

# Fundamentals of Trademark Law



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# What is a Trademark?

A trademark is a word, symbol, slogan, or other identifier that identifies the source of a good or service in the marketplace. Trademarks are protected by law to prevent others from copying the source-identifying mark. This protection benefits a potential consumer by allowing the consumer to recognize a product or service as originating from a particular producer. In other words, trademarks allow a consumer to quickly associate a product with the company that produced it and make a purchasing decision based on prior experience with that company or product. Likewise, trademark protection benefits a producer by allowing a company to protect its investment in its reputation. If a company works hard and puts resources into providing a consistent and superior product, trademark law allows that company to prevent others from using its trademarks and selling products based on the trademark owner's good reputation.

The interplay between the covered goods and services and the descriptiveness of the trademark is important because trademark law encourages distinctive trademarks while attempting to prevent trademarks that are overly descriptive of the covered goods. The reasoning behind this is that a trademark owner should not be allowed to have exclusive rights to a generic or descriptive mark for a particular product or service. Therefore, trademarks are generally placed into a continuum of five categories: generic (e.g., "Software" for software), descriptive (e.g., "Business Machine" describes a primary use of a computer), suggestive (e.g., it takes some imagination to connect "Microsoft" with software), arbitrary (e.g., "Apple" is a real but arbitrary word for electronics), and fanciful (e.g., "Xerox" is a made-up word for copiers). The farther down the continuum, generally, the easier it is to receive the trademark and the stronger the legal protection.

## Types of Trademarks

Generally, there are three main types of trademarks: trademarks, service marks, and trade dress (two other types, certification and collective marks, are not discussed here).

- **Trademark** – A trademark is a word, logo, symbol, or combination of these and identifies the source of a product or good. A trademark may be located on a package, a label, a voucher, or on the product itself.
- **Service mark** – A service mark is similar to a trademark except it identifies the provider of a service rather than a product. Service marks are a subset of trademarks and are oftentimes referred to as trademarks. Examples of service marks include Amazon.com (retail service), UPS (delivery service), and Geek Squad (computer service). Because there is no product or packaging to mark, service marks are generally seen on advertising, uniforms, vehicles, and the like.

- **Trade dress** – A trade dress protects elements of a product or its packaging, including color, size, shape, aroma and flavor. Examples include the distinctive shape and décor of a restaurant, the color of insulation, or the shape of a beverage container. Like a service mark, trade dress is a subset of trademark law and is oftentimes referred to as a trademark.

## Applying for a Trademark

In the U.S., a trademark application may be filed with the federal government, one or more state governments, or both. Moreover, a trademark may also be acquired without filing an application if certain conditions exist. Trademarks are geographical in scope with a federal trademark providing nationwide coverage. An applicant can obtain a trademark by filing a trademark application with the United States Patent and Trademark Office (USPTO). Once received, a trademark examiner is assigned to review the application and ensure it complies with the trademark laws. The examiner determines whether the trademark should be granted based on several factors, including the goods or services covered, whether any confusingly similar trademarks are registered, and the distinctiveness of the trademark.

Trademarks are territorial in nature. That is, a U.S. federal trademark applies across the U.S. only. Similarly, a trademark obtained from one of the U.S. states applies in that state only. Therefore, for trademark protection in other countries, a trademark application must be filed in each country. Fortunately, the U.S. is part of several treaties—chiefly, the Madrid Protocol which covers over 100 countries—that streamline and centralize the process for filing in multiple countries via a single “international application.” An applicant that files under the Madrid Protocol selects the countries (or, in some instances, group of countries such as the European Union) in which it seeks trademark protection and pays fees based on the selected countries. Once filed, the international application is examined by the government of each of the selected territories for registration within that territory.

## About the Author

Dev Batta is a Senior Associate and admitted to practice law in California, Virginia, and in front of the United States Patent and Trademark Office (USPTO). Mr. Batta has over 10 years of experience as an intellectual property and technology lawyer. Prior to joining Avasant, he worked for several large law firms, including Cooley and Locke Lord. Mr. Batta has successfully prosecuted over 100 patent applications in technologies ranging from driverless vehicles, E-commerce, drones, content delivery, and Internet advertising. He also represents both plaintiffs and defendants in patent and trademark litigations and proceedings both in Federal Court and in front of the USPTO.

## About Avasant Law

Avasant Law is a law firm that includes attorneys dedicated to all aspects of technology law, including technology transactions, business process sourcing, patents, trademarks, privacy, and information security.

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