

# The Marlette Report

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Basic Facts About Trademarks

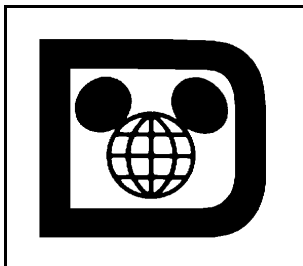
January 2007

## Proper Trademark Usage

A trademark or service mark is one of the most valuable assets of your business -- a symbol of your quality, reputation and goodwill.

### What is a Trademark?

A TRADEMARK is either a word, phrase, symbol or design, or combination of words, phrases, symbols or designs, which identifies and distinguishes the source of the goods or services 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. In this newsletter, the terms "trademark" and "mark" are used to refer to both trademarks and service marks whether they are word marks or other types of marks. Normally, a mark for goods appears on the product or on its packaging, while a service mark appears in advertising for the services.



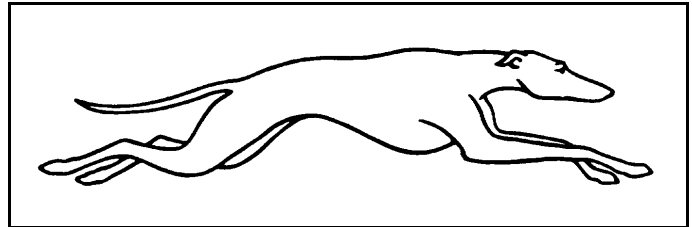
Disney World, circa 1960

A trademark is different from a copyright or a patent. A copyright protects an original artistic or literary work; a patent protects an invention. For more information regarding patents and copyrights, contact Mr. Todd E. Marlette at the address set forth below.

### Establishing Trademark Rights

Trademark rights arise from either (1) actual use of the mark, or (2) the filing of a proper application to register a mark in the Patent and Trademark Office ("PTO") stating that the applicant has a bona fide *intention to use* the mark in commerce regulated by the U.S. Congress. (See below, under "Types of Applications," for the terms *commerce* and *use in commerce*.) Federal registration is not required to establish rights in a mark, nor is it required to begin use of a mark. However, federal registration can secure benefits beyond the rights acquired by merely using a mark. For example, the owner of a federal registration is presumed to be the owner of the mark for the goods and services specified in the registration, and to be entitled to use the mark nationwide.

There are two related but distinct types of rights in a mark: the right to register and the right to use. Generally, the first party who either uses a mark in commerce or files an application in the PTO has the ultimate right to register that mark. The PTO's authority is limited to determining the right to register. The right to use a mark can be more



Greyhound Corporation, dog used since 1914.

complicated to determine. This is particularly true when two parties have begun use of the same or similar marks without knowledge of one

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MEMBER MICHIGAN AND MARYLAND BARS  
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another and neither has a federal registration. Only a court can render a decision about the right to use, such as issuing an injunction or awarding damages for infringement. It should be noted that a federal registration can provide significant advantages to a party involved in a court proceeding. However, only a private attorney can provide advice regarding proper trademark use and potential litigation.

Unlike copyrights or patents, trademark rights can last indefinitely if the owner continues to use the mark to identify its goods or services. The term of a federal trademark registration is 10 years, with 10-year renewal terms. However, between the fifth and sixth year after the date of initial registration, the registrant must file an affidavit setting forth certain information to keep the registration alive. If no affidavit is filed, the registration is canceled.

Unlike copyrights or patents, trademark rights can last indefinitely if continually used

used the mark may apply based on a bona fide intention to use the mark in commerce (an "intent-to-use" application). For the purpose of obtaining federal registration, commerce means all commerce which may lawfully be regulated by the U.S. Congress, for example, interstate commerce or commerce between the U.S. and another country. The use in commerce must be a *bona fide* use in the ordinary course of trade, and not made merely to reserve a right in a

mark. Use of a mark in promotion or advertising before the product or service is actually provided under the mark on a normal commercial scale does not qualify as use in commerce. Use of a mark in purely local commerce within a state does not qualify as "use in commerce." If an applicant files based on a bona fide intention to use in commerce, the applicant will have to use the mark in commerce and submit an allegation of use to the PTO before the PTO will register the mark.

(3) Additionally, under certain international agreements, an applicant from outside the United States may file in the United States based on an application or registration in another country. For information regarding applications based on international agreements please contact Mr. Todd E. Marlette as set forth below.

A United States federal registration provides protection only in the United States and its territories. If the owner of a mark wishes to protect a mark in other countries, the owner must seek protection in each country separately under the relevant laws. Mr. Marlette maintains a number of associate

relationships with attorneys in other countries to assist clients in obtaining trademark protection outside of the United States.

## Who May File a Federal Trademark Application?

The application must be filed in the name of the owner of the mark; usually an individual, corporation or partnership. The owner of a mark controls the nature and quality of the goods or services identified by the mark.

An owner may submit and prosecute its own application -- just as an owner may prepare its own lawsuit in federal court to protect its rights. However, it is recommended that the owner seek the advice of an attorney who routinely practices in the area of federal trademark registration and litigation for assistance in preparing the federal trademark application.

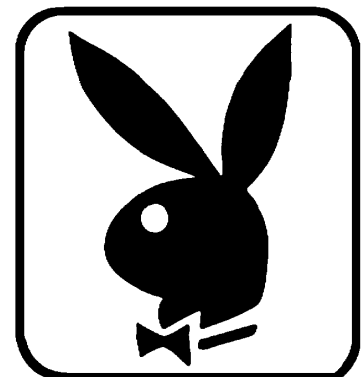
If you are unsure whether you or your organization should file the trademark application, please let us know. We're happy to help.

## Types of Applications for Federal Registration

An applicant may apply for federal registration in three principal ways.

(1) An applicant who has already commenced using a mark in commerce may file based on that use (a "use" application).

(2) An applicant who has not yet



Playboy Magazine, 1953

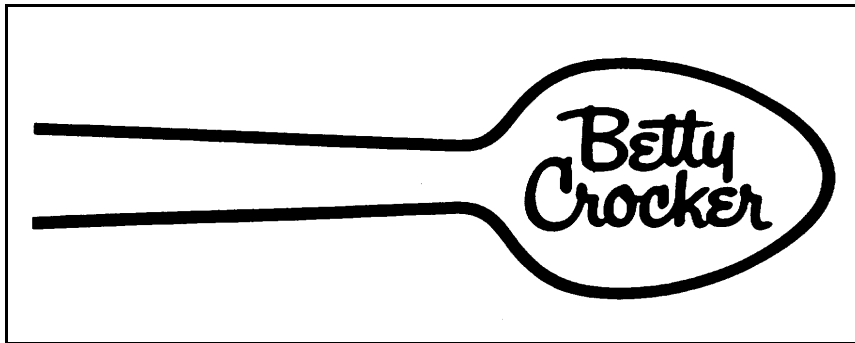
## Non - United States Applicants

Applicants not living in the United States must designate in writing the name and address of a domestic representative -- a person residing in the United States "upon whom

the potential for conflicts involving the mark. Moreover, during the application process, the PTO may uncover a mark which presents a bar to registration. Service fees associated with the preparation and filing of a trademark application cannot be refunded even if a conflict is found and the mark is refused registration.

marks. To find a conflict, the marks need not be identical, and the goods and services do not have to be the same.

The PTO does not conduct trademark searches for the public. To determine if a conflicting mark is registered, or is the subject of a pending application, a *private* trademark search should be conducted. Moreover, the PTO cannot provide advice about possible conflicts between marks. If you require assistance in this regard, kindly contact Mr. Todd E. Marlette as set forth below.



Betty Crocker, a division of General Mills, adopted 1950's

notices of process may be served for proceedings affecting the mark." The applicant may do so by submitting a statement that the named person at the address indicated is appointed as the applicant's domestic representative under §1(e) of the Trademark Act. The applicant must sign this statement. This person will receive all communications from the PTO unless the applicant is represented by an attorney in the United States.

## Searches for Conflicting Marks

An applicant is not required to conduct a search for conflicting marks prior to filing of the federal application. However, the preparation of a federal, state and common law trademark search report is strongly recommended to reduce

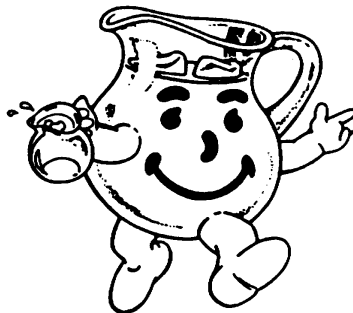
To determine whether there is a conflict between two marks, the PTO determines whether there would be likelihood of confusion, that is, whether relevant consumers would be likely to associate the goods or services of one party with those of the other party as a result of the use of the marks at issue by both parties. The principal factors to be considered in reaching this decision are the similarity of the marks and the commercial relationship between the goods and services identified by the

## Laws & Rules Governing Federal Registration

The federal registration of trademarks is governed by the Trademark Act of 1946, as amended, 15 U.S.C. §1051 et seq.; the Trademark Rules, 37 C.F.R. Part 2; and the Trademark Manual of Examining Procedure (2d ed. 1993).

## Other Types of Federal Applications

In addition to trademarks and service marks, the Trademark Act provides for federal registration of other types of marks, such as certification marks, collective trademarks and service marks, and collective membership marks. These types of marks are relatively rare. For forms and information regarding the registration of these marks, please contact Mr. Todd E. Marlette as set forth on the next page.



General Foods, 1978

## Use of the "TM," "SM" and "®" Symbols

Anyone who claims rights in a mark may use the "TM" (trademark) or "SM" (service mark) designation with the mark to alert the public to the claim. It is not necessary to have a registration, or even a pending application, to use these designations. The claim may or may not be valid. The registration symbol, "®," may only be used when the mark is registered in the PTO. It is improper to use this symbol at any point before the registration issues. Of course, all symbols are omitted from the official drawings which are submitted with your application before the United States Patent and Trademark Office.

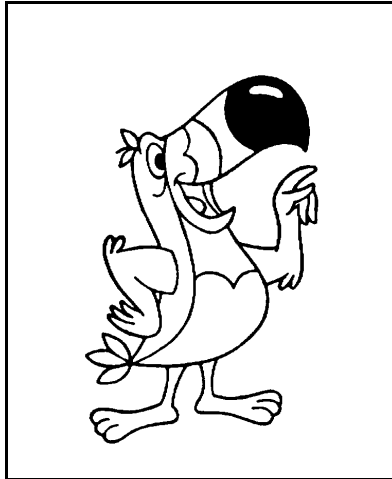
## Filing Date - Filing Receipt

The PTO is responsible for the federal registration of trademarks. If the federal application meets the requirements for establishing a filing date, the PTO assigns it a serial number and forwards a receipt to the applicant. If the minimum requirements are not met, the application is returned.

## Examination

About four months after filing, the PTO reviews the application and determines whether the mark may be registered. If the mark cannot be registered, the PTO will issue a letter listing any grounds for refusal and any corrections required in the application. The applicant must respond to any objections within six months of the mailing date of the letter, or the application will be abandoned. If the applicant's response does not overcome all

objections, the PTO will issue a final refusal. The applicant may then appeal to the Trademark Trial and Appeal Board, an administrative tribunal within the PTO.



The Kellogg Company, circa 1964

A common ground for refusal is likelihood of confusion between the applicant's mark and a registered mark. Another common ground of rejection is that the mark is merely descriptive in relation to the applicant's goods or services. Marks consisting of geographic terms or surnames may also be refused

## Publication for Opposition

Once there are no objections, the mark is approved for publication in the Official Gazette of the PTO. The PTO will send a NOTICE OF PUBLICATION to the applicant indicating the date of publication. In the case of two or more applications for similar marks, the PTO will publish the application with the earliest effective filing date first. Any party who believes it may be damaged by the registration of the mark has 30 days from the date of publication to file an opposition to registration. An opposition is similar to a formal proceeding in the federal

courts, but is held before the Trademark Trial and Appeal Board. If no opposition is filed, the application enters the next stage of the registration process.

## Issuance of Certificate of Registration or Notice of Allowance

If the application was based upon the actual use of the mark in commerce, the PTO will register the mark and issue a registration about 12 weeks after publication, provided no opposition was filed. However, if the mark was published based upon a bona fide intention to use the mark in commerce, the PTO will issue a NOTICE OF ALLOWANCE, again provided no opposition was filed. The applicant then has six months to either (1) use the mark in commerce and submit a STATEMENT OF USE, or (2) request an EXTENSION OF TIME.

For more information or assistance with protection for your trademark or service mark, please contact....

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