

# The Basics of Trademarks

An Administrators guide

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# What is the purpose of a Trademark/Service mark?

- ▶ Allow the public to make informed decisions and to differentiate between competing products and companies.
- ▶ To protect the providers' investment in their reputation.
- ▶ The Supreme Court held in *Qualitex Co. v. Jacobson Products Co (1995)* that:
  - ▶ "[T]rademark law, by preventing others from copying a source-identifying mark, 'reduce[s] the customer's costs of shopping and making purchasing decisions,' for it quickly and easily assures a potential customer that ... the item with this mark ... is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation related rewards associated with a desirable product."

# What is a Trademark?

The term trademark is often used when referring to a service mark but the two words have different meanings and requirements.

- ▶ A **Trademark** is any word, name, symbol, or device or any combination used by a person
- ▶ To identify and distinguish the **goods** of such person, including a unique product, from those manufactured or sold by others
- ▶ To indicate the source of the goods, even if that source is unknown.
- ▶ A trademark isn't a verb (or noun), it's an intangible asset.

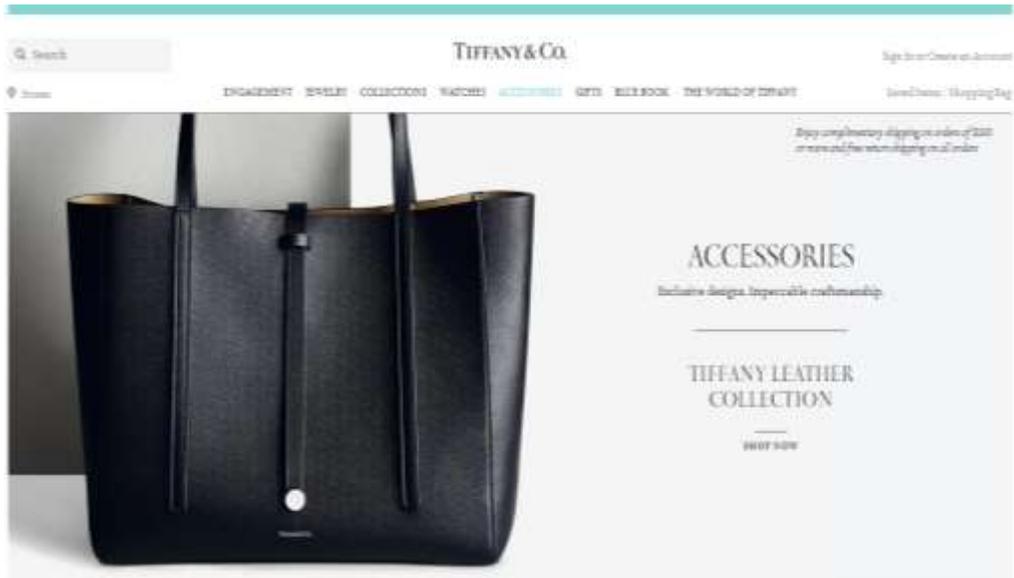
# What is a Service Mark?

A service mark is registered for a non tangible service.

- ▶ A **Service mark** is any word, name, symbol, or device or any combination thereof used by a person,
- ▶ To identify and distinguish the **services** of one person, including a unique service, from the services of others
- ▶ To indicate the source of the services, even if that source is unknown.
- ▶ Titles, character names used by a person, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

# Can a mark be both a trademark and a service mark?

**YES** – If the mark meets the criteria for both.



- ▶ Tiffany & Co. is a service mark of Tiffany and Company to identify its services of providing online retail sales of jewelry and accessories.
- ▶ Tiffany & Co. is a trademark for jewelry produced by Tiffany and Company.



# What a trademark **isn't**

Trade name or DBA

Business Entity Name

A trade name or business entity name does not necessarily qualify for Trademark or Service Mark registration.

- ▶ A trade name is "any name used by a person to identify a business or vocation of such person."
- ▶ A **trade name** is adopted and used for the purpose of identifying the company and distinguishing it from other companies.
- ▶ A **trademark** is adopted and used for the purpose of identifying the company's goods/services and distinguishing the goods/services from those produced by others.

# Trade Name versus Trademark

- ▶ Whether a trade name may be registered as a trademark will depend on how it is used.



This sample of use (“specimen”) does not support use of “Leading Edge Toners” as a trademark for the toner products shipped by the retailer to the customer.

This sample simply identifies “Leading Edge Toners” as the company that sold and shipped the toner product to the customer.

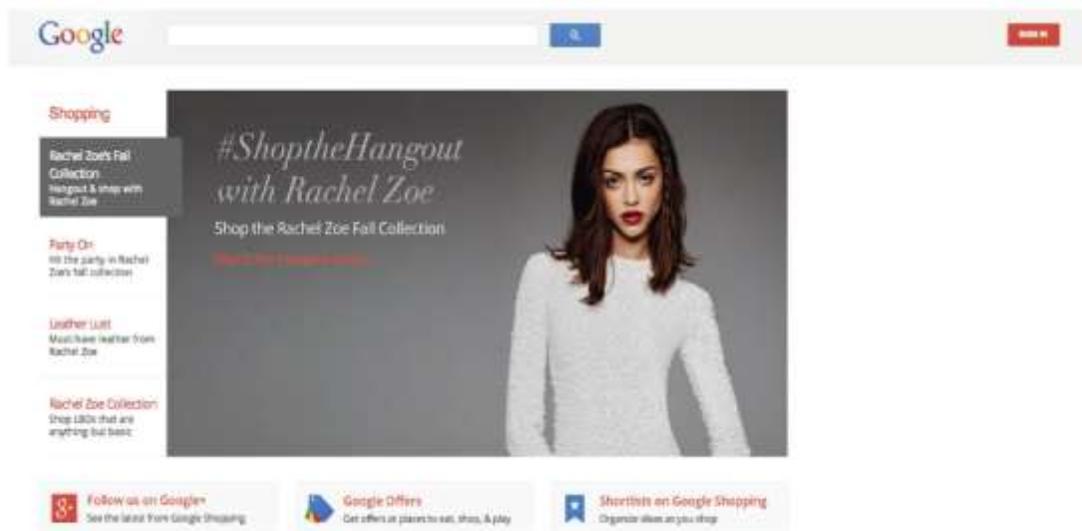
This label does not support use of “Leading Edge Toners” as a trademark for toner products.

# Trade Name versus Service Mark

A trade name can be registered as a trademark or service mark, but only when used as a trademark or service mark.

Google is also used as a service mark to identify the company's online retail store services featuring the goods of others.

- ▶ For example:
  - ▶ Google Inc. is the business entity name of a Delaware corporation.
  - ▶ Google is a trade name used by the company, as shown below.
    - ❑ **Google's** mission is to organize the world's information and make it universally accessible and useful.
    - ❑ Our company has packed a lot into a relatively young life. Since **Google** was founded in 1998, we've grown to serve millions of people around the world.



# Marks are Different

- ▶ Trade and Service Marks are not simply a filing. They are a registration conferring a status granted by Federal and State Governments.
- ▶ State Government actually has a public policy interest in the issuance and registration of a mark.
- ▶ The purpose of mark registration is to protect the public from being confused by similarly designated products.

# Marks are Different

- ▶ Unlike situations involving the same or similar corporate names, the holders of a conflicting mark cannot simply consent to the use of a name by another.
- ▶ Prospective registrants must instead demonstrate that the public will not be confused by the registration of the similar and concurrent marks.

# Can I register my mark?

## Is the mark:

- ✓ In use?
- ✓ Acceptable?
- ✓ Distinctive?

# Is the Trademark in “Use”?

In use means the bona fide use of a mark in the ordinary course of trade.

Not made merely to reserve a right to a mark.

It is not sufficient to say that you plan to launch the new product or start a business using the mark.

- ▶ For a **Trademark**
- ▶ The goods are sold or transported in commerce in the state AND
- ▶ The mark is placed in any manner on the goods or other containers;
- ▶ The mark is placed on displays associated with the goods; or
- ▶ The mark is affixed directly to the goods by means of tags or labels.
- ▶ **If** the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.
  - ▶ An airplane
  - ▶ A prefabricated metal building
  - ▶ A brand of veneer teeth

## Is the Service Mark in “Use”?

In use means the bona fide use of a mark in the ordinary course of trade.

Not made merely to reserve a right to a mark.

It is not sufficient to say that you plan to start your business.

- ▶ For a Service mark
  - ❑ Mark is used or displayed in the sale or advertising of the services **AND**
  - ❑ The services are rendered in the state of filing.



## Is it acceptable?

Trademark act has restrictions and limitations on what may be registered.



Registered mark of Bank of America Corporation

- ▶ Does mark consist of the flag or coat of arms or other insignia of the US or of any state or municipality, or of any foreign nation?



Not Registrable

## Is it acceptable?

Trademark act has restrictions and limitations on what may be registered.

- ▶ Does mark consist of the name, signature or portrait identifying a particular living individual, except by the individual's written consent?

# Registration Needs Consent

## DECLARATION OF DEBBIE MCKEE-FOWLER

I, DEBBIE MCKEE-FOWLER, hereby declare as follows:

1. I am the individual who is referred to and whose likeness appears in U.S.

Trademark Application Serial No. 86/430,965 for registration of the trademark:



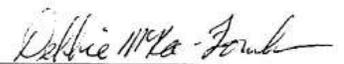
("LITTLE DEBBIE & Design") filed by McKee Foods Kingman,

Inc. with the United States Patent and Trademark Office (the "USPTO").

2. I hereby consent to the use and registration by McKee Foods Kingman, Inc. of my name and likeness as a trademark with the USPTO.

3. All statements made in this declaration of my own knowledge are true and all statements made on information and belief are believed to be true. These statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of this application or any resulting registration.

Dated: 2-6-15

  
Debbie McKee-Fowler



Registered Trademark of:  
McKee Foods Kingman, Inc.  
U.S. Reg. No. 4,763,816  
Registered June 30, 2015  
Classes 29 & 30

## Is it acceptable?

Trademark act has restrictions and limitations on what may be registered.

This determination may sometimes be subjective.

- ▶ Does mark consist of matter which may disparage or falsely suggest a connection with:
  - ▶ Persons, living or dead,
  - ▶ Institutions,
  - ▶ Beliefs,
  - ▶ National symbols,
- ▶ Or, bring them into contempt, or disrepute?
- ▶ Does mark consist of immoral, deceptive or scandalous matter?

# Does mark disparage or bring into contempt a group of individuals ?

The current attitudes of the day must be considered when determining the meaning imparted by the mark.

## ▶ Dykes on Bikes

More than two dozen expert declarations from scholars, linguists, psychologists, and activists demonstrating how the word "dyke" has evolved to become a positive term and that lesbians view "DYKES ON BIKES" as a symbol of pride and empowerment.

Does mark consist of immoral, deceptive or scandalous matter?

What would the average person think?

It is the responsibility of the applicant to prove mark is not immoral, deceptive, or scandalous.

The applicant might have to take additional steps beyond “filing” to get a Mark registered.

- ▶ Applicants might be asked to “provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace.”
- ▶ Evidence may include “dictionary definitions, newspaper articles, and magazine articles.”

# Is Mark Distinctive?

Design Mark

vs.

Standard Character Mark

When people hear the word "trademark", most people think of a logo.

- ▶ McDonald's Golden Arches



- ▶ Nike Swoosh



- ▶ Starbucks



# Design mark vs. Word mark

Design mark - Comprises stylized words, letters, numbers, or a combination thereof, and/or a design element (i.e., a logo).

The design may appear by itself, or combined with the stylized words, letters, and numbers.

While we talk about the “distinctive” criteria, we will just focus on standard word marks.



vs.

CHICK-FIL-A

# Word Marks

## Standard Character Mark

A standard character mark, also known as a “word mark,” consists solely of words, letters, numbers, or a combination thereof.

- ▶ A standard character word mark makes no claim to design element, stylization of the letters or numbers, and no claim to colors or size.
- ▶ A distinct text-only typographic treatment of the name of a company, institution, or product name used for purposes of identification and branding.
- ▶ To keep things simple, in the next slides we will talk exclusively about standard character word marks.

## Registrable

- Fanciful
- Arbitrary
- Suggestive

## Needs Acquired Distinctiveness

- Merely Descriptive
- Surname
- Primarily Geographically Descriptive

## Never Registrable

- Commonly Used Name of the Class of Product/Service
- Commonly Used Adjective for Significant Attribute of Product/Service



Distinctive

Not  
Distinctive

Generic

# Distinctive Marks—Registrable

- ▶ *Arbitrary or fanciful* – arbitrary and fanciful marks are closely related in that they both are inherently distinctive and receive the highest degree of protection.
  - *Arbitrary marks* contain real words that are used arbitrarily with respect to the product or service.
  - *Fanciful marks* are completely made up terms. A fanciful mark has no other meaning other than its trademark significance.
- ▶ *Suggestive* – suggestive marks automatically receive protection and don't require evidence of secondary meaning. A suggestive mark may imply something about the product/service without directly describing it.

# Non-Distinctive Marks

- *Descriptive* – descriptive terms, because they are not inherently distinctive, are not generally given trademark protection unless a secondary meaning due to the public association of the mark with the holder's product or service can be proven. Such secondary meanings can be found when a significant number of consumers and other companies associate the mark with the specific product or service.
- *Generic* – generic or common descriptions receive no protection under the law of trademarks.

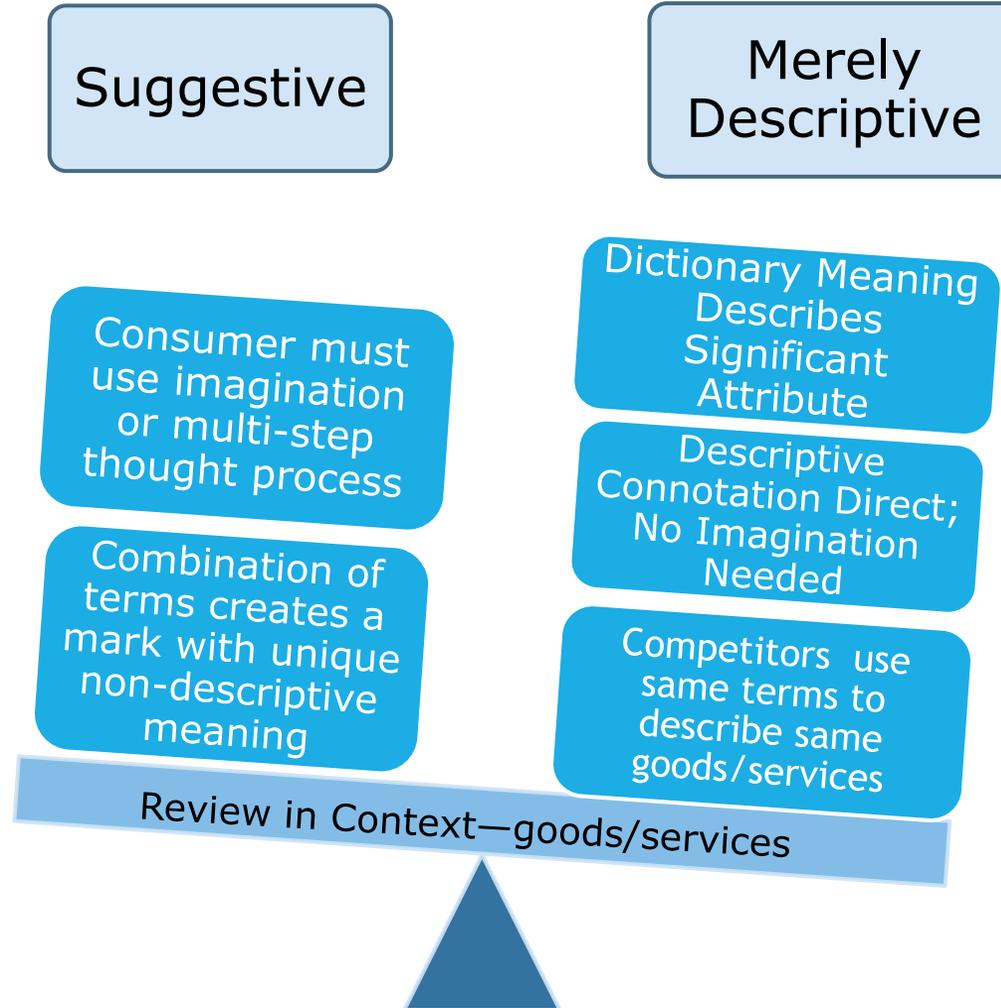
# Types of Descriptiveness

A mark is “merely descriptive” and not distinctive if:

- ▶ Mark immediately and directly conveys information about a function, characteristic, ingredient, or feature of the goods/services.
- ▶ Mark describes the class of users of the goods/services.
- ▶ Mark describes the products sold by the retailer.
- ▶ Mark describes the alleged merit of the goods/services.

# Suggestive or Merely Descriptive?

*No Bright Line*



# Acquired Distinctiveness

(aka Secondary Meaning)

- ▶ The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but a single source of those goods.
- ▶ The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered.
- ▶ Typically, more evidence is required where a mark is so highly descriptive that purchasers would be less likely to believe that the term indicates a single source.
- ▶ The burden of proving that a mark has acquired distinctiveness is on the applicant.

# Acquired Distinctiveness

## Evidence of Acquired Distinctiveness

- ▶ **Prior Registrations:** A claim of ownership of one or more active prior registrations on the Principal Register of the same mark for goods or services that are sufficiently similar to those identified in the pending application.
- ▶ **Five Years' Use:** A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made.
- ▶ **Other Evidence:** Other appropriate evidence of acquired distinctiveness (e.g., surveys, customer affidavits, etc.)

# U.S. Patent & Trademark Office Resources (<http://www.uspto.gov/trademark>)

The screenshot displays the USPTO Trademark website interface. At the top, the navigation bar includes the USPTO logo, the text 'UNITED STATES PATENT AND TRADEMARK OFFICE', and links for 'About Us', 'Careers', and 'Contact Us'. A search bar is positioned to the right of the logo. Below the navigation bar, a secondary menu features 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Quick Links' dropdown. The main content area is divided into sections: 'Getting Started' (with sub-links for 'Application Process' and 'Maintaining a Trademark'), 'Getting Started with Trademarks' (with introductory text), and 'Helpful Resources' (listing links for 'Trademark Basics', 'Using Private Legal Services', 'Non-USPTO Solicitations', 'Trademark FAQs', 'Trademark Process', and 'Madrid Protocol'). Below this, a 'Trademark Tools & Links' section is organized into a grid of eight tiles, each with an icon and a title: 'TESS Search Trademark Database', 'TEAS Filing Online', 'TSDR Check Status & View Documents', 'ESTTA TTABVue Trademark Trial and Appeal Board (TTAB)', 'ETAS AOTW Trademark Assignments', 'Trademark Application', 'View Fee Schedule', and 'Laws & Regulations'.

**uspto** UNITED STATES PATENT AND TRADEMARK OFFICE

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Patents Trademarks IP Policy Learning and Resources Quick Links

**Getting Started**

Application Process

Maintaining a Trademark

**Getting Started with Trademarks**

Before you apply for a trademark, you should familiarize yourself with the basics. Determine if you need a trademark or another form of Intellectual Property protection.

**Helpful Resources:**

- > Trademark Basics
- > Using Private Legal Services
- > Non-USPTO Solicitations
- > Trademark FAQs
- > Trademark Process
- > Madrid Protocol

**Trademark Tools & Links**

**TESS** Search Trademark Database

Search database for trademark registrations and applications by mark, owner, or serial/registration number with Trademark Electronic Search System (TESS)

**TEAS** Filing Online

File forms for the trademark application, maintenance and other trademark processes with Trademark Electronic Application System (TEAS)

**TSDR** Check Status & View Documents

Check the status of an application and view and download application and registration records using Trademark Status and Document Retrieval (TSDR)

**ESTTA TTABVue** Trademark Trial and Appeal Board (TTAB)

Trademark Trial and Appeal Board News and Notices ... Public Meeting! Report Out on the comments to the TTAB's Notice of Proposed Rulemaking : On June 24, 2016, the USPTO will...

**ETAS AOTW** Trademark Assignments:

**Trademark Application**

**View Fee Schedule:**

**Laws & Regulations**

# U.S. Patent & Trademark Office Resources

(<http://www.uspto.gov/trademark>)

- ▶ *Trademark Database* – The Trademark Electronic Search System [[TESS](#)] allows you to search both pending applications and registered trademarks and service marks.

Welcome to the **Trademark Electronic Search System (TESS)**. This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to a **likelihood of confusion** refusal.

**WARNING:** Before conducting your search, you must understand the following: (1) what the database includes; (2) how to construct a complete search; and (3) how to interpret the search results. Click [TESS TIPS](#) for detailed information on these and other important search topics.

[HELP](#) [News!](#)

Select A Search Option
▶ <b>Basic Word Mark Search (New User)</b> This option cannot be used to search design marks.
▶ <b>Word and/or Design Mark Search (Structured)</b> This option is used to search word and/or design marks. <b>NOTE:</b> You must first use the <a href="#">Design Search Code Manual</a> to look up the relevant Design Codes.
▶ <b>Word and/or Design Mark Search (Free Form)</b> This option allows you to construct word and/or design searches using Boolean logic and multiple search fields. <b>NOTE:</b> You must first use the <a href="#">Design Search Code Manual</a> to look up the relevant Design Codes.

# U.S. Patent & Trademark Office Resources

(<http://www.uspto.gov/trademark>)

- ▶ Trademark ID Manual – The Acceptable Identification of Goods & Services Manual is helpful to applicants and examiners. Provides a means of identifying descriptions of goods or services that contain multiple classes. Helps applicant's appropriately describe & classify their goods/services.
- ▶ Design Code Search Manual – The USPTO's design code manual provides some uniformity for indexing and/or searching marks that are comprised of only a design/logo.

# U.S. Patent & Trademark Office Resources

- ▶ Trademark Manual of Examining Procedure – The Trademark Manual of Examining Procedure (TMEP) provides federal examiners with guidelines and procedures to follow when examining federal applications for registration.
- ▶ Answers the question “WWFED?”
- ▶ Very useful materials and information may be downloaded at: <http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>



Trademark

Service Mark

Arbitrary

Fanciful

Suggestive

Secondary  
meaning

Generic

Deceptive

distinctive

immoral

Acceptable

Word Mark

Acquired Distinctness

Questions?