

# TRADEMARKS

## **I. What is a Trademark?**

A trademark is a designation, such as a word, slogan, or symbol used to identify and distinguish goods or services. When referring to services, such marks are often called a "service marks." On the other hand, a corporate name (also known as a trade name) is simply the name of a business as registered with the Secretary of State at the time of incorporation. Such registration does not provide any trademark/service mark rights whatsoever.

In the United States, trademark rights are acquired by adoption and use of a mark in association with a product or service. These so-called common law rights exist independently of whether the mark is registered federally or on a state level and such rights continue to exist so long as the mark is used. Since rights generally belong to the first party to use the mark, it is important to conduct a search for possible prior users of confusingly similar marks for the same or similar product before adopting a mark. Trademarks are often used with the abbreviations "®" or TM. An ® denotes a trademark that has been registered with the federal government. TM is used to denote a trademark that is not federally registered.

## **II. Trademark Search**

A trademark search for your mark is advisable to determine whether the mark conflicts with an existing mark. The U.S. Patent & Trademark Office (USPTO) will reject an application to register your mark if consumers are likely to confuse your mark with a mark already registered. A search is therefore recommended to avoid infringement of prior marks, to avoid the expense of application fees when rejection appears likely, and to avoid spending advertising resources on a mark which you may ultimately be forced to cease using because of a third party's prior rights.

There are generally two types of searches: a preliminary on-line screening search and a comprehensive search.

A preliminary on-line screening search includes only a search of the USPTO records to determine whether another mark exists which is *identical* to your proposed mark. This is a very useful screening tool, especially if you have a number of proposed marks.

If the preliminary screening search does not uncover any conflicting marks, you may wish to consider commissioning a more comprehensive search, which includes federal and state registered and pending marks and many common-law sources (e.g., trade journals, phone directories, product registers, Internet domain name registers) to determine if any prior users exist who may have superior rights based on common-law.

The comprehensive search also includes variations of your mark, such as spelling and phonetic equivalents, which are not included in on-line screening searches. Graphic design searches and searches of foreign trademark databases can also be conducted.

## **III. Qualification for Federal/State Registration**

Registration of a mark is not mandatory but there are advantages that flow from federal or state registration. For example, when a federal application is filed, the filing date serves as the constructive date of first use of the trademark and provides the applicant with nationwide priority provided the registration eventually issues. State registration generally does not have as many of the benefits of federal registration but a state registration is virtually assured of appearing in comprehensive trademark searches conducted by others and may deter others from adopting a similar mark.

To qualify for federal registration, the mark must meet the following requirements:

- (a) The mark cannot resemble a mark already in use, and thereby cause confusion among consumers.
- (b) The mark must also be distinctive as applied to the products or services and cannot merely describe the products or services. Furthermore, the mark cannot be primarily geographically descriptive or primarily merely a surname.
- (c) The mark must not dilute a famous mark.
- (d) The mark must be actually in use on the goods or services and must have been used in interstate commerce (use-based application) or the applicant must have a bona fide intent to use the mark (intent-to-use application) followed by actual use prior to registration. Use in interstate commerce includes, for example, shipping the product with a label bearing the mark or by offering the services in more than one state.

A State of Florida registration may be obtained if the mark meets the requirements set forth in paragraphs "a" and "b" and the mark is in use within Florida. You may also "reserve" a mark in Florida prior to use. However, if federal registration can be secured, there is usually no advantage to also seeking a state registration.