

Trademarks

A Bite-Sized Legal Guide

Disclaimer

The information below is intended to provide a general overview of trademark law and answer some common questions. The information is not legal advice. Trademark law is very fact-specific and we recommend that you consult an attorney for advice on your specific situation.

Trademarks and Service Marks

“**Trademark**” means a word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish their goods. A trademark can be a logo or slogan, or in some cases a trademark can be a product’s packaging or a product’s shape, which is more specifically known as “trade dress.” In some cases a trademark can even be a sound.

When the mark is used to identify and distinguish a person’s services it is called a “service mark.” The term “trademark,” however, is commonly used broadly to refer to trademarks or service marks. Therefore, for the purposes of this resource, when we use “trademark” we are referring to either a trademark or a service mark.

Trademark is a property right. A trademark is treated similarly to any other property right, and can therefore be bought, sold, or licensed.

Trademark Law and Trademark Registration

There are three main sources of trademark law:

- Federal law (Lanham Act)¹
- State law
- Common law (based on court decisions, not statute)

You don’t have to register your trademark with a state or federal government to claim trademark rights. However, registering your trademark makes it easier to enforce your rights. State registration is most useful if your use of the trademark is limited to one state. If you are engaging in interstate commerce (across state lines, including over the internet) then federal registration provides the most protection. For purposes of this resource, we are focusing primarily on federal law.

¹ Section 1051 and following of Title 17 of the United States Code (17 U.S.C. § 1051 et seq.).

Is Your Mark a Trademark?

For a mark to be viewed as a trademark it needs to meet three requirements:

1. **It is a tangible symbol:** the mark is a word, name, symbol, or device or any combination thereof.
2. **The mark is used in trade:** the mark is actually used in trade/commerce (this one is key).
3. **The mark is used to identify and distinguish:** The mark is used to identify and distinguish the seller's goods or services from the goods or services of others.

Is Your Trademark Eligible for Trademark Protection?

If your mark can be viewed as a trademark, the next step is to determine if it is protectable. A trademark is not automatically eligible for registration; trademark protection is awarded to marks that are distinctive. The following categories can be used to classify **terms** for purposes of trademark protection:

Usually protectable:

- **Fanciful:** Fanciful marks are made up and have no other meaning (e.g., Xerox, Kodak). Some resources classify these terms as “coined terms.”
- **Arbitrary:** Arbitrary marks are unexpected or surprising; a word may be viewed as arbitrary if its use does not relate to the nature of the product or service (e.g., Apple computers).
- **Suggestive:** Names that hint at what the product or service is without being descriptive. Suggestive marks are often clever or evoke an image or feeling for a customer (e.g., Dove soap, Greyhound bus).

Usually **not** protectable:

- **Descriptive:** Marks that describe the product or service, such as geographic designations or personal names.
- **Generic:** Marks that are generic for the underlying product, such as computer, cafe, or lite beer. Trademarks that include generic terms with other fanciful, arbitrary, or suggestive elements can be eligible for trademark protection, but the generic components of the mark will not be eligible for protection on their own.

Personal Names

Personal names are generally deemed to be descriptive marks, and therefore not distinctive enough to be eligible for trademark registration. An exception may be made if it can be proved that the mark has acquired secondary meaning. Secondary meaning is acquired if the public recognizes the mark as originating from one specific seller (e.g., McDonalds).

Domain Names

Domain names are generally not protectable as trademarks unless they are being used as more than an address of where to be found on the internet (for example, the “.com” is actually part of the business name). However, be careful when choosing domain names, a trademark owner may still be able to sue if your business name looks like or sounds like theirs or is likely to confuse customers.

What if the Mark Includes Both Distinctive and Non-Distinctive Elements?

If a trademark has both distinctive elements and non-distinctive elements then the mark is analyzed as a whole, or how it would be viewed by consumers. This is known as the anti-dissection rule.

The Difference Between the ™ and ®

The ® symbol may be used to designate a mark that is federally registered with the United States Trademark and Patent Office. The ™ symbol (or ℠ for service marks) may be used if you are claiming rights to use the mark but the mark is not federally registered.

Trademark Infringement

To determine if there has been trademark infringement, the courts look at the likelihood of confusion between the marks. Most courts use a multi-factor balancing test (known as the *Polaroid* factors).² The factors are:

- Strength of the mark (how distinctive is it?);
- Degree of similarity between the marks;
- Proximity of the products (are they similar products?);
- Actual confusion (*note, infringement can still be found if no actual confusion is proved);
- Marketing channels used;
- Intent of the alleged infringer (was there good faith?);
- The quality of the product and sophistication of the consumers;
- Likelihood the trademark owner will expand their product line.

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² AMF Incorporated v. Sleekcraft Boats 599 F.2d. 341 (9th Cir. 1979).