

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Protecting your trademark in the United States

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February 5, 2020

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Discussion topics

1. Definitions/types of marks
2. Benefits of federal registration
3. Selecting a mark
4. Filing and registration
5. How to find help

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.

Definitions

TRADEMARK for goods/products

- Also seen as "TRADE MARK" or "TRADE-MARK"

SERVICE MARK for services

Symbols TM SM [®]

- Not required, but help put public "on notice" of claimed rights



Types of marks

Word mark (and slogan)

COCA-COLA

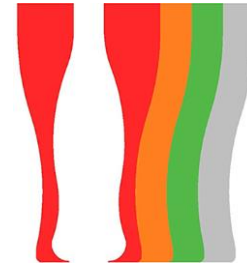
Special form mark

Coca-Cola

Composite mark



Design mark



uspto

Types of marks

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

In sum, anything that functions as a **source identifier**.

Different purposes, different results

- Domain name \neq Trademark registration
- Business name \neq Trademark registration

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: TM 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

Mark selection challenges

- Not every mark is registrable.
- Not every mark is enforceable.
- Even if a mark is registered, another party may be able to assert superior common law rights.

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

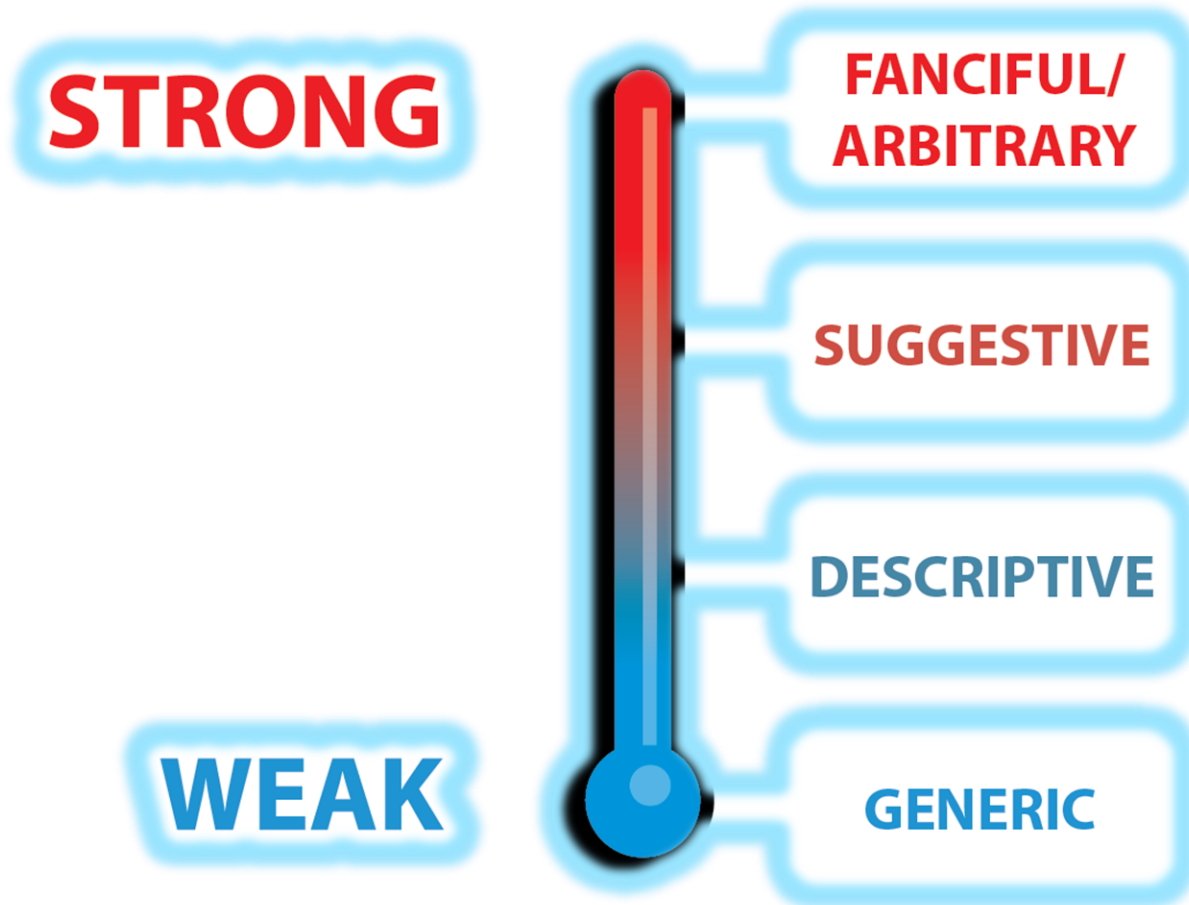


Suggestions for searching

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

Strength of mark



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



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



Registration responsibilities

- The mission of the USPTO is to register any mark that is eligible for registration.
- NOTE: The USPTO has no enforcement powers.
- It is the right and responsibility of the owner of any registration to enforce its rights.



Registration responsibilities

- Registration is a sword, not a shield.
- May use registration certificate to support a “cease and desist” letter.

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.



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



Legal resources

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



