



## ***Some Frequently Asked Questions about Trademarks***

### ***What is a trademark/service mark?***

A trademark is any distinctive word, symbol, logo, or other feature identifying the source of a product (e.g. Clorox is a trademark for a brand of bleach) or identifying who controls the quality of the product (e.g. a Big Mac hamburger is prepared by a local McDonald's franchise, and McDonald's H.Q. sets the quality standards for the Big Mac.) A service mark is what we call a trademark when it is used for services (e.g. "GEICO" for a brand of insurance services). I'll "trademark" to refer to both trademarks and service marks.

### ***How do I get a trademark?***

By using a mark you get common law trademark rights in the geographic territory where you use it. Registering the mark provides additional rights and benefits.

### ***My company was incorporated/formed through the State Corporation Commission – isn't my name protected?***

No. When the SCC forms a company they do not clear the name for trademark purposes.

### ***What can be used as a trademark?***

The only requirement is that the mark be distinct. Words, designs, colors, sounds, and smells have all been registered as marks. Some examples are: "Coca-Cola"; the Nike swoosh; pink for fiberglass insulation; and the NBC chimes. The Trademark Office rejected Harley Davidson's application to register the sound of its motorcycles.

### ***Is there anything that can't be a trademark?***

Terms describing the product or a feature of the product can only be trademarks under certain circumstances. Geographic terms are difficult to register. Exceptions are sometimes made for descriptive terms used for a long time, if competitors are not using similar terms. Words understood to be last names also have special requirements.

### ***What is a trademark search?***

A trademark search looks for other confusingly similar uses. You can search the U.S. Patent and Trademark Office database for free: [http://www.uspto.gov/ebc/index\\_tm.html](http://www.uspto.gov/ebc/index_tm.html). If this search looks good then I recommend using a search company to get a comprehensive search of both registered and unregistered uses. A comprehensive search gives you the best chance of finding similar marks as early as possible.

### ***Should I federally register my mark?***

Some benefits of registering a mark include: 1) expanding your trademark's geographic territory; 2) making it easier for others to find your mark so they don't adopt a mark similar to yours; 3) making it easier to prove you own the mark; 4) making it harder for others to challenge your trademark rights; 5) building an asset that is easier to sell,



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license, and value; 6) making it easier to enforce your rights against domain name infringers.

***Once I get the mark registered does that mean I own it?***

A federal registration establishes a *presumption* that the owner has the exclusive right to the mark. It doesn't defeat someone who has been using the trademark since before the trademark application was filed. For example, if a company in Kalamazoo has been using the XYZ trademark since 1950 for lawn mower repair services, they have the right to keep using XYZ for lawn mower repair services in Kalamazoo even if in 2010 you get a federal trademark registration for XYZ for lawn mower repair services. The federal registration gives you the presumption that you can use it nationwide, but it will not take priority over a senior user. If your company expands into Kalamazoo in 2011 you will have to come up with a new name in that town.

***Should I get a trademark search?***

I recommend two levels of searching. The first is a "screening" search of the Federal Trademark Office records. This search weeds out choices that have obvious problems. If the mark survives that search, I recommend obtaining a comprehensive search of both registered and unregistered uses. This comprehensive search is designed to find the Kalamazoo repair shop (see above), so you can avoid that surprise later on. No search is perfect, but the comprehensive search gives you a much higher comfort level. The Trademark Office only reviews its records of federally registered marks, and does not research unregistered uses.

***How much will it cost?***

Each case is different but as a general rule screening searches on the Trademark Office website are about \$150 - \$200, and comprehensive searches are about \$1,200. If you file in one class, and there are no issues at the Trademark Office you can expect to spend approximately \$1,000 - \$1,500. State registrations are much simpler. The search process is the same, but the application process usually costs about \$500.

***How long will it take?***

Federal applications are taking about 12 -18 months.  
Virginia registrations can be obtained in about 2 – 4 weeks.

***Do I have to wait until it's registered before I can use it?***

No. Just the opposite. You have to use the mark before you can get it registered. You can apply for a federal registration before you use the mark, but it won't get registered unless you later file proof of use. In Virginia you can't file the application until after the mark is already in use.

***Do I need a lawyer?***

No you don't. The US Trademark Office website [www.uspto.gov](http://www.uspto.gov) accepts credit cards. The instructions for filing in Virginia are also available on-line: <http://www.scc.virginia.gov/division/srf/webpages/forms.htm>



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***Why should I hire a lawyer?***

A trademark attorney will evaluate your mark to check for common problems such as likelihood of confusion, descriptiveness, generic terms, descriptions of the goods or services, and the classifications for the goods and services. In addition a trademark lawyer will help you consider ownership and licensing issues.

***I think someone is infringing my mark. What should I do?***

Call your lawyer. If you accuse another party of infringing and it turns out they were using the mark first, you will have a big problem – even if you are registered and the other party is not.

***Someone is using my name for unrelated goods or services. Is that an infringement?***

Not necessarily. Examples of unrelated companies using the same names are Delta Dental, Delta Airlines, and Delta Faucets.

***If I register my mark will the Government make sure no one infringes it?***

No. That is the trademark owner's responsibility.

***Once I register my mark am I protected in other countries?***

No. A US registration only gives you rights in the US, but you can often piggyback off of a US application to apply for registrations in other countries. The mark has to be separately registered in each country, and has to meet each country's requirements.

***What are the remedies for trademark infringement?***

An infringer is almost always ordered to stop using the infringing mark, and to destroy or turn over any remaining supply of infringing labels, signage, or other materials. In addition the infringer can be ordered to pay to the trademark owner all of the infringer's profits that were made from the infringing use, plus any damages suffered by the trademark owner and the costs of the lawsuit. If the court believes the infringement was committed in bad faith, it can treble the damages award and require the infringer to pay the attorney's fees of the trademark owner.

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