

**SELECTING AND PROTECTING YOUR  
TRADEMARKS**  
by Maria E. Recalde

*What's the difference between copyrights and trademarks?*

Copyrights protect all original creative tangible works of authorship. Copyrights protect a wide variety of works including, web site designs, data bases, sound recordings, all original creative expressions contained on a web site, including the text and the source code for any software associated with the site. Under the Copyright Act, copyright owners have, among other things, the exclusive rights to reproduce the work, prepare derivative works based on the work, and distribute copies of the work. In general, the copyrights in any given work vest in the work's author, that is, its creator, from the moment of the work's creation, whether or not the work has been published, with or without registration in the U.S. Copyright Office, and with or without a copyright notice being placed on the work.

A trademark is any word, name, symbol or device, or a combination of both, used to identify the source of goods of one party from those of others. Marks used to identify services are also known as service marks.

*What's the difference between a company name and a trademark?*

A company name or trade name is the name under which an organization does business. It is not necessarily a trademark. There are instances where the same word may be used as both a trade name and a trademark. For example, "Westinghouse" is used as a trade name in Westinghouse Electric Corporation and as a trademark in Westinghouse® refrigerators. Trade names represent the reputation of the business as a whole rather than a single product or service.

*What's wrong with selecting a mark that "merely describes" your company's goods or services?*

A descriptive mark, predictably, describes the services or goods with which the mark is used. Descriptive marks do not receive any trademark protection unless their user has used them in commerce and has built up secondary meaning. "Secondary meaning" occurs when consumers identify the goods or services on which the descriptive term appears with a single source. A well-known example of a trademark that was considered descriptive and non-enforceable in the United States was RAISIN-BRAN for bran cereal with raisins. Naturally, adoption of these types of trademarks should be avoided since they will not be enforceable against third parties unless they have obtained "secondary meaning".

***Why is selecting a “made-up” mark a better option?***

Made-up marks, called fanciful marks (e.g., “Kodak” for photographic supplies) generally receive a lot of protection. A fanciful trademark is one that is created for the sole purpose of functioning as a trademark or service mark, such as KODAK. Fanciful trademarks are the strongest trademarks because they are invented and few competitors may claim that they accidentally adopted the same trademark.

Slightly less strong than fanciful marks are arbitrary marks, words that have some meaning to the public but, when used in connection with the relevant goods or services do not immediately suggest or describe any quality of the goods or services, such as APPLE for computers. An arbitrary mark may be a strong trademark unless a number of other trademark owners have adopted the same or similar mark in other fields.

***Why should you conduct a search for conflicting marks before you start using it?***

The company’s marks may not be confusingly similar to existing marks of other companies that were using the mark first in connection with similar goods or services. It is therefore important that a search for conflicting marks be conducted before any investment is made in advertising and promotional materials; not only because you do not want to invest in a mark you cannot use, but because you do not want to infringe on another’s prior right to the mark. The factors to be considered when analyzing the likelihood of a new mark being confused with a pre-existing mark are many, but it is important to recognize that, if an element of a third party’s pre-existing mark is used in the new mark, there is a possibility of conflict.

***Do you need to have your mark registered with the United States Patent and Trademark Office to protect it?***

No, a trademark does not have to be registered with the U.S. Patent and Trademark Office (USPTO). Trademark rights are usually judged on a priority basis. In general, the first person to use a mark has a superior claim to use of that mark. Most states have trademark protection laws and simple procedures for registering a trademark. State registration is usually only effective within that state and not effective for businesses engaged in multi-state operations. The federal registration process is more complex, but provides numerous important benefits, including: (1) the right to use the ® symbol in conjunction with the mark; (2) the ability to record ownership and transfer of the mark; (3) the right to sue infringers in federal court; (4) the benefit of statutory presumptions as to the mark’s ownership and validity; (5) the right to certain statutory remedies in the event the mark is infringed. Federal registration also constitutes nationwide notice of the company’s rights in the mark; something that is particularly important in the business’ initial launch is limited in geographic scope.

***When can I use the trademark symbols TM, SM and ®?***

Any time you claim rights in a mark, you may use the “TM” (trademark) or “SM” (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO. However, you may use the federal registration symbol “®” only after the USPTO actually registers a mark, and not while an application is pending. Also, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration.

*Maria E. Recalde is a partner in the Boston office of Sheehan, Phinney, Bass + Green, PA. She is a member of the firm’s Business Litigation and Intellectual Property and Technology Practice Groups. She may be reached at mrecalde@sheehan.com or 617.897.5620.*

© 2006 Sheehan, Phinney, Bass + Green, PA. All rights reserved.

SHEEHAN PHINNEY BASS + GREEN, PA  
A Regional Business Law Firm  
Innovative Approaches. Practical Solutions.

[WWW.SHEEHAN.COM](http://WWW.SHEEHAN.COM)