



YOUR BRAND HERE

The Entrepreneur's Guide to
Choosing a Strong Trademark

**BROUGHT TO
YOU BY**



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INTRODUCTION

Hey there, Entrepreneur.

I'm Matthew Goings. I'm a startup attorney, and I help entrepreneurs legally launch, grow, and protect their ideas. Because branding is such an important part of entrepreneurship, I wrote this short guide to educate entrepreneurs on some trademark basics. This guide won't make you an expert, and it won't teach you how to file your own application, but it **will** help you make smart branding decisions.

One of the most commonly asked questions I see is "Do I really need an attorney to file a trademark application?" I've seen many "reasons" to not hire a trademark attorney.

- It costs too much.
- I can do it myself.
- It's just filling out a form. How hard can it be?
- I'll get advice on Reddit/Quora/Avvo.
- LegalZoom is cheaper.

I'm sure you can think of other "reasons" to not hire a trademark attorney for your trademark application, but have you ever considered why you **should**?



Notice I said "application" not "registration." Why? A trademark application doesn't guarantee you a registration. There are many factors and risks to consider, and a trademark attorney will help you identify and navigate those barriers.

A trademark attorney will help you create a strong mark.

A trademark attorney can run a comprehensive search and analyze the results.

A trademark attorney already knows the application process.

A trademark attorney can craft language that gives you broad protection.

A trademark attorney can advise you on when you **SHOULDN'T** apply for a mark.

When you're building a business, both time and money are money. Don't be "penny wise, pound foolish". Invest early to hire an expert to build strong protections while you build a strong business.

Just click the shield below to begin your entrepreneurial journey with the right legal partner. HINT: that's me!



TRADEMARKS 101

What is a trademark?

A trademark is a word, phrase, symbol, and/or design that identifies and distinguishes the source of the goods of one party from those of others. A service mark accomplishes the same purpose for services rather than goods, but they are both commonly referred to as trademarks.

TL;DR: Trademarks identify brands.

TM vs. ®

You may see the TM, SM, ® symbols used next to company names or slogans. These marks put others on notice that you are using the words or symbols as a trademark for your goods/services, not merely descriptors or generic terms.

NOTE: YOU MAY ONLY USE ® IF YOU HAVE OBTAINED A REGISTRATION FROM THE USPTO FOR YOUR MARK.

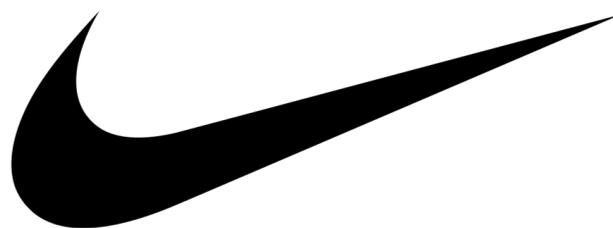


What purpose do trademarks serve?

1. Protect the consumer.



SCENARIO: You want a pair of NIKE running shoes. The store has hundreds of shoes, all different styles and companies. How do you choose the right one? You look at the trademarks. Even without words, you can still distinguish brands by the logos.



TAKEAWAY: Trademarks allow consumers to differentiate between sources of goods and services. Certain standards and characteristics become associated with the trademarks. Without those trademarks, consumers would be unable to distinguish between products of superior and inferior quality. Similarly, you have certain expectations whenever you enter a franchised business.

What purpose do trademarks serve?

2. Protect the business.



SCENARIO: You have been selling your product for years and have gained recognition as a quality brand in your market. A competitor begins to use a mark similar to yours. Can you prevent this? Yes, because you have a trademark, you can stop the competitor from using a name or logo that is too similar to yours.

TAKEAWAY: Trademarks distinguish you from your competitors, allowing you to stand out to consumers. They also protect your goods or services from misuse by competitors. Each of the 3 companies on the previous page can sell "running shoes," but they can only use their own names or logos; NIKE cannot associate the PUMA or ADIDAS name or logo with their (NIKE) own running shoes, and vice versa. This prevents competitors from profiting from the goodwill that you build with your brand and also prevents the degradation of your brand through inferior 3rd party products.

The protection can also extend to names other than the main brand name. For example, APPLE can not only prevent the use of the APPLE name in electronics, they can prevent the use of MAC/MACINTOSH and even the "i" like in iPhone or iPad.

Principal vs. Supplemental Register

The USPTO maintains 2 trademark registers. By default, an application is to the principal register. In order to register on the supplemental register, the applicant must request it or approve an Examining Attorney's recommendation that it be moved.

Principal

- distinctive marks only
- mark presumed valid
- registration owner presumed to be valid mark owner
- constructive notice to third parties
- can become "incontestable" by filing Section 15 after 5 years
- can file on 1(b) "intent to use" basis
- can use ®
- prevents registration of confusingly similar marks
- can sue under federal law
- can register with US Customs to prevent importation of counterfeit goods

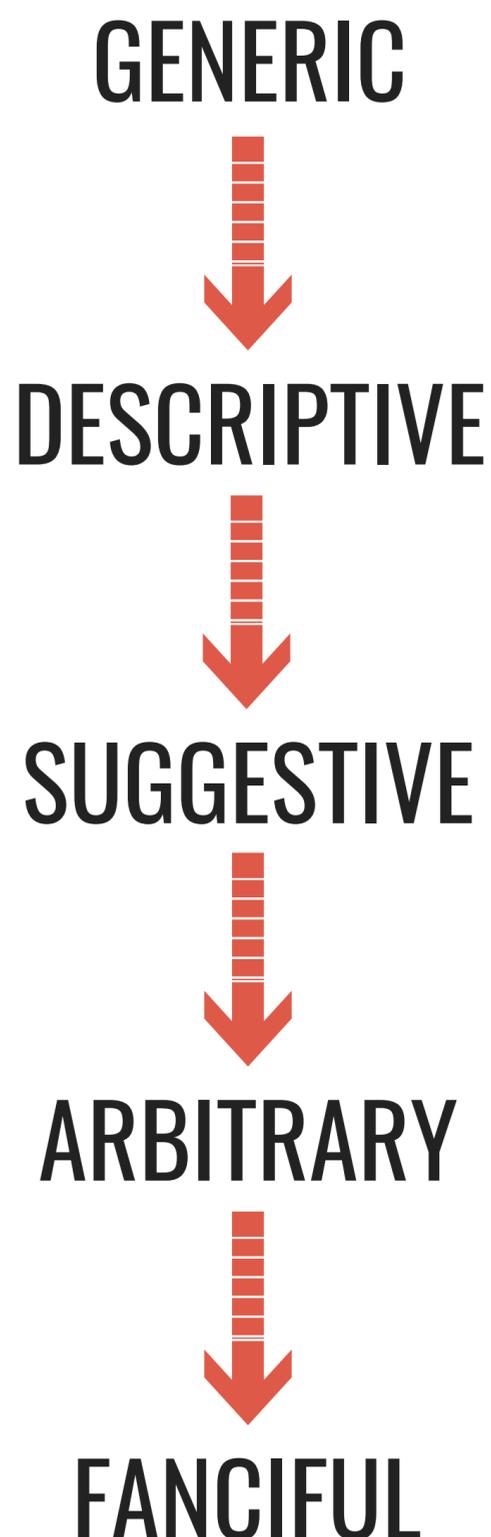
Supplemental

- nondistinctive marks only
- no presumption of validity
- no presumption of ownership
- no constructive notice
- cannot become incontestable
- cannot file 1(b) "intent to use." must be in use
- can use ®
- prevents registration of confusingly similar marks
- can sue under federal law
- can apply for principal register after 5 years
 - still must prove distinctiveness, but time on supplemental counts as evidence

DISTINCTIVENESS

A trademark that properly identifies the source to a consumer has "distinctiveness." The less related to the goods/services the mark is, the greater the distinctiveness of the mark. Some marks have "inherent distinctiveness," which means they immediately identify the source. Other marks take time to acquire "secondary meaning" or "acquired distinctiveness".

There are 5 levels distinctiveness in trademarks. Each level of distinctiveness has a broader scope of protection than the previous. The more distinctive a mark is, the more different another mark must be to not infringe.



GENERIC



Generic terms are the common names of goods and services. Generic marks are the weakest of marks. In fact, they can **never** receive protection. They are not registerable, period.

Look at the two images above. What would you call the things in the images? If you said "trampoline" and "escalator," then you have correctly identified their common/generic terms! Each of these terms used to be trademarks for the products, but they became synonymous with the products (this process is called genericide). Now, anyone can use the term.

TAKEAWAY: When choosing a trademark, do not choose the easy, generic name. You will not create a distinguishing brand, and you will be unable to prevent others from using the name as well. If you pioneer an industry, it's all the more important to create both a brand name **AND** a generic term for the product.

DESCRIPTIVE



Airport Parking

Tito's



Handmade
VODKA



Descriptive marks operate as you might think. They describe the source ("Tito's"), the goods/services themselves ("handmade"), and include laudatory terms. These are weak marks as they do nothing to set your brand apart from other goods or other providers.

Descriptive marks are not inherently distinctive. They are registerable on the principal or supplemental register, but the owner must prove that the marks have "acquired distinctiveness" before they can be registered on the principal register. Acquired distinctiveness means that the mark has gained a secondary meaning as an identifier for a single source. This usually happens through exclusive use over a long period of time.

TAKEAWAY: While it may be tempting to use a name that describes your goods/services so people easily know what you provide, it may take much more time to create a distinctive, registerable brand, and there is a high burden of proof. Some may **never** become a registerable brand.

SUGGESTIVE



AIRBUS

GREYHOUND



Suggestive marks hint at the goods/services provided without actually describing them. They require a "leap of intuition" to get from the mark to the goods/services. Suggestive marks are the first level to have inherent distinctiveness. They can be registered immediately on the principal register. Because the mark is distinctive on its own, you don't have to **PROVE** that consumers associate the goods/services with **YOU**.

You likely recognize at least 1 of these marks. You may not immediately know what goods/services they provide like a descriptive term, but you might be able to infer it. For example, CHICKEN OF THE SEA is not literally chicken that comes from the sea. Rather, chicken is a common meat, and tuna is a common fish, so tuna might be described as the "chicken of the sea."

TAKEAWAY: Suggestive marks are a great way to engrain your brand in the minds of consumers or make a statement about your goods/services. GREYHOUND implies that it is a fast way to travel because greyhounds are known for being fast racing dogs, and CHICKEN OF THE SEA is clever, so it sticks in the mind .

ARBITRARY

CAMEL



Canon

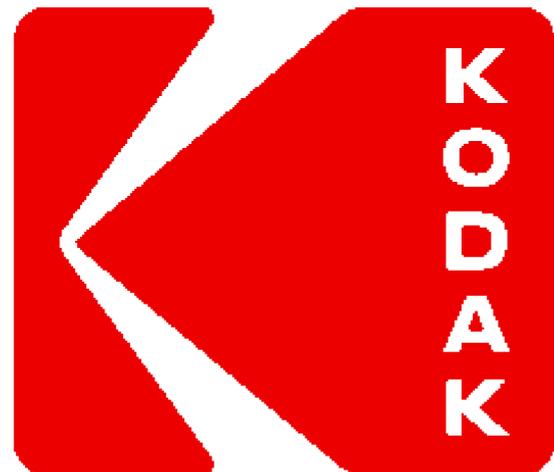
Arbitrary marks are real words that have no relation to the goods/services provided. Because they have no relation to the goods/services, they are inherently distinctive and can immediately be registered on the principal register.

There are multiple benefits to arbitrary marks. They're easy to defend against infringement, easily recognizable to consumers, and unlikely to suffer from genericide.

TAKEAWAY: Arbitrary marks can easily create a recognizable brand. However, you should be careful not to create confusion with the mark. While an arbitrary name might give broad protection, naming your TV company "AUDIO" would likely confuse consumers.

FANCIFUL

XEROX®



Fanciful marks are words that are made up. Because the mark is a word that exists only to indicate the source of goods/services of the owner who created it, it is inherently distinctive.

These marks have the broadest protection because any use by a third party would immediately cause confusion as to the source of goods/services. A consumer who sees the mark would think that it was related to the original. However, being an invented word does have its drawbacks. Because it is a new word, it may take some time to gain recognition or even for consumers to remember.

TAKEAWAY: To get the broadest protection available, consider making up your own word. Remember, if it's a new product in the market, the trademark/brand name and what you call the product should be different in order to avoid losing your trademark rights to genericide. You'll also need to police the use of the mark to make sure it doesn't go the way of the trampoline. XEROX and VELCRO have had to fight this off.

HIRE ME

I hope you found this information helpful and not too dry. If you think your branding is ready for registration, schedule your TM Process Call by clicking my logo below! Have other questions or needs? Check our other options by clicking the my logo.



TESTIMONIALS

Still not convinced you need an attorney or that Goings Legal is right for you? Check out what others have to say about us!

C. Leamon

"Matthew is very professional, and even when we miss his emails during busy seasons he is sure to contact us to follow up and stay on top of everything. His pricing is fair, and he's empathetic towards small business needs. We've been very happy with his work!"

J. Lawrence

"If you are starting a business you definitely want to hire Matt to ensure you are legally protecting your brand and your assets! Matt is truly a one stop shop because after he handles all the business formation paperwork for your business he can then protect your brand and product by trademarking it for you! He is knowledgeable and is very informative. He enjoys teaching his clients along the way so they understand the importance and value of what he does for them so they can share with others!"

M. Wetherington

"I am an attorney and small business owner. I highly recommend Matthew for his patience and willingness to take time to understand my goals and guide me through the process of meeting those goals. If you are a small business owner -- especially in the tech space -- hire him now!"

T. Leftwich

"I reached out to Attorney Goings to help with legal questions I had about a trademark. He was very knowledgeable and easy to talk to. Definitely recommend."