

Trademark Registration

A trademark, as defined in the Lanham Act includes any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by the Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if the source is unknown. The term service mark is similarly defined for services. Case law makes it clear that anything that acts to identify a product or service as originating from a particular source, functions as a trademark.

The two principal purposes of the trademark statute are to avoid customer confusion and to protect a trademark owner, who has invested energy, time, and money in presenting the product to the public, from misappropriation by pirates and cheats.

Trademark Protection / Clearance Process

The registration of a federal trademark or service mark with the United States Patent and Trademark Office (USPTO) is governed by the Lanham Act, 15 U.S.C. § 1052(a), a federal statute which specifically outlines the steps, procedures and hurdles that must be taken in order to protect a name, logo, tag line, etc.

The first step in any trademark clearance process is to look at the proposed mark and evaluate it in terms of the goods or services for which it is going to be used. This review may indicate something in the nature of the trademark, or its use, which will immediately show that the proposed mark should be barred from further consideration as a candidate for use or registration. In other instances, this review may show potential limitations or bars to trademark use or registration which should be investigated or weighed. The review could give rise to suggestions for modification of the proposed mark, or the addition of further elements to be included in the search.

The following is a short summary of substantive bars to, or problems with, registration and use which can be detected by a pre-search review :

[A] Generic Name of the Goods

By definition, a generic term is the name of the product or services itself and should be freely available to all who wish to use it. Generic usage is the exact opposite of trademark usage which identifies and distinguishes the goods or services of one source from those offered or sold by other sources. Generic names are not registrable with the USPTO.

[B] Merely Descriptive of the Goods

Section 2(e)(1) of the Lanham Act specifically bars registration of marks which, when used on or in connection with the goods or services of applicant are merely descriptive of

them. A mark is descriptive if the mark "immediately conveys" the ingredients, qualities, or characteristics of the goods or services with which it is used.

[C] Geographically Descriptive

Section 2(e)(2) of the Lanham Act bars the registration of a mark that is "primarily geographically descriptive" of the goods or services. The purpose of this bar is to leave place names free for all businesses operating in particular areas to inform customers where the goods or services originate.

[D] Deceptively Misdescriptive or Deceptive Marks

The Lanham Act has two provisions to protect the public from registration of a mark which will act to deceive them. Sections 2(e)(1) of the Lanham Act bars against the registration of marks which are deceptively misdescriptive, and Section 2(a) bars the registration of deceptive marks. A mark is misdescriptive if it falsely indicates an ingredient, quality, or characteristic of the goods or services. The Lanham Act does not prohibit registration of marks that are solely misdescriptive. It prohibits registration of marks that are deceptively misdescriptive unless secondary meaning is shown. A mark is deceptive under Section 2(a) if the misrepresentation materially affects the decision to purchase the goods, that is, if the misleading information conveyed by the mark gives the product greater marketability. If the goods are desired and then bought, at least in part, because of the misrepresentation, then the purported mark is deceptive under Section 2(a). As such, it is unregistrable under any circumstances.

[E] Geographically Deceptively Misdescriptive

Under Section 2(e)(2), a geographically deceptively misdescriptive mark cannot be registered. If the public makes a misdescriptive geographic association, that is, consumers would believe the goods or services do originate from the place indicated in the mark; but the goods or services in fact do not, then the mark is primarily geographically deceptively misdescriptive.

[F] Geographical Name for Wines and Spirits

Section 2(a) of the Lanham Act bars registration of a "geographical indication" which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods. This restriction only applies to marks first used on or in connection with wines or spirits by an applicant on or after January 1, 1996.

[G] Use of Name, Symbol, or Device of Organization Prohibited by Statute

Federal statutes have been enacted to protect the trademarks, symbols, and devices associated with certain organizations. The statutes bar not only registration, but the improper or unauthorized use of certain words, letters, emblems, or devices. Some examples of names

that are protected from use include The Boy Scouts of America, The Girl Scouts of America, the Red Cross, the Peace Corps, Social Security, Little League, and 4-H Club, among many others.

[H] Immoral or Scandalous Matter

Section 2(a) of the Lanham Act provides that a trademark will be refused registration if it "consists of or comprises immoral . . . or scandalous matter." In deciding whether a mark is considered immoral or scandalous, the USPTO "must demonstrate that the mark is shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscious or moral feeling; ... (or) called out for condemnation." In re Mavety Media Group Ltd., 31 U.S.P.Q.2d 1923, 1925 (Fed. Cir. 1994)

[I] Disparages, Falsely Suggests a Connection, or Brings Into Contempt or Disrepute a Person, Institution, Belief, or National Symbol

Section 2(a) of the Lanham Act bars the registration of any mark that consists of or comprises matter that disparages, falsely suggests a connection with, or brings into contempt or disrepute any person (living or dead), institution, belief, or national symbol.

[J] Flag, Coat-of-Arms, or Other Insignia of the United States, State, Municipality, or Foreign Nation

Section 2(b) of the Lanham Act bars the registration of marks which consist of or comprise the flag, the coat-of-arms, or other insignia of the United States, any state or municipality, or any foreign nation or any simulation of such. This provision does not require either disparagement or false connection since it simply bars the use of such symbols.

[K] The Name, Portrait, or Signature Identifying a Particular Living Individual, or a Deceased President of the United States During the Life of his Widow

Section 2(c) of the Lanham Act bars registration of a mark which consists or comprises a name, portrait, or signature identifying a particular living individual, and the name, signature or portrait of a deceased president of the United States during the life of his widow, unless written consent of the particular living individual or widow is obtained.

[L] Primarily Merely a Surname

Section 2(e)(4) of the Lanham Act provides that no mark shall be registered if it is primarily merely a surname. It can be registered, however, with a showing that the mark has acquired distinctiveness from the name itself

[M] Non-Ownership of the Mark

As a general rule, Section 1 of the Lanham Act provides only the owner of a trademark used in commerce may register its mark under this chapter. The question of ownership of a mark, as among several parties cooperatively using a mark in connection with the sale of goods or services, presents little problem if the companies are related. The USPTO has developed operating rules for related companies. However, situations arise which actively raise the question of ownership that should be dealt with during the initial review.

[N] Proposed Mark Does Not Function as a Trademark

A mark can only be registered as a trademark or service mark if it functions as a trademark or service mark. There are a number of instances where the uses of proposed marks are in actuality not trademark or service mark uses and as such are barred from protection under the Lanham Act as set forth below:

[1] Exclusive Trade Name Use

If the proposed mark functions only as a trade name, it is not registrable;

[2] No Goods or Services

The proposed mark must be used on goods or in connection with services made available to the public. Thus, if the goods or services are not made available to the general public, the proposed mark is not registrable;

[3] Merely Informational

Where a purported mark, typically a word or slogan, is merely informational it does not function as a trademark and is not registrable. The test to determine whether a mark is merely informational is whether it would be perceived by the relevant public as a source indicator, or merely an informational designation;

[4] Functional

The design of a product ("product configuration") and packaging, can be a trademark, provided it is not functional and the design functions as an indication of source.

[5] Ornamental or Decorative Feature

If an ornamental or decorative feature of goods, or packaging for the goods, does not identify or distinguish the goods, it does not function as a trademark and is nonregistrable.

[6] Book, Album, and Play Titles and Fictional Characters in Same

Normally, a title of a single creative work such as a single book, record or compact disc, video, play, or the like, is considered merely descriptive of the contents of the work.

[O] Unlawful or Improper Use in Commerce

In order for a "use in commerce" to be considered as a basis for federal registration, it must be lawful use in commerce."

[P] Phantom Marks

A phantom mark is a mark having a portion designated by X's, dashes, or blank spaces into which may be inserted one or more words. For example, "LIVING - - - FLAVORS" into which a specific, herb, fruit, plant or vegetable name could be inserted. While initially, the USPTO did register several such registrations including "NOBODY KNOWS - - - LIKE BEST WESTERN, or " - - - FOR DUMMIES, the Federal courts have recently found that such phantom marks are improper since they do not specifically designate a single mark, but a large, possibly unlimited group of marks, each of which would require a separate application.