



This article presents general guidelines for Georgia nonprofit organizations and should not be construed as legal advice. Always consult an attorney to address your particular situation.

Trademarks

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What is a Trademark?

A trademark is a word, logo, or design used to identify the source of goods or services and distinguish that source from others. Trademarks include brand names identifying goods (for example, "Tide" for laundry detergent) and service marks identifying services (for example, "CNN" for television programming). Trademarks may take the form of a word mark (for example, UPS or Clorox), logo (for example, the McDonald's Golden Arches), a package design (for example, the Coca-Cola bottle shape), or even sounds (for example, the Cingular ring tone). All of these variations of trademarks may be referred to as "trademarks" or simply "marks."

Trademarks, patents and copyrights, are all forms of intellectual property. While trademarks are used to identify the source or brand of goods or services, patents protect the underlying functional or design invention, and copyrights are used to protect artistic expression, such as literary, musical, or audiovisual works, or even computer programs. For example, while XEROX is the trademark to identify a particular brand of copy machines, the company may hold a patent on the technology underlying the copy machine and may own copyrights in the software code used to program the copy machine and the operation manual given to users.

How do I secure a Trademark?

In the United States,¹ we recognize both registered trademarks and common law marks. Registered trademarks are those that have been granted registration by the United States Patent and Trademark Office ("USPTO") or, if used solely for commerce in a single state, with the relevant state trademark office. However, it should be noted that reserving a corporate name with the Secretary of State's office or other state agency is irrelevant to trademark rights. Therefore, simply obtaining a corporate name registration will not insulate an organization from a claim of trademark infringement. Common law marks have not been registered with federal or state trademark offices, but a user may claim common law rights

¹ This summary focuses solely on U.S. trademark law. If you intend to conduct business outside the U.S., please consult an experienced trademark attorney for information regarding any international jurisdictions.

to the mark by virtue of the user's pre-existing use of the mark. States vary with regard to the degree of use required to establish common law rights and the degree of protection they afford the user. Therefore, it is generally preferable to register the mark as a trademark with the USPTO or state trademark office.

Search and Clearance

Before adopting a mark, a prospective user should search the mark in order to determine if it is clear for the proposed use. Clearance searches generally require review of trademarks registered with the USPTO and state trademark offices, as well as a search of common law databases. Review of the search results requires consideration of several factors, such as similarity of the marks, similarity of the goods or services associated with the marks, the number of similar marks, distinctiveness of the terms used to form the mark, etc. Therefore, it is necessary that an experienced trademark attorney review the search and provide a clearance opinion. Before requesting a full search from a trademark attorney, however, a prospective user may review registered trademarks at the USPTO's website, located at www.uspto.gov, to identify any potential obstacles that may suggest a full search would be futile.

In evaluating the availability of a proposed mark, bear in mind that simply because another party holds a registration for the same or similar mark, it may not be an obstacle to your proposed use. Two or more parties may have trademark rights in the same mark for different goods and services (e.g., DELTA to identify an airline or plumbing fixtures). The degree of similarity of the marks is but one factor in assessing the mark's availability. Some marks, however, are so famous that the trademark holder has exclusive rights to use the mark across all classes of goods and services.

Filing an Application with the USPTO

Trademark prosecution is the term used to refer to the process by which one applies for and receives a registration for a mark from the USPTO or relevant state agency. When filing an application, the prospective user must identify whether the application is use-based or based upon a intention to use the mark (commonly referred to as an "ITU application"). When filing a use-based application, the trademark applicant must identify the date upon which it began use of the mark. ITU applications are filed prior to the applicant beginning actual use and are based upon a "bona fide intention" to use the mark in federally regulated commerce. An ITU application will not mature to registration until the applicant actually uses the mark in the ordinary course of trade, and should not be used merely to reserve a right in the mark.

After filing an application with the USPTO, a Trademark Examiner assigned by the USPTO will review the application and determine whether the mark is suitable for registration under the terms of the application. The Examiner will

consider a number of factors, such as the distinctiveness of the mark, other previously registered marks that may be confusingly similar to the applicant's mark,² and the suitability of the description of goods and services upon which the mark will be used. The Examiner may then either issue an Office Action requiring one or more amendments to the application or simply refusing the application, or issue a Notice of Allowance, permitting the application to be published for opposition. Once published, other trademark holders then have the opportunity to file an opposition to registration of the mark. If opposed, the parties will file arguments before the Trademark Trial and Appeal Board, which will ultimately determine whether to issue a registration for the mark to the applicant. If unopposed, the application will mature to registration after the opposition has expired, and the applicant has submitted acceptable evidence of use of the mark. It is highly recommended to have a trademark attorney file the application on your behalf and navigate the application through the federal prosecution process. Depending upon the likelihood of obstacles arising during prosecution, obtaining a federal trademark registration may be expensive.

An applicant may file a state trademark registration if it is unable to secure a federal registration because use is limited to commerce within a single state. Unlike the federal prosecution process, state trademark prosecution generally involves much less scrutiny of the application and is almost always inexpensive. However, federal registration rights may provide better protection than state registration rights.

How do I designate a Trademark?

Trademarks are designated with either a ® (registered trademark), TM (common law or not-yet-registered trademark), or SM (common law not-yet-registered service mark) symbol immediately adjacent to the mark. It is inappropriate to use a ® designation before securing a registration for the mark, and such inappropriate designation may prevent you from obtaining relief against an infringer. While use of a designation is not mandatory, it is advisable to clearly indicate to the general public that you claim trademark rights in the mark and may affect your ability to obtain judgment against an infringer.

How do I protect a Trademark?

Common law trademark rights will continue indefinitely provided that the trademark holder neither abandons the mark (through non-use for a statutorily

² When filing a trademark application, the applicant must identify the class of goods and services, as well as a more detailed description thereof, upon which the mark will be used. For example, the application may note that the application is filed for the mark in class 16 (for printed materials) and provide a description of the goods and services as follows: "Printed material, namely calendars, notebooks, and trading cards." Most countries recognize the same international classification system of goods and services for trademark applications.

defined period of time) nor allows it to become generic.³ To protect the registered status of federal and state trademark registrations, registrants must periodically file declarations averring continued use of the marks.

In addition to continuing use and maintaining registration rights, trademark holders must police their rights in a mark against infringers to ensure that they maintain exclusivity of their intellectual property rights for the mark in a particular territory or for a particular class of goods and services. It is an infringement for someone else to use the same or confusingly similar mark to identify the same or similar goods or services in the same territory. To adequately police its mark, a trademark holder must prioritize infringing uses and take reasonable steps to pursue them. Pursuit of a trademark infringement typically involves issuance of a cease-and-desist letter, followed by filing a lawsuit and request for preliminary injunction, if necessary. It is necessary to consult a trademark attorney to establish a procedure for policing your mark and assess whether to pursue infringements.

³ A mark will be deemed generic if it becomes synonymous with the good or service it is intended to identify. ESCALATOR, CELLOPHANE, and THERMOS were all once trademarks in which the owners had exclusive rights. Due to the fame of these marks, the public soon referred to the products by their brand names rather than their product names, consequently rendering the marks generic. For this reason, trademark owners often take steps to encourage reference to the brand and product separately (e.g., ads for “KLEENEX brand tissues”).