

TRADEMARKS: PRIORITIZING APPLICATIONS TO REGISTER

Almost all businesses have several trademarks that deserve the protection provided by a trademark registration. However, a new business often has little income and many expenses so filing multiple trademark applications at the outset can be prohibitively expensive. In this article, I will discuss how to set priorities for the filing of multiple trademark applications by a new business.

Word Marks vs. Design Marks

The primary trademark for many businesses is a word or combination of words. They may be:

- a. a known word or a component of a known word;
- b. an invented word or “coined” term; or
- c. a combination of the above.

When represented in the standard characters of the Roman alphabet, these are all known as “word marks”.

Most businesses will also adopt a logo with graphic elements such as fanciful fonts, colours, lines and stylized images. These are known as “design marks”. If the design mark combines graphic elements with a word or combination of words, it may also be referred to as a “composite mark”.

Word Marks

When registered as a trademark, a word mark effectively prevents others from adopting a similar word mark even if they represent it in a different font or in combination with different design features. This is true if the word marks are similar in appearance, sound or meaning. For

instance, GOOGLE and GUGAL may be considered confusing since they sound similar and HURRICANE and TSUNAMI may be considered confusing since they have a similar meaning. For this reason, it is often stated that word mark registrations provide the broadest trademark protection.

It is also important to note that, unlike design marks, word marks are NOT eligible for overlapping copyright protection. Most word marks are considered too brief to be considered an original expression entitled to copyright protection. As a result, word marks can only be protected as a trademark.

Given the broadness of the protection provided by a word mark registration and that the only means of protecting exclusive rights in such marks is as a trademark, word marks are most often ranked as the most important trademarks to register. The words marks which also appear in the business or corporate name are often given the highest priority.

Design Marks

When registered as a trademark, a design mark effectively prevents others from adopting a similar design mark, but the scope of protection is more limited in effect than that of a word mark registration. Although design marks are also prohibited if similar to others in appearance, sound or meaning, design marks are rarely capable of being sounded or assigned a specific meaning. As a result, the examination of design marks is effectively limited to their appearance and seemingly minor variations can have significant consequences.

First, variations in the dominant features of a design mark may allow a competitor to adopt a mark remarkably similar in appearance if not considered confusing. For instance, the adoption of a composite mark in which a different word appears in the same or similar font as a competitor may not be prohibited since words are usually considered the dominant feature of a composite mark.

Second, variations between a mark as it appears on the trademark register and its actual use in the marketplace may result in an invalid trademark registration. For trademark registrations to remain valid, the trademark must be used in the format in which it is registered. From a legal perspective, a new design mark may be inadvertently created by adding features to or subtracting features from the format in which it was originally registered. Unfortunately, newly adopted design marks are especially vulnerable to “tinkering” as they are adapted by the business to new promotional purposes.

Finally, the design features of a design mark are often eligible for overlapping copyright protection as artistic works. International copyright protection arises automatically by operation of law upon the creation of an original work and prohibits the unauthorized reproduction of a substantial copy for any purpose. As a result, exclusive rights in a design mark can often be protected under both trademark and copyright law.

Given the relatively narrow protection provided by a design mark registration, the fact that such registrations are especially vulnerable to invalidity challenges and that such marks often benefit from overlapping copyright protection, design marks are often ranked as less important trademarks to

register. Of course, this last generalization may be set aside if the design mark is considered unusual or the design mark has been used consistently for several years in the marketplace.

Composite Marks

In some cases, the word marks adopted by a business are relatively weak trademarks or wholly unregistrable as trademarks. This will arise when the word mark: (a) is an acronym; (b) is a name or surname; or (c) is comprised of geographic place names, laudatory terms or other descriptive elements. When these circumstances arise, a trademark registration may not be available at all or may enjoy only a narrow scope of protection so filing an application to register the word mark on its own may be an unwarranted expense.

In such circumstances, an application to register a composite mark, including both word and design elements, may be filed instead of an application to register the word mark on its own. Of course, a registration for such a composite mark will only be entitled to a wide scope of protection and merit the cost of filing a trademark application if its design elements are truly distinctive. Further, it should be noted that surnames and descriptive words will not be rendered registrable as a trademark simply by using a fanciful font or adding a few simple lines.

Conclusion

In order to set priorities for the filing of trademark applications, it is important to understand both its value from a business perspective and the relative benefits and weaknesses of the subject mark from a legal perspective.

In general terms, a new business is well-advised to place the highest priority on filing

trademark applications to register any word mark that appears in their corporate or business name. The second priority should be on filing trademark applications to register any other word marks to be used in their business as a slogan or to identify specific products or services. In most cases, the least priority should be placed on filing trademark applications to register design marks and composite marks unless the design features are highly unusual or the word marks are relatively weak.

After a design mark has been used in a consistent format for two to three years, a business may consider whether to file a trademark application to provide it with increased protection. If a design mark is unique and has acquired a reputation in the marketplace, an application to register it may now be warranted. If a design mark is likely to be updated in the near future, filing a trademark application is likely an unwarranted expense.

Disclaimer: The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.