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Present

\*\*\*WINTER SERIES\*\*\*

Protecting Your Good Name --Trademarks and Non-Profits

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- 1.. What is a trademark or service mark--distinction from trade or corporate name.
- 2.. Availability of trademark rights for protection of marks of non-profits.
3. Protectability of different marks--confusing similarity.
  - a. Distinctiveness or strength of marks
    - i. Arbitrary or fanciful
    - ii. Suggestive
    - iii. Descriptive, geographic, personal name
    - iv. Merely descriptive or generic
  - b. Additional indicia of confusing similarity
    - i. Similarity of marks: sound, sight, and meaning
    - ii. Similarity of product or service
    - iii. Similarity of channels of trade
    - iv. Sophistication of customers
4. Forms of protection
  - a. Common law protection

- i. Based on state law
    - ii. Only encompasses area of actual use
    - iii. Subordinate to registered mark after 5 years of registration and use
  - b. State registration
  - c. Federal registration
    - i. Actual use v. intent to use
    - ii. Primary register for fanciful and arbitrary marks and descriptive marks with secondary meaning
    - iii. Secondary register for descriptive marks without secondary meaning
    - iv. Registration process
- 5. Asserting rights in marks
  - a. Cease and desist letters to avoid laches or abandonment
  - b. Infringement action
- 6. Special kinds of marks
  - a. Collective marks
  - b. Certification marks
- 7. Conveying rights in marks to others
  - a. Licenses
  - b. Assignments
- 8. Antidilution concerns
- 9. Other methods of unfair competition, e.g., passing off.

