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Law in Brief: Guideline to Trademark Law

Background

You offer fresh, high-quality produce and value-added foods to your customers and take pride in your good reputation in the community. But how can you protect your “brand” -- the goodwill and trust you have developed for your business? Can you prevent others from riding on the coattails of your good reputation to sell their goods? This guideline sets out how to obtain and protect your trademark and how to identify trademark infringement.

What is a trademark?

A trademark is a word, name, and/or symbol which is used to identify the source of goods or products.

- *Company name.* Your company name, along with your logo or the artwork that goes along with your company name, can be trademarked. The trademark shown here includes both the business name – Lexington Community Farm – as well as distinctive red and green coloring and a fanciful image.
- If your company offers a service, the mark is called a *service mark*.
- *Product name.* You can also trademark your product name.



How to choose a trademark

Choose a strong mark that does not suggest or describe an ingredient, characteristic, or quality of the goods or services.

This may seem counterintuitive. A trademark creates an idea of your company or product in the minds of the viewer. Does yours evoke the image you want? Why not use a business or product name that tells the viewer what the product is, *e.g. Tasty Tomato Farm?* Tempting, but...if the name describes a property that all tomatoes have (don't all farmers believe their tomatoes taste best?), then:

- Anyone can use it to describe *their* product;
- The name does not help *your* product stand out; and
- It is not a trademark.



A name falls into one of five categories of decreasing trademark strength:

1. Fanciful – a coined or made-up word
2. Arbitrary – words are in use, but do not describe the good
3. Suggestive - describes some quality of the good, but requires imagination
4. Descriptive - Identifies a quality or purpose of the good or is a surname
5. Generic – common name for the good

The figure below illustrates the spectrum of product name strength for a beverage.



Strong mark

Weak mark

Fanciful or arbitrary names such as “Pepsi” and “Bearded Lady” are strong trademarks that are memorable and don’t suggest a product characteristic. “Crush Orange” is suggestive of a feature of an orange soda, while “Chocolate Fudge” clearly describes a chocolate-flavored soda and is a weak mark. “Cola” is a generic name and can never be used as a trademark.

Before you choose a business or product name, investigate whether it is already in use.

- *Internet searches* using for example the Google® search engine is a quick and inexpensive way to see if anyone is using the name.
- *State registration data bases* such as **corporations data bases** (usually maintained by the Secretary of State) and **fictitious business names (‘doing business as’) data bases** (maintained at county or state levels) can identify existing businesses using the name.
- *Patent offices* such as the US Trademark Office maintain user-friendly searchable data bases of pending and expired trademarks. See, <http://tmsearch.uspto.gov/>.
- Search alternative phonetic spellings and similar-sounding names, too.

To Register or Not to Register?

Simply by using your name as a trademark, you enjoy common law protection for your mark.

No formal registration is required to create a trademark. However, protection is limited to the geographic area in which you run your business. If you are only selling locally, further action may not be needed. You may consider registering your mark with your state for a small fee.

Registration provides notice to third parties and simplifies proof of ownership should the mark be challenged. Registration typically is made with the Secretary of State.^{1,2,3,4,5,6}

If you anticipate interstate business, consider registering your trademark with the U.S. Trademark office.

Federal registration gives you the right to use the mark in all 50 states as well as other benefits.⁷ If you think you need a federal trademark, you may want to confer with an attorney who can advise on whether the name is available and help streamline the application process.

Proper Use of a Trademark

Goods and services should properly display the trade or service mark.

- *Labeling.* A trademark is associated with goods and should be affixed to the product, either directly, on tags or on packaging. However, use of a service mark on websites, letterheads or advertising qualifies as use of a service mark.
- *Grammar.* Marks should be used as adjectives, not nouns. Therefore, proper usage of the Oreo mark is “OREOS® chocolate cookies,” NOT Oreos.
- *Symbols.* TM and SM are used for unregistered trade and service marks. Federally registered trademarks and service marks both use ®.



Enforcing your Trademark

Police the use of your marks by third parties. Monitor for unauthorized use and document use and evidence of customer confusion. Monitor state and federal trademark registrations for registration of confusingly similar marks. If you find an infringer, ask them to stop. Consider seeking the advice of an attorney to help resolve any disputes.

Additional References

For more information on U.S. federal trademark registration, see <https://www.uspto.gov/trademark>.

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¹ For Massachusetts, see <https://www.sec.state.ma.us/cor/corpcweb/cortmsm/tmsmfrm.htm>

² For Maine, see <https://www.maine.gov/sos/cec/corp/trademarks.html>

³ For New Hampshire, see <http://sos.nh.gov/tmforms.aspx>

⁴ For Rhode Island, see http://www.sos.ri.gov/doc_lib/search/trademark

⁵ For Connecticut, see <https://portal.ct.gov/-/media/sots/CommercialRecording/AllForms/TradeServiceMarks/appforacertofregoftradeorservmarkpdf.pdf?la=en>

⁶ For Vermont, see <https://www.sec.state.vt.us/corporationsbusiness-services/trademarks.aspx>

⁷ For a more detailed discussion of benefits of U.S. federal trademark registration, see <https://www.fr.com/news/top-10-benefits-of-us-trademark-registration/>.

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