Trademark basics: Protection in the United States

Craig Morris
Managing Attorney, Trademarks Customer Outreach

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Discussion topics

• Definitions and types of marks
• Benefits of federal registration
• Selecting a mark
• Filing and registration
• How to find help
Definitions and types of marks
What is a trademark?

Any word, symbol, design, or combination of those that:

• Identifies the source of goods and

• Distinguishes them from the goods of another party
Definitions

• Trademark
  – Indicates the source of goods or products.

• Service mark
  – Indicates the source of services.
Indicator symbols

• Trademark
  – TM ®

• Service mark
  – SM ®
Definitions

• Patent
  – Protects an invention.

• Copyright
  – Protects an original artistic or literary creation.

• Trade secret
  – Protects information that has value because it is not generally known.
Traditional types of marks

Word mark (or slogan)
COCA-COLA
IT’S THE REAL THING

Composite mark

Stylized mark

Design mark
Non-traditional types of marks

Anything that functions as a source identifier might be eligible for registration.

- Sound
- Color
- Scent/smell

- Motion
- Hologram
- Configuration/shape
Different purposes, different results

- Domain name $\neq$ trademark registration
- Business name $\neq$ trademark registration
Domain name vs. trademark use

TODAY'S RATES

15 YR FIXED
2.054%
(Rate & APR)
Get Quote

https://lowrates.com/
Business name vs. trademark use
Discussion topics

Benefits of federal registration
Trademark rights

• Rights can be created two ways:
  – Common law
  – Federal registration
Common law trademark rights

• Rights
  – Created when trademark is used in commerce
  – Limited to geographic area where mark is used

• Symbols
  – Optional: TM  SM
  – Never: ®
Federal registration rights

• Rights
  – Created when trademark registers with the USPTO
  – Legal presumption you own the trademark
  – Legal presumption you have the right to use the trademark in all 50 states and U.S. territories (but not other countries)
Federal registration rights

• Rights
  – Can claim notice to the public of your rights in the trademark.
  – Can bring legal action concerning trademark in federal court.
  – Enables recordation of registration with U.S. Customs and Border Protection.
Federal registration rights

• Rights
  – Can be used as a basis for filing in another country.

• Symbols
  – Permitted: ®
Discussion topics

Selecting a mark
Trademark selection challenges

• Remember:
  – The mission of the USPTO is to register any trademark that is eligible for registration.
  – Not every trademark is registrable.
  – Not every trademark is enforceable.
  – Select a trademark that is both federally registrable and legally protectable.
Registrable and protectable

Two main concepts:
• Likelihood of confusion
• Strength of the trademark
Likelihood of confusion

• Confusion as to source:
  – Are the trademarks confusingly similar?
  and
  – Are the goods and/or services related?
Likelihood of confusion

X-SEED for “agricultural seeds”

EXCEED for “live plants”
Likelihood of confusion

LUPO for “pants”

WOLF for “shirts”
Suggestions for searching

On your own:

• USPTO database
  – TESS (Trademark Electronic Search System)
  – www.uspto.gov/SearchTrademarks

• The internet
  – Option for searching for common law use
Trademark clearance search

Hire a private trademark attorney:

• Full clearance search
  – USPTO database of registrations and applications
  – State trademark databases
  – Business name registries
  – Foreign trademark databases
  – The internet
Strength of trademark

- STRONG
- FANCIFUL/ARBITRARY
- SUGGESTIVE
- DESCRIPTIVE
- GENERIC

STRONG

WEAK
Strength of trademark examples

• Fanciful
  – XEROX for “photocopiers”
  – KODAK for “cameras”

• Arbitrary
  – APPLE for “computers”
  – GAP for “clothing”
Strength of trademark examples

• Suggestive
  – COPPERTONE for “suntan lotion”

• Descriptive
  – CREAMY WHIP for “whipped topping”

• Generic
  – MILK for “dairy-based beverage”
Discussion topics

Filing and registration
Filing for federal registration

• Create a USPTO.gov account.
  – Two-step login process for authentication

• File using the Trademark Electronic Application System (TEAS).
  – Two filing options: TEAS Plus and TEAS Standard
  – www.uspto.gov/TEAS
Filing for federal registration

• Filing fees per TEAS filing option
  – TEAS Plus: $250 per international class
  – TEAS Standard: $350 per international class

• Formula for calculating filing fee
  – Your filing option fee multiplied by the number of international classes in the application
Filing for federal registration

- Mark drawing type
  - Standard character drawing
  - Special form drawing

COCA-COLA
Filing for federal registration

• Identification of goods and services
  – Generally understood terminology
  – Specific terminology
  – Cannot expand “scope” after filing
  – Trademark ID Manual
    • www.uspto.gov/TrademarkID
Filing for federal registration

• Filing basis
  – Required for each listed good or service in your application
  – Most common bases
    • Use in commerce
    • Intent to use
Filing for federal registration

• Common bases for refusal
  – Likelihood of confusion
  – Merely descriptive
  – Geographically descriptive of the origin of the goods/services
  – Specimen does not support use for listed items
  – Trademark used in ornamental manner
Registration responsibilities

• Must enforce your own trademark rights.
• May use your registration certificate to support a “cease-and-desist” letter.
• May use your registration to sue an infringing user.
Post-registration requirements

• Required filings
  – Section 8 declaration of use
    • Due between 5\textsuperscript{th} and 6\textsuperscript{th} years after registration
  – Combined Section 8 declaration of use and Section 9 application for renewal
    • Due between 9\textsuperscript{th} and 10\textsuperscript{th} years after registration
    • Then due every 10 years thereafter
Post-registration requirements

• Optional filing
  – Section 15 claim of incontestability
    • May be filed after five years of continuous use.
Caution: misleading notices

• All application data becomes public information.

• Beware of misleading notices and offers.
  – Usually for fees not required by the USPTO
  – www.uspto.gov/TrademarkSolicitations
Discussion topics

How to find help
USPTO resources

• Website
  – www.uspto.gov

• “Basic Facts About Trademarks” booklet
  – www.uspto.gov/TrademarkBasicsPDF

• Trademark videos
  – www.uspto.gov/TMvideos
USPTO resources

• Law School Clinic Certification Program
  – www.uspto.gov/LawSchoolClinic
USPTO resources

• Trademark Assistance Center
  – Phone: 1-800-786-9199
  – Email: TrademarkAssistanceCenter@uspto.gov
  – Web: www.uspto.gov/TrademarkAssistance
The USPTO does not:

– Provide legal advice.
– Enforce legal rights.
– Recommend specific private attorneys.
Legal resources

• Remember:
  – Best resource might be an experienced trademark attorney.
  – Best resource might not be a trademark filing company.
Legal resources

• Free or reduced-price legal services
  – American Bar Association
    • [https://www.americanbar.org/groups/legal_services/fl_h-home/](https://www.americanbar.org/groups/legal_services/fl_h-home/)
  – International Trademark Association
    • [https://www.inta.org/resources/pro-bono-clearinghouse/](https://www.inta.org/resources/pro-bono-clearinghouse/)
Other resources

• Advice and business consulting
  – Patent and Trademark Resource Centers (PTRCs)
    • www.uspto.gov/PTRC
  – Small Business Development Centers (SBDCs)
    • https://americassbdc.org/
Questions?