

WHAT YOU NEED TO KNOW ABOUT TRADEMARKS

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

A trademark is a word, name, symbol, logo, slogan, design, or other designation used by a person or company to identify its goods or services and distinguish them from those provided by others. A trademark used in connection with services is often referred to as a service mark. Adoption and use generally gives the owner the right to prevent others from using the same or confusingly similar mark in a manner likely to cause customer confusion.

Trademark rights generally arise from commercial use. However, a trademark used in interstate or foreign commerce may also be registered with the U.S. Patent and Trademark Office (USPTO) under the Trademark Act of 1946, commonly known as the Lanham Act, 15 U.S.C. §§ 1051 et seq.

Although registration is not necessary to create trademark rights, federal registration provides significant advantages to the owner, including nationwide notice of the registrant's claim of ownership, important evidentiary presumptions, access to federal remedies, and the right to use the ® symbol for the covered goods and services.

A federal registration can remain in force indefinitely as long as the mark continues to be used and the owner maintains and renews it. (Think *Coca-Cola* or *General Electric*, both over 125 years old!). Between the fifth and sixth years following registration, the owner must establish that its mark is still in use in commerce, or that its nonuse is excusable. In the last year of registration, and every ten years thereafter, the owner may renew its registration to maintain it in force for the following term.

Before adopting or registering a trademark, it is usually advisable to conduct an availability search of registrations, pending applications, and other uses of the mark or similar marks. The search should not be limited to identical marks because infringement depends upon a likelihood of confusion, so marks that

are similar in appearance, sound, meaning, or commercial impression may present the possibility of conflict even though they are not identical.

A search may include USPTO and state trademark records, business and trade directories, domain names, Internet searches, social media, and other sources. A search cannot guarantee that a proposed mark is available, but it can identify potential problems before the owner invests substantial resources in a new brand.

Federal law also permits a person with a bona fide intention to use a trademark in commerce to apply for a registration before it commences its use. An "intent-to-use" application establishes priority over those who seek to use the same or similar mark afterwards, but the registration itself will not be issued until the applicant demonstrates that it has actually used the mark in commerce.

A company using a trademark in Florida may also register it with the Florida Department of State under Chapter 495 of the Florida Statutes. A Florida registration is effective for five years and may be renewed for successive five-year periods. State registration does not replace federal registration but may provide additional rights and remedies under Florida law.

Once trademark rights have been established, the owner may sue anyone who infringes those rights. Infringement means the unauthorized use of the same or similar mark where the use is likely to cause confusion, mistake, or deception concerning source, sponsorship, affiliation, or approval.

Whether a likelihood of confusion exists depends upon the circumstances. A court may consider the similarity of the marks, relationship between the parties' goods or services, strength of the plaintiff's mark, marketing channels, sophistication of purchasers, evidence of actual confusion, and the defendant's intent. No single factor necessarily determines the result.

Federal and Florida law also protect certain marks against "dilution." Unlike ordinary infringement, dilution does not necessarily require confusion. Under federal law, the owner of a famous mark may obtain protection against uses likely to cause dilution by "blurring," which impairs the mark's distinctiveness, or "tarnishment," which harms its reputation. Federal law contains exceptions for certain fair uses, parody, criticism, commentary, news reporting, and noncommercial uses.

Trademark law has become increasingly important online. A trademark may be infringed through unauthorized use on websites, social media, online marketplaces, digital advertising, or other Internet-based activities. Counterfeit goods offered through e-commerce platforms present another significant problem. Federal law also provides remedies in appropriate cases against the bad faith registration or use of domain names identical or confusingly similar to protected trademarks.

In an infringement case, a court may order the violator to cease its unauthorized use, destroy infringing products, and award monetary 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 the suit.

In case of infringement under the federal statute, the court may also award attorney's fees in "exceptional cases." The infringer's intent and willfulness may be relevant in determining monetary relief and attorney's fees, but willfulness is not necessarily a prerequisite to such awards. Under the Florida statute, an award of attorney's fees may be ordered without a showing that the case is exceptional, so this is a reason why some trademark owners register their marks under state law in addition to registering under the federal act.

Trademark law ultimately protects both businesses' goodwill and consumers against confusion regarding the source of goods and services. In today's marketplace, where a business name or product can acquire national or international exposure and renown almost overnight, the owner's brand can become one of its most valuable assets. Businesses should therefore carefully select their proposed trademarks, obtain and maintain appropriate registrations, and take reasonable steps to protect their marks against unauthorized use by others.

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