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What You Need to Know About Trademark Law

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By David R. Ellis, Attorney at Law
Largo, Florida

Why do lawyers need to know about trademark law? If you or your clients have ever opened a business or adopted a distinctive name, logo, or slogan to identify the firm's goods and services, you need a basic understanding of trademark law.

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A trademark is a name, symbol, logo or slogan adopted by a company to identify its goods and services and distinguish them from competing goods and services provided by others. When a trademark is used in connection with services, it is called a service mark. Adoption and use of a trademark gives the owner the right to prevent others from using the same or similar mark in a manner that would be deceptive, misleading or confusing to the public.

If a firm provides goods or services in more than one state, the trademark may be registered with the U.S. Patent and Trademark Office (PTO) in Washington. The federal law is the Trademark Act of 1946 (Lanham Act), 15 U.S.C. §§1051 et seq. A federal trademark is good for ten years and may be renewed for as long as it continues to be used. A federal trademark gives the owner the exclusive right to prevent others from using the trademark in a manner that would create a likelihood of confusion to the public throughout the United States, and to enforce its right by suing in either federal or state court.

Before attempting to register a trademark, it is usually advisable to search the records of the PTO to determine whether there have been any previous filings or registrations of the mark or any similar one. Often such a search is extended to include all of the state trademark offices, and various publications such as trade directories and the Internet in order to reduce the likelihood that the trademark has been previously used or registered by another party.

If a company is selling its product or services only in Florida, it may register the trademark with the Department of State in Tallahassee. Florida recently adopted a new trademark act, Chapter 495 of the Florida Statutes, making a number of changes to conform the state law to federal law and practice. For more information about the new law, see my article, "What's In A Name? Florida Enacts A Trademark Act For The 21st Century."
http://easl.info/index.php?module=Static_Docs&func=view&f=20030419+David+Ellis+Victorias+Secret+Article.htm.

Under the new Florida law, the term of registration is five years, reduced from ten years as of January 1, 2007. A registration may be renewed for a term of five year if it is still being used. By registering its mark, the owner can prevent others from using the same or confusingly similar trademark for a similar product or service in Florida.

Once a trademark is registered, either at the federal or state level, the registrant can bring suit against anyone who has infringed it. Infringement means the unauthorized use of the trademark in connection with any product, service or advertising where the use is likely to cause confusion or mistake or to deceive the user as to the true source of the goods or services.

In addition, both the federal and state trademark statutes protect a trademark owner against the "dilution" of a distinctive trademark, where the use might blur, tarnish or whittle away the mark's distinctiveness. Trademark dilution is different from trademark infringement, which occurs when a subsequent user adopts the same or similar trademark on competing or closely related goods so that consumers are likely to be confused as to the source of the goods. Trademark dilution can occur when a famous trademark is used by another on non-competing goods even when there is no likelihood of confusion between the uses of the marks.

The standard of trademark dilution is "likelihood of dilution," both under the new state law and also under the federal law. Under an amendment to the federal Trademark Act enacted in October 2006, trademark dilution can occur when someone uses a mark that is likely to cause dilution by blurring or tarnishment of a famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury to the owner of the famous mark. The amendment overturned the decision of the U.S. Supreme Court in the Victoria's Secret case, *Moseley v. V Secret Catalogue*, 537 U.S. 418 (2003), which required actual dilution of the mark. For a discussion of that case, see my article, "It's Not Just Victoria's Secret: In A Case Of Comparative Negligees The Supreme Court Clarifies Trademark Dilution Law."
http://easl.info/index.php?module=Static_Docs&func=view&f=20030419+David+Ellis+Victorias+Secret+Article.htm.

In a case of either trademark infringement or dilution, the court can order the violator immediately to cease its unauthorized use of the mark. In an infringement case, the court can also order all infringing products destroyed and award money damages to the trademark owner, which can be trebled in certain instances. In determining the amount of damages, the court may require the infringer to pay to the trademark owner all profits derived from the wrongful use, plus the cost of suit.

In cases of infringement under the federal statute, the court may also award attorney's fees in "exceptional cases." Under the new Florida statute, however, an award of attorney's fees may be ordered without a showing that the case is exceptional, so this may be a reason why trademark owners may want to consider registering their marks under state law in addition to registering under the federal act.

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David Ellis is a Largo attorney practicing copyrights, trademarks, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and the author of the book, *A Computer Law Primer*. He has taught Intellectual Property and Computer Law as an Adjunct Professor at the Law Schools of the University of Florida and Stetson University.

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