Basic Facts About Trademarks: What Every Small Business Should Know Now, Not Later

Jason Lott
Attorney Advisor for Trademark Educational Outreach
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?
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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

Smell

THE MARK COMPRIS
THE MUSICAL NOTES
G, E, C PLAYED ON
CHIMES

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
Trademark
Brand for goods and services

Patent
Protects inventions
Trademark
Brand for goods and services

Patent
Protects inventions

Copyright
???
Copyright

Protection for original artistic works

Occurs when an idea is affixed in a tangible medium
Copyright

Songs          Sculptures
Movies         Plays
Books          Paintings
TV Shows       Photographs
Choreography   Architecture
Trademark
Can last indefinitely

Patent
Utility: 20 years       Design: 15 years

Copyright
Life of the author plus 70 years
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 ≠ TRADEMARK REGISTRATION

BUSINESS NAME ≠ 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
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3. Puts public on notice of ownership of the mark
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6. Right to bring legal action concerning mark in federal court
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7. Use registration as a basis for foreign filing
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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”
Trademark Clearance Search
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1. Trademark Electronic Search System (TESS)
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
Likelihood of Confusion

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

Determines registrability and protectability
Strength of Mark

STRONG

FANCIFUL/ARBITRARY

SUGGESTIVE

DESCRIPTIVE

WEAK

GENERIC
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

[Logos for Xerox, Cisco, and Microsoft]
Arbitrary Marks

Actual words, but no association with the goods and services

Apple

GAP

BlackBerry
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

xerox  
Kleenex®

Google
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
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
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2. Interpret search results
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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
Other Sources of Assistance

1. Free and reduced-price legal services
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2. USPTO Law School Clinic program
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1. Free and reduced-price legal services
2. USPTO Law School Clinic program
3. SCORE program
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4. Patent and Trademark Resource Centers (PTRCs)
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5. Free information on USPTO.GOV
Finding an Attorney

1. Check local telephone listings
2. Search on-line
3. Check with local or state attorney bar associations
WRAP UP
Five Things to Remember

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