

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Trademark fundamentals

Jason Lott

Attorney Advisor, Trademarks Customer Outreach

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PATENT AND TRADEMARK OFFICE

























# 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**

# Interbrand best global brands

Interbrand					
<b>01 Apple</b> +38% \$322,999m 	<b>02 Amazon</b> +60% \$200,667m 	<b>03 Microsoft</b> +53% \$166,001m 	<b>04 Google</b> -1% \$165,444m 	<b>05 Samsung</b> +2% \$62,289m 	<b>06 Coca-Cola</b> -10% \$56,894m 
<b>07 Toyota</b> -8% \$51,595m 	<b>08 Mercedes-Benz</b> -3% \$49,268m 	<b>09 McDonald's</b> -6% \$42,816m 	<b>10 Disney</b> -8% \$40,773m 	<b>11 BMW</b> -4% \$39,756m 	<b>12 Intel</b> -8% \$36,971m 
<b>13 Facebook</b> -12% \$35,178m 	<b>14 IBM</b> -14% \$34,885m 	<b>15 Nike</b> +6% \$34,388m 	<b>16 Cisco</b> -4% \$34,119m 	<b>17 Louis Vuitton</b> -2% \$31,720m LOUIS VUITTON	<b>18 SAP</b> +12% \$28,011m 
<b>19 Instagram</b> NEW \$26,060m 	<b>20 Honda</b> -11% \$21,694m 	<b>21 Chanel</b> -4% \$21,203m 	<b>22 J.P. Morgan</b> +6% \$20,220m J.P.Morgan	<b>23 American Express</b> -10% \$19,458m 	<b>24 UPS</b> +6% \$19,161m 

# 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
- Trade 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 the "LowRates.com" logo, also circled in red, with a house icon and the text "by Sun West Mortgage Company, Inc. NMLS 3277". 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 white box highlights a "15 YR FIXED" mortgage offer at a rate of "2.054%" (Rate & APR), with a "Get Quote" button.

# Trade 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	Less Than	300g	375g
Dietary Fiber	Less Than	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](http://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.



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"

# Trademark clearance search

Simple clearance search:

- USPTO database
  - TESS (Trademark Electronic Search System)
  - [www.uspto.gov/SearchTrademarks](http://www.uspto.gov/SearchTrademarks)
- The internet
  - Option for searching for common law use



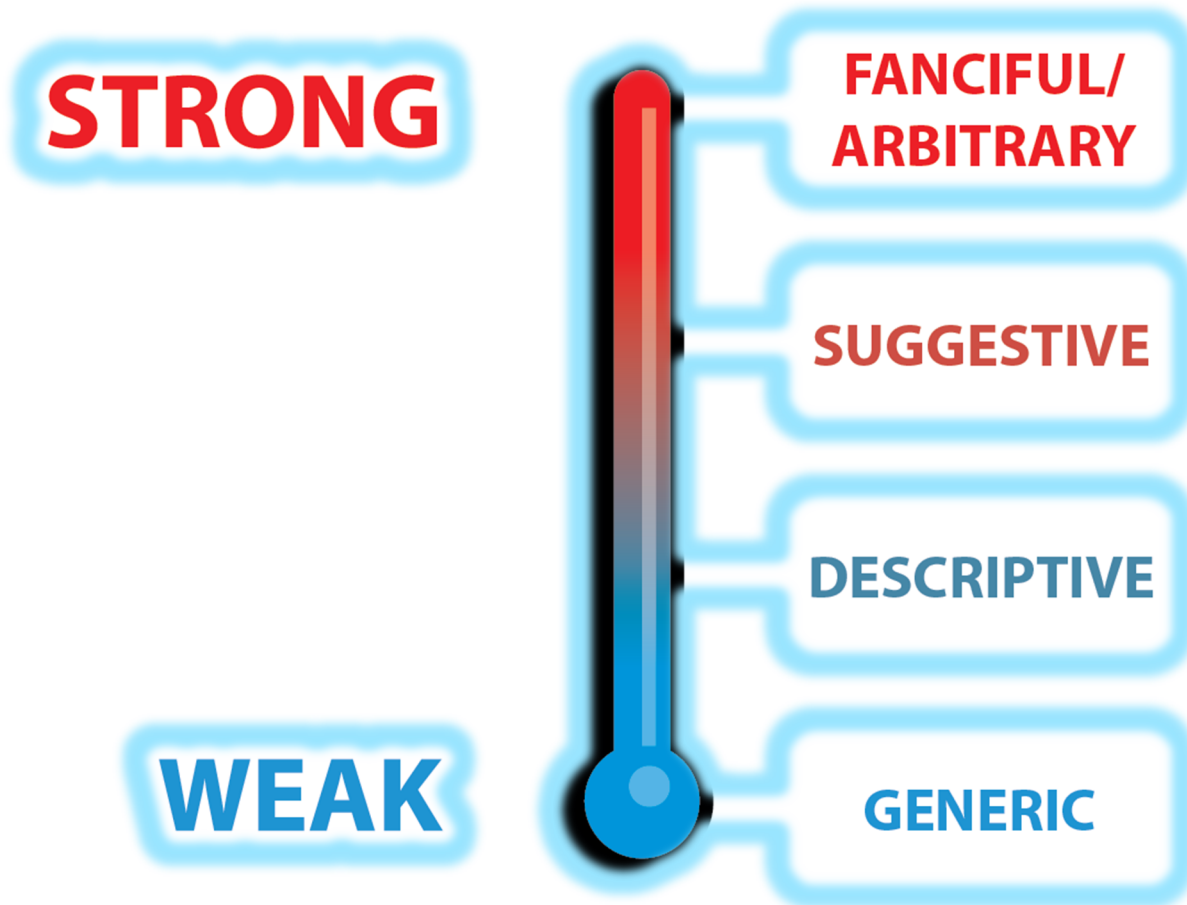
# Trademark clearance search

Full clearance search:

- USPTO database
- 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 in MyUSPTO.
  - Two-step login process for authentication
  - <https://my.uspto.gov/>
- File using the Trademark Electronic Application System (TEAS).
  - Two filing options: TEAS Plus and TEAS Standard
  - [www.uspto.gov/TEAS](http://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](http://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.
- Must file required post-registration documents with the USPTO.



# Post-registration requirements

- Required filings
  - Section 8 declaration of use
    - Due between 5<sup>th</sup> and 6<sup>th</sup> years after registration
  - Combined Section 8 declaration of use and Section 9 application for renewal
    - Due between 9<sup>th</sup> and 10<sup>th</sup> 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](http://www.uspto.gov/TrademarkSolicitations)

Discussion topics

# How to find help

# USPTO resources

- Website
  - [www.uspto.gov](http://www.uspto.gov)
- “Basic Facts About Trademarks” booklet
  - [www.uspto.gov/TrademarkBasicsPDF](http://www.uspto.gov/TrademarkBasicsPDF)
- Trademark videos
  - [www.uspto.gov/TMvideos](http://www.uspto.gov/TMvideos)



# USPTO resources

- Trademark Assistance Center
  - Phone: 1-800-786-9199
  - Email: [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)
  - Web: [www.uspto.gov/TrademarkAssistance](http://www.uspto.gov/TrademarkAssistance)

# USPTO resources

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

**Questions?**

# Appendix

- Slide 10: Reg. 0238145, 2908803, 0238146, 1867757, and 2085197
- Slide 13: Reg. 6181903
- Slide 14: Reg. 4728626
- Slide 30: Reg. 3719198, 5254240, 1078312, and 129294
- Slide 31: Reg. 0917825 and 3162725
- Slide 35: Reg. 0238145, 0238146, and 1867757



