Trademark Administration:
The Who, What, How, and Why

By Mary A. Donovan∗

I. Introduction

Trademarks, also called brands, are everywhere. It is estimated that the average American is exposed to 4,000 to 10,000 advertisements per day, be it through television, radio, phone apps, the Internet, newspapers, billboards, or other media. (See Jon Simpson, “Finding Brand Success in the Digital World,” Forbes, Aug. 26, 2017.) No doubt, almost all of those advertisements prominently display trademarks. Trademarks are the essence of marketing, benefiting both the trademark owner and the consumer by identifying the source of a product or service. In assisting with the clearance, maintenance, and protection of trademarks, trademark administrators (“Administrators”) serve a valuable function in the national and international economy. This chapter presents a general overview of trademarks as part of the body of rights known as intellectual property.

II. What Is Intellectual Property?

It is easy to understand “property” in the sense of real estate or physical objects that can be owned, such as cars, furniture, or jewelry. Systems of ownership of physical property probably have existed since the beginning of human society; they sprang from common-law principles of civilized behavior and fairness.

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“Intellectual property,” however, has no physical embodiment that one can see, touch, or feel. Systems of ownership of intellectual property are relatively new historically. Trademark rights have been recognized the longest in those countries that follow the principles of common law. Apart from that, trademarks and other types of intellectual property are statutory. For example, the first statutes recognizing the modern concepts of patents and copyrights appeared in England in the mid-seventeenth and early eighteenth centuries, while the first statutes to recognize trademark protection appeared in the middle to late nineteenth century. The use of trademarks, however, is thought to date as far back as the Roman Empire, when blacksmiths were known to brand their swords.

Trademarks, trade names, inventions, designs, domain names, and original expressions through art, writing, or even computer or digital programming can constitute intellectual property. Like physical property, intellectual property can be owned, purchased, sold, transferred, or licensed. The following is a brief summary of the types of intellectual property other than trademarks.

A. Trade Names

A trade name identifies the name of a business, be it a corporation (Hearst, Inc.), a partnership (PricewaterhouseCoopers), a nonprofit organization (Susan B. Komen Foundation), or merely a “d/b/a” for an individual or group (The Black-Eyed Peas). Trade names are closest to trademarks in the realm of intellectual property; consequently, they often function, particularly in some shortened version, as trademarks as well. For example, SONY is both shorthand for the trade name Sony, Inc. and the trademark used on that company’s electronic products.

As the following comparison illustrates, whether a term is used as a trade name or a trademark depends on the context in which it is used.
<table>
<thead>
<tr>
<th>Use as a Trade Name</th>
<th>Use as a Trademark</th>
</tr>
</thead>
<tbody>
<tr>
<td>“IBM’s stock was up 10 points today.”</td>
<td>“I love my IBM computer.”</td>
</tr>
<tr>
<td>“Starbucks is opening 1,000 new cafes.”</td>
<td>“I want a STARBUCKS latte.”</td>
</tr>
<tr>
<td>“Armani announced a new fall collection.”</td>
<td>“Do you like this ARMANI jacket?”</td>
</tr>
</tbody>
</table>

Other companies may have unique trade names but may choose not to use those names as brands. These firms often are known more by the trademarks they use than by their actual trade names. For example, the TORY BURCH trademark, used in connection with a wide range of clothing and accessories, is owned by River Light V, L.P. CRB, LLC. Do you know which companies own the following brands?

- **LEAN CUISINE** meals
- **CASCADE** dish detergent
- **GLADE** air fresheners

(Lean Cuisine: (Société des Produits Nestlé S.A.)
CASCADE: (Proctor & Gamble Company)
GLADE: (S.C. Johnson & Son, Inc.)

Generally, trade names last for the life of the business involved. In the United States, trade names are not registered on the federal level with the U.S. Patent and Trademark Office (USPTO) or any other national registry; instead, they are registered on a state-by-state basis. In many countries, there is national registration of trade names.
B. Patents

Patents protect inventions by granting exclusive rights to prevent others from using them for specified periods of time. The word *patent* itself comes from the Latin word meaning “to reveal,” because the inventor files a detailed description with the intellectual property office that will show others how to make the invention after the patent expires. To be patented, an invention must be new or “novel” and “non-obvious.” “Novel” is a higher standard of originality than the mere fact of independent creation required by copyright.

Patents generally apply to areas such as manufacturing, chemistry, biotechnology, business methods, and electronics. Patents will protect against duplication of a protected invention, whether or not the infringer has had any access to the patented invention. Because the rights are quite substantial and exclusive, patents have a much shorter life than copyrights or trademarks. Patent rights are considered a “limited monopoly.” In most countries, patents last for 20 years from filing. Once the patent expires, anyone can use the technology revealed by the patent.

C. Copyright

Copyright protects authors, artists, musical composers, performers, and other creators (jointly and severally, “authors”) by granting them exclusive rights in their original works of authorship, generally writings, artwork, music, musical performances, movies, and the like. Copyright protects artistic expression and does not protect the design of useful objects. Thus, no matter how attractive and beautifully designed, the shape of an automobile would not be protected by copyright. Copyright would extend to protection of a separable artistic element if one existed, such as a painting of a country scene on the side of a chest or a frieze showing horses and riders on the side of a building.

In the United States, copyrights can be owned by companies under the “work for hire” doctrine—that is, that the works were created by employees or, for certain types of works, that the works were created by independent contractors at the behest of the company. Under the work for hire doctrine, the company is considered the “author” of the work. Most other countries do not have a “work for
hire” concept, and an author retains certain rights in his or her work even if the copyright has been transferred. Copyright prevents “copying” of someone else’s work; it does not protect against independent creation.

Unlike trademarks, which can last forever, copyright generally lasts for a long, but not an infinite, time. In the United States, the term of a copyright for an individual is the life of the author plus 70 years. For companies, the term of a copyright is the shorter of 95 years from first publication of the work or 120 years from creation of the work. Other countries will have different terms. Most countries do not have any formalities or registration process involved in establishing copyright ownership. In the United States, however, U.S. citizens must register their works with the Copyright Office to be able to bring a suit to enforce their rights. Once the copyright expires, a work is said to be in the “public domain,” and it may freely be copied by anyone.

In certain commercial fields there is often an overlap between copyrights and trademark rights. For example, comic book and children’s book characters are protected by copyright with respect to the drawings and artwork involved. These characters may also be trademarks when the same distinct depiction of them is consistently used on goods or packaging in a way that indicates the source of the goods and not just a storyline, as in the following examples:

**Practice Tip**
If there is artwork involved in your logo, you might consider whether copyright is another avenue of protecting the mark. Mere stylization of lettering is not going to be copyrightable, but a picture, such as the depiction of SPIDERMAN or CURIOUS GEORGE, below, may be.

![SPIDERMAN](image1)

![CURIOUS GEORGE](image2)
D. Design Patents/Industrial Designs

Design patents and industrial designs do not exist at common law but are covered by statute in various countries. Each protects the original appearance of a functional object, such as the design of a table or an automobile body. Design protection resembles copyright in that it is concerned with artistic elements that make products more visually pleasing. It resembles patents for inventions because the objects are functional and are improved or at least altered aesthetically by the designer.

Certain countries will protect the look of manufactured objects only by industrial design/design patent filing. Others may protect the look of useful objects by copyright if the objects are seen as nonfunctional. For example, dolls and jewelry manufactured in multiples are protected under copyright in the United States, but in certain other countries they must be registered as industrial designs in order to be protected. Design patents and industrial designs are protected for a limited number of years, as specified in the relevant statutes, and generally for a shorter period than patents.


E. Domain Names

Domain names are the newest form of intellectual property. In essence, the domain name is, first and foremost, an address on the Internet. Many domain names are and remain simply addresses—for example, www.pets.com or www.cosmetics.com. At other times, a domain name may serve a dual role, as
both a Web address and a trademark, particularly where the domain name and the mark serve as shorthand for the company name, as in the case of AMAZON and EBAY. To be considered a trademark, a domain name must be more than just a Web address, or a Web address that directs users to another site. It must be used as a source designation, and therefore displayed prominently on the website as a mark.

Here, COSMOPOLITAN is being used as a source identifier for the goods and services offered on the website www.cosmopolitan.com. Thus, it is both a trademark and a domain name.

Domain names have become very valuable “possessions” that have been bought and sold, sometimes for great sums of money. Generally, the acquisition and maintenance of domain names is handled by a company’s internal technology department. Legal departments get involved where there is an infringement, such as when a company’s name or mark has been reserved as a domain name by a third party.

FURTHER READING: INTA Fact Sheet, *Differences Between Trademarks and Domain Names*. 

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[INTA logo]

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III. What Is a Trademark?

As defined under U.S. law, a trademark is “any word, name, symbol, or device, or any combination thereof-- (1) used by a person [or business], or (2) which a person [or business] has a bona fide intention to use in commerce...to identify and distinguish his or her [or its] goods...from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” U.S. Trademark Act (Lanham Act) § 45, 15 U.S.C. § 1127.

RESOURCE: For definitions of the terms of art used herein and many more, see INTA’s Member Resources, Glossary.

The concept of a trademark or brand as a source identifier is relatively consistent across the world, but there are national distinctions as to which words, symbols, or devices may constitute a mark for a product or service.

A. Traditional Trademarks

1. Words

Word marks make it easy for the consumer to ask for and obtain the exact product he or she seeks. The words that jump out at you because they are the largest, boldest, and most distinctive on the packaging, on the product, or on displays are likely to be the “trademark” or “brand.”
Virtually every item sold or promoted is going to have a word mark so that you can identify it by brand name and ask for it at the store, by catalog, or online. When a word is used as a trademark, it is said to have taken on primary significance as the identifier of the source of the product or service. For example, while the dictionary definition of AMAZON includes, *inter alia*, a river in Brazil or a parrot, the public association of the term in commerce today is with an online retailer of books and other consumer goods.

2. **Slogans**

Catchy phrases can be very effective as trademarks. For example:

- *Save money. Live better.*
- *Just do it.*
- *The king of beers.*
- *Like a good neighbor...*

  WALMART      NIKE      BUDWEISER      STATE FARM

To qualify as trademarks, slogans must follow the same rules as other marks for goods and be used on the products or packaging or on displays associated with the products. Similarly, slogans that are service marks must be used in connection with the sale or promotion of a service. Generally speaking, the life of a slogan is shorter than most brand designations, because slogans often are the basis of advertising campaigns and marketers are constantly on the lookout for new, fresh approaches. However, many of these phrases live on in the minds of consumers for years, even after the slogans are discontinued. Can you name the products that once were, and still are, associated with these slogans?
### Trademark Administration

**A Diamond Is Forever**  
DE BEERS (first use 1940s), by De Beers Group  
(In 1999, Advertising Age magazine named “A Diamond Is Forever” the best advertising slogan of the twentieth century.)

**Look sharp, be sharp**  
GILLETTE (first use 1950s), by Proctor & Gamble Company

**It's the real thing.**  
COCA-COLA (first use 1960s), by Coca-Cola, Inc.

**Got milk?**  
California Milk Processor Board (1993)

In 2011, the WENDY’S restaurant chain introduced an advertising campaign with a twist on its popular slogan “WHERE’S THE BEEF?”, which became a catch phrase in politics, the media, and general parlance during the mid-1980s. The new slogan is “HERE’S THE BEEF!”

![1984 Advertisement for WENDY’S Restaurants](image1.png)  
![2011 Advertisement for WENDY’S Restaurants](image2.png)

**FURTHER READING:** Stuart Elliott, “After 27 Years, an Answer to the Question, ‘Where’s the Beef?’”, New York Times, September 25, 2011.

Slogans can be registered as trademarks and protected as such. For example, the National Pork Board and the National Pork Producers Council, the owners of

3. Personal Names

Personal names can be trademarks. Probably the most common area in which to see an individual’s name used as a trademark is the realm of fashion and beauty. DONNA KAREN, MARC JACOBS, RALPH LAUREN, and MARTHA STEWART are all names that have come to identify the single source of a product or service. Names can reflect a real person, as in the previous examples, or they can be fictional characters, such as BETTY CROCKER, ANN TAYLOR, or TOMMY BAHAMA. Some names have become so iconic that the first name alone is enough to signify the source—for example, MADONNA. Sometimes a pseudonym—for example, ICE-T, LL COOL J, or LADY GAGA—is all one needs.

Surnames are not viewed as inherently distinctive and generally are not registrable as trademarks without other words or devices. However, it is possible that, over time and with widespread use and advertising, a surname may achieve sufficient recognition in association with particular products or services that it becomes a strong brand. For example:

ARMANI       HEINZ       CAMPBELL’S

4. Letters

In many countries a trademark can be a letter or a combination of letters, frequently an acronym for a word mark or a company name, as shown below.

W (hotels)       IBM       AT&T       CBS
In some countries, letter combinations alone are not considered distinctive. They may be protected as marks only with an additional element, such as words, a picture, or a distinctive design element.

5. Logos

Marks that consist of a graphic representation or symbol, trademark, or abbreviation, with some stylization or design elements, are called “logos.” Often, words and symbols or devices are used together to create a strong corporate identity. For example:

![Verizon Logo](image1)

![NBC Logo](image2)

6. Numbers

Similarly, numbers, either alone or in combination with other words, can come to reflect the source of a product.

<table>
<thead>
<tr>
<th>Trademark</th>
<th>Product</th>
<th>Owner</th>
</tr>
</thead>
<tbody>
<tr>
<td>No. 5</td>
<td>Perfume</td>
<td>Chanel, Inc.</td>
</tr>
<tr>
<td>7-UP</td>
<td>Soft drink</td>
<td>U.S. rights held by Dr Pepper/Seven-Up Corporation; rights in the rest of the world held by PepsiCo or its licensees.</td>
</tr>
<tr>
<td>88</td>
<td>Race car</td>
<td>Dale Earnhardt, Jr.</td>
</tr>
</tbody>
</table>

Model and parts numbers or lettering that differentiates between the goods of a single producer, representing, *inter alia*, size, color, material, tensile strength, or
other aspects of different qualities of the same product, generally are not trademarks because they do not reflect the source of the goods.

7. **Symbols/Devices**

Symbols, also known as “devices,” can become very strong and recognizable identifiers of source that can last forever if properly used. For example, the SANDEMAN port logo (see below) is over 200 years old.

![SANDEMAN port logo](image)

Moreover, often these types of designs become strong enough that consumers can recognize the brand even without any corresponding words. For example:

![TARGET Bullseye](image)  
**TARGET** Bullseye

![NIKE Swoosh](image)  
**NIKE** Swoosh

The traditional “device” element is generally some symbol, color combination, or packaging that has come to distinguish the goods and services of one producer from those of another. Some of these may even be artwork or pictures, as in the examples shown below.

![Hillshire Farm logo](image)  
**Hillshire Farm®**

![Coppertone logo](image)  
**Coppertone®**
8. Typefaces

While a typeface per se is not protectable as a trademark, if a typeface is distinctive and has a long association with a particular mark, its owner may be successful in stopping a competing product or a disparaging use under general unfair competition principles. For example, Coca-Cola was able to stop the use of a poster (below, right) that imitated the signature script and slogan used for the COCA-COLA trademark (below, left). See Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972).

9. Trade Dress

Trade dress is another form of brand recognition. Some jurisdictions have held that trade dress that is unique and original may be recognized as a trademark immediately. Traditionally recognized trade dress includes distinctive packaging, color combinations, store designs, and container shapes. Generally, however, trade dress results from building familiarity with consumers over time, particularly for product shapes. These categories of trade dress may be protected where they have achieved source identification significance.

For example, trade dress recognition has been held broad enough to cover patterns of stitching on clothing, combinations of stripes on shoes, and even the layout of a store:
10. Single Colors and Color Combinations

Color combinations can be protected in some, but not all, jurisdictions. For example, the color combination on RED BULL drink cans has been recognized and protected as a trademark in Europe.

Red Bull’s distinctive can (left) is protected by a European Union Trade Mark (EUTM) registration (EUTM No. 004381554). In 2011, a court in Brussels held that Red Bull’s blue-and-silver color combination was an independent distinctive and dominant element of its trade dress and that this element was infringed by Powerdrinks’ use of the same color scheme on its canned energy drink (right). See Red Bull GmbH v. Powerdrinks Group BVBA (Commercial Court of Brussels June 8, 2011). (See http://applications.inta.org/apps/tdii/case/1765/ for case discussion.)
Moreover, in rare cases a single color has become so associated with a producer that it is recognized as a trademark. For example, the U.S. Court of Appeals for the Second Circuit held that the distinctive red soles of LOUBOUTIN heeled shoes, when combined with a different-colored top, were protected under the trademark. See Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc., 696 F.3d 206 (2d Cir. 2012). Following are other classic examples of a single color that has achieved trademark recognition:

**TIFFANY** jewelry (blue), by Tiffany & Co.

**OWENS CORNING** insulation (pink), by Owens Corning Intellectual Capital, LLC

**UPS** delivery services (brown), by United Parcel Service, Inc.
11. Packaging

Probably the most famous “packaging” mark in the world is the COCA-COLA bottle shape. Similarly, the cow-spot–covered boxes in which GATEWAY computers are shipped are widely recognized as identifying the source of the computer.

12. Product Shapes

Even product shapes, where the shape is distinctive and not necessary to the function of the product, can be trademarks. In those cases, the shape of the product itself identifies the source of the product for consumers. Some classic examples of product shapes that serve as trademarks are:

- **GOLDFISH crackers**
  (U.S. Reg. No. 3,290,648, owned by Pepperidge Farm, Inc.)

- **HERSHEY’S chocolate bar**
  (U.S. Reg. No. 4,033,631, owned by Hershey Chocolate & Confectionery Corp.)

- **PEPPERIDGE FARM cookies**
  (U.S. Reg. No. 3,852,499, owned by Pepperidge Farm, Inc.)
It is possible for a design to be both protected as a trademark and covered by a design patent, because in both cases the design is not functional. For example, Apple has protected the look of its IPOD device under both types of intellectual property.

A product shape, packaging, or container cannot be a source designator if it is functional. It must be separable from the element that makes the product work. The shape of the COCA-COLA bottle does not enhance the flavor of the soda or improve the way the bottle holds liquid. If the shape is dictated by function (e.g., a holster for a gun), it cannot be a trademark. The same is true for design patents.

**RESOURCE:** The INTA website has a searchable database of comprehensive country profiles on trade dress protection and enforcement. The database allows you to search by jurisdiction, company name, type of product, or type of trade dress (color, packaging, product shape, etc.), and it provides information on trade dress registration, available causes of action, remedies, and defenses. See [http://www.inta.org/TradeDress/Pages/TradeDress.aspx](http://www.inta.org/TradeDress/Pages/TradeDress.aspx).

### B. Nontraditional Marks

Many jurisdictions will protect more unusual forms of source recognition. As with product shapes and product packaging, these identifiers must be separable from the functioning of the product or service.

#### 1. Sounds and Moving Images

Sounds and moving images can be trademarks. For example, when you begin to watch a movie produced by 20th Century Fox Film Corporation, you will see a moving image with floodlights sweeping back and forth across the sky. This is not only artwork; it identifies the source of the movie being watched and has been registered as a trademark in the United States (U.S. Reg. No. 1,928,424). Do you recognize the 20th Century Fox example, and these other moving-image or sound marks?
Twentieth Century Fox Film Corporation

Metro-Goldwyn-Mayer Studios, Inc. (MGM) has been using its moving-image and sound mark of a lion’s roar at the beginning of its films since the 1920s.

The “I’m lovin’ it” jingle is a widely recognized sound mark for McDonald’s Corporation.

Intel Corporation has a famous sound mark consisting of a three-second chord sequence used in connection with its Pentium processor.
Automobili Lamborghini S.p.A. has a registration in the European Union for the moving-image trademark for LAMBORGHINI car doors opening and turning upward (EUTM No. 1400092).

**RESOURCE**: The USPTO website contains a page featuring examples of trademark applications and registrations for sound marks, with sound clips. See [http://www.uspto.gov/trademarks/soundmarks/index.jsp](http://www.uspto.gov/trademarks/soundmarks/index.jsp).

2. **Scent**

Sensory marks involving sound and sight are easily verified because human perception is fairly consistent in these instances. Marks based on the other senses—scent, taste, and touch—are more difficult to establish because they are more subjective and more difficult to define. Fairly recently, scent has been found to function as a source identifier in certain jurisdictions. For example, “the smell of fresh cut grass” has been protected in the European Union as a trademark for tennis balls. Similarly, in Australia a eucalyptus scent has been found registrable for sporting goods and apparel.

3. **Taste**

While attempts have been made to register flavors as marks, they have not succeeded thus far because of the difficulties in defining and commonly recognizing how something tastes or because it may have a functional aspect. For example, when N.V. Organon tried to register an orange flavor for pharmaceuticals, the USPTO rejected the application. See *In re N.V. Organon*, Serial No. 76467774 (T.T.A.B. June 14, 2006). Nonetheless, it is quite conceivable that such marks will be allowed in the future.

4. **Touch**

In terms of registrations, there are very few tactile or touch source designations that have been recognized. In the United States, examples of registered tactile trademarks include a velvet-feeling wine bottle (U.S. Reg. No. 3,155,712), a pebble-grain–textured fragrance dispenser (U.S. Reg. No. 3,348,363), and cotton-textured paper used to package soap (U.S. Reg. No. 2,682,410). Additionally, some jurisdictions have allowed registrations of words depicted in Braille, such as performer Stevie Wonder’s registrations for “a wonder summer’s night” and “Stevie Wonder” (U.S. Reg. Nos. 3,512,464, 3,512,465, 3,495,229, 3,741,784).


**RESOURCE:** For more information on nontraditional trademarks generally, see INTA Fact Sheet, *Nontraditional Trademarks*. 
IV. How Does One Choose the Best Mark (Spectrum of Distinctiveness)?

Some words and devices are better than others in terms of being able to function immediately as source designations. The “spectrum of distinctiveness” ranges from marks that are inherently strong because they do not have any descriptive meaning associated with the product, its quality, ingredients, intended use, or function, to marks that are “suggestive” of some attribute of the product, to marks that began as “descriptive” terms but over time have developed secondary meaning.

From a legal perspective, the most easily protected marks are those that consist of terms that are totally unrelated to the product or service at hand, either because they are coined (e.g., KODAK, for cameras and film) or because they have no meaning applicable to the product (e.g., APPLE, for computers). These are called “coined marks” or “arbitrary marks.” From a marketing perspective, the most desirable marks are those that tell the consumer something about the product or are laudatory as applied to the product. These are called “suggestive marks.” It may take longer to build up recognition value in an arbitrary mark, while a suggestive mark may have a somewhat easier road to recognition. Over time, even descriptive or laudatory marks can become very strong. Generic terms can never become trademarks because they name the product or service itself and therefore cannot identify a specific source.

Marks are rated from strongest to weakest, as described below.

Coined or Arbitrary Marks. “Coined” or “fanciful” terms, that is, words that do not exist in any language, are considered the “strongest” marks. These marks will be given the broadest scope of protection because there is really no reason for anyone to use a coined word other than to trade on the reputation established by its owner.

Classic examples of coined marks are:

- EXXON
- KODAK
- VERIZON
- GOOGLE
Arbitrary marks consist of words that exist but that do not have any descriptive, laudatory, or other meaning with respect to the characteristics, ingredients, quality, or function of the product or service involved. Classic arbitrary marks are:

- BLACKBERRY smart phones, by BlackBerry Limited (formerly Research In Motion Limited)
- AMAZON retail services, by Amazon.com, Inc.
- COACH leather goods, by Coach, Inc.
- GREY GOOSE vodka, by Bacardi Limited

Legal departments prefer coined and arbitrary terms because they are very easy to protect. There is no real reason for a competitor to use an existing arbitrary mark on its product or service except to benefit from the goodwill represented by the mark. Marketing departments do not favor these terms because they do not have any immediate meaning associated with the product or service and therefore are more difficult to promote.

**Suggestive Marks.** Suggestive marks require some imagination, thought, or perception for the consumer to reach a conclusion about the product or service. They may have some nexus with the product or service but do not immediately describe it. Classic examples of suggestive marks are COPPERTONE tanning lotion, MICROSOFT software, and NETSCAPE Internet services. Each of these marks hints at the type of product or service or the result achieved from using the product or service without actually having a direct meaning.

**Descriptive and Laudatory Marks.** There can be a fine line between suggestive and descriptive marks, and reasonable minds can differ as to where to draw the line. With respect to some marks it can depend on the “eye of the beholder.”

Words that describe the product, an ingredient, or a function of the product directly are descriptive. Laudatory terms are those positive words and phrases that could describe anything “good,” so they are very commonly used by many manufacturers and providers.
With descriptive terms, it may be necessary to prove secondary meaning, also called “acquired distinctiveness”—that is, that consumers see the mark as identifying a source and not merely as describing the product. Secondary meaning generally is shown by length and extent of exclusive use, amount of sales, amount spent on advertising, recognition in the media, and evidence of consumer recognition in the form of letters or emails from consumers or by consumer surveys. While these terms may not function as source designations at the outset, over time they can develop goodwill by virtue of consumers’ coming to associate the term with a brand. Classic examples are BEST mayonnaise, SHARP television, and EVERREADY batteries.

FURTHER READING: INTA Fact Sheet, Considerations in Selecting a Trademark.

V. What Purpose Do Trademarks Serve?

A. Product and Service Marks

Single Source. In general, trademarks identify a source—generally the individual or entity that is the manufacturer, distributor, or retail or wholesale supplier of a product or service. The producer of the goods or provider of services uses a trademark so that consumers can identify its goods/services in the marketplace while distinguishing them from competing goods/services. Consumers rely on brands as assurance that the source will be the same for all goods or services offered under the same brand even if they do not know the name of the company that owns the brand. This is referred to as a “single, albeit anonymous, source.” In other words, one does not need to know who manufactures SCOPE mouthwash, but based on the mark you can rely on the fact that the SCOPE mouthwash you buy will be essentially the same as the one you purchased before. (Actually, the mark is owned by the Proctor & Gamble Company.)

Do you know what companies own these well-known brands?
BAND-AID adhesive bandages (Johnson & Johnson Corporation)
LISTERINE mouthwash (Warner Lambert Company, LLC)
DORITOS corn chips (Frito-Lay North America, Inc.)

B. Special Types of Marks

There are marks that represent “source” or “sponsorship” in a broad sense but are not the same as simple product or service marks. They include collective marks, certification marks, and geographical indications.

**Collective Marks.** A collective mark shows membership in a group, association, or organization. For example:

![United Auto Workers](image1)
![United Federation of Teachers](image2)
![Realtor](image3)
![Certified Public Accountants](image4)

Unlike traditional trademarks, which let the consumer know that the products or services come from a single source, collective marks are used by many different producers of goods, but they show that these producers all belong to the same organization. Because groups and organizations also provide services to their members, often these marks are service marks as well. Under both the Paris
Convention for the Protection of Industrial Property (Paris Convention) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), member jurisdictions must allow filings for collective marks of “associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.”

**RESOURCE:** For more information on the Paris Convention, the TRIPS Agreement, and other international treaties, see INTA Fact Sheet, *International Treaties.*

**Certification Marks.** A certification mark certifies the nature or origin of the goods or services to which it has been applied. This includes, for example, region or location or designation of origin; materials of construction; method or mode of manufacture or provision; quality assurance; accuracy of the goods or services; and any definable characteristic of the goods or services. It can also certify standards of manufacture or provision of services by members of a union or other organization.

Not every jurisdiction has certification marks, but three important ones that do are the United States, the European Union, and Japan.

**RESOURCE:** For trademark laws, regulations, regional office practices, case law, and treaties for particular countries, see INTA’s Global Trademark Resources, *Global Portal.*

Following are classic examples of certification marks.
Certifies that goods from developing countries have met certain standards of fairness.

Certifies that the product contains 100% pure new wool.

Certifies that appliances meet certain standards vis-à-vis energy efficiency.

Certification marks—for example, the GOOD HOUSEKEEPING SEAL OF APPROVAL and UNDERWRITERS LABORATORIES—are particular to independent organizations that have established testing procedures and standards to be met by a particular industry or type of product. Any member of the defined industry or producer of a product in the defined product group may submit its product for review, and if the product meets the standards of the certifying organization the member will be granted the right to use the certification mark. The certifying organization must remain independent and may not manufacture products under the certification mark.

**Practice Tip**

In filing an application for a certification mark, the filing of a copy of the standards used by the testing organization will likely be required in many jurisdictions.

**FURTHER READING:** INTA Fact Sheet, *Certification Marks.*

**Geographical Indications.** Somewhat analogous to certification marks, geographical indications (GIs) are words that may be used only if the goods are produced in a certain geographic location. Like collective marks, GIs are covered by the TRIPS Agreement under the jurisdiction of the World Trade Organization (WTO). They are defined as “indications which identify a good as originating in
the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” For example, a sparkling wine is not CHAMPAGNE unless it comes from the Champagne region of France, and all STILTON cheese comes only from Great Britain.

**FURTHER READING:** INTA Fact Sheet, *Geographical Indications.*

### C. Other Familiar Trademark Terms

**House Marks and Sub-brands.** A “house mark” is the trademark that a company uses on all of its products, even though certain products may also carry their own particular brand. Some companies have many different trademarks to represent various lines of their products; where there is more than one brand, the main brand is known as a “house mark” and the specific product brands are referred to as “sub-brands.” For example, KELLOGG’S is the house mark for a variety of cereals, each with its own sub-brand (e.g., CORN FLAKES, RICE KRISPIES, and FROSTED FLAKES). Similarly, APPLE is the house mark of Apple Inc. for computers and phones, while iMAC, iPAD, and iPHONE are sub-brands.

Some trademark owners may even have products with individualizing properties of taste, smell, style, etc., sold under different trademarks to attract different segments of the purchasing public. For example, MAXWELL HOUSE, GEVALIA, and YUBAN are all brands for coffee of Kraft Foods, Inc., each with a distinctive taste, image, market channel, and intended market. Similarly, GAP, OLD NAVY, and BANANA REPUBLIC stores are all owned by Gap, Inc., yet they have different images, price points, and appeal to different demographics. In addition to its main brand, TOYOTA, Toyota Motor Corporation owns the LEXUS and SCION brands, representing its luxury and economy lines of cars, respectively.

By contrast, other producers may have very few trademarks, but what they have is of extraordinary value (e.g., FEDEX for mail delivery services; EILEEN FISHER for clothing).
**Family of Marks.** Some manufacturers will create brand names that are related, such as the well-known “MC” formatives of McDonald’s Corporation:

MCNUGGETS    MCSKILLET    MCCAIFE    MCGRIDDLES

When these brands are advertised and promoted together they create a “family of marks.” This marketing approach strengthens the marks by giving them an overall recognition value that exceeds the value of each mark individually. For this reason, McDonald’s Corporation has succeeded in preventing others from using “MC” formatives with respect to food, restaurants, and related areas.

**FURTHER READING:** Valerie Brennan, “Brand the Sandwich: Establishing Trademarks in Restaurant Menu Items,” *INTA Bulletin*, Vol. 64 No. 6 (March 15, 2009).

**VI. How Do I Use a Trademark Correctly?**

Trademark rights can last forever if used properly.

**No rights in gross.** Trademarks do not exist in a vacuum. They exist only because of their association with the source or sponsorship of a particular product or service. There is no such thing as a trademark right in gross. Even if someone coins a term that has no recognized meaning, for example, DOMAD, it is not a trademark unless used to identify the source of a particular product or service. It could become a trademark if, for example, a company sold DOMAD bicycles or offered DOMAD financial services.
**Same mark, unrelated products.** It is possible that an identical trademark can be used by different owners for totally unrelated products or services without creating confusion. For example, there are many well-known marks that, depending on the context, the consumer will recognize as identifying a particular source. Moreover, the consumer may perceive the same mark as identifying multiple and different sources where the mark is used on products that are totally unrelated. In these situations, consumers are not likely to be confused and to believe that the unrelated goods or services come from the same provider. For example:

<table>
<thead>
<tr>
<th>Trademark</th>
<th>Product/Service</th>
<th>Owner</th>
</tr>
</thead>
<tbody>
<tr>
<td>DELTA</td>
<td>Airline travel</td>
<td>Delta Air Lines, Inc.</td>
</tr>
<tr>
<td>DELTA</td>
<td>Faucets</td>
<td>Masco Corporation</td>
</tr>
<tr>
<td>DELTA</td>
<td>Dental plan</td>
<td>Delta Dental Plans Association</td>
</tr>
<tr>
<td>DOVE</td>
<td>Chocolate</td>
<td>Mars, Inc.</td>
</tr>
<tr>
<td>DOVE</td>
<td>Soap</td>
<td>Conopco, Inc.</td>
</tr>
</tbody>
</table>

**Trademarks are proper adjectives.** Trademarks are proper adjectives, and, at a minimum, they should be capitalized. They normally should be followed by a generic term—for example, HUGGIES diapers or SCHWINN bicycles. Using a trademark as a noun or a verb can lead to the trademark’s becoming a generic term. Trademarks should never be used in the plural (I own two FORDS) or as a possessive (my HONDA’s bumper). “Genericide” is more likely where the product is a new invention and there is no generic term for the item yet. For example, escalator and cellophane began life as trademarks, but they are now generic terms.

Another way that a mark can become generic is through the owner’s use of the term as a noun—that is, the owner uses the mark to define the product and to identify the source of the product. This can also occur when an owner allows third parties to use the mark extensively as the name of the product. Some terms have maintained their trademark status in one or more jurisdictions but have lost it in
others. For example, in the United States, aspirin is considered a generic term, whereas in countries such as Germany and Mexico, ASPIRIN is still a registered trademark of Bayer, AG.

FURTHER READING: INTA Fact Sheet, Trademarks vs. Generic Terms.

Use on products. Trademarks appear on product packaging, labeling, displays associated with products, or websites through which products can be purchased. The technical phrases used are “affixed to the product” or “displayed at point of purchase.” Trademarks are often the largest, brightest, boldest, and most eye-catching words or symbols used in connection with the product. They are meant to stand out and be easily recognized by the consumer. For example, you will know the following mark, even if you do not speak the language of the various countries in which it is used:
The following are classic examples of types of trademark use on products.

**Labels and hangtags:**

- DOONEY AND BOURKE handbags
- POLO RALPH LAUREN clothing

**Packaging:**

- WEIGHT WATCHERS prepackaged meals

**Embossed, printed, or stamped directly on the product:**

- APPLE computers
- BMW automobiles
Displays associated with the goods/services:

**KLEENEX** tissues
(in-store product advertising)

**MACY’S** department store
(flagship store signage)

Use on advertising and promotional materials is not considered trademark use in most countries unless they are part of point-of-sale materials. Likewise, use on materials that are not seen until after the goods are purchased, such as packaging inserts, ingredient lists, and invoices, is not recognized as trademark use.

**Use in connection with services.** Trademarks can also identify the source of services, such as retail stores (MACY’S), banks (CITIBANK), gas stations (EXXON), sports teams (RED SOX), health care (BETH ISRAEL MEDICAL CENTER), or charities (MIRACLE CORNERS OF THE WORLD). In the United States, these marks are referred to as “service marks,” while in other English-speaking countries, such as Canada, a “trademark” can cover a service as well as a product.

By contrast with a trademark for goods, use of a service mark in advertising, signage, and promotional materials is considered valid use of the mark. Even menus can be used to show use in connection with service marks.

While trademarks for products are registrable everywhere in the world, certain jurisdictions do not allow service mark registration. For example, service mark registration was allowed in India only recently, and there are a few countries where trademarks for services are not recognized at all. However, most countries
will protect a service mark under general principles of unfair competition even if there is no registration system.

**FURTHER READING:** INTA Fact Sheet, *Service Marks.*

**RESOURCE:** To see whether service marks are registrable in a particular jurisdiction, see INTA’s Member Resources, *Country Guides.*

### VII. When Can I Use the ® (Trademark Symbols, Marking and Notice)?

Once its mark has been registered, the owner can use the generally recognized registration symbol ®. The ® symbol has legal significance in many, but not all, jurisdictions. In many jurisdictions, products or services covered by marks that are not registered may be marked TM (trademark) or SM (service mark) to indicate that the producer considers the mark a brand that the company owns. Generally, these symbols are used in the superscript position following the name of the mark, though that is not required.

A company may decide it prefers to use a written trademark notice, such as the following:

> “The X design and X TRADEMARK are exclusive trademarks of XYZ, Inc.”

Major corporations generally will have a style guide or manual that specifies how their marks are to be used and displayed by their own marketing and manufacturing people and by licensees.

**Practice Tip**

As an Administrator, you can help your company by reviewing packaging, advertising, and promotional materials for proper trademark markings in connection with at least one use in each of the materials. You might also suggest, as appropriate, that the company create a style guide that will provide its marketing department, manufacturers, and licensees with guidelines on how to use the company’s marks consistently and in the proper form.
Other ways of indicating that a mark is registered are:

- “Registered in U.S. Patent and Trademark Office” or, in abbreviated form, “Reg. U.S. Pat. & Tm. Off.”
- “Marca Registrada” or “MR”
- “Marque Déposée” or “MD”
- “Marque de Commerce” or “MC”

In the United States, an owner is not required to indicate that a mark is registered, but a registration symbol or notice may provide certain statutory benefits in terms of putting infringers on actual notice that the mark has been registered, which might lead to greater damage awards in infringement actions.

**FURTHER READING:** INTA Fact Sheet, *Marking Requirements*.

### VIII. How Are Rights Lost (Abandonment/Failure to Use)?

Because trademarks exist to identify the source of products and services, without such association with a product or service there is no trademark. Inexcusable failure to use a trademark over a long period of time can cause the loss of trademark rights. This is known as “abandonment.” Abandonment can be voluntary, as when a company decides it will no longer make a certain branded product (e.g., Chrysler’s decision to stop manufacturing PT CRUISER cars), or involuntary, as when a mark is challenged for the owner’s failure to use it for a period of years and the owner has no valid reason for not doing so. Jurisdictions vary as to what constitutes sufficient length of non-use to constitute a prima facie showing of abandonment. In some jurisdictions, abandonment can be refuted by showing valid reasons why the mark could not be used—for example, war, natural disaster, product development, product redesign, or, as in one case, even a stint in jail by the owner was held to be excusable non-use.
IX. What Is Not Protectable as a Trademark or Other Type of Intellectual Property?

**Titles of Books, Plays, Movies, and Songs.** Titles of individual books, plays, movies, and songs are not trademarks. In contrast, a series title can be a trademark (e.g., TIME magazine; the MODERN FAMILY television program; STAR WARS movies).

**National Symbols.** National symbols such as flags, royal crests, coats of arms, and other national indicia (e.g., the Presidential Seal of the United States) cannot be trademarks because they stand for the countries that they represent. It would be unfair and also misleading to allow one company to usurp rights in a national symbol. Additionally, in most jurisdictions the names of living presidents or heads of state cannot be owned or registered. Some jurisdictions may apply this concept to religious words and symbols as well.

**Surnames.** In general, surnames are not viewed as trademarks. This is because they are not considered distinctive, as they apply to many individuals. There is also the public policy consideration of allowing an individual to use his or her own name. However, as seen above, some surnames do take on trademark significance after extensive, exclusive use and promotion in connection with particular products or services.

**Merely Descriptive or Misdescriptive Terms.** Words, phrases, or devices that immediately tell the consumer something about the nature of a product, its ingredients, characteristics, features, quality, purpose, or function are not protectable as trademarks. Obviously, no competitor should be prevented from aptly describing its products or services because someone else has claimed the words, phrases, or symbols that tell the consumer something about those products or services. However, if descriptive elements are included with other words, phrases, or devices (i.e., the mark is a composite mark), it may be possible
to overcome trademark office objections by including a statement that the applicant is not claiming exclusive rights in the descriptive elements. This type of statement is called a “disclaimer.” For example, the owner of the mark SOUTH BEACH DIET, used in connection with a variety of weight loss goods and services, has disclaimed the term DIET except as it appears in the whole mark.

Nonetheless, as covered above, it is possible that, over time and with substantially exclusive use, marks that began as merely descriptive may become so associated with the source of a product that they become registrable.

**Geographically Descriptive or Misdescriptive Terms.** Setting aside geographical indications, geographic terms generally are not capable of source-identifying significance if they represent the place where an item is made or a place that has a natural association with the item—for example, cars and Detroit or barbeque sauce and Texas. It would be against public policy to allow an individual manufacturer to have an exclusive right in such terms. It is possible to combine a geographic term and another word to establish a trademark—for example, TEXAS PETE hot sauce—but the owner would need to disclaim the geographic portion of the mark.

Geographic terms are also not registrable if they are deceptive, that is, they falsely indicate a connection with a particular location that has some natural association with the goods or services. It has been held, however, that where there is no such association, a geographic term may be a valid mark. For example:

KLONDIKE ice cream  
L.A. GEAR clothing

**Disparaging Terms.** Section 2(a) of the Lanham Act served as a complete bar to the registration of marks that consist of or comprise matter that may
disparage, or bring into contempt or disrepute, persons, institutions, beliefs, or national symbols. In June 2017, the United States Supreme Court decided *Matal v. Tam*, wherein Simon Tam was refused federal registration for the mark THE SLANTS, which he chose “in order to ‘reclaim’ the term and drain its denigrating force as a derogatory term for Asian persons” (137 S. Ct. 1744, 1747 (2017)). The USPTO denied registration under Section 2(a) of the Lanham Act. After the case was taken to federal court, the en banc Federal Circuit found that the disparagement clause was unconstitutional under the First Amendment’s Free Speech Clause. The Supreme Court affirmed this decision.

This decision has had an impact on another long-standing case involving the Washington Redskins, which in 2014 lost six trademarks for their allegedly being offensive to Native Americans. Prior to the *Tam* decision, the case was pending in the U.S. Court of Appeals for the Fourth Circuit; however, post-*Tam*, the U.S. Department of Justice indicated its agreement with Pro-Football, Inc. that the decision in *Tam* was controlling and that a judgment should be entered in favor of Pro-Football.

**Scandalous or Pornographic Terms.** The Lanham Act specifically stated that “immoral, deceptive, or scandalous matter” is not registrable. In April 2019, two years after the Court’s decision in *Tam*, the United States Supreme Court decided *Iancu v. Brunetti*, in which Erik Brunetti, an artist and founder of a clothing line, was refused registration of the mark FUCT for various goods and services because FUCT was a “totally vulgar” mark and was therefore unregistrable. On appeal, the Trademark Trial and Appeal Board agreed with the Examining Attorney, finding the mark to be “extremely offensive” and “vulgar” because it had “decidedly negative sexual connotations” and communicated “misogyny, depravity, [and] violence.” Brunetti then challenged the bar on immoral or scandalous marks in an appeal to the Court of Appeals for the Federal Circuit. The Federal Circuit found that this prohibition violated the First Amendment. The Government then sought review by the Supreme Court.

The Court, relying on the reasoning set forth in *Tam*, similarly found that the Lanham Act’s bar on immoral or scandalous trademarks was unconstitutional because it was viewpoint-based in that it “permits registration of marks that
champion society’s sense of rectitude and morality, but not marks that denigrate those concepts.”

Other jurisdictions have similar laws, such as the European Trade Marks Directive, which rejects for registration marks that are “contrary to public policy or to accepted principles of morality.”

Judgments on scandalous marks vary greatly because of local customs and moral codes. For example, something that is not considered offensive in the West, such as the stylized outline of a naked female form, may not be permitted in the Middle East.


**Deceptive Matter.** Marks that are calculated to deceive the public as to the nature, quality, or ingredients of a product are not registrable. For example, if one is to use the word “cotton” in a mark or slogan—for example, THE LOOK, THE FEEL OF COTTON—the mark would be deceptive if the product were not made of cotton. However, one can use a phrase such as “cotton soft” in describing fabric softeners because it would be seen as making a positive descriptive association rather than taken literally to mean that the softeners were made of cotton. Marks that are highly laudatory or “mere puffery,” using general terms like “best” or “greatest,” are not considered deceptive because they are so commonly used that they are not likely to affect the decision to purchase.

**Generic Terms.** “Generic terms” are dictionary words (e.g., ice cream, automobiles, or cereal) that, when used in their ordinary sense, cannot be trademarks. A generic term remains in the public domain so that anyone can identify a product or service by its common name. A trademark identifies not the product itself but the source of that product—for example, HAAGEN-DAZS ice cream, TIDE detergent, or KELLOGG’S cereal. Even if you do not know the name
of the manufacturer of the product you are buying, you know that all ice cream marked BEN & JERRY’S is made by the same company.

Even though the general public may use a trademark as though it were the generic object—for example, “I own a JEEP”—trademarks are actually modifiers and proper adjectives; to be used properly, they normally must be followed by the generic term—for example, “I own a JEEP automobile.” Sometimes, the generic term may be considered to have been implied—for example, in repeated uses in a promotional piece. As noted above, misuse of a mark over a long period of time can lead to the trademark’s becoming the generic term for the product, and therefore to the loss of rights in the mark.

Because trademark rights are territorial—that is, they are determined on a country-by-country basis—some marks may be generic terms in one country and still be brands in others. A classic example of this split is HOOVER for vacuum cleaners, which is a brand in the United States but generic in the United Kingdom, where one “hoovers” the rug! Many companies spend huge sums of money on advertising directed at preserving the source-designating function of the mark. For example, the marks XEROX and KLEENEX at one time were in danger of becoming generic; in response, the mark owners initiated expensive marketing campaigns to educate consumers on the proper usage of their marks (see below).

Practice Tip
Review the advertising and promotional materials produced by your company or client for proper trademark use. Owners who do not use their trademarks as proper adjectives or who do not follow their trademarks with generic terms at least once in each piece run the risk that their marks will, over time, become generic terms.
Who Benefits from Trademarks?

Trademarks serve to protect the producer and the consumer. For the trademark owner, the trademark represents its identity. The mark distinguishes the product or service of the producer or provider from the products or services of its competitors. The trademark represents the reputation of the trademark owner; it has been called the “face” the company holds out to the world. It is this reputation that we call “goodwill” and/or “secondary meaning” — that is, the public’s perception of the mark as representing the source of the goods or services. Over time, the goodwill represented by a trademark can develop enormous value. For example, BRANDZ, which publishes an annual list of the 100 most valuable global brands, places the value of the AMAZON brand at over $315 million, the APPLE brand at over $309 million, and the GOOGLE brand at over $309 million. (See BRANDZ™ Top 100 Most Valuable Global Brands 2019 for the full list.)

Trademarks also provide a service to consumers, by letting them know that they are getting the same properties and qualities that they have come to expect from the producer of the product. If you like the way your STARBUCKS coffee tasted today in New York City, you should be able to depend on the name and mark STARBUCKS to be sure you will get coffee of the same quality tomorrow in Miami. Your new medium-size POLO RALPH LAUREN shirt should fit you as well as your medium-size POLO RALPH LAUREN shirt from last year does.
XI. Conclusion

Trademarks can be a very valuable form of intellectual property. As an Administrator, you can help businesses or law firms in the searching and clearance, filing, and maintenance and administration of these assets.