

## Why Consider the Supplemental Register?

One of the more confusing aspects of a trademark registration in the United States is the opportunity to register on not one but two different registers - the Principle Register and the Supplemental Register. The Principle Register is the preferred registration for US trademarks because it confers many more substantial benefits than does the Supplemental. However, a mark registered on the Principle Register must meet a more rigorous standard of review and the mark cannot be descriptive of any features of the subject goods or services.

Still, registration on the Supplemental Register does confer benefits otherwise unavailable to unregistered marks, namely : (1) the ability to use the federal registration “®” symbol next to the trademark; (2) the ability for the United States Patent and Trademark Office (USPTO) to cite registration against another’s later application to register a substantially similar mark; (3) provision of notice (but not constructive notice) to third parties that the registrant has established rights to the mark and plans to continue using them; and (4) the ability to bring suits for infringement of the mark in federal court. In addition, marks used on the Supplemental Register are not subject to opposition and therefore, the threat of challenge is minimized.

But the most important benefit to registration on the Supplemental Register may be the use of such a registration as a major stepping stone towards registration on the Principle Register (in a very real sense, the Holy Grail of US registration). The USPTO considers the continued use of a mark for five years as the basis for registration of the mark on the Principal Register because such use may be deemed to be a showing that the mark has acquired “secondary meaning.”

Consequently, if the mark already exists, is descriptive, and has not acquired secondary meaning, then register on the Supplemental Register. Otherwise, select a mark that can be registered on the Principle Register.

### KEY CONCEPTS

- 1** Select a mark that is arbitrary, fanciful or suggestive, not descriptive.
- 2** Register on the Principle Register if at all possible.
- 3** Be aware of the advantages of registration on the Supplemental Register.
- 4** Don't discount the importance and value of registration on the Supplemental Register
- 5** Convert to the Principle Register after 5 years.

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*“The Supplemental Register is not as advantageous as the Principle Register, but there are important advantages to be considered.”*

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