

TRADEMARKS for the General Practitioner

By John C. Linderman and Mallory Hein

WITHIN THE FIELD OF INTELLECTUAL PROPERTY (patents, trademarks, trade names, copyrights, and trade secrets) the general practitioner is more likely than not to encounter trademarks in the practice of law, particularly with small clients and startups. Patents and copyrights are somewhat peculiar properties having more limited areas of use and specific to the business involved. Trademark matters on the other hand can arise in connection with broad array of areas such as business and commercial transactions, financial arrangements, acquisitions or property settlements, or outright conflicts. In many common business transactions, trademarks may not be the dominant issue, and may simply be understood as a related property right. For infringement actions, an in-depth understanding of trademark properties is paramount. In any event it would behoove the general practitioner to have some general knowledge of trademarks.

Trademarks in the traditional sense are any word, term, name, symbol, or device, even sounds, used in commerce in connection with goods or services to identify the source, known or unknown. To be candid, the word “trademark” has a generic meaning, which for convenience is used in this article, to include marks associated with goods and marks associated with services. But in the statutes marks associated with goods are technically “trademarks” and marks associated with services are technically “service marks.” Two other lesser classes of marks are Collective Marks for organizations, such as unions, and Certification Marks for goods or services certified to conform to certain standards. The property rights of the four categories of marks are fundamentally the same and are intended to protect against confusion of source when used in commerce on goods or services.

“Trade dress” is a special type of trademark that refers to the distinctive appearance of the owner’s property. Trade dress may be a distinctive styling, presentation, or packaging (e.g. the hourglass shaped Coca-Cola bottle; or the green and yellow paint décor of John Deere lawn, garden, and farm equipment). Trade dress marks can be registered as a trademark if they are distinctive.

Unlike patents and copyrights that are governed exclusively by federal law in the United States, trademarks fall within the jurisdiction of both state and federal laws and the common law. Protection against confusion of source is the common thread afforded marks under the various laws within the jurisdictional

and geographic limits of the laws. To fall within the jurisdiction of federal law (The Lanham Act – 15 U.S.C. §§1051 et seq.) and the remedies provided, the mark must be used in interstate or foreign commerce, and be registered with the US Patent & Trademark Office. To fall within the jurisdiction of state law, a trademark must be used in commerce within the state and be registered with the secretary of state. Absent a state or federal registration, protection is limited to the common law, or reliance could be placed on unfair trade practice laws such as CUTPA – CGS §§42-110a et seq. or if interstate or foreign commerce is involved, the Lanham Act §43(a)– 15 U.S.C. §1125(a).



From the practitioner’s perspective, the first encounter with a trademark question often is whether the client’s mark is protectable. If a registration has already been procured, the question of protectability has usually been addressed subject to prior user’s rights. If no registration is involved, the question becomes is the mark distinctive in the relevant market so that the mark when used with goods or services is capable of identifying the brand of the goods and distinguishing them from similar goods or services of others in the field. An unofficial hierarchy of marks and their protectability is:

1. **Arbitrary** – registerable without question (e.g. KODAK)
2. **Suggestive** – usually registerable (e.g. DUNKIN DONUTS)
3. **Descriptive** – not registerable without evidence of acquired distinctiveness
4. **Generic** – not registerable as lacking distinctiveness (GLASS CLEANER)

A few clients are creative and come up with arbitrary marks that generally are the easiest to register and protect. But most clients will be seeking protection of suggestive marks. Descriptive marks, such as Soft Soap for a liquid soap, need evidence of distinctiveness acquired through long and continuous use, extensive advertising, voluminous sales, and the like, so the consuming public comes to know and recognized the goods or services as coming from a particular source, known or not.



After a mark is selected, and preferably before adoption and use, it is advisable to conduct a trademark clearance search to see if the mark is available. A mark is not available if, when used in commerce, it is likely to cause confusion, mistake, or deceive as to the source of the goods or services. Availability depends basically on the marks of others that have been used in commerce before. The rule—first in time is first in right—usually prevails. The first referred to here is the first to use the mark in commerce in connection with goods or services. Therefore, a trademark clearance search takes into consideration not only the marks themselves, but also the goods and services with which the marks are used. Since confusion of source is the primary driver in availability, another factor influencing selection of a mark is the geographic region where the mark is to be used. If the business with which the mark is going to be used is limited to one state with little chance of expansion, registration in the state may suffice. But if business projections are not so circumscribed, a federal registration is more desirable.

A clearance search of US registered trademarks can be conducted by anyone in the trademark records of the secretary of state and the US Patent & Trademark Office. But such a search is incomplete since it does not cover common law or unregistered marks that are

in use and protected. For common law marks the search can be extended to the internet and trade directories. Searching is not an exact science and its limits and risks should be recognized. Commercial search services such as Corsearch and individual practitioners are also available to conduct trademark searches for a fee.

As indicated above, to enjoy the protection and benefits of state or federal trademark laws, the mark should be registered. Registration is obtained by filing an application for registration with the appropriate governmental body having the administrative and geographic jurisdiction over the registration being sought. For state registrations, the secretary of state is generally the authority, and for federal registrations, the Commissioner of Trademarks in the US Patent & Trademark Office is the authority. Attorneys admitted to practice in any state can file for a client in a representative capacity with either office. Foreign registrations can also be obtained by filing directly in the individual countries or indirectly by an international application through the World Intellectual Property Organization (WIPO). Priority rights are recognized by most countries through a number of treaties.

Several matters must be considered before filing. As indicated above, the prime consideration in determining where to file is the

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geographic area for which trademark protection by registration is desired. Other factors that influence the filing are costs and potential conflicts with previously registered marks.

Costs for a state application are typically less than for a federal application. The current filing fee for new Connecticut applications is \$50. However, the application must be limited to a single class of goods or services. All goods and services are divided up into classes according to the Nice Convention that is used by trademark offices around the world, including the US Trademark Office. If a client wants to register his mark for “pumps” and “pump repair services” in Connecticut, he would have to file two applications and pay two fees for two classes—one for the goods and one for the repair services. At the federal level, multiclass applications are permitted.

Examination of a Connecticut state application is relatively simple and consists of a comparison with existing Connecticut state registrations for possible confusion of source and a review of the specimen of use filed with the application. If the application passes examination, a Connecticut registration is issued and is valid for five years subject to prior user’s rights. The Connecticut registration can be renewed for successive five-year periods as long as use of the mark is continued. It should be noted that the examination of a mark for confusion is conducted against other registered marks, and does not comprehend examination against corporate names in the records of the secretary of state. Conversely, incorporation or registration of a corporate entity such as an LLC or LLP, does not equate to trademark clearance and registration.

Examination at the US Trademark Office for likelihood of confusion is similar to the state examination except the database of issued marks of others is significantly larger and comprehends marks filed from businesses in all states and foreign countries doing business in the USA. Therefore, the applicant needs to think about potential conflicts from a broad database of marks. Additionally, following examination by a federal examiner, the mark is published for opposition by anyone who thinks he would be harmed by registration of the mark being examined. An opposition is a mini-trial before the Trademark Trial and Appeal Board within the Trademark Office on the issue of registration of the mark, and can be expensive. Filing for a federal registration could be significantly more involved than a state registration.



So what benefits are derived from a trademark registration? A certificate of trademark registration will be accepted in judicial proceedings as presumptive evidence of the facts stated or apparent from the registration. The facts would include the registrability of the mark for the stated goods and services against prior marks on the register, and the ownership of the mark. The facts can be challenged, but presumptions attaching to the registration give the registrant an advantage in contests involving the mark, including infringements and ownership disputes.

A further and perhaps not immediately obvious benefit of a

registration is the fact that when the mark is on the register of marks, the mark becomes an impediment to innocent adoption and use of confusingly similar marks by others. The impediment arises not only during examination, but also whenever a third party conducts a trademark clearance search.

Additional benefits attaching to the registration of a mark arise in litigation of trademark disputes. The state or federal statutes governing registration provide the right to a civil trial for enforcement of the trademark rights. In the case of infringement the registrant can recover as remedies his damages, and the profits of the defendant to the extent they are not duplicates of damages. In its discretion the court can increase the damages award up to three times the actual damages for egregious actions. In exceptional cases the court can also award reasonable attorney fees to the prevailing party. As injunctive relief the court may order all infringing product to be delivered up and destroyed in addition to barring the defendant from further use of the mark.

While state and federal laws are similar regarding relief for infringements, federal law offers the option to elect statutory damages as high as \$2,000,000 for infringement by counterfeit marks—that is, a mark on a product or service for which the mark is registered and is passed off as genuine. A similar statutory damage option is provided for infringement of a mark used as a domain name.

The state and federal statutes provide special relief for infringement of famous marks that result in dilution by blurring or dilution by tarnishment of the marks. Famous marks are marks that are widely recognized by the general consuming public.

Defenses for trademark infringement are typically challenges to the validity of the registration and to the claim of infringement itself. A defense peculiar to trademark dilution claims is “fair use.” Any use by one other than the owner that is found to be for the purpose of comparative advertising, parody, critical comment, newsworthiness, or other noncommercial use is considered a “fair use” and not an actionable infringement. The non-commercial use takes the use out of the “likely to cause confusion” realm.

A few nuances sometimes confused with trademarks are “trade name” and “domain name.” A trade name is the name that a business uses to identify itself when doing business. Registration of trade names (fictitious names) with town clerks where the business is located is required by state statute (CGS §35-1). A trade name can also be a trademark when used in association with the business’s goods or services to identify source. A domain name is the name a business uses as its electronic address and identity on the internet. Domain names are registered through domain name registrars authorized by the Internet Corporation for Assigned

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Names and Numbers (ICANN), which manages the top-level development and architecture of the Internet domain name space. A domain name can also be used as a trademark.

Trademarks are valuable property rights belonging to a business and promote the business to the consuming public. Trademarks as properties can be bought, sold, and licensed to others. Trademarks can become enduring properties whose value increases with time and use as long as they are properly cared for. ■

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News and Events

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member of the panel shared their own personal story of why they chose to pursue alternatives to private practice and the advantages that such roles can offer.

The final day of the conference, Saturday, September 30, consisted of two educational seminars. The morning began with Alternative Pathways to Leadership: Government, Lawyering, and Community Engagement, which took the form of a panel comprised of attorneys Michael Dumas, Melanie Dykas, Aigné Goldsby, and Shasta Inman, moderated by YLS executive committee member Ali Toumekian. In the seminar, the attorneys discussed the importance of civic engagement and how participation in bar associations and affinity groups can provide a path to leadership roles in government and other organizations.

During the final seminar of the conference, Balancing Wellness with the Scales of Justice: A Perspective on Attorneys and Wellness, Professor Larry Dickson of Plain and Simple Counseling and Consultation Services presented on the critical issue of well-being within the legal profession. He explained how to identify different physical, emotional, and mental health warning signs as well as how to engage in stress reduction and relaxation techniques to address them.

Following the end of the conference's seminars, attendees were able to enjoy a final lunch together before departing.

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gram benefit is available to the caregiver present with a critically ill child admitted to the hospital regardless of financial situation; age, race, or religion; patient condition, illness, or injury; and regardless of the length of inpatient stay.

This year, the Young Lawyers Section has chosen to honor Feeding Families Foundation as the beneficiary of all funds raised through our annual holiday party. If you are unable to attend in person, we hope that you will consider making a monetary donation to this worthy organization either through their website directly at feedingfamiliesfoundation.org or through the Connecticut Bar Association's registration page for this event at ctbar.org/YLSDonation, which will remain open through December 31, 2023. All proceeds will be donated in honor of Jeff and Sam's daughter.

Jeff and Sam are finding ways to make their community a better place for others who may share the same road. Throughout the past year, Jeff has been present for his family and Harper's treatment all while continuing in his path as a lawyer. Being 100 percent present in whatever you do or for whomever you are with is an achievement that takes conscious effort. As we strive to seek balance in our lives, especially through the holiday seasons, may we be proud to recognize that being lawyers will always be a part of who we are, but may we have the strength to realize that it is not all that we are. ■