Trademarks
Step-by-Step

How to Protect Your Business with Trademarks
Kelley Keller, Esq.


Knowledge is Power in Business and Life
Learning Objectives

1. Understand what a trademark is
2. Differentiate between the types of trademarks and what can be trademarked
3. Introduction to the relevant laws that affect trademarks
What is a Trademark?

- Words
- Symbols
- Letters
Be Unique!

Trademarks Protect Brand Value & Eliminate Confusion in the Marketplace

But only if you register & enforce them!
Trademark vs. Service Mark

Trademark

Service Mark
Common Trademark Types

1. BRAND NAME
   - COCA-COLA
   - MCDONALD’S
   - AT&T

2. SYMBOL
   - Apple
   - Nike
   - Olympic Rings
   - Dell
   - Skype
   - BMW

3. COMBINATION
   - Apple
   - Nike
   - Olympic Rings
   - Dell
   - Skype
   - BMW

4. SLOGAN
   - Just do it.
   - What’s in your wallet?
   - Taste the rainbow.
Less Common Trademark Types

1. COLORS
   - UPS Brown
   - Tiffany Blue
   - Coca-Cola Red

2. SHAPES
   - [Image of shapes]

3. SOUNDS
   - NBC Chime
   - Intel Startup Chime
   - MGM’s lion roar

4. SCENTS
   - Flower smell for yarn
   - Cherry scent for synthetic lubricants
Relevant Laws

Trademark Laws

- Lanham Act
- Anti-Cybersquatting Consumer Protection Act
- Uniform Domain-Name Resolution Policy

U.S. National, Regional, & Local Considerations

International Law

Common Law
Learning Objectives

1. Identify potential problems if you don’t secure your trademarks
2. Understand the business value of a trademark
3. Understand the role of employees in protecting trademarks
Real Trademark Problems – The Value of a Shape

DJ Deadmau5

Disney
Fully research the elements you want to trademark **before** you make your business dependent on them.
Risks to Your Business

- New Packaging
- Pull Products from Stores
- Destroy Inventory
- Recreate Marketing & Advertising
- Rebuild Brand Awareness & Trust
- Pay Legal Fees and Fines

Rebranding
Choose a Trademark You Can Actually Protect

Strength
- Don’t be descriptive!

Research
- Don’t forget common law!
Legal Rights of Trademark Registration

Rights
- You can use the ® symbol.
- You get protection against registration of confusingly similar marks in the future.
- You can sue infringers in federal court.

Time
- Initial registration is 10 years.
- Registration is renewable for successive 10-year periods as long as mark is still in use in commerce.

Presumptions
- You are the owner.
- The mark is valid.
- You have the exclusive right to use the mark nationwide.
- You have the ability to get trademark protection in other countries.
Business Value of a Trademark

- Quality
- Reliability
- Experiences
- Perceptions
- Expectations
- Emotions
- Experiences
- Investments
- Pricing
- Loyalty

Business Value
Brand Value Can Be Significant

The Role of Employees in Protecting Trademarks

- Create brand identity guidelines
- Develop processes
- Hold employees accountable
- Educate leaders

Training is critical!
Learning Objectives

1. Understand the difference between trademarks and trade names
2. Understand why the difference matters to your business
Trademarks vs. Trade Names

**TRADEMARK**
Identifies your business’ products or services in the marketplace. It is registered through the U.S. Patent & Trademark Office.

**TRADE NAME**
Identifies your company on tax documents, official corporate documents, bank accounts, etc. It is registered in the state where you do business.

**COULD MATCH**
You could have a trademark and trade name that match, but they’re not the same thing legally.

- TYLENOL®
- NIKE®
- Johnson & Johnson
- Nike, Inc.
Why the Difference Matters to Your Business

Clearing and registering trademarks and trade names are not the same

Handled by different agencies

Use different approval criteria

If you don’t secure your trademarks, your business is in jeopardy.
Learning Objectives

1. Understand what it means for a mark to be distinctive
2. Understand the levels of trademark distinctiveness
3. Understand the risks of choosing a non-distinctive mark
What Does It Mean to be Distinctive?

Distinctive

Descriptive

A strong trademark does not describe the products or services it represents.
The Thing You Use to Type Stuff & Do Other Stuff with a Screen & Keyboard Store
The Levels of Trademark Distinctiveness

Is your trademark’s enforceability on the fence? Find out how strong it really is:

Not all trademarks are created equal!
Strong Marks are Highly Protectable and Enforceable

Coined or Fanciful Marks
- GOOGLE
- EXXON
- CLOROX
- KODAK
- STARBUCKS

Arbitrary Marks
- APPLE
- AMAZON
- BABE RUTH
- IVORY
- SHELL

Suggestive Marks
- CHICKEN OF THE SEA
- GREYHOUND
- MICROSOFT
- NORTHFACE
- WRANGLER
Weak Marks are weakly (or not at all) protectable.

Descriptive Marks
- BANK OF AMERICA
- BEST BUY
- CRÈME DE MENTHE
- HEALTHY CHOICE
- MOTT’S

Generic Terms
- BICYCLE
- CEREAL
- COMPUTER
- EMAIL
- TABLE

Weak marks are less protectable and difficult to enforce.
Choosing a Strong Mark

A bigger moat = More protection
Learning Objectives

1. Understand what a trademark search is
2. Determine how to choose an attorney, legal document services provider, or doing it yourself
## What is a Trademark Search?

<table>
<thead>
<tr>
<th></th>
<th><strong>Preliminary Search</strong></th>
<th><strong>Comprehensive Search</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td>Search USPTO</td>
<td>Yes</td>
<td>Yes (ALL relevant classifications)</td>
</tr>
<tr>
<td>(ONLY for classifications on the application)</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Search active and inactive records</td>
<td>Yes (ONLY active records)</td>
<td>Yes (ALL records – inactive and active)</td>
</tr>
<tr>
<td>Search terms beyond the actual mark in the application</td>
<td>No (identical matches only)</td>
<td>Yes</td>
</tr>
<tr>
<td>Search potential indirect conflicts</td>
<td>No</td>
<td>Yes</td>
</tr>
<tr>
<td>State registration search</td>
<td>No</td>
<td>Yes</td>
</tr>
<tr>
<td>Common law conflict search</td>
<td>No</td>
<td>Yes</td>
</tr>
<tr>
<td>Search of traditional domain names</td>
<td>No</td>
<td>Yes</td>
</tr>
<tr>
<td>Search of social media usernames and profile URLs</td>
<td>No</td>
<td>Yes</td>
</tr>
</tbody>
</table>
Legal Document Service Company or Do-It-Yourself?

- Missed conflicts during search
- Denied application
- No help with assistance in communications with USPTO
- No help in choosing a protectable mark
- No consideration of common law

Lost Time, Lost Money, and Lost Business
You get what you pay for.
Using an Intellectual Property Attorney

Federal registration search
- State registration search
  - Active & inactive records search
  - Confusingly similar conflict search
  - Search of all relevant classifications

Common law web-based search
- Common law traditional search
- Indirect conflict search
- Domain name search

Completes & files the trademark application in best way
- Legal opinion related to mark’s risks
- Social media URL and username search

Receives all USPTO correspondence
- Responds to USPTO messages
- Can help protect and enforce your rights in the future
How much risk are you willing to accept to save money now?

How much are you willing to invest to protect your business in the future?
Learning Objectives

1. Identify the things you need to have on hand to apply for a trademark registration

2. Determine if you should use an attorney, legal document services provider, or do it yourself
What Do You Need to Have on Hand?

- Applicant
  - Owner of the Mark & Legal Rights-Holder

- Trademark Application

- Contact
  - Receives USPTO Correspondence
Depiction of the Mark

- **Standard Character Mark**: Protects Literal Elements. Broadest Protection.
- **Special Form Mark (stylized word)**: Protects Literal and Creative Elements: Font, Colors & Stylization.
- **Special Form Mark (design without text)**: Protects Literal and Creative Elements: Colors & Design.
- **Special Form Mark (design with text)**: Protects Literal and Creative Elements: Font, Colors & Design.

Examples:
- **GOOGLE**: Standard Character Mark
- **Coca-Cola**: Special Form Mark (stylized word)
- **Apple**: Special Form Mark (design without text)
- **Dell**: Special Form Mark (design with text)
Identifying Goods and Services

* Choose ONE method for adding the Goods and/or Services:  ○ Searching IDManual  ○ Entering Free-form text

NOTE: For an instructional video on goods and services and the importance of making the proper selection, click here.

Add Class(es) of Goods/Services

Click on the above button to create the next class. For more instructions, click here.

Remove Checked Class(es)

Click on this button to remove a class entirely. For more instructions, click here.

Class(es) of Goods/Services

<table>
<thead>
<tr>
<th>International Class</th>
<th>Goods and/or Services</th>
<th>Assigned Filing Basis(es)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Unknown</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Instructions:
- Enter the common commercial name for the specific goods and/or services associated with your mark. Failure to list your goods and/or services accurately could prevent registration. Separate each specific item with a semicolon or comma.
- Do not enter a Class Number in the text box below.
- Do not include html or other programming code or language that may create embedded links.
- Do not use abbreviations, brackets ([]), or braces ({}).

You should review the USPTO Goods Services ID Manual (ID Manual) before entering items below. You are not required to use an entry from the ID Manual; however, if your entry is not from the ID Manual, you must describe your goods and/or services in specific, clear, and concise terms.

ID Assistance (optional feature):
Before continuing to the next screen, you may want to use the ID Assistance tool, which may result in more efficient processing of your application. This tool compares your proposed identification (ID) of goods/services with the ID Manual’s list of acceptable entries. Once you have reviewed the results, you can then revise your entry to follow the acceptable language from the ID Manual, if the language from the ID Manual is accurate for your goods and/or services.

ID Assistance Instructions:
1. After entering your goods and/or services in the text box by following the above instructions, select one of the four buttons below to specify how this tool should search the wording (i.e., by semicolons, commas, both, or neither) for comparisons with the ID Manual wording.
2. Click "Analyze."

Note: For accurate results, use only characters from the English alphabet. Do not enter the following special characters such as accent marks, punctuation other than hyphens, commas, or semicolons, or more than 4,000 characters. For additional information, please see the detailed instructions.
- Semicolon: Searches all wording separated by a semicolon as a single clause. Commas will be ignored.
- Comma: Searches all wording separated by a comma as a single clause. Semicolons will be ignored.
- Both: Searches all wording separated by a comma or a semicolon as a clause.
- None: Searches all wording as a single clause. Commas and semicolons will be ignored. (This is rarely appropriate.)
Goods vs. Services

GOODS

SERVICES
Choose One or More Classifications

Your Choices

Choose a Pre-Written Classification Description

Write Your Own Description
There are 115 consulting classification descriptions under code 035 in the USPTO Manual.

Here are the first 40:

* 035 - Business Consultancy
* 035 - Business Consultation
* 035 - Business Consultation Services
* 035 - Business Consulting, Management, Planning & Supervision
* 035 - Business Consulting Services, Namely, Providing Assistance in the Development of Business Strategies and Creative Ideation
* 035 - Business Advisory Services Relating to Business Management and Business Operations
* 035 - Business Management Consultancy
* 035 - Business Management Consultancy & Advisory Services
* 035 - Business Management Planning
* 035 - Business Strategy Development Services
* 035 - Business Strategic Planning Services
Use-in-Commerce
Submitting a Specimen

**GOODS**
- Label
- Tag
- Container for the goods
- Display

**SERVICES**
- Print ad
- Brochure
- Direct mail piece
- Web page printout
- Billboard ad
Pay the Fee and Sign the Application

Make sure the right person signs the application!
Do-It-Yourself, Legal Document Services Provider, or an Intellectual Property Attorney?

**Do-It-Yourself**
- You choose the type of mark
- You pick the goods and services classification and description
- You or the legal document services provider (e.g., LegalZoom) fill in and submit the application to the USPTO
- You are the point of contact for all USPTO communications (which can be confusing)

**Legal Document Services Provider**
- Helps you choose the type of mark to submit
- Helps you pick the best goods and services classification and description
- Completes and submits the application to the USPTO
- Is the point of contact for all USPTO communications

**Intellectual Property Attorney**
- Helps you resolve any questions or problems from the USPTO examining attorney
How much is it worth to you to protect your business?
Learning Objectives

1. Understand what happens after you submit your trademark application
2. Determine what to do if the response to your trademark application is positive
3. Identify what to do if the response to your trademark application is negative
What Happens after You Submit Your Trademark Application?

- Application Reviewed for Accuracy
- Specimen of Use Reviewed
- Descriptive vs. Generic Mark Review
- 13 Factors of Possible Consumer Confusion Reviewed
What Happens if the Response is Positive?

- If There Are No Problems with the Application, Trademark Goes to Publication
- Third Parties are Given 30-Days to Oppose the Registration
- Third Parties Can Request to Extend Time to Oppose
- If There is No Opposition, Mark Registered
What Happens if the Response is Negative?

If There are Problems with the Application, Examiner Issues Office Action

You Have 6 Months to Answer Questions & Address Concerns in the Office Action

If There are Still Problems, Examiner Issues Second Office Action

You Have 6 Months to Respond to the Second Office Action

If the Office Actions are Resolved, Trademark Goes to Publication

Third Parties are Given 30-Days to Oppose the Registration

Third Parties Can Oppose the Mark’s Registration

If There is No Opposition, Mark Registered
1. Choose a strong mark.

2. Conduct a comprehensive search for potential conflicts.
Learning Objectives

1. Understand how to use trademark symbols
2. Identify what happens if you don’t use your trademark
3. Learn the right and wrong ways to use your trademark
What are Trademark Symbols?

- **TM** (Registered Trademark)
  - For unregistered marks that represent goods
  - Includes marks with applications still pending with USPTO

- **SM** (Service Mark)
  - For unregistered marks that represent services
  - Includes marks with applications still pending with USPTO

- **®** (Registered in the U.S. Patent and Trademark Office)
  - For all marks registered in the U.S. Patent and Trademark Office
  - Includes only federally registered marks

**REPRESENT CLAIM OF OWNERSHIP ONLY**
Registration Symbol: Regulated by Federal Law

Deliberate Misuse

Innocent Misuse

FRAUD
CIVIL OFFENSE

FIX AS SOON AS POSSIBLE

Federal Law
Use is king.

NON-USE could equal ABANDONMENT
Trademarks and Constructive Notice

Federally registered trademark is yours to use, enforce, and exploit.

Symbol provides constructive notice of your claim of trademark rights.

By providing constructive notice, you can collect monetary damages or recover lost profits in an infringement lawsuit.
Learning Objectives

1. Understand how to maintain and monitor your trademark over time
2. Learn what to do if someone infringes on your trademark
Before the end of the 6th year following the original registration date.
(You can request a 6-month grace period after that date if necessary).

Before the end of every 10-year period after the original registration date.
(You can request a 6-month grace period if necessary.)

Trademark is Registered with the USPTO

File a Declaration of Continued Use and Application for Renewal

File Declaration of Continued Use
How to Maintain Your Trademark: Ongoing Searches

- USPTO database & Official Gazette
- Trademark Search Monitoring
- Third-Party Watch Service
- Intellectual Property Attorney
- Internet Searches
How to Maintain Your Trademark: Enforcement

- **DO** Send a Cease and Desist Letter
- **DON’T** Cause a Declaratory Judgment
- **DO** Start by Assuming They’ll Comply
- **DON’T** Start by Attacking
The Keller Law Firm

We help entrepreneurs and innovators protect and profit from their intellectual property.

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