many otherwise reasonable people behave like pit bulls in divorce proceedings—emotional attachment to being right. And remember the Gypsy curse we discussed earlier—many lawyers get rich because clients try to vindicate their positions.

Sadly, the question of who has the right to use a mark often affects people in an emotional way that doesn't always serve their long-term economic interests. They get addicted to their mark, and as with any addiction, they may be willing to spend way beyond what common sense would dictate to keep it. And it may be hard to perceive if your litigation is motivated by ego, principle, or a sense of outrage when the name of your business (which may even get confused with the existence of the business itself) is threatened.

### **The Mental State of the Infringer Matters in Trademark Litigation**

When a mark infringer knew about the infringed mark at the time the infringement began, he or she will be considered a willful infringer. This knowledge is either something that is proved in a trial (such as continued use by the infringer after having been notified of the infringement), or is presumed to have existed if the mark was on the federal Principal Register when the infringement began and the owner of the infringed mark properly used the registration notice with the mark (an ® or a statement to the effect that “This is a registered trademark belonging to Rackafrax Company”). Once the willful label attaches to an infringer, the infringer can be forced to pay treble damages and surrender its profits made from the goods or services carrying the infringing mark.

On the other hand, if the infringer is considered innocent—the business had no knowledge of the infringed mark—the plaintiff-owner usually cannot collect treble damages or the defendant’s profits, and in some cases cannot even prevent the infringer from continuing to use the mark, at least in a limited geographical area.

## **Negotiate—Don’t Litigate**

Negotiation offers you lots of options that litigation doesn’t. For one, it’s cheaper; for two, it’s quicker; and for three, you help fashion the outcome. It gives you a chance to devise a solution both parties can live with rather than wasting time and money trying to allocate fault.

How do you get a purported infringer to the negotiating table? As mentioned, some would advocate a lawsuit to seek a preliminary injunction for that purpose. But that is obviously an expensive method of getting the defendant’s attention. And, of course, whenever litigation is started, there is a risk that it will gain too much of its own momentum and escalate.

A better way to start is to send the infringing business a letter, stating the problem and proposing that you negotiate. The fact that both

parties must bear the high cost of a lawsuit may even become part of the common ground on which you build a solution, instead of a threatening weapon. But no need to give up all your weapons at once. Even if you don't plan to litigate (or would only do so reluctantly), your opponent need not know that at the start.

On the other hand, negotiation does necessarily imply give and take. So you have to decide what you are willing to give and what you need in exchange. For example, must the infringer change the mark completely, or can you live with it if modifications are made? Do you need the matter resolved right now, or are you able to provide the infringer with some time to make necessary changes? What's the maximum you feel it is worth spending on this dispute? How much would you pay to buy the right to use the name, even if you think you already own it?

### **Insurance for Trademark Litigation**

If you are reading this chapter prospectively and have not yet suffered any harm by another's infringement, check into the option of trademark litigation insurance. This is a rider that can be purchased to augment the coverage of a comprehensive general liability policy that all businesses have. The rider offers "advertising injury coverage," which is the coverage that courts have interpreted to extend to trademark and unfair competition claims. This is not yet available in all states, but California, Illinois, and Minnesota permit it, among others. Even if you don't have such a rider, there's no harm in asking your agent whether the risk is covered by your regular policy. You may be pleasantly surprised.

You might even consider this: How many dollars would it take for you to change your mark?

Let us add our personal perspective: Changing your mark need not be a disaster. In fact, depending on who you are and how you do it, it may hardly cause a ripple.

For example, a very popular Berkeley restaurant had to change from Fat Albert's to Fat Apple's as a result of an ownership dispute. It never

lost a beat in the local restaurant scene and still has 45-minute waits out the door for weekend breakfasts.

Even Nolo, the publisher of this book, has had to change its marks from time to time. Its computerized will-writing program, now called *WillMaker*, was originally called WillWriter. After Nolo had launched the product and established it in the market, it received a series of threatening letters from a New York law firm stating that Will Writer was a federally registered trademark belonging to a small company in New York City that registered wills and printed will forms.

Admittedly, Nolo should have done a more thorough check of the mark before using it, but even if it had, it might have gone ahead and used the mark, because the other company's use was different. It did not make wills or sell computer programs. In addition, the other company's trademark was weak, because it described what the product did—provide a form on which to write a will.

Nolo's first response was to write back to each of these letters, which arrived about six months apart, to say basically, "Don't bother us; you don't have a case." However, the letters kept coming, and the idea of having to defend a suit on the other coast—even one that it might win—loomed as a waste of time and money. So against the almost universal advice of friends and business associates ("You'll lose thousands of sales, confuse your customers, and make yourself a commercial laughingstock"), Nolo cast about for a new name, and came up with *WillMaker*, a mark that was similar to the old one but with a crisper edge to it.

Nolo notified everyone they could of the change, and placed ads that prominently featured the house mark Nolo to provide continuity. A few trade journals noted the change, but the upshot was that nobody cared one way or the other.

*WillMaker* flourished, despite the change, perhaps because of Nolo's reputation, perhaps because it was a distinctive product in a narrow field, and perhaps because Nolo's main competitors didn't yet have a comparable product on the market. Still another possibility is that there was nothing all that distinctive about the name WillWriter in the first place.

Whether a name change would be similarly trouble free for another company depends on the business, the product or service, and the nature of competition in that field. It may be harder for a fledgling business than for an established one to weather a change in a trademark. A main concern would be how expensive and feasible it would be to notify all the customers, distributors, or suppliers who would need to know about the change. And for manufacturers of products, the expense of restamping the products or obtaining new containers may be prohibitive.

Certainly, the Internet complicates this issue. If you are using the mark in dispute as your Internet domain name, the cost and hassle associated with changing a domain name (such as getting other websites and search engines to change their links to your site) may be so great that changing it may not be a viable option for you.

If you are a small business in a specific market, you can probably contact your client list either through mailings, in-store flyers, or targeted advertising. You will be surprised how much conversation the name change will generate.

If you are a larger business, perhaps you can make the name change into a news story that industry magazines or newsletters would mention, either as a story or in a column. You might make the name change the basis of a new and different ad campaign. While it does appear a little careless to have adopted someone else's mark, most customers can relate to the misfortune of inadvertently stepping on the toes of some unknown business in a distant city. So it need not ruin your reputation at all. In fact, it may be a shot in the arm. In the metaphor of the self-help therapy industry, you got lemons, so get busy selling lemonade.

## **How to Handle an Infringer**

Regardless of how your dispute is finally resolved, you will want to take some or all of the following steps when dealing with infringement of your mark. Obviously, since no two infringement situations are exactly the same, you'll need to adopt and change these steps to fit your needs.

## **Step 1: Discover the Registration and Use Status of Your Opponent's Mark**

Your first step is to discover:

- whether the mark is federally registered and/or registered in your state
- when the other mark was first used anywhere, and
- when the mark was first used in a manner that came into conflict with your mark.

You can find out the registration information by doing a trademark search in the manner described in Chapter 5. If the mark is federally registered, your trademark search can also tell you the date the owner claimed it was first used anywhere. To find out when the mark was first used in a manner that conflicts with your mark, you will need to do a little investigation.

## **Step 2: Read Chapter 10, “Sorting Out Trademark Disputes, to Discover Who Is the Infringer”**

That chapter explains who has priority when two marks conflict in the marketplace. It will teach you which mark owner—you or your opponent—has the stronger legal case. This information is vital in the negotiation process, because your negotiating position is likely to be far different if you are clearly the top dog from a legal point of view than if you are just as clearly the infringer.

## **Step 3: Research as Much as You Can About the Business With Which You Will Be Negotiating**

You need to know its size, financial health, ownership, market share, products or services, and, most importantly, its litigation history. Obviously, this information will help greatly when you have to decide on a negotiating strategy. For example, if the company is on shaky financial ground, you can play harder ball than if they have a robust balance sheet. And if the other business has gone to court before on this or another mark, you should be very cautious in your dealings with it,

unless you too are willing to invest a great deal in your favorite law firm. Also, you need to know what kind of product the company makes and how and where it is marketed to properly evaluate its use of the mark in question. If its use is an obvious case of infringement (identical mark, closely related markets) and you have legal priority, you have a much stronger negotiation position than if it is a borderline case.

These pieces of information are not as hard to find as you may think. The computer databases that are available for your use (see Chapters 4 and 5) contain a great deal of information on businesses, in the form of business descriptions and revenue.

For either large or small businesses, litigation history is available in state or federal court files, which are public records and increasingly available on the Internet. (See Chapter 14 for more on Internet resources.) They are usually indexed by the names of the parties. In this way, you can discover most cases that the business has initiated (assuming it filed in the county in which it operates), but not necessarily those in which it has been sued (which is also relevant to its financial health) because that could have happened anywhere.

You can do all this yourself or hire a lawyer, business investigator, or information broker to do it for you. Of course, you may not need all the pieces of information we've discussed, so just obtain the facts you think are relevant or you can afford.

## Step 4: Write a Letter

The next step is to write a letter to the infringer. This is what attorneys do, if you are more comfortable having an attorney write the letter, find one to do it. (See Chapter 14, "Help Beyond This Book.") Write to the owner or president or whatever person is the highest level of management for which you can obtain a name, address, and phone number.

The letter should be businesslike and firm but not accusatory, and it should state the key facts in a clear and concise way. "It has come to our attention that your business is using [\_\_\_\_\_] trademark or trade name in [\_\_\_\_\_] manner" is an acceptable way to start. State your claim that your mark has legal priority—including the nature of your business, how you use the mark, when and where you began using it, when you registered it

(if you registered it), and whatever else you think is relevant. Then state that you believe the use of the mark by the other business infringes on your rights, and firmly ask the business to cease and desist its use of the mark.

**CAUTION**

**Let sleeping dogs lie.** If the material in Chapter 10, “Sorting Out Trademark Disputes,” indicates that you and not your opponent clearly are in the wrong, the worst thing you can do is bring the conflict to the opponent’s attention. Here, the old adage of “Let sleeping dogs lie” is very appropriate.

Make sure you provide the other business with enough information, including, for example, a copy of your registration certificate, so they can independently verify the basic facts that you allege and respond appropriately. But there is no need to exhaustively recount your business history or give extraneous information. Whatever you put in this letter must be accurate because it can be used later in court as evidence of some sort of inconsistency or misdescription.

**CAUTION**

**Don’t set deadlines or make threats.** Don’t set deadlines or make threats of litigation in this first letter. If you do, you will feel compelled to take some action if the business doesn’t comply with your demand, in order to show that you are serious. And it is likely that your action will be premature. Better to give yourself room and expect to write a second or even a third letter before giving your opponent an ultimatum.

There is another potential downside to threatening litigation. The infringing party may interpret your threat as a statement that litigation is inevitable and file an action for declaratory judgment in its local federal court. If that court is in a different part of the country than you are, you will be at a significant disadvantage and will no longer have a choice about whether to litigate or use some other, less costly, method of resolving the dispute.

## Sample Letter

[Date]

[Infringer's Name]

[Infringer's Address]

Dear [Infringer's Name],

It has recently come to our attention that your business is using [describe the infringer's trademark] trademark or trade name on [service or product]. We believe that this use infringes on our ownership rights in [describe your trademark] trademark. We first became aware of your mark [state the circumstances—e.g., at the 2009 Weaving Trade Show in Albuquerque].

We have the exclusive right to use this trademark based on the following facts: [Now list the bases of your rights—federal or state registration numbers, date of first use, date of registration, on what products or services you use it, and in what geographical areas. Attach copies of your registration papers and samples of how you use the mark.]

We believe that your use of this mark is likely to confuse our customers [and suppliers] and will damage the good reputation that our [goods, services] have enjoyed until now. Therefore, we request that you cease any further use of this mark.

Please reply with an acknowledgment of the ownership right that we claim in this mark and a proposed timetable for halting its continued use.

Sincerely,

[Your name]

[Your title]

[Your address]

### **If There Is No Actual Conflict**

Sometimes the use of a mark that—on its face—overlaps with another mark does not result in a conflict in the marketplace. For instance, if you own the national right to a mark but are only using it in the Southwest, an infringing use in the Northeast won't affect you. However, if you later decide to move into that region, the dual use of the marks would be very confusing. Also, as we indicated in Chapter 8, "How to Use and Care for Your Trademark," it is important for you to police the use of your mark so it won't be weakened by overuse or considered abandoned.

If you discover an infringer whose use of the mark isn't in conflict with yours, consider writing a letter pointing out that you own the exclusive national right to the mark and intend to enforce your right when you start using your mark in that part of the country. You need not demand that their use cease immediately. If you never expand in that direction, no harm is done. But if you do want to start using your mark in that part of the country, you've at least preserved your right to force the other user to adopt a different mark at that time. The Internet makes these kinds of situations less likely because use on the Internet often immediately creates a national or international market.

## **Step 5: Negotiate**

This process can be as flexible as you wish it to be. The outcome is only limited by the creativity of the negotiators. But once you reach an agreement, it makes sense to be aware of all its ramifications. For instance, if you agree to let the defendant continue using the mark in exchange for a license fee, your pocketbook may be in better shape, but you may lose control of the mark (it will be considered abandoned) if it no longer serves its function of uniquely identifying the source of goods or products in the marketplace. On the other hand, if the mark is being used on entirely different goods and services and no customer confusion is likely, it may not hurt to assign the defendant all rights to the mark

for that other purpose in exchange for cash. The bottom line is, have a trademark attorney read over the agreement before you commit to it.

Here are five possible negotiation strategies:

1. You can bluff your opponent into thinking you are on the verge of filing a lawsuit. This strategy works best when your mark is federally registered and the other mark is not, and it appears that your opponent began to use its mark after your mark's registration date. The reason for this is that under these facts, your opponent is legally liable to you for treble (triple) damages, the profits they realized from the sale of the goods or services carrying the mark, and possibly your attorneys' fees. You might scare your opponent into stopping use of the mark entirely. Or you might just get your opponent to agree to modify its mark. Of course, you must be prepared to spend a fair amount of energy (and attorneys' fees if you use an attorney as part of your bluff) to convince the other side that you're not bluffing. And you ought to be prepared to go to court if the bluff fails.



#### CAUTION

**Don't put your bluff in writing.** If you send a written letter threatening litigation, you run the risk of finding that letter as an exhibit on a complaint for declaratory judgment filed by the other party in a federal court far from your place of business. If you decide to threaten litigation as part of your bluff, make sure you do it orally unless the infringing party is located in the same part of the country as you are and, as mentioned, you are prepared to litigate if the other party calls your bluff.

2. A good fallback position is to suggest an agreement on territory or manner of usage—such as, “You can have the name in Nebraska and Kansas, and I'll use it in Oklahoma and Texas,” or “You use it only as a trade name for your crockery-manufacturing business, and I'll use it only as a mark on my line of stuffed animals.”
3. Perhaps you and the other party can make a few modifications to the way your marks appear to distinguish each more clearly

from the other. For instance, you change your mark from the Homemade Cafe to Homemade Diner, and the other party changes from HomeMade Cafe to the Home Cooking Cafe.

4. You may offer to buy your opponent's rights in the trademark. It may seem unfair to have to pay the other party to change its name, but that might solve your problem in an economical way, considering that you are saving everyone the cost of litigating over the trademark.
5. You might even sell your rights to the mark to the other party for a handsome sum in exchange for adopting a new mark. The money could serve as a much-needed capital infusion, as well as the means to afford an advertising campaign around your new name.

## **Step 6: Consider Other Dispute Resolution Options**

Traditionally, trademark-related disputes have been settled by negotiation or ended up in court before a judge or jury. However, in recent years several alternative, informal, and private ways to handle these and other types of disputes have become popular. They are faster and cheaper than traditional court processes; they often produce superior solutions; and, because of their informality, they don't necessarily require representation by an attorney.

Unless a written contract provides that a particular approach to dispute resolution must be followed in case a dispute under the contract arises, these alternative approaches are usually voluntary, which means all parties have to agree to use them. However, some courts are beginning to require litigants to first attempt one of these alternative approaches before the case is allowed to proceed to a trial.

The two best-known alternative ways to resolve disputes are arbitration and mediation. Although arbitration and mediation are often mentioned in the same breath and are frequently confused with each other, they are actually quite distinct in the way they approach disputes. The most striking difference between them is that in arbitration you still present your case to a third party—called an arbitrator—for a decision,

while in mediation you enlist the aid of a third party to help you and the other parties reach your own solution, without any particular resolution being imposed on you. Think of it as structured negotiation. Let's take a closer look at how each approach works.

## **Arbitration**

In arbitration, the parties agree to select and pay one arbitrator—or a panel of three arbitrators—to hear the dispute. If three arbitrators are desired, the usual selection method is for each party to select its own arbitrator and then leave it to these arbitrators to pick the third.

As a general rule, arbitrators are selected from panels put together by such large national organizations as the American Arbitration Association ([www.adr.org](http://www.adr.org)) and JAMS-Endispute (Judicial Arbitration and Mediation Services; [www.jams-endispute.com](http://www.jams-endispute.com)). However, smaller, more specialized groups of arbitrators may also be available in your locality (see the yellow pages).

Although many of the arbitrators offered by the larger organizations are attorneys or retired judges, many are not. It is up to the parties to decide whether their particular dispute should be decided by someone with a legal background or someone who perhaps has a more appropriate expertise—such as a contractor in a construction dispute, or an insurance broker if the dispute involves the interpretation of an insurance contract. In the case of a trademark dispute, it is likely that you will, in fact, want at least one experienced trademark lawyer to arbitrate the dispute.

The rules used to choose the arbitrator(s) and conduct the arbitration are also usually provided by the organization to which the parties turn to provide the arbitrators. For instance, it is common to agree to have the arbitration conducted under the “rules of the American Arbitration Association.”

Unlike court, arbitration can proceed very rapidly and be finished in a matter of weeks, although several months is more common. Obviously, the length of time a particular arbitration will take depends on the complexity of the dispute and the eagerness of the parties to push the

matter. Even if one party to an arbitration is in a hurry, it is usually possible for the other party to slow things down.

As a general rule, the arbitrator's fees are paid equally by the parties, by agreement. These fees can be considerable. If the arbitration only takes an hour or two of the arbitrator's time, this can be reasonable. However, if the arbitration takes days, then the expense will mount accordingly. The arbitrator's fees are in addition to what each side is paying its attorney, if they decide to use one.

Probably the biggest issue in any arbitration is whether the decision of the arbitrator(s) is to be final or if the loser will be permitted to go to court for a regular trial.

This issue is typically addressed by the parties when they decide to arbitrate, unless the matter has already been addressed in a contract. Because a decision to arbitrate usually is based on a wish to resolve the dispute quickly and cheaply, most parties opt to make the arbitrator's decision final, meaning that it can be entered in a court with competent jurisdiction as a final, unappealable judgment, which makes it enforceable.



#### CAUTION

**Beware of binding arbitration.** The finality of an arbitration can be troublesome if the arbitrator strays far from established legal principles in arriving at the decision. Under most court rules dealing with binding arbitration, an arbitrator's departure from the law cannot be challenged in an appeal. For that reason, businesses that believe they are legally in the right are often reluctant to turn their fate over to a decision maker who is, in essence, unconstrained by the law. Better the costs of litigation, these businesses believe, than creating the risk of a runaway and crippling arbitration result.

If you are asserting your trademark rights against the owner of a domain name, you may invoke nonbinding arbitration under rules established by an international body known as ICANN. See Chapter 10, "Sorting Out Trademark Disputes," for more on how this procedure works.

## Mediation

The central idea underlying mediation is simple. Most disputes can be settled in a manner that is at least minimally satisfactory to each of the disputing parties—the colloquial win-win scenario. Mediators use a number of techniques designed to identify potential points of agreement and help the parties understand and move towards these points on a voluntary basis.

If the mediation does not produce a settlement, the parties are free to pursue other avenues, including litigation.

The same organizations that provide arbitrators usually also furnish mediators. Also, a number of individual business attorneys and law firms are beginning to offer mediation services to people engaged in business disputes—including disputes over trademarks. The best way to locate these services is to use the yellow pages and look for announcements that emphasize business mediation.

Another good way to find potential mediators is to visit the websites maintained by the Association of Intellectual Property Law Attorneys (AIPLA; [www.aipla.org](http://www.aipla.org)) and the International Trademark Association (INTA; [www.inta.org](http://www.inta.org)).

A list of business mediators in your area may also be obtained from the Mediation Information and Resource Center ([www.mediate.com](http://www.mediate.com)).

Because mediation is about reaching agreement rather than trying to convince a decision maker—as is the case with arbitration—there is no need to involve an attorney. However, attorneys often can help you find an appropriate mediator. They also can be helpful as advisers during the course of the mediation, and, assuming an agreement is reached, can reduce a general oral agreement to a detailed written agreement that both you and the other party will feel comfortable signing.

## Step 7: Consult an Attorney

If none of the above gets you anywhere, by all means call a trademark lawyer. The lawyer might have a better letter-writing technique, or might tell you to forget about the conflict. The lawyer probably will be able to help you find a mediator or arbitrator, if you want to pursue one of

these options, or the lawyer might advise that your best shot is to go to court. If you've tried everything else first, the lawyer might be right. (See Chapter 14, "Help Beyond This Book.")



# If Someone Claims That You Infringed a Trademark

<b>What the Complaining Party Can Do to You</b> .....	348
<b>Steps You Should Take</b> .....	349
Step 1: Find Out What You Can About the Complaining Firm and Its Use and Registration of the Mark at Issue.....	349
Step 2: Get Advice.....	350
Step 3: Choose Your Tactical Responses.....	350
Step 4: Plan Your Negotiation Strategy .....	351
Step 5: Seek Mediation .....	351

**Y**ou have gotten an irate letter from Ms. Blowhard in North Nuluk demanding not only that you immediately cease using your new mark for clothing designs, Nines, but also that you account for all your profits derived from the use of that name and pay her treble (triple) damages for the insult, or she will see you in court. What to do?

Stay calm.

First, you need to know that no matter how threatening the letter, the world won't fall on your head today, tomorrow, or even next week. However, legal steps may eventually follow. So, first, we'll tell you what those are. Next, we will help you decide what your options are in response. Finally, before you actually adopt a strategy, you'll need to think about your version of the big name picture—how valuable is your name and, given the legal realities, how much energy and money are you willing to spend to protect it?

Much of this discussion is very similar to the information in Chapter 11, “If Someone Infringes Your Mark.” It's a good idea to read that whole chapter (it's short) to get an idea of the other guy's point of view.

Start by understanding the same key point we emphasize in Chapter 11, that trademark lawsuits are extremely expensive.

From the point of view of either the infringer or the infringe, negotiation is a more pragmatic, cost-effective, and often more fruitful way to resolve a trademark dispute. With that guiding principle, let us help you respond to someone's claim that you infringed on his or her mark.

## What the Complaining Party Can Do to You

Right away, you should know that your opponent can only stop your use of your mark with a court order (that is, a temporary injunction). To get this, two legal hurdles must be leapt:

1. Your opponent must convince a judge that he or she has suffered, or will suffer, irreparable immediate damage without an immediate court order barring your continued use of the mark.

2. Your opponent must convince a judge that he or she is likely to eventually win in court (that is, showing that his or her has superior rights to the mark and that you infringed on those rights).

In cases where the two names compete in the marketplace, the first hurdle will often be assumed, because trademark infringements siphon off goodwill in a way that cannot easily be measured and repaired in a later action for damages (which is why the injury is called irreparable).

The second hurdle is much more difficult to overcome, because the judge, without the benefit of a full trial, is being asked to make an important finding about the primary issue in the case: Has infringement really occurred? To develop and prove the facts that the judge will need to arrive at this conclusion normally involves quite a bit of (always expensive) legal time. So unless your opponent is both solvent and determined, he or she will not likely leap into court without first: (1) finding out as much about you and your use of the mark as possible, and (2) testing your reaction to his or her infringement claims. The upshot is, you probably have a little time to figure out what to do.

## Steps You Should Take

We don't mean to imply that you should ignore the letter. On the contrary, you should get busy with the following steps, lest you end up with a process server at your door.

### **Step 1: Find Out What You Can About the Complaining Firm and Its Use and Registration of the Mark at Issue**

Here we echo the discussion in Chapter 11 on the same issue from the opposite perspective. Please read that material. In essence, the more you know about the other party, the better you can evaluate how to respond to his or her allegations. In addition, it's essential to the development of your case that you know exactly how your opponent uses its mark, and where and how long the party has used it.

Once you get all that information, you should reread Chapter 10, “Sorting Out Trademark Disputes,” to help you make up your mind if your opponent has a case against you.

## Step 2: Get Advice

After you have gathered as much information as possible, consult a trademark attorney to confirm or correct your understanding of the situation as well as to get the point of view of a disinterested experienced party. Although you may understandably want to avoid attorneys and their attendant costs, paying several hundred dollars for a reasoned legal opinion about your situation is cheap given the probable cost of ending up on the losing side of a lawsuit or even retooling your stationery and marketing materials if your decision is to switch rather than fight. You may also want to get the advice of friends or business associates whom you trust. They may have had comparable experiences, or they may simply have reliable common sense and good tactical reactions.

Once you fully inform yourself of the legal and practical implications of the trademark dispute, trust your gut. It’s almost always a mistake to follow a course of action you don’t feel comfortable about. Fortunately, because the complaining business is likely to write you several letters before taking legal action, you probably have enough time to consider your next step carefully.

## Step 3: Choose Your Tactical Responses

Here are some common responses, and at least some of the possible consequences of each.

- **The ostrich technique.** You can ignore the infringement claim and hope it goes away. In fact, if you are convinced that the other business doesn’t have a case and knows it, this may work. Otherwise, it’s probably a mistake, as it risks your being sued just to get your attention.
- **The German shepherd response.** You can send back a letter full of sound and fury, informing them that under no circumstances

will you ever stop using your mark, and the mere suggestion that you are infringing is a shocking insult. Remember, however, that this is a typical lawyerly tactic, and lawyers often profit most when they fan the flames of small disputes into true conflagrations.

- **The elephantine response.** You reply in a calm and polite letter, stating the facts as you see them and explaining why you disagree with the infringement claim. Your tone makes it clear that you are reasonable and flexible and perfectly willing to engage in further discussion and to hear more information on the subject. This sort of letter does not predispose you to any particular strategy, because you can always dig in your heels later, but in our view, it's most likely to put you farther along the road to fruitful discussion than does either of the other two responses.

## Step 4: Plan Your Negotiation Strategy

Now let's assume that negotiation by letter, fax, or phone has begun. What sort of strategies should you consider? These are identical to the ones discussed in Chapter 11, "If Someone Infringes Your Mark," and we suggest you read (or reread) that material. Also, once again let us make the point that changing your name need not be a disaster and may even be a marketing opportunity.

## Step 5: Seek Mediation

One approach that may help you reach agreement without being dragged into court is to seek arbitration or mediation. These alternative approaches to dispute resolution are described in more detail in Chapter 11.



### FREQUENTLY ASKED QUESTION

#### Overzealous Zazzler zeeks TM advice

*"I'm a Zazzle ([www.zazzle.com](http://www.zazzle.com)) entrepreneur. From my understanding, a registered trademark is a pretty specific thing (I could be wrong). So, for example, if you get a trademark for the words 'First Kiss', the trademark would specify the*

*font in which the words would be written, the colors if any other than black as well as whatever else you specify to make your trademark original and how it will be used. 'First Kiss' is now your registered trademark! Now for the questions: (1) You come across someone who uses the words 'First Kiss' in a graffiti styled design with all sort of frills and embellishments and plasters it on a t-shirt, mug etc. Now, although the words used are the same, they are written in completely different style (font), it looks nothing like the trademarked words and would never be confused as having anything to do with the company/individual that registered the trademark.... is that a trademark violation? (2) 'First' and 'Kiss' are pretty common words and are used frequently. You come across someone who has used those words in a sentence and plastered in on a t-shirt, mug, etc. 'Remembering our very first kiss'... is that a trademark violation?"*

You're starting with some incorrect information; we need to back up a few steps.

**Square One Dept.** A trademark registration for a name or text is usually not limited to a specific font; if that were the case, Nike, Gucci, and Coca-Cola would have problems stopping ripoffs. Even if someone registers the word mark in connection with a design, courts won't limit protection to the design. They will apply common sense to determine whether someone is trading off the mark unfairly and consumers are likely to be confused. So changing colors and fonts doesn't get you off the hook for infringement.

**As for your questions...** Someone who registered First Kiss for t-shirts and cups would have priority over subsequent users on similar merchandise and could stop them regardless of the font. You claim that customers "would never be confused." If you can prove that in court, you might be able to get off the hook for infringement, but we believe that the chances of proving an identical word mark on identical goods does not infringe is a little bit like Dr. Richard Kimble finding the one-armed killer.

**Trademark fair use.** Your second question is a little more complex and relies on interpreting the rules for trademark fair use. As a general rule, descriptive use of terms is permissible. Again, common sense prevails here since a competitor's repetitive use of a descriptive term may be an illegal attempt to siphon customers.



## International Trademark Protection

<b>Where Will You Seek Protection?</b> .....	355
<b>How Will You Register Abroad?</b> .....	358
The Madrid Protocol.....	358
The Community Trademark .....	359
Registering on a Country-by-Country Basis .....	359

It's possible as your mark becomes well-known that you'll want to protect it in another country. If so, you should take some steps to do that or at least look into the process.

Trademark laws are different abroad. Many countries follow the U.S. principle and require actual use in commerce before registration. These “use” countries include the United Kingdom, Canada, Australia, New Zealand, and other current and former British Commonwealth members.

But in the majority of nations, registration alone forms a basis for ownership rights. In these countries, anyone can get a registration on your mark without having used it there first. This presents a serious problem for marks that appear to be headed for international use after becoming well-known in this country. Some businesses have made money by spotting these types of marks, preemptively registering them in key countries, and then demanding large fees to transfer (assign) the names back to their original U.S. owners. Also, in some countries you may not be able to import your goods without first registering your mark there.

In this chapter, we discuss the two basic issues to resolve if you're considering seeking foreign trademark rights: (1) Where will you seek protection and (2) what method will you use to register your trademark abroad?



#### CAUTION

**Our basic advice about international trademarks is that when in doubt about how to proceed, get an experienced trademark attorney who has done international registrations to help.** It is possible, as explained below, for a layperson to accomplish international registrations under the Madrid Protocol, but you may have difficulty assessing your likelihood of success in foreign countries unless you consult with a trademark expert.

## Where Will You Seek Protection?

Where you seek protection depends, obviously, on where you plan to market your services or products. All countries require that you use the mark within a period of time after registration or it will lapse, so only register in those countries where it is reasonable to foresee sales in the next several years.

Unfortunately, you may not yet know into which countries you will be expanding. If so, consider registering your trademark in Canada and Mexico, which are natural choices, following the signing of the North American Free Trade Agreement (NAFTA) in 1993.



### TIP

**Canada and Mexico don't belong to the Madrid Protocol, a group of nations that uses a simplified system for international registrations, described below.** To register in Canada and Mexico, you'll need to file applications in each nation.

Additional candidates for international registration will depend on the nature of your product and how it might fit into the international market. Because you can't foresee all contingencies, your basic business philosophy will dictate this decision: Either cover as many possibilities as you can by registering in many countries (the expensive choice), or restrict your international registrations to your one or two best choices and hope your decision pays off.

Once you're certain about foreign registration, you must arrange for or conduct an international trademark search. In those countries in which registration alone forms a basis for ownership rights, such searches are much simpler to do than in "use" countries, because all potential conflicts will be found on the national register of trademarks, without the need to search for unregistered trademarks.

### **Free and Fee-Based Resources for International Trademark Searching**

You may search the trademark registries of many foreign countries for free. Visit the All About Trademarks website ([www.ggmark.com](http://www.ggmark.com)) and click “Trademark Links.” You may also use the fee-based services identified in Chapter 4 and have a search company perform these national searches.

### **What Does It Mean in Italian?**

Check to see if your mark has an unintended meaning in the country in which you plan to register. For example, Pschitt was a French mark that could not be marketed as a soft drink in the United States. This suggestion also applies to English-speaking countries—in Australia, a “Whopper” (a U.S. trademark for a hamburger) is slang for male genitalia and, so, not advisable as a trademark there. To get an opinion on your mark, consult a native speaker of the country you are considering.

### **Making Money (But Losing Your Name)**

In 1971, a young, recently divorced mother and her friend started a unique low-profile company that:

- sold pure and simple cosmetics, lotions, and perfumes
- offered its products in small-size, recyclable bottles with no extraneous ingredients, and
- didn’t test its products on animals.

The business was named The Body Shop (because its first place of business was in a former auto repair shop). The owners had the foresight to register the name with the PTO not long after business started to blossom. It was a timely enterprise and a great success, eventually opening several outlets within its region. It was the kind of business that made people who

### **Making Money (But Losing Your Name) (continued)**

moved out of the area beg friends traveling back there to bring them some Body Shop products. Soon, it also had a booming catalog business.

Years passed. Meanwhile, in London, another entrepreneur had the same idea for similar products and the same name. The second Body Shop also took off, even faster and on a wider basis than the original had in the United States. Eventually, the Body Shop (U.K.) had over 500 flourishing franchises throughout Europe. It was confusing to travelers, but because the U.S. company had obtained only the exclusive rights to the name in the United States, they could not stop the British Body Shop's use.

Then came the day when the British store owners sought to enter the U.S. market. The U.S. corporation had the legal right to the name and therefore potent weapons at its disposal. But the British firm had many times the capital of its U.S. counterpart. Like reasonable businesspeople, the U.S.-based Body Shop heeded the bottom line, settling the dispute amicably. It sold the U.S. rights to its name to the British company, agreeing to change its name within 18 months, in exchange for an undisclosed (but sizable) sum of money. Everybody's happy, more or less.

The point of this story depends on your perspective. Some might say: Trademark your name everywhere you can at once! Others could reflect that the protagonists in our story, by federally registering their trademark, showed foresight that was unusual at the time for a small "New Age" concern. That act gave them the leverage they needed to extract a price from the English company for use of the trademark in the United States.

In the end, the U.S. company suffered the inconvenience of changing its name, but that's something that many companies do willingly when their circumstances change. Furthermore, they weren't, as a practical matter, deprived of expansion opportunities. They hadn't expanded much before the conflict arose, and even now they are still a relatively small—but profitable—concern with a few regional outlets and a catalog. And that's fine with the owners. They bargained for enough time to reach all their regular customers and notify them of the new name Body Time, and they received a handy infusion of capital from the sale of their trademark.

## How Will You Register Abroad?

There are three ways for the owner of a U.S. trademark registration to acquire a foreign registration—under the Madrid Protocol (among 79 member nations), as a Community Trademark (among 27 European nations), or via separately filed registrations in each nation.

### The Madrid Protocol

The Madrid Protocol is a system that allows an applicant to file simultaneous registration applications in any of the 79 nations that belong to the Madrid Protocol treaty. You can find a listing of all member nations at the World Intellectual Property Organization (WIPO) website ([www.wipo.int/madrid/en/members](http://www.wipo.int/madrid/en/members)).

The Madrid Protocol, adopted in the United States in November 2003, is administered by the WIPO and is considered a more efficient and less expensive route for simultaneous registration of several foreign marks.

For U.S. applicants, the first step under the Madrid Protocol is to federally register your mark with the PTO. (This procedure is explained in Chapter 7.) This application/registration is then referred to as either the basic application or basic registration. The nations in which you choose to register after the United States are referred to as nations for which “extension of protection” is sought.

Each of these nations will decide, using its national criteria, whether to register the mark. If registration is refused in one of these countries, it will not affect the main Madrid Protocol application. For example, if you apply to register in Denmark and Estonia but are rejected in Estonia, it will not affect the status of your application in Denmark. Only if the basic registration (the U.S. registration) is abandoned or declared invalid within the first five years of the international registration will the other registrations be terminated.

To file, click “File Forms Online” under “Trademarks” at the UPSTO home page. Then on the TEAS home page, click “Madrid Protocol

Forms.” Choose “Application for International Registration.” If you later want to add more nations, you can come back and choose “Subsequent Designation.”

## The Community Trademark

The Community Trademark is a method of registering for a trademark that is good in the 27 European countries that belong to the European Union (Austria, Belgium, Bulgaria, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovenia, Slovak Republic, Spain, Sweden, and the United Kingdom). To qualify for Community Trademark status, the proposed mark must be acceptable in all countries. If your application is rejected by even one country, you must file separate national applications for trademark registration in each country.

Unlike a trademark issued under the Madrid Protocol, the CTM is good throughout the European Union nations and can be enforced throughout the EU. So, instead of having to file separate lawsuits in each member nation, you can file one lawsuit for infringement in many nations.

Generally, trademark lawyers advise that a CTM is worthwhile if registration would otherwise be sought in more than three of the EU nations. An application for a Community Trademark may be made to the Office for Harmonization of the Internal Market, in Alicante, Spain. For more information about how the community mark works and how to apply for one, visit <http://oami.europa.eu>.

## Registering on a Country-by-Country Basis

The good news if you are filing separate trademark applications in foreign countries is that most nations where you will file belong to the International Convention for the Protection of Industrial Property (known as the Paris Convention).

This law has standardized a few things. One of the most important is that trademark owners from one Paris Convention country who register their trademarks in another Paris Convention country are entitled to the same rights as are native trademark owners of that country. Although each country's laws are different, the convention at least puts all trademark owners in any one Paris Convention country on the same legal footing.

Another important benefit is that once a U.S. citizen applies to register a federal trademark in the United States, the date of that application serves as the effective date of application in all other Paris Convention countries in which that citizen applies, if done so within six months of the U.S. application. This is important because in most of those countries rights are based on registration, and the effective date of application (or priority date) is an important method of determining rights. Thus, it is imperative to file an international registration soon after filing one in the United States, if you plan to do so at all.

If you plan on handling the filing in a foreign country, you'll need to research the trademark laws of that nation. You can do this online—start at either the WIPO website ([www.wipo.org](http://www.wipo.org)) or the All About Trademarks site ([www.ggmark.com](http://www.ggmark.com)). These foreign laws are usually summarized at each nation's trademark office website and will inform you how soon you must begin to use your mark after registration and whether there are special licensing and tax rules that may apply to your service or product and its mark. Again, this is why you should consult an experienced international trademark attorney—to make sure you find out about and comply with all applicable laws.



## Help Beyond This Book

<b>Nolo: Your One-Stop Trademark Resource</b> .....	362
<b>Finding Trademark Laws and Information on the Internet</b> .....	363
<b>Doing Your Own Research in a Law Library</b> .....	364
Read One or More Discussions by Experts.....	365
Read the Law Itself.....	366
<b>Finding a Lawyer</b> .....	366
Find a Lawyer Who Knows the Trademark Field Well.....	367
Find a Lawyer Who Is Willing to Acknowledge Your Competence.....	368
Find a Lawyer Who Is Honest and Conscientious.....	368
Find a Lawyer Who Is Open to Dispute Resolution Alternatives.....	370
Internet Resources.....	370

We hope that this book provides all the information you will need to choose and protect your trademark, service mark, or trade name. But you may need additional help, either in the form of more advanced legal resources or a trademark attorney's assistance.

### Don't Be Afraid of Legal Research

Looking up the law for yourself needn't be scary. By reading this book you will have already learned the basic trademark vocabulary necessary to understand the more technical legal materials we discuss. In addition, Nolo publishes a basic legal research guide, *Legal Research: How to Find & Understand the Law*, by Stephen Elias and Susan Levinkind, which teaches you how to efficiently do basic legal research. You will also find most law librarians to be of great help.

## Nolo: Your One-Stop Trademark Resource

Nolo ([www.nolo.com](http://www.nolo.com)), the publisher of this book, offers a range of trademark resources including the following:

- **Legal Information.** Nolo's website provides detailed legal information about acquiring and protecting trademarks. Click on "Patent, Copyright & Trademark" on the home page menu and then choose "[Trademark Law](#)." Nolo also provides helpful information on [conducting legal research](#) with links to sites where case law and statutes can be located. And don't forget [Nolo's Patent, Copyright and Trademark Blog](#) (also known as the "Dear Rich" Blog) that provides answers to questions about trademarks and other intellectual property subjects.
- **Trademark Registration.** If you want Nolo to assist you in filing your application for federal registration, click on Nolo's [Online Trademark Application](#). By answering a series of online

questions, Nolo can help you promptly prepare and file your application. If you need more help, Nolo offers a [free guide to the trademark application process along with handy FAQs](#).

- **Trademark attorneys.** Nolo operates a national lawyer directory that provides in-depth profiles of attorneys, as well as verification that each lawyer is in good standing and that each lawyer promises respectful services. The directory includes many trademark attorneys. Note, it is often not necessary that the trademark attorney you choose is in your local area since many trademark actions—for example, appealing from a trademark objection—can be done from anywhere in the U.S.

## Finding Trademark Laws and Information on the Internet

The Internet offers convenient access to an enormous amount of trademark materials, including:

- the federal trademark database
- the federal trademark statutes and regulations
- informative articles by trademark experts
- the PTO's *Trademark Manual of Examining Procedure*
- the *Design Search Code Manual*
- the *Acceptable Identification of Goods and Services Manual*
- guides to various aspect of trademark practice
- recent changes in PTO rules and procedures, and
- much, much more.

Here is a brief list of sites that will either have the information you are looking for or will provide you with links to other sites that do.

**[www.nolo.com](http://www.nolo.com)**. Nolo's website offers free [trademark law information](#), a [lawyer directory](#) featuring many trademark attorneys, and an [online trademark filing service](#).

**[www.uspto.gov](http://www.uspto.gov)**. The U.S. Patent and Trademark Office is the place to go for recent policy and statutory changes and transcripts of hearings on various trademark law issues. This site also lets you do your own

trademark search for free, search the *Trademark Manual of Examining Procedure* (the guide the PTO examiners use when processing trademark applications and handling other proceedings), complete your trademark registration application online, and check the status of any trademark. This site also links to other useful trademark-related sites.

**www.findlaw.com.** This search engine offers an excellent collection of trademark-related materials on the Web, including trademark statutes, regulations, classification manuals, and articles of general interest. Click the intellectual property link in the topics section on the Findlaw home page, and then click “trademark” in the subcategory section on the intellectual property page.

**www.ggmark.com.** This site, maintained by a trademark lawyer, provides basic national and international trademark information and a fine collection of links to other trademark resources.

**http://trademark.blog.us.** The Trademark Blog, written by Martin Schwimmer, has become the leading site on the Web for current news about trademark law.

**www.thettablog.blogspot.com.** The TTAB Blog by John Welch is the most comprehensive source on the activities of the Trademark Trial and Appeals Board.

## Doing Your Own Research in a Law Library

When seeking answers in a law library, you will find useful the three-step approach that we describe below:

1. Read one or more discussions by experts in the field to get a background and overview of the topic being researched. In this case, you will already have a basic background from this book and will be looking for additional details on a particular topic.
2. Read the law itself (cases and statutes) upon which the experts base their opinions. Reading primary materials such as these can be confusing without first digesting an expert’s analysis.
3. Make sure the law you read is completely up to date.

## Trademark Associations and Legal Publishers

Two associations of trademark lawyers offer other materials that you might find helpful. You can get a list of their publications by writing or calling them.

International Trademark Association (INTA)  
 1133 Avenue of the Americas  
 New York, NY 10036  
 212-768-9887  
[www.inta.org](http://www.inta.org)

Among other materials, the INTA publishes an annual paperback, *Trademark Law Handbook*, which analyzes current trademark issues, and *The Trademark Reporter*, a bimonthly law review that discusses recent trademark cases and issues. Only members can subscribe to it, but law libraries carry it for the public's use.

American Intellectual Property Law Association (AIPPLA)  
 Suite 203, 2001 Jefferson Davis Highway  
 Arlington, VA 22202  
 703-415-0780  
[www.aipla.org](http://www.aipla.org)

The AIPPLA is an association of lawyers that conducts scholarly studies and publishes articles by its members. Materials by AIPPLA are available only in libraries or through members of the association.

## Read One or More Discussions by Experts

The following are some recommended publications written by trademark law experts. You can find others via your law library's subject matter catalog.

**Federal Trademark Law.** The most authoritative book on trademark law is the multivolume set entitled *McCarthy on Trademarks and Unfair Competition*, by J. Thomas McCarthy, published by West. McCarthy,

a law professor at the University of San Francisco, is the most widely respected trademark law expert in the United States. His book is so comprehensive and well respected that judges often consult it and refer to it in their decisions. You can find this treatise, with its annual supplements, in many public and academic law libraries.

Although very comprehensive, McCarthy's material may not give you enough detail on how to apply trademark law to real-life situations, such as rules on using the ® symbol or filing and prosecuting a trademark action in the PTO. Probably the best resource for questions of this type is the *Trademark Manual of Examining Procedure* (TMEP), published by the USPTO and available at the USPTO website.

## Read the Law Itself

**Statutes.** The main law governing trademarks in the United States is the Lanham Act, also known as the Federal Trademark Act of 1946 (as amended in 1988). It is codified at Title 15, Chapters 1051 through 1127, of the *United States Code*. You can find it in either of two series of books, *United States Code Annotated* (U.S.C.A.) or *United States Code Service, Lawyers Edition* (U.S.C.S.). All law libraries carry at least one of these series. To find a specific section of the Lanham Act, consult either the index at the end of Title 15, or the index at the end of the entire code.

## Finding a Lawyer

If you become involved in a trademark dispute, are having trouble getting your mark registered, or simply want some advice from a professional about a trademark issue, you will want to consult a trademark lawyer—but not just any trademark lawyer. Start by understanding that if you have read substantial portions of this book, you already know more about trademarks than most lawyers. This puts you in the difficult position of finding someone who knows more than you do and yet is willing to acknowledge the considerable competence that you've now gained in this area. You want a trademark lawyer who:

- knows the trademark field well
- is willing to acknowledge your competence gained from using this book, and
- is honest and conscientious.

Fortunately, by arming yourself with the information in this book, you have a good shot at finding a lawyer with all of these characteristics.

Nolo ([www.nolo.com](http://www.nolo.com)), the publisher of this book, operates a national [lawyer directory](#) that provides in-depth profiles of attorneys, as well as verification that each lawyer is in good standing and that each lawyer promises respectful services. The directory includes many trademark attorneys. Note, it is often not necessary that the trademark attorney you choose is in your local area since many trademark actions—for example, appealing from a trademark objection—can be done from anywhere in the U.S.

## Find a Lawyer Who Knows the Trademark Field Well

Trademark lawyers usually advertise in the yellow pages and legal journals as intellectual property specialists able to handle patent, trademark, copyright, and trade-secret cases. Because each of these fields is increasingly becoming a complicated legal world all to itself, in fact the ads lie—most intellectual property law specialists tend to be very knowledgeable in one or two of these areas and only passingly familiar with the others.

For instance, it is common for patent lawyers to be far more knowledgeable in that area than in trademark law, even though both patents and trademarks involve practice before the PTO. Similarly, some lawyers specialize in trademarks and do little or no patent work.

The point of knowing this, of course, is that you want a trademark lawyer who really knows trademarks, not someone willing to brush up on trademarks at your expense.

When you call on the intellectual property specialist, ask these questions:

- What percentage of your practice involves trademark work?
- Are you a member of the International Trademark Association or the American Intellectual Property Law Association?

The first inquiry will help you find a true specialist in this area, while the second will help you find a lawyer who is curious enough about the subject of trademarks to join these associations of trademark specialists.

## **Find a Lawyer Who Is Willing to Acknowledge Your Competence**

In addition to satisfying yourself that a lawyer is competent, you want to find someone who is reasonably congenial to work with. You don't need us to tell you that lawyers tend to look down on laypersons when it comes to the lawyer's area of expertise. Which means that many of the lawyers you initially encounter are likely to be turned off by your expertise. Fortunately, however, some lawyers are willing to respect their clients' knowledge and know how to work with it rather than against it. It is this type of lawyer you should be looking for.

You can find a lawyer who isn't intimidated by a competent client if you:

- explain over the phone that you have been using this book
- articulate exactly what you want the lawyer to do, and
- carefully monitor the lawyer's reaction.

If the lawyer scoffs at the idea of a self-help law book or you get a whiff of, "Don't tell me what you need, I'm the lawyer," go on to the next name on the list. If the response appears to respect your self-help efforts and admits the possibility that you are a competent human being, make an appointment.

## **Find a Lawyer Who Is Honest and Conscientious**

If you are just seeking advice, then you needn't worry much about the lawyer's character. But if you are looking for someone to represent you, the human being you are dealing with becomes paramount. The best

analytical trademark lawyer in the world can bring you to financial and emotional ruin if he or she lacks the ability to understand your needs and to represent you with your best interests in mind.

## **Honesty**

While some would argue that there's no such thing as an honest lawyer, we maintain that it is possible to have honest dealings with your lawyer. Start by clearly understanding that the lawyer's financial interest—to run up lots of billable hours over a period of time—is the opposite of yours—which is to arrive at a fast, cost-efficient, and reasonably livable resolution of the problem.

Once you understand this, you'll also understand that it is essential that you and your lawyer agree up front about what the lawyer is to do and the amount of control you are to have over the lawyer's activities. Rule One is that the lawyer is working for you, not vice versa; and Rule Two is that you have a right to understand the reason for every minute of the lawyer's time that will be billed to you.

## **Conscientiousness**

Your lawyer must be willing to agree to have you regularly consulted on all phases of the case and to promptly return your phone calls. Although nothing leads to a ruinous relationship faster than bad communication, too few lawyers keep their clients well posted. Lawyers faced with complaints about their lousy client-contact habits often reply that many clients call or expect too much. But because the client is paying for the lawyer's time, this seems like a pretty weak excuse. Our experience tells us that the usual reason lawyers don't return phone calls is that they have neglected some facet of the case and simply don't want to face the client.

Your lawyer must also be willing to follow through on your case to its completion. This one is tricky to monitor, because it involves predicting the future. However, as long as good communication is established at the outset, there's an improved chance that your lawyer will give you good service.

## Find a Lawyer Who Is Open to Dispute Resolution Alternatives

In recent years, many lawyers have discovered that there often are better ways to resolve disputes than the old “haul ’em into court” technique. The two most common of these alternative approaches are arbitration and mediation. When you search for an attorney, make sure that the attorney is fully up to speed on these private, fast, inexpensive, and often successful techniques and is willing to help you explore them as a potential way to solve your problem. Arbitration and mediation are discussed in Chapter 11, “If Someone Infringes Your Mark.”

### Internet Resources

A number of websites offer listings for domestic and international trademark lawyers, including:

- the International Trademark Association ([www.inta.org](http://www.inta.org))
  - the American Intellectual Property Law Association ([www.aipla.org](http://www.aipla.org)), and
  - [Nolo’s lawyer directory](http://www.nolo.com) ([www.nolo.com](http://www.nolo.com)) that may be able to assist you in locating a trademark attorney in your area.
- 



# International Classifications of Goods and Services

The following classifications are from the *International Classification of Goods and Services under the Nice Agreement* (Ninth Edition). A more detailed version of the *Classification* can be found at the WIPO website at [www.wipo.int/classifications/nivilo](http://www.wipo.int/classifications/nivilo).

## GOODS

### CLASS 1 (Chemicals)

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

**Explanatory Note:** This class includes mainly chemical products used in industry, science and agriculture, including those which go to the making of products belonging to other classes.

Includes, in particular:

- compost;
- salt for preserving other than for foodstuffs.

Does not include, in particular:

- raw natural resins (CL 02);
- chemical products for use in medical science (CL 05);
- fungicides, herbicides and preparations for destroying vermin (CL 05);
- adhesives for stationery or household purposes (CL 16);
- salt for preserving foodstuffs (CL 30);
- straw mulch (CL 31).

## CLASS 2 (Paints)

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

**Explanatory Note:** This class includes mainly paints, colorants and preparations used for the protection against corrosion.

Includes, in particular:

- paints, varnishes and lacquers for industry, handicrafts and arts;
- dyestuffs for clothing;
- colorants for foodstuffs and beverages.

Does not include, in particular:

- unprocessed artificial resins (CL 01);
- laundry bluing (CL 03);
- cosmetic dyes (CL 03);
- mordants for seed (CL 05);
- paint boxes (articles for use in school) (CL 16);
- insulating paints and varnishes (CL 17).

## CLASS 3 (Cosmetics and cleaning preparations)

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Explanatory Note:** This class includes mainly cleaning preparations and toilet preparations.

Includes, in particular:

- deodorants for personal use;
- sanitary preparations being toiletries.

Does not include, in particular:

- chemical chimney cleaners (CL 01);
- degreasing preparations for use in manufacturing processes (CL 01);
- deodorants other than for personal use (CL 05);
- sharpening stones and grindstones (hand tools) (CL 08).

### CLASS 4 (Lubricants and fuels)

Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks.

**Explanatory Note:** This class includes mainly industrial oils and greases, fuels and illuminants.

Does not include, in particular:

- certain special industrial oils and greases (consult the Alphabetical List of Goods).

### CLASS 5 (Pharmaceuticals)

Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

**Explanatory Note:** This class includes mainly pharmaceuticals and other preparations for medical purposes.

Includes, in particular:

- sanitary preparations for medical purposes and for personal hygiene;
- deodorants other than for personal use;
- cigarettes without tobacco, for medical purposes.

Does not include, in particular:

- sanitary preparations being toiletries (CL 03);
- deodorants for personal use (CL 03);
- supportive bandages (CL 10).

### CLASS 6 (Metal goods)

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; iron mongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

**Explanatory Note:** This class includes mainly unwrought and partly wrought common metals as well as simple products made of them.

Does not include, in particular:

- bauxite (CL 01);
- mercury, antimony, alkaline and alkaline-earth metals (CL 01);
- metals in foil and powder form for painters, decorators, printers and artists (CL 02).

### **CLASS 7 (Machinery)**

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

**Explanatory Note:** This class includes mainly machines, machine tools, motors and engines.

Includes, in particular:

- parts of motors and engines (of all kinds);
- electric cleaning machines and apparatus.

Does not include, in particular:

- certain special machines and machine tools (consult the Alphabetical List of Goods);
- hand tools and implements, hand operated (CL 08);
- motors and engines for land vehicles (CL 12).

### **CLASS 8 (Hand tools)**

Hand tools and implements (hand operated); cutlery; side arms; razors.

**Explanatory Note:** This class includes mainly hand-operated implements used as tools in the respective professions.

Includes, in particular:

- cutlery of precious metals;
- electric razors and clippers (hand instruments).

Does not include, in particular:

- certain special instruments (consult the Alphabetical List of Goods);

- machine tools and implements driven by a motor (CL 07);
- surgical cutlery (CL 10);
- paperknives (CL 16);
- fencing weapons (CL 28).

### **CLASS 9 (Electrical and scientific apparatus)**

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

#### **Explanatory Note**

Includes, in particular:

- apparatus and instruments for scientific research in laboratories;
- apparatus and instruments for controlling ships, such as apparatus and instruments, for measuring and for transmitting orders;
- the following electrical apparatus and instruments:
  - a. certain electrothermic tools and apparatus, such as electric soldering irons, electric flat irons which, if they were not electric, would belong to Class 8;
  - b. apparatus and devices which, if not electrical, would be listed in various classes, i.e., electrically heated clothing, cigar-lighters for automobiles;
- protractors; punched card office machines; amusement apparatus adapted for use with television receivers only.

Does not include, in particular:

- the following electrical apparatus and instruments:
  - a. electromechanical apparatus for the kitchen (grinders and mixers for foodstuffs, fruit-presses, electrical coffee mills, etc.), and certain other apparatus and instruments driven by an electrical motor, all coming under Class 7;

- b. electric razors and clippers (hand instruments) (CL 08);  
electric toothbrushes and combs (CL 21);
- c. electrical apparatus for space heating or for the heating of liquids, for cooking, ventilating, etc. (CL 11);
- clocks and watches and other chronometric instruments (CL 14);
- control clocks (CL 14).

### **CLASS 10 (Medical apparatus)**

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

**Explanatory Note:** This class includes mainly medical apparatus, instruments and articles.

Includes, in particular:

- special furniture for medical use;
- hygienic rubber articles (consult the Alphabetical List of Goods);
- supportive bandages.

### **CLASS 11 (Environmental control apparatus)**

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

#### **Explanatory Note**

Includes, in particular:

- air conditioning apparatus;
- bedwarmers, hot water bottles, warming pans, electric or non-electric;
- electrically heated cushions (pads) and blankets, not for medical purposes;
- electric kettles;
- electric cooking utensils.

Does not include, in particular:

- steam producing apparatus (parts of machines) (CL 07);
- electrically heated clothing (CL 09).

**CLASS 12 (Vehicles)**

Vehicles; apparatus for locomotion by land, air or water.

**Explanatory Note**

Includes, in particular:

- motors and engines for land vehicles;
- couplings and transmission components for land vehicles;
- air cushion vehicles.

Does not include, in particular:

- certain parts of vehicles (consult the Alphabetical List of Goods);
- railway material of metal (CL 06);
- motors, engines, couplings and transmission components other than for land vehicles (CL 07);
- parts of motors and engines (of all kinds) (CL 07).

**CLASS 13 (Firearms)**

Firearms; ammunition and projectiles; explosives; fireworks.

**Explanatory Note:** This class includes mainly firearms and pyrotechnical products.

Does not include, in particular:

- matches (CL 34).

**CLASS 14 (Jewelry)**

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.

**Explanatory Note:** This class includes mainly precious metals, goods in precious metals and, in general, jewelry, clocks and watches.

Includes, in particular:

- jewelry (i.e. imitation jewelry and jewelry of precious metal and stones);
- cuff links, tie pins.

Does not include, in particular:

- certain goods in precious metals (classified according to their function or purpose), for example:
- metals in foil and powder form for painters, decorators, printers and artists (CL 02);
- amalgam of gold for dentists (CL 05);
- cutlery (CL 08);
- electric contacts (CL 09);
- pen nibs of gold (CL 16);
- objects of art not in precious metals (classified according to the material of which they consist).

### **CLASS 15 (Musical instruments)**

Musical instruments.

#### **Explanatory Note**

Includes, in particular:

- mechanical pianos and their accessories;
- musical boxes;
- electrical and electronic musical instruments.

Does not include, in particular:

- apparatus for the recording, transmission, amplification and reproduction of sound (CL 09).

### **CLASS 16 (Paper goods and printed matter)**

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

**Explanatory Note:** This class includes mainly paper, goods made from that material and office requisites.

Includes, in particular:

- paper knives;
- duplicators;
- plastic sheets, sacks and bags for wrapping and packaging.

Does not include, in particular:

- certain goods made of paper and cardboard (consult the Alphabetical List of Goods);
- colors (CL 02);
- hand tools for artists (for example: spatulas, sculptors' chisels) (CL 08).

### **CLASS 17 (Rubber goods)**

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

**Explanatory Note:** This class includes mainly electrical, thermal and acoustic insulating materials and plastics, being for use in manufacture in the form of sheets, blocks and rods.

Includes, in particular:

- rubber material for recapping tires;
- padding and stuffing materials of rubber or plastics;
- floating anti-pollution barriers.

### **CLASS 18 (Leather goods)**

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

**Explanatory Note:** This class includes mainly leather, leather imitations, travel goods not included in other classes and saddlery.

Does not include, in particular:

- clothing, footwear, headgear (consult the Alphabetical List of Goods).

### **CLASS 19 (Nonmetallic building materials)**

Building materials (nonmetallic); nonmetallic rigid pipes for building; asphalt, pitch and bitumen; nonmetallic transportable buildings; monuments, not of metal.

**Explanatory Note:** This class includes mainly nonmetallic building materials.

Includes, in particular:

- semi-worked woods (for example: beams, planks, panels);
- veneers;
- building glass (for example: floor slabs, glass tiles);
- glass granules for marking out roads;
- letter boxes of masonry.

Does not include, in particular:

- cement preservatives and cement-waterproofing preparations (CL 01);
- fireproofing preparations (CL 01).

### **CLASS 20 (Furniture and articles not otherwise classified)**

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

**Explanatory Note:** This class includes mainly furniture and its parts and plastic goods, not included in other classes.

Includes, in particular:

- metal furniture and furniture for camping;
- bedding (for example: mattresses, spring mattresses, pillows);
- looking glasses and furnishing or toilet mirrors;
- registration number plates not of metal;
- letter boxes not of metal or masonry.

Does not include, in particular:

- certain special types of mirrors, classified according to their function or purpose (consult the Alphabetical List of Goods);

- special furniture for laboratories (CL 09);
- special furniture for medical use (CL 10);
- bedding linen (CL 24);
- eiderdowns (CL 24).

### **CLASS 21 (Housewares and glass)**

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

**Explanatory Note:** This class includes mainly small, hand-operated utensils and apparatus for household and kitchen use as well as toilet utensils, glassware and articles in porcelain.

Includes, in particular:

- utensils and containers for household and kitchen use, for example:
- kitchen utensils, pails, and pans of iron, aluminum, plastics and other materials, small hand-operated apparatus for mincing, grinding, pressing, etc.;
- candle extinguishers, not of precious metal;
- electric combs;
- electric toothbrushes;
- dish stands and decanter stands.

Does not include, in particular:

- certain goods made of glass, porcelain and earthenware (consult the Alphabetical List of Goods);
- cleaning preparations, soaps, etc. (CL 03);
- small apparatus for mincing, grinding, pressing, etc., driven by electricity (CL 07);
- razors and shaving apparatus, clippers (hand instruments), metal implements and utensils for manicure and pedicure (CL 08);
- cooking utensils, electric (CL 11);
- toilet mirrors (CL 20).

### **CLASS 22 (Cordage and fibers)**

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

**Explanatory Note:** This class includes mainly rope and sail manufacture products, padding and stuffing materials and raw fibrous textile materials.

Includes, in particular:

- cords and twines in natural or artificial textile fibres, paper or plastics.

Does not include, in particular:

- certain nets, sacks and bags (consult the Alphabetical List of Goods);
- strings for musical instruments (CL 15).

### **CLASS 23 (Yarns and threads)**

Yarns and threads, for textile use.

### **CLASS 24 (Fabrics)**

Textiles and textile goods, not included in other classes; bed and table covers.

**Explanatory Note:** This class includes mainly textiles (piece goods) and textile covers for household use.

Includes, in particular:

- bedding linen of paper.

Does not include, in particular:

- certain special textiles (consult the Alphabetical List of Goods);
- electrically heated blankets (CL 10);
- table linen of paper (CL 16);
- horse blankets (CL 18).

### **CLASS 25 (Clothing)**

Clothing, footwear, headgear.

**Explanatory Note**

Does not include, in particular:

- certain clothing and footwear for special use (consult the Alphabetical List of Goods).

**CLASS 26 (Fancy goods)**

Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

**Explanatory Note:** This class includes mainly dressmakers' articles.

Includes, in particular:

- slide fasteners.

Does not include, in particular:

- certain special types of hooks (consult the Alphabetical List of Goods);
- certain special types of needles (consult the Alphabetical List of Goods);
- yarns and threads for textile use (CL 23).

**CLASS 27 (Floor coverings)**

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

**Explanatory Note:** This class includes mainly products intended to be added as furnishings to previously constructed floors and walls.

**CLASS 28 (Toys and sporting goods)**

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

**Explanatory Note**

Includes, in particular:

- fishing tackle;
- equipment for various sports and games.

Does not include, in particular:

- Christmas tree candles (CL 04);

- diving equipment (CL 09);
- amusement apparatus adapted for use with television receivers only (CL 09);
- electrical lamps (garlands) for Christmas trees (CL 11);
- playing cards (CL 16);
- fishing nets (CL 22);
- clothing for gymnastics and sports (CL 25);
- confectionery and chocolate decorations for Christmas trees (CL 30).

### **CLASS 29 (Meats and processed foods)**

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

**Explanatory Note:** This class includes mainly foodstuffs of animal origin as well as vegetables and other horticultural comestible products which are prepared for consumption or conservation.

Includes, in particular:

- milk beverages (milk predominating).

Does not include, in particular:

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- baby food (CL 05);
- dietetic substances adapted for medical use (CL 05);
- salad dressings (CL 30);
- fertilized eggs for hatching (CL 31);
- foodstuffs for animals (CL 31);
- living animals (CL 31).

### **CLASS 30 (Staple foods)**

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

**Explanatory Note:** This class includes mainly foodstuffs of plant origin prepared for consumption or conservation as well as auxiliaries intended for the improvement of the flavor of food.

Includes, in particular:

- beverages with coffee, cocoa or chocolate base;
- cereals prepared for human consumption (for example: oat flakes and those made of other cereals).

Does not include, in particular:

- certain foodstuffs of plant origin (consult the Alphabetical List of Goods);
- salt for preserving other than for foodstuffs (CL 01);
- medicinal teas and dietetic substances adapted for medical use (CL 05);
- baby food (CL 05);
- raw cereals (CL 31);
- foodstuffs for animals (CL 31).

### **CLASS 31 (Natural agricultural products)**

Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

**Explanatory Note:** This class includes mainly land products not having been subjected to any form of preparation for consumption, living animals and plants as well as foodstuffs for animals.

Includes, in particular:

- raw woods;
- raw cereals;
- fertilized eggs for hatching;
- mollusca and crustacea (live).

Does not include, in particular:

- cultures of micro-organisms and leeches for medical purposes (CL 05);
- semi-worked woods (CL 19);
- artificial fishing bait (CL 28);

- rice (CL 30);
- tobacco (CL 34).

### **CLASS 32 (Light beverages)**

Beers; mineral and aerated waters and other nonalcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

**Explanatory Note:** This class includes mainly nonalcoholic beverages, as well as beer.

Includes, in particular:

- de-alcoholized drinks.

Does not include, in particular:

- beverages for medical purposes (CL 05);
- milk beverages (milk predominating) (CL 29);
- beverages with coffee, cocoa or chocolate base (CL 30).

### **CLASS 33 (Wine and spirits)**

Alcoholic beverages (except beers).

**Explanatory Note:**

Does not include, in particular:

- medicinal drinks (CL 05);
- de-alcoholized drinks (CL 32).

### **CLASS 34 (Smokers' articles)**

Tobacco; smokers' articles; matches.

**Explanatory Note:**

Includes, in particular:

- tobacco substitutes (not for medical purposes).

Does not include, in particular:

- cigarettes without tobacco, for medical purposes (CL 05);
- certain smokers' articles in precious metal (CL 14) (consult the Alphabetical List of Goods).

## SERVICES

### CLASS 35 (Advertising and business)

Advertising; business management; business administration; office functions.

**Explanatory Note:** This class includes mainly services rendered by persons or organizations principally with the object of:

1. help in the working or management of a commercial undertaking, or
2. help in the management of the business affairs or commercial functions of an industrial or commercial enterprise, as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

Includes, in particular:

- services consisting of the registration, transcription, composition, compilation, or systematization of written communications and registrations, and also the exploitation or compilation of mathematical or statistical data;
- services of advertising agencies and services such as the distribution of prospectuses, directly or through the post, or the distribution of samples. This class may refer to advertising in connection with other services, such as those concerning bank loans or advertising by radio; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods.

Does not include, in particular:

- activity of an enterprise the primary function of which is the sale of goods, i.e., of a so-called commercial enterprise;
- services such as evaluations and reports of engineers which do not directly refer to the working or management of affairs in a

commercial or industrial enterprise (consult the Alphabetical List of Services);

- professional consultations and the drawing up of plans not connected with the conduct of business (CL 42).

### **CLASS 36 (Insurance and financial)**

Insurance; financial affairs; monetary affairs; real estate affairs.

**Explanatory Note:** This class includes mainly services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds.

Includes, in particular:

- services relating to financial or monetary affairs comprise the following:
  - a. services of all the banking establishments, or institutions connected with them such as exchange brokers or clearing services;
  - b. services of credit institutions other than banks such as cooperative credit associations, individual financial companies, lenders, etc.;
  - c. services of “investment trusts,” of holding companies;
  - d. services of brokers dealing in shares and property;
  - e. services connected with monetary affairs vouched for by trustees;
  - f. services rendered in connection with the issue of travelers’ checks and letters of credit;
  - g. services of realty administrators of buildings, i.e., services of letting or valuation, or financing;
  - h. services dealing with insurance such as services rendered by agents or brokers engaged in insurance, services rendered to insured, and insurance underwriting services.

## CLASS 37 (Building construction and repair)

Building construction; repair; installation services.

**Explanatory Note:** This class includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings, as well as services rendered by persons or organizations engaged in the restoration of objects to their original condition or in their preservation without altering their physical or chemical properties.

Includes, in particular:

- services relating to the construction of buildings, roads, bridges, dams or transmission lines and services of undertakings specializing in the field of construction such as those of painters, plumbers, heating installers or roofers;
- services auxiliary to construction services like inspections of construction plans;
- services of shipbuilding;
- services consisting of hiring of tools or building materials;
- repair services, i.e., services which undertake to put any object into good condition after wear, damage, deterioration or partial destruction (restoration of an existing building or another object that has become imperfect and is to be restored to its original condition);
- various repair services such as those in the fields of electricity, furniture, instruments, tools, etc.;
- services of maintenance for preserving an object in its original condition without changing any of its properties (for the difference between this class and Class 40 see the Explanatory Note of Class 40).

Does not include, in particular:

- services consisting of storage of goods such as clothes or vehicles (CL 39);
- services connected with dyeing of cloth or clothes (CL 40).

## CLASS 38 (Telecommunications)

**Explanatory Note:** This class includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which:

1. allow a person to talk to another,
2. transmit messages from one person to another, and
3. place a person in oral or visual communication with another (radio and television).

Includes, in particular:

- services which consist essentially of the diffusion of radio or television programs.

Does not include, in particular:

- radio advertising services (CL 35).

## CLASS 39 (Transportation and storage)

Transport; packaging and storage of goods; travel arrangement.

**Explanatory Note:** This class includes mainly services rendered in transporting people or goods from one place to another (by rail, road, water, air or pipeline) and services necessarily connected with such transport, as well as services relating to the storing of goods in a warehouse or other building for their preservation or guarding.

Includes, in particular:

- services rendered by companies exploiting stations, bridges, railroad ferries, etc., used by the transporter;
- services connected with the hiring of transport vehicles;
- services connected with maritime tugs, unloading, the functioning of ports and docks and the salvaging of wrecked ships and their cargoes;
- services connected with the functioning of airports;
- services connected with the packaging and parceling of goods before dispatch;
- services consisting of information about journeys or the transport of goods by brokers and tourist agencies, information relating to tariffs, timetables and methods of transport;

- services relating to the inspection of vehicles or goods before transport.

Does not include, in particular:

- services relating to advertising transport undertakings such as the distribution of prospectuses or advertising on the radio (CL 35);
- services relating to the issuing of travelers' checks or letters of credit by brokers or travel agents (CL 36);
- services relating to insurance (commercial, fire or life) during the transport of persons or goods (CL 36);
- services rendered by the maintenance and repair of vehicles, nor the maintenance or repair of objects connected with the transport of persons or goods (CL 37);
- services relating to reservation of rooms in a hotel by travel agents or brokers (CL 42).

### **CLASS 40 (Treatment of materials)**

Treatment of materials.

**Explanatory Note:** This class includes mainly services not included in other classes, rendered by the mechanical or chemical processing or transformation of objects or inorganic or organic substances.

For the purposes of classification, the mark is considered a service mark only in cases where processing or transformation is effected for the account of another person. A mark is considered a trade mark in all cases where the substance or object is marketed by the person who processed or transformed it.

Includes, in particular:

- services relating to transformation of an object or substance and any process involving a change in its essential properties (for example, dyeing a garment); consequently, a maintenance service, although usually in Class 37, is included in Class 40 if it entails such a change (for example, the chroming of motor vehicle bumpers);
- services of material treatment which may be present during the production of any substance or object other than a building; for

example, services which involve cutting, shaping, polishing by abrasion or metal coating.

Does not include, in particular:

- repair services (CL 37).

### **CLASS 41 (Education and entertainment)**

Education; providing of training; entertainment; sporting and cultural activities.

**Explanatory Note:** This class contains mainly services rendered by persons or institutions in the development of the mental faculties of persons or animals, as well as services intended to entertain or to engage the attention.

Includes, in particular:

- services consisting of all forms of education of persons or training of animals;
- services having the basic aim of the entertainment, amusement or recreation of people.

### **CLASS 42 (Computer, scientific and legal)**

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

**Explanatory Note:** Class 42 includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer specialists, lawyers, etc.

Includes, in particular:

- the services of engineers who undertake evaluations, estimates, research and reports in the scientific and technological fields
- scientific research services for medical purposes

Does not include, in particular:

- business research and evaluations (CL 35);

- word processing and computer file management services (CL 35);
- financial and fiscal evaluations (CL 36);
- mining and oil extraction (CL 37);
- computer (hardware) installation and repair services (CL 37);
- services provided by the members of professions such as medical doctors, veterinary surgeons, psychoanalysts (CL 44);
- medical treatment services (CL 44);
- garden design (CL 44).

### **CLASS 43 (Hotels and restaurants)**

Services for providing food and drink; temporary accommodations.

**Explanatory Note:** Class 43 includes mainly services provided by persons or establishments whose aim is to prepare food and drink for consumption and services provided to obtain bed and board in hotels, boarding houses or other establishments providing temporary accommodations.

Includes, in particular:

- reservation services for travellers' accommodations, particularly through travel agencies or brokers;
- boarding for animals.

Does not include, in particular:

- rental services for real estate such as houses, flats, etc., for permanent use (CL 36);
- arranging travel by tourist agencies (CL 39);
- preservation services for food and drink (CL 40);
- discotheque services (CL 41);
- boarding schools (CL 41);
- rest and convalescent homes (CL 44).

### **CLASS 44 (Medical, beauty and agricultural)**

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

**Explanatory Note:** Class 44 includes mainly medical care, hygienic and beauty care given by persons or establishments to human beings and

animals; it also includes services relating to the fields of agriculture, horticulture and forestry.

Includes, in particular:

- medical analysis services relating to the treatment of persons (such as x-ray examinations and taking of blood samples);
- artificial insemination services;
- pharmacy advice;
- animal breeding;
- services relating to the growing of plants such as gardening;
- services relating to floral art such as floral compositions as well as garden design.

Does not include, in particular:

- vermin extermination (other than for agriculture, horticulture and forestry) (CL 37);
- installation and repair services for irrigation systems (CL 37);
- ambulance transport (CL 39);
- animal slaughtering services and taxidermy (CL 40);
- timber felling and processing (CL 40);
- animal training services (CL 41);
- health clubs for physical exercise (CL 41);
- scientific research services for medical purposes (CL 42);
- boarding for animals (CL 43);
- retirement homes (CL 43).

### **CLASS 45 (Personal)**

Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

#### **Explanatory Note**

Includes, in particular:

- investigation and surveillance services relating to the safety of persons and entities;

- services provided to individuals in relation with social events, such as social escort services, matrimonial agencies, funeral services.

Does not include, in particular:

- professional services giving direct aid in the operations or functions of a commercial undertaking (CL 35);
  - services relating to financial or monetary affairs and services dealing with insurance (CL 36);
  - escorting of travellers (CL 39);
  - security transport (CL 39);
  - services consisting of all forms of education of persons (CL 41);
  - performances of singers and dancers (CL 41);
  - legal services (CL 42);
  - services provided by others to give medical, hygienic or beauty care for human beings or animals (CL 44);
  - certain rental services (consult the Alphabetical List of Services and relating to the classification of services).
- 



## Glossary of Terms

**Abandonment.** Loss of trademark rights resulting from nonuse of a mark and demonstrated by sufficient evidence that the owner intends to discontinue use of the mark; may also occur when mark has lost its distinctiveness through owner's misuse of trademark rights or as a result of naked license.

**Allegation of Use.** A PTO form that combines the Statement of Use and Amendment to Allege Use.

**Amendment to Allege Use.** An amendment to an intent-to-use application indicating use of a mark in commerce; it can only be filed before the PTO approves the mark for publication (or if there is a rejection, within six months of the response period). An applicant would complete the Allegation of Use form when filing an Amendment to Allege Use.

**Answer.** A written response to a court complaint in which the defendant admits or denies the allegations and provides a list of defenses.

**Arbitrary mark.** A word or group of words that has a dictionary meaning that does not pertain to the goods or services with which it is associated.

**Assignment.** A permanent transfer of trademark rights and goodwill.

**Blurring.** A form of dilution in which a famous mark loses some of its distinctiveness due to the use of a similar mark.

**Cancellation proceeding.** An action brought before the Trademark Trial and Appeal Board to cancel a federal registration of a mark; must be based upon one of the statutory grounds provided in the Lanham Act, and the party bringing the action must prove that it would be damaged.

**Certification mark.** A mark that indicates that third-party goods and services meet certain standards such as regional origin, material, mode of manufacture, quality, accuracy, or that the work or labor was performed by a member of a certain organization.

- Civil cover sheet.** A form required at the time of filing of the complaint for use by the court in maintaining certain statistical records.
- Collateral estoppel.** A defense to infringement; a senior user is required to abide by factual or legal determinations made in a previous lawsuit.
- Collective mark.** Used by members of a cooperative, an association, or other collective group or organization to indicate membership or to indicate the source of the organization's products or services.
- Commerce.** For purposes of protection of U.S. trademarks, any trade or business lawfully regulated by the United States.
- Common law.** A system of legal rules derived from the precedents and principles established by court decisions.
- Concurrent use.** A legal determination that more than one person is entitled to use a similar mark.
- Confidentiality agreement** (also known as nondisclosure agreement or disclosure agreement). A contract that restricts or prohibits the disclosure of confidential information.
- Counterfeiting.** The act of making or selling look-alike goods or services bearing fake trademarks
- Cybersquatter.** A person who registers a well-known trademark as a domain name hoping to later profit by selling the domain name to the trademark owner.
- Declaratory relief.** Request that the court sort out the rights and legal obligations of the parties in the midst of an actual controversy.
- Defamation of business.** False statements that injure a business's reputation. Defamation affects the manner in which the public perceives the company's trademarked products.
- Descriptive mark.** A name or term that merely describes a product or service (or its nature, quality, characteristics, ingredients, or origin) and is considered "weak."
- Design patent.** Legal protection granted for a new, original, and ornamental design for an article of manufacture; it protects only the aesthetic appearance of an article, not its structure or utilitarian features.
- Dilution.** A form of trademark injury that occurs when a famous mark's reputation is blurred or tarnished by the commercial use of a similar

mark. Unlike traditional trademark infringement, there is no requirement of consumer confusion, and the parties do not have to be competitors selling similar goods or services.

**Disclaimer.** A statement that a trademark owner asserts no exclusive right in a specific portion of a mark, apart from its use within the mark.

**Disparagement.** False statements that interfere with a company's business relations and negatively affect a company's ability to do business.

**Distinctive mark.** A mark that is either immediately distinguishable, such as an arbitrary, fanciful, or suggestive mark or a descriptive mark that has acquired secondary meaning.

**Diversity.** The right to file a lawsuit based upon nonfederal claims in federal court; parties must be from different states and the matter in controversy over \$50,000.

**Domain name.** An identifier of a website location consisting of two parts: a generic top-level domain (such as .com or .org) and a second level that is the name of the business or organization (such as amazon or eBay).

**Drawing.** A substantially exact representation of the mark as used or (in the case of intent-to-use applications) as intended to be used. A drawing is required for all federal trademark applications and for many state trademark applications.

**Estoppel.** A defense to infringement in which the junior user prevents the senior user from contradicting behavior upon which the junior user has justifiably relied. To assert an estoppel defense successfully, the senior user must know the facts of the junior user's conduct, and the junior user must have a justifiable belief that the infringing conduct is permitted.

**Fair use.** A company may defend its use of a trademarked term (owned by someone else) when the term is used to describe products or services. For example, an ad for a dishwashing machine may refer to the "joy of dishwashing" without infringing the trademark "Joy" as used for dishwashing soap. In 2005, the U.S. Supreme Court ruled that the fair-use defense can be made even when the use results in consumer confusion.

**Fanciful marks.** An invented word that is created solely to be used as a trademark or service mark, for example, Exxon or Kodak. These fanciful coined marks are immediately distinctive and are considered to be the strongest of all marks.

**Franchise agreement.** A contract in which a trademark owner (the “franchiser”) permits another business (the “franchisee”) to operate under the trademark and offer trademarked (or “branded”) products and services, for example a Ford dealership, a Baskin & Robbins ice cream store, or an H&R Block tax preparation business.

**Functionality.** The usability of a product feature or design; functional features or design will not be protected under trademark law.

**Generic term.** A term that describes an entire group or class of goods.

**Genericide.** The process by which trademark rights are abandoned because consumers have begun to think of the trademark as the descriptive name for the goods; results from a judicial determination or inter partes proceeding at the Patent and Trademark Office.

**Geographically descriptive (weak).** A geographic term describes the origin, location, or source of the product or service, for example, First National Bank of Bloomington for a bank located in Bloomington, Indiana.

**Geographically misdescriptive (unprotectible).** A geographic term that misleads consumers into believing that the product originates from a region when it does not. For example, Danish Maid Cultured Products is geographically misdescriptive of products that are not from Denmark.

**Goodwill.** The tendency or likelihood of a consumer to repurchase goods or services based upon the name or source of the goods or services.

**Gray-market goods.** When goods are manufactured abroad with the authorization of the trademark owner but are imported into the United States without authorization of the trademark owner.

**House mark.** A word or group of words that functions as the source for various products or services from one company; it is often used in conjunction with other trademarks.

**Incontestable.** A trademark that is immune from challenge except for certain grounds specified in Section 33(b) of the Lanham Act;

conclusive evidence of the registrant's exclusive right to use the registered mark in commerce in connection with the specified goods or services.

- Infringement.** Occurs when the junior user's goods or services create a likelihood of confusion with the senior user's goods or services.
- Inherently distinctive.** A mark that is immediately distinguishable, such as an arbitrary, fanciful, or suggestive mark. Marks that are not immediately distinguishable but describe some quality or aspect of the goods or services may acquire distinctiveness through sales and advertising (see *secondary meaning*).
- Injunction.** A court order directing the defendant to stop certain activities.
- Intellectual property.** Any product of the human mind that is protectible under law.
- Intent to use.** An application for federal trademark registration based upon the trademark owner's bona fide intention to use the mark in commerce.
- Inter partes.** A formal administrative hearing governed by federal rules of civil procedure and evidence.
- Interference proceeding.** A mini-trial before the Trademark Trial and Appeal Board brought when two pending trademark applications conflict or when a pending application conflicts with a registered mark that is not incontestable; only permitted under extraordinary circumstances.
- Interference with business relations.** A defendant intentionally interferes with the plaintiff's business relationship with a third party.
- Interference with prospective economic advantage.** A defendant intentionally interferes with a probable business relationship between the plaintiff and a third party.
- International schedule of classes of goods and services.** A system for classification of goods and services applicable to federal trademark applications filed on or after September 1, 1973.
- Junior user.** A party who adopts and uses a trademark similar to a mark previously adopted and used by a senior user.

**Jurisdiction.** The right of a court to hear a type of case or to bind the participants.

**Laches.** A defense to infringement in which the junior user argues that the senior user's delay in bringing the lawsuit is so unreasonable that the senior user should be barred from proceeding.

**Likelihood of confusion.** The probability of whether consumers will be confused as to the sponsorship, affiliation, or connection between the products or services of companies with similar marks; a standard for infringement, registration, and inter partes proceedings.

**Merchandise license.** A contract between the trademark owner and licensee permitting the licensee to apply the trademark to certain consumer goods, for example, coffee mugs featuring images of Bugs Bunny or the logo of a university.

**Merely descriptive.** See *descriptive mark*.

**Motion for preliminary injunction.** A request that the court order the defendant to halt the infringing activity until the outcome of the trial.

**Motion for summary judgment.** A request that the court grant a judgment without having a trial because there is no dispute as to the facts.

**Naked license.** A trademark license in which a trademark owner fails to supervise the nature and quality of the goods or services being produced under the license. A naked license can result in loss of all trademark rights.

**Opposition proceeding.** An action brought before the Trademark Trial and Appeal Board to prevent the federal registration of a mark; must be based upon one of the statutory grounds provided in the Lanham Act, and the party bringing the action must prove that it would be damaged.

**Parody.** A defense used by a junior user who seeks to justify its imitation on the premise of humor or satirical social commentary. As a general rule, the same likelihood of confusion standards are applied in a case involving parody as in any other type of infringement. The difference is that the junior user attempts to argue that consumers could not be confused because the use is obviously a joke.

- Permanent injunction.** A court order issued after a final judgment on the merits of the case; it permanently restrains the defendant from engaging in the infringing activity.
- Preliminary injunction.** A court order granted after a noticed hearing when the parties have an opportunity to present evidence as to the likelihood of plaintiff's success on the merits and irreparability of the harm to be suffered if the injunction is not granted; it lasts until a final judgment has been rendered.
- Priority.** A senior user's right to prevent a junior user from using a mark.
- Related goods or services.** Goods or services that the consuming public is likely to believe come from a certain company.
- Remedies.** Forms of judicial relief available in a lawsuit, for example, damages, injunctions or attorneys' fees.
- Request to divide out.** A statement included in an Allegation of Use asking to separate from the application certain goods for which the trademark has not been used.
- Reverse confusion.** When a junior user, usually a larger, more powerful company, attempts to usurp the power of the senior user's mark and create the impression that the senior user is the infringer.
- Right of publicity.** The legal right to control the commercial exploitation of a person's name, image, or persona.
- Secondary meaning.** Demonstration that the consuming public associates a mark with a single source; it's usually proved by advertising, promotion, and sales. A weak (descriptive) mark is said to acquire distinctiveness when it takes on a secondary meaning.
- Section 8 declaration** (also known as a Declaration of Continued Use). A declaration by a trademark owner that the mark is still in use. Filed between the fifth and sixth year following registration and at the time of each trademark renewal. Failure to file in this time period or within the six-month grace period may result in loss of trademark rights.
- Section 9 application for renewal.** An application seeking renewal of a federal trademark registration; it must be filed within six months of the expiration of the initial term of trademark registration.

**Section 15 declaration** (also known as a Declaration of Incontestability). A declaration that a trademark has been in continuous use for five years since registration. Filed between the fifth and sixth year following registration. If filed and accepted by the Patent and Trademark Office the mark becomes incontestable.

**Section 44 application.** An application for federal trademark registration by the owner of a mark registered in a foreign country, provided that country is a party to an international convention or treaty of which the United States is a member.

**Senior user.** The first party to adopt and use a particular mark in connection with its goods or services.

**Service mark.** A mark used in the sale or advertising of services to identify and distinguish services.

**Statement of Use.** A declaration indicating use of a mark in commerce; it can only be filed after a Notice of Allowance has been issued. An applicant would complete the Allegation of Use form when filing a Statement of Use.

**Strong mark.** Achieved by an inherently distinctive mark or by a nondistinctive mark that has achieved secondary meaning.

**Suggestive mark.** A mark that alludes to or hints at (without describing) the nature or quality of the goods.

**Summons.** A document served with the complaint that explains that the defendant has been sued and has a certain time limit in which to respond.

**Sweetheart sales.** Shipments or transactions within a company and performed solely to qualify for registration or for a claim of priority.

**Tarnishment.** A form of dilution that occurs when a famous mark is damaged by an unpleasant or unwholesome use of a similar mark.

**TARR (Trademark Application and Registration Retrieval).** A PTO database available to the public (at [www.uspto.gov](http://www.uspto.gov)) that allows the user to retrieve information about the status of applications or federally registered marks.

**TDR (Trademark Document Retrieval).** Debuting in 2005, TDR offers the public an advanced electronic portal to PDF viewing, downloading, and printing of an array of trademark information and documents.

- TEAS (Trademark Electronic Application System).** A PTO database available to the public (at [www.uspto.gov](http://www.uspto.gov)) that allows the user to apply for a trademark, a collective mark, or certification mark or file a Statement of Use/Amendment to Allege Use or other application and post-registration forms.
- Temporary restraining order (TRO).** An injunction, often granted *ex parte*, that is short in duration and only remains in effect until the court has an opportunity to schedule a hearing for the preliminary injunction.
- TESS (Trademark Electronic Search System).** A PTO database available to the public (at [www.uspto.gov](http://www.uspto.gov)) that allows the user to search through federal trademark registrations and prior-filed applications.
- Trade dress.** A distinctive combination of elements, many of which may not be protectible by themselves under trademark law.
- Trade secret.** Any business information that is kept in confidence and that gives the business an advantage over competitors who do not know it.
- Trademark.** Any word, symbol, design, device, logo, or slogan that identifies and distinguishes one product or service from another.
- Trademark license.** An agreement granting limited trademark rights.
- Unclean hands.** A defense asserted when the senior user has committed a serious act of wrongdoing in regard to the lawsuit or the activity precipitating the lawsuit.
- Unfair competition.** A collection of common law principles and precedents, many of which are adopted as state laws, that protect against unethical business practices.
- URL (Uniform Resource Locator).** A system for locating a website; it generally begins with <http://www>. followed by a domain name.
- Use in commerce.** Actual use of a mark in the ordinary course of trade (or, if otherwise impracticable, on documents associated with the goods). For federal registration, commerce is any commerce lawfully regulated by the federal government. For state registration, it is generally any commerce occurring within the state of registration. A service mark is deemed to be in use in commerce when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.

**Weak.** Nondistinctive name or term that cannot be registered or protected as a trademark unless the owner proves a consumer awareness or “secondary meaning.”





# Selected Pages From Thomson CompuMark Trademark Research Report

**Search: Incorporator Pro**

Reprinted with permission of Thomson CompuMark

Thomson CompuMark

## Trademark Research Report

**Mark Searched:** INCORPORATOR PRO**Client Name:** THOMSON COMPUMARK**Type Of Search:** FULL SEARCH**Formatted:** By Source**Attention:** SCOTT RUTHERFORD**Our File:** 136177611 -78**Date Completed:** February 26, 2007**Date Received:** February 22, 2007**Received by:** Telephone**Goods/Services:**

SOFTWARE PRODUCT

We have taken all reasonable steps to ensure the completeness and accuracy of this report. However, for various reasons, including the subjective nature of trademark searching and the possibility of incomplete and inaccurate data provided by the United States Patent & Trademark Office and other national trademark offices, the Secretary of States' Offices, and all of the many vendors and publishers of trademark and business information used in compiling search reports, we cannot warrant that this report is complete or error free. AS A RESULT, WE DISCLAIM ALL WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE. This search is valid only for the mark and goods noted above. If the mark or goods that were the subject of this search change, even slightly, a new search should be performed.

Any liability arising out of the preparation of this report is limited to a refund of the search fee paid. Acceptance of this search constitutes an acceptance of the aforesaid terms, conditions and limitations. This report in no way constitutes a legal opinion. The ranking of cited references into groups based on their relative relevance to the mark searched is for the convenience of our clients in reviewing the search report and is not intended to convey an opinion regarding the legal significance of any cited reference.



Thomson CompuMark, 500 Victory Road, North Quincy, MA 02171-3145  
Telephone (617) 479-1600 (800) 692-8833 • Fax (617) 786-8273 (800) 543-1983

# Table of Contents

## Report Summary

Report Graph .....	5
Group One Summary .....	6

## USPTO Trademark Report

USPTO Summary .....	7
Analyst Review .....	13
USPTO Citations .....	18

## State Trademark Report

State Summary .....	115
Analyst Review .....	118
State Citations .....	123

## Web Common Law

Analyst Review .....	147
Web Common Law Summary .....	149
Web Common Law Citations .....	150

## Common Law Database Report

Common Law Database Summary .....	159
Analyst Review .....	161
Common Law Database Citations .....	165

## Common Law Business Name Report

Common Law Business Name Summary .....	183
Analyst Review .....	185
Common Law Business Name Citations .....	188

## Gale Group Database Report

Gale Group Database Summary .....	193
Analyst Review .....	194
Gale Group Database Citations .....	198

## Internet Domain Name Report

Internet Domain Name Summary .....	199
Analyst Review .....	200
Internet Domain Name Citations .....	202

## Additional References

Common Law Library Citations .....	213
Shepard's Citations .....	215

**INCORPORATOR PRO**

**Group One Summary**

Citation	Status	Class(es)	Owner	Source	Page	Record of Interest
<b>GROUP ONE</b>						
1. <u>INCORPORATOR PRO</u>	Abandoned	9	NOLO	USPTO	18	<input type="checkbox"/>
2. <u>INCORPORATOR PRO</u>	N/A	9	NOLO PRESS	Common Law Data-base	165	<input type="checkbox"/>
3. <u>INCORPORATORPRO.COM</u>	N/A	N/A	N/A	Domain Name	202	<input type="checkbox"/>

INCORPORATOR PRO

USPTO Summary Page

Citation	Status	Class(es)	Owner	Reg/Serial Number	Page	Record of Interest
<b>GROUP ONE</b>						
<b>1. INCORPORATOR PRO</b>						
	Abandoned	9	NOLO	SN-76-463,346	18	<input type="checkbox"/>
<b>GROUP TWO</b>						
<b>No Group Two Matches</b>						
<b>GROUP THREE</b>						
<b>2. NATIONWIDE INCORPORATORS THE INCORPORATION PROFESSIONALS</b>						
	Registered	42	CALIFORNIA INCORPORATORS	RN-2,801,326 SN-78-090,464	19	<input type="checkbox"/>
<b>3. MARI PRO INCORPORATED</b>						
	Registered	9, 40, 42	MARI PRO INCORPORATED	RN-2,706,549 SN-76-363,473	20	<input type="checkbox"/>
<b>4. CAPRO INCORPORATED</b>						
	Cancelled	9, 16	CAPRO INCORPORATED	RN-1,268,994 SN-73-407,856	22	<input type="checkbox"/>
<b>5. PROSYNAPTIC TECHNOLOGIES, INCORPORATED</b>						
	Pending	9, 42	PROSYNAPTIC TECHNOLOGIES, INCORPORATED	SN-77-067,918	24	<input type="checkbox"/>
<b>6. PROMED SYSTEMS INCORPORATED</b>						
	Abandoned	42	PROMED SYSTEMS, INC.	SN-73-493,128	26	<input type="checkbox"/>
<b>7. COMPUTER SERVICE PROFESSIONALS INCORPORATED</b>						
	Abandoned	42	COMPUTER SERVICE PROFESSIONALS INCORPORATED	SN-74-346,720	28	<input type="checkbox"/>
<b>8. SHOWPRO INCORPORATED</b>						
	Abandoned	35	SHOWPRO, INC.	SN-73-553,149	30	<input type="checkbox"/>
<b>9. PROFESSIONAL TECHNOLOGIES, INCORPORATED</b>						
	Misassigned	35	PROFESSIONAL TECHNOLOGIES, INCORPORATED	SN-74-043,051	31	<input type="checkbox"/>
<b>10. COMMUNICATIONS PROFESSIONALS OF SOUTH CAROLINA INCORPORATED</b>						
	Abandoned	37	COMMUNICATIONS PROFESSIONALS OF SOUTH CAROLINA	SN-75-052,275	32	<input type="checkbox"/>

## INCORPORATOR PRO

Citation	Status	Class(es)	Owner	Reg/Serial Number	Page	Record of Interest
<b>GROUP FOUR</b>						
<u>11. PROSOFT LEARNING CORPORATION</u>						
	Pending	9	PROSOFT LEARNING CORPORATION	SN-78-822,486	33	<input type="checkbox"/>
<u>12. PRL PROSOFT LEARNING CORPORATION</u>						
	Pending	9	PROSOFT LEARNING CORPORATION	SN-78-822,479	35	<input type="checkbox"/>
<u>13. VIPRO CORPORATION THE INTERNET SURETY COMPANY</u>						
	Abandoned	35	VIPRO CORPORATION	SN-75-899,602	37	<input type="checkbox"/>
<u>14. PROSOFT LEARNING CORPORATION</u>						
	Pending	16	PROSOFT LEARNING CORPORATION	SN-78-822,484	38	<input type="checkbox"/>
<u>15. PLC PROSOFT LEARNING CORPORATION</u>						
	Pending	16	PROSOFT LEARNING CORPORATION	SN-78-822,476	40	<input type="checkbox"/>
<u>16. HIRSCHLER FLEISCHER A PROFESSIONAL CORPORATION</u>						
	Registered	16	HIRSCHLER FLEISCHER	RN-2,708,709 SN-76-340,064	42	<input type="checkbox"/>
<u>17. PTC PROFESSIONAL TESTING CORPORATION</u>						
	Registered	16, 42	PROFESSIONAL TESTING CORPORATION	RN-2,133,782 SN-75-100,729	43	<input type="checkbox"/>
<u>18. CORPORATE PRO BONO</u>						
	Pending	35	PRO BONO INSTITUTE	SN-78-762,830	45	<input type="checkbox"/>
<u>19. SOLUTIONS BUTZEL LONG A PROFESSIONAL CORPORATION</u>						
	Registered	42	BUTZEL LONG	RN-2,570,908 SN-76-088,200	46	<input type="checkbox"/>
<u>20. PROSOFT LEARNING CORPORATION</u>						
	Pending	41	PROSOFT LEARNING CORPORATION	SN-78-822,482	47	<input type="checkbox"/>
<u>21. PLC PROSOFT LEARNING CORPORATION</u>						
	Pending	41	PROSOFT LEARNING CORPORATION	SN-78-822,473	49	<input type="checkbox"/>
<u>22. PROACTIVE INFORMATION CORPORATION</u>						
	Abandoned	41	PROACTIVE INFORMATION CORPORATION	SN-75-614,879	51	<input type="checkbox"/>

**INCORPORATOR PRO**

Citation	Status	Class(es)	Owner	Reg/Serial Number	Page	Record of Interest
<b>23. MYCORPORATION.COM PROFESSIONALS NETWORK</b>						
	Registered	35, 42	MY CORPORATION BUSINES SERVICES, INC.	RN-2,897,331 SN-78-293,665	52	<input type="checkbox"/>
<b>24. PGC ISO9001 PROGATE GROUP U.S.A. CORPORATION</b>						
	Registered	42	PROGATE GROUP U.S.A. CORPORATION	RN-2,674,346 SN-76-316,857	53	<input type="checkbox"/>
<b>25. PROVIS CORPORATION</b>						
	Abandoned	9	PROVIS CORPORATION	SN-75-174,338	55	<input type="checkbox"/>
<b>26. DIGITAL PRO CORPORATION</b>						
	Abandoned	9	DIGITAL-PRO, CORP.	SN-73-492,585	56	<input type="checkbox"/>
<b>27. SMART FORMS CORPORATION PERMITPRO FOR WINDOWS CORPORATION, NEW YORK, NY.</b>						
	Misassigned	9	SMART FORMS CORPORATION	SN-75-760,799	57	<input type="checkbox"/>
<b>28. PSC PROFESSIONAL SOUND CORPORATION</b>						
	Cancelled	9	PROFESSIONAL SOUND CORPORATION	RN-2,092,736 SN-75-080,421	58	<input type="checkbox"/>
<b>29. MORETIME THE CORPORATE TIME MANAGEMENT SYSTEM DESIGNED FOR MANAGERS AND PROFESSIONALS A PRODUCT OF LYNN-ARTHUR ASSOCIATES</b>						
	Abandoned	42	LYNN-ARTHUR ASSOCIATES	SN-73-404,692	59	<input type="checkbox"/>
<b>30. INTERNET INCORPORATORS</b>						
	Registered	42	WICKFORD EQUITIES, LLC.	RN-2,458,702 SN-75-404,152	60	<input type="checkbox"/>
<b>31. INTERNET INCORPORATORS</b>						
	Registered	42	WICKFORD EQUITIES, LLC.	RN-2,679,110 SN-75-124,945	62	<input type="checkbox"/>
<b>32. WORLDWIDE INCORPORATORS LTD.</b>						
	Registered	35	WORLDWIDE INCORPORATORS LTD.	RN-2,299,102 SN-75-570,111	65	<input type="checkbox"/>
<b>33. INCORPORATORS USA, LLC</b>						
	Pending	35	REGISTERED AGENTS, LTD.	SN-78-808,595	66	<input type="checkbox"/>
<b>34. AMERICAN INCORPORATORS</b>						
	Registered	35	AMERICAN INCORPORATORS LTD.	RN-2,536,840 SN-78-068,934	67	<input type="checkbox"/>
<b>35. FASTINCORPORATORS</b>						
	Abandoned	35	FAST INCORPORATORS INC.	SN-76-519,811	68	<input type="checkbox"/>

## INCORPORATOR PRO

Citation	Status	Class(es)	Owner	Reg/Serial Number	Page	Record of Interest
36. <u>GEEKS INCORPORATED</u>	Registered	42	GEEKS ONSITE LTD.	RN-2,783,731 SN-76-391,514	69	<input type="checkbox"/>
37. <u>PCO INCORPORATED</u>	Published	9	PC OPEN INC.	SN-78-704,318	71	<input type="checkbox"/>
38. <u>GVP INCORPORATED NETWORK &amp; SYSTEMS CONSULTING</u>	Registered	42	PC MALL, INC.	RN-2,361,713 SN-75-628,860	73	<input type="checkbox"/>
39. <u>INCORPORATETIME</u>	Registered	42	WALSH, KERRY	RN-3,004,229 SN-78-464,888	75	<input type="checkbox"/>
40. <u>INCORPORATE</u>	Cancelled	9	UNABRIDGED SOFTWARE, INC.	RN-2,085,108 SN-75-128,694	76	<input type="checkbox"/>
41. <u>MICROPRO INTERNATIONAL CORPORATION</u>	Cancelled	9, 16	MICRON PC, LLC	RN-1,233,332 SN-73-267,413	77	<input type="checkbox"/>
42. <u>CORPRO</u>	Registered	9	CORSTAR BUSINESS COMPUTING CO., INC.	RN-1,450,424 SN-73-588,242	82	<input type="checkbox"/>
43. <u>MEMBERPRO</u>	Registered	9	REDESIGN TECHNOLOGIES INC.	RN-3,008,149 SN-76-417,408	83	<input type="checkbox"/>
44. <u>INSTALLPRO</u>	Registered	9	RELEASE ENGINEERING INC.	RN-2,800,234 SN-78-115,518	85	<input type="checkbox"/>
45. <u>INTRUPRO</u>	Registered	9	INTOTO, INC.	RN-3,040,878 SN-78-503,676	86	<input type="checkbox"/>
46. <u>INTERACTIVEPRO</u>	Registered	9	SIGMATECH, INC.	RN-2,798,237 SN-76-103,632	87	<input type="checkbox"/>
47. <u>PARTNER PRO</u>	Registered	42	VMG TECHNOLOGIES, INC.	RN-2,706,944 SN-76-426,736	88	<input type="checkbox"/>
48. <u>PRESENTERPRO</u>	Registered	9	SIGMATECH, INC.	RN-2,854,043 SN-75-728,431	89	<input type="checkbox"/>

**INCORPORATOR PRO**

Citation	Status	Class(es)	Owner	Reg/Serial Number	Page	Record of Interest
49. <u>INFO-PRO</u>	Registered	9	INFORMATION PROFESSION ALS COMPANY	RN-3,019,036 SN-76-546,245	91	<input type="checkbox"/>
50. <u>INDUSTRYPRO</u>	Registered	35, 42	ZIRKLE & CO.	RN-2,406,037 SN-75-840,779	92	<input type="checkbox"/>
51. <u>INSTALLATIONPRO</u>	Registered	37	METRON NORTH AMERICA, LTD.	RN-2,869,799 SN-78-298,485	93	<input type="checkbox"/>
52. <u>PROFILERPRO</u>	Published	9	CALIPER LIFE SCIENCES, INC.	SN-77-000,497	95	<input type="checkbox"/>
53. <u>ALLOCATOR PRO</u>	Registered	9	FMR CORP.	RN-2,269,948 SN-75-311,768	96	<input type="checkbox"/>
54. <u>LAWYER PRO</u>	Renewed	9	HARLAND FINANCIAL SOLUTI ONS, INC.	RN-1,874,579 SN-74-399,446	98	<input type="checkbox"/>
55. <u>SMALL BIZ PRO</u>	Pending	35	BESACK & ASSOCIATES	SN-78-886,070	102	<input type="checkbox"/>
56. <u>EBUSINESS PRO</u>	Abandoned	9, 16, 42	ZD INC.	SN-75-514,100	103	<input type="checkbox"/>
57. <u>COMPANYDATA PRO</u>	Abandoned	9, 16, 35, 36, 38, 42	DEUTSCHE TELEKOM AG	SN-78-166,920	106	<input type="checkbox"/>
58. <u>BIZPRO</u>	Pending	16	APEX BUSINESS SOLUTION S, LLC	SN-76-665,761	108	<input type="checkbox"/>
59. <u>PRO BUSINESS TOOLS</u>	Registered	42	PROSITE BUSINESS SOLUTI ONS, LLC	RN-3,131,366 SN-78-467,030	109	<input type="checkbox"/>
60. <u>BIZPRO</u>	Cancelled	35	APTAN, INC.	RN-2,136,707 SN-75-138,818	110	<input type="checkbox"/>
61. <u>BUSINESS PLAN PRO</u>	Registered	9	PALO ALTO SOFTWARE, INC.	RN-2,165,157 SN-75-167,857	111	<input type="checkbox"/>

## INCORPORATOR PRO

Citation	Status	Class(es)	Owner	Reg/Serial Number	Page	Record of Interest
<b>GROUP FIVE</b>						
<b>62. THE INCORPORATOR WWW.INCBYPRO.COM</b>						
	Registered	42	THE INCORPORATOR INCORPORATED	RN-3,201,257 SN-78-795,446	112	<input type="checkbox"/>
<b>63. PROS INCORPORATED</b>						
	Abandoned	35	PROS INCORPORATED	SN-75-288,910	113	<input type="checkbox"/>

**INCORPORATOR PRO**

**US-1**  
**Group: One**

INCORPORATOR PRO

**INCORPORATOR PRO**

**Status:** ABANDONED  
 INTENT TO USE

**USPTO Status:** ABANDONED-FAILURE TO RESPOND  
**USPTO Status Date:** MAY 27, 2004

**Goods/Services:**  
**International Class 9:** COMPUTER SOFTWARE FOR USE IN  
 CREATING STATE CORPORATION DOCUMENTS

**Last Reported Owner:**  
 NOLO  
 CALIFORNIA CORPORATION  
 950 PARKER STREET  
 BERKELEY, CALIFORNIA 94710

**Chronology:**  
**Filed:** OCT 31, 2002      **Serial Number:** 76-463,346  
**Abandoned:** MAY 27, 2004

**Ownership Details:**

**Applicant:**  
 NOLO  
 CALIFORNIA CORPORATION  
 950 PARKER STREET  
 BERKELEY, CALIFORNIA 94710

**Filing Correspondent:**  
 NOLO  
 950 PARKER STREET  
 BERKELEY CA 94710

**In-Use Information**

**Citation Link:** None Found  
**Owner Link:** None Found  
**In-Use Link:** None Found

## INCORPORATOR PRO

US-2  
Group: ThreeNATIONWIDE INCORPORATORS THE INCORPORATION  
PROFESSIONALS

Status: REGISTERED

USPTO Status: REGISTERED

USPTO Status Date: DEC 30, 2003

## Goods/Services:

**International Class 42:** PREPARATION AND FILINGS TO STATE AGENCIES ON BEHALF OF BUSINESS OWNERS TO FORM CORPORATIONS AND LIMITED LIABILITY COMPANIES

First Used: DEC 15, 2001 (INTL. CL. 42)

In Commerce: DEC 15, 2001

## Disclaimers:

"NATIONWIDE INCORPORATORS" AND "THE INCORPORATION PROFESSIONALS"

## Last Reported Owner:

CALIFORNIA INCORPORATORS  
CALIFORNIA CORPORATION  
15928 VENTURA BLVD., SUITE 224  
ENCINO, CALIFORNIA 91436

We Have Located Other Marks With This Owner

CALIFORNIA INCORPORATORS THE State Page 123  
PROFESSIONAL SOLUTION

## Chronology:

Filed: OCT 26, 2001 Serial Number: 78-090,464

Published For Opposition: NOV 05, 2002

Registered: DEC 30, 2003 Registration Number: 2,801,326

## Ownership Details:

## Registrant:

CALIFORNIA INCORPORATORS  
CALIFORNIA CORPORATION  
15928 VENTURA BLVD., SUITE 224  
ENCINO, CALIFORNIA 91436

## Filing Correspondent:

CALIFORNIA INCORPORATORS  
15928 VENTURA BLVD STE 224  
ENCINO CA 91436-4413

**INCORPORATOR PRO**

**US-4**  
**Group: Three**

CAPRO  
 INCORPORATED

**CAPRO INCORPORATED**

**Status:** CANCELLED **Cancellation Section:** 8

**USPTO Status:** CANCELLED - SECTION 8  
**USPTO Status Date:** JUL 12, 1990

**Goods/Services:**

**International Class 9:** COMPUTERS AND PERIPHERAL EQUIPMENT FOR COMPUTERS-NAMELY, PRINTERS AND VIDEO DISPLAY TERMINALS

**International Class 16:** INSTRUCTION MANUALS FOR COMPUTER HARDWARE AND SOFTWARE

**First Used:** JUN 01, 1982 (INTL. CL. 9)

**In Commerce:** JUL 30, 1982

**First Used:** JUN 01, 1982 (INTL. CL. 16)

**In Commerce:** JUL 30, 1982

**Disclaimers:**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INCORPORATED", APART FROM THE MARK AS SHOWN.

**Last Reported Owner:**

CAPRO INCORPORATED  
 CALIFORNIA CORPORATION  
 12781 PALA DR.  
 GARDEN GROVE, CALIFORNIA 92641

**We Have Located Other Marks With This Owner**

CAPRO INCORPORATED State Page 133

CAPRO INCORPORATED State Page 134

**Chronology:**

**Filed:** JAN 03, 1983 **Serial Number:** 73-407,856

**Published For Opposition:** DEC 13, 1983

**Registered:** MAR 06, 1984 **Registration Number:** 1,268,994

**Cancelled:** AUG 21, 1990

**Ownership Details:**

**Registrant:**

CAPRO INCORPORATED  
 CALIFORNIA CORPORATION  
 12781 PALA DR.  
 GARDEN GROVE, CALIFORNIA 92641

**Filing Correspondent:**

HOWARD J. KLEIN  
 KLEIN & SZEKERES

## INCORPORATOR PRO

US-30  
Group: Four

## INTERNET INCORPORATORS

**Status:** REGISTERED  
SUPPLEMENTAL REGISTER

**USPTO Status:** SECTION 8 - ACCEPTED  
**USPTO Status Date:** NOV 18, 2006

**Goods/Services:**

**International Class 42:** LEGAL SERVICES, NAMELY, FORMATION OF CORPORATIONS, RESIDENT AGENT SERVICES AND OFFICE HEADQUARTERS SERVICES FOR OTHERS

**First Used:** APR 11, 1998 (INTL. CL. 42)

**In Commerce:** APR 11, 1998

**Disclaimers:**

"INTERNET INCORPORATORS"

**Last Reported Owner:**

WICKFORD EQUITIES, LLC.  
NEVADA LIMITED LIABILITY COMPANY  
1151 AIRPORT RD., STE. 02  
MINDEN, NEW YORK 89423

**We Have Located Other Marks With This Owner**

INTERNET INCORPORATORS USPTO Page 62

**Chronology:**

**Filed:** DEC 11, 1997      **Serial Number:** 75-404,152  
**Application Amended:** SEP 13, 1999  
**Registered:** JUN 05, 2001      **Registration Number:** 2,458,702  
**Affidavit Section:** REGISTERED - SEC. 8 (6-YR) ACCEPTED NOV 18, 2006

**Ownership Details:****Registrant:**

SIERRA HOLDINGS LIMITED  
NEVADA CORPORATION  
PO BOX 1490  
VERDI, NEVADA 89438

**INCORPORATOR PRO**

**US-31**  
**Group: Four**

**INTERNET  
INCORPORATORS**

**INTERNET INCORPORATORS**

**Status:** REGISTERED  
SUPPLEMENTAL REGISTER

**USPTO Status:** REGISTERED  
**USPTO Status Date:** JAN 21, 2003

**Goods/Services:**

**International Class 42:** LEGAL SERVICES, NAMELY, FORMATION OF CORPORATION, ESTABLISHMENT OF RESIDENT AGENTS AND OFFICE AND HEADQUARTERS FOR CORPORATIONS

**First Used:** APR 11, 1998 (INTL. CL. 42)

**In Commerce:** APR 11, 1998

**Disclaimers:**

"INCORPORATORS"

**Last Reported Owner:**

WICKFORD EQUITIES, LLC.  
NEVADA LIMITED LIABILITY COMPANY  
1151 AIRPORT RD., STE. 02  
MINDEN, NEW YORK 89423

**We Have Located Other Marks With This Owner**

INTERNET INCORPORATORS USPTO Page 60

**Chronology:**

**Filed:** JUN 25, 1996      **Serial Number:** 75-124,945  
**Application Amended:** OCT 26, 1998  
**Registered:** JAN 21, 2003      **Registration Number:** 2,679,110  
**Date Revived/Reinstated:** AUG 14, 2001

**Ownership Details:**

**Registrant:**

SIERRA HOLDINGS LIMITED  
ANGUILLA CORPORATION  
P.O. BOX 801  
THE VALLEY, ANGUILLA

## INCORPORATOR PRO

US-40  
Group: Four

## INCORPORATE

## INCORPORATE

**Status:** CANCELLED                      **Cancellation Section:** 8  
SUPPLEMENTAL REGISTER

**USPTO Status:** CANCELLED - SECTION 8  
**USPTO Status Date:** MAY 01, 2004

**Goods/Services:**

**International Class 9:** SOFTWARE FOR CREATING THE LEGAL DOCUMENTS TO FORM A CORPORATION AND INSTALLATION AND INSTRUCTION MANUALS SOLD AS A UNIT THEREWITH

**First Used:** MAR 23, 1995 (INTL. CL. 9)

**In Commerce:** APR 13, 1995

**Last Reported Owner:**

UNABRIDGED SOFTWARE, INC.  
TEXAS CORPORATION  
5959 WEST LOOP SOUTH, SUITE 300  
BELLAIRE, TEXAS 77401

**Chronology:**

**Filed:** JUN 10, 1996                      **Serial Number:** 75-128,694  
**Application Amended:** FEB 17, 1997  
**Registered:** JUL 29, 1997              **Registration Number:** 2,085,108  
**Cancelled:** JUN 15, 2004

**Ownership Details:****Registrant:**

UNABRIDGED SOFTWARE, INC.  
TEXAS CORPORATION  
5959 WEST LOOP SOUTH, SUITE 300  
BELLAIRE, TEXAS 77401

**Filing Correspondent:**

RITA M. IRANI  
PRAVEL, HEWITT, KIMBALL & KRIEGER  
1177 WEST LOOP SOUTH, TENTH FLOOR  
HOUSTON, TX 77027-9095

## INCORPORATOR PRO

US-42  
Group: Four

CORPRO

CORPRO

**Status:** REGISTERED**USPTO Status:** SECTION 8 & 15 - ACCEPTED AND  
ACKNOWLEDGED**USPTO Status Date:** DEC 11, 1992**Goods/Services:****International Class 9:** COMPUTER PROGRAMS RECORDED ON  
MAGNETIC MEDIA**First Used:** OCT 09, 1985 (INTL. CL. 9)**In Commerce:** OCT 09, 1985**Last Reported Owner:**CORSTAR BUSINESS COMPUTING CO., INC.  
NEW YORK CORPORATION  
1 AQUEDUCT ROAD  
WHITE PLAINS, NEW YORK 10606**Chronology:****Filed:** MAR 17, 1986**Serial Number:** 73-588,242**Published For Opposition:** JUL 01, 1986**Registered:** AUG 04, 1987**Registration Number:** 1,450,424**Affidavit Section:** REGISTERED - SEC. 8 (6-YR) ACCEPTED &  
SEC. 15 ACK. DEC 11, 1992**Ownership Details:****Registrant:**CORSTAR BUSINESS COMPUTING CO., INC.  
NEW YORK CORPORATION  
1 AQUEDUCT ROAD  
WHITE PLAINS, NEW YORK 10606**Filing Correspondent:**MARILYN MATTHES BROGAN  
CURTIS, MORRIS & SAFFORD  
530 FIFTH AVENUE  
NEW YORK, NY 10036

## INCORPORATOR PRO

US-63  
Group: FivePROS  
INCORPORATED

## PROS INCORPORATED

**Status:** ABANDONED  
SUPPLEMENTAL REGISTER  
AMENDED TO USE APPLICATION

**USPTO Status:** ABANDONED-FAILURE TO RESPOND  
**USPTO Status Date:** MAR 28, 2000

**Goods/Services:**

**International Class 35:** PROVIDING BUSINESS AGENT SERVICES  
FOR PROFESSIONAL ATHLETES AND OTHER CELEBRITIES  
**First Used:** MAR 02, 1973 (INTL. CL. 35)  
**In Commerce:** APR 01, 1973

**Last Reported Owner:**

PROS INCORPORATED  
VIRGINIA CORPORATION  
9 SOUTH 12TH STREET  
P.O. BOX 673  
RICHMOND, VIRGINIA 23218

**Chronology:**

**Filed:** MAY 08, 1997      **Serial Number:** 75-288,910  
**Abandoned:** MAR 28, 2000

**Ownership Details:****Applicant:**

PROS INCORPORATED  
VIRGINIA CORPORATION  
9 SOUTH 12TH STREET  
P.O. BOX 673  
RICHMOND, VIRGINIA 23218

**Filing Correspondent:**

ALLEN S MELSER  
REID & PRIEST LLP  
701 PENNSYLVANIA AVE NW  
WASHINGTON DC 20004

INCORPORATOR PRO

State Summary Page

Citation	Status	Class(es)	Owner	Registration Number	State	Page	Record of Interest
<b>GROUP ONE</b>							
<b>No Group One Matches</b>							
<b>GROUP TWO</b>							
<b>No Group Two Matches</b>							
<b>GROUP THREE</b>							
<b>1. CALIFORNIA INCORPORATORS THE PROFESSIONAL SOLUTION</b>							
	Registered	42	CALIFORNIA INCORPORATORS	47569	CA	123	<input type="checkbox"/>
<b>2. PROMED SYSTEMS INCORPORATED</b>							
	Not renewed	9, 16	PROMED SYSTEMS, INC.	5946	CT	124	<input type="checkbox"/>
<b>3. PROMEDSYSTEMS INCORPORATED</b>							
	Expired	35, 36, 41, 42	PROMED SYSTEMS, INC.	5947	CT	125	<input type="checkbox"/>
<b>4. PROWEST INCORPORATED</b>							
	Not renewed	35, 42	PROWEST INCORPORATED ALBUQUERQUE	40407	NM	126	<input type="checkbox"/>
<b>5. CSPI COMPUTER SERVICE PROFESSIONALS INCORPORATED</b>							
	Not renewed	35	COMPUTER SERVICE PROFESSIONALS INC.	S12095	MO	127	<input type="checkbox"/>
<b>6. MPPA MINNESOTA PROFESSIONAL PHOTOGRAPHERS' ASSOCIATION, INCORPORATED</b>							
	Not renewed	9, 40, 42	MINNESOTA PROFESSIONAL PHOTOGRAPHERS ASS ...	13818	MN	128	<input type="checkbox"/>
<b>7. THE POWERPRO'S, INCORPORATED</b>							
	Registered	37	THE POWERPRO'S INCORPORATED	20020719	RI	129	<input type="checkbox"/>
<b>8. PRO PRINT INCORPORATED</b>							
	Renewed	35	PRO-PRINT, INCORPORATED	N/A	KS	130	<input type="checkbox"/>
<b>9. NATIONAL PROMOTIONS INCORPORATED "PROFESSIONALS IN CREATIVE PRODUCTIONS"</b>							
	Registered	35	NATIONAL PROMOTIONS INCORPORATED	N/A	WI	131	<input type="checkbox"/>

## INCORPORATOR PRO

Citation	Status	Class(es)	Owner	Registration Number	State	Page	Record of Interest
10.	<u>PROFESSIONAL DATA RESOURCES INCORPORATED PDR</u>						
	Registered	42	PROFESSIONAL DATA ETC CINCINNATI	63157	OH	132	<input type="checkbox"/>
11.	<u>CAPRO INCORPORATED</u>						
	Expired	9	CAPRO INCORPORATED	68265	CA	133	<input type="checkbox"/>
12.	<u>CAPRO INCORPORATED</u>						
	Expired	9, 16	CAPRO INCORPORATED	68269	CA	134	<input type="checkbox"/>
13.	<u>INCORPORATOR</u>						
	Registered	7, 8, 9	DYNAMICS CORP OF AMERICA GREENWICH	9457	OH	135	<input type="checkbox"/>
<b>GROUP FOUR</b>							
14.	<u>FLORIDA BUSINESS "INCORPORATORS"</u>						
	Registered	35	FLORIDA BUSINESS INC ORPORATORS LLC	T200611 10	FL	136	<input type="checkbox"/>
15.	<u>PROVISTA CORPORATION</u>						
	Not renewed	35	PROVISTA CORPORATI ON	50101689	IN	137	<input type="checkbox"/>
16.	<u>PROFESSIONAL CADD CONCEPTS CORPORATION-PLANT THE SEED OF EXCELLENCE PCC</u>						
	Not renewed	42	PROFESSIONAL CADD CONCEPTS CORPORATI ON	1993S31 26	MD	138	<input type="checkbox"/>
17.	<u>THE INCORPORATOR</u>						
	Not renewed	16	KITCO, INC.	11385	SC	139	<input type="checkbox"/>
18.	<u>THE INCORPORATOR</u>						
	Not renewed	42	THE INCORPORATOR, INC.	N/A	WI	140	<input type="checkbox"/>
19.	<u>DELAWARE BUSINESS INCORPORATORS, INC.</u>						
	Expired	35	DELAWARE BUSINESS INCORPORATORS, INC.	1708	DE	141	<input type="checkbox"/>
20.	<u>JOHNSON, MILLER &amp; CO. CERTIFIED PUBLIC ACCOUNTANTS A PROFESSIONAL CORPORATION</u>						
	Registered	35, 36	MOHNSON, MILLER & CO. CERTIFIED PUBLIC A ...	TK970328 02	NM	142	<input type="checkbox"/>
21.	<u>PSC PROFESSIONAL SOUND CORPORATION</u>						
	Expired	9	PROFESSIONAL SOUND CORPORATION	101033	CA	143	<input type="checkbox"/>

**INCORPORATOR PRO**

Citation	Status	Class(es)	Owner	Registration Number	State	Page	Record of Interest
----------	--------	-----------	-------	---------------------	-------	------	--------------------

<b>22. IMPORTPRO</b>							
	Registered	9, 42	TRANS MOUNTAIN CONSULTING CO.	19971132681	CO	144	<input type="checkbox"/>

<b>23. BUSINESSPRO</b>							
	Registered	35	RECOMPUTE! CORPORATION	56075	TX	145	<input type="checkbox"/>

**GROUP FIVE**

<b>24. PRO INCORPORATED</b>							
	Not renewed	20	PROFESSIONAL REPRESENTATION ORGANIZATION ...	19891021749	CO	146	<input type="checkbox"/>

## INCORPORATOR PRO

ST-1  
Group: Three

## CALIFORNIA INCORPORATORS THE PROFESSIONAL SOLUTION

State: CALIFORNIA

Status: REGISTERED

Date Registered: MAR 20, 1997

Registration No.: 47569

Goods/Services: **International Class: 42**

NEW BUSINESS IN CALIFORNIA

**State Class: 42****First Use In State:**

FEB, 1996

**First Use Anywhere:**

FEB, 1996

**Design Phrase:** THE WORDS "CALIFORNIA INCORPORATORS" WITH THE FIRST LETTERS OF EACH NAME IN A DROP CAP STYLE, THE NAME IS ACCOMPANIED WITH A LOGO IN THE STYLE OF TWO CRESCENTS FACING EACH OTHER (LOCATED ABOVE THE NAME) AND THE WORDS "THE PROFESSIONAL SOLUTION" (LOCATED BELOW THE NAME)

**Registrant:**

CALIFORNIA INCORPORATORS  
CALIFORNIA CORPORATION  
15928 VENTURA BOULEVARD, SUITE 108  
ENCINO, CALIFORNIA 91436

**We Have Located Other Marks With This Owner**

NATIONWIDE INCORPORATORS THE PROFESSIONALS

USPTO

Page 19

**Manner Of Display:**

USED ON ADVERTISING BROCHURES, ON ADVERTISING LEAFLETS, ON BUSINESS CARDS, ON LETTERHEADS.

# Index

## A

- Abandoned marks
  - ability to use, 178–179
  - as defense in disputes, 247, 296
  - failure to police mark, 250–251
  - international registrations and, 358
  - licensing and danger of, 340
  - name choice and, 83
  - noncontrol of mark, 250
  - as option following final rejection, 236
  - presumption of (three-year), 249
  - types of, 178–179
  - and “use it or lose it” rule, 249
  - See also* Canceled marks
- Abandonment of application
  - express filing of, 235
  - failure to respond to PTO causing, 227, 230
  - intent-to-use application and, 235
  - as response to rejection, 234–235
  - trademark searches
    - uncovering, 178–179
  - types of abandonment, 235
- Acquired distinctiveness. *See* Secondary meaning
- Action letter, 227
- Actual use
  - defined, 190
  - international trademarks requiring, 354, 355
  - overview, 26
  - priority of use and, 293
  - proof of, 189–190
  - TESS report and, 138
  - See also* Intent-to-use application
- Advertising
  - authorized use of others’ marks in, 252
  - budget for, scope of trademark search and, 106
  - changing a mark and, 335, 342
  - comparative, as dilution defense, 315
  - Internet click-through revenue, 13–14, 57, 62
  - Internet keywords, 11, 66–67
  - logo choice and, 91
  - as specimen for registration, 198, 199, 200
  - See also* Marketing considerations
- Advertising agencies, 92
- Advertising injury coverage, insurance, 333
- AIPLA (American Intellectual Property Law Association), 365
- All About Trademarks, 34, 49, 360
- Allegation of Use for Intent-to-Use Application, 228, 236–237
- Alternative dispute resolution. *See* Dispute resolution alternatives
- Ambiguous geographic descriptors, 270
- American Arbitration Association, 343
- American Intellectual Property Law Association (AIPLA), 365
- Analytical searches, 98, 101–103, 110, 141–142
  - See also* Trademark searches
- Anti-cybersquatting Consumer Protection Act, 285, 318–320, 321
- Anti-trust laws, 247
- Applicant information on application, 212–213
  - technical rejections involving, 231
- Application. *See* Registration
- Arbitrary terms
  - assessment of strength, 262, 264–265
  - geographic terms as, 271
  - name choice and, 78, 81–82
- Arbitration, 342–344
  - ICANN domain name policy, 320–323
  - See also* Dispute resolution alternatives
- Assignment of marks
  - evaluation of search report showing, 181

- goodwill transferred with, 254
  - international marks, 354
  - process and form for, 253–255
  - purchasing rights to name, 342, 354
  - Section 8 and 15
    - Declarations and, 245
  - selling marks, as
    - negotiation strategy, 340–341, 342, 356–357
  - Association of Intellectual Property Law Attorneys, 345
  - Assumed name. *See* Fictitious business name
  - Attorney of record, 138
  - Attorneys
    - arbitration and, 343
    - for assignment of mark, 341
    - associations of trademarks attorneys, 365
    - for collective or certification marks, 19
    - for complaint against your mark, 350
    - for Declaration statement raising doubts, 222
    - defenses that require, 296
    - for dividing the application, 239
    - for exceptions to rules, 24
    - fees, postponement of, 329
    - fees, recovery of, 329
    - finding, characteristics needed, 366–370
    - finding, directory of, 363
    - for international trademarks, 354, 360
    - for international trademarks, U.S. based on previous, 217
    - mediation and, 345
    - need for, generally, 5
    - Nolo directory of, 363
    - opinion of, damages avoided through, 154
    - rejection responses by, 233
    - trademark searches and, 110, 111
    - uncertainty of dispute outcomes and, 154
  - Audio specimens, 202
  - Authorized uses of trademarks, 252
    - See also* Fair use; Use and protection of trademarks
- B**
- Bad faith. *See* Intent
  - Binding arbitration, 344
  - Blackout period, 236
  - Blurring of a famous mark, 29, 313–314
    - See also* Dilution
  - Book titles, 33, 52
  - Bridging the gap, 289
  - Business directories, 147
  - Business plan, scope of trademark search and, 106–109
  - Buying marks. *See* Purchasing marks
- C**
- Canada, registration in, 355
  - Canceled marks
    - ability to use, 178–179
    - failure to file Section 8 Declaration, 248
    - fraudulent application statements and, 220
    - Petition for Cancellation, 179
    - and use of ® symbol, 243
    - See also* Abandoned marks
  - Cases, finding. *See* Legal research
  - CASSIS CD-ROM, 113–114
  - Certificate of Registration, 253227
  - Certification marks, 18–19
  - Changing a mark, 302, 333–335, 341–342, 357
  - Classes. *See* International Classification of Goods and Services
  - Click-through revenue, 13–14, 57, 62
  - Coined terms
    - assessment of strength, 261–262, 264–265
    - name choice and, 79–80
  - Collective marks, 19
  - Colors, 20–21, 352
  - Commerce use
    - examples of, 192–193
    - first date of, on application form, 220
    - international registrations and, 354, 355
    - keywords and, 11
    - proof, need for, 193
    - as requirement, 191–192
    - as triggering trademark law, 17
    - See also* Actual use
  - Common law, 49
    - See also* Legal research; Trademark law
  - Common law search, 99, 103, 145–149
    - cost for professional service, 110
    - evaluation of, 183
  - Common terms. *See* Ordinary terms in trademarks

- Common words in Google search, 148
- Community Trademark method, 359
- Competition  
 cybersquatting by the, 322  
 likelihood of customer confusion and, 170  
 as strategy by infringers, 21–22
- Complaint, response to, 348–351
- Composites. *See under* Ordinary terms in trademarks
- Comprehensive trademark searches  
 cost of, 110  
 factors to consider in scope of, 106–109  
 overview, 103–104  
 strategy for utilizing professional service for, 109  
 uncertainty and, 104–105  
*See also* Trademark searches
- Conflicts. *See* Disputes
- Confusion. *See* Customer confusion
- Connotations, foreign words and, 88, 131–132
- Constructive use, 294  
*See also* Intent-to-use application
- Consumer confusion. *See* Customer confusion
- Consumer familiarity. *See* Secondary meaning
- Continuous use for five years  
 incontestable status, 245–247  
 secondary meaning presumed, 268
- Coordinated classes, 164
- Copyright, 50–51
- Corporate names  
 defined, 36  
 fictitious business names and, 40  
 registration of, 37–39, 42  
 searching for to avoid conflict, 145–149
- Costs  
 of arbitration, 344  
 of cybersquatting fight, 61, 323–324  
 of goods/services, likelihood of customer confusion and, 172  
 intent-to-use application, 195, 238  
 of litigation, 328–329, 331, 348  
 of litigation bluff, 341  
 of litigation, recovery of, 329  
 preliminary injunction, 331  
 professional name consultant, 92  
 professional search services, 110–111  
 for registration, 188, 204–205, 206, 208  
 for SAEGIS, 119, 141, 142, 143
- Counterfeit goods, 13, 288
- Counties, fictitious names and, 40
- Courts. *See* Litigation
- Customer base  
 criteria for name choice and, 90–92  
 likelihood of customer confusion and, 172–173
- Customer confusion  
 as ambiguous concept with no clear answers, 23–24, 154, 287  
 as central question, 28, 153–154, 284  
 counterfeit goods and, 288  
 cybersquatting and, 318, 319, 321  
 deceptive marks and, 87  
 distinctiveness and, 77–78  
 domain names and, 58, 64, 65  
 dual users of mark and, 27, 28  
 evaluation of. *See* Customer confusion, likelihood of  
 fair use defense and, 297  
 infringement disputes and, 284, 286–293  
 the internet and, 28, 170  
 literal geographic descriptors and, 269  
 overview, 28–29  
 reverse confusion, 292  
 similarity of goods/services. *See* Related goods/services, customer confusion and  
 trade dress and, 45  
 trademark searches to avoid, 96, 127–128  
 types of confusion, 155–157  
 weak marks and, 28–29, 76, 172
- Customer confusion, likelihood of, 155–174  
 as ambiguous concept, 154  
 attorney opinion and, 154  
 competing goods/services, 170  
 cost of goods or services and, 172  
 customer base, 172–173  
 feedback on, 171  
 golden rule and, 171

- “likelihood” as term, 155
  - multiple goods/services
    - by same mark owner, 173–174
  - overview of court evaluation criteria, 158–160
  - “reasonable” customers, 157–158
  - rejection of application for, 232, 234
  - relatedness. *See* Related goods/services
  - similarity of the marks, 170–171
  - strength of marks, 172
  - types of confusion, 155–157
  - See also* Customer confusion; Evaluation of trademark searches
  - Customer surveys, legal availability check prior to, 79
  - See also* Feedback
  - Cybersquatting
    - ACPA procedure, 318–320
    - arbitration and, 61
    - bad faith and, 318, 319, 322
    - buying domain held by, 61
    - click-through advertising and, 13–14, 57, 62
    - .com and other extensions, purchasing to protect against, 62
    - cost of fight, vs. purchasing domain, 61, 323–324
    - defenses to, summary of, 296–297
    - defined, 48, 317–318
    - evidence of, 60
    - ICANN procedure, 320–323, 325
    - jurisdiction and, 320, 321
    - law governing, 48, 285, 318–320
    - litigation and, 61
    - overview, 285, 317–318
    - in rem provisions, 320
    - right to use domain name, 59
    - typosquatting, 67
    - See also* Disputes
- D**
- Damages, 5, 23
    - attorney opinion and avoidance of, 154
    - attorneys’ fees paid by, 329
    - cybersquatting and, 318
    - dilution and, 316
    - failure to search and, 100, 115
    - failure to use © symbol and loss of, 242–243
    - registration as allowing, 33
    - trademark searches to avoid, 100
    - willfulness and, 100, 301, 302, 316, 329, 332
    - See also* Litigation
  - Date of filing. *See* Filing date
  - Date of first commerce use. *See* Commerce use
  - Date of registration, assigned marks referencing, 245
  - Date trademark first used
    - application form, 220
    - fraudulent statements of, 220
    - information gathering and, 188
    - by infringer, likelihood of litigation and, 175
    - intent-to-use and, 195
    - See also* Actual use; Commerce use; First-to-use rule; Priority of use
  - DBA, 40
  - Deadlines, demand for, 338
  - Dead/live label, 139
  - Dead marks. *See* Abandoned marks; Canceled marks
  - Deception
    - as defense for use of mark, 247
    - geographic terms and, 87
    - registration qualifications and, 193–194
    - as unfair competition, 269
    - as unprotected, 87, 269
    - website links and, 64–65
  - Deceptively misdescriptive terms, 87, 269
  - Declaration on application, 222
  - Declaratory judgment, avoiding, 338
  - Decor. *See* Trade dress
  - Descriptive marks
    - assessment of strength, 266–269
    - composite terms as, 279
    - deceptive misdescription, 87
    - as defense in disputes, 247, 296
    - defined, 265
    - name choice and, 75, 76
    - names to avoid and, 86
    - rejections based on, 232, 234, 236
    - See also* Ordinary terms in trademarks; Supplemental Register
  - Design marks
    - information on application, 214–215

- PTO codes for, 138, 143  
 searching for, 143  
*See also* Logos; Stylized marks
- Design of products. *See* Product design
- Design patent, 52
- Devices for identification.  
*See* Names; Trade dress
- DIALOG, 99
- Diligence required in application process, 228
- Dilution  
 blurring, 29, 313–314  
 defenses to, 315–316  
 defenses to, summary of, 296–297  
 defined, 29, 311  
 definition of “famous,” 311  
 distinctiveness and, 78  
 domain names and, 59  
 fanciful or arbitrary marks and, 262  
 law governing, 29–30, 48, 310–311  
 likelihood of, vs. proof, 312  
 noncommercial purposes and, 315, 316  
 overview, 310–311  
 parody and satire excluded and, 315  
 and personal names as trademarks, 85  
 relief for, 316–317  
 requirements to prove, 311  
 state laws and, 30, 48–49, 316  
 tarnishment, 29, 313, 314  
 trade dress and, 47  
*See also* Disputes
- Direct hit searches  
 cost for professional, 110  
 of Federal Register, as first rule, 106  
 overview, 100–101
- Disclaimed terms  
 ability to use, 180–181  
 fair use of, 268  
 in online applications, 225  
 overview, 225  
 rejections based on, 232  
 slogans and, 281–282
- Disparaging marks, 193–194
- Dispute resolution  
 alternatives  
 arbitration, 342–344  
 arbitration of domain names, 320–323  
 complaints against your mark and, 351  
 court mandated, 342  
 finding a lawyer open to, 370  
 mediation, 342, 345  
 overview, 342–343  
*See also* Infringement, dealing with
- Disputes  
 changing a mark in, 302, 333–335, 341–342, 357  
 defenses to, summary of, 296–297  
 multiple types of wrongful activity in, 285  
 overview of, 284–286  
 preserving rights if no actual conflict, 340  
 resolution of, typical, 291  
 types of. *See* Cybersquatting; Dilution; Infringement  
 uncertainty of outcomes, 154–155
- See also* Dispute resolution alternatives; Litigation; Negotiation
- Distinctiveness  
 acquired. *See* Secondary meaning  
 as ambiguous term, 23–24, 260–261  
 cleverness as central to, 78–79  
 cybersquatting and, 318, 319  
 dilution and, 312  
 domain names and, 63  
 fame and, 311–312  
 guidelines to achieve, 78–83  
 guidelines to assess, 261–265  
 identify distinctive portion of mark, 259  
 “inherent” defined, 44  
 intent-to-use and, 195  
 qualifying for Principal Register, 32  
 as strong and protectible, 25, 73, 77–78  
 and strong marks, evaluation of, 259–265  
 trade dress and, 14, 42–45  
 trademark searches and focus on, 127–128  
 unique names, qualities of, 73, 261–262
- Dividing the application, 238–239
- Domain names  
 already registered to someone else, 59–61  
 ambiguities in trademark law and choice of, 24  
 availability checking, 55  
 buying, 60–61, 323

- changing a mark and, 335
  - click-through revenue and, 13–14, 57, 62
  - .com and other extensions as unprotectible, 14, 200
  - .com and other extensions, purchasing additional, 62
  - .com vs. other extensions, in name choice, 62, 128–129
  - customer confusion and, 58, 64, 65
  - defined, 21, 54
  - dilution and, 59
  - fighting for, 61, 323–324
  - illegal registration of. *See* Cybersquatting
  - loss of, reasons for, 58–59
  - overview, 54
  - ownership information, checking, 55–56
  - personal names and, 84
  - registration of, 57–58, 199–200, 202–203
  - renewal of, 59
  - sharing, 61
  - specimen for registration, 199, 202–203
  - trademark conflicts with, 57–58
  - trademark protection traded for easy-to-remember, 61
  - trade name selection and checking of, 42
  - Web hosting of, 58
  - See also* Domain names and trademarks; Internet; Online resources; Web pages
  - Domain names and trademarks
    - dilution, 59
    - infringement, 59, 64, 294–295
    - no trademark guarantee, 63
    - overview, 62
    - personal names, 84
    - searching trademarks before choosing, 58, 128–129, 134, 295
  - Dual ownership, 27–28
- E**
- Electronic Trademark Assignment System (ETAS), 253
  - Enforcement. *See* Infringement, dealing with; Use and protection of trademark
  - Estoppel, 296, 297
  - ETAS (Electronic Trademark Assignment System), 253
  - European Union, registrations in, 358–359
  - Evaluation of trademark searches, 153–184
    - attorneys for, 110, 111, 154
    - customer confusion and. *See* Customer confusion, likelihood of
    - goals of, 153
    - history of litigation by owner, 174
    - intent of alleged infringer, 175
    - length of time used by alleged infringer, 175
    - report evaluation, 175–182
  - Examiner
    - approval by, 227–228
    - manual used by, 165–167
    - request for information from, 227, 229
    - See also* Rejections
  - Examiner’s Amendment, 177
  - Expansion
    - bridging the gap, 289
    - geographic terms and, 271
    - preserving right of, 340
    - right of, 168, 173–174
    - trademark searches in light of, 107
  - Extension of protection. *See* International registrations
- F**
- Fair use, 268, 296, 297, 352
  - False advertising, law governing, 48
  - Familiarity. *See* Secondary meaning
  - Famous marks
    - bridging the gap (expansion) and, 289
    - customer confusion not an issue for, 29, 30, 153
    - cybersquatting and, 320, 322
    - defined, 311
    - domain names and, 58, 59, 64
    - name choice and, 88
    - unrelated products and services and, 273–274
    - variation on, avoidance of, 88
    - See also* Dilution
  - Famous names
    - right of publicity, 273
    - in trademarks, 273–274
  - Fanciful terms
    - assessment of strength, 262, 264–265

- geographic terms as, 271
  - name choice and, 81
  - personal names as, 273
  - Federal law
    - attorneys' fees, recovery of, 329
    - basic concepts of, 22–24, 48
    - See also* Cybersquatting; Dilution; Infringement; Legal research; Registration
  - Federal Register. *See* Principal Register
  - Federal Trademark Dilution Act (FTDA), 29–30, 311
  - Feedback
    - on coined terms, 79
    - on complaints against your mark, 350
    - on customer confusion, 171
    - on suggestive terms, 79
    - See also* Attorneys
  - Fees. *See* Costs
  - Fictitious business names, 36, 39–40
  - Filing basis, 138, 215, 217
  - Filing date
    - for assignment (transfer of ownership), 245
    - earliest, 207–208
    - for intent-to-use, as first-use date, 195, 196, 235, 240
    - proof of (filing receipt), 224, 226
    - in TESS search results, 138
  - Filing Receipt for Trademark Application, 226
  - Film titles, 33, 52
  - Final rejections, 230, 235–236
  - Findlaw, 364
  - First-to-use rule
    - comprehensive trademark searches and, 103, 105
    - as defense for use of mark, 247
    - domain names and, 64
    - dual ownership and, 27
    - as key, 17
    - priorities among trademark users. *See* Priority of use
    - registration vs., 31–32
    - types of first use. *See* Actual use; Intent-to-use
    - application
    - See also* Date trademark first used
  - Flags, 194
  - Flavors, 21
  - Follow-up documents, 244–249
    - continuous use/incontestability status, 245–247
    - failure to file, and use of ® symbol, 243
    - file in name of current owner, 245
    - for intent-to-use application, 236–240
    - mark still in use, requirement of, 245
    - online filing, 244, 248
    - overview, 240, 244–245
    - renewal of trademark, 248–249
    - timeliness of filing, 247–248
  - Foreign registrations. *See* International registrations
  - Foreign words
    - name choice and, 83, 88, 131–132, 267
    - ordinary words not distinctive, 75
    - trademark searching for, 131–132
    - unintended meanings, 88, 356
  - Fraud
    - application statements, 220
    - as defense in dispute, 247, 297
    - intent required for, 10–11
    - See also* Deception
  - Free speech
    - as defense, 297
    - website commentary using trademarks, 65
  - Frequently asked questions, 3–8
  - Friends. *See* Feedback
  - FTDA. *See* Federal Trademark Dilution Act
  - Functional trade dress, 14, 21, 45–46, 47
- ## G
- General geographic descriptors, 270
  - Generic marks (genericide)
    - as defense in dispute, 296
    - incontestable status and, 246
    - prevention of becoming, 252–253, 267
  - Generic slogans, 281
  - Generic terms for underlying goods/services
    - assessment of strength, 275–277
    - avoidance of, 86, 87
    - .com addition not protectible, 14, 200

- competing uses of, and claim to likelihood of confusion, 13
  - defined, 72
  - disregarded in strength evaluations, 259
  - excluded from trademark registration, 72
  - included as part of trademark, 72–73
  - rejections based on, 232
  - suggestive terms vs., 80
  - See also* Disclaimed terms; Ordinary terms in trademarks
  - Geographic location, scope of trademark searches and, 107–108
  - Geographic marks
    - assessment of strength of, 269–271
    - defined, 265
    - expansion of business and, 271
    - name choice and, 86, 87, 194
    - types of, 269–270
  - Glossary of terms, 397–406
  - Good faith. *See* Intent
  - Goods and services
    - classes. *See* International classification
  - Goods and services
    - information on application, 215
    - technical rejections based on, 231–232
  - Goodwill
    - assignment of, 254
    - customer confusion rule and, 287
    - loss of, order to stop use of mark and, 23
    - loss of, preliminary injunction and, 330, 349
  - Google.com
    - click-through revenue and, 13–14, 57, 62
    - keyword controversy and, 11, 66–67
    - tips and tricks in searching with, 148–149
    - trademark searches using, 99, 146, 147–149
  - Graphic images. *See* Design marks; JPEG files; Logos; Stylized marks; Trade dress
- H**
- Homonyms (sound-alikes)
    - customer confusion and, 28
    - domain name choice and, 64
    - name choice and, 24
    - search for, 131
    - unfortunate, name choice and, 88
- I**
- ICANN
    - Cybersquatting procedure, 320–323
    - domain name availability, 55
    - odds of success under, 325
    - registration of domain names, 58
  - Immoral marks, 193–194
  - Incontestable status
    - filing to create, 245–246
    - reasons for failure of, 247
  - Indirect geographic descriptors, 270
  - Infringement
    - changing a mark, 302, 333–335, 341–342, 356–357
    - as competition strategy, 21–22
    - customer confusion and, 284, 286–293
    - dealing with complaint against your mark, 348–351
    - defenses to, summary of, 296–297
    - domain names and, 59, 64, 294–295
    - good faith/bad faith, 290–293, 332
    - junior user, 286
    - main issues underlying, 284
    - priorities and. *See* Priority of use
    - relatedness (similarity) of goods/services, 288–289
    - reverse confusion, 292
    - search engine keywords and question of, 11, 66–67
    - senior user, 286
    - willful, damages and, 100, 301, 302, 329, 332
    - See also* Disputes; Infringement, dealing with; Marketing territories, infringement and
  - Infringement, dealing with alternatives. *See* Dispute resolution alternatives
  - attorney consultation, 345–346

- discover registration and use status of opponent's mark, 336
- discover who is the infringer, 336
- let sleeping dogs lie, 338
- negotiation strategies, 341–342
- preserving rights if no actual conflict, 340
- research opponent's business, 33607
- threats or deadlines, 338, 341
- write a letter to infringer, 337–339, 341
- See also* Damages; Litigation; Negotiation
- Inherent distinctiveness, defined, 44
- Initials, 85–86
- In rem provisions, cybersquatting and, 320
- Insurance, litigation, 333
- Intent
- adoption of mark following rejection, 13
  - domain name conflicts and, 318, 319, 322
  - failure to trademark search and, 100, 114–115
  - fraud requiring, 10–11
  - likelihood of litigation and, 175
  - outcome of litigation and, generally, 290–293
  - of senior user, as defense, 297
  - willful, damages and, 100, 301, 302, 329, 332
- Intent-to-use (ITU) application, 194–196
- abandonment of application and, 235
- advantages of, 195, 196
- Allegation of Use for, 228, 236–237
- as constructive use, 294
- cost of, 195, 196, 238
- defined, 31
- dividing the application, 238–239
- evaluation of search report and, 181
- extension(s) to file Statement of Use, 239–240
- filing date as first-use date, 235, 240
- follow-up activity required for, 236–240
- online application and, 215, 219
- overview, 26, 188, 194–196
- requirement of actual intent to use, 12, 237
- specimens for, 237
- TESS report and, 138
- timeframes for, 236, 239–240
- weak marks not covered by, 195, 196
- See also* Registration
- International Classification of Goods and Services *Acceptable Identification of Goods and Services Manual*, 165–167
- adding a product or service, 3
- competitor classifications, 167–168
- coordinated classes, 164
- court vs. PTO interpretation of, 204
- examples of, 162–163
- finding the appropriate class, 163–169, 203–205
- as key information, 119
- listing of classes, complete, 371–395
- marketing channels and, 162, 164
- multiple class registration, 197, 204
- overview of, 161–163
- PTO assistance with, 169, 203–204
- right of expansion and, 168, 173–174
- searching for during TEAS application, 215
- technical rejections involving, 231–232
- TESS report and, 137–138
- See also* Marketing channels
- International Convention for the Protection of Industrial Property (Paris Convention), 359
- International languages. *See* Foreign words
- International registrations
- attorneys for, 354, 360
  - commerce-use requirement, 354, 355
  - Community Trademark method, 359
  - country-by-country basis, 355, 359–360
  - example of failure to register, 356–357
  - filing in U.S. based on, 217, 237

- for-profit registration of U.S. marks, 354
  - intent-to-use applicants in U.S., 237
  - Madrid Protocol system for, 358–359
  - Paris Convention and, 359–360
  - search engine keyword controversy and, 67
  - trademark searches, 355, 356
  - unintended meanings in names, 88, 356
  - where to seek protection, 355–357
  - International Trademark Association, 345, 365
  - Internet
    - changing a mark and, 335
    - customer confusion and, 28, 170
    - dual ownership of marks less likely due to, 28
    - litigation history
      - information on, 337
    - marketing channels and, 28, 270, 290
    - marketing on, trademark searches and, 105, 107
    - marketing territories and, 28, 107, 290, 304–305, 340
    - metadata and metatags, 65
    - search engine keywords controversy, 11, 66–67
    - specimen of services for registration, 199, 202–203
    - trademark search of, 97, 99, 146
    - website links, 64–65
  - See also* Domain names; ISP (Internet service provider); JPEG files; Online resources; Trademark searches; Web pages
  - InterNIC, 55, 58
  - ISP (Internet service provider)
    - liable for counterfeit goods sold from hosted websites, 13
    - website hosting, 58
  - ITU application. *See* Intent-to-use application
- J**
- JAMS-Endispute, 343
  - JPEG files
    - attachment of, 217
    - audio specimens and, 202
    - for mark information, 215
    - specifications for scanning, size, and color, 197, 215
    - for specimens, 197, 198–199, 202
  - Junior user, 286
- K**
- Keywords, 11, 66–67
- L**
- Labor law, 296
  - Laches, 296, 297
  - Lanham Act, 22, 31, 48, 366
  - Laudatory terms, 75, 265, 266–268
  - Law. *See* Trademark law
  - Law libraries. *See* Legal research
  - Lawyers. *See* Attorneys
  - Legal research
    - discussions by experts, 365–366
    - fear of, 362
    - on Internet, 363–364
    - Nolo assistance through website, 362
    - overview of approach to, 364
    - statutes, finding, 363–364, 366
    - See also* Attorneys
  - Letter to alleged infringer, 337–340
  - Liability insurance, for litigation, 333
  - Licensing a trademark, 251, 340
  - Linking websites, 64–65
  - Literal geographic descriptors, 269–270
  - Litigation
    - alternative dispute resolution mandated prior to, 342
    - beware of being right, 331
    - as bluff, 341
    - classification of goods/services, interpretation of, 204
    - costs of, 31, 328–329, 331, 348
    - costs of, recovering, 329
    - for cybersquatting, 61
    - history of, 174, 336–337
    - insurance for, 333
    - likelihood of, factors affecting, 174–175
    - names resembling famous marks and, 88
    - overview, 30–31
    - and policing of marks, requirement for, 251

- preliminary injunction, 330–331, 348–349
- registration advantages and, 33
- response to claim you infringed, 348–351
- settling, 331
- as threat, 338, 341
- tips for, 31
- for website use of trademarks, 65
- willfulness as issue, 332
- See also* Damages; Dispute resolution alternatives; Negotiation
- Local business, scope of trademark search and, 107–108
- Logical operators, TESS and, 125–127
- Logos
- authorized use of, 252
  - common terms combined with, 82–83
  - defined, 19–20
  - information on application, 214–215
  - marketing considerations for, 91
  - PTO classification of, 138, 143
  - and registration of multiple marks, 205–206
  - unauthorized use of, 295–296
- See also* Product design; Stylized marks; Trade dress
- Long-term goals, trademark searches and, 107–108
- M**
- Madrid Protocol, 358–359
- Mail, application by, 208, 236
- application specifics. *See* TEAS
  - intent-to-use followup, 240
  - See also* Registration
- Marketing channels
- classification of goods/services and, 162, 164
  - infringement disputes and, 289–290
  - and intent-to-use, proof of, 237
  - Internet and, 28, 170, 290
  - related goods/services and, 169–170
  - right of expansion and, 168, 173–174, 340
  - See also* International Classification of Goods and Services
- Marketing considerations
- coined terms and, 79–80
  - concepts of, in making name choice, 90–92
  - name choice and, 88–92
  - professional name consultant, 92
  - suggestive terms and, 80
  - trademark searches and size of market, 108–109
  - See also* Advertising
- Marketing territories, infringement disputes and changing definition of, 289–290
- Internet and, 28, 108, 290, 304–305, 340
  - negotiation of territory, 341–342
  - priority of use and, 299–303, 304–305, 307–310
  - remoteness factor and, 291
- Marksonline, 34
- Marks, types of, 18–19
- See also* Trademarks
- Mediation, 342–343, 345
- See also* Dispute resolution alternatives
- Mediation Information and Resource Center, 345
- Metadata and metatags, 65
- Mexico, registration in, 355
- Misuse of trademark, 296
- Money damages. *See* Damages
- Movie titles, 33, 52
- MP3 files for audio specimens, 202
- Music, 12
- N**
- Naked licenses, 251
- Name choice
- abandoned marks and, 83
  - and ambiguities in trademark law, overview of, 24
  - arbitrary. *See* Arbitrary terms
  - coined terms. *See* Coined terms
  - common terms and. *See* Ordinary terms in trademarks
  - criteria for, 88–89
  - descriptive. *See* Descriptive marks
  - distinctiveness in, guidelines for, 78–83
  - fanciful. *See* Fanciful terms

- foreign words, 83, 88, 267
  - marketing considerations
    - in, 88–92
  - methods for choosing, 89–90
  - parts of different words, 79–80, 83
  - sources for finding, 83
  - suggestive vs. descriptive, 80
  - unique names, qualities of, 73, 261–262
  - See also* Disclaimed terms; Names to avoid; Trademark searches
  - Name consultants, 80, 92
  - Names
    - additional devices to trademark, 19–21
    - changing, in dispute resolution, 302, 333–335, 341–342, 357
    - importance of, 17
    - See also* Domain names; Famous names; Name choice; Name consultants; Names to avoid; Personal names; Trade names
  - Names to avoid
    - bad translations, homonyms, or connotations, 88
    - descriptive terms for type of product or service, 86
    - geographic location, 86, 87, 194
    - personal names, 84–86, 194
    - registration requirements on, 193–194
    - variations of famous marks, 88, 93
  - See also* Trademark searches
  - Negotiation
    - arbitration or mediation as structured form of, 343
    - benefits of, 332
    - complaints against your mark and, 348, 351
    - initiating, 332–333
    - process of, 340–341
    - questions to answer prior to, 333
    - strategies for, 341–342
    - as typical dispute resolution, 291
  - Network Solutions, 56
  - News reporting, as dilution defense, 316
  - Niche fame, 311
  - Noncommercial uses
    - as cybersquatting defense, 321
    - as dilution defense, 315, 316
  - Nonprofits, fictitious business names and, 40
  - Notice of Allowance, 195, 236
  - Notice of Publication, 227
  - Numbers, searching for range of, 148
- O**
- Objection by examiner
    - evaluation of search report and, 178–179
    - See also* Rejections
  - Odors, 21
  - Office for Harmonization of the Internal Market, 359
  - Official Gazette* (USPTO), 121–122, 227
  - Online resources
    - arbitrators, finding, 343
    - attorneys, finding, 370
    - classification of goods/services, 165–168
    - cybersquatting arbitration, 61
    - cybersquatting ICANN procedure, 323, 325
    - domain brokering services, 61
    - domain name registration, 54–55, 57–58
    - domain owner information, 55–56
    - ETAS (Electronic Trademark Assignment System), 253
    - Harvard Cyber Law, 325
    - ICANN, 323
    - international registrations, 358, 359, 360
    - international trademark searching, 355, 356
    - law resources, list of, 363–364
    - legal research, 363–364
    - mediators, finding, 345
    - name consultant, 92
    - Nolo trademark resources, 362–363
    - professional trademark searches, 112–113
    - PTO, 363–364
    - PTO automated response system, 234
    - SAEGIS (searches), 98
    - state dilution statutes, 317
    - state trademark information, 34, 49
    - state trade name registration, 38

- TARR (status checks), 226–227
- TEAS (applications), 208
- TESS (searches), 120
- trademark searches, 98, 99, 143
- trade name searches, 99, 146
- websites and trademarks, information on, 64
- See also* Domain names; Internet; Web pages
- Opposition, published for, 138, 227
- Ordinary terms in trademarks
- assessment of strength, 265–275
  - composites of elements of words, 79–80, 83, 280
  - composites of whole words, 74, 78–79, 82, 83, 277–279
  - fair use of, 268, 297
  - most not protected, 74–75, 76
  - with novel designs, 82–83
  - overview, 74, 265–266
  - rejections for, 232, 234, 236
  - secondary meaning and, 75–76, 266, 268, 269, 272
  - unfair competition laws and, 78, 268
  - widely recognized marks protected, 75–76
- See also* Disclaimed terms; Generic terms for underlying goods/services; Supplemental Register
- P**
- Packaging. *See* Trade dress
- Paris Convention, 359–360
- Parody
- as defense, 12–13, 297
  - and dilution, 315
- Partnerships
- assignment of trademarks and, 255
  - fictitious business names and types of, 40
- Patent and Trademark Depository Libraries (PTDLs), 97
- as choice for search, 113–114
  - common law search in, 99
- Patent and Trademark Office. *See* PTO
- Patents
- design, 52
  - distinguished from trademarks, 51–52
  - utility, 47, 51
- Pending applications
- appearance in trademark database, 207
  - evaluation of trademark search and, 181
  - no registration number, 138
  - search of, 97
  - status of application, checking, 227, 228
  - status of mark, trademark searches and, 139–140
  - word mark and, 137
- Perl Foundation, 93
- Personal names
- as defense for use of mark, 247
  - domain names and, 84
  - initials, 85–86
  - selling business with, 84, 85
  - trademarks and, 84–86, 265, 271–275
  - trade names and, 39
  - unauthorized marks using, 194, 274–275
- Petition for Cancellation, 179
- Petition to the Director, 236
- Photographs, of specimens, 198–199
- See also* JPEG files
- Phrases. *See* Slogans
- Piggybacking, avoidance of, 24
- Plays, titles of, 33
- Policing a mark, 30, 250–251, 340
- Praise, terms with, 75, 265, 266–268
- Preliminary injunction, 14, 330–331, 348–349
- Presumption of abandonment, 249
- Presumption of ownership, registration providing, 33, 187
- Principal Register
- benefits of placement on, 33
  - information found on, 32
  - marks on Supplemental Register moved to, 34
  - qualification for placement on, 32–33, 189
  - timeframe for listing, 98
  - trademark search of, 97, 98, *See also* SAEGIS; TESS
  - See also* Supplemental Register
- Priority of use, 293–310
- definitions of “use,” 293

- nationwide, registration providing, 11–12
- questions to answer in determining, 298
- registered mark conflicts with another registered mark, 305–306
- registered mark conflicts with an unregistered mark, 307–310
- unregistered mark conflicts with another unregistered mark, 303–305
- unregistered mark conflicts with a registered mark, 298–303
- Product design
- defenses in disputes of, 297
  - design patents, 52
  - distinctiveness and, 42–45
  - ordinary terms with novel designs, 82–83
  - as subcategory of trade dress, 42
  - See also* Trade dress
- Product expansion. *See* Expansion
- Product shape. *See* Trade dress
- Professional name consultant, 80, 92
- Professional search reports, 175–182
- common law search, 183
  - conclusions, 184
  - evaluation method, 176–177
  - example of, 407–428
  - federal search, 177–182
  - goals of, 176
  - no guarantees, meaning of, 176
  - state search, 182–183
- Professional search services, 109–113
- aggressive marketing techniques of, 112
  - attorneys and, 110, 111
  - cost of, 110–111
  - finding, 111–113
  - international registrations, 356
  - no guarantees, meaning of, 176
  - reasons for using, 109–110
  - strategy for utilizing, 109
  - vs. do-it-yourself, 101, 102, 104
  - See also* Professional search reports
- Protection of trademark. *See* Use and protection of trademark
- PTDLs. *See* Patent and Trademark Depository Libraries (PTDLs)
- PTO (U.S. Patent and Trademark Office)
- application database. *See* TEAS
  - application file database (TDR), 120
  - application status database (TARR), 120, 139–140, 226–227
  - classification of goods/services help from, 169, 203–204
  - design classification codes, 138, 143
  - Electronic Trademark Assignment System (ETAS), 253
  - information requests from, 225–226
  - lists of. *See* Principal Register; Supplemental Register
  - Official Gazette*, search of, 121–122
  - status of applications, checking on, 225, 227
  - telephone number, 169
  - trademark database of. *See* TESS
  - website, 363–364
  - See also* International Classification of Goods and Services; Registration Publications, trademark search of, 97
- Publicity, right of, 273
- Published for opposition, 138, 227
- Purchasing names
- domain names, 60–61, 323, 324
  - trademarks, 342, 354
- ## Q
- Quality, tarnishment as injury to reputation for, 313, 314
- ## R
- Reasonable customers, meaning of, 157–158
- Recordation Form Cover Sheet, 253
- Recordings, titles of, 33
- ® Symbol
- canceled registration and use of, 243
  - specimens should not contain, 200
  - use of, 188–189
  - verbal equivalent to, 243
- Registration number, 138

- Registration of domain names, 58–59, 199–200, 202–203  
*See also* Cybersquatting
- Registration of marks  
 benefits of, 5, 31–33, 187  
 Certificate of Registration, 227  
 class. *See* International Classification of Goods and Services  
 consistency and accuracy required in, 215, 219, 237  
 costs, 188, 205–206, 206, 208  
 date of filing. *See* Filing date  
 as dilution defense, 316  
 first-to-use rule vs., 31–32  
 follow-up required. *See* Follow-up documents  
 foreign registration, filing based on, 217  
 fraudulent statements and, 220  
 lists for. *See* Principal Register; Supplemental Register  
 by mail, 208, 226–227  
 of multiple marks, 205–206  
 Nolo website assistance with, 362–363  
 not yet in use. *See* Intent-to-use application  
 online. *See* TEAS  
 overview of, 188–189  
 paper form, as disfavored, 8, 208  
 as presumption of ownership, 33, 187  
 published for opposition, 227  
 qualifications for, 32–33, 189–194,  
*See also* Actual use;  
 Commerce use; Customer confusion, likelihood of;  
 Distinctiveness  
 receipt for filing, 224, 225  
 specimen of mark required, 197–203  
 state, 34, 49  
 state, trademark search of, 97, 98–99, 144–145, 182–183  
 status of application, checking on, 225–227  
 timeframes for. *See* Timeframes  
 of trade dress, 45, 47  
*See also* Abandonment of application; Canceled marks; Pending applications; Rejections; Unregistered marks
- Registration of trade names, 36–40
- Rejections  
 abandonment of application, 234–235  
 alternatives following final rejection, 235–236  
 attorney responding to, 233  
 final, 230, 235–236  
 overview, 230  
 process for resolving, 231, 234  
 responding to, 231–233  
 subsequent use of rejected marks, as bad faith, 13  
 substantive, 230, 232  
 technical, 230, 231–232
- Related goods/services, customer confusion and bridging the gap (expansion) and, 289  
 classes. *See* International Classification of Goods and Services  
 infringement disputes and, 288  
 Internet and, 170  
 marketing channel similarities and, 169–170  
 overview, 29, 158–160  
 right of expansion and. *See* Expansion  
 similar goods/services vs. class, importance of, 181–182
- Remoteness factor, 291
- Renewal of domain name, 59
- Renewal of trademark, 248–249, 254
- Research. *See* Legal research; Trademark searches
- Reverse confusion, 292
- Right, beware of being, 331
- Right of expansion. *See* Expansion
- Right of publicity, 273
- S**
- SAEGIS search engine, 141–143  
 and analytical searches, generally, 103  
 common law searches, 99  
 costs for, 119, 131, 142, 143  
 domain name searches, 99  
 getting started with, 141–143  
 help file for, 141

- index browsing, 142–143
- information given by, 119
- state registration searches through, 99
- in strategy for using professional search service, 109
- TrademarkScan Autoquery, 141–142
- TrademarkScan Custom Search, 142, 143
- use TESS first, 98
- Sale of business
  - assignment document in, 254
  - personal names and, 84, 85
- Sale of marks. *See* Assignment of marks
- Satire, and dilution, 315
- Scandalous marks, 193–194
- Scanning requirements for JPEGs, 197, 215
- Search engines and keywords, 11, 66–67
- Searches. *See* Professional search services; Trademark searches
- Secondary meaning (acquired distinctiveness), 25
  - deceptively misdescriptive marks and, 87, 269
  - defined, 23, 44
  - drawbacks to dependence on, 76
  - geographic terms and, 87
  - ordinary terms and, 75–76, 266, 268, 269, 272
  - personal names and, 85, 86, 272
  - presumption of, timeframe for, 268
  - slogans and, 281
  - trade dress and, 44–45
    - See also* Distinctiveness
- Section 8 and 15 Declarations
  - cost of filing, 247–248, 249
  - failure to file, and use of ® symbol, 243
  - file in name of current owner, 245
  - incontestability status (Section 15), 245–247
  - mark still in use, requirement of, 245
  - online (TEAS), 244, 248
  - overview, 244–245
  - renewal of marks (Sections 8 and 9), 248–249, 254
  - timeliness of filing, 247
- Section 9 (renewal application), 248–249
- Senior user, 286
- Serial number of application, 138, 224, 226
- Series titles, 33, 52
- SERION, 98, 103
- Service marks
  - defined, 18
  - legal conflict with trademark, 138
  - <sup>SM</sup> symbol, 244
  - specimen for, 201–203
  - as term in book, 19
  - for unregistered marks, 244
    - See also* Trademarks
- Shape of product. *See* Trade dress
- Signature on application, 221, 222–223
- Similarity of goods. *See* Related goods/services, customer confusion and
- Similarity of marks. *See* Customer confusion
- Sleeping on your rights, 175
- Slogans (phrases)
  - evaluation of, 82, 280–282
  - generic, 281
  - as protectible, 20
  - searching for, 129, 148–149
  - tips for selecting, 282
- Sole proprietorships, fictitious names and, 40
- Songs, 12
- Sound-alikes. *See* Homonyms
- Sounds, 14
- Specimen of marks, requirement for
  - attachment of, 217, 219
  - consistency and accuracy for, 215, 219, 237
  - description of, 219
  - domain names, 200–201
  - goods, 197–201
  - services, 201–203
  - submission requirements, 197, 214–215
  - unacceptable specimens, 200–201, 203
    - See also* JPEG files
- Spelling, of common terms, 75, 267
- State law
  - attorneys' fees, recovery of, 328–329
  - conflicts between unregistered marks and, 303–304

- dilution, 30, 48–49, 316, 317
- fictitious business name, 39–40
- labor laws, 296
- overview, 48–49
- registration of trademarks, 34, 49
- registration of trade names, 37–40
- registration, trademark search of, 97, 98–99, 144–145, 182–183  
*See also* Unfair competition
- Status, incontestable, 245–247
- Status of application, 227, 228
- Strong marks  
customer confusion and, 172
- direct hit searches to help evaluate, 100–101
- distinctiveness and, 25, 73, 77–78
- geographic marks as, 271
- overall impression key to evaluation of, 82, 83, 259
- overview, 25
- scope of trademark search and, 106–107
- tests for, 258  
*See also* Secondary meaning; Strong marks, evaluation for
- Strong marks, evaluation for composite terms, 277–280
- distinctiveness, 259–265
- generic labels, 275–277
- ordinary marks, 265–275
- slogans (phrases), 280–282
- tests for, 258
- Stylized marks  
authorized use of, 252
- JPEG preparation of, 214–215
- multiple mark registration and, 205–206
- online application for, 214–215
- ordinary terms combined with, 82–83
- unauthorized use of, 352  
*See also* Trade dress
- Substantive rejections, 230
- Suggestive marks  
assessment of strength, 263–265
- name choice and, 80
- Suits. *See* Litigation
- SuperPages, 99, 146
- Supplemental Register  
benefits of placement on, 34
- importance of marks on, 179–180
- information contained on, 32
- marks moved from, to Principle Register, 34, 179–180
- request for, following rejection, 236
- Surveys. *See* Customer surveys; Feedback
- Suspension of the application, 236
- Syllables, trademark searches for, 128
- Synonyms, Google search for, 148
- T**
- Tarnishment of a famous mark, 29, 313, 314  
*See also* Dilution
- TARR (Trademark Application and Registration Retrieval), 120, 139–140, 225–226
- TDR (Trademark Document Retrieval), 120
- TEAS (Trademark Electronic Application System)  
Allegation of Use on, 237
- applicant information, 212–213
- audio specimens, submission of, 202
- consistency and accuracy required, 215, 219
- date of filing, 207
- date of first use anywhere, 220
- date of first use in commerce, 220
- Declaration, 222
- disclaimers, 225
- dividing the application, 239
- email receipt for submission, 224
- as favored method, 8, 208
- fee and payment, 222, 224
- filing basis, 215, 217
- filling out the form, 208–225
- fraudulent statements, 220
- goods and/or services information, 215
- help system, 211
- mark information, 213–215
- overview, 120, 207

- renewal (Section 9) and Section 8 Declaration, 248–249
- Section 8 and 15 Declarations, 244, 248
- signature, 221, 222–223
- specimen, 217, 219
- TEAS Plus form, 208, 211
- timeframes for registration, 207
- validation, 223–224
- Technical rejections, 230, 231–232
- Telephone assistance
  - automated status check, 227
  - on classification of goods/services, 169, 204
  - status check, 227
- Telephone directories, search of, 146
- Temporary injunction. *See* Preliminary injunction
- TESS (Trademark Electronic Search Service), 119–139
  - analytical searches on, 102
  - classification of goods/services, 167–168
  - dictionary, browsing, 122–123
  - direct hit searches on, 101
  - distinctive part of mark, focus on, 127–128
  - distinctive syllables, 128
  - domain names, 128–129
  - example search, 132–134
  - field, 125
  - field codes, 136
  - foreign translations, 131–132
  - free form search, 134–136
  - as free resource, 98, 101
  - getting started with, 120–123
  - help file for, 120
  - information given by, 119
  - logical operators, 125–127
  - new user form search, 121
  - overview, 119–120
  - phrases, 129
  - plurals, 124
  - records returned, 124
  - saving searches, 134
  - search history, 123–124
  - search terms, 124, 135–136
  - sound-alikes, search for, 131
  - status of mark, determining, 139
  - in strategy prior to using professional service, 109
  - structured form search, 123–134
  - timed out by, 134
  - time required to obtain searches, 119
  - truncation feature, 129–130
  - type of search, choosing, 121–122
  - understanding results of, 137–139
  - wildcards, 131
- Testing ideas. *See* Feedback
- Thomas Register of Products and Services, 99
- Thomson CompuMark, 113
- Threat of litigation, 338, 341
- Timeframes
  - arbitration, 344
  - for follow-up (Sections 8 and 15), 247–248
  - for follow-up to intent-to-use, 236, 239–240
  - for registration application, 207, 225, 228
  - for renewal (Section 9 and Section 8), 248–249
  - See also headings at* Date
- Titles of books and movies, 52
- Trade associations and directories, 146
- Trade dress
  - consumer confusion and, 45
  - defenses in disputes of, 297
  - defined, 20, 42–43
  - dilution and, 47
  - distinctiveness and, 14, 43–46
  - functional, 21, 45–46, 47
  - importance of, 17
  - as protectible, 19–21
  - registration vs. first-use of, 45, 47
  - See also* Logos; Names; Product design
- Trade label, law governing, 48
- Trademark Application and Registration Retrieval (TARR), 120, 139–140, 226–227
- Trademark Assistance Center, 169, 227
- Trademark Blog (Schwimmer), 364
- Trademark Dilution Revision Act (2006), 29–30, 47, 311, 313, 314, 315
- Trademark disputes. *See* Disputes
- Trademark Document Retrieval (TDR), 120

- Trademark Electronic Application System. *See* TEAS
- Trademark Electronic Search System. *See* TESS
- Trademark Express, 113
- Trademarkia, 143
- Trademark law  
 ambiguities in, rules for addressing, 23–24  
 overview, 22–24  
 research. *See* Legal research  
 sources of. *See* Common law; Federal law; State law  
 summary of changes in, since last edition of book, 10–14  
*See also* Abandoned marks; Assignment of marks; Canceled marks; Cybersquatting; Dilution; Infringement; International registrations; Registration of marks; Unfair competition
- Trademark licensing, 251, 340
- Trademark misuse, 296
- Trademarks  
 copyright distinguished from, 50–51  
 defined, 18  
 licensing of, 251, 340  
 patents distinguished from, 51–52  
 as term in book, 19  
 trade names distinguished from, 35, 41–42, 203  
*See also* Disputes; Domain names and trademarks; Names; Trade dress; Trademark law; Trademark searches; Unregistered marks
- TrademarkScan State Database, 99, 141–142
- Trademark searches  
 analytical searches, 98, 101–103, 110, 141–142  
 comprehensive. *See* Comprehensive trademark searches  
 defined, 96  
 design marks, 143  
 direct hit. *See* Direct hit searches  
 distinctiveness and, 127–128  
 domain names and, 58, 128–129, 134, 295  
 failure to search, bad faith and, 100, 114–115  
 of Federal Register, 97, 98, *See also* SAEGIS; TESS  
 foreign translations, 131–132  
 homonyms (sound-alikes), 131  
 for international registrations, 355, 356  
 legal uncertainty persisting, 104–105, 144  
 levels of, 100–104  
 phrases, 129  
 priority-of-use questions and, 298  
 in PTDLs, 113–114  
 reasons for, 4, 96  
 resources used in, 97  
 scope of search, guidelines to plan, 105–109, 112  
 state registered trademarks and trade names, 97, 98–99, 144–145, 182–183
- of unregistered marks. *See* Common law search variations on terms, 129–130  
*See also* Evaluation of trademark searches; Professional search reports; Professional search services
- ™ Symbol  
 specimens and, 200  
 with unregistered marks, 244  
 use of, 242–243
- Trademark Trial and Appeal Board (TTAB), 235
- Trade names  
 corporate. *See* Corporate names  
 defined, 37  
 distinguished from trademark, 35, 41–42, 203  
 fictitious business name, 36, 39–40  
 online resources for searching of, 99, 146  
 registration of, 37–40  
 searching for, to avoid trademark conflict, 145–149
- TRAM (Trademark Reporting and Monitoring), 227
- Transfer of ownership. *See* Assignment of marks
- TTAB (Trademark Trial and Appeal Board), 235, 364
- Typefaces. *See* Stylized marks

## U

Unauthorized marks, 193–194

Unauthorized use of famous name, 273

Unclean hands, as defense, 296, 297

Underlying goods/services. *See* Generic terms for underlying good/services

Unfair competition conflicts between unregistered marks and, 303–304

deceptive marks as, 269

defined, 22

ordinary terms in trademarks and, 78, 268

and personal names as trademarks, 86

state laws on, 49

Uniform Domain Name Dispute Resolution Policy (UDRP), 320–323, 325

Unique names

qualities of, 73, 261–262

*See also* Distinctiveness

Unregistered marks

benefits of registration vs., 31–32

continued use of, following rejection, 234

dead marks still being used as, 179

federal law protecting, 48

infringement disputes involving, 298–303, 303–305

trade dress, 45, 47

trademark search of. *See* Common law search

unfair competition law and, 303–304

use of <sup>TM</sup> and <sup>SM</sup> symbols with, 244

*See also* First-to-use rule; Priority of use

Use and protection of marks assignment. *See* Assignment of marks

authorized uses, 252

controlling the mark, 250–252

genericide, prevention of, 252–253, 267

licensing, 251, 340

nonuse, permitted, 249

policing the mark, 30, 250–251, 340

® symbol, 200, 242–243

renewal (Section 9) and Section 8 Declaration, 248–249, 254

<sup>TM</sup> and <sup>SM</sup> symbols, 244

use it or lose it, 249

*See also* Disputes; Section 8 and 15 Declarations

Use of trademarks. *See* Actual use; Commerce use; Constructive use; First-to-use rule; Priority of use

U.S. Patent and Trademark Office. *See* PTO

Utility patent, 47, 51

## V

Validation of application, 223–224

## W

WAV files as specimens, 202

Weak marks

becoming protectible. *See* Secondary meaning

customer confusion and, 28–29, 76, 172

intent-to-use not available for, 195

overview, 25

unfair competition laws protecting, 78

*See also* Distinctiveness; Strong marks; Supplemental Register

Web pages

specimen of, for registration, 199–200, 202–203

as trademark, 20

Websites. *See* Domain names; Internet; Online resources

WHOIS records, 55–56

Willfulness, damages and, 100, 301, 302, 329, 332

World Intellectual Property Organization (WIPO) website, 358



# Online Legal Forms

Nolo offers a large library of legal solutions and forms, created by Nolo's in-house legal staff. These reliable documents can be prepared in minutes.

## Create a Document

- **Incorporation.** Incorporate your business in any state.
- **LLC Formations.** Gain asset protection and pass-through tax status in any state.
- **Wills.** Nolo has helped people make over 2 million wills. Is it time to make or revise yours?
- **Living Trust (avoid probate).** Plan now to save your family the cost, delays, and hassle of probate.
- **Trademark.** Protect the name of your business or product.
- **Provisional Patent.** Preserve your rights under patent law and claim "patent pending" status.

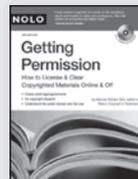
## Download a Legal Form

Nolo.com has hundreds of top quality [legal forms](#) available for download—bills of sale, promissory notes, nondisclosure agreements, LLC operating agreements, corporate minutes, commercial lease and sublease, motor vehicle bill of sale, consignment agreements and many, many more.

## Review Your Documents

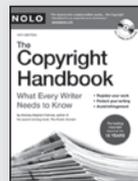
Many lawyers in Nolo's consumer-friendly [lawyer directory](#) will review Nolo documents for a very reasonable fee. Check their detailed profiles at [www.nolo.com/lawyers/index.html](http://www.nolo.com/lawyers/index.html).

## Nolo's Bestselling Books



### Getting Permission

How to License & Clear Copyrighted Materials Online & Off  
\$34.99



### The Copyright Handbook

What Every Writer Needs to Know  
\$34.99



### Patent, Copyright & Trademark

An Intellectual Property Desk Reference  
\$39.99



### Patent It Yourself

\$49.99

*Every Nolo title is available in print and for download at Nolo.com.*

## Find a Quality Attorney



- *Qualified lawyers*
- *In-depth profiles*
- *A pledge of respectful service*

When you want help with a serious legal problem, you don't want just any lawyer—you want an expert in the field who can give you and your family up-to-the-minute advice. You need a lawyer who has the experience and knowledge to answer your questions about personal injury, wills, family law, child custody, drafting a patent application or any other specialized legal area you are concerned with.

**Nolo's Lawyer Directory** is unique because it provides an extensive profile of every lawyer. You'll learn about not only each lawyer's education, professional history, legal specialties, credentials and fees, but also about their philosophy of practicing law and how they like to work with clients.

All lawyers listed in Nolo's directory are in good standing with their state bar association. Many will review Nolo documents, such as a will or living trust, for a fixed fee. They all pledge to work diligently and respectfully with clients—communicating regularly, providing a written agreement about how legal matters will be handled, sending clear and detailed bills and more.

1

Go to [Nolo.com/newsletters/index.html](http://Nolo.com/newsletters/index.html) to sign up for free [newsletters and discounts](#) on Nolo products.

- **Nolo Briefs.** Our monthly email newsletter with great deals and free information.
- **Nolo's Special Offer.** A monthly newsletter with the biggest Nolo discounts around.
- **BizBriefs.** Tips and discounts on Nolo products for business owners and managers.
- **Landlord's Quarterly.** Deals and free tips just for landlords and property managers, too.

2

Don't forget to check for [updates at Nolo.com](#). Under "Products," find [this book](#) and click "Legal Updates."

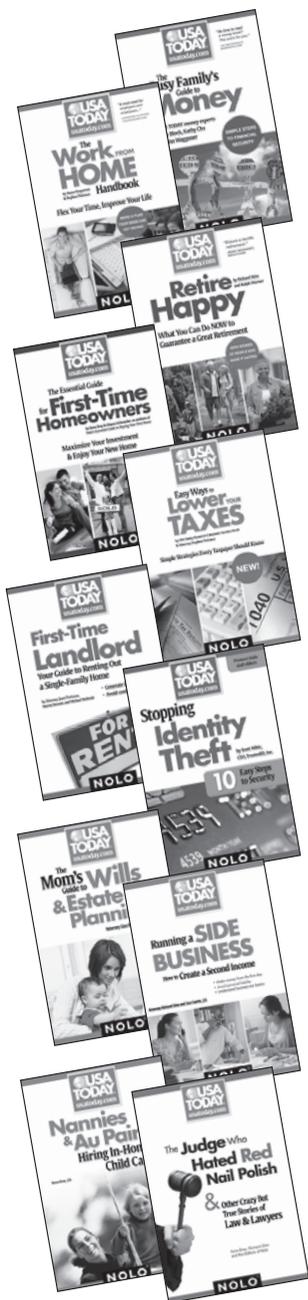
### *Let Us Hear From You*

3

Comments on this book? We want to hear 'em. Email us at [feedback@nolo.com](mailto:feedback@nolo.com).

# NOLO<sup>®</sup> and USA TODAY

Cutting-Edge Content, Unparalleled Expertise



## The Busy Family's Guide to Money

by Sandra Block, Kathy Chu & John Waggoner • \$19.99

## The Work From Home Handbook

*Flex Your Time, Improve Your Life*

by Diana Fitzpatrick & Stephen Fishman • \$19.99

## Retire Happy

*What You Can Do NOW to Guarantee a Great Retirement*

by Richard Stim & Ralph Warner • \$19.99

## The Essential Guide for First-Time Homeowners

*Maximize Your Investment & Enjoy Your New Home*

by Ilona Bray & Alayna Schroeder • \$19.99

## Easy Ways to Lower Your Taxes

*Simple Strategies Every Taxpayer Should Know*

by Sandra Block & Stephen Fishman • \$19.99

## First-Time Landlord

*Your Guide to Renting Out a Single-Family Home*

by Attorney Janet Portman, Marcia Stewart & Michael Molinski • \$19.99

## Stopping Identity Theft

*10 Easy Steps to Security*

by Scott Mitic, CEO, TrustedID, Inc. • \$19.99

## The Mom's Guide to Wills & Estate Planning

by Attorney Liza Hanks • \$21.99

## Running a Side Business

*How to Create a Second Income*

by Attorneys Richard Stim & Lisa Guerin • \$21.99

## Nannies and Au Pairs

*Hiring In-Home Child Care*

by Ilona Bray, J.D. • \$19.99

## The Judge Who Hated Red Nail Polish

*& Other Crazy But True Stories of Law and Lawyers*

by Ilona Bray, Richard Stim & the Editors of Nolo • \$19.99

ORDER ANYTIME AT [WWW.NOLO.COM](http://WWW.NOLO.COM) OR CALL 800-728-3555

Prices subject to change.

## About the Authors

**Stephen Elias** received a law degree from Hastings College of the Law in 1969. He practiced in California, New York, and Vermont until 1980, when he decided to make a full-time career of helping nonlawyers understand and use the law. Steve has written and edited over 30 books for Nolo, including eight books on intellectual property law. Steve is now working as general counsel for the National Self-Help Law Project in Lakeport, California, and cohosts a radio talk show with his wife, Catherine.

**Richard Stim** is a Nolo editor and author who has practiced copyright and trademark law for over 25 years. Rich also supervises [Nolo's podcast series](#) at [www.nolocast.com](http://www.nolocast.com) and writes the "[Dear Rich](#)" blog that provides answers to copyright and trademark questions.

