

TRADEMARK LAW BASICS

A Trademark is a distinctive mark, word or design employed by a producer, manufacturer or seller of goods to distinguish those goods from the goods of another entity. As defined by federal law, a trademark is "any work, name, symbol, or device, or any combination thereof (1) 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 [the name of the register on which all federally registered trademarks are kept] established under the [Lanham] Act, to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source unknown."

Trademarks may be acquired by mere use of a distinctive mark, etc., over a period of time. Trademarks may also be acquired by registering a distinctive mark, etc., with the appropriate government agency. The advantage associated with a registered trademark is that it gives the trademark holder instant protection from most competing uses of the same mark.

Limitations apply, however, because a trademark may be acquired by mere use over a period of time, registration of a mark is only *prima facie* evidence that the registered holder is the owner of the trademark. An unregistered use of the same trademark commencing prior in time to the holder's registration of the trademark will operate to defeat the subsequent registered holder's ownership of the mark. Additionally, competing uses of a trademark is not necessarily a sufficient basis to preclude use of the mark by one or the other competing users if the users' respective markets are different in scope or are geographically separate. For instance, a trademark infringement action most likely cannot be maintained by a Texas user of the mark "Zorax" against a coincidental Alaska user of the same mark, where Zorax is sold by the Texas user only within the state of Texas and by the Alaska user only within the state of Alaska. The reason? The respective uses of the mark Zorax are so geographically separate that there is little likelihood that confusion will arise in the minds of consumers as to the respective sellers of the goods.

Trademarks may be registered locally in any state, typically with the state's department of commerce or the secretary of state, or federally with the United States government through the Patent and Trademark Office ("PTO"). Federally registered trademarks are valid for a period of 10 years from the date of registration, renewable for additional ten year periods. Additional filings and fees to maintain the federally registered mark are required by the PTO. The validity period for state fees to maintain the federally registered mark are required by the PTO. The validity period for state-registered trademarks varies depending upon the law of the state in which the trademark is registered.

Whether a mark, etc., is eligible for registration depends on the law of government entity to which the mark is presented for registration. At the federal level, the mark, etc., must have some distinctiveness such that it will become associated with a particular entity. For that reason, marks, etc. that do no more than describe the product (use of "apple" as a mark for an apple), will not be eligible for registration. Use of "apple" for a computer (or the use of "Zorax" as in the preceding example) however is sufficiently distinctive to associate a particular product with a particular producer, so as to be eligible for trademark registration.