

Montana Innovation Partnership (MTIP) assists tech-based individuals and companies to commercialize their innovative solutions. Moving ideas into the marketplace requires attention to protecting the creative works of the owner in a manner suitably oriented to future commercial objectives. Intellectual property (IP) is a legal concept which refers to a creation of the mind with potential economic value and for which exclusive rights are recognized. Types of IP include copyright, trademarks, service marks, patents, industrial design rights, trade dress, and trade secrets. This guide serves as an introduction to the protection of trademarks and service marks.

WHAT IS IT

A Trademark is a recognizable word, phrase, symbol, sign or design expression that identifies and distinguishes the source of the goods of one party from those of others. For example, Nike® (circle-R) is distinct and recognizably different from Adidas® (circle-R). Trademarks represent products commercially sold in interstate trade and can be strongly identified with the quality of the product represented. Trademarks can be secured for typed words or graphical representations. For instance, Compromise Elsewhere® (circle-R) is a word mark of the Boar's Head® brand meat company, and the Boar's Head® (circle-R) logo is a registered design mark or stylized logo. A service mark is a recognizable word, phrase, symbol, or design that identifies and distinguishes the source of a service (rather than goods) and is represented in superscript SM (SM). AT&T protects its brand offerings with trademarks for hard goods such as accessories, and service marks for services such as telephone repair.

The term "trademark" is often used to refer to both trademarks and service marks. Both trademarks and service marks may be used even without having been awarded a federal registration. A trademark designation that has not been federally registered is indicated in superscript TM (TM), and an unregistered service mark designation is indicated in superscript SM (SM). When a trademark or service mark has been granted by the USPTO, the superscript 'circle-r' symbol (®) is used.

To be effective, the superscript designation needs to be applied consistently with every use of the mark. The appropriate designation is generally placed to the upper right immediately following the trademarked word(s) or graphical representation. Both trademarks and service marks are most frequently noted within text (including online content), on printed materials including advertisements, labels and packaging, and on products or company signage.

WHY IT MATTERS

Trademarks address the three-way balance of 1) maintaining control over what's been created, 2) using that to add value to the company and its products, and 3) avoiding infringement on works by others. Trademarks were first introduced in the Middle Ages when craftsmen, artists and merchants wanted to distinguish their products or services from those offered by other business people. Trademark creation was quickly followed by counterfeiting. Potential prosecution for infringement reduces the incidence of competitors creating similar marks and diluting the value of the original brand. A trademark is very important to a business because customers equate the mark with the credibility of the good or service and the reputation of the owner. Often, a trademark is the most valuable asset owned by a company seeking to build branding value.

Learn more about trademarks by viewing this slide deck: <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf>
Opportunities for growth, e-commerce, licensing and import/export in today's economy make the trademark a critically valuable reinforcement of brand recognition and brand integrity.

REGISTRATION

United States law allows for the use of the trademark and service mark designations without any formal registrations. States also register trademarks and service marks for protection within a state's boundaries. While this provides some value for local use or in early stages of sales, state registrations do not obviate the need for a federal registration. The circle-r trademark symbol (®) can only be used when a trademark has been registered with the federal government through the USPTO at www.uspto.gov/trademarks.

A trademark or service mark is frequently confused with a copyright ©. A copyright protects works of authorship, such as writings and music, and works of art that have been tangibly expressed. Copyrights do not apply to company names, logos or brand name.

Before investing in a name or logo for a company or products, it is important to become knowledgeable as to the availability of that mark. It becomes a substantial blow to a company to have invested in an identity that can be challenged later by an original mark holder. A search for US marks can be performed on the USPTO Trademark Electronic Search System (TESS) located at: <https://www.uspto.gov/trademarks-application-process/search-trademark-database>. Not all federal trademark applications are approved. For example, if a mark is confusingly similar to another previously registered mark in the same product category, the application will be denied. Marks also cannot be merely descriptive, deceptive, or deceptively mis-descriptive. Though registration is not required, registered marks are national in scope and the owner of the registered mark has the right to sue for infringement in federal court.

Before conducting a search, review Tess Tips at: www.uspto.gov/trademarks/process/search/Tess_tips.jsp# to make the best use of this utility. If a search in TESS yields a mark that might conflict with a proposed mark, identify first whether the "Live/Dead Indicator" shows the mark to be "live." A "dead" mark will not be used to block an application. Even though the proposed mark is already registered a number of times in the same or different variants, it still may be available for other categories of Goods and Services. Descriptions of the product category can be viewed in each of the registered trademarks. A word mark offers the most flexibility and value, but filing on a graphical mark or a logo that includes the selected name can often be more easily allowed under copyright examination.

Other search resources include trademarks and service marks registered within the State of Montana which can be found at the MT Secretary of [State Business Entity Search](#). International trademark protection is filed under the Madrid Protocol, a treaty agreement for uniform International marks. Information about the International Trademark System and its ROMARIN registry database can be found at: www.wipo.int/madrid/en.

Although not required, most applicants use private attorneys for legal advice regarding use of their trademark and filing an application. Any attorney can file a trademark but may be less knowledgeable than a trademark specialist in how to respond to the USPTO Examiner on whether or not it will be allowed. Therefore, applicants may want to look for assistance from an IP attorney or inquire about past experience in filing trademarks. Locate an attorney using local listings or contact Montana's State Bar Association.

Unregistered use of the TM or SM designations is free. Federal registration [®] (circle-r) with USPTO requires a registration fee which is calculated on a "per class basis," meaning, there is a fee for each class in which the trademark is registered. There are 44 potential classes. An investigation of the Trademark section of the USPTO or a conversation with a Trademark attorney will help you select the appropriate class(es) which cost from \$225 - \$400 each with some additional fees associated with special cases. The duration is 10 years which can be extended by optional 10-year renewal periods with evidence of ongoing commercial use of the mark. To register a company name or trademark in the State of Montana, an application is filed with the MT Secretary of State Office with a \$20 fee for duration of 5 years.

READY FOR THE NEXT STEP?

This guide has been prepared by the Montana Innovation Partnership (MITP) powered by MSU TechLink Center and does not imply endorsement from the USPTO. MITP can provide no-cost guidance to qualified Montana technology-based companies seeking help in R&D funding programs, commercialization and intellectual property matters, when funding is available. For more information, contact the MITP Program or visit the web at montanainnovationpartnership.org



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