

TRADEMARK AND DOMAIN NAME SELECTION AND USE

When to use:

- For selection of a trademark or domain name
- For registration of a trademark or domain name
- For use of a trademark of domain name

TRADEMARK SELECTION

All trademarks used by a company should be selected and cleared taking the following guidelines in consideration. These guidelines are designed to ensure that trademarks selected by a company can be used free of infringement concerns, and can be registered and enforced, in all jurisdictions of importance.

Considerations for Selecting a Trademark

When choosing or changing a trademark for a product or service, there are some key issues to bear in mind. In deciding what makes up a good trademark, the strength or distinctiveness of the mark is important to understand. In general, the more distinctive the mark, the stronger the mark will be. Additionally, distinctive marks are significantly easier to register and protect from use by other parties. Trademarks are generally categorized by their distinctiveness, from strongest to weakest as follows:

- **Fanciful Marks:** A fanciful mark is one that is a newly coined term or made-up word that has no regular meaning. The sole purpose of the word is simply to be a trademark, and as such it is the strongest kind of mark. Good examples of this kind of mark are “Yahoo” for Internet searching or “Acura” for cars. Neither trademark has a regular everyday meaning. For this reason, fanciful trademarks are generally given the broadest scope of protection against use by other parties.
- **Arbitrary Marks:** An arbitrary mark is made of a word or words that have plain meaning, but that plain meaning is completely unrelated to the product or service with which the mark is used. Examples of arbitrary marks are “Sun”

- Domain Name Selection 2
- Trademark Use 3
- Trademark and Domain Name Registration 4
- Policing and Protecting Trademarks 5

for computers or “Galaxy” for smart phones. Like fanciful marks, arbitrary marks are given broad scope of protection against use by other parties. The primary difference is that the owner of an arbitrary mark would not be able to stop other parties from using the mark with respect to goods or services that are part of the plain meaning.

- **Suggestive Marks:** A suggestive mark suggests some attribute or feature of the goods or services it is associated with, without being outright descriptive of those attributes or features. Examples of suggestive marks are “Microsoft” for software or “Jaguar” for cars.
- **Descriptive Marks:** A descriptive mark simply describes the product. These types of marks are generally very easy to understand and associate with products; however, rights to the exclusive use of such marks are very limited. Examples of descriptive marks include “Quick Charge” for a device that charges batteries (quickly) or “Nut Brown Ale” for beer. Other examples may include words that simply describe an attribute, feature, end result, use of the product, or persons associated with the product. Additionally, words or phrases that are merely laudatory (“best”, etc.) are considered descriptive as well. These types of marks are generally difficult/impossible to protect with a trademark. In most cases, these are not ownable trademarks.

Other Trademark Categories to Note

- **Generic Terms:** A generic term is a word or phrase that has become a common term associated with a particular category of goods or services to which it relates. By becoming generic, the term ceases to function as an indicator of origin—which is the purpose of a trademark. As an example, “Car” is a generic term for automobiles. Generic designations cannot be registered or protected. It is possible for an otherwise protectable mark to become generic if used improperly. If such a mark becomes generic, a company may lose its claim to exclusivity. Examples of marks that have become generic include “Escalator” and “Zipper”—terms that were originally trademarked but now are used generically.

Remember: Generic terms can never be trademarks.

- **Names/Surnames/Geographic Locations:** In many jurisdictions, trademark laws prohibit the registration of marks that are merely the name of an individual, a surname, or the geographic location where the goods are made or originate. For example, “Corleone” may not qualify for trademark registration, as it is primarily a surname. Adding a modifier, however, may aid in the ability to protect the mark—“Corleone Security Services.” Similarly, an attempt to register “Napa” for a wine, would likely be unsuccessful as it is a well-known wine region. In this case, no one producer should have exclusive rights over that name for wines.

TRADEMARK SEARCH & CLEARANCE

Prior to adoption and use of a trademark, steps should be taken to ensure that the mark is available for use and is not merely descriptive (as described above). This analysis can typically be done quickly

and relatively inexpensively by an outside IP counsel based on a search of the records of the United States Patent and Trademark Office.

In many cases, especially where the mark is of heightened importance, a “full” or “complete” search by an outside IP counsel may be advisable. Such a search typically reviews federal and state registration records, and common law trademark uses such as certain trade directories, business name lists, domain names, and listings of certain published judicial decisions regarding relevant marks. Internet page content and International Registration information may also be included.

It can be difficult to uncover all potential types of common law trademark usage but an appropriate search is a cost effective way of identifying potential issues in advance. A search may be able to identify prior trademark rights which could preclude a company’s ability to use or register the proposed mark. Moreover, the search may identify a famous or well-known trademark which could form the basis for a claim that the mark is illegally diluting the famous trademark. Additionally, if there are plans to enter foreign markets with the trademarked product or service, it is necessary to consider the availability and clearance of the mark in those jurisdictions as well. These risks and considerations should be understood in order to identify and deal with potential problems in advance.

DOMAIN NAME SELECTION

When selecting a domain name for registration, it is important to review the registered name in light of these trademark guidelines. Proper analysis and clearance from the trademark perspective is necessary to defend the use and ownership of the domain.

TRADEMARK AND DOMAIN NAME SELECTION AND USE

TRADEMARK USE

The manner of use of a trademark is critical to maintaining its strength. Care should be taken to use all trademarks appropriately at all times.

The following guidelines should be followed in order to maintain the strength of a company's mark(s):

✓ **Trademarks should always be used as adjectives that modify nouns.**

Regardless of the context, a company's trademark(s) must always be used to modify the common name for the associated product or service. For example:

- "Apple" computers
- "Honda" motors
- "SpeakerCraft" speakers

The word "brand" may be used to further distinguish the trademark from the noun it modifies. For example:

- "Nike" brand apparel
- "Best" brand kitchen ventilation products

If you are in doubt whether you have used a trademark as an adjective, try removing the trademark from the sentence. If the sentence still makes sense, you have likely used the trademark correctly.

Using a company's trademark as a noun or as a verb is prohibited. For example:

Use as a verb

- Improper: Can you "Xerox" me a document?
- Proper: Can you make a copy of the document on the "Xerox" photocopy machine?

Use as a noun

- Improper: He has a "Go!Control" installed in his home.
- Proper: He has a "Go!Control" security system installed in his home.

✓ **Trademarks should be distinguished from other words in printed materials.**

Trademarks that are registered with the United States Patent and Trademark Office should include the registration symbol ® on the shoulder of the mark. As appropriate, trademarks and service marks which are not yet federally registered, should be accompanied by the ™ or ℠ symbol, respectively. This rule should be followed at least for the first or most prominent usage of the mark in any printed material.

As a standard practice, in addition to the use of the symbols described above, to distinguish trademarks from other words, the first letter of the mark should generally be capitalized. Other alternative options include placing the trademark in quotations, or using all capital letters, italics, bold type, or contrasting colors. The point is to indicate that the mark is not a plain word. These rules should be consistently followed throughout the text of a printed document.

If a mark registered in one jurisdiction is intended for use in another jurisdiction where it is not registered, consult with your legal representative with regard to the use of the ® symbol to avoid problems associated with local laws.

✓ **Trademarks should be used only in their exact format.**

It is generally improper to make changes to a trademark or logo in use. Avoid combining together two trademarks, adding words or letters to a trademark, or making a trademark plural or possessive with an apostrophe "s".

TRADEMARK AND DOMAIN NAME REGISTRATION

Trademark Registration

There are advantages provided by federal registration of a company mark(s) in the United States. These advantages include the right to use the ® registration symbol, providing notice to the world of the company's rights, and the statutory presumption of the company's exclusive right to use the mark in commerce.

It is possible to file applications based on:

- A bona fide intention to use the mark at a later date, or
- Commercial use of the mark in commerce.

If an application is filed on the basis of an intention to use the mark, actual commercial use of the mark must be commenced before U.S. registration of the mark will issue. There are certain time limits and other restrictions which apply to intent-to-use applications. Consult with your legal counsel for more details.

Filing an application based on commercial use of a mark, as well as maintaining or renewing a registration, requires that the mark be used in the ordinary course of trade. This normally requires full-scale and routine use.

Value of Registering Trademarks in Foreign Countries

It is possible to register trademarks in most foreign countries. Such registration can prevent difficulties in selling a company's products or providing services overseas. Prior planning and understanding of trademark implications in key markets is critical.

In many foreign countries, rights are accorded to the first to register, so it is important to file applications in foreign countries of interest before another party tries.

It is advisable to file foreign trademark applications within six months of filing a corresponding U.S. trademark application. Under International Convention, the foreign applications may then be entitled to the benefit of the U.S. filing date.

In addition to securing foreign and domestic trademark registrations, consider the value of registering important trademarks as Internet domain names to prevent others from later securing the names and blocking use of the domain name by the trademark owner.

Ongoing Use of Each Mark is Important

In the U.S., ongoing use of a mark is required to maintain trademark rights. Use in the ordinary course of trade is required to obtain and maintain a federal registration. In many foreign countries, registrations may be successfully challenged after several years of registration if the mark has not been used in that country since the registration issued.

Note: Rights in a mark may be lost or abandoned if there is no commercial use of the mark for a long period of time [i.e. three years or more], or if usage of the mark is discontinued with no intention to resume. When discontinuing a product or technology, it is important to consider the trademark implications and whether there is a desire to preserve the mark.

POLICING AND PROTECTING TRADEMARKS

Company trademarks are valuable assets. Part of the value of trademarks comes from the exclusivity they provide and the fact that others cannot use similar marks on related goods or services. In order to preserve these rights, it is important to monitor the activities of others in the industry. This can be done by watching for the use or attempted registration of similar marks by competitors.

For key trademarks, the following guidelines should be considered:

- ✓ Monitor new trademark registration filings with the USPTO to ensure no one else attempts to register a same or similar trademark.
- ✓ Monitor any potential infringing commercial use made by a third party.
- ✓ Monitor the use of the company trademark(s) to (by the company or third parties) ensure compliance with trademark laws and company policies.

If competitors or others are using confusingly similar trademarks, it may be essential to take action to prevent infringement and avoid any narrowing of the company rights.

Internet Considerations

The Internet presents additional considerations with respect to a company's trademark(s).

Periodic review of the Internet, both for conflicting domain names, metatags and content is necessary to identify incidents and aid in policing infringers.

Because the Internet crosses international borders, U.S. trademark law does not automatically apply in certain circumstances. This should be kept in mind when reviewing use by others. In addition, material published on a company's Internet site should be carefully prepared to confirm compliance with local and international laws.