

Trademark Basics

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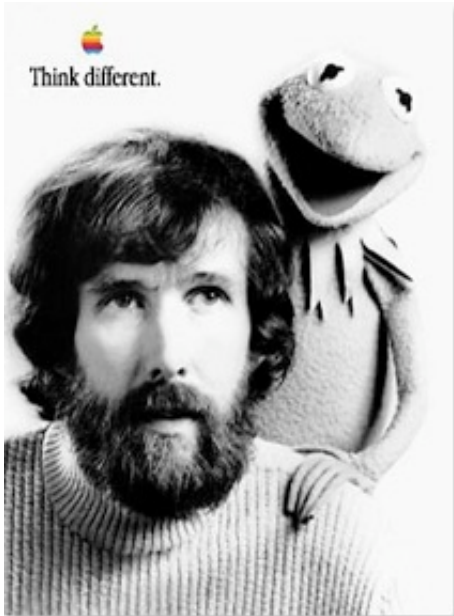
What is a trademark?

Trademarks identify and distinguish the source of products. Likewise, service marks identify and distinguish the source of services. The law is virtually the same for trademarks and service marks and, here, the discussion of "trademarks" or "marks" refer to both. Trademarks allow customers and potential customers to more easily find or know what company is responsible for a product or service. Federal and state trademark laws allow a company to prevent others from using similarly confusing marks.

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Brand owners commonly use names, slogans and logos as trademarks. Depending on the size and type of business, a brand owner can have a variety of different trademarks. A business typically uses a **name** that serves as an overall trademark used to identify its products or services. For example, "Apple" is a trademark for Apple Inc. and used as a source identifier for a wide range of products. Apple's many computer devices and software applications all feature the "Apple" trademark name, which serves to identify the company as the source of those products. In addition to using the company's name as a general trademark for

all of its products, brand owners often use trademarks to identify its particular products. For instance, Apple has individual product trademark names such as "iPhone," "iPad," and "MacBook" that are just as strong as its umbrella "Apple" trademark.



Distinctive **slogans** are also protectable as trademarks. Slogans are a way for a company to more explicitly communicate the qualities, characteristics or a description of its business to the public. Apple's "Think Different" slogan is a good example of this.

Logos are another way to identify a product's source. So, in addition to the name "Apple" and individual product names, Apple affixes to all of its products the silhouette of an apple with a bite taken out of it. This type of non-verbal trademark is a powerful way to visually convey a products source and the qualities and characteristics associated with it.



The **stylization** or **coloring** of words can also function as a trademark. The blue, red, yellow, and green coloring of Google and Gmail has its own source identifying significance apart from the words themselves. If another web search or email provider were to use a word other than Google as a trademark, but rendered it in a similar blue, red, and yellow combination, that could be considered similarly confusing to Google's trademark.

What are the differences among trademarks, copyrights and patents?

Trademarks should not be confused with copyrights, which give a copyright owner the right to prevent others from copying creative expression without permission, or patents, which allow the holder of a patent the right to prevent the non-authorized making, selling or using of an invention. Trademark law is limited to identifying source and only gives trademark owners the right to exclude others from using trademarks that would cause confusion in the marketplace. Products and services may sometimes be protected, however, by all three intellectual property areas. For example, a new product may have patents covering any of its components that are a novel invention, copyright protection for any its decorative or ornamental features, and trademark protection for the name or logo used to bring the product to the market.

Is there anything other than words, names or graphic design elements that can serve as a trademark?

Yes. In addition to these traditional trademarks, almost anything that can function as a source identifier is eligible for trademark protection. For instance, a sound can serve as a trademark. Two well-known examples are the NBC chimes (the first audio trademark registration to be granted) and the Intel five note sequence. Hearing either of those sounds lets consumers know that the advertised product is connected with NBC or Intel. In addition to sound marks, other nontraditional trademarks include color, product configuration, product packaging, or even scent. Keep in mind, however, that these non-traditional trademarks cannot be functional.

When do trademark rights begin?

In the United States, trademark rights are established when a mark is used in connection with the sale of goods or the provision of services. This use-based requirement matters for a couple of reasons. To begin with, a brand owner can have a trademark without federal registration of a mark in the geographical area the goods using a trademark are sold. These are known as a common law trademarks.

Although federal trademark registration confers important benefits, action against infringement should not be postponed until registration is secured—if infringement is discovered, a brand owner should seek out a trademark attorney for advice. In addition, federal registration of a trademark requires that the mark is used in commerce, which requires the sale of goods or provision of services across state lines. Whether an application is based on existing use or whether it is based on an applicant's genuine intention to use the mark in the future, to secure registration the applicant must show the Trademark Office evidence of use. Also, even though an applicant may search the Trademark Office database for similar registered marks, a trademark may be exposed to infringement by common law, unregistered trademarks. This is why in many situations trademark attorneys recommend that an additional comprehensive search be performed to discover any potentially infringing common law trademarks.

Generally, the first to use a trademark has priority over subsequent users of the mark. This means that if two businesses are using a similar trademark, the business that first used the mark has the right to stop later users of the mark if there is likelihood of confusion. Determining priority of use takes into account the extent of protection for the geographical area a trademark is used and whether a trademark has a federal registration. An exception to the United States first-to-use rule, is that an individual or business can file an intent-to-use application, which gives priority to a trademark owner based on the filing date of the application even if the mark has not yet been used in connection with the sale of a product.

How are the symbols TM and ® properly used?

The short answer is that the ® symbol is used for trademarks or service marks that are federally registered. The TM symbol is used to assert trademark rights that have not been federally registered.

But to better understand the difference between the two symbols, you need to know that trademark rights begin with use of a mark and, if a trademark is inherently distinctive, trademark rights begin the very first day a product is sold in connection with the trademark or a service is provided using a service mark. These trademarks based on use are known as common law trademarks, but the right to prevent competitors from using confusingly similar trademarks is limited to the geographical area in which they are used. The owner of these common law trademarks can use the TM symbol next to the logo or brand name. It is a brand owner's way to tell the public and competitors that a trademark is being claimed.

A federally registered trademark, on the other hand, extends trademark rights beyond the geographical area a mark has been used to protection nationwide. Federal registration also creates a presumption of trademark validity and ownership and gives the registrant the sole right to use the trademark in connection with the goods and services for which it is registered. The ® symbol gives notice to the public and competitors that federal registration has been obtained. The actual notice function of the ® symbol is also helpful in the event that a trademark owner seeks profits or damages in a trademark infringement lawsuit. Be aware that only federal registration, not state registration or common law trademark rights, allows use of the ® symbol.

Many owners of federally registered trademarks will continue to use the TM symbol despite their legal right to use the ® symbol. Sometimes the reason for this is that a brand owner simply hasn't gotten around to changing the symbol. Other times, a trademark owner has not obtained registration in all of the countries where its product is sold or a service is provided. Many countries also require registration from their own trademark offices in order for companies to display the ® symbol. So even though a company may have secured United States registration, use of the ® symbol in a country where registration has not been obtained would violate that country's trademark laws.

These answers to frequently asked questions are for informational purposes only and may not be relied on for legal advice. Please consult Armistead Law or another licensed attorney for legal advice.