

Choosing and Clearing the Right Trademark

A trademark is typically a word, phrase, symbol or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others. A Service Mark is similar to a trademark but is distinguished in that it identifies and distinguishes the source of a service rather than a product or class of goods. Trademarks also include sounds (NBC chimes) and color (pink fiberglass – Owen Corning, yellow arches – McDonalds). Whatever mark you choose, trademark research is an important step towards minimizing risk and optimizing the value of the trademark.

Generally, the terms "trademark" and "mark" are used interchangeably, and refer to both trademarks and service marks.

It is legally important and commercially practical to pick a mark that:

- is capable of acquiring distinctiveness;
- satisfies current trademark laws;
- is not confusingly similar to another mark already in use, registered or applied for on the US Federal Register and that is associated with a similar product or service;
- is not in use or filed by another in any potential foreign markets; and
- the domain name is available or obtainable.

Trademark research for clearing desired marks should check existing, pending, issued, and abandoned federal applications/registrations, state registrations, common-law non-registered uses such as trade directories, trade name directories, specialized directories, buyer's guides, phonebooks, telephone directories, search engines, domain directories, and international sites. Simply stated, the greater the scope of the trademark research, the greater the level of confidence in the mark. Since it is possible for a foreign trademark application filed under treaties such as the Paris Convention and Madrid Protocol to claim priority to an earlier filed application, the research of international trademark resources is advisable.

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Continuing trademark monitoring for the later emergence of marks confusingly similar to existing marks is equally important in order to maintain the value and enforceability of the client's trademark portfolio.

It is always helpful for a client to prescreen desired or candidate marks before approaching the trademark attorney. This can save time and money.

Analyzing the Results of the Trademark Research

Once the trademark research is completed, the results must be analyzed by a competent trademark attorney. The 'likelihood of confusion' analysis is the legal test for comparing related trademarks. In particular, the test is employed to determine whether there is a likelihood that usage of the two marks will cause public confusion as to the source, sponsorship, or other association of the goods/services on which the marks appear. Clearly, candidate marks that are similar to marks already registered or in widespread use for similar goods/services are likely to be rejected for registration by the Trademark Office, be unenforceable against the senior mark, and increase the risk of legal actions. Having to change a trademark is not only expensive and time-consuming, but loses whatever goodwill may have accrued.

It is difficult to identify, let alone avoid every relevant mark in use, and even a robust trademark research process can miss a similar mark in use by a small company in a remote place like Dixville Notch, New Hampshire. In the long run, however, trademark research is worth the effort and expense. A strong trademark can be a valuable asset to your business - engage a competent trademark professional early.

For more information about trademarks, consult our Documents Library.
