

What is in a Name?



PRESENTED BY THE BOUSQUET HOLSTEIN PLLC
INTELLECTUAL PROPERTY PRACTICE GROUP



BOUSQUET HOLSTEIN PLLC

Formerly known as Green & Seifter, Attorneys, PLLC



A trademark ("mark") is a word, name, symbol, or device used individually or in combination. The mark is used by a company or individual to link, "brand", or identify the goods and/or services with the individual or company that sells them. The trademark connection is that small mental synapse that links the name of the product or service to a company. For example, when someone mentions the name Coca Cola® you think of a range of products. No further description of the product is required.

Trademarks include trade names, brand names, service marks, collective marks, trade dress, and certification marks as well as actual trademarks.

WHY IS IT IMPORTANT?

If your business name cannot serve as a marketing tool, then you have wasted time and money securing the business name. A strong trademark gives your business the ability to distinguish itself from other producers or providers in your market. With a strong trademark you will be able to prohibit others from capitalizing on your marketing efforts and goodwill.

TRADEMARK SPECTRUM

Trademark strength or distinctive nature determines the level of protection and prohibition available to you. There are five general categories to consider: These categories are as follows:

Generic: The "Car" Company (manufacturing cars). Because all car makers use the word "car" in connection with the manufacture of the product, no exclusive right to use the word "car" is possible. Generic marks can not be registered and common law rights will not attach to a generic mark.

Descriptive: Good Italian Pizza - This mark is descriptive if the product is pizza. No protection to this mark will be possible unless it can be proven that the mark has acquired "secondary meaning".

Suggestive: BeautyRest® (mattress manufacturer), Chicken Tenders® (boneless chicken pieces). Suggestive marks connote the product or service, but fall short of describing it.

Arbitrary: Apple® (computer manufacturer), Hostess® (baked goods). These marks have a commonly known meaning, but that meaning does not relate to the product or service for which the mark is used.

Fanciful: Intel® (Semiconductor and microprocessor cartridges), Kodak® (photographic prints and enlargements), Xerox® (copies of typewritten or printed material), Avis® (automobile rental). The name of the product or service is distinctive and conveys no direct information about goods and/or services.

WHAT IS A STRONG MARK?

Trademarks that are fanciful, arbitrary, or suggestive are considered strong trademarks. Fanciful marks are considered stronger than suggestive marks, and therefore are more easily protected in court.

WHAT IF I JUST WANT TO DESCRIBE WHAT I DO/ SELL?

Marks that are descriptive cannot be registered initially, but can be registered once they have established what is known as a "secondary meaning." For example, the application for Waffle House® (restaurant services) was initially opposed by the examining agent as both generic and descriptive. The applicant expended significant funds to submit over 400 pages of documentation to demonstrate that the mark was not considered by the public as generic and that it had attained secondary meaning. The mark was registered.

It may be necessary to use a logo or design to avoid the problem of a descriptive mark.

HOW DO I CHOOSE THE RIGHT NAME?

Naming a product or a service is not easy and it can be very frustrating. The name should combine the business purpose for the name and its marketing identity. Naming can be an expensive process from a marketing, design and legal perspective. However, those costs pale in comparison to the marketing and legal costs that will be incurred if the name turns out to be too difficult to market or is in use by someone else.

WHERE DO I BEGIN?

Tips to naming -

The natural tendency of a person or business is to pick a name that describes what it is that you sell or do. It is tempting to call the company's consulting business for business executives "CEO Consulting." This is a weak mark which cannot be registered without demonstrating a "secondary meaning." This is not a recommended start for a mark. Stay open to all possibilities. Resist the natural tendency to "label" and "categorize" the company.



Who is your customer? Visualize the end use of the product or service and think of the name that would attract them. Are there certain qualities of your product that you want to emphasize? For example: Chicken Tenders®. Is your product produced in a special location? For example: Stonewall Kitchen®. Are there unusual characteristics of the product or your customer base? Does your product present a solution to a problem?

Is the name easy to say, read and spell?

Does it have any negative meaning—connotative or in translation into a language which may be a target market? Is it easily adaptable to advertising media and positioning in connection with the product or service?

Does it convey the feeling you want to achieve? For example, sports equipment needs a name which conveys action or safety. A meditation and massage service should inspire tranquility

WHAT DOES REGISTRATION DO FOR MY BUSINESS?

Registration will permit you to prevent all others in the United States from using your mark in connection with the goods and/or services that you sell. Registration permits you to expend monies to build your brand and goodwill.

After five years—with the appropriate maintenance affidavits filed with the PTO, your company will own the right to use the name even against a prior user and be able to prevent all others from using the trademark. A prior user may be able to continue to use a mark, but the use will be limited to the use of the mark as it existed at the time of your registration.

Further, you will be able to access the federal courts to enforce your rights to the trademark, claim damages and attorney fees in an infringement action. The fact that you have a registration number often will ward off infringers who receive your cease and desist letter.

DO I HAVE TO REGISTER MY TRADEMARK WITH THE PTO?

Registration with the United States Patent and Trademark Office is not mandatory. However, it is highly recommended. If you have been doing business for many years without the protection of registration, it is possible that a more recent user of a mark similar to your mark may have registered the similar mark. If the mark is likely to cause confusion with your mark and five (5) years have elapsed since the more recent mark was registered, your ability to make use of your mark in commerce will be limited as a prior user.

HOW LONG DOES IT TAKE TO REGISTER A TRADEMARK?

Generally the process is completed within 12 to 14 months. Most submissions to the PTO are accomplished electronically. Depending on your needs and documentation, the application will be submitted within a week of our initial meeting. If you are in a rush, the application can be filed more quickly. However, because certain aspects of the application cannot be amended after filing, it is important to take the time needed to secure accurate information before submission. For example, the ownership of the mark must be decided before submission. The application process will be significantly shorter if the examining agent at the PTO does not file challenges or require changes (documented in "Office Actions") to the application.

HOW DO I BEGIN?

SEARCH PROCESS:

Whether or not the name is available is a determination that cannot be made as an absolute "yes". The determination that the name is NOT available is much easier to ascertain. The question is whether or not your mark is likely to be confused with a prior mark.

That decision is based on a number of

factors, the most significant of which are the mark itself and the nature of the service or product on which or for which the mark is to be used.

You can conduct informal searches using internet search engines. If the mark is used currently for the type of product or service that your company will offer, the mark is most likely not available. You may want to discuss the results of your search with us. If your mark is to be used in interstate commerce and if you intend to invest considerable dollars into goodwill and name recognition, it is recommended that you consider conducting a more formal and extensive search for conflicting marks.

REGISTRATION PROCESS

Application

Once a decision is made to register your trademark, Bousquet Holstein PLLC will prepare and submit your Application to the PTO. The Application must specify your "basis" for filing. If you have already used your mark in commerce, you may file under the "use in commerce" basis. If you have not yet used the mark but plan to do so in the future, you may file under the "intent to use" basis.

Legal and Procedural Review of Application

Approximately 3 months from the date your application is filed, your application will be assigned to an examining attorney or the PTO. The examining attorney will review and approve your trademark or raise a legal concern with the mark. If any filing or legal issue(s) arises during the examining agent's review, Bousquet Holstein PLLC will be notified. We will advise you of any changes to the application or additional requirements based on the examining agent's concerns.

Notice of Publication

The PTO publishes your application for registration of new mark in The Federal Register. If someone wants to oppose your mark, an "opposition" to your mark must be filed within 30 days of publication.



Registration Certificate

If no opposition to your registration is filed with the PTO within the 30-day period, the PTO will issue a registration certificate approximately 12 weeks after publication for a "use in commerce" application.

If you have filed an "intent to use" application, the PTO will issue a Notice of Allowance approximately 8 weeks after publication. Bousquet Holstein PLLC will contact you and advise you as to the need to file a Statement of Use which states that you are now using the mark in commerce on all the goods and/or services described in the application. The Statement of Use must be filed no later than 6 months from the issue date of the Notice of Allowance. Extensions of time are available.

The PTO will issue a registration certificate approximately 2 months after the Statement of Use is filed and approved.

CAN I REGISTER IN NEW YORK STATE?

Additional protection for your mark is available at the state level. New York permits the registration of marks for goods and services performed or delivered in New York.

The application is typically completed after the federal registration is concluded. Each state has its own registration requirements and scope of protection. The state registration protection may be broader than the federal protection, but the state cannot limit the federal protection.

DO I HAVE TO DO ANYTHING AFTER THE MARK IS REGISTERED?

Maintaining Federal Trademark Registration

In order to maintain your trademark protection, additional filings after completion of the registration process are required. The registration certificate advises you of these dates. The maintenance documents are as follows:

Declaration of Continued Use or Excusable Nonuse must be filed between the 5th and 6th year after the date of registration. A Combined Declaration of Continued Use and Application for Renewal must be filed between the 9th and 10th year after the date of registration. The same filing is required every 10 years thereafter.

The PTO does not send reminder notices when the documents are due. You will need to calendar these dates to be sure that you comply. Failure to make these required filings will result in cancellation and/or expiration of the registration.

Enforcement and Abandonment

In the event that you discover an infringing use of your registered trademark, it may be necessary to send a cease and desist letter to the infringer. If you fail to enforce your mark it may be deemed by the PTO to have been abandoned. While a single instance is not likely to produce this result, a pattern of neglecting the mark places the registration at risk.

ABOUT THE BOUSQUET HOLSTEIN PLLC INTELLECTUAL PROPERTY PRACTICE GROUP

We offer clients the ability to integrate and retool their current business operations or explore and develop new opportunities in the worldwide marketplace. As our clients rely increasingly on technology and the internet, we have expanded our Intellectual Property Law Practice Group to address the full range of issues that arise in technology and business transactions.

We provide services to our clients in the areas of trademark and business name acquisition and protection, including development and registration of trademark and business names, development and enforcement of non-compete agreements, and confidentiality and nondisclosure agreements. Our attorneys are experienced in software development and licensing, including Internet commerce, web site development, web site hosting, and site linking and content licensing. We provide guidance in relation to intellectual property law and the workplace, such as internet use policies, invention rights, confidentiality agreements, and employee restrictive covenants. We also handle consultant (independent contractor) arrangements, copyright protection, and publisher agreements.

As the emphasis on technology has grown, so has our attention to the needs of clients in the computer and telecommunications field, as well as those who simply contract with vendors for computer services or who have developed relationships that require contract, license or related protections. Our Intellectual Property Practice Group draws on the firm's extensive business experience to integrate the business needs of the client with the special requirements of technology and intellectual property by collaborating with the Business Transactions and Telecommunications Practice Groups. FOR MORE INFORMATION, PLEASE VISIT WWW.BHLAWPLLC.COM

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