



THE VIRTUAL TRADEMARK CONSULTATION

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1. Do I have to federally register a trademark to have rights in it?

Not necessarily. If you have been using the trademark in commerce you may already have certain rights in the mark. Please see our discussion of Common Law Trademarks [here](#).

2. What makes a good trademark?

Generally, a "good" trademark is one that is a unique identifier of your goods or services. Something that when they see it or hear it they instantly think of YOUR goods or services. Often times there is a temptation for business people to choose a mark that is very descriptive of the products. The thinking is that if the product name describes the product or describes an essential feature of the product, less money needs to be spent on advertising to educate the potential purchasers as to what the product is or

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what it does. While it is debatable if such a strategy produces any sort of marketing benefit, the above strategy does have one definite result - it is much harder to protect the mark.

In the world of trademarks there are different "levels" of protection afforded to marks based on the characteristics of the mark itself. The levels range from arbitrary and fanciful on one end (the strongest marks) to generic on the other end (generic terms are afforded no protection and therefore are not even considered marks).

Arbitrary or Fanciful marks are afforded the highest protection and are by default able to be registered on the primary federal trademark registry without the applicant showing evidence of secondary meaning or acquired distinctiveness. Quite simply, fanciful marks are essentially coined terms or words that do not have any true meaning. Examples of these would be XEROX, GOOGLE, KODAK etc. Arbitrary marks are real words that have been arbitrarily chosen or applied to identify the goods or services in question. A good example of an arbitrary mark is APPLE for computers. Additionally, because of their unique and creative nature, arbitrary or fanciful marks are often given more breadth of protection than other marks because

The next step down from arbitrary or fanciful marks are marks that are suggestive. Suggestive marks, like their name implies suggest the nature of the goods or services but do not actually describe the goods or services. Some amount of thought or effort is required for a consumer to draw the connection. Often times these can be thought of cute plays on words in either the sound or appearance of the mark. Like arbitrary or fanciful marks, suggestive marks may be registered on the primary registry without proof of secondary meaning or acquired distinctiveness.

After suggestive, there are marks that are descriptive of the goods or services they identify. Marks that are determined to be merely descriptive may be registered on the primary registry upon a showing of secondary meaning or acquired distinctiveness. Essentially secondary meaning is a concept that recognizes that the mark is merely descriptive, but through the applicant's marketing efforts and marketing expenditures when consumers see the mark, they do not think of the general class of products described by the mark, they think of the applicant's particular products. Evidence of secondary meaning can be proven by customer surveys, marketing dollars spent, or the length of time the applicant has used the mark in commerce. Unless the applicant can prove secondary meaning, the mark cannot be registered on the primary trademark registry.

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Lastly there are terms that are considered generic. Generic terms are terms that are commonly used to refer to the goods or class of goods identified by the term. Examples of generic terms are "CARS" as a brand name for cars or "SHOES" as a brand name for shoes, or PATENTS.COM for patent legal services. Generic terms are not afforded any trademark protection. The theory behind it being that if one person was able to control those terms when associated with the relevant goods it would prevent other people from using generally accepted words and language to describe their goods and services. Often times there is a very fine line as to whether a brand name is merely descriptive or generic.

3. I have received a cease and desist letter from a company stating that my name infringes their trademark. Do I have to change my company name?

It depends. In certain circumstances you may have to change your name to avoid a trademark infringement suit. For more details click here for a more in depth article.

4. Can I use someone else's trademark in my advertising?

The answer to this is the "traditional lawyer answer" that it depends. 15 USC § 1115(b)(4) provides for a fair use defense to trademark infringement. This defense permits a non-owner of a mark to use the trademark under certain circumstances. This defense is available in two different situations. In both cases, they allow the use of the trademark for purposes of description or identification.

The first case is called "nominative use". Nominative use occurs when the non-owner uses the trademark to refer to the trademark owner's own goods. An example of this would be the use of a trademark in a comparative advertising situation. Therefore, the use of the trademark "Ford" by Chevy when comparing two different models of trucks in a truck commercial would be allowed. However, keep in mind that comparative advertising is allowed in the United States, but is often forbidden in other parts of the world. Always consult the local law of a foreign country before you start advertising there. In order for your use to be considered nominative, it must meet 3 requirements: 1) the trademark owner's product or service must be one that's not readily identifiable without the use of the trademark (or that describing the product without using the trademark would be overly cumbersome) 2) the non user only uses as much of the trademark as reasonably necessary to identify the trademark owners goods or services and 3) the use does not suggest to the viewer sponsorship or endorsement by the trademark owner of the non-owner's goods or services. One important aspect is not to overuse the trademark - because then an argument can be made that your use is not descriptive or identification, or that the prominent and repeated display of the mark in question is denoting sponsorship or endorsement.

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The second defense available is called (confusingly enough) the "fair use" defense. This surrounds the use of a mark in a manner other than that of a trademark. An example of this would be an author starting that a particular character walked into the room with a "coke" in his hand, or drove a particular make or model of a car. In this case, the trademark isn't being used as a trademark in a commercial sense - but more as a descriptor. The basic requirements of the defense are 1) that the use accurately describes the trademark owners goods or services (i.e. accurately reflects what the goods or services are and doesn't disparage the goods or services) 2) the use must be incidental and not as a source identifier to the non-owners goods or services and 3) the non-owners use must be in good faith.

The third aspect of the use of another's trademarks in advertising surrounds the use of trademarks in meta tags and pay per click advertising. Recently, numerous decisions have put this issue to the forefront of the legal debate. In general, the position that the use of competitor's trademarks in meta tags and key words does not constitute the use of a mark (and therefore is not trademark infringement) as long as the actual copy of the advertisement does not contain the trademarks seems to be gaining strength with numerous recent rulings adopting that logic. However, it is important to note that there is a split in the federal circuit courts on these issues, so the law that is actually in force will depend on where you are located and what circuit you are in. before utilizing any of these strategies it is important you seek legal counsel.

Fair use cases are extremely fact specific and may be difficult to interpret. If you have any questions concerning fair use of another trademark you are strongly advised to seek legal counsel with expertise in this area.

5. I am not using a particular trademark now, but plan to in the future. Can I register the trademark to protect from anybody else using it?

In general since trademark rights arise from use, you generally have to be using the trademark to have any substantive rights. If however, you do have a good faith belief that you will be using the trademark in a fairly short period of time after you file your application you can file an application known as a 1(b) application AKA an "Intent to Use Application. An "Intent to Use Application" goes through much of the same process as a regular trademark application [click here](#). However, after the trademark is published for opposition and a notice of allowance is issued you have six months from the date of the notice of allowance to provide evidence that you are using the trademark. If you are not using the trademark by the end of the six month time period, you can file a petition to extend the time for another six months. The fee to do this is \$150.00 per class, and you can file up to 5 extensions. So analytically speaking, if you are not

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using a trademark now, but feel you will be using it in commerce within conservatively 3 years from now years, you could potentially file an Intent to Use Application and prevent someone else from obtaining trademark registration of an exact or similar name that causes a likelihood of confusion. NOTE FOR WES: THE ABOVE LINK WILL LEAD TO THE PROCESS OF REGISTERING A FEDERAL TRADEMARK PAGE

6. I filed for a trademark with the USPTO and have received an office action stating that the trademark is "merely descriptive" and is not eligible for registration on the Primary Registry. Should I give up?

Not necessarily, the first thing to determine whether or not our mark is truly merely descriptive, or if there is room to make a good argument that the mark is suggestive, thus having to avoid proof of secondary meaning. Alternatively, you may be able to provide evidence that your trademark has acquired secondary meaning and overcome the objection of the examiner. Additionally, if it has not yet acquired secondary meaning you may be able to place it on the "Supplemental Registry". Placement on the Supplemental Registry does have some advantages such as giving you a registration number, having your trademark appear in the federal database (so it will pop up in subsequent clearance searches) and the owner is allowed to use the ® symbol in reference to the trademark. Additionally, after 5 years on the Supplemental Registry, secondary meaning will be presumed. However, while on the supplemental registry the trademark owner will not receive certain benefits conferred to marks on the principal register such as the presumptions that the trademark and registrations are valid, that the registrant is the owner of the trademark, and the right for a trademark to become incontestable.

7. I have received a letter from a company stating that my website infringes their trademark. Do I have to assign my domain name to them?

Maybe, Maybe not. The best thing to do is to seek the advice of an attorney. Many things influence whether you are infringing or not such as, do they truly have superior right to you, when did they start using the trademark, how are they using the trademark, what products or services are they using the trademark in connection with, do they have a federal or state registration? The answers to all of these questions (and more) are required to make a proper determination of your legal rights and options.

8. How long do trademarks last?

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Trademark rights last as long as you are using them to identify your goods or services in commerce, therefore, in theory they could last in perpetuity. Trademark registrations can also last in perpetuity as long as you make your required filings for your affidavits of continued use. In general these are required during the 6th year after your registration issues, during the 10th year after your registration issues and every 10 years thereafter. If you continue to use a mark, but fail to maintain your registration, you basically default back to common law rights and would not be able to enjoy the benefits of the federal registration after the registration was abandoned.

9. I recently saw someone that is using a product name that I used years ago but haven't recently. Is there anything I can do to stop them?

There may be but most likely you can't. As we have stated before, trademark rights arise from use of those identifiers in commerce in connection with your goods or services. Those rights cease when you "abandon" the mark. Abandonment can occur from an overt action on behalf of the trademark owner, such as statements that you aren't going to use the mark, or that you are renaming your goods or services. This sort of abandonment is referred to as an express abandonment. Abandonment can also happen if you fail to use the mark for a certain amount of time, which is referred to as a constructive abandonment. Depending on why you stopped using the mark, whether or not you intended to continue using the mark and how long it has been since you last used the mark, will determine whether or not the mark is abandoned and whether or not you would have the ability to stop the new user from using the mark. As always, competent legal counsel should always be consulted when dealing with issues of a potential abandonment.

10. Why should I use an attorney? Aren't the do it yourself places like LegalZoom just as good?

While it may be tempting to use do DIY providers for trademarks, often times it is not a wise idea. The fact that trademark applications can be done on-line leads some people to believe that getting a trademark registration is as simple as filling out a form. What they don't realize is that trademark law is governed by an extensive and complex body of law and that the information contained in the trademark application and how it is worded can have huge legal consequences. We often times have clients come to us with applications they have filed themselves and have received office actions where the examiner has rejected the application. At this point in time our hands are often tied as to the legal arguments in response to a rejection because we cannot materially alter the information that was submitted by the client and may not be able to salvage the application. Not only was the application a waste of the client's money, we also lost the priority date and are at risk of some other application filed after the client's application receiving

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priority over the client. Services like legalzoom cannot by law offer legal advice. They can only fill in the forms with the information you provide them. If they provide legal advice, it is against the law. We currently have a client where one of these document preparation services broke the law and gave legal advice and the advice was wrong. Based on the advice the client filed an application that actually issued into a registration - however the registration would never stand up in court because it is actually on its face invalid. The result was that we had to refile all of the client's marks and the client is potentially at risk of losing

11. Is a clearance search required?

Technically speaking the answer is yes and no. A few federal circuits around the country (the 2nd circuit immediately comes to mind) have issued opinions stating that the adoption of a mark and filing for a registration without first doing a clearance search to determine whether there are any parties that may have a prior right to the mark constitutes willful blindness and is tantamount to bad faith. A finding of bad faith will increase the damage award in an infringement lawsuit. Some circuits have not weighed in on this issue yet, but since you never really know where you might be facing a lawsuit, needless to say clearance searching is a very good idea.

12. What is the difference between your search and those that cost a lot less?

As with anything in this world, you get what you pay for. Rest assured there is a difference between lower cost clearance searches and more expensive ones. In general, the cheaper searches only include searches of the United States Patent and Trademark database. While this may be an indicator as to whether you would be able to get an application through the USPTO office, it doesn't necessarily mean that you are entitled to use the mark or that a registration will actually issue. When examining the mark, the USPTO will only check against the federal trademark database. If the mark is approved by the office, the mark is then published for opposition. In the opposition process ANYBODY who feels that they may be harmed by the registration may bring a proceeding to oppose the registration. These people may be common law mark holders, state trademark holders, or others who have been using their mark prior to you, and they feel that they will be harmed if your mark is registered. These people will not show up on a standard low cost clearance search.

As standard course, Leyendecker & Lemire, LLC utilizes a comprehensive trademark search when clearing trademarks. Our search includes not only a search of the federal database, but searches of the business and state trademark databases of all 50 states, a common law search that includes industry and

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trade publications, phone book directories, and a search of the internet. This sort of a search is geared to not only give use results of registered or pending federal marks, but an idea of the universe of all other users who may become an issue in the opposition portion of the examination or later on after the mark has issued. This search gives you the most information possible to make an informed decision as to whether or not you want to adopt a certain trademark or pursue federal registration. While no search can gather 100% of all of the potential registered and common law users, we consider our search to capture at least 90% -95% of the results

Another important distinction between our clearance search services and others out there is that when we receive the search results in, we actually analyze the results for you and give you our opinion. As previously stated on this website, trademark law is an extremely complex area of law, and the average person (or attorney that doesn't practice in this area) does not have the requisite knowledge or background to determine whether other marks pose a problem to your mark. Given all of the data revealed by the search we will give you our opinion as to whether or not you will be clear to use the mark and whether or not federal registration will be available to you, and if so what marks may pose some potential problems to use or registration.

13. What is the difference between the ® and the ™ symbol?

Basically the ® denotes a federally registered trademark and the ™ identifies a common law trademark. Under the Lanham act it is illegal to use the ® if you do not in fact have a registered trademark.

Leyendecker & Lemire, LLC is a Denver-based law firm offering a full spectrum of Intellectual Property, Business and Entertainment related legal services for entrepreneurs, individual inventors, and businesses of all sizes. We pride ourselves in providing large firm quality, but with personalized service and attention the large firms do not provide to their smaller clients. Our strength is working with a client from the beginning of his/her venture to maximize the venture's value and potential, as well as, help minimize the risk of legal disputes. Call (303) 768-0123 or e-mail us at info@coloradoiplaw.com today to see how we can help you!

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