

Introduction to Trademarks and Other Marks

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Marks distinguish products and services. Because many consumer decisions are based on "recognized names," the goodwill attached to certain marks gives them their value. Marks are protected by law and prevent others from palming off their products and services on another's established goodwill.

What is a mark?

The Lanham Act defines a mark as "any word, name, symbol, or device, or any combination thereof." The U.S. Patent and Trademark Office recognizes four types of marks: trademarks, service marks, certification marks and collective marks.

A trademark is "used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." A trademark differs from a trade name. IBM may be both a trademark and a trade name, but only the trademark is protected by federal statutes and registered with the Patent and Trademark Office.

A service mark is associated with services, rather than goods. A certification mark indicates that the marked goods or services meet standards or requirements established by the mark's owner, for example — Good Housekeeping. A collective mark identifies members of a group such as an organization, union or association.

Trademarks used only in advertising or literature cannot be registered. To be registered, they must be attached to the product or service. Descriptive terms of a product or its features, characteristics, qualities or ingredients generally cannot be registered as marks. Marks can only be used as adjectives, never as nouns. For example, "Kodak" Cameras is a trademark but not "Kodak."

The rights to a mark can be lost, especially if a mark is abandoned or allowed to become a generic word. To avoid losing a mark, vigilance must be exercised even to the point of suing infringers.

What to do?

Step 1: Select the mark.

A mark must not be the same as or similar to another mark already in use. Once a mark is selected, it should be checked against other marks. For a nominal fee, search services will provide a printed list of marks most similar to the one selected. An attorney, preferably one specializing in marks, should then determine if the selected mark can be used.

Marks range from suggestive words, as opposed to descriptive words, to arbitrary, fanciful or coined terms. Arbitrary, fanciful and coined terms are legally the strongest and easiest to protect and the least likely to infringe upon. Business, marketing and advertising persons, however, find these terms less desirable than suggestive words because they make no instant association with a good or service.

Step 2: Apply for registration of the mark.

To be eligible for registration, either the mark must be in commercial use, or its owner must be able to demonstrate a **bona fide** intent to use the mark in commerce within a certain amount of time. If the latter course is taken, the owner of the mark must file a Statement of Use within six months from the time the Patent and Trademark Office gives notice that it will allow the mark (Notice of Allowance), or file for a six month extension of the allotted time. A total of five such extensions is allowable. It must also be shown that such a mark is identified with a particular product or service and that it points distinctly to the origin or ownership of the product or service to which it is applied.

Almost all states have their own trademark law. If a trademark is to be used entirely within one state, the only protection it has, other than common law, is registration under the state's trademark law. Federal trademark law applies only to marks used in interstate commerce.

A mark does not have to be registered, but TM or "Trademark" should be used with such a mark. A non-registered mark has common law rights. Official registration, however, provides distinct advantages. Registering a mark with the Patent and Trademark Office offers these benefits:

1. Registration notifies everyone that the mark is claimed by the person registering it. This avoids the problem of proving an infringer knew of the infringement.
2. The registrant has the right to bring suit in federal courts against an infringer without having to prove the usual requirements for bringing a suit in federal court.
3. A registrant successful in a lawsuit can get an injunction against the infringer; receive payment for damages and, in some cases, triple damages; and be assured of the infringing labels' destruction.
4. Registration is sufficient proof in court of the mark's validity and ownership.
5. The registrant may obtain relief against imported products bearing an infringing trademark.

Three notices signify a registered mark. They include: "Registered in U.S. Patent and Trademark Office," "Reg. U.S. Pat. and TM Off.," and ®. Use of such notice before the actual certificate of registration is issued for a mark is illegal and may be the basis for registration refusal.

Federally registered marks may be renewed for 36-year periods. An affidavit, showing use of the mark, must be filed within six years after registration or the mark must be forfeited. An application with the Patent and Trademark Office costs \$35 in each registration class.

Marks registered in Missouri are renewable every 10 years. Registration costs \$15.

More information sources

The U.S. Department of Commerce offices in Kansas City and St. Louis no longer handle trademark matters; all such activity has been centralized at the U.S. Patent and Trademark Office (PTO), phone (703) 308-4357 or (703) 308-4364.

The PTO publishes a booklet titled Basic Facts about Trademarks, which includes registration forms. It is available for \$2.25 at Government Printing Office bookstores. The nearest one is in Kansas City, phone (816) 765-2256.

On the state level, trademark registration is still handled by the Office of the Secretary of State, 209 State Capitol, Jefferson City, MO, 65102, phone (816) 751-4936.

The Commissioner of Patents and Trademarks, Washington, D.C. 20231.

To order, request BI0004, *Introduction to Trademarks and Other Marks* (25 cents).

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