

What is a Trademark?

A trademark is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others. A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product. The terms "trademark" and "mark" refer to both trademarks and service marks.

Registration does not establish rights in a mark. You establish rights in a mark based on legitimate use of the mark in commerce. However, owning a federal trademark registration provides several advantages. Registration provides constructive notice to the public of the registrant's claim of ownership of the mark and creates a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration. Additionally, registration establishes the ability to bring an action concerning the mark in federal court, to use the U.S. registration as a basis to obtain registration in foreign countries, and to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

A trademark owner does not need to have used the mark before filing an application for federal registration. If you plan to use the mark in the future, you may file based on a good faith or bona fide intention to use the mark in commerce. If you file based on an intent to use, you must begin actual use of the mark in commerce before the United States Patent and Trademark Office ("USPTO") will register the mark; that is, you will later be required to file a form to establish that use has begun. You may also base your application on foreign-based applications or registrations.

After an application is filed at the USPTO, the assigned examining attorney will make his or her initial determination of

whether the mark is registerable. Included in this determination is a search of USPTO records to determine if a "likelihood of confusion" exists between the mark in the application and another mark that is registered or pending in the USPTO. A likelihood of confusion is the primary concern of U.S. trademark law and policy. Consumer protection, namely the avoidance of confusion, is the driving goal of trademark law. The principal factors considered by the examining attorney in determining whether there would be a likelihood of confusion are the similarity of the marks and the commercial relationship between the goods and/or the services listed in the application. To find a conflict, the marks do not have to be identical, and the goods and/or services do not have to be the same. It may be enough that the marks are similar and the goods and/or services are related. In addition to likelihood of confusion, registration may be refused on other grounds. The most common grounds include a finding that the mark is merely descriptive or deceptively misdescriptive of the goods/services, either geographically or product related.

Various symbols associated with marks are employed to designate different meanings. Any time you claim rights in a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO. However, you may use the federal registration symbol ® **only** after the USPTO actually registers a mark, and **not** while an application is pending. Also, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration.

The above-mentioned criteria to register a trademark, as well as the considerations briefly discussed, are merely a cursory overview of the factors that must be examined when deciding to obtain registration. Consultation with an attorney is the most reliable and efficient way to acquire the information necessary to make the best decision.