

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Trademark basics: Protection in the United States

Craig Morris

Managing Attorney, Trademarks Customer Outreach

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UNITED STATES
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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

Discussion topics

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

Coca-Cola

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

The screenshot shows a web browser with the address bar containing "lowrates.com", which is circled in red. The website header features a logo with a house icon and the text "LowRates.com" and "by Sun West Mortgage Company, Inc. NMLS 3277", both of which are circled in red. The navigation menu includes "Home", "About Us", "Loan Programs", "Resources", and "Talk To Us". A large blue banner displays "TODAY'S RATES". Below this, there are tabs for "Conventional" and "FHA". A central card shows "15 YR FIXED", "2.054%", "(Rate & APR)", and a "Get Quote" button.

Business name vs. trademark use



THE PHILLY POUNDER
Premium Beef Sandwich Steaks



Nutrition Facts

Serving Size 4 oz. (112g)
Servings Per Container 4

Amount Per Serving

Calories 120 Calories from Fat 50

% Daily Value*

Total Fat 6g 9%

Saturated Fat 2.5g 13%

Trans Fat 0g

Cholesterol 45mg 16%

Sodium 180mg 7%

Total Carbohydrate 1g 0%

Dietary Fiber <1g 2%

Sugars 0g

Protein 16g

Vitamin A 0% • Vitamin C 0%

Calcium 0% • Iron 0%

*Percent Daily Values are based on a 2,000 calorie diet. Your daily values may be higher or lower depending on your calorie needs:

	Calories: 2,000	2,500
Total Fat	Less Than 65g	80g
Sat Fat	Less Than 20g	25g
Cholesterol	Less Than 300mg	300mg
Sodium	Less Than 2,400mg	2,400mg
Total Carbohydrate	300g	375g
Dietary Fiber	25g	30g

Calories per gram:
Fat 9 • Carbohydrate 4 • Protein 4

INGREDIENTS: BEEF, WATER, SOY PROTEIN CONCENTRATE, DEXTROSE, MODIFIED CORN STARCH, SODIUM PHOSPHATE, SALT, ISOLATED SOY PROTEIN, HYDROLYZED SOY PROTEIN, NATURAL FLAVORINGS.

CONTAINS: SOY

Philly's Best Steak Company, Inc.
Yeadon, PA 19050

COOKING INSTRUCTIONS

1. Preheat frying pan to 375°F (high).
2. Break up steak into small pieces and place in pan.
3. While cooking, toss and stir with spatula for a few minutes until golden brown.

Raw beef products should be cooked to an internal temperature of 160°F.

Safe Handling Instructions

This product was prepared from inspected and passed meat and/or poultry. Some food products may contain bacteria that could cause illness if the product is mishandled or cooked improperly. For your protection, follow these safe handling instructions.

- Keep refrigerated or frozen. Thaw in refrigerator or microwave.
- Keep raw meat and poultry separate from other foods. Wash working surfaces (including cutting boards), utensils, and hands after touching raw meat or poultry.
- Cook thoroughly.
- Keep hot foods hot. Refrigerate leftovers immediately or discard.

Try Our Other Tasty
Philly's Best Steak Products
Chicken Philly Sandwich Slices
&

Buffalo Chicken Philly Sandwich Slices
Visit us at www.phillysbeststeak.com

SERVING SUGGESTIONS

Philadelphia Style Cheesesteak

Cook Philly's Best Steak Beef Philly Sandwich Slices according to cooking instructions and serve on a fresh Italian roll. Add 3 slices of American cheese. Top with your favorite condiment.



Steak, Egg & Cheese Bagel

Toast your favorite style bagel and add cooked Philly's Best Steak Beef Philly Sandwich Slices, one fried egg and your favorite cheese.



Cheesesteak Stromboli

Pick up your favorite pizza dough and roll out on a sheet pan in the shape of a rectangle. Spread cooked Philly's Best Steak Beef Philly Sandwich Slices loosely over dough. Add shredded mozzarella cheese and Italian seasoning spices. Carefully roll dough into a loaf shape. Tuck the end of dough under loaf. Brush with olive oil and bake at 350°F for 20 - 30 minutes or until crust is golden brown. Serve with marinara sauce for dipping.



PROOF OF PURCHASE
8 55204 00507 4
© PHILLY'S BEST STEAK COMPANY INC.

MADE IN THE U.S.A.

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



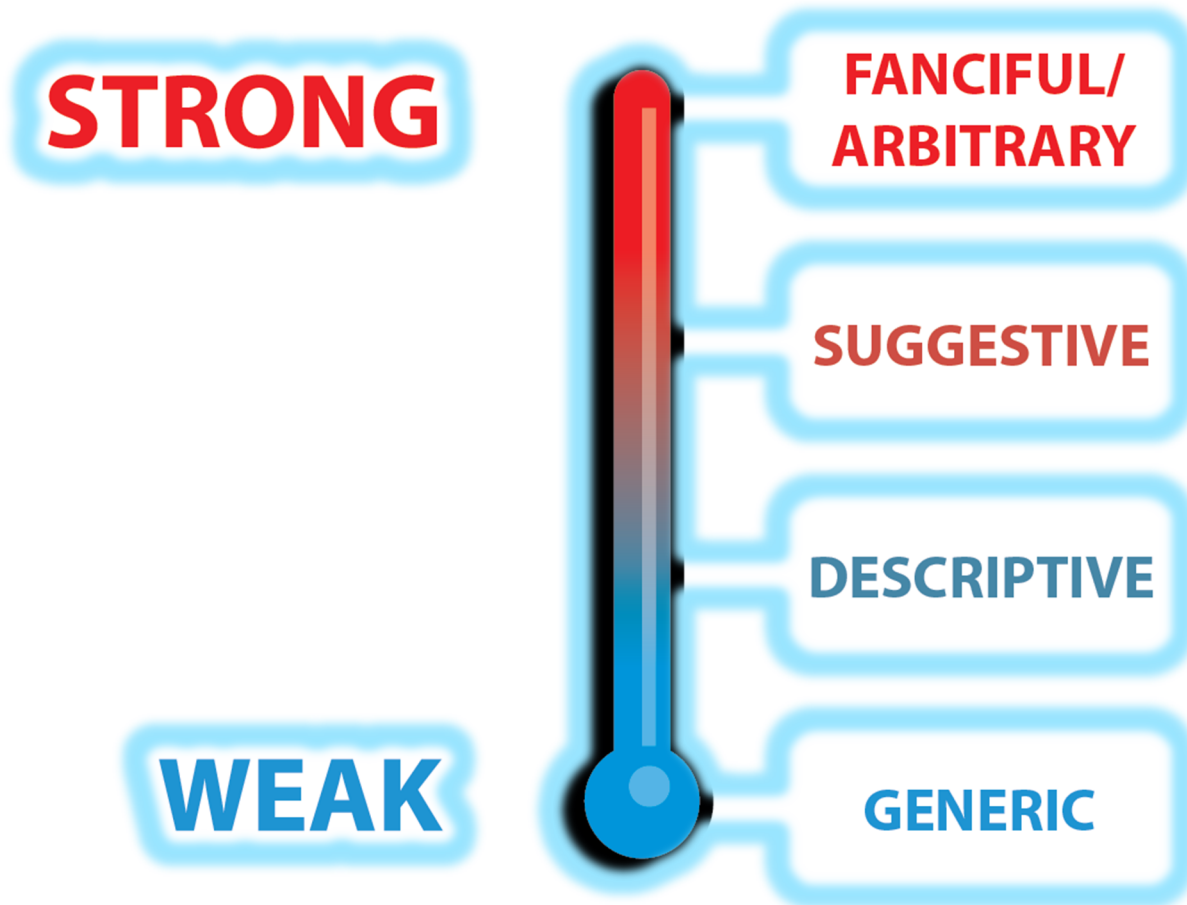
Trademark clearance search

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



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

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 5th and 6th years after registration
 - Combined Section 8 declaration of use and Section 9 application for renewal
 - Due between 9th and 10th 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

USPTO resources

- 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/flh-home/
 - International Trademark Association
 - <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?

