

What Is A Trademark? A **symbol** that is used in **commerce** to **identify and distinguish** goods or services by one seller or provider from those of other sellers or providers, and to indicate the **source** of the goods or services. Symbols can include colors, sounds, phrases, designs, images, scents, and words.

Trademark Ownership & Term

Who is the owner of a trademark? Whoever controls the **first use** of the trademark for the goods or services is the owner of the trademark. An owner can be an individual, business, or a legal entity. At UTHealth, the **Board of Regents** owns the trademarks that were either developed within the course and scope of employment of the individual or resulting from activities performed on UT System time, or with support of state funds, or from using facilities or resources owned by the UT System or any UT System institution.

How long does the trademark last? As long as the trademark is used in commerce and is defended against trademark infringers, trademark protection can last in **perpetuity**. Trademark protection will cease if the owner stops using the trademark with the intention not to resume use or if the trademark becomes generic.

How long does a trademark registration last? A registration is valid and may theoretically last forever so long as post registration maintenance documents are timely filed, including a Declaration of Use between the fifth and sixth year following registration, a Declaration of Use and Application for Renewal between the ninth and tenth year after registration, and every 10 years thereafter. If the documents are not timely filed, the registration will be cancelled and cannot be revived or reinstated.

Distinctiveness

To qualify as a trademark, a symbol must be **distinctive** enough to identify and distinguish the goods or services.

There are three categories of distinctiveness.

(1) **Inherently distinctive marks** which include:

Fanciful marks (invented symbol, such as Kodak®), **arbitrary marks** (common word used in meaningless context, such as Apple®), and **suggestive marks** (tends to indicate the nature, quality, or characteristic by use of imagination of the consumer, such as Grayhound® bus lines). These marks by themselves are distinctive enough to qualify for protection.

(2) **Marks that are capable of acquired distinctiveness** which includes:

Descriptive marks. These alone describe the goods or services and are initially unprotected. It is only when these marks acquire **secondary meaning** (the public is able to indicate the source) are they protected as a mark.

(3) **Generic Terms** are marks that designate the category of the goods or services rather than the source. These are **not protectable** as marks.

Federal Registration & Benefits

Federal registration is **not required** to establish rights in a trademark. If you claim rights to use an unregistered mark, you may use “TM” (trademark) or “SM” (service mark) to alert the public to your claim of a common law mark. However, there are benefits to federally registering your trademark including:

- (1) Public notice of your claim of ownership in the mark;
- (2) Legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide;
- (3) Ability to bring an action in federal court;
- (4) Use as basis for obtaining registration in foreign countries;
- (5) Ability to record the registration with the U.S. Customs and Border Protection Service to prevent importation of infringing foreign goods;
- (6) The right to use the federal registration symbol ®; and
- (7) Listing in the United States Patent and Trademark Office’s online database.

Are There Different Types of Trademarks?

Trademarks – used to identify source of tangible goods.

Service marks – used to identify source of services and intangible activities.

Certification marks – used by a person other than its owner to certify to consumers that the goods or services meet the standards set by the mark’s owner.

Collective marks – a trademark or service mark used by members of a group or organization.

Trademarks and Their Purpose

Q: People tell me I should trademark my logo, but what exactly is a trademark and what is it for?

A: A trademark is any symbol (which can include colors, sounds, phrases, designs, images, scents, and words) that is used commercially to identify and distinguish your product or service from the products or services of others so that consumers know you are the source of the your particular product or services. Trademarks serve to give consumers confidence that the goods or services they are purchasing are of the same quality and source that they expect when they see the trademark. Therefore, if you are commercializing a product, it may be helpful to attach or affix a trademark on your product so that consumers will recognize the brand and hopefully purchase additional products in the future. To trademark a logo, you should contact The Office of Technology Management at UTHealth since all trademarks developed at UTHealth is owned by the Board of Regents.

Q: My logo is a picture and someone told me it is copyrightable. Then what is the difference between copyright and trademarks?

A: Copyright is a form of protection provided by the laws of the United States (as well as international treaties including the Berne Convention) to the authors of original works of authorship of their creative expression in the work. Therefore, the owner of the work has a copyright in that logo. Trademark law serves a different purpose, which is to reduce the likelihood of confusion as to the source of goods and services by protecting those that have established marks that distinguish their goods or services from others. Therefore, the owner of the logo may have both copyright in the logo as well as trademark protection at the same time, each intellectual property protecting serving a different purpose.

Registerability and Protection of Certain Marks

Q: Are there any marks that are “off limits” and I should not think about using?

A: Marks that are currently not registerable include marks that are: (1) Immoral, deceptive, scandalous, or disparaging; (2) flags, coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation; (3) name, portrait, or signature identifying a particular living individual (except with consent), or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any (except with consent by widow); (4) resembles another mark as to be likely to cause confusion, or to cause mistake, or to deceive; (5) is primarily merely a surname; (6) is merely descriptive or descriptively misdescriptive; or (7) is generic. The inability to register a mark does not forbid the owner to still use the mark in connection with the sale of goods or services, but whether that mark owner will be able to enforce the mark is less clear. At least one district court has held that the United States Patent and Trademark Office’s refusal of a trademark application signals that trademark protection to that mark is unsuitable and not protectable.

Use of Trademarks

Q: Trademark protection requires the use of the trademark. How much “use” of the mark do I need to do for it to be sufficient enough to be considered “use” of the mark?

A: United States trademark law states that “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. Therefore, if placing the mark on or with the goods and the goods are sold or transported in commerce, then that is sufficient enough use. On the other hand, solely using the mark for internal purposes, such as internal company memos, is probably not enough “use” to be considered sufficient enough use.

Q: If the phrase I want to use as a trademark is already in use by someone else, can I still use it?

A: It depends. If your use of the trademark phrase is likely to cause confusion in the relevant market place, then most likely you should not. If however, the use of the trademark phrase is used in a completely different field, then it is more likely that the use of that phrase is acceptable. For example, Delta[®] Airlines and Delta faucets or Lexus[®] (automobile) and LexisNexis[®] (legal research) are allowed to co-exist since the consumer can distinguish between the two marks.

Q: If I don’t want to register my logo yet and I want to use the “TM” symbol instead, what do I need to do to use the “TM”?

A: For common law use (non-registered) of a mark as a trademark, you can start using the “TM” in connection with your goods or services in commerce right away. However, keep in mind that if your use of your logo causes likelihood of confusion as to the source of the goods or services, you may be liable to someone who started to use the logo before you did. Therefore, it would be good practice to do a search of the potential marks you want to use to see if that particular (or similar) mark is in use by others already.

Q: If I decide to protect my logo through the common law use of “TM”, will I be able to enforce that anywhere in the United States?

A: The common law use (non-registered) of a mark as a trademark by using the “TM” gives the mark owner priority but only in the geographic area in which the mark is actually used. For example, if you sell educational products under a certain logo only in Texas and another individual sells educational products under the same logo in Maine, then each owns the rights to use the mark in their respective markets and have priority over the other. If the Maine seller then registers that logo, that Maine seller has priority in the United States *except* in Texas. However, geographic limitations are as big of an issue these days due to national marketing strategies via the internet and other digital means.

Registration and Use of Trademarks at UTHealth

Q: I am interested in registering a logo that our department is currently using for a product that is commercialized by the University. What next?

A: Important factors involved in deciding whether or not to register your logo are whether you plan on using the logo for a long time or whether it is a short term use, cost, and plans on modification. If you plan on using the logo for a short time then it may not be worth registering the logo. On the other hand, if you plan on using it long term then registration may be worth doing. Furthermore, costs should be taken into consideration when making this decision. An initial search can run \$500-\$700; a full search can range \$2,000-\$3,000. Additional costs of \$3,000-\$5,000 for filing per class and attorney’s fees for the initial filing of \$1,600. There are also costs to continuing to maintain the mark. Finally, if you plan on modifying the logo in the future, it may be worth it to wait until you come up with the final version of the logo; otherwise, once you file and obtain federal registration protection of your logo, it may not apply to your new version. If you decide to go forward with the registration process, the University will need you to provide, among other things, an account number for billing of services, artwork of the mark, description of the goods/ services in which the mark will be used, exhibits of use in commerce and date of first use in commerce.

Q: Registration seems too much work and I don’t have the funds to pay for registration. What else can I do instead?

A: An alternative option would be to start using the logo and place a “TM” next to your mark to indicate that the University is claiming trademark rights in that logo. However, it would be good practice to do a search of potential marks you want to use to see if that particular (or similar) mark is in use by others already so as to reduce likelihood of potential infringement of another’s trademark.

Q: Can I create my own logo to use for our school program or department?

A: Per the Handbook of Operating Procedures (HOOP) policy number 116, no independent logos or images are allowed to represent schools, departments or entities of the institution unless prior written approval is obtained from Institutional Advancement.

Q: As the head of a department, I want to hold an event in which I would use the name, logo, or seal of The University of Texas Health Science Center at Houston on the flyers as well as have merchandise created for this event. Can I go ahead and do so or do I need to get approval? If I don’t like how the logo looks, can I modify it slightly?

A: Per HOOP policy number 8, the name, logo, and seal of the University are registered trademarks and cannot be used unless authorized. Employees, departments, schools, centers or student organizations representing the University in an official capacity and University sponsored organizations are authorized, upon appropriate approvals, to use the name and logo in any activity that is directly in support of the University’s mission areas of teaching, research, patient care, or community service. This applies to merchandise created by faculty, students and staff for use in promotional activities as well as to organization who create or commission the production of merchandise used to promote mutual organizational and institutional goals. However, you may not alter a mark. Contact the Office of Public Affairs for more information at 713-500-3045.