

**Defining Your Trademark:
Cover The World or Not?
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You're about to launch your new product or service. You've spent months, and maybe even years developing the product, researching the market, developing software if appropriate and lots of other research items. Now the really hard part begins... selecting a trademark name and defining your goods and services.

Determining a name is difficult enough and, many times, a trademark owner will think that is the most difficult part. After all, we know what our product does, don't we? Therefore defining the goods or services for the trademark should be an easy task.

Not necessarily so.

In considering the definition of your goods and services there are a number of strategic decisions one must reach. For example, what is it that our product is now designed to do? What is it that our product is going to do in the future? Where is the company going in the future? All of these can factor into how you define the good. This becomes critically important since over time, there maybe other entrants into the same field as your goods and services are, and these other entrants may have trademarks that are similar to yours.

It is axiomatic that you do not want to have other competitors using trademarks that are similar to your trademarks since the competitors may, in fact, be attempting to build off the goodwill that you have spent millions of dollars in establishing. In such a case, you might think that a very broad definition of your goods and services would be required. However, it's important to note that a broad definition of goods and services may cover a number of market channels. You may be operating on only one or two of the market channels that are covered by the trademark as you have defined it. If a latecomer arrives with a mark that is similar to yours and is primarily operating in one of the trade channels in which you are not operating, that trademark may be able to exist in a channel in which you are not now offering your goods and services.

Why is this important?

This is important since, in order to knock out a newcomer having a similar mark, it is necessary for you to oppose the registration of that new mark. In so doing, the primary inquiry regarding the mark to be opposed is "What is the actual definition of the goods or services in the trademark application that is being opposed?" Thus, it is not important to the trademark office precisely what the applicant (whose mark you are opposing) is actually doing, but rather what does that applicant say.

If the definition of goods and services is very broad, even though the applicant is operating in narrow channels of commerce, the broadness of the definition of terms is what will be argued in any appeal before the Trademark Trial and Appeals Board. Of course, if you are the applicant whose mark is being opposed, you will have a better chance of surviving any opposition if your definition of goods and services is relatively narrow and you were the first to use the mark in the channel of commerce named.

Thus, you will be able to argue to the Trademark Trial and Appeals Board that the narrow definition of goods and services prevents any potential confusion in the minds of consumers.

If, on the other hand, your definition of goods and services in your application is very broad, a corporation whose goods and services may overlap with your definition might possibly prevail in an opposition if they had been using their mark from a time prior to your actual use of your mark.

Have I confused you?

Well, the moral of this particular story is to look carefully at how you define goods and services in your trademark application. If you define them narrowly, another company may move in with a similar mark and in channels of commerce in which you are now operating. If you define your mark broadly, you might not be able to oppose someone else's mark since you might not be able to show confusion in the mind of consumers in channels of commerce in which you are now not operating. However, if you do define broadly, it behooves you as a business to begin marketing in the various potential channels of commerce defined by your trademark definition as soon as possible. This will give you the maximum leverage against the bad guys who are trying to profit from your good name.

Call us. We can answer any questions you may have.

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