

UNITED STATES
PATENT AND TRADEMARK OFFICE





INVENTION-CON 2017

The Place for **Inventors**, **Makers**, & **Entrepreneurs**

USPTO's Inventors Conference • August 11-12 • Alexandria, VA

UNITED STATES
PATENT AND TRADEMARK OFFICE



Trademark Basics: What Every Small Business Should Know Now, Not Later

Presented By:

Craig Morris

UNITED STATES
PATENT AND TRADEMARK OFFICE



BUSINESS PLAN?

TRADEMARK COMPONENT OF YOUR BUSINESS PLAN?

Discussion Topics

1. What is a trademark?



Discussion Topics

1. What is a trademark?
2. Benefits of federal registration



Discussion Topics

1. What is a trademark?
2. Benefits of federal registration
3. Selecting a trademark



































Discussion Topics

1. What is a trademark?
2. Benefits of federal registration
3. Selecting a trademark
4. How to find help



WHAT IS A TRADEMARK?

01  +5% 178,119 \$m	02  +11% 133,252 \$m	03  -7% 73,102 \$m	04  +8% 72,795 \$m	05  +9% 53,580 \$m	06  -19% 52,500 \$m	07  +14% 51,808 \$m	08  +33% 50,338 \$m <small>TOP GROWING</small>
09  +18% 43,490 \$m	10  +2% 43,130 \$m	11  +12% 41,535 \$m	12  -1% 39,381 \$m	13  +6% 38,790 \$m	14  +4% 36,952 \$m	15  +48% 32,593 \$m <small>TOP GROWING</small>	16  +4% 30,948 \$m
17  -3% 26,552 \$m	18  +9% 25,034 \$m	19  +8% 23,998 \$m	20  +2% 22,681 \$m	21  -4% 22,106 \$m	22  +13% 21,293 \$m	23  +3% 20,265 \$m	24  -10% 19,950 \$m
25  -3% 18,358 \$m	26  +8% 17,834 \$m	27  +19% 16,766 \$m	28  +6% 16,134 \$m	29  +4% 15,333 \$m	30  +8% 15,099 \$m	31  +3% 14,227 \$m	32  -6% 13,136 \$m

Trademark Definition

Any word, slogan, symbol, design, or combination of these



Trademark Definition

Any word, slogan, symbol, design, or combination of these that:

- 1. Identifies the source of your goods and services**

and



Trademark Definition

Any word, slogan, symbol, design, or combination of these that:

1. **Identifies the source of your goods and services**

and

2. **Distinguishes them from the goods and services of another party**



Trademark Definition

Any word, slogan, symbol, design, or combination of these

Can also be a sound,
color, or
smell



Trademark Examples

Sound

**THE MARK COMPRISES
THE MUSICAL NOTES
G, E, C PLAYED ON
CHIMES**

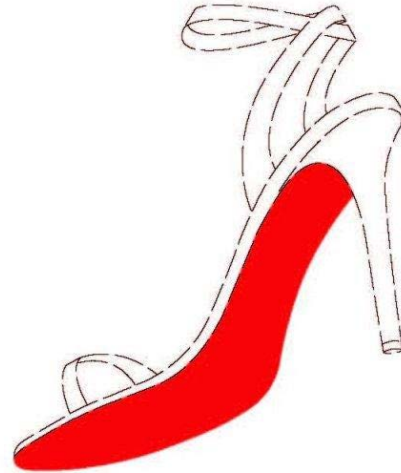
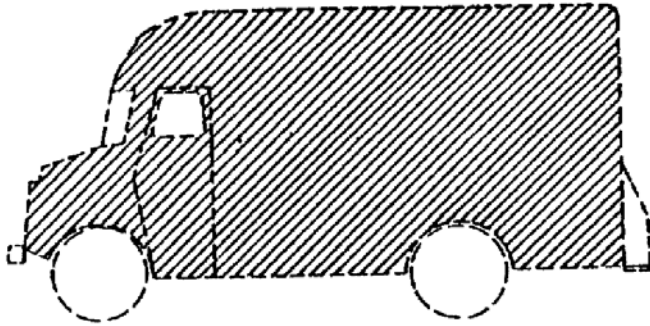
Smell

**Toothbrushes impregnated with the
scent of strawberries**



Trademark Examples

Color



Types of Trademarks

Word Mark

COCA-COLA

Special Form Mark



Composite Mark



Design Mark



TRADEMARK, PATENT, OR COPYRIGHT

Trademark

Brand for goods and services

Patent

Protects inventions

Copyright

Protects original artistic works





Patent



Copyright



Trademark



Trademark

Can last indefinitely

Patent

Utility: 20 years

Design: 15 years

Copyright

Life of the author plus 70 years



DOMAIN NAME OR BUSINESS NAME

Domain Name

Web address for finding a site on the Internet



Domain Name

Web address for finding a site on the Internet

Examples:

USPTO.GOV

COPYRIGHT.GOV



Domain Name



TMARKEY.COM



Business Name

Name under which you do business in a particular state



DOMAIN NAME \neq TRADEMARK REGISTRATION

BUSINESS NAME \neq TRADEMARK REGISTRATION

Trademark

Brand for goods and services

Patent

Protects inventions

Copyright

Protects original artistic works

Domain Name

Web address

Business Name

Entity name under which you do business



Trademark

www.uspto.gov

Patent

www.uspto.gov

Copyright

www.copyright.gov

Domain Name

www.internic.net

Business Name

your state's Secretary of State website



BENEFITS OF FEDERAL REGISTRATION

Common Law Trademark

Trademark that is used in commerce in connection with specified goods and services

Rights are limited to a particular geographic area



Federally Registered Trademark

Trademark that is used in commerce in connection with specified goods and services and is registered with the USPTO

Rights are granted throughout the United States and its territories



Federally Registered Trademark

1. Legal presumption that owner of the mark



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark
3. Puts public on notice of ownership of the mark



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark
3. Puts public on notice of ownership of the mark
4. Mark is listed in the USPTO database



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark
3. Puts public on notice of ownership of the mark
4. Mark is listed in the USPTO database
5. Can record registration with U.S. Customs and Border Protection



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark
3. Puts public on notice of ownership of the mark
4. Mark is listed in the USPTO database
5. Can record registration with U.S. Customs and Border Protection
6. Right to bring legal action concerning mark in federal court



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark
3. Puts public on notice of ownership of the mark
4. Mark is listed in the USPTO database
5. Can record registration with U.S. Customs and Border Protection
6. Right to bring legal action concerning mark in federal court
7. Use registration as a basis for foreign filing



Federally Registered Trademark

1. Legal presumption that owner of the mark
2. Legal presumption of right to use the mark
3. Puts public on notice of ownership of the mark
4. Mark is listed in the USPTO database
5. Can record registration with U.S. Customs and Border Protection
6. Right to bring legal action concerning mark in federal court
7. Use registration as a basis for foreign filing
8. Able to use the federal registration symbol: ®



SELECTING A TRADEMARK

Trademark Selection Challenges

Not every trademark registers



Trademark Selection Challenges

Not every trademark registers

Even if the mark registers, it may not be enforceable



Likelihood of Confusion

Likelihood of confusion between
the mark in your application and
a mark registered to another party



Likelihood of Confusion

Two prong test:

1. **Marks are similar**

and

2. **Goods and services are related**



Likelihood of Confusion

Two prong test:

1. Marks are similar

Look alike; Sound alike; Have similar meanings;
Create similar commercial impressions

and

2. Goods and services are related



Likelihood of Confusion

Two prong test:

1. Marks are similar

Look alike; Sound alike; Have similar meanings;
Create similar commercial impressions

and

2. Goods and services are related

Consumers mistakenly believe the goods and services come from the same source



Likelihood of Confusion

X-SEED for “agricultural seeds”

EXCEED for “live plants”



Likelihood of Confusion

LUPO for “pants”

WOLF for “shirts”



Trademark Clearance Search



Trademark Clearance Search

1. Trademark Electronic Search System (TESS)



Trademark Clearance Search

1. Trademark Electronic Search System (TESS)
2. State trademark databases



Trademark Clearance Search

1. Trademark Electronic Search System (TESS)
2. State trademark databases
3. Internet search



Additional Search Assistance

1. Hire a trademark attorney



Additional Search Assistance

1. Hire a trademark attorney
2. Trademark Information Network (TMIN)
on USPTO.GOV

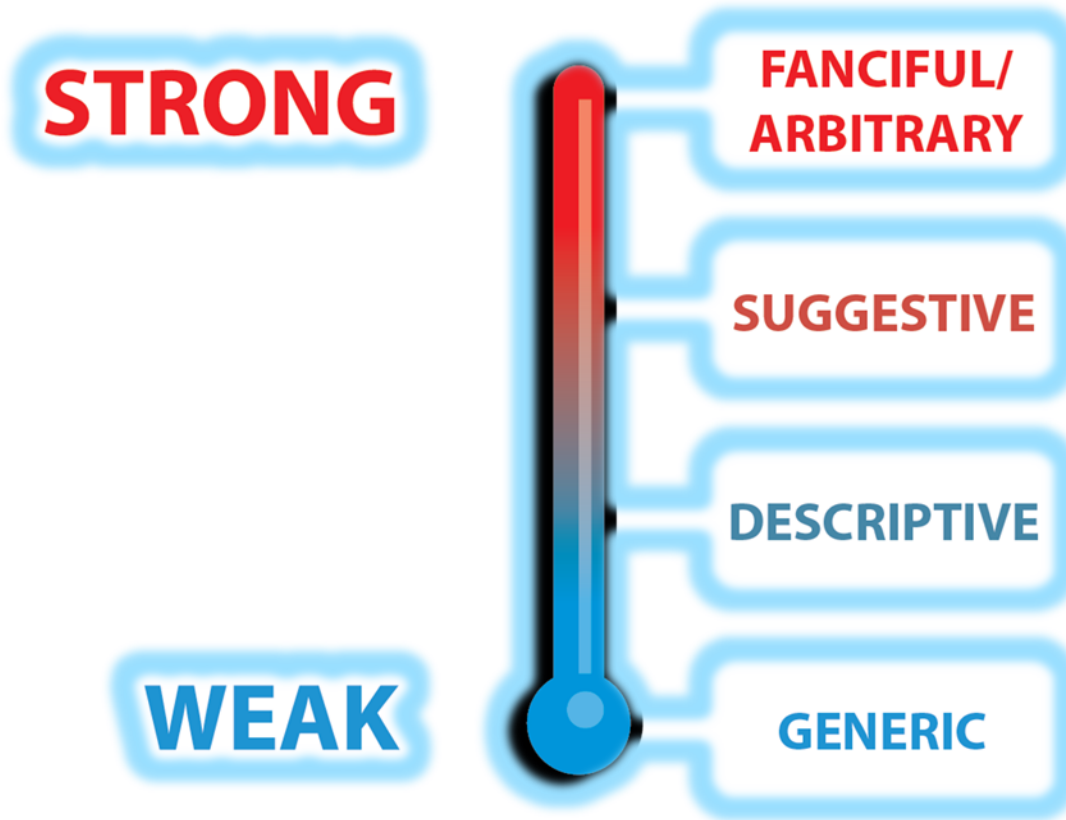


Strength of Mark

Determines registrability and protectability



Strength of Mark



Generic Terms

Common, everyday names for goods and services

Examples:

BICYCLE for “bicycles”

MILK for “a dairy-based beverage”



Descriptive Marks

Directly describe something about the goods and services

Examples:

CREAMY for “yogurt”

THE ULTIMATE BIKE RACK for “a bike rack”



Suggestive Marks

Suggest quality of the goods and services

Examples:

QUICK 'N NEAT for "pie crust"

GLANCE-A-DAY for "calendars"



Fanciful Marks and Arbitrary Marks

Inherently distinctive



Fanciful Marks

Invented words



Arbitrary Marks

Actual words, but no association with the goods and services

Apple®



 **BlackBerry**

uspto

Marketing

Descriptive = Hard to protect



Marketing

Descriptive = Hard to protect

Fanciful/Arbitrary = Easier to protect



“Genericized” Marks

**Trademarks that have lost their
trademark significance**

Examples:

ZIPPER

ESCALATOR

YO-YO



Policing Your Mark

Ensure that consumers use it properly



Trademark Selection Considerations

1. Likelihood of confusion
2. Strength of mark



Trademark Selection Considerations

1. Likelihood of confusion
2. Strength of mark
3. Surname
4. Geographically descriptive
5. Deceptive, disparaging, or offensive
6. Misspelling of descriptive/generic wording
7. Name or likeness
8. Title of a single book or movie
9. Ornamental/Descriptive matter



HOW TO FIND HELP

USPTO Resources

1. USPTO.GOV



USPTO Resources

1. **USPTO.GOV**
2. **Basic Facts About Trademarks booklet**



USPTO Resources

1. **USPTO.GOV**
2. **Basic Facts About Trademarks booklet**
3. **Basic Facts About Trademarks videos**



USPTO Resources

1. USPTO.GOV
2. Basic Facts About Trademarks booklet
3. Basic Facts About Trademarks videos
4. Trademark Information Network (TMIN)



USPTO Resources

1. USPTO.GOV
2. Basic Facts About Trademarks booklet
3. Basic Facts About Trademarks videos
4. Trademark Information Network (TMIN)
5. TEAS Nuts and Bolts videos



USPTO Contact

Trademark Assistance Center

Phone: **1-800-786-9199**

E-mail: **TrademarkAssistanceCenter@uspto.gov**



USPTO Restrictions

The USPTO does not:

1. Provide legal advice
2. Enforce trademark rights



Advantages of Hiring an Attorney

1. Obtain or conduct a pre-application clearance search



Advantages of Hiring an Attorney

1. Obtain or conduct a pre-application clearance search
2. Interpret search results



Advantages of Hiring an Attorney

1. Obtain or conduct a pre-application clearance search
2. Interpret search results
3. Navigate the application process



Advantages of Hiring an Attorney

1. Obtain or conduct a pre-application clearance search
2. Interpret search results
3. Navigate the application process
4. Help you understand the scope of your rights



Advantages of Hiring an Attorney

1. Obtain or conduct a pre-application clearance search
2. Interpret search results
3. Navigate the application process
4. Help you understand the scope of your rights
5. Advise you on the best way to police and enforce your rights



Finding an Attorney

1. Check local telephone listings
2. Search on-line
3. Check with local or state attorney bar associations

Other Sources of Assistance

1. Free and reduced-price legal services



Other Sources of Assistance

1. Free and reduced-price legal services
2. USPTO Law School Clinic program



Other Sources of Assistance

1. Free and reduced-price legal services
2. USPTO Law School Clinic program
3. SCORE program



Other Sources of Assistance

1. Free and reduced-price legal services
2. USPTO Law School Clinic program
3. SCORE program
4. Patent and Trademark Resource Centers (PTRCs)



Other Sources of Assistance

1. Free and reduced-price legal services
2. USPTO Law School Clinic program
3. SCORE program
4. Patent and Trademark Resource Centers (PTRCs)
5. Free information on [USPTO.GOV](https://www.uspto.gov)



WRAP UP

Five Things to Remember

1. A trademark is a brand



Five Things to Remember

1. A trademark is a brand
2. Federal registration provides nationwide protection



Five Things to Remember

1. A trademark is a brand
2. Federal registration provides nationwide protection
3. Select a mark that is strong and not likely to cause confusion



Five Things to Remember

































1. A trademark is a brand
2. Federal registration provides nationwide protection
3. Select a mark that is strong and not likely to cause confusion
4. Hiring a trademark attorney is recommended



Five Things to Remember

1. A trademark is a brand
2. Federal registration provides nationwide protection
3. Select a mark that is strong and not likely to cause confusion
4. Hiring a trademark attorney is recommended
5. Your trademark is the face of your business



01  +5% 178,119 \$m	02  +11% 133,252 \$m	03  -7% 73,102 \$m	04  +8% 72,795 \$m	05  +9% 53,580 \$m	06  -19% 52,500 \$m	07  +14% 51,808 \$m	08  +33% 50,338 \$m <small>TOP GROWING</small>
09  +18% 43,490 \$m	10  +2% 43,130 \$m	11  +12% 41,535 \$m	12  -1% 39,381 \$m	13  +6% 38,790 \$m	14  +4% 36,952 \$m	15  +48% 32,593 \$m <small>TOP GROWING</small>	16  +4% 30,948 \$m
17  -3% 26,552 \$m	18  +9% 25,034 \$m	19  +8% 23,998 \$m	20  +2% 22,681 \$m	21  -4% 22,106 \$m	22  +13% 21,293 \$m	23  +3% 20,265 \$m	24  -10% 19,950 \$m
25  -3% 18,358 \$m	26  +8% 17,834 \$m	27  +19% 16,766 \$m	28  +6% 16,134 \$m	29  +4% 15,333 \$m	30  +8% 15,099 \$m	31  +3% 14,227 \$m	32  -6% 13,136 \$m

QUESTIONS?



UNITED STATES
PATENT AND TRADEMARK OFFICE

Thank You!



Presented By:
Craig Morris



