



# Trademarks 101

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## 1. Definitions

- **Trademark:** a “brand”; a word, phrase, symbol, or design (or any combination) that identifies and distinguishes the source of goods or services from those of others (e.g., APPLE® computers)
- **Service Mark:** used to identify or distinguish services (e.g., KINKO’s® copy services)
- **Trademark or Mark:** are often used interchangeably to refer to both **Trademarks** and **Service Marks**
- **Trade Name:** name used to identify a business (e.g., COCA-COLA COMPANY); may constitute a **Trademark** or a **Service Mark** *IF* it is used as a source-identifier of goods or services (e.g., COCA-COLA [w/o the COMPANY])
- **Use:** applying a mark as a source-identifier in connection with the sale of goods or services
- **In Commerce:** in more than one state
- **Goodwill:** established business reputation regarded as a quantifiable asset; unlike other assets, can actually *appreciate* in value

## 2. 5 Functions of Trademarks

- Indicate the source of particular goods or services
- Identify and distinguish goods or services from a competitor’s
- Indicate a level of quality of goods or services associated with the mark
- Primary method for labeling, advertising, and selling goods or services
- Primary medium for embodying and protecting accumulated goodwill in connection with particular goods or services

## 3. How to Create Trademark Rights in the U.S. = Use the Trademark

- Common law rights extend only to the geographic area where the mark is actually used
- Federal registration (for marks used “in commerce”) provides the exclusive right to use the mark in all 50 states

## 4. Why Register? 5 Advantages of Federal Registration

- Constructive notice of claimed ownership
- Exclusive right to use the mark nationwide and to use the ® symbol
- Right to file an action in federal court, stop other’s use, and recover profits, damages, and costs, and possibly treble damages and attorney fees
- Basis to obtain registration in foreign countries
- Prevent importation of infringing foreign goods

## 5. Distinctiveness and Registrability: the Distinctiveness Continuum

- *Inherently distinctive* marks: Fanciful (e.g., “Xerox” copier), Arbitrary (e.g., “Apple” computers), and Suggestive (e.g., “London Fog” raincoats) marks ARE registrable
- Descriptive marks that HAVE *acquired distinctiveness* (i.e., that have come to be known in the minds of the public as a source-identifier (“Family Tree Maker” software) ARE registrable
- Generic marks (e.g., “machine”) have *no distinctiveness* and descriptive marks (e.g., “copy machine”) that have *NOT acquired distinctiveness* are NOT registrable

## 6. How to Choose a Trademark: brief; fanciful, arbitrary, or suggestive (not descriptive); easy to remember, read, pronounce, and adapt to any media; no unpleasant connotations; suitable for export (translates); capable of visual expression (logo)

## 7. How to Federally Register a Trademark: 8 Steps

- Comprehensive search: to see lay of the land, avoid potential infringement, and save money
- Use (or plan to use) the mark “in commerce”
- Provide dates of 1st use anywhere & 1st use in commerce (may be the same date; can provide later for intent-to-use)
- Identify the appropriate International Class(es) (1-34 for goods; 35-45 for services) under which to file your mark
- Prepare a description of the goods or services you offer in connection with the mark
- Decide whether to apply for a words-only or words-and-design (logo) mark
- Provide a copy of any logo, and a specimen showing the word mark or logo in use
- Pay the filing fee (& an additional fee for an intent-to-use application when you file a statement of use and specimen)