



TRADEMARK TERMINOLOGY – WHAT TRADEMARK OWNERS NEED TO UNDERSTAND TO TALK WITH A TRADEMARK ATTORNEY

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Since my astute colleague, Gary Shuster, posted helpful terminology related to patent “speak,” I thought it might be helpful to have a similar glossary of terms for trademark terminology. Although trademark law tends to be less complex than patent law, without a fundamental understanding of the terms trademark lawyers use, it is easy to get lost in a conversation with a trademark attorney.

The following glossary of trademark terms is fundamental to an understanding of trademark law, and in any case, you can impress your trademark attorney with your grasp of trademark terms and concepts. As with the patent glossary, this glossary may also grow over time.

Abandonment: A trademark or service mark application that has been declared abandoned is “dead” and no longer pending. The most common reason for abandonment of a trademark or service mark application is when the U.S. Patent and Trademark Office (“USPTO”) does not receive a response to an Office Action (see definition below) from the applicant within 6 months from the date the Office Action was mailed.

Acceptable Identification of Goods and Services Manual: This manual lists numerous examples of identification of goods and services that are acceptable to the USPTO for inclusion in trademark applications and registrations.

Acquired Distinctiveness: See Secondary Meaning.

Allegation of Use: A sworn statement signed by the applicant or a person authorized to sign on behalf of the applicant attesting to use of the mark in commerce. The allegation of use must include one specimen showing use of the mark in commerce for each class of goods/services included in the application,

and the required fee.

Amendment to Allege Use: An Allegation of Use filed before the Examining Attorney (see below) approves the mark for publication and prior to issuance of the trademark registration. The Amendment to Allege Use and the Statement of Use (see below) include the same information, and differ only as to the time when filed.

Application (Trademark): A document by which a person requests a federal trademark registration. To receive a filing date, an application must include (1) the applicant's name, (2) a name and address for correspondence, (3) a clear drawing of the mark sought to be registered, (4) a list of the goods or services, and (5) the application filing fee.

Assignment: A transfer of ownership of a trademark application or trademark registration from one entity to another.

Cancellation Proceeding: A proceeding before the Trademark Trial and Appeal Board in which the plaintiff seeks to cancel an existing registration of a mark.

Certificate of Registration: Official document from the USPTO evidencing that a mark has been registered.

Classification of Goods and Services: Goods and Services are classified by an international system, according to international treaties to which the United States is a signatory. All goods and services included in trademark applications are classified by the Office according to this system. Goods are classified in International Classes (IC) 001 through 034, and services are classified in IC 035-045.

Common Law Rights: Property or other legal rights that do not absolutely require formal registration in order to enforce them. Proving such rights for a trademark in court can be very difficult, requires meticulous documentation, and places a heavy burden on the individual. Active Federal registration of trademark can provide a higher degree of legal protection and readily-demonstrated evidence of ownership of a mark.

Dead: A dead or abandoned status for a trademark application means that specific application is no longer under prosecution within the USPTO, and would not be used as a bar against your filing.



Declaration of Incontestability: See Section 15 below.

Descriptive Mark: A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. If a mark is merely descriptive or deceptively misdescriptive of the goods or services to which it relates, the mark will be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Disclaimer: A statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark. The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone.

Examining Attorney: A USPTO employee who examines (reviews and determines compliance with the legal and regulatory requirements of) an application for registration of a federally registered trademark.

Expired Trademark: Trademark registration is no longer active. The registrant failed to renew the trademark registration at the end of the registration period. Expired Trademark Fresno attorney

Fanciful Marks: Terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, EXXON) or are completely out of common usage (e.g., FLIVVER).

Filing Basis: The legal basis for filing an application for registration of a mark. The Trademark Act sets out five filing bases, and an applicant must specify and meet the requirements of one or more bases before the mark will be approved for publication for opposition or registration on the Supplemental Register (see below). The five bases are: (1) use of a mark in commerce under §1(a) of the Act; (2) bona fide intention to use a mark in commerce under §1(b) of the Act; (3) a claim of priority, based on an earlier-filed foreign application under §44(d) of the Act; (4) registration of a mark in the applicant's country of origin under §44(e) of the Act; and (5) extension of protection of an international registration to the United States, under §66(a) of the Act and the Madrid Protocol.



Generic Terms: Terms that the relevant purchasing public understands primarily as the common or class name for the goods or services.

These terms are incapable of functioning as trademarks denoting source, and are not registrable on the Principal Register (see below) under 2(f) or on the Supplemental Register (see below). Examples include: CLASSES ONLINE for classes provided via the Internet, PIZZA.COM for pizza ordering and delivery services, and LIVE PLANTS for plant nurseries.

Goods: Goods are products.

Identification of Goods and/or Services: A written statement of the goods and/or services included in an application. Every application must include an identification of goods and/or services.

Intent to Use (ITU): Refers to the intent-to-use filing basis provided for in Trademark Act Section 1(b), 15 U.S.C. 1051(b). Applicants who have not yet used the mark they wish to register may file a trademark application under this filing basis. An “intent to use” application must include a sworn statement (usually in the form of a declaration) that applicants have a bona fide intention to use the mark in commerce.

International Class (IC): See Classification of Goods and Services above.

Likelihood of Confusion: A statutory basis (Trademark Act Section 2(d), 15 U.S.C. Section 1052(d)), for refusing registration of a trademark or service mark because it is likely to conflict with a mark or marks already registered or pending before the USPTO. After an application is filed, the assigned Examining Attorney will search the USPTO records to determine if such a conflict exists between the mark in the application and another mark that is registered or pending before the USPTO. The principal factors considered by the examining attorney in determining whether there is a likelihood of confusion are: (1) the similarity of the marks; and (2) the commercial relationship between the goods and/or services listed in the application. To find a conflict, the marks do not have to be identical, and the goods and/or services do not have to be the same. It may be enough that the marks are similar and the goods and/or services related.

Notice of Allowance (NOA): A written notification from the USPTO that a specific mark has survived the opposition period following publication in the Official Gazette (see below), and has consequently been allowed for registration. It does not mean that the



mark has registered yet.

Notice of Publication: A written statement from the USPTO notifying an applicant that its mark will be published in the Official Gazette (see below). If the Examining Attorney raises no objections to registration, or if the applicant overcomes all objections, the Examining Attorney will approve the mark for publication. The notice of publication provides the date of publication. Any party who believes it may be damaged by registration of the mark has thirty (30) days from the publication date to file either an opposition to registration or a request to extend the time to oppose.

Office Action: A letter from a trademark examining attorney setting forth the legal status of a trademark application. There are several types of Office actions: examiner's amendments, priority actions, non-final Office actions, final Office actions, and suspension inquiry letters.

Official Gazette: A weekly publication of the USPTO that includes regular and special notices of the Office.

Opposition Proceeding: a proceeding before the Trademark Trial and Appeal Board in which the plaintiff seeks to prevent the issuance of a registration of a mark. An opposition is similar to a proceeding in a federal court, but is held before the Trademark Trial and Appeal Board, a USPTO administrative tribunal. An opposition may only be filed in response to the publication of the mark in the Official Gazette.

Principal Register: Primary trademark register of the USPTO. When a mark has been registered on the Principal Register, the mark is entitled to all the rights provided by the Trademark Act. For a listing of the advantages of owning a registration on the Principal Register see "Registration" below.

Publication for Opposition: If the examining attorney raises no objections to registration, or if the applicant overcomes all objections, the examining attorney will approve the mark for publication in the Official Gazette.

Registration: Federal registration of trademarks involves the establishment of rights in a mark based on legitimate use of the mark. Although federal registration of trademarks is not required to use a trademark, owning a federal trademark



registration has several advantages, including notice to the public of the registrant's claim of ownership of the mark, a legal presumption of ownership nationwide, the exclusive right to use the mark on or in connection with the goods or services set forth in the registration, the ability to bring an action concerning the mark in federal court, the use of the U.S. registration as a basis to obtain registration in foreign countries, and the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

Request for Extension of Time to File a Statement of Use: A sworn statement signed by the owner or a person authorized to sign on behalf of the owner, stating that the applicant still has a bona fide intention to use the mark in commerce, and needs additional time to use the mark in commerce. A filing fee per class of goods/services must accompany the Extension Request.

Section 8 Declaration of Continued Use: A sworn statement, filed by the owner of a registration that the mark is in use in commerce. It must be filed by the current owner of the registration and the USPTO must receive it during the following time periods: (1) At the end of the 6th year after the date of registration, and (2) At the end of each successive 10-year period after the date of registration. There is a six-month grace period. If these rules and deadlines are not met, the USPTO will cancel the registration.

Section 9 Renewal Application: A sworn document, filed by the owner of a registration, to avoid the expiration of a registration. Federal trademark registrations issued on or after November 16, 1989, remain in force for 10 years, and may be renewed for 10-year periods. Trademark registration issued or renewed prior to November 16, 1989 remain in force for 20 years, and may be renewed for 10-year periods. Trademark owners have a total of 18 months to file a §9 Renewal Application. The §9 Renewal Application may be filed one year prior to the registration expiration date or during the 6-month grace period immediately after the date of expiration. If the §9 Renewal Application is not filed or is filed after the grace period ends, the registration will expire.

Section 15 Declaration of Incontestability: A sworn statement, filed by the owner of a mark registered on the Principal Register, claiming "incontestable" rights in the mark for the goods/services specified. An "incontestable" registration is conclusive evidence of the validity of the registered mark, of the registration of the mark, of the owner's ownership of the mark and of the owner's exclusive right to use the mark with the goods/services. Filing a Section 15 Declaration is optional.



However, there are certain rules governing when one may be filed. A §15 Affidavit may not be filed until the mark has been in continuous use in commerce for at least five consecutive years subsequent to the date of registration. The §15 Affidavit must be executed and filed within one year following a 5-year period of continuous use of the mark in commerce.

Service Mark: A word, name, symbol or device that is used to indicate the source of the services and to distinguish them from the services of others. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms “trademark” and “mark” are often used to refer to both trademarks and service marks.

Secondary Meaning (aka Acquired Distinctiveness): A doctrine of trademark law that provides that trademark protection is afforded to the user of an otherwise unprotectable mark when the mark, through advertising or other exposure, has come to signify that a product or service comes from a single source.

Specimen: A real-world example of how the mark is actually used on goods or in the offer of services. Labels, tags, or containers for goods are considered to be acceptable specimens of use for a trademark. For a service mark, specimens may be advertising such as magazine advertisements or brochures. One specimen is required for each class of goods or services specified in the trademark application.

Statement of Use (SOU): An Allegation of Use filed after issuance of the Notice of Allowance. The Amendment to Allege Use and the Statement of Use include the same information, and differ only as to the time when filed.

Stylized Mark: One type of depiction of the mark sought to be registered. Another name for this type of mark is “special form.” If the mark includes a particular style of lettering, or a design or logo, the mark is considered to be stylized or in special form. Therefore, applicants must select the “stylized or special form” mark format when applying for these types of marks. The mark in special form must be a substantially exact representation of the mark as it appears on the specimen or on the foreign registration, as appropriate.

Standard Character Format: An applicant may submit a standard character format representation of a mark if (1) All letters and words in the mark are depicted in Latin characters; (2) all numerals in the mark are depicted in Roman or Arabic numerals; (3) the mark includes only common punctuation or diacritical marks; and (4) the mark does not include a design element.

Suggestive Mark: A mark that, when applied to the goods or services at issue, requires imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Suggestive words are acceptable for registration (e.g. “Nutrasweet” for artificial sugar).

Trademark: A word, name, symbol or device that is used to indicate the source of goods and to distinguish them from the goods of others.

Trademark Act: Title 15 of the United States Code (USC). The major body of U.S. law that governs federal registration of trademarks.

Trademark Electronic Application System (TEAS): USPTO’s electronic filing system.

Trademark Electronic Search System (TESS): USPTO’s online database for searching pending, registered and dead federal trademarks. TESS is free and intended for use by the general public.

Trademark Manual of Examining Procedure (TMEP): A reference work on the practices and procedures relative to registration of marks in the USPTO. It contains guidelines for USPTO examining attorneys, trademark applicants and owners, and attorneys and representatives for trademark applicants and owners.

Use in Commerce: For the purpose of obtaining federal registration, “commerce” means all commerce that the U.S. Congress may lawfully regulate; for example, interstate commerce or commerce between the U.S. and another country. “Use in commerce” must be a bona fide use of the mark in the ordinary course of trade, and not use simply made to reserve rights in the mark.

Word Mark: A type of trademark or service mark comprised of text.

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