



Guide to Filing a Trademark

Introduction

Given the complexity of trademark law and registration, this document serves as a guide to understanding the trademark filing process. Protected at the federal (Lanham Act) and state (common law, state statutes) level, trademarks are utilized to identify and distinguish a source or origin of goods and services in its respective marketplace. They can come in many forms, including names, brands, symbols, slogans, colors, sounds, packaging, and more.

To be eligible for federal protection, trademarks must be registered with the United States Patent and Trademark Office (USPTO). The USPTO provides procedural guidance on how to receive trademark protection. There are also state statutes that can vary for registering trademarks within a specific state. This guide focuses on the key steps to follow to file a trademark with the USPTO and in the state of Pennsylvania. It will help one evaluate whether a potential mark can be trademarked as well as what makes a strong mark.

Key Definitions

A trademark is a word, phrase, symbol, or design that identifies the source of your goods or services. While registering your trademark will provide broader rights and protections, you become a trademark owner the second you start using your trademark with your goods or services. Those rights, however, are limited. By registering a trademark with the USPTO, nationwide rights are granted.

The term trademarks is typically inclusive of service marks, which identify and distinguish the source or origin of services, rather than goods. Service marks receive the same treatment as other trademarks under the Lanham Act.

Strong Trademarks

When evaluating a trademark, it is important to consider factors that deem it a strong one. Strong trademarks allow for greater protection in preventing others from using your mark without your permission.

A strong trademark is one that is inherently distinctive, or one that quickly and clearly identifies what the source of your good or service is. Being distinctive means being able to distinguish a single source of a good or service.

Inherent Distinctiveness: Some trademarks are inherently distinctive, by their nature. This includes three categories of trademarks: suggestive, arbitrary, and fanciful designations.

- *Suggestive Trademarks* – words that suggest the quality of the good or service, without outright stating the quality. Ex: Microsoft® for microcomputer software.
- *Arbitrary Trademarks* – words whose actual meaning have nothing to do with the underlying good or service. Ex: Apple® is registered for computers, not apples.
- *Fanciful Trademarks* – words that are invented to have a meaning in relation to their goods or service. Ex: Pepsi®, Exxon®

Weak Trademarks

While not all trademarks are inherently distinctive, some can acquire distinctiveness. These tend to be weaker trademarks.

Acquiring Distinctiveness: Designations that are descriptive terms and symbols are not inherently distinctive, or generic terms. These however, can acquire distinctiveness if you extensively use the trademark and promote the trademark.

- *Generic terms* – these are not even trademarks actually. They are just common and everyday words. Thus, they are not federally registrable. Ex: “Bicycle” for bicycle, “Bagel Shop” for bagel shop.
- *Descriptive terms* – words that simply describe some aspect of your goods and services. These can get registration in only certain circumstances, such as if you used it extensively in commerce for years. Ex: American Airlines® for flight services in America.

Supplemental Register: If a mark has not acquired distinctiveness, it may still be registrable on the Supplemental Register. See below for a description of Supplemental Register vs. Principal Register.

- *Geographically Descriptive terms* – words that describe or contain a geographic location. While not considered inherently distinctive, these can

be registered on the Principal Register upon acquiring distinctiveness. Otherwise, they are registrable on the Supplemental Register.

- *Surnames* – if a mark is primarily a surname, it is not inherently distinctive but can acquire distinctiveness, at which point it can be registered on the Principal Register. Otherwise, it is registrable on the Supplemental Register.
- *Slogans* – common phrases or slogans may be rejected as insufficiently distinctive, even if it is not in the literally descriptive category.
- *Logos* – if it consists of a simplified depiction of the product or a product feature, it may be deemed descriptive.
- *Trade Dress/Packaging* – this is the commercial look and feel of a product or service or its packaging. Three-dimensional configurations of entire products are always deemed inherently nondistinctive and are only registrable (on the Principal Register) with proof that they have acquired distinctiveness. These cannot be functional.

Types of Trademark Registration

As mentioned before, one does not need to register a mark to protect it. By commercially using a mark, such as on the good or on the packaging, a trademark right can be maintained. However, these are usually very *limited* rights as well as limited to the territory that the mark is used in.

1. Federal Registration:

- Registering a trademark federally will offer significantly more benefits. There are two bases that a federal trademark registration can be registered on. Either 1) the trademark is actually used in commerce or 2) there is a bona fide (good faith) intent to use the trademark in connection with the good or service that gets listed in an “intent-to-use” application.
- As mentioned above, the federal registration of a mark requires distinctiveness, either inherent distinctiveness or acquired distinctiveness. Terms that are generic are again, not registrable.
- Once your mark is federally registered, the trademark registration can last forever. As long as you continue to use the trademark in commerce and provide evidence with maintenance documents at periodic intervals, then you will not lose your federal registration.
- The Federal Trademark Register has two separate registers: The Principal Register and the Supplemental Register. The Principal Register will grant protection for *distinctive* marks or marks that have acquired secondary meaning. The Supplemental Register is a secondary trademark register. It is reserved for certain *nondistinctive* marks that do not qualify for registration on the Principal Register, but still are capable of distinguishing goods and services. The scope of protection for marks on the Supplemental Register is less than that of

the Primary Register. However, if a mark that is registered on the Supplemental Register eventually acquires distinctiveness through use and promotion over time, then it can be filed for registration on the Principal Register through a new application.

2. Statewide Registration in Pennsylvania:

- Registering a trademark with your state can also give you statewide trademark rights. In Pennsylvania, trademarks are effective for a term of five years. An application to register a trademark must include a few components. The trademark must be available for use in Pennsylvania. The application must additionally include the name of the applicant and jurisdiction if the applicant is a corporation, a statement describing the mark, a specification of what class of goods or services the mark is in, a listing of current goods and services using that mark, the date the mark was first used in Pennsylvania, and a signature from the applicant. State registration can be a good idea if the trademark is used only within one state. However, state registrations usually create no substantive rights beyond those created under the common law by use of the mark.

3. Common Law Rights:

- If you do not file for registration in either your state or federally, then the protection you get for your trademark is based *only* on your trademark as used in commerce within a particular geographic area. Should problems with your trademark arise, there is no guarantee as to how large the scope of this geographic area will be. Here, settlements agreements are often utilized that will bind you to restrictions set by the senior user of the mark.

Federal Registration of a Trademark

The Trademark Electronic Application System (TEAS) is the registration system used by the USPTO. To file for registration, you can 1) use the Trademark Electronic Application System (TEAS) at a cost of \$350 per class of good or service or 2) the Trademark Electronic Application System (TEAS) Plus at a cost of \$250 per class of good or service.

TEAS Plus is designed to be easier for the applicant and comes with a reduced fee. A TEAS Plus applicant can register about 2 months faster than a standard TEAS applicant. In a TEAS Plus application, an applicant can only choose goods and services identifications that are already listed and approved for use by the USPTO.

In a standard TEAS application, an applicant does not need to select an identification in goods or services from the preexisting list. A new application can be filled out online here:

- <https://www.uspto.gov/trademarks/apply/initial-application-forms>

Generally, the steps to register your trademark with USPTO include:

- describe your trademark
- state when it was first used such as the date when you first used the mark to signify your company, products, or services in the marketplace
- describe the products or services that the mark will be used on
- suggest what classification the mark should be registered under – there are 45 different classes listed on the USPTO website
- include a drawing of your mark (this could also be a word if it is a wordmark or a photo file)
- sample of how the mark is being used
- registration fee (\$350 for TEAS or \$250 for TEAS Plus)

After the application is filed, the application is assigned to a USPTO Trademark Examining Attorney. The Examining Attorney will review the application for requirements, and see if the mark is eligible for registration in accordance with the Lanham Act, federal regulations, and the USPTO rules. They will also search USPTO records to make sure there are no similar marks previously registered or applied for to the same or related good or service.

An Examining Attorney can reject the registration if there is any formal defect in the application, the mark itself is ineligible (generic or descriptive), or if there is likelihood of it being confused with a similar registered or applied for mark. The applicant can then answer the objections by filing a response within a specific period of time, which is usually six months. There is sometimes a fee to correct deficiencies in applications.

If the USPTO determines that the mark is eligible for federal registration, then the USPTO will publish the trademark in its online publication, *Official Gazette*. Then, if no existing trademark owners object, you will receive a response from the USPTO, though the processing time can vary from a year to several years. An applicant will be issued a certificate of registration, which has an initial term of ten years. To maintain this mark, the owner should file a statement of continued use and a renewal application.

In the case that a trademark is unavailable for registration federally, sometimes a mark can still be available for use itself under common law rights. However, as described above, these rights would be limited in geographic scope.

Useful Links

- United States Patent and Trademark Office: <https://www.uspto.gov/trademarks>
- Registration of a Trademark in Pennsylvania State:
<https://www.dos.pa.gov/BusinessCharities/Business/Resources/Pages/Registration-of-a-Trademark.aspx>