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

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Discussion topics

• Trademarks and intellectual property
• Benefits of federal registration
• Selecting a trademark
• Filing and registration
• How to find help
Discussion topic

Trademarks and intellectual property
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.
What does a trademark not do?

• Trademark
  – Does **not** mean you legally own a word or phrase.
  – Does **not** mean you can stop other people from saying a word or phrase.
  – Does **not** mean people owe you money if they say a word or phrase.
Definitions

• Trademark
  – Indicates the source of goods or products.

• Service mark
  – Indicates the source of services.
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
Knowledge check

Does a federally registered trademark mean that you own a word or phrase?

Yes

No
Other intellectual property

• 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.
Other trademark-related concepts

• Domain name registration
  – Provides a web address for your website.
  – Does **not** create a registered trademark.

• Trade name registration
  – Allows you to do business in a particular state or jurisdiction.
  – Does **not** create a registered trademark.
Domain name vs. trademark use
Trade name vs. trademark use
Knowledge check

Do you have to use your business name as your trademark?

Yes  No
Discussion topic

Benefits of federal registration
Trademark rights

• Traditional ways of creating rights:
  – Common law
  – 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 trademark
  – Legal presumption you own the trademark
  – Legal presumption you have the right to use the trademark in all 50 states and the U.S. territories
  – Notice to the public of your rights in the trademark
Federal registration rights

• Rights
  – 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.
Federal registration rights

• Symbols
  – Unnecessary: TM  SM
  – Permitted: ®
Knowledge check

Are you required to register your trademark with the USPTO?

Yes    No
Knowledge check

Does registering your trademark with the USPTO give you international protection?

Yes  No
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

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

Your trademark

X-SEED for agricultural seeds

Registered trademark

EXCEED for live plants
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

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

WEAK
Strength of trademark examples

• Generic terms
  – Common, everyday name for the good or service
  – Unregistrable

• Example
  – MILK for “dairy-based beverage”
Strength of trademark examples

• Descriptive trademarks
  – Directly describe something about the goods and services
  – Unregistrable on the Principal Register
    • Except with showing of acquired distinctiveness

• Example
  – CREAMY WHIP for “whipped topping”
Strength of trademark examples

• Suggestive trademarks
  – Suggest a quality of the goods and services
  – Registrable

• Example
  – COPPERTONE for “suntan lotion”
Strength of trademark examples

• Fanciful trademarks
  – Invented words with no meaning in any language
  – Registrable

• Example
  – XEROX for “photocopiers”
Strength of trademark examples

• Arbitrary trademarks
  – Actual words, but no association with the goods and services
  – Registrable

• Example
  – APPLE for “computers”
Knowledge check

Which is registrable?

BICYCLE for bicycles

BICYCLE for playing cards
Discussion topic

Filing and registration
Filing for federal registration
Filing for federal registration

• File using the Trademark Electronic Application System (TEAS).
  – Two filing options
    • TEAS Plus
    • TEAS Standard

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

• 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

• 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.
Knowledge check

Are you guaranteed registration of your trademark?

Yes  No
Knowledge check

If your trademark registers, do you have to do anything to keep your registration alive?

Yes          No
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

• Free services and resources
  – www.uspto.gov/FreeServices

• Women’s Entrepreneurship
  – www.uspto.gov/initiatives/we

• Inventor and entrepreneur resources
  – www.uspto.gov/Inventors
USPTO resources

• IP Identifier
  – Identify your IP assets by answering six brief questions.
  – Learn basic information about your identified IP and access additional resources.
  – Download a PDF of your results and resources.

https://ipidentifier.uspto.gov
USPTO resources

• USPTO virtual assistant
  – Beta testing on trademark questions
  – Easy way to look up your application status

www.uspto.gov/TrademarkBasics
USPTO resources

• Trademark Assistance Center
  – Main support center for all trademark customers
    • Phone: 1-800-786-9199
    • Email: TrademarkAssistanceCenter@uspto.gov

www.uspto.gov/TrademarkAssistance
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
Legal resources

• Remember:
  – Best resource is an experienced trademark attorney.
  – Most trademark filing companies can only provide limited services.

www.uspto.gov/trademarks/basics/do-i-need-attorney
Legal resources

• Free or reduced-price legal services
  – USPTO law school clinic certification program
    • [www.uspto.gov/LawSchoolClinic](http://www.uspto.gov/LawSchoolClinic)
  – American Bar Association
    • [www.americanbar.org/groups/legal_services/flh-home](http://www.americanbar.org/groups/legal_services/flh-home)
  – International Trademark Association
    • [www.inta.org/resources/pro-bono-clearinghouse](http://www.inta.org/resources/pro-bono-clearinghouse)
Other resources

• Advice and business consulting
  – Patent and Trademark Resource Centers (PTRCs)
    • www.uspto.gov/PTRC
  – Small Business Administration programs
    • www.sba.gov/local-assistance/resource-partners
Questions?