Trademark fundamentals

Jason Lott
Attorney Advisor, Trademarks Customer Outreach

Images used in this presentation are for educational purposes only.
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

01. Apple
   +39%  $322,999m

02. Amazon
   +60%  $200,667m

03. Microsoft
   +53%  $166,001m

04. Google
   -1%  $165,444m

05. Samsung
   +1%  $62,289m

06. Coca-Cola
   -10%  $56,894m

07. Toyota
   -5%  $33,595m

08. Mercedes-Benz
   -3%  $40,298m

09. McDonald’s
   -6%  $42,816m

10. Disney
   -9%  $40,773m

11. BMW
   -4%  $39,756m

12. Intel
   -8%  $36,977m

13. Facebook
   +2%  $35,178m

14. IBM
   -9%  $34,885m

15. Nike
   +4%  $34,388m

16. Cisco
   -4%  $34,119m

17. Louis Vuitton
   +2%  $31,720m

18. SAP
   +17%  $28,011m

19. Instagram
   New  $26,060m

20. Honda
   -11%  $21,694m

21. Chanel
   +4%  $21,203m

22. J.P. Morgan
   +6%  $20,282m

23. American Express
   -10%  $19,458m

24. UPS
   +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

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
Trade name vs. trademark use

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

• 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

- STRONG
- FANCIFUL/ARBITRARY
- SUGGESTIVE
- DESCRIPTIVE
- GENERIC

WEAK
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
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
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
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.

• Must file required post-registration documents with the USPTO.
Post-registration requirements

• Required filings
  – Section 8 declaration of use
    • Due between 5\textsuperscript{th} and 6\textsuperscript{th} years after registration
  – Combined Section 8 declaration of use and Section 9 application for renewal
    • Due between 9\textsuperscript{th} and 10\textsuperscript{th} 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

• 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.
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