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## *First Steps: What is a trademark?*

### Basic Protection Methods

You have a name, a product, or an idea ... while these may be intangible, they represent your intellectual property - the unique character of your business. They are yours and yours alone, and like business owners the world over, you want to keep them that way.

A well-designed and well-researched intellectual property program helps to safeguard your names, trademarks, products, business information, and ideas against infringement or copying by others. It can also save your business valuable time and money in the event a name or idea is already taken.

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### *Categories of Trademarks*

A trademark (or service mark) is a word and/or design by which the purchasing public identifies the source of a product (or service). A mark represents all the quality and goodwill developed by the owner. A word and/or design for which trademark protection is claimed falls into one of four categories:

- Arbitrary or Fanciful
- Suggestive
- Descriptive
- Generic

A general understanding of these categories is important in choosing a trademark possessing protectable characteristics. An arbitrary or fanciful trademark receives the greatest protection because it is least likely to be confused with another origin. It means nothing in the context in which it is used (e.g., "Apple®" computers or "Kodak®" film). Suggestive marks are equally registrable and suggest a quality or ingredient of the product or service (e.g., "Caterpillar®" tractors). Such marks require imagination to associate the mark and its meaning.

Descriptive marks are more generally understood to describe the products they represent (e.g., "The Breathable Mattress" for mattresses). If a trademark examiner at the U.S. Patent and Trademark Office (PTO) deemed a mark descriptive, it may be denied registration or be granted limited registrability on the Supplemental Trademark Register (as opposed to the Principal Register). After 5 years of continuous use,

such a mark may (or may not) then achieve registration on the Principal Register by an application for that purpose.

## *Confusing Similarity*

A trademark is protectable if, when used with a particular good or service, consumers are not likely to confuse it as coming from a different, source. If such a “confusingly similar” pre-existing trademark, company name, or trade name exists, and the chosen mark is likely to cross paths with any of these pre-existing names or marks, the mark should not be utilized. The mark first utilized in interstate commerce is the mark with senior rights.

## *Registration*

A mark is protected upon creation in the U.S.; however, registration of a mark provides benefits that may not be otherwise available. Use in only one state without any sales across state lines relegates registration to the Secretary of State in which the mark is used. Use across state lines opens up the possibility for registration with the U.S. Patent and Trademark office. (PTO). More information can be obtained at the [PTO](#) website.

Registration in some other countries is also possible through the U.S. PTO as the U.S. is a member certain treaties that permit such applications. In certain circumstances, this type of trademark application for registration is beneficial, however, a careful analysis of a trademark owner’s needs must be made before determining whether this application is sufficient, or if a direct application with the country of interest is more appropriate.

## *Use of a Mark*

A mark should always be utilized as an adjective with either a TM or SM placed next to the mark if the mark is not registered with a national registrar (as opposed to a state registrar). The company name and address should also appear somewhere on any written materials as well. Finally, efforts should be continuously made to stop junior confusingly similar uses of marks. Failure to properly utilize and protect a mark could result in loss of all protection for that mark. Some examples of trademarks that have lost protection are “Monopoly,” “Aspirin,” “Escalator,” and “Cellophane.”

Please note that this material should not be considered legal advice and is for informational purposes only. If you have specific legal questions, you should consult a qualified legal professional skilled in the area of trademark law. If you would like more information about this topic, please contact Judith A. Keene, Esq. at (720) 684-5375 or by email at [jkeene@holzeriplaw.com](mailto:jkeene@holzeriplaw.com).