

UNITED STATES  
PATENT AND TRADEMARK OFFICE





# Trademark basics: What every small business should know now, not later

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UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# Discussion topics

- Trademark fundamentals
- Benefits of federal registration
- Selecting a trademark
- Filing and registration
- How to find help

Discussion topic

# Trademark fundamentals

# What is a trademark?



*Coca-Cola*



amazon

Google





# What does a trademark do?

- Trademark
  - Identifies the source of goods and services.
  - Distinguishes them from the goods and services of another party.
  - Provides legal protection for a brand.

# Traditional types of marks

- Common source identifiers:
  - Brand names
  - Slogans
  - Logos

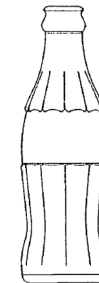
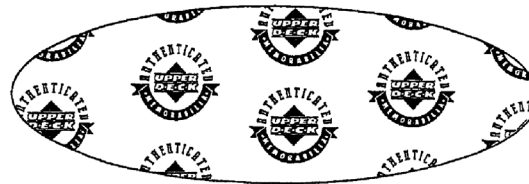
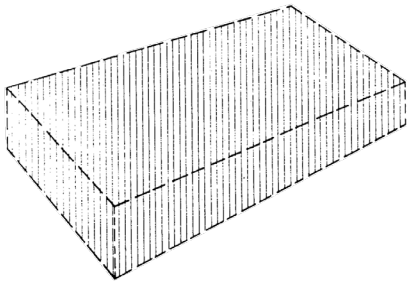
**COCA-COLA**

**IT'S THE  
REAL THING**



# 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





Discussion topic

# **Benefits of federal registration**



# Common law trademark rights

- Rights
  - Created when you use trademark in commerce
  - Limited to geographic area where mark is used
- Symbols
  - Optional: TM SM
  - Never: ®



# Federal registration rights

- Rights

- Created when you federally register a trademark.
- Can bring legal action concerning trademark in federal court.
- Enables recordation of registration with U.S. Customs and Border Protection.
- Can be used as a basis for filing in another country.
- May use the registration symbol, ®.



Discussion topic

# Selecting a trademark



# 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
  - Likelihood of confusion refusal
- Strength of the trademark
  - Descriptiveness refusal

Discussion topic

# **Selecting a trademark: Likelihood of confusion**



# Likelihood of confusion

- Concept:
  - Avoid confusing consumers about the source of the goods and services.
- Test:
  - Are the trademarks confusingly **similar**?
  - and
  - Are the goods and/or services **related**?







# Likelihood of confusion example

**Your trademark**

T.MARKEY

for

shirts

**Registered trademark**

T.MARKEY

for

pants





# Likelihood of confusion example

**Your trademark**

T.MARKEY

for

shirts

**Registered trademark**

TEE MARQEE

for

pants





# Likelihood of confusion example

**Your trademark**

T.MARKEY

for

shirts

**Registered trademark**

TEE MARQEE

for

golf flags





# Suggestions for searching

- On your own
  - USPTO database
    - Federally applied-for and registered trademarks
  - The internet
    - One option for searching for common law use



# Suggestions for searching

- Hire a private trademark attorney
  - Comprehensive clearance search includes
    - USPTO database of registrations and applications
    - State trademark databases
    - Business name registries
    - Foreign trademark databases
    - The internet



Discussion topic

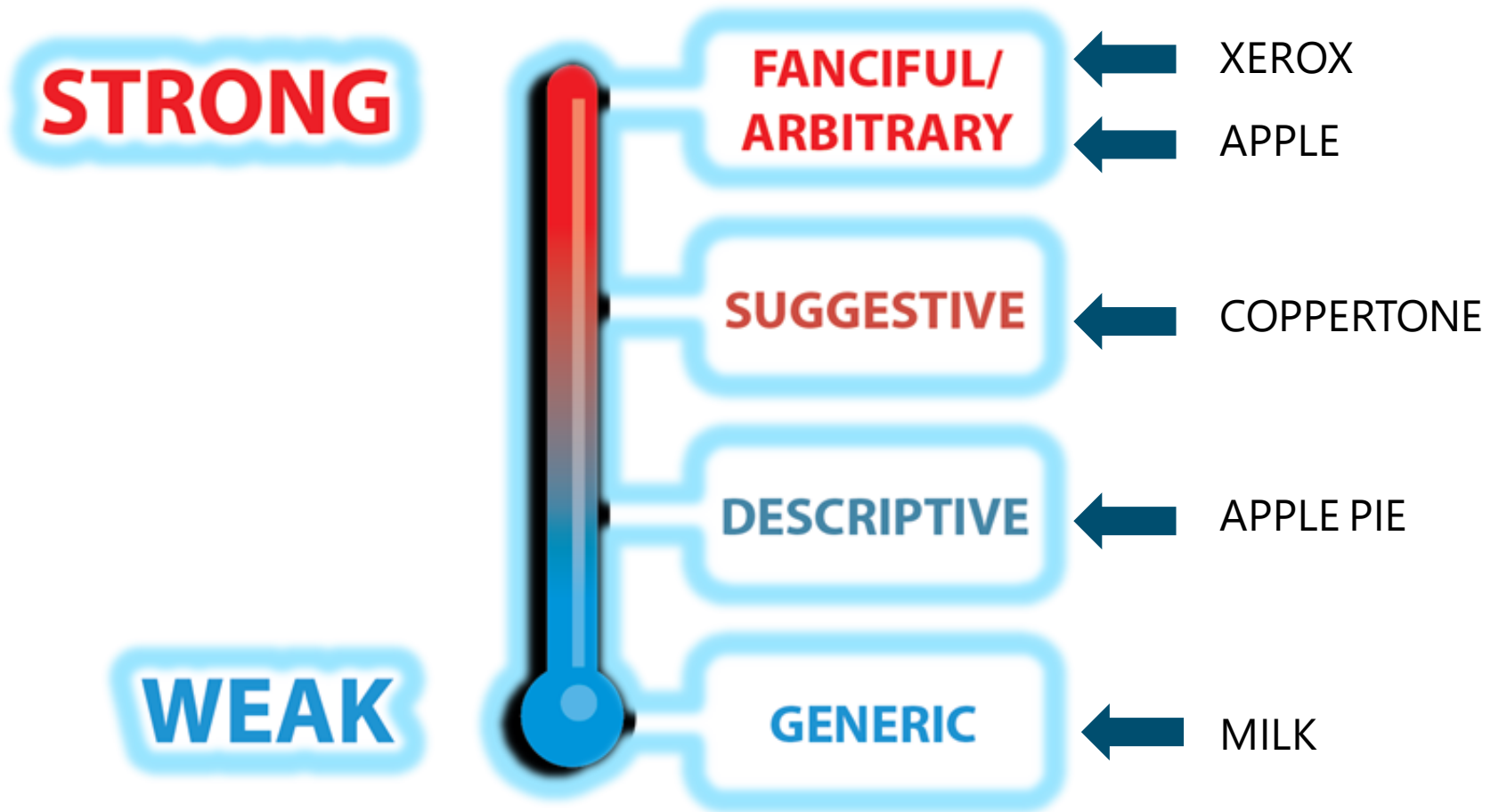
# **Selecting a trademark: Strength of the trademark**



# Strength of trademark

- Concept:
  - Avoid using trademarks that fail to indicate the source of goods and services.
- Test:
  - Does the trademark **merely describe** the goods and services?

# Strength of trademark





Discussion topic

# Filing and registration



# Filing for federal registration

- File using the Trademark Electronic Application System (TEAS).
  - TEAS filing options
    - TEAS Plus: \$250 per international class
    - TEAS Standard: \$350 per international class
  - Total fee determined by how many classes you include in the application





# Filing for federal registration

- Application requirements
  - Clear **drawing** of the trademark
  - Listing of the **goods and services** used with the trademark
  - Application **filing basis** for each good or service
  - **Contact information** for the trademark owner
  - Filing **fee**





# 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.
- Must file required post-registration documents with the USPTO.



Discussion topic

# How to find help



# Caution: scam alert

- Beware of scams.
  - [www.uspto.gov/TMFraud](http://www.uspto.gov/TMFraud)
- Beware of filing firms.
  - [www.uspto.gov/trademarks/protect/filing-firms](http://www.uspto.gov/trademarks/protect/filing-firms)
- Beware of misleading notices and offers.
  - [www.uspto.gov/TrademarkSolicitations](http://www.uspto.gov/TrademarkSolicitations)



# USPTO resources

- Website
  - [www.uspto.gov](http://www.uspto.gov)
- Trademark videos
  - [www.uspto.gov/TMvideos](http://www.uspto.gov/TMvideos)
- Trademark basics registration toolkit
  - [www.uspto.gov/TrademarkBasicsToolkit](http://www.uspto.gov/TrademarkBasicsToolkit)





# USPTO resources

The screenshot shows the USPTO website header with the logo and navigation links. The main navigation bar includes 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. A search bar is located in the top right. Below the navigation bar, a breadcrumb trail reads 'Home > About Us > Events > Trademark Basics Boot Camp'. The main content area features the title 'Trademark Basics Boot Camp' and three paragraphs of text. To the right of the text is a blue graphic with the text 'Trademark Basics BOOT CAMP' and three testimonials from boot camp veterans.

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## Trademark Basics Boot Camp

This free USPTO event series provides a comprehensive overview of the process for federal trademark registration and maintaining a federal trademark. If you're a small business owner or entrepreneur seeking to protect your brand and product identities, Trademark Basics Boot Camp is for you.

Trademark Basics Boot Camp is offered regularly throughout the year. During each series run, we cover one module weekly for eight weeks, with each module focusing on different aspects of trademarks and the registration process, from filing and examination to post-registration requirements for keeping your registration alive. Each module concludes with a question-and-answer period where you can ask our USPTO trademark experts questions.

You can attend the entire series or just the modules that best match your interests, but you must sign up for each module to attend. If you attend all eight modules, you can request a certificate of attendance. To learn more and sign up, select an individual module from the listing below.

**Trademark Basics**  
**BOOT CAMP**

Here's what our boot camp veterans are saying:

- "It's a terrific program. I may take it again as it is a wealth of knowledge."
- "Great information and very thorough explanation of the process and requirements for trademarks."
- "Fantastic program. Have already recommended it to several people."

# USPTO resources

- IP Identifier
  - <https://ipidentifier.uspto.gov>
- Free services and resources
  - [www.uspto.gov/FreeServices](http://www.uspto.gov/FreeServices)
- USPTO virtual assistant
  - [www.uspto.gov/trademarks/basics](http://www.uspto.gov/trademarks/basics)





# USPTO resources

- Trademark Assistance Center
  - Main support center for all trademark customers
    - Phone: 1-800-786-9199
    - Email: [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

# USPTO resources

- The USPTO does not:
  - Provide legal advice.
  - Enforce legal rights.
  - Recommend specific private attorneys.

**Questions?**

