Learning the ropes to protect your creative works:

Trademarks

Invention-Con 2021
Discussion topics

Definitions/types of marks
What is a trademark or service mark?

A trademark/service mark is any word, symbol, design, or combination of those that serves to:

1. **Identify** the source of goods/services; and
2. **Distinguish** them from the goods/services of another party.
Types of marks

Word mark (and slogan)  Special form mark

COCA-COLA

Composite mark  Design mark
Types of marks

- Configuration (shape)
- Sound
- Color
- Scent
- Motion
- Hologram

In sum, anything that functions as a source identifier.
Discussion topics

Benefits of federal registration
Common law trademark

• Trademark that is **used** in commerce in connection with specified goods and services, but **not registered**

• Rights are limited to geographic area (based on use in that area).

• Symbols: \( ^{	ext{TM}} \quad ^{	ext{SM}} \) (optional)

• Note: U.S. is a first-to-use country, while most countries are first-to-file countries.
Federally registered trademark

- Legal presumption that registrant owns the mark in all 50 states and U.S. territories (but **not** other countries)
- Legal presumption of right to use the mark
- Public notice of ownership of mark
- Permits use of federal registration symbol: ®
Federally registered trademark

- Automatic listing in the USPTO database
- Right to bring legal action concerning mark in federal court
- Use as a basis for foreign filing (e.g., under the Madrid Protocol)
- Recordation with U.S. Customs and Border Protection, to help prevent importation of infringing products
Discussion topics

Selecting a mark
Strength of mark

STRONG

FANCIFUL/ ARBITRARY

SUGGESTIVE

DESCRIPTIVE

WEAK

GENERIC

uspto
Likelihood of confusion

Confusion as to **source**:

1. Are the marks confusingly similar?
   - Look alike? Sound alike? Have similar meanings? Create similar commercial impressions?

and

2. Are the goods and/or services related?
   - Encountered in the same channels of trade? Complementary?
Suggestions for searching

On your own:

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

• The internet
  – Only option for searching for common law use
Suggestions for searching

Hire a private trademark attorney or search firm:

• Full clearance search
  – TESS (Trademark Electronic Search System)
  – State trademark databases
  – Business name registries
  – Foreign trademark databases
  – The internet
Discussion topics

Filing and registration
Filing for federal registration

- Trademark Electronic Application System (TEAS)
  - www.uspto.gov/TEAS
- Basis for initial filing may be:
  - Use in commerce (interstate or between the U.S. and another country)
  - Intent to use (bona fide intent to use in the future)
  - Foreign application
  - Foreign registration
Post-registration requirements

• Between fifth and sixth years after the registration date, **must** do new filing (Section 8 declaration) to show continued use of mark in commerce.

• May combine with optional filing (Section 15 declaration), if qualify, to claim incontestability.

• Between ninth and tenth years, must do new filing (Combined Section 8 and 9) to show continued use **and** request renewal, with same requirement every ten years.

• USPTO emails reminder notices.
Caution: misleading notices

All application data becomes public information

Be aware of misleading notices and offers, particularly for fees not required by the USPTO

www.uspto.gov/watch/TMINSolicitations
Discussion topics

How to find help
USPTO resources

• USPTO.gov website
• “Basic Facts About Trademarks” booklet
  – www.uspto.gov/TrademarkBasicsPDF
• “Basic Facts About Trademarks” videos
• “Trademark Information Network” (TMIN) videos
• “TEAS Nuts-and-Bolts” videos
  – www.uspto.gov/TMvideos
The best resource may be an experienced trademark attorney.

The USPTO does **not:**

- Provide legal advice
- Enforce legal rights
- Recommend specific private attorneys
USPTO contact

Trademark Assistance Center

Phone: 1-800-786-9199
Email: TrademarkAssistanceCenter@uspto.gov
Web: www.uspto.gov/TrademarkAssistance