

## Chapter 1 : Chapter a - Trademarks and Service Marks

*Whenever a trademark or service mark is federally registered with the United States Patent and Trademark Office (USPTO), the owner of the trademark may use the registered trademark symbol, often referred to as the registration symbol, ®. It is unlawful for unregistered companies to use this symbol.*

A trademark or service mark is a word, symbol, phrase, design or combination thereof which the public associates with a single source of a product or service. Knowing whether a product or service can be mark-protected, how to register a product or service, and how to enforce trademark or service mark protection laws are important issues facing businesses. Governing Laws Trademarks and service marks are regulated by both federal and state law. The Lanham Trademark Act of 1946, the federal statute governing trademark rights, defines a trademark as "[A]ny word, name, symbol, or device, or any combination thereof" used by a person, or 2 which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. State trademark statutes protect the use of trademarks and service marks within a particular state. Thus, Minnesota Statutes sections 100A.01 to 100A.05. A common misunderstanding occurs when a business believes that its filing of a trade name automatically confers the right to use the trade name as a mark. This is not the case. Rather, the filing of a trade name, articles of incorporation, or qualification to do business merely notifies the public that an entity is operating under specific name. It does not confer trademark rights beyond providing some evidence that the name has been used since at least the filing date. Classic examples of fanciful marks include Kodak film trademarked by the Eastman Kodak Company and Exxon gasoline trademarked by the ExxonMobil Corporation. Such marks are highly distinctive and the strongest against infringement. These are weaker than fanciful or arbitrary marks, but also highly protectable. Examples include Jaguar suggesting a sleek and speedy automobile and Downy suggesting a product that will leave your clothes feeling soft and fresh. These are weaker trademarks that may only be protectable if they take on a secondary meaning that readily identifies the product or service with the mark. Examples include the Yellow Pages describing the color of pages in a telephone book and Shredded Wheat describing the composition and main ingredient in a breakfast cereal. A mark that becomes generic may have been protectable at first, but, due to the manner in which the mark is used. Classic examples include Aspirin and Escalator, while Google may be approaching generic status. Mark Searching and Registration Once a business selects a mark, it should determine whether the mark is already in use. As noted earlier, because rights in marks are determined by actual use or federal intent to use filings, the first person to use a mark or to apply to register a mark owns it. Unfortunately, no single database exists that compiles all marks currently in use. However, many marks can be eliminated by checking one or more of a number of resources, including USPTO records; trade publications such as dictionaries, directories, and magazines; the trademark registration department of each state in which the mark is expected to be used; and even internet searches or the telephone book. Professional search companies and trademark attorneys may also have access to other comprehensive search options. Once a search is complete and a mark is chosen and used, federal registration should be the next step. Although use of a mark alone does confer some rights on the owner, registration expands and adds to those rights. The Lanham Act created two separate registers on which marks may be registered, the Principal Register and the Supplemental Register. Most states provide a registration mechanism for registering marks used solely within a state or otherwise not qualifying for federal registration. A mark that is used in more than one state may be registered separately in each state. State registration is typically quicker and less expensive than federal registration, but affords little in terms of protection against infringement. Thus, state registration is typically recommended only when federal registration cannot be accomplished. Use and Monitoring of Marks Once a mark is placed in commerce, it is up to its owner to promote proper use of the mark. Mark use is not regulated by law, but is rather a matter of common sense and is based on the use of marks as proper adjectives, which they are. Proper use is important, particularly for stronger marks, which are prone to becoming common usage. Proper mark

usage includes the following: Distinguishing marks in print through capitalization, bold or italics, or other means. Avoiding use of a mark in plural form, because it is a proper adjective, not a noun. Avoiding use of a mark as a verb e. Apart from promoting proper use of their marks, businesses have different options for policing mark use. Mark owners should watch for the use of similar marks by competitors or others within their industry. Any time a potential infringement is discovered, businesses should notify their legal department if they have one or an outside attorney. However, registration, proper use and vigilant monitoring must follow in order to maintain it. With these steps, a mark can last forever, potentially endowing a business with a proprietary right of immeasurable value. Often, consultation with a trademark attorney through any or all of these steps will assist businesses in maximizing the strength and protectability of their marks. Time and money devoted to establish, strengthen and protect a trademark or service mark is a continuing investment, which, if carefully made, can yield commercial success and longevity for both brands and businesses alike. Published in Business North , April Fryberger Recognized by U. This is the ninth year since that Fryberger has been recognized. Hansen is a graduate of the University of Wisconsin Law School. You should not rely on any information contained herein regarding your specific situation until you have consulted with a qualified attorney.

## Chapter 2 : Trademark vs. Service Mark | LegalZoom Legal Info

*A service mark is the same type of device as a trademark, but service marks distinguish the services of one company from those of another provider. Service marks are often slogans. For example, the service mark of a plumber might be "The Leak Fixers" with or without a distinctive logo.*

A trademark offers protection for a symbol, logo, phrase, word, design, or name for goods or products and service marks offer similar protection for services. A service mark, or servicemark, offers similar protection for services. If you have a company that provides a service, focus on the service mark. Using TM in your mark represents trademark and SM represents service mark. Neither holds any legal significance. The only symbol that has legal weight is the registered symbol, represented by an encircled R. Before submitting an application, those involved should carefully review existing service marks and trademarks in the registry. Similar marks are often rejected because they can cause confusion among consumers. Trademark and service mark laws exist to protect consumers as well as businesses. Without a clear mark, a customer may not know what company manufactured a product or provided a service. Protection under trademark and service mark laws also extends to the owners of the marks. If another company can confuse a customer into purchasing its products, your business will suffer. With legal protection, you can sue the infringer for damages. This includes profits lost during the time that the other company used the similar or identical mark. The difference between a service mark and a trademark seems pretty straightforward, but the two options do lead to some confusion for business owners. If you offer both goods and services, you may not know which to use. Many businesses that provide services and goods use both trademarks and service marks. An example of a service mark might apply to a bank. The bank might include a service mark on the unique names of its checking and savings accounts. Why is Trademark vs. Service Mark? But when you look at what the company provides, it becomes clearer. You may hear both service marks and trademarks referred to simply as "marks." Reasons to Consider Using Trademark vs. Service Mark The benefit of using the symbols associated with trademarks and service marks is that both inform competitors of your plan to use the mark for your business. If a similar company is considering making a change to its logo, phrase, symbol, design, or word associated with the goods or services, seeing one of these symbols on your mark might reduce the chances of duplication. But the real legal protection comes when you file an application for a trademark or service mark. When you do file for a trademark or service mark, consider these important points: A trademark or service mark that only contains characters should be submitted in all caps. The legal protection will extend to the characters in lowercase or capital letters. A trademark or service mark that contains a design, logo, or symbol should be submitted in the exact form that you plan to use. You may want to consider submitting several applications at once. When you submit the design in color, only that exact layout has protection under the laws. So if you ever plan to use the design in another color or in black and white, submit a separate application for each option. Reasons to Consider Not Using Trademark vs. Service Mark These superscript letters might clutter up the text or layout of your design. But when using any of the symbols in print, you can simply use one in the first instance of the mark. Doing so will reduce the clutter and improve readability of the text. Another reason that you might choose not to file an application for your trademark or service mark is the cost. Completing the trademark or service mark registration process is the only way to fully protect your mark. Common law rights afford protection to companies that use the mark in regular business practices. But if someone else has registered an identical or similar mark, the common law trademark rights no longer apply. If the other individual chooses to file an application for either a service mark or trademark with a similar or identical mark, you lose the option to do so. This becomes even more complex when the USPTO reviews the filing date on the application, since that is the basis for all legal rights to the mark. One example of a trademark is Nike, a company that sells apparel and footwear products. Some companies fall under both service mark and trademark categories. You can purchase items like boxes and packing materials in its stores. The company might add TM to marks that relate to the goods, while the marks relating to services might have an SM symbol. Common Mistakes One mistake is not understanding which mark best protects your company and

goods or services. You do qualify for common law trademark rights, but if someone else files for trademark protection or already has a trademark for something similar, you will no longer be able to use it. Filing quickly starts the approval process and reduces the chances of losing the opportunity to file for a trademark in the future.

**Frequently Asked Questions** What is the difference between a trademark and a service mark? A trademark extends legal protection to a symbol, word, phrase, logo, or device used by a company or person that sells goods. A service mark offers the same legal protection to a symbol, word, phrase, logo, or device for a company or person that provides a service. What does it mean when a lawyer refers to a "mark" or "marks"? An attorney might simply refer to the mark or marks registered to a specific company or person. The term refers to either a service mark or a trademark. If you were filing for registration of your trademark in the Commonwealth of Massachusetts, your company may receive material advantages. Registering your mark in this area of the U. Registering your trademark in the state will also protect you against infringement through the option to take legal action against those who copy your mark. If a court determines that an infringer acted with knowledge of your mark and its protected status, your company could qualify for additional damages. In order to file a mark for legal protection in the Commonwealth, you will need to provide the following information about yourself or your business as well as your mark: When you clearly see which mark is the best option for your business, you can save time by filing the correct application from the start. If you need help with filing for a trademark vs. Lawyers on UpCounsel come from law schools such as Harvard Law and Yale Law and average 14 years of legal experience, including work with or on behalf of companies like Google, Stripe, and Twilio. Was this document helpful?

## Chapter 3 : Trademarks and Service Marks - KPPB LAW

*Trademarks and Service Marks The Secretary of State's office maintains registration and all updates of California state trademarks and service marks. This information is accessible to the public upon request.*

Trademarks and Service Marks You are here: Registering your trademarks and service marks is an important step toward protecting the general perception of your brand. Difference Between Trademarks and Service Marks Trademarks and service marks serve very similar purposes and may contain the same elements, so there is often confusion as to which is which and which one your business should register. An experienced trademark and service mark lawyer can help you make that assessment and guide you through the research and registration process. What is a Trademark? Patent and Trademark Office provides this brief definition of a trademark: A trademark is generally a word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others. In simple terms, a trademark allows consumers to recognize that your company is offering the goods they are considering, and to factor the source of goods into purchasing decisions. Exclusivity of trademark is important to a business offering goods for sale for two reasons: A service mark offers the same type of protection as a trademark, except that rather than identifying the source of goods, a service mark identifies a business that provides a service or services rather than goods. Determining Whether You Need a Trademark or Service Mark Given the brief descriptions above, the choice between a trademark and a service mark may seem obvious. For example, a company that manufactures and sells tires is producing and selling goods, and so employs a trademark. In reality, however, the analysis is often more complicated. For example, a retail store sells goods, but it is not the goods that are branded. The goods typically come from other sources with their own trademarks. For the retailer, the protected brand image relates to the set-up, the displays, the customer service provided and other service-related elements. So, although Piggly-Wiggly is in the business of selling goods, the company name is a registered service mark. In some cases, a company may need both a trademark and a service mark. Registering a Trademark or Service Mark The process of registering trademarks and service marks is virtually identical. Before commencing the process, it is important that the business consider the mark carefully and answer a few key questions, including: Is the mark eligible for registration? For example, a word or phrase that is too common or generic cannot be a registered trademark. Is there a likelihood of confusion with an existing mark? Avoiding confusion among providers of goods and services is a key goal of trademark and service mark protection, so a mark that is too close to or easily confused with an existing mark will likely be rejected. An experienced intellectual property attorney can be your best source of advice on that issue. Multi-step Process Registration is a multi-step process that may take a year or more to complete. First, the application and specimen are reviewed, which may take three to four months. Then, if the examining attorney finds no obstacles to proceeding, the mark will be approved for publication and an opportunity for objections from the public. Protecting Your Trademark or Service Mark One important manner in which trademarks and service marks differ from other types of intellectual property is that they must be actively employed and defended. Work With a Legal Professional at KPPB LAW An experienced trademark and service mark attorney can help you determine which type of registration to pursue, or whether different aspects of your business may require different types of protection. Our firm can help, from the initial analysis of your mark through registration and maintenance.

## Chapter 4 : Trademarks and Service Marks | Jeppesen

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## Chapter 5 : Trademarks and Service Marks | Fryberger, Buchanan, Smith & Frederick, P.A.

*Trademarks and Service Marks. This webpage contains guidelines to help you make proper referential use of Carnegie Mellon University Software Engineering Institute (SEI) trademarks and service marks in your documents (e.g., files, presentations, webpages).*

### Chapter 6 : California Secretary Of State CA Trademark and Service Mark

*All registered marks (trademarks and service marks) are on the Division website, so members of the public are aware of the trademark owner's claim on the mark. Registering your mark in this area of the U.S. also provides you with a filing date, which counts as the date of first use in the state of Massachusetts, helping solidify your claim if.*

### Chapter 7 : Difference between Trademarks and Service Marks?| LegalRaasta

*Trademarks and service marks are effective for five years and may be renewed within six months prior to the expiration date. Registrants are notified of pending expiration at least six months prior to the expiration date.*

### Chapter 8 : Trademark vs. Service Mark: Everything You Need to Know

*A trademark is a word, name, symbol, device, slogan or any combination thereof which, whether registered or not, has been adopted and used by a person to identify his goods and distinguish them from the goods manufactured or sold by others. Tex.*

### Chapter 9 : Kentucky Secretary of State

*A service mark is a word, phrase, symbol, and/or design that identifies and distinguishes the source of a service rather than goods. Some examples include: brand names, slogans, and logos. The term "trademark" is often used in a general sense to refer to both trademarks and service marks.*