

Overview of Trademark Law

Overview of Trademark Law – Study Notes

1. What Is a Trademark?

- **Definition:** A sign (word, logo, slogan, design, sound, color, or a combination) that identifies the source of goods or services and distinguishes them from those of others.
 - **Purpose:**
 - Protect consumers from confusion.
 - Protect the goodwill and reputation built by the owner.
 - **Key Terms:**
 - **Trademark** – for goods.
 - **Service Mark** – for services (often just called “trademark”).
 - **Collective Mark** – used by members of an association.
 - **Certification Mark** – indicates compliance with standards.
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2. Sources of Trademark Rights

Source	How Rights Are Acquired	Typical Jurisdiction
Common?law (common law)	First actual use of the mark in commerce.	United States, Canada, UK, Australia (limited protection, geographic scope).
Statutory registration	Filing an application with the national trademark office (e.g., USPTO, EUIPO, UKIPO).	Most countries; provides nationwide (or regional) protection and stronger enforcement tools.
International registration	Filing a single application under the Madrid System (WIPO) designating multiple member states.	Over 120 countries.

3. Elements of a Registrable Trademark

1. Distinctiveness

- **Fanciful / Arbitrary** – strongest (e.g., *Xerox*, *Apple* for computers).

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- **Suggestive** – requires imagination (e.g., *Coppertone* for sunscreen).
- **Descriptive** – generally not registrable unless it has acquired secondary meaning (e.g., “Sharp” for knives).
- **Generic** – never registrable (e.g., “Computer” for computers).

2. Nonfunctional

- The mark cannot be essential to the product’s use or purpose (e.g., a specific shape that is purely utilitarian).

3. Not misleading

- Must not deceive consumers about the nature, quality, or origin of the goods/services.

4. No conflict with prior rights

- Must not be identical or confusingly similar to an existing registered or common-law mark.

4. Trademark Registration Process (U.S. example, similar steps elsewhere)

1. Pre-filing Search

- Use trademark databases (USPTO TESS, EUIPO eSearch) to check for conflicts.

2. Prepare Application

- Identify owner, mark representation, goods/services (classify using the **Nice Classification**).
- Choose filing basis:
 - *Use in commerce* (already used).
 - *Intent to use* (future use).

3. File with the Trademark Office

- Pay filing fees (per class).
- Receive **Application Number**.

4. Examination

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- Office examiner reviews for compliance and conflicts.
- May issue an **Office Action** requiring clarification or amendment.

5. Publication for Opposition

- If approved, the mark is published in an official gazette.
- Third parties have a set period (e.g., 30 days in the U.S.) to oppose.

6. Registration / Notice of Allowance

- If no opposition (or opposition resolved), the mark registers (or, for intent-to-use, a **Statement of Use** is required).

7. Maintenance

- File periodic **Declaration of Use** (U