

Principal and Supplemental Trademark Registrations

What are Principal and Supplemental Trademark Registrations?

The United States Patent and Trademark Office has two sections of the Federal Trademark Register: the Principal Register and the Supplemental Register. Most marks are registered on the Principal Register. The Supplemental Register is reserved for non-distinctive marks (merely descriptive and do not have a design element) that are capable of acquiring distinctiveness (i.e. “secondary meaning”), but have not yet done so.

What is secondary meaning?

Secondary meaning, which is also referred to as “acquired distinctiveness,” attaches when a non-distinctive mark becomes known to consumers as a designation of source for particular products or services due to the mark’s long-term and extensive use. The exact amount of use needed to prove secondary meaning varies according to each mark’s level of descriptiveness, but a presumption of secondary meaning arises after five years of substantially continuous and exclusive use of a trademark in commerce.

What types of marks are registered on the Supplemental Register?

Marks registrable on the Supplemental Register include:

- *descriptive marks that are capable of acquiring distinctiveness,
- *surnames,
- *geographic terms, and
- *non-distinctive, nonfunctional trade dress.

What rights are provided by registering a mark on the Supplemental Register?

A registration on the Supplemental Register grants its owner the right to use the registered ® symbol when the mark is used with the products or services listed in the registration. A registration on the Supplemental Register will also block later-filed applications for confusingly similar marks for related goods. The Supplemental Register is like a waiting area. A mark registered on the Supplemental Register is waiting for five years until it has acquired secondary meaning as a trademark. In most cases, the USPTO will assume that a mark has acquired secondary meaning after five years of use in the U.S. Secondary meaning can also be shown by the owner investing enough money or having enough sales or market share to convince the USPTO that it has acquired secondary meaning, but this is a difficult thing to do. All descriptive marks must go on the Supplemental Register unless they can show secondary meaning.

How does a registration on the Supplemental Register differ from a registration on the Principal Register?

A registration on the Supplemental Register does not provide all the protections of a registration on the Principal Register. For example, a Supplemental Registration does not convey the presumptions of validity, ownership and exclusive rights to use the mark that attach with a registration on the Principal Register. A Supplemental Registration cannot be used to stop importation of counterfeit products. Also, a Supplemental Registration can never become incontestable. The Principal Register provides the best legal protection because, once registered there, a mark is deemed to be “fully protected.” If someone disputes the trademark owner’s rights, the other person must prove that the mark is invalid, for example, because it is descriptive, or functional, or for some other reason permitted by the law. But the USPTO or US Federal Court will assume at the beginning that the trademark is valid, and if the other party can’t prove that your mark is invalid, then it remains valid and you win on that point (which is normally a very important point in a trademark dispute).

How and why does one obtain a registration on the Supplemental Register?

One may file an application seeking registration on the Supplemental Register, if for example, one is certain the USPTO will view its mark as descriptive. More often, however, the Patent and Trademark Office rejects an application for the Principal Register and gives its owner the option to amend the application to the Supplemental Register. A trademark must actually be used in commerce at the time the applicant seeks registration on the Supplemental Register; trademarks not in use may not be registered.

The main benefit of the Supplemental Register is that no one else can register a confusingly similar mark on the Principal Register or the Supplemental Register. So registering a mark on the Supplemental Register “holds a place” while your mark acquires distinctiveness. You can start using a descriptive mark in the U.S. without a Supplemental Register registration, but then someone else might register a mark on the Principal Register and you would have to try to oppose or cancel that mark. If your mark is on the Supplemental Register, then the trademark examiner at the USPTO will see your mark and will block any other marks from being registered on either the Supplemental Register or the Principal Register. A benefit of the Supplemental Register is that there is no Publication for Opposition phase. If the mark is accepted, then it is immediately registered. No one will notice the mark in the publication stage because it is not published before registration on the Supplemental Register. This can help your mark remain unnoticed while you are starting to build market awareness (i.e., secondary meaning). When you apply again after

five years to register the mark on the Principal Register, then the mark would be Published for Opposition and others would have a chance to try to block your registration.

A benefit of the Supplemental Register is that it gives you the legal right to use the ® symbol on your trademark, which is only permitted for registered marks (on either the Supplemental Register or Principal Register). This may have the effect of discouraging some people from using a mark that is similar to yours, even during the time when the USPTO still considers it to be a descriptive mark.

A disadvantage of the Supplemental Register is that you must actually be using the mark in commerce before it can become registered. There is no “Intent to Use” status on the Supplemental Register.

If you need to sue for trademark infringement, having a mark on the Supplemental Register is not as helpful as the Principal Register because during the lawsuit you must prove that your mark has acquired secondary meaning as a trademark (as noted above). Otherwise, if your mark is still just considered a descriptive mark, then the court won’t protect it, because descriptive words have to be left available for others to use.

Can one oppose registration of an application for the Supplemental Register?

No. Applications for registration on the Supplemental Register are not published for third party opposition, unlike applications for registration on the Principal Register. If a third party objects to an application for the Supplemental Register, it must seek to cancel the registration after it issues.

Can a Supplemental Registration be converted to a Principal Registration?

No. A Supplemental Registration cannot be converted into a Principal Registration. Instead, the owner of the Supplemental Registration can file a new application for a Principal Registration of the mark. If the trademark owner has used the mark sufficiently that it has acquired secondary meaning, the mark will be granted a Principal Registration, with all the protections it affords.

What if I register a design mark on the Principal Register when all the words in the mark are disclaimed as descriptive? The benefit of registering a design mark (logo) on the Principal Register with all the (descriptive) text disclaimed is this: the text is protected to the same degree that it would be protected on the Supplemental Register, but the design is protected fully on the Principal Register. And the entire mark is on the Principal Register, which “looks better.” That is a small thing,

perhaps, but it is something. I wouldn't want to rely on the ignorance of others regarding the meaning of the disclaimer, but that could also occur, so that they might assume your entire mark is protected. Many American business people search the database of the USPTO, but few of them understand what is actually protected when they read the details on a trademark registration. As with the Supplemental Register, it would be necessary to file a new application after five years (or sooner if the owner has worked to acquire secondary meaning through advertising campaigns, etc.), so that the words were not disclaimed as descriptive in the new application.