

## INTERACTIVE TRADEMARKS 2.0:

### *Selection, Clearance & Registration*

By William E. Maguire



*William E. Maguire has been a member of the California Bar since 1981, has an LL.M degree in Intellectual Property, and was previously Senior Counsel for Malibu Comics Entertainment, Inc., a subsidiary of Marvel Entertainment Group, Inc. He is currently in private practice in West Los Angeles where he concentrates on trademark, copyright, and licensing matters, and represents clients in the entertainment, publishing, multimedia, toy, sporting goods, restaurant, and garment industries. Phone (310)470-2929; Fax (310)474-4710; E-Mail: maguire@artnet.net Website: www.TrademarkEsq.com*

### INTRODUCTION

Interactive Trademarks and the corresponding jargon have evolved significantly since the 1990s. Consider such terms as “edutainment” or “superhighway” which were once in vogue. Today’s buzz words now include “Web 2.0,” “shopcasting,” “wiki,” and “mobile tv,” among many others.

The purpose of this article is to introduce the reader to the fundamental aspects of trademark law, particularly with respect to such well known interactive trademarks as SONY, NINTENDO, EA SPORTS, and EIDOS. Each of these marks readily identify the products that have made them well known. Yet, these types of interactive trademarks are also merchandised for ancillary products such as t-shirts, hats, gear bags, comic books, posters, among other products. In addition, these marks can be spun off as feature films or animated cartoon series which may in turn be registrable as service marks.

### TRADEMARKS DEFINED

A trademark is defined as any word, symbol, slogan, or device (such as a design), or a combination of them, used by a manufacturer or merchant to identify his goods or services and to distinguish them from those manufactured, sold, or serviced by others. GAMEPRO® magazine or a SONY® video game are excellent examples of trademarks. In the United States, trade-

An example of a service mark is U2 for entertainment services in the nature of a musical band. The mark U2 can also be exploited and serve as a trademark (i.e., for clothes (t-shirts, hats, sweatshirts); records, compact discs, DVDs, audiotapes, and videotapes; fanny packs; and jewelry). Another example of an entertainment service mark is EA SPORTS NATION® which is registered for “Entertainment services, namely, providing an on-line computer game; online entertainment in the nature of tournaments and fantasy sports league, et al.” A suitable specimen of service mark usage would include featuring the mark online at the website that hosts the registered services and which identifies the services offered, as set forth above.

### SELECTION AND CLEARANCE

The selection of a trademark should be the first step that a manufacturer or merchant undertakes to create an identity for its product. The clearance of a service mark or trademark (collectively, the mark) is the process of determining whether or not the mark is available and is not being used by someone else as a mark. This clearance process cannot be overemphasized in its importance. Ignoring this vital step can lead to a multitude of problems and expense. In the clearance of a mark, a two-step process is suggested. The first step is to conduct an on-line computer trademark search of the mark. This on-line search is further

clarified by identifying the goods sought to be used or sold as trademarks which are categorized by classification. In the United States, the federal government has adopted the International Classification system. Toys, sporting goods, and arcade games are in Class #28. Shirts and related apparel and clothing are in Class #25. Backpacks, fanny packs, and gear bags are in Class #18. Posters, magazines, comic books, trading cards, and other printed matter and publications are in Class #16. Jewelry is in

Class #14. Videotapes, audiotapes, compact discs, DVDs, CD-ROMs, records, video game programs (including downloadable software over a global computer network), computer programs, and business software are in Class #9. Therefore, if you are plan-

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mark rights are acquired through use (e.g., by selling your product in commerce with the mark attached or on a label). Registration of one’s trademark or service mark greatly enhances the rights of enforceability, as will be discussed herein.

ning to sell software or video games, posters, and apparel and to post entertainment content online, then you will want to conduct an on-line search of Classes # 9, 16, 25, and 41. The on-line search is often called a “knock-out” search. This is because the on-line search is a quick and relatively inexpensive way to determine if the mark is already being used.

If your mark appears free of conflicts after conducting an on-line search, the next level of search is the full search, which is obtained from commercial search firms. The full search will search the federal database of trademarks at the United States Patent and Trademark Office (USPTO), state trademark registrations, common law sources such as phone directories and Dun & Bradstreet listings, plus internet domain name registrations and world wide web search results.

If your mark still appears clear of conflicts after a full search, then you can be fairly certain that you can adopt and start using your mark. CAVEAT: These searches are not guarantees of the absence of conflicting marks, but they do allow you to make a more informed decision in the clearance of a mark.

### FEDERAL TRADEMARK REGISTRATION

To obtain maximum protection, it is best to register your trademark or service mark. In the United States, your greatest rights can be obtained with a federal trademark registration. If you are only conducting business within one state, e.g., California, it is possible to register your mark with the California Secretary of State. However, if it is your intent to do business across state lines or in foreign commerce (or if you are already doing business across state lines or in foreign commerce), then the prudent thing to do is to file a federal trademark or service mark application with the USPTO located in Alexandria, Virginia.

An application for registration of a federal trademark or service mark with the USPTO must be filed in the name of the owner of the mark. The applicant must submit: (a) a written application, (b) a drawing of the mark, and (c) the required filing fee (which is \$325 per mark per class at this time). The applicant will also incur attorney’s fees, typically a fixed fee, should an attorney be hired to file the application(s). As previously discussed, trademarks registered with the federal government are categorized by a classification system which correspond to the type of goods or services sought to be registered. The United States, as with many other countries, uses the International Classification (hereinafter, “Class”) system. For instance, the SONY® and EA SPORTS® entertainment service marks fall within Class #41; U2® and NIKE® for clothing are in Class #25; ATLANTIC® and INTERSCOPE® records and compact discs and DVDs are in Class #9, as are MICROSOFT® computer programs or business software and BASF® audio tapes. Likewise, XBOX®, EIDOS®, and NINTENDO® video games (or computer game programs) fall within Class #9; GAME-PRO® and ROLLING STONE® magazines and SUPER-MAN® comic books are in Class #16 for publications.

After the mark is registered in the United States, it is important to give notice of this fact by placing the registered trademark symbol, “®,” adjacent to the mark. Prior to registration, it is also advisable to use the symbols, “TM” (for trademarks) and “SM” (for service marks).

The chief advantages of a United States federal registration include:

1. “Constructive Notice” nationwide of the registrant’s claim to ownership of the mark. This basically eliminates the good faith defense of an infringer who claims to have lacked actual knowledge of the registered mark.
2. Registration is also evidence of (a) the validity of the registration, (b) the registrant’s ownership of the mark, and (c) the registrant’s exclusive right to use the mark in commerce in connection with the goods or services.
3. Registration also entitles the registrant to (a) file a lawsuit for infringement of the mark in federal court, (b) prevent importation of goods bearing an infringing mark, and (c) use the registration as a basis for registering the same mark in certain foreign countries.

Federal trademark registrations are valid for 10 years, subject to certain use and filing requirements, and are renewable every 10 years, also subject to continued use and renewal filing requirements.

### FOREIGN TRADEMARK REGISTRATION

If your product is distributed internationally, then you must, by and large, register your mark(s) in each country where you plan to do business or are doing business. Is this expensive? Yes! On the other hand, the alternative is the potential loss of the ability to sell your product in those countries where a third party has filed a prior application for your mark(s). Therefore, foreign trademark protection is typically obtained on a country-by-country basis. Unlike the United States, however, trademark rights in many foreign countries are obtained by registration rather than use. This further necessitates the importance of filing for marks in foreign countries as soon as possible.

One notable alternative to the typical practice of registering trademarks on a county-by-country basis is the European Community Trade Mark Application which has been available since January 1, 1996 for the filing of applications. By obtaining a European Community-wide trademark registration, an owner of a United States registered trademark, for example, can potentially save both time and money otherwise invested in registering a mark in each separate European country and can thus hopefully attain maximum protection for its trademarks in overseas markets at a minimum of cost. An additional and separate registration option is that offered by the Madrid Protocol, an international treaty that the United States belongs to and enforces. The details of this treaty, however, are beyond the scope of this article.

### CONCLUSION

Whenever you are selling products or services, it is very important to be aware of your trademark or service mark and its value. In a competitive business environment, the potential for economic loss is tremendous if trademark rights are not acquired, evaluated, protected, and maximized. While this article does not portend to cover all the intricacies of trademark law, hopefully it has helped to shed some light on this area of the law which should be of paramount importance to anyone involved in the development and marketing of multimedia or interactive products or services.