

Creation of Trademark Rights and Registration

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Q. **HOW DOES ONE OBTAIN TRADEMARK RIGHTS?**

- a. In the United States, we do not "trademark" anything.
- b. Instead, trademark rights in the U.S. arise by use. This means that once a person starts using any word, symbol, logo or other device as a brand - they are generating legally protectable rights recognized under the law.
- c. People often ask me, "Can I trademark this?" What these people typically mean to ask is, "Can I obtain a registration for this mark?"

In countries around the world that are not former English colonies, mark rights generally require a formal registration. This is not the case in the United States. Trademark rights are created by using a mark. Registering a trademark with the United States Patent and Trademark Office (USPTO) gives a trademark owner extra rights.

- d. So remember this simple rule.

In the United States, the **FIRST** person to use a mark ...

in connection with a **CATEGORY OF GOODS OR SERVICES** ...

in a **PARTICULAR GEOGRAPHIC AREA** ...

is considered the **OWNER OF THE MARK** in that geographic area for those goods or services.

This is the important concept of **PRIORITY**.

Q. **IF TRADEMARK RIGHTS ARISE BY USE, WHY SHOULD MY COMPANY REGISTER ITS MARKS?**

- a. Trademark rights that arise by using the mark are enhanced by registration with the USPTO. There are many advantages from having a mark registered with the USPTO.
- b. The key right gained from registration with the USPTO is being recognized as a user of the mark in the entire U.S. starting from the date of the application to register
- c. If one gets a registration, then only those businesses using the mark at the time of the filing date of the application can keep using their marks, and only in their limited geographic area.

d. The opportunity to register a mark with the USPTO is open only to those persons actually *using* or who have a *bona fide intent to use* a mark.

e. Those who have a bona fide intent to use a mark can also apply based upon the intent to use, but the application will not result in a registration until proof of use is shown. The major advantage with marks that are registered based upon an "intent-to-use" rather than actual use, is the fact the filing date of the application to register, not the later date of first use, serves as the priority date.

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