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To: Future Client
Re: Trademark Primer

Dear Inquiry:

This is a primer on trademark basics. It presents the issues that you should be aware of and the common misunderstandings and misconceptions that first-time inquiries tend to have. It will be highly valuable for both of us if you read this report before our first consultation! Then we can spend your consultation time applying these principles to YOUR case.

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What trademarks are for

A trademark designates you as the rightful owner of a **brand in commerce**. It is an important legal instrument because it signals to consumers the origins of goods and services. When a shopper buys an iPhone, she expects the quality and features of an Apple brand smart phone, not a cheap flip phone that someone is selling from a street corner suitcase with the name *iPhone* on the box.

When you own a trademark, you can lawfully stop others from using the **same trademark** for the **same goods or services** in the **same geographic region**. You can also **license** it for others to use in exchange for royalty payments. You “own” your trademark simply by using it first. Registering your mark with the USPTO extends your territory nationwide, and creates irrefutable evidence of your first date of use. This is valuable because, if you get into disputes with someone over dates or territory afterward, it can be difficult to prove when and where you first used an unregistered mark.

What trademarks are not for

Think of a trademark as a red light, not a green light. You don’t need to register your mark to go into business.*

One of my most common requests comes from people who want to monopolize a **catch phrase, tagline, or hashtag**. Someone will call and say, “I just thought of a cool slogan: *I Identify as Human*.† It will represent universal solidarity of men and women across borders. I want to start a hashtag and print this slogan on T-shirts and bumper stickers. I don’t want anybody else to use it without buying the rights from me!!”

The problem here is that this catch phrase is not a brand being used to sell goods or services. Remember the purpose of a trademark, to assure consumers of the origins of items they buy. If there is no underlying product, then there is nothing to protect the consumer from. The person who made up this phrase is not in the business of making T-shirts or bumper stickers. He just wants to put this phrase on them. The USPTO calls that an **ornamental** use, and it is not registrable. T-shirt trademarks are for *Hanes* and *Fruit of the Loom*, who design and manufacture shirts and have their brand name on the tags.

There is another legal instrument for protecting ownership in text for text’s sake, and that is the copyright. However, the shorter the literary work, the weaker the copyright protection. There is no legal limit to what copyright will protect, but realistically it won’t protect any creative work less than a paragraph. When it comes to blurbs like *I Identify as Human*, for better or for worse, they are regarded as public domain, free for everyone to use. Frankly, we should be happy for that. Otherwise, you can bet that copyright trolls would have registered copyrights for millions of common sentences and would be suing everyone for all speech everywhere.

* Though you do need to register a fictitious business name on a state or county level.

† For the record, I made this one up, thanks. 😊 SF

Types of marks

Trademarks can be categorized in two dimensions: The appearance of the mark itself and the nature of the products or services that it identifies.

Standard Characters

Anything that you could type on a keyboard would be a standard characters mark. Example: COCA-COLA. The USPTO registers marks in all-capital letters, indicating that they are case-insensitive. They are also essentially space-and-dash-insensitive, meaning that NIGHT SHADES, NIGHT-SHADES, and NIGHTSHADES would represent the same mark.*

The power of a standard characters mark is that it defines your mark very broadly. Thereafter, any competitor who labels their product as *Night Shades* brand will be counterfeiting your mark, regardless of the font or color of their mark. Even intentional misspellings such as *Nite Shadez* would probably qualify as infringement. Standard character registration is most helpful to protect you against “coincidental” infringement. This is my own term, and it means infringement by parties who don’t know you and just happen to use the same brand name.

Special Form

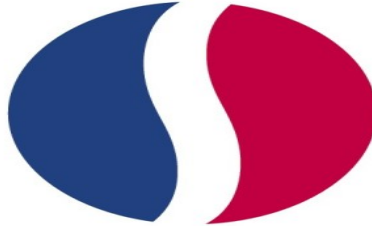
A trademark is regarded as “special form” if it requires a picture to convey the way it is presented. This will be true if there is a graphic *design* in the mark, or even if the lettering is *stylized*, presented in a distinct style, e.g. font or color. Here are two examples of special form trademarks:



You can probably tell that there’s not much chance of coincidental infringement of a special form trademark. These marks are more valuable if you are concerned about willful infringement. If your product becomes a big money-maker, there will be counterfeiters, and they will try to make their packaging look as similar to yours as possible. Having an elaborate mark makes

* Be careful when searching trademarks at the USPTO. The search system is space-insensitive but dash-sensitive. You would have to search twice for NIGHT SHADES and NIGHT-SHADES, even though they are legally equivalent.

counterfeiting more difficult. It also makes the intent to infringe very clear (which is important in litigation). Further, you will have legal rights against counterfeiters who use marks that are not identical, but similar enough to cause **likelihood of confusion** with consumers. For instance, if someone made a beverage called “S Cola” and branded it with this mark:



Pepsi would surely have standing for a counterfeit lawsuit.

One? The other? Both?

Note that when we file an application, you must pay separately for each Standard Character or Special Form mark. If you have a brand name and a logo, you can lump them together into a special form mark. This will cut your USPTO fees in half. A mixed-type trademark will end up being identified by its Standard Character version, making it easy to file and find. The downside to filing a mixed-type Special Form mark is that it defines your mark more narrowly. Filing two separate marks can provide stronger protection, because they will be effective against counterfeiters who use either your name OR your image in isolation.

Most of my clients are interested in selling their products on Amazon. Amazon Brand Registry requires a trademark with an alphanumeric component, whether standard or stylized. From what I understand, Amazon will not accept a mark that consists entirely of a design element, like the Pepsi logo.

Classes of goods

Each registered mark designates its **class(es) of goods or services**. It was okay to have an *Apple* records label and an *Apple* computer company because music and computers were entirely different industries in the 1980s. It was okay, that is, until *Apple* computers went into the music business. Then they created “likelihood of confusion” problems and clashed famously with the Beatles.

When you file an application, you must identify all classes of goods or services that will be designated with your mark. You must pay equal fees for each class, so you should only declare classes of goods and services that you are actually selling. The overly ambitious entrepreneur who dreams of selling *Tammy Z* brand shirts, notebooks, handbags, jewelry, perfume, motorcycles, smart phones, and frozen meals is in for a rude awakening when her \$225 basic application fee is multiplied by eight!

In fact, notice the multiplicity of fees that we have discussed in two dimensions now. You must pay separate filing fees for each type of mark (standard characters or special form) in each class of goods. These figures can multiply very quickly. You'll want to work closely with me to keep your costs to a reasonable minimum.

I have mentioned the common client misconception of wanting to register a catch phrase for a vibe, philosophy, or movement, and printing that catch-phrase on a million different items. Here's a possible workaround. You can define your business as a retail operation. If you create the website www.I-Identify-as-Human.com and set it up as an e-commerce site, then you are now basically establishing yourself as a unique storefront. Then you can print your slogan on as many items as you want, and it all falls under one "retail" class! You're welcome.

Actual Use vs. Intent to Use

The purpose of registration is to protect a trademark *in commerce*. In other words, the intent is to protect active sellers, not "trolls" who hoard brand names for the purpose of suing. You must be ready to follow up your application with proof that you are actually using your trademark for every class of goods on your application. It is common for companies to start using their trademarks even before applying for registration. This carries some risk, as your application might not be accepted. In fact, your mark might infringe someone else's. It's best to work with a trademark attorney like me to assure you of name clearance and trademark strength issues before investing too heavily in a new brand name.

If you're not using your trademark yet, you can file your application with an "Intent to Use" status. This application will go through the approval process, and you'll know whether the USPTO will accept it before committing to it. Then you must start using the mark within three years and provide evidence to the USPTO before registration is complete. This process costs an extra few hundred dollars, with fees due every six months.

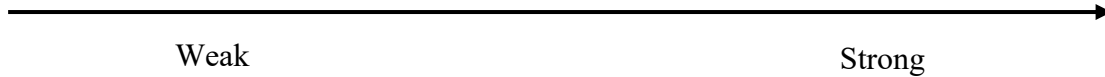
If you have several classes of goods in mind, I recommend that you start your application only with those classes that you are already selling or very nearly ready to sell. Otherwise, Tammy Z's dream class of "motorcycles" will hold up her entire application until she can prove that she's actually selling them. After your first mark has been approved, you'll have increased confidence to keep the brand name and then start adding classes of goods as you diversify over the years.

Trademark Strength or "Registrability"

We're not done yet. There is one more important arena of trademark law that is chock-full of misconceptions. Not every trademark is registrable. Trademarks come on a scale from weak to strong. For many business owners, the scale is counterintuitive. I get many inquiries along the lines of, "I want to design and sell edgy blue jeans for men, and I would like to register the mark *Edgy Jeans for Men*". Trust me; this application will be dead on arrival.

The basic principle is that the *less* association there is between the name and the product, the *more* likely it is to be approved. The five legal categories are shown by increasing strength on the scale below.

Generic < Descriptive < Suggestive < Arbitrary < Fanciful



A mark that is “generic” is not entitled to any trademark protection. Generic terms would be those that describe the genus of product or service rather than any particular company or source. Examples would be words like “clothing” or “food.” Although this seems like backward logic to many entrepreneurs, it makes perfectly good sense from a public perspective. If you owned the trademark “Clothing”, then nobody else in the US would have a right to use the word “clothing” to describe their clothing. That’s not fair. All vendors should have a right to use words that describe their product in a generic sense.

The minimal semi-protected category is “descriptive.” Descriptive marks are those that “identify some function, use, characteristic, size, or intended purpose of the product” or service, like “Cold and Creamy” ice cream. Other examples might be “Burger on a Bun” or “Sammiches”.¹ A descriptive mark is not registrable or protectable UNLESS it has already acquired “secondary meaning” in the marketplace. This essentially means that it has become a famous mark.² My favorite example is Wiley book publisher’s registered mark for its book series, *For Dummies*. At first, this mark wasn’t registrable because it was a common phrase. Now, when people hear a phrase like *Trademarks For Dummies*, they most likely think of Wiley’s yellow and black paperback series, and they expect the same kind of book as the ones they’ve already read. Now that this phrase has acquired secondary meaning in US culture, it would be unfair for others to pass themselves off as Wiley. Wiley has earned the right to register this descriptive mark.

To determine whether a mark has acquired secondary meaning, legal considerations are:

- (1) the amount and manner of advertising,
- (2) the volume of sales,
- (3) the length and manner of the term's use, and
- (4) results of consumer surveys.³

One legal blog suggests that “five years and a significant advertising budget” would be typical.⁴

My point is that this process is a lot of work! If you’re calling me for legal advice, chances are you’re not at the level of Wiley publishers. If you don’t own a business that’s worked its way into the public consciousness, then you can avoid all this trouble by choosing marks that don’t merely describe your goods or services. I am emphasizing this point here because, as I’ve mentioned, this is a very common beginners’ mistake. Businesspeople get emotionally attached to brand names that describe just what their gizmo does, and it’s hard for me to break them of that habit.

The next level, “suggestive”, is the minimum level that we should strive for. A suggestive trademark is a distinctive mark that does not explicitly describe a product, but suggests or refers to it, requiring consumers to exercise imagination to connect the mark with the product. Examples are *Microsoft* and *Android*.

“Arbitrary” names use words that already existed, but that would normally not be associated with the product (like *Amazon* for package delivery or retail).

The very strongest protection goes to “fanciful” names, like business owners’ names (*Disney*) or words that never existed before (*Skype*). After all, why would anybody else give their animation studio a random name like *Disney* unless they were trying to pass off as the well-known Disney company? Unlike the phrase “animation studio” (generic / weak), nobody else should have the right to use the name *Disney* (fanciful / strong). Make sense?!

Combining Descriptive and Registrable elements

Many aspiring entrepreneurs find it hard to swallow that their trademark should not describe their product. I understand the appeal of a name like *Edgy Jeans for Men*. That name tells customers just what to expect at a glance, and that’s especially valuable for a non-famous brand.

If you have a descriptive brand name in mind, don’t despair. I didn’t say that you can’t *use* it. I said that you can’t *register* it and keep others from using it. Why not come up with a strongly protective word or phrase to use in conjunction with it? How about this: *Tammy Z Edgy Jeans for Men*. You can register the fanciful brand name *Tammy Z*. The rest of the phrase won’t be registered, but nobody else can register it either, so you’re perfectly free to use it. It’s the *Tammy Z* part that makes your brand name unique. You’d be really pissed off if someone counterfeited that part, wouldn’t you? That’s why you should register it.

Summary

This primer has taken you through some of the basic issues involved in selecting and applying for trademark registration. I have tried to plead my case especially for these two common problematic concerns:

- (1) You can’t trademark a “catch phrase” for generic purposes. It must identify a good or service in commerce, and printing it on apparel does not make it an apparel trademark.
- (2) The ideal brand name has some non-descriptive element in it

Now that you understand the basics, you’re in a good position to consult with me and apply these principles to your brand. You will especially need my help to give you first impressions on name strength, to conduct name clearance searches, and to help you wisely select classes of goods and types of mark. We will also discuss issues of timing your application and your product release. Finally, I will carry out filing the application and, if necessary, prosecuting it with the USPTO if the examiner unreasonably refuses registration.

I look forward to discussing your trademark needs soon! – SF

Citations

¹ <https://www.upcounsel.com/suggestive-trademark>

² America Online, Inc. v. AT&T Corp., 64 F. Supp. 2d 549, 560 (E.D. Va 1999)

³ [Zatarain's, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 \(5th Cir. 1983\).](#)

⁴ <http://www.veritrademark.com/articles/five-categories-trademarks>