

## The Background and Basics of American Trademark Law

Hi everyone and thanks for tuning in to the Witmart video series covering everything you need to know about intellectual property.

In this video, we'll cover the progress of U.S. trademarking from day one until... well, as of right now!

So if you've ever wondered what to expect when growing your business and defending your IP in the American market, this episode is for you.

Let's get to it!

Given that the United States has the world's largest economy, it's no surprise you might want to get in on the action.

Whether you're planning to scale your business into the U.S., or you've already planted your flag on American soil — protecting yourself from infringement should be an essential part of your overall business strategy.

### **So who regulates the trademark registration process in America?**

Founded in 1802, the United States Patent and Trademark Office (or "USPTO") is the federal government agency responsible for granting trademarks and other intellectual property rights like copyrights and patents.

Believe it or not, the first ever trademark registered with the USPTO actually has a pretty interesting and controversial backstory.

Officially, the oldest recognized trademark in the United States was registered on May 27, 1884 to a cord, line and rope company called Samson, whose logo features a depiction of the Biblical character, Samson, fighting a lion. Remarkably, this trademark is still in use to this day under Samson Rope Technologies, Inc.

But wait! We promised controversy! Intrigue! A story! Well, plot twist — Samson may not be the earliest trademark in the U.S. after all.

Back in 2000, a USPTO employee discovered an old, dusty book containing the oldest known record of American trademark registrations — predating the official record by 14 years!

According to the long lost document, the first ever trademark was registered to Averill Chemical Paint Company on July 28, 1870.

That said, there's little evidence of trademark reproduction anywhere and the Trademarks Act of 1870 has since been ruled as "unconstitutional" by the U.S. Supreme court, so Samson maintains top billing as trademark #1.

Samson and Averill may be the oldest registered trademarks in America, but there are plenty of common marks we encounter everyday that have been around for longer than 100 years!

These include:

- General Electric's GE Medallion
- The Cream of Wheat Logo
- Carnation Brand Condensed Milk
- Coca Cola
- And many more!

Fascinating as ancient trademarks may be, let's move on from the history lesson and talk about the current legal landscape of trademarks in the U.S.

The primary legislation governing the issuance of trademarks at a federal level is the Trademark (Landham) Act of 1946. Each state also has its own laws and regulations dictating trademark use and protection at the state level.

As we mentioned earlier, the United States Patent and Trademark Office (USPTO) is the government agency federally responsible for the evaluation and registration of American trademarks. Their agents are the ones who will review and ultimately reject or grant your application.

**You might be wondering -- how does the USPTO determine who gets a trademark and who doesn't?** Well, there's a lot goes into the process but ownership ultimately comes down to proof of use.

The USPTO recognizes trademark ownership on a **first-to-use basis**, rather than first-to-file. That means if you can prove first use of your trademark in the U.S. your ownership rights are enforceable under common law rights in state and federal court — even without registration.

**Unregistered trademarks** are still a risky move, though. You can use the <sup>TM</sup> (trademark) or <sup>SM</sup> (Service Mark) symbols as a way to demonstrate ownership to the public, but that doesn't necessarily mean you are protected from infringement in America or elsewhere. In fact, if you're unregistered, you can't sue for infringement on your mark

**Registered trademarks**, on the other hand, are considered legally valid. Registration with the USPTO also establishes defendable ownership rights nationwide. You can use the ® symbol to demonstrate ownership of your registered marks.

But let's say your trademark application with the USPTO gets rejected. Can you appeal the decision? Yep, all USPTO decisions can be disputed with the Trademark Trial and Appeal Board (TTAB) in Federal Court. Don't let the fear of rejection hold you back, though. There's plenty you can do to prepare your best possible application -- and Witmart can definitely help as needed.

**So who exactly can register a trademark with the USPTO?**

Anyone! Well, any person or entity with a *genuine* intention to enter commerce with their desired mark can apply for registration.

**Now that you've decided to register a trademark, what types of business assets can you file to protect?**

According to the Lanham Act, you can basically file an application to register any “distinctive and non-functional word, symbol, drawing or combination thereof.” Since the American market is always growing and innovating itself, the definition of what can be trademarked is also somewhat fluid.

For example, these days, you can also register trademarks for particular sounds, smells, colours, flavours and other non-visual materials associated with your brand.

I could go on talking about trademarks all day — but if you're anything like me, you probably need a break after all that legal jargon!

So kick back, reflect on what you've learned and don't forget to tune in for our next episode all about the Untold Adventures of the USPTO Application Process.