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TRADEMARK REGISTERS

Trademark registration is an important aspect of protecting intellectual property rights. All trademark registrations must be filed with and approved by the United States Patent and Trademark Office (“USPTO”) to be put on one of two registers, the Principal Register or the Supplemental Register. The registers hold different levels of legal protections for trademarks, which is important for anyone who is considering filing a trademark registration application. This article explains the key distinctions between the two registers.

To begin, we will focus on the Principal Register. The Principal Register is home to trade names which are considered fanciful, arbitrary, or suggestive. These categories of trademarks are considered unique and do not simply describe the goods or services to which they are attached. Fanciful marks use essentially made-up words. A good example is the consulting company “Accenture.” The word “accenture” did not exist until it was used as a trade name for this company, which makes it fanciful. Arbitrary words or phrases are words which have no rational connection to the product associated with them. The movie review website “Rotten Tomatoes” is an example of an arbitrary mark because movies and rotten tomatoes are not necessarily connected to each other. Suggestive marks are actual words that convey an idea or concept of the product or service but do not describe it precisely. The rideshare company “Lyft” is an example of a suggestive mark. It suggests to consumers that they may be able to purchase a ride or “lift” somewhere when using this company without that fact being directly communicated through the trade name. All of these types of abstract trade names can be found on the Principal Register.

The Supplemental Register, on the other hand, protects trademarks that are descriptive of the business or entity that is applying for trademark protection. Trademarks that merely describe a service are often placed on the Supplement Register. For example, a restaurant called “Bob’s Hamburger Restaurant” that serves hamburgers and is owned by someone named Bob would likely be considered a descriptive trademark, and thus likely to be placed on the Supplement Register. Descriptive

trademarks are almost always placed on the Supplemental Register because they are not considered unique.

Each register has a different level of protection guaranteed to each trademark. While marks on the Principal Register are afforded substantial protection, trademarks that land on the Supplemental Register still receive a lesser protection. Below is a table comparing the key distinctions between the Principal and Supplemental Registers.

PRINCIPAL REGISTER	SUPPLEMENTAL REGISTER
Enjoys prima facie presumption of exclusive ownership in relation to product or service.	No presumption of ownership in an infringement situation. Owner must prove sufficient use of the trademark such that the owner has acquired enforceable common law trademark rights in a relevant geographic area.
Exclusive national protection to use the trademark in connection with the good or service.	No national protection. Owner must prove sufficient use of the trademark such that the owner has acquired enforceable common law trademark rights in a relevant geographic area.
Right to use the ® symbol.	Right to use the ® symbol.
Deters the registration of subsequent marks likely to cause confusion with the registered trademark.	Deters the registration of subsequent marks likely to cause confusion with the registered trademark.
Registration opens the door to protection in other countries through certain treaties.	Registration opens the door to protection in other countries through certain treaties.
Registration may be used as basis for infringement lawsuit.	Registration may be used as basis for infringement lawsuit.
After 5 years of use in commerce, the trademark can become incontestable	Cannot become incontestable after 5 years unless the trademark is transferred on to the Principal Register by acquiring a “secondary” or “distinctive” meaning. More on this below.

A trademark on the Supplemental Register can be moved up to the Principal Register if, after 5 year the trademark acquires a distinctive meaning apart from its descriptive nature. An example of this would be “Best Buy.” Best Buy has a literal

descriptive meaning, but the name, through repeated advertising and longevity, now also has acquired a distinctive meaning associated with being an electronic product retail store.

When considering submitting a trademark application, it is important to think about the protections that each register provides. Depending on the protections that are important to your business, you should aim to create a trademark that allows for registration on the register that best meets your protection needs.