

TYPES OF TRADEMARK PROTECTION

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1. Trademark protection under state common law.

Ownership of trademarks is automatic under state common law as soon as the mark is first used in trade (or in the case of trademarks that are not inherently distinctive, as soon as the claimant uses them in trade to the point that they obtain secondary meaning). No registration or other administrative process is necessary to acquire ownership rights at common law.

A primary advantage of a state registration is that it provides notice to those who might be inclined to infringe the mark. It is good to have a certificate of registration when sending a cease and desist letter.

2. Federal registration on the principal register.

Registration on the principal register provides the following advantages over common law trademark protection:

- a) infringement actions can be brought in federal court;
- b) the Lanham Act allows for treble damages and attorneys fees;
- c) there is a presumption that the registrant is the owner of a valid trademark and after five (5) years of registration the following challenges or defenses to the mark are precluded all together:
 - (i) that the trademark is not inherently distinctive (i.e., is merely descriptive or misdescriptive, primarily geographically descriptive or misdescriptive or primarily merely a surname) and lacks secondary meaning;
 - (ii) that the trademark is confusingly similar to a mark that someone else used prior to the registrant in which the registrant continues to use.
- d) federal registration allows the trademark owner to acquire rights in the trademark in a greater geographical area than would be possible under common law.

3. Federal registration on the supplemental register.

Trademarks capable of distinguishing an applicant's goods or services but not registerable on the principal register because they are not sufficiently distinctive may be registered on the supplemental register. Thus, any would-be mark that is descriptive, geographically descriptive, primarily a surname or otherwise not inherently distinctive and that lacks secondary meaning may be registered on the supplemental register. However, the mark must be capable of distinguishing the applicant's goods or services, so generic terms may not be registered. Similarly, deceptive marks, marks consisting of government insignia, marks consisting of a likeness or name of a living individual without that person's consent, and marks already in use by another may not be registered. In addition, to register on the supplemental register, the applicant must demonstrate that he or she has used the mark lawfully in commerce in connection with goods or services for the year prior to the application. Other than allowing for infringement actions to be brought in federal court, registration on the supplemental register provides few substantive rights beyond those available at common law. Thus, there is no presumption of validity or ownership and no expansion of geographic rights through constructive notice. Note however that registration on the supplemental register does not preclude an applicant from later applying to register on the principal register if the mark has become sufficiently distinctive through use.

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