



BENEFITS AND LIMITATIONS OF THE TRADEMARK SUPPLEMENTAL REGISTRATION

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Registering your trademark is crucial for defending your intellectual property. However, the USPTO will not grant full registration to trademarks that are overly descriptive of the goods or services that the mark represents. These include descriptive marks, which include descriptive terms, last names, geographic locations, and less common types of marks including product designs, trade dress, and sound marks.

Despite this, some descriptive marks can still be afforded a secondary level of trademark registration on the Supplemental Register. While the protections are not the same as full registration on the Principal Register, there are still valuable benefits to registration on the Supplemental Register.

When Does the Supplemental Register Come into Play?

To be eligible for the Principal Register, a trademark must be distinctive, which requires that the mark is a unique indicator of its source of goods and/or services. Distinctiveness helps consumers avoid confusion about who provides a product or service. Distinctive marks include the following:

- **Fanciful marks:** Made-up words (e.g., *Xeljanz* for medication, *Exxon* for oil and gas, *Verizon* for telecommunications).
- **Arbitrary marks:** Real words with no connection to the product (e.g., *Apple* for computers, *Camel* for cigarettes, *Amazon* for online retail).
- **Suggestive marks:** Hints at the product's qualities without directly describing them (e.g., *Jaguar* for cars, *KitchenAid* for kitchen products).

However, a mark that directly describes a characteristic, quality, purpose, or feature of a product or service is considered “merely descriptive” and is not eligible for the Principal Register. Examples of descriptive marks might be “creamy” for yogurt products or “fast” for bikes.

Descriptive marks will typically be rejected by the USPTO. However, if the mark is in use and the mark is not overly descriptive, the USPTO will offer to allow the applicant to amend the application to the Supplemental Register. If you do not believe you can overcome a descriptiveness refusal, then the Supplemental Register may be the right choice. Then, after five years of continued use, you can re-file for registration on the Principal Register.

Benefits to Supplemental Registration

Registration on the Supplemental Register has several immediate benefits:

- Allows use of the federal registration ® symbol with your mark, which may enhance your reputation and credibility of the mark.
- Provides the ability to sue for trademark infringement in federal court and to seek certain remedies, such as injunctions, damages, and attorney's fees.
- Provides the basis to register your mark in foreign countries, such as through the Madrid Protocol or the Paris Convention, that recognize the Supplemental Register, which may expand your international reach and protection.
- Provides the opportunity to later apply for registration on the Principal Register, as mentioned above, if you can show that your mark has acquired distinctiveness through continuous use in commerce for at least five (5) years.





Limitations of the Supplemental Register

Registering your trademark on the Supplemental Register is better for your business than not having a registration at all, especially if your mark is not eligible for the Principal Register. However, you should also be aware of the limitations and disadvantages of the Supplemental Register:

- No presumption of validity, ownership, and exclusivity of your mark, which means although you are in fact the owner of the mark, you still need to prove these elements in court if you sue for infringement or defend against a cancellation.
- No benefit of constructive notice and nationwide priority of your mark, which means that you may have to prove your actual use of your mark and reputation in each geographic area where you seek to enforce your rights as others can independently file a trademark similar to yours.
- No ability to prevent the importation of infringing goods by recording your mark with the U.S. Customs and Border Protection.
- You cannot obtain incontestability status of your mark, which is only available for principal registrations upon renewal, which means that your mark may be challenged on various grounds, including descriptiveness, genericness, or functionality (trademark law prohibits functional product features from serving as a trademark).

How Roetzel Will Help

Attorneys at Roetzel have assisted numerous brands with obtaining trademark registration and placing their marks on both the Principal Register and the Supplemental Register. Please reach out to your attorney at Roetzel & Andress if you are interested in obtaining a trademark registration or have any questions relating to your IP needs.

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