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PATENT AND TRADEMARK OFFICE
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Trademarks Overview

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

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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?



















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

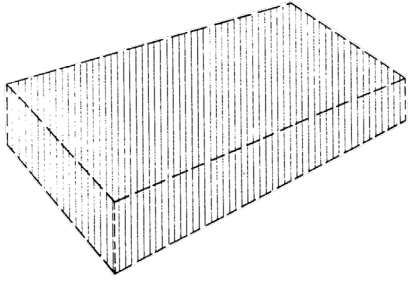
IT'S THE REAL THING

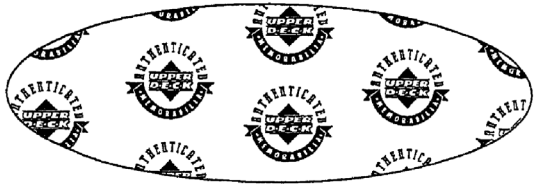


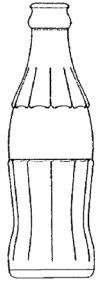


Non-traditional types of marks

- 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

www.uspto.gov/SearchTrademarks

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

www.uspto.gov/trademarks/basics/why-hire-private-trademark-attorney

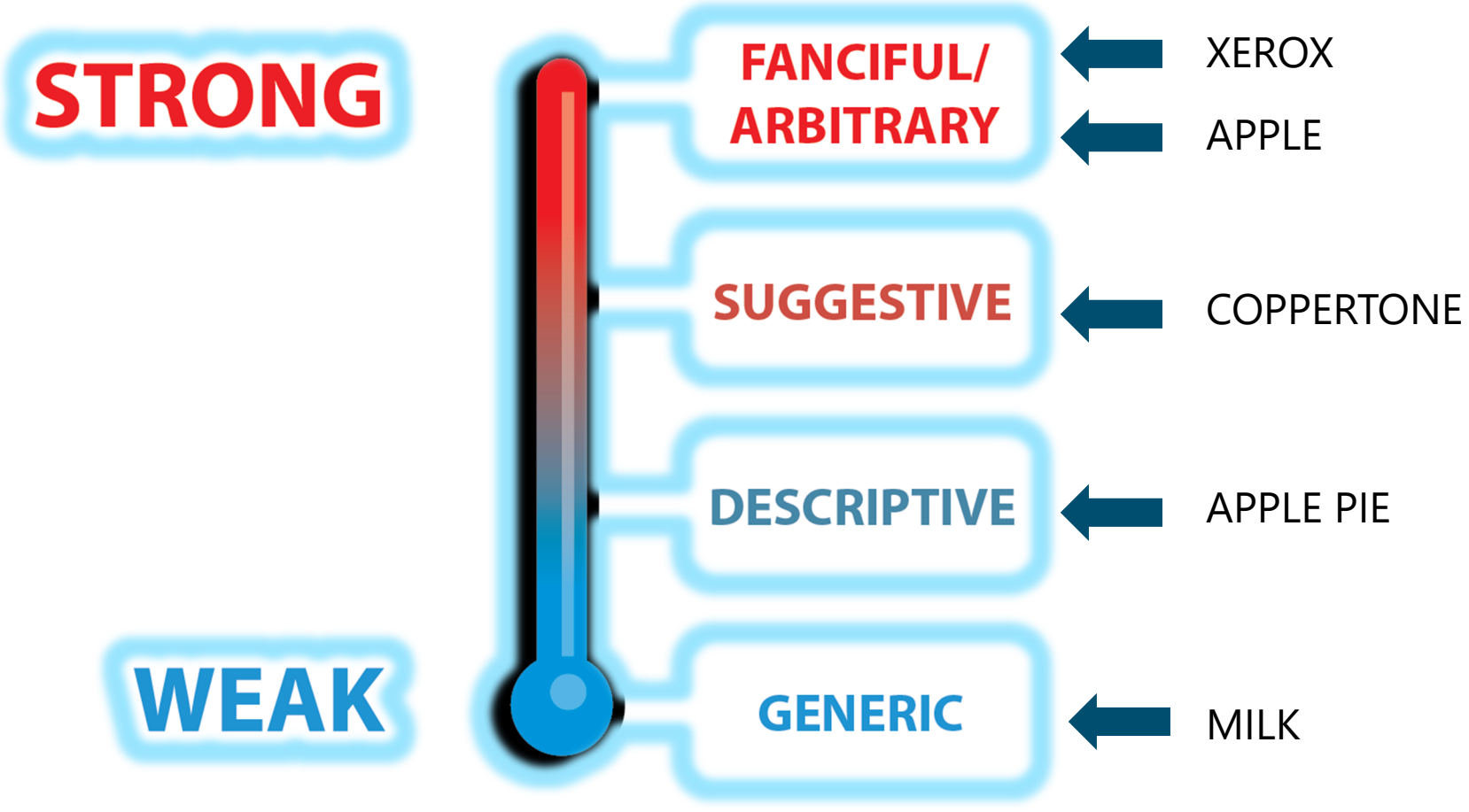
Discussion topic

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

www.uspto.gov/TEAS

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
- Beware of filing firms.
  - www.uspto.gov/trademarks/protect/filing-firms
- Beware of misleading notices and offers.
  - www.uspto.gov/TrademarkSolicitations

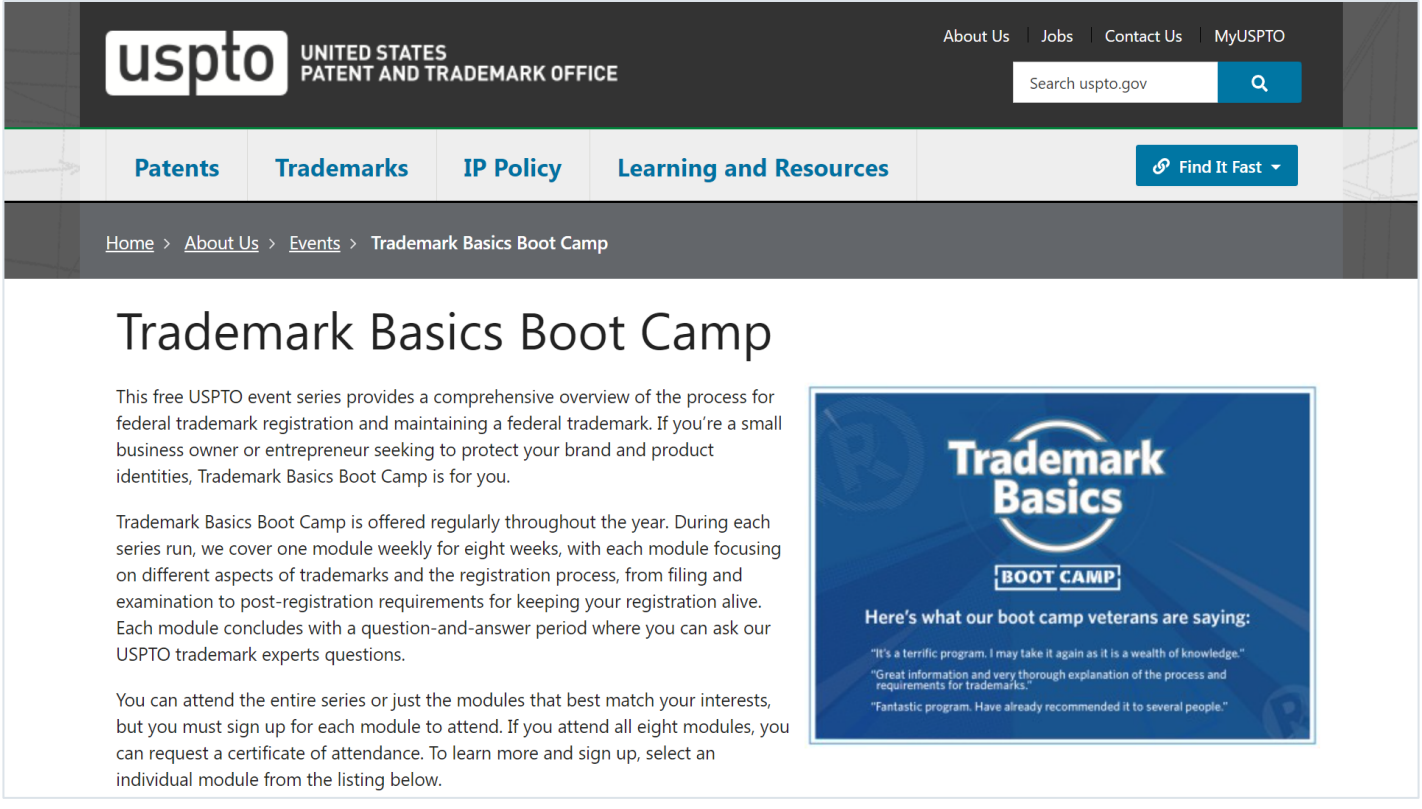


USPTO resources

- Website
  - www.uspto.gov
- Trademark videos
  - www.uspto.gov/TMvideos
- Trademark basics registration toolkit
  - www.uspto.gov/TrademarkBasicsToolkit



USPTO resources



www.uspto.gov/about-us/events/trademark-basics-boot-camp

USPTO resources

- IP Identifier
  - https://ipidentifier.uspto.gov
- Free services and resources
  - www.uspto.gov/FreeServices
- USPTO virtual assistant
  - 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

USPTO resources

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

www.uspto.gov/trademarks/basics/why-hire-private-trademark-attorney

Questions?


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