

Trademarks ® ™

by Attorney Jay Eckhaus

Trademarks



Jay E. Eckhaus, Esq.

Business Law Center of the Palm Beaches



561.630.4800

561.630.4800

BusinessAttorneyPalmBeach.com

info@businesslawcenterpalmbeaches.com

Copyright and republication information:

©2011 Copyright Business Law Center of the Palm Beaches, Palm Beach Gardens, FL 33410. Non-commercial redistribution is permitted provided that the content, logo, QR code for the Business Law Center of the Palm Beaches affixed to this manual and the website address and links for the Business Law Center of the Palm Beaches remains intact and unaltered.

Foreword

This e-book is designed to give you general information on the business law area known as Trademarks. While this primer is short, the subject matter of Trademarks is not. This e-book is not a substitute for sound legal advice from an attorney who practices trademark law.

Table of Contents

Foreword.....	1
1. Trademarks & Service Marks	1
2. Trademark Registration -	3
The Process of Making Your Trademark "Official"	3
3. Proper Trademark Usage; ® or TM	4
Conclusion...Some Advice	5
About the Author.....	6

1. Trademarks & Service Marks

Trademarks and service marks are fantastic ways of making your products easily recognizable. They instantly bring attention to your product and represent the quality of the items the mark appears on.

Trademarks and service marks distinguish your products from those of competitors, guarantee consistent quality and help in advertising and selling your products and services.

A great trademark makes it easy for customers to recognize, identify and remember your brand. It gives your business a personality and identity that separates you from competition.

Here is the difference between trademarks and service marks. Trademarks are applied to goods while service marks are used with services. Examples are ENTENMANN'S® which is a trademark for "products" (bakery goods), and CENTURY- 21 which is a "service mark" (real estate services).

Trademarks are very important corporate assets and represent goodwill. Just think of the businesses established under a single mark...KODAK®, CANON® and MACINTOSH®!

Some marks are quite distinctive, leaving an immediate impression in the mind of the consumer; an impression which the trademark owner expects will translate into increased sales. As we go through the types of marks, you'll see how fanciful and arbitrary marks can cause immediate recognition of the goods the mark is used on.

Trademarks generally fall into four groups: **Fanciful**, **Arbitrary**, **Suggestive** and **Descriptive**. **Generic** words need special treatment.

- **Fanciful** marks are coined words. They're made up. They have no real meaning. EXXON® and XEROX® are fanciful marks.
- **Arbitrary** marks are recognized words but not for the goods the marks are used with. SUNBEAM® for appliances, GULF® for gasoline and ARROW® for shirts are all arbitrary marks.

- **Suggestive** marks hint at the goods they represent; usually a little bit subtle. These marks are considered easier to remember and easier to promote. IVORY® for soap. 7-ELEVEN® suggests the hours these stores are open. TIRE KINGDOM® suggests the nature of their product.
- **Descriptive** marks describe a function, ingredient, quality, characteristic, use or a feature of the goods. Descriptive marks can usually be "registered" on the Principal Register only with proof that the marks have earned a "secondary meaning" in the market place. NU-ENAMEL® for paint and LITTLE EARS® for corn are some examples. The mark SHAKE 'N BAKE® is considered a descriptive mark and with lots of advertising and increased sales, the owner of this mark was able to show that consumers recognized this brand, establishing a secondary meaning for the mark.

Generic marks deserve a special word: Caution. Generic words are never trademarks as they describe the goods or service. They are common everyday terms such as coffee, cereal and plastic wrap. But this category is instructive in one important area. Certain trademarks ceased being trademarks through misuse, not following the "rules of the road" for proper trademark use. Marks such as zipper, cellophane, escalator and aspirin were famous brand names which became generic.

Trademarks come in different forms. Your mark might be pictures, words, even a container...or a combination, such as a picture of a partly eaten apple and the word MACINTOSH. Remember that apple? Well, it is a terrific mark from a trademark point of view. It is an arbitrary mark when it comes to representing a specific type of computer, but a generic term for a fruit.

2. Trademark Registration - The Process of Making Your Trademark "Official"

Now that you've chosen your mark and you're actually using it in your business, or you intend to use it, you want to get the ball rolling. This means getting the mark registered.

The U. S. Trademark Office (USPTO) registers those marks which are used, or intended to be used, in interstate commerce. When a trademark is registered, it is registered for specific goods or services within a particular class or classes. MICROSOFT®, for example, is registered in International Class 036 ("Insurance and Financial") and Class 009 ("Electrical and Scientific").

It's very important when you register your trademark that you register it in the correct class or classes in order to protect it from infringement. If you file your trademark in the wrong class or you neglect to file it in all the applicable classes, your trademark may not be protected from a mark in another class.

The first step towards registration doesn't involve the trademark office; it involves a "search." The proposed mark, be it graphic or words (even slogans, recipe titles and flavor designations) will be searched.

A search on the USPTO website is not sufficient to protect you from infringing other trademarks because not all trademarks are registered with the USPTO.

You need to have a comprehensive trademark search in order to avoid choosing a mark that may infringe another person's mark. A complete search will not only show those marks registered with the Trademark Office, but also similar marks registered in each state as well as trade names and names that are similar to your mark. By showing that your mark doesn't infringe other marks, the search aids you in establishing the registerability of your mark.

For your protection, a trademark attorney is used to do a comprehensive trademark search and interpret the search results. This means that the attorney will determine whether or not your trademark is registerable, if it appears to conflict with an existing trademark, or if your

trademark may need some modification before you should spend your time and money to apply for your trademark as it presently exists.

When you apply for a Trademark, the USPTO will either approve it or the USPTO will send you an Office Action with the legal reasons why your application cannot be accepted. An attorney experienced in Trademark Law, who is skilled in dealing with the USPTO, will take the proper steps to modify your application so that it can be approved, if at all possible.

If you have a trademark attorney take care of the entire trademark registration process, it may be less expensive in the long run because he is skilled and readily available to modify your trademark if the USPTO office requires modification for approval.

Once your mark clears the search, a trademark application is prepared and filed with the Trademark Office. If all goes well and the trademark examiner approves your mark, it is then published in the *Official Gazette of the United States Patent and Trademark Office*. If no one opposes your mark (persons who believe your mark may be confusingly similar to their own) the Trademark Office will register the mark.

3. Proper Trademark Usage; ® or TM

Proper trademark usage, while not difficult, is absolute. After all, you don't want your mark to go the way of *escalator* or *cellophane*!

First the symbol TM. This is used when you believe that you are the first to use the mark. You are claiming it as your own.

The symbol ® is used once the Trademark Office accepts your mark and a registration number is assigned.

Now for some **absolute**, and we mean **absolute**, rules on trademark usage. Use the mark:

- As an adjective to modify the generic name of the goods or services. Do not use the mark as a noun, verb or in possessive form.
- With its generic or common descriptive name in close proximity to the mark.
- Consistently. If the mark is in the singular form, do not pluralize it; if in the plural form, do not make it singular...and don't vary the spelling!
- With some special type, be it all capital letters, different color or type style to differentiate your mark from other words. In this primer, we're showing all trademarks in CAPITAL letters.
- With the proper trademark designations TM or ® .

Conclusion...Some Advice

Ben Franklin once said, "An investment in knowledge pays the best interest." In our design of this manual, we've followed this advice.

Your business is taking care of business and not the practice of law; familiarity with various legal topics being just one way to maximize your business by alerting you to certain legal concepts and potential pitfalls. We've designed this brief treatment on the subjects covered with this philosophy in mind, and not to make an attorney out of you. Our primer deals with general principles which may vary from state to state and may not cover or be applicable to your situation. We encourage you to speak with your personal attorney should you be confronted with a legal problem.

THE AUTHOR IS NOT ACTING AS YOUR ATTORNEY AS A RESULT OF YOUR PURCHASING OR READING THIS PRIMER. JAY E. ECKHAUS, P.A., D/B/A THE BUSINESS LAW CENTER OF THE PALM BEACHES, ITS EMPLOYEES, OFFICERS AND DIRECTORS, AND THE AUTHOR DISCLAIM ANY LIABILITY TO YOU, INCLUDING ACTUAL, CONSEQUENTIAL, INCIDENTAL OR INDIRECT DAMAGES (INCLUDING DAMAGES FOR LOST BUSINESS OPPORTUNITY OR

PROFITS) CONCERNING YOUR USE OF THE INFORMATION AND/OR MATERIAL COVERED BY THIS PRIMER.

About the Author

Jay E. Eckhaus, Esq. practices business law in Palm Beach Gardens, Florida. He is licensed in Florida, New York and Ohio.



During Jay's many years of Business Law practice, he represented major companies, national franchisees, entrepreneurial startup companies & small businesses including Kraft-General Foods, Entenmann's, Inc., Oroweat Bakeries, Boboli pizza crust, Freihofer's Bakery, McDonald's Franchisees, Little Caesars' Franchisees, Burger Chef Systems, Theme Restaurants of America, Meriwether's Restaurants and Mexican Foods of America Restaurants, as well as entrepreneurs.

Jay served as Vice President, General Counsel and Corporate Secretary for the U.S. operations of a prominent European multinational corporation and for a Ft. Lauderdale, Florida consumer products and technology company.

Jay was selected Chair of both the Litigation and Arbitration Committee and the Mergers and Acquisitions Committee of the New York State Bar Association's Corporate Counsel Section.

He has served as an Executive Trustee of the Northern Palm Beach County Chamber of Commerce where he also served as Co-Chair of the Chamber's Government - Legislative Affairs Committee and is Chair of the Small Business Advisory Council.

Jay is a member of the Society For Human Resource Management (SHRM) and served as Chair of the Palm Beach County Business Incubator, Inc.