

Trademark
Questions...
Answered!

A GUIDE TO GETTING YOUR NEW
BUSINESS TRADEMARKED

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Introduction

When you start a business or create a new product, it is in your best interest to have it legally trademarked by the U.S Patent & Trademark Office.

Trademarking through the U.S. government protects your unique brand from other business entities that attempt to use the same or similar name.

Unfortunately, it can be a long process (12-18 months) and the decisions by the United States Patent and Trademark Office can seem arbitrary to new trademark seekers.

This guide is meant to provide you with quick answers to frequently asked questions about trademarking your new business/product name.

Note: This guidebook is for general education information only. If you have any specific legal questions, please consult an attorney licensed to practice law in your state.

Why should I register my business name as a trademark?

Building your brand is a long and costly process. Name, logo and slogan recognition can take years. If you don't have the proper legal protections such as a U.S. Trademark in place, you could easily jeopardize everything that you have worked towards.

Where do I register my business name as a trademark in the U.S.?

In the United States, businesses register their trademark through the U.S. Patent and Trademark Office (USPTO) <http://www.uspto.gov/trademarks/>. The USPTO determines who has the legal right to use a name or a logo.

How Do I Protect My Business Internationally? Can the USPTO register my trademark internationally?

Unfortunately the trademarking of your business name in the United States does not give it protection internationally. Each country has different protocols and legalities when it comes to trademarking a name. If you will be performing international commerce with your name, it is best to determine which countries you will be conducting business in and then have your attorney file the

necessary paperwork in each country. This can become a costly endeavor.

Should I hire an attorney to register my trademark?

It is often advised to use the services of a trademark attorney to file your paperwork. These attorneys can also communicate with the Patent and Trademark Office's examiners on your behalf.

The cost of hiring an attorney to file your paperwork is widely variable, ranging from \$500 on up. Depending on the acceptance or rejection of your trademark application by the USPTO, the cost of your attorney is quite variable. There are trademark attorneys that advertise themselves as flat fee attorneys, but this is usually for the initial filing and initial communication with the examiners.

If you have a very unique name, then filing on your own is an option. Nolo.com, Trademarkia.com and others have inexpensive online application systems where you can file your own trademark application. The online guides walk you step-by-step through the application.

Before you do any of that, it is in your best interest to do a trademark search.

How do I do a trademark search to check if someone else is already using the name I would like to trademark?

It is important to do a thorough check of pre-existing businesses that already have a trademark or might fall under the “common law trademark” (whereas they have been in business and worked under a name in a similar industry but have not trademarked their name).

Probably the three most important things you can do when checking to see if your trademark is available is:

- Check the USPTO TESS (Trademark Electronic Search System) website: <http://tess2.uspto.gov>
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- Do a general Google search with “Quotes around the name”. Then, do a general Google search without the quotes.
- Check the state business registry where you will be doing business. This is often the Secretary of State’s office or Department of Financial Institutions. Each state is different. Often, a Google search with quotes: “Wisconsin Business Name Lookup” will give you what you are looking for.

While doing a complete search following these steps will give you a great idea of availability, it is not fool proof.

Even lawyers who practice trademark law can miss something or have the USPTO reject an application for differing reasons.

What if I want to trademark a name that is the same as another business but used in a different industry?

The USPTO uses the International Classification of Goods and Services to determine if trademarks infringe upon one another. That being said, it is better to tread on the side of caution and avoid a lawsuit by creating an original name that does not appear anywhere in the USPTO database (or is a dead mark). If you are determined to use a trademarked name or slogan that is already claimed by another business, then it is highly advised that you consult a trademark attorney before proceeding.

When registering my trademark, how do I determine which classification to use?

The USPTO maintains an Acceptable Identification of Goods and Services page located at: <http://tess2.uspto.gov/netathtml/tidm.html>. You can search this page to check where your business will fall under. Once again, even if the trademark name you are attempting to register is already trademarked in a different

sector, think very carefully before proceeding with your application. You have a higher probability of rejection of your application if the name is already being used.

If you are very serious about using a pre-existing name, consult with an attorney before wasting your time and money. Remember, you could wait 18 months to find out you just wasted your entire filing fee.

What if I search the USPTO TESS system and find that the trademark I want is registered by another company, but the status is “Dead” or “Abandoned?” *Can I still use it?*

The best answer to this is... maybe. It is possible that the user of the trademark has simply forgotten to renew their trademark. Therefore, the trademark may still be claimed under “Common Law Trademark.”

You can research the company further to decide whether it is worth pursuing. If they are out of business, then you are probably fine. If not, best consult with an attorney.

What is a common law trademark?

The USPTO states that: “Federal registration is not required to establish rights in a trademark. Common law

rights arise from actual use of a mark and may allow the common law user to successfully challenge a registration or application.” What this means is that if somebody has been performing commercial activity under a name, they have the “common law” right to that name. This is why a thorough search is very important, both in and out of the USPTO TESS database.

Important: If a business has been performing commerce under a certain name but has not applied for a trademark, they may very well hold a “common law mark” and your trademark application for the same name may be rejected.

How long does it take to get a response or decision from the USPTO Office?

It can take from between 12-18 months to get a decision from the USPTO. If there are any disputes or appeals, then it can take quite a bit longer.

What is a service mark? Is a service mark different that a trademark?

Individuals often confuse the two terms. In fact, they have the same meaning... a name that is trademarked. It is also often mistakenly thought that a service mark is a logo, which it may be, but a trademark refers to logos as well.

The USPTO differentiates the two as:

Trademarks: Used by their owners to identify goods, that is, physical commodities, which may be natural, manufactured, or produced, and which are sold or otherwise transported or distributed via interstate commerce.

Service Marks: Used by their owners to identify services, that is, intangible activities, which are performed by one person for the benefit of a person or persons other than himself, either for pay or otherwise.

Can I register my logo as a trademark?

Yes, you may register your name and logo as a trademark at the same time. The USPTO has a system in place for handling this type of application online.

What is the cost of registering a trademark?

The cost of registering a trademark in the U.S. is between \$275 and \$375, depending on your business size and whether you register online or by paper form.

The USPTO encourages online applications by reducing the fee for standard registration from \$375 to \$325.

Can't I just get a state trademark?

It's a lot cheaper!

While state trademarks are quite a bit less money, the federal protections are not in place. It is better to just go ahead with the USPTO registration.

How often do I have to renew my trademark?

In order to keep your trademark in place, you must renew accordingly. The USPTO states that: “For a trademark registration to remain valid, an Affidavit of Use (Section 8 Affidavit) must be filed: (1) between the fifth and sixth year following registration, and (2) within the year before the end of every ten-year period after the date of registration. The registrant may file the Section 8 Affidavit within a grace period of six months after the end of the sixth or every tenth year, with payment of an additional fee.”

It is your job as the business owner to keep track of your trademark and make sure that you file your renewals on time.

What about slogans or taglines? Can they be trademarked?

Yes, just as with a name, a slogan or tagline may be registered with the USPTO as a trademark. The same

search process as a name should take place to ensure no duplication.

I’ve heard that movie and book titles can’t be trademarked. Is that correct?

Yes! It is true! If you want to go make a movie called *The Sixth Sense*, there’s nothing that M. Night Shyamalan can do about it!

What is “customer confusion”?

When selecting a name, it is important to NOT select a name that causes customer confusion between your new name and established trademarks. The USPTO examiners may reject your application if they believe that your name will cause customer confusion.

Customer confusion can be best determined if there is a strong trademark in place before you, and your proposed name is substantially similar to the other company's name. The USPTO may deny your trademark application if your new name is likely to confuse a customer into believing that you are the other business or product.

Example: Your last name is McCarthy. You would like to start a fried chicken restaurant called “McChicken Burgers.”

Even if McDonalds is not using the word “McFryer,” you will either be denied by the USPTO for the trademark, or be sued by McDonalds for using the prefix “Mc”.

Always consider the USPTOs interpretation of the likelihood of trademark confusion.

What is a strong "mark"?

A strong trademark is a name that is very unique. It could be an invented name, a name with a strange character in it, or have a unique construction of words.

Weak marks are general words/common words and ideas. An example of this might be “The Best Garbage Collectors.” Even if nobody has a trademark on this, the name is too common to trademark in most instances. The USPTO may deny your application for being too general and common use. The best advice is to create a unique name. This will give you the best possible approval chance with the USPTO.

I registered my business with my state. Isn't that the same as a trademark?

No. While your business may eventually fall under common law trademark protection, it is best to be proactive and register both your business name and logo as a trademark.

Are trademark, copyright, and patent the same?

No. **Trademark** is meant to distinguish a business or product in the general marketplace.

The USPTO defines each as such: “A trademark is a word, phrase, symbol, and/or design that identifies and distinguishes the source of the goods of one party from those of others. A service mark is a word, phrase, symbol, and/or design that identifies and distinguishes the source of a service rather than goods. The term “trademark” is often used to refer to both trademarks and service marks.

Must all marks be registered? No, but federal registration has several advantages, including a notice to the public of the registrant's claim of ownership of the mark, a legal presumption of ownership nationwide, and the exclusive right to use the mark on or in connection with the goods or services set forth in the registration.

A **patent** is a limited duration property right relating to an invention, granted by the United States Patent and Trademark Office in exchange for public disclosure of the invention.

A **copyright** protects works of authorship, such as writings, music, and works of art that have been tangibly expressed.

The Trademark Operation of the United States Patent and Trademark Office (USPTO) handles trademarks only.”

A copyright is meant to protect writers, musicians, artists, etc. from having their work appropriated by another person or business entity.

Creators of copyrightable material should apply for copyright protection from the U.S. Copyright Office which is different from the United States Patent and Trademark Office.

Can I trademark my personal name?

Most likely not. Especially if your name is not distinctive. The simple reason for this is that there are so many people with the exact same name. It would be unfair for one person to have control over their name when there are so many others as well.

If I mistakenly use a trademarked business name, what can happen to me?

If a company, especially a large corporation determines that you are infringing on their trademark, then they may send you a cease and desist letter.

Obviously, you will have to decide whether you want to risk a lawsuit in this case, and if your name and their

trademarks are substantively different or if the different classes would preclude the claimant from winning in the courts.

You could be sued for trademark infringement if you continue using the name. Obviously, protecting yourself against a trademark infringement lawsuit could cost you into the hundreds of thousands of dollars if you are going up against Wal-Mart or SEARS.

You will have to ask yourself if it is in your best interest to change your name or fight the corporation. Most small businesses would elect NOT to fight McDonald's in court.

Who at the Patent and Trademark Office actually decides if you will get a trademark or not?

A PTO examining attorney will determine whether or not your trademark will be registered. These examiners are trained professionals who carefully examine your application.

My Trademark Application was rejected! Why? *What do I do now?*

Hopefully this doesn't happen to you, but if it does there are a few steps that you can take.

First, your trademark application may be rejected for a number of reasons. It could be a technical reason, something as simple as missing a spot on the application form.

Alternately, a serious issue substantive rejection such as “likelihood of confusion” or “dilution” may also get your application rejected.

If you were rejected based on substantive grounds, but you do not agree with the determination, then hiring an attorney to appeal to the Trademark Trial and Appeal Board is always a possibility.

You must decide if that is an expense that you are comfortable with.

What is the Trademark Symbol ® all about?

Only companies with USPTO registered trademarks are allowed to use the trademark symbol after their name. The use of this symbol after your name or slogan is a great way to let others know that you have claim to the name or slogan.

What makes for a strong trademark that will most likely get approved?

First of all, it is important to understand that even the best attorney could be wrong in their determination as to whether or not a trademark will be approved or not. Obviously this is cold comfort to those just starting the process. Once again, it is best to pick a very unique name before sending your application in to the USPTO.

What if I don't actually use my trademark? Is it still viable?

You could lose your trademark if you are not using it in commercial activities. If you are not active in commerce with the use of your trademarked name, your trademark could be revoked or given to another company. The Trademark Act states "use in commerce" as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark."

Do USPTO examiners ever make mistakes?

Yes, they do! An examiner may register two or the same trademarks mistakenly (which is very rare), or they may register a name that is highly likely to cause customer confusion. Therefore, there is always the possibility of a

challenge to your trademark even after it is registered! Fun, right?

What is dilution of a mark?

Regardless if the name is likely to cause customer confusion, if a new trademark is likely to dilute the trademark of another business, then the trademark should not be registered.

An example would be a new pet food store named, Patco Pet Food. Since this is very similar to Petco and provides the same services of retailing pet foods, this name could be found in breach of trademark infringement due to dilution.

The Trademark Dilution Revision Act of 2006 states that a company such as Petco would need to show likelihood of dilution against Patco Pet Foods in order to gain relief or injunction. But, as you can imagine, this is still a bit subjective on the part of the junior company.

What if somebody is using my trademarked name in a domain name?

Under the Federal Cybersquatting Protection Act, it is illegal for an individual to register a domain name based on a trademarked business name in the hopes of selling it at a profit. If somebody is cybersquatting on your trademarked name, you have the right to relief by having

the domain name transferred to you. Unfortunately, this can be quite costly and you will have to decide if the legal action necessary to regain the domain name is worth the time and money.

How do I get my domain name from a cybersquatter?

The Internet Corporation for Assigned Names and Numbers (ICANN) arbitrates trademark disputes in domain name conflicts. For more information on getting a domain name out of the hands of cybersquatting extortionists, head over to ICANN's arbitration site:

<http://www.icann.org/en/help/dndr>

It would also be in your best interest to have your legal counsel attend to these matters.

What should I do if somebody is infringing on MY trademark?

If you have a valid trademark and YOU discover that somebody else is using your trademarked name, there are a number of things that you can do:

- Nothing. Unless they are operating in the same region or business area, you might decide to avoid the cost of hiring an attorney and let sleeping dogs lie.

- Have your attorney draft a letter demanding that the infringing party cease the use of your trademarked name immediately. This is often a powerful tool that can work quickly. *If not, you can...*
- Bring about legal action for injunctive relief. This can be quite costly. If you are successful in your action, then the other party will have to cease use of the name, slogan or logo.

Important: Understand that bringing a lawsuit against a possible trademark infringer can cost well over \$100,000. You must decide how important it is for your overall business operation and what type of damage the infringing party is doing to your business.

Use common sense, and don't become emotional.

Conclusion

It is very important to trademark your business or product, but there are many considerations when you are choosing a name and applying for your trademark. Be unique. Stand apart from your competition with the perfect name.

Check out www.rockwellnames.com . We will create fun, unique TRADEMARKABLE names that will get you noticed.