

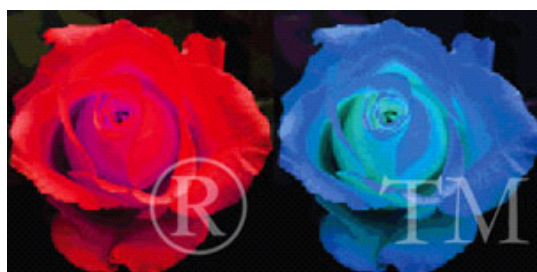
# GROWERTALKS

## Features

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### A Plant by Any Name is Not the Same

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The 2011 California Spring Trials generated an amazing array of plant varieties, as well as a number of creative and catchy trademarks. One dominant theme at all of the trial sites was that more companies are using trademarks to help their products stand out from the pack. However, it was also clear that there's a wide range of ways companies are using trademarks.

#### What is a trademark?

A trademark is a word, symbol, sound or device which serves to indicate the source of plants, fruit or other products or services. United States trademark law is based upon the Lanham Trademark Act of 1947, which provides the owner of a trademark the right to prevent others from using the same or a confusingly similar mark for the same or similar goods or services. It's important to note that a trademark is not the same thing as a patent or copyright. A patent affords protection in an invention, while a copyright affords protection to literary and artistic work on a permanent medium.

#### Why should I care about trademarks?

The horticultural marketplace is becoming increasingly more competitive each year, so the ability for a consumer to differentiate where a plant, fruit or other plant product is coming from is critical. The use of trademarks is a simple means for a business to develop, market and sell a single product, or a series of products, and allow a consumer to identify and know where a particular product or service is coming from. A good and recognizable trademark can allow a consumer to distinguish the quality of similar goods while allowing a business to gain an advantage over businesses with similar products or services.

#### Selecting the right trademark

Choosing the right trademark can be a tricky proposition; however, there are a couple of key things to think about:

1. Choose an arbitrary or coined mark. The most successful trademarks tend to be marks that are coined, completely random or arbitrary from the products or services that they're associated. Some of the most famous trademarks, such as Apple, Coca-Cola, Google, or Xerox bear no relation to the products or services they will be used with (i.e., the mark is not descriptive of the goods or services). In general, the more random

a mark is to the goods or the services, the stronger the mark tends to be.

2. Avoid consumer confusion. It's always important to remember that a trademark is used to differentiate a product from others on the marketplace. Therefore, it's important to choose a trademark that doesn't create confusion for the consumer as to where the product or service is originating. In order to avoid consumer confusion, stay away from trademarks that look or sound similar to other marks that are used on similar products or services and formally clear a proposed mark before proceeding with use.

3. Avoid geographical origins marks. Choose a trademark that doesn't describe the geographical origin of a product or service. Example: If you're producing plants in the Monterey area and the area is known for producing plants, it may be difficult to enforce the word Monterey as a trademark. The idea is that if other nurseries in the Monterey area need to use the name Monterey to describe where their plants are from, then one company should not be allowed to own that mark.

4. Evaluate foreign words. Foreign words should be translated and evaluated in their English context. For example, using "Bianco," which means white in Italian, to describe a series of white flowering plants may be a difficult trademark to enforce because of the descriptive nature of the mark.

The difference between a trademark and varietal name

In the plant and fruit industry, a trademark is intended to identify the source of the plant or fruit variety and not the plant or fruit variety itself. In other words, if a company has a word that they would like to use as a trademark, refrain from using the word as the varietal/cultivar name of the plant in any publications or brochures, and even patent or Plant Breeders Rights applications. Doing so prevents the possibility of your trademark from becoming part of the public domain and losing the enforceability of a good mark.

Consequently, the use of nonsensical or code names for plants in plant patents is increasingly gaining popularity. There has been much debate as to whether the practice of using nonsensical names for a cultivar denomination violates the entire purpose of the International Code of Nomenclature for Cultivated Plants 2009. (It's respectfully noted that the International Code of Nomenclature for Cultivated Plants 2009 is not a legal document and simply provides guidance for naming plants.)

## Getting a trademark

Once you've decided on the mark that you want to file, the general process for filing a U.S. trademark is as follows:

1. Application requirements. You'll need to provide the owner's (or applicant's) information, the name and address for the correspondence, a "drawing" or depiction of the mark, the international class of goods and services, the application filing fee, the basis for filing, the specimen for use-based applications, and a signature.

2. The trademark must be put to use in commerce. The basis for filing a trademark application is a key requirement. For U.S.-based applications, there are two types: (1) a mark is in current use in commerce; or (2) an "intent to use" the mark in commerce by the owner or the applicant. In the U.S. to get a trademark registered, the trademark must be used in interstate commerce. However, the U.S. provides the option of applying for a trademark application before commencing use of the mark through the use of the "intent to use"

application. Once an “intent to use” application receives a Notice of Allowance, the applicant has six months to provide a “Statement of Use” showing use of the mark in interstate commerce, although extensions of time are possible.

3. Post-filing actions. After the trademark application has been filed, it will be reviewed by an examining attorney who may issue an Office Action listing reasons for refusal of the mark. An applicant then has six months to respond to the Office Action. When all of the issues for refusal have been resolved, the examining attorney approves the application for publication in the Official Gazette. There is a 30-day period that the public may oppose registration of the mark. If there is no opposition, your mark will register if you filed with current use in commerce, or receive a Notice of Allowance if you filed as an “intent to use.”

## How long is a trademark valid?

In the U.S., a trademark can be valid indefinitely as long as you continue using your trademark in commerce and file the necessary maintenance documents thereafter. Therefore, once your trademark is registered, it's important to document all future renewal dates so that your trademark registration doesn't lapse.

Does a U.S. trademark provide protection in other countries?

Having a U.S. registered trademark doesn't mean that the mark is also registered outside the U.S. If you're interested in pursuing registrations outside the U.S., the U.S. registration may be used as a basis under the Madrid Protocol. The Madrid Protocol is an international system coordinated by the World Intellectual Property Organization (WIPO), whereby an applicant can file one trademark application in many different countries. The fees depend on which countries and the number selected. Not all countries, such as Canada and Mexico, are members of the Madrid Protocol. In these cases, a trademark application will need to be filed directly in the specific country, although it may be possible to claim priority to a prior U.S. registration.

## Using a trademark correctly

Your trademark rights commence with your use in commerce, so it's very important that you correctly use either the TM or ® symbol in association with your trademark. The use of the TM symbol indicates a company is claiming ownership of a trademark, while the use of the ® symbol indicates that the trademark has been registered with the U.S. Patent and Trademark Office or another international trademark authority. The TM and ® should be used anywhere the trademark appears including, but not limited to: labels, tags, containers, invoices, catalogs and websites. It's important not to use single quotes around a trademark, as the use of single quotes is used to indicate a varietal or a cultivar name. Lastly, a company should strongly consider seeking protection of the trademark in the countries where the plant, fruit or service will be used.

Trademarks are becoming increasingly important in the intellectual property portfolios and marketing strategies of companies. As long as proper use and maintenance of a trademark is made a priority by a trademark owner, trademarks will continue to offer new possibilities for marketers and commercialization schemes that lead to more specialized products and higher profit margins for all levels of the supply chain.

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*Media Department of Holme Roberts & Owens LLP in Denver, Colorado. They have more than 10 years of experience in prosecuting horticultural and biotechnology-based patents, plant patents, United States Plant Variety Protection, plant breeders rights and trademarks in North America, Europe, Africa, South America, Asia and Australia, as well as working on import/export, plant quarantine, seed registration and Federal Seed Act issues.*