

Protection and Enforcement of Trademarks, in the U.S. and Abroad



Susan Anthony, Acting Director
Global Intellectual Property Academy
Office of Policy and International Affairs
Susan.Anthony@uspto.gov - (571) 272-1500



Life of a Trademark

I. CREATION

- Choosing a trademark or service mark

II. SCREENING and CLEARANCE

- Making sure the proposed mark is available

III. PROTECTION

- Seeking protection, country-by-country

IV. MAINTENANCE

- Renewing trademark registrations

Part I: LIFE OF A TRADEMARK



CREATION



Types of Trademarks

- Word Marks **KODAK**
- Design Marks
- Composite Marks containing both words and design
- Slogans



WE BRING GOOD THINGS TO LIFE



Unusual Trademarks

- Shape: Bottle shape for soda pop
- Color: Pink color for insulation
- Sound: Drums, trumpets and strings for entertainment / motion picture films
- Scent: Plumeria flower blossom scent for sewing thread
- Motion: Flying pegasus for movie studios



20thCenturyFox.mp3





Select Strong Trademarks!

In general, the more “**distinctive**” a mark is, the **stronger** it is and the **greater the scope of protection** the mark will receive in court against uses of the same or similar marks.

Because all trademarks do not receive or deserve the same scope of protection, the type of mark a business selects will have a direct effect on its ability to protect the mark.





Strength (inherent and marketplace)

“**Strength**” of a mark refers to its ability to identify and distinguish the goods/services of one party from those manufactured or sold by others and to indicate the source, even if that source is unknown.

“**Strength**” can be measured by two factors:

- 1) The degree to which the mark is **inherently distinctive** (fanciful, arbitrary or suggestive).
 - The more unusual, arbitrary, and fanciful a mark, the more **unlikely** it is that two independent entities would have chosen it.
- 2) The degree to which it is distinctive in the **marketplace**.
 - Fame, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition.
 - Even a mark that had to acquire distinctiveness may qualify as a very strong mark for likelihood of confusion analysis.



Trademark Continuum



Source Indicating Capacity

No Source Identifying Capacity

Generic
soda

Not Inherently Distinctive
– but may acquire.

Merely Descriptive
COASTER-CARDS

Inherently Distinctive

Suggestive
VERICHECK

Arbitrary
APPLE

Fanciful
EXXON

Part II: LIFE OF A TRADEMARK



SCREENING and CLEARANCE



Types of Trademark Protection in the U.S.

- **Common Law** – unregistered; derived from use. “TM”
- **State Registration** – the “truly local.” Registered with one or more U.S. states
- **Federal Registration®** - interstate commerce or between the U.S. and another country.
- **Other Federal Statutes**
 - Smokey Bear
 - Woodsy Owl





SCREENING and CLEARANCE in the U.S.

- **USPTO DATABASE**
 - Federally registered trademarks and pending applications for registration
- **STATE TRADEMARK REGISTRIES**
- **DOMAIN NAME SEARCH**
 - Generic Top Level Domains (gTLDs)
 - Country Code Top Level Domains (ccTLDs)
- **COMMON LAW SEARCH**
 - the Web, trade names, trade directories, etc.

Obtaining a **“full search”** helps to ensure that these other sources of information will be considered in clearing trademarks.



Conducting a search can save a company time, money and grief! ... How?

Danger!

- Avoid having to change your mark – in every place it appears.
- Avoid having to recall existing product with the infringing mark.
- Avoid having to destroy existing product with the infringing mark.
- Avoid being held liable for damages to the owner of the mark – and possibly even attorney's fees.

PART III: LIFE OF A TRADEMARK



PROTECTION (Country-by-Country)



Does a Company Need to Register its Mark in the U.S.?

- Not required, because trademark rights (in the U.S.) arise from **use** on or in connection with goods or services, BUT...
 - There are significant **advantages** to having a federal trademark registration.



Advantages of Federal Registration on Principal Register

- **Public notice** of your claim of ownership of the mark;
- A **legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide** on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in **federal court**;
- The use of the U.S. registration as **a basis to obtain registration in foreign countries**;
- The right to use the **federal registration symbol ®**;
- Listing in the United States Patent and Trademark Office's **online databases**; and
- Registration may be recorded with **U.S. Customs and Border Protection** to prevent importation of infringing foreign goods.
 - The recordation fee for trademarks is US\$190 per International Class of goods.



How Do I Get a Federal Trademark Registration?

- File an application at the U.S. Patent and Trademark Office.
- You can complete an application online, check it for completeness, and file it over the Internet using the **Trademark Electronic Application System (TEAS)**.
 - **97.8%** of trademark applications were filed electronically in FY 09!
- Three ways to pay: credit card, automated deposit account or electronic funds transfer.





Filing Fees

**Filing fee for
paper filing:**

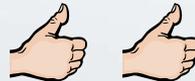


\$375 per class of
goods/services.

**Filing fee for
e-filing:**



\$325 per class of
goods/services if filed
using the “regular” TEAS
form.



\$275 per class of
goods/services if filed
using the **TEAS Plus**
form.



Legal Basis to File

What are the possible legal bases on which I can file an application to register a trademark in the United States?

- **Use** of the mark in commerce
 - bona fide use of a mark in the ordinary course of trade, and ***not*** made merely to reserve a right in a mark.
- A **bona fide intention** to use the mark in the future
 - Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), provides that an applicant may file an application based on a bona fide intention to use a mark in commerce “under circumstances showing the good faith of such person.”
- Foreign application or registration.



Examination Process at the USPTO

1. **File** Application (Current pendency = 3.1 months)
2. **Examination** by Trademark Examining Attorney → Allowed, Amended, or Refused.
 - Common grounds for refusal?



Examination Process at the USPTO – continued...

3. If **Allowed**, publication in the *Official Gazette* and Notice of Allowance (if intent-to-use).
4. If **Refused**, appeal to the Trademark Trial and Appeal Board (TTAB)
5. If Refusal is **affirmed**:
 - A) Appeal to a U.S. District Court *de novo*: or
 - B) Appeal to the United States Court of Appeals for the Federal Circuit (CAFC) on the administrative record.



Examination Process at the USPTO – continued.

6. After Publication, **Opposition period**. Both parties (Opposer and Applicant) have right to appeal the TTAB decision.
7. If no Opposition, **Registration** issues.
8. **Cancellation** proceeding available to cancel a registration. Both parties (Petitioner and Registrant) have right to appeal the TTAB decision. In general, the USPTO is not involved in inter partes appeals of TTAB decisions.



Trademark Timeline*

Examination: **3.1 months** from filing to examination.

Registration: **10.0 months** after filing.

* Figures are approximate and based on FY 2013 performance.



Congratulations!

**TRADEMARK
REGISTRATION
CERTIFICATE**





Trademark Registration Information on uspto.gov

Highlights



Popular Links

- [Documents for Prosecutors](#)

First-Time Filers, Start Here

TRADEMARK BASICS

[View How-To Videos, FAQs, the Basic Facts Booklet, processing timelines and the ID Manual.](#)

Tools

TESS search trademarks

Search pending and registered marks using the [Trademark Electronic Search System \(TESS\)](#).

TEAS file forms online

File applications and other documents online using the [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 \(TSDR\)](#) (combining TARR and TDR).

ASSIGN assignments

Transfer (assign) ownership of a mark to another entity or change the owner name and search the [assignments database](#).

TTAB trademark trial & appeal board

Visit the [Trademark Trial and Appeal Board \(TTAB\)](#) online.

DASHBOARD

Visit the [Trademark Dashboard](#) for Trademark Operation performance measurements.



Is Federal Registration Valid Outside the United States?

- **No.**

Trademark rights are *territorial*: rights in particular trademarks exist only within the country whose laws granted those rights.



Protecting Trademarks Abroad

- Be proactive in protecting trademarks!
- Have you considered registering your mark in countries in which:
 - Your goods or services are **marketed**;
 - Products or parts for your products are **manufactured**;
 - **Research and development facilities** are located;
 - Your products are **trans-shipped**;
 - You **might expand your business** in the future;
 - **Counterfeiting** is likely to be a problem; and
 - Where your **competitors** are.

PART IV: LIFE OF A TRADEMARK



MAINTENANCE



Maintain Trademark Registrations

- In The U.S.
 - Evidence of continued use: submitted between 5th and 6th year.
 - Renewal: submitted between 9th and 10th year.
 - Electronic forms can be completed very easily; much of the data is entered automatically.
- Other Countries
 - First-to-file, but generally can be cancelled after 3 years of non-use.
 - Renewal terms and procedures vary by country.



Maintain Your Trademarks: Tips on Proper Trademark Usage

- Distinguish your trademark from surrounding text, e.g., use capital letters or italics, as in a XEROX photocopy or a KLEENEX tissue.
- Use your mark in its proper form; avoid pluralizing it or making it possessive.
- Use the mark as an adjective and couple it with a descriptive or generic term, e.g., a Xerox copy.
 - Not as a noun, e.g., use “copy”, not “Xerox”.
 - Not as a verb, e.g., use “photocopying”, not “xeroxing”.
- If your mark is federally registered, use the ®. Other countries may have different marking symbols.



Maintaining Your Trademarks: Don't Lose Your Rights!

- Register your marks and maintain the registrations.
- Use your mark, use your mark as a mark, and use your mark consistently. Use notices of prior right.
- License use of your marks, **in writing**, with your manufacturers, your distributors, and any other authorized third-party users, and exercise **quality control** over your licensees' products. Some countries may require recordation of licenses.
- Monitor the USPTO *Official Gazette* (and similar publications in other countries), monitor the marketplace, and STOP unauthorized third-party uses.



Trademark Disputes

- **Administrative** (Registration)
 - Opposition @ Trademark Trial and Appeal Board (TTAB)
 - Cancellation @ TTAB
- **Court** (Use)
 - Federal
 - State
- **U.S. International Trade Commission**
(Section 337 Proceedings)
- **Domain Names**
 - (U.S.) Anticybersquatting Consumer Protection Act (ACPA)
 - UDRP (generic top-level domains or gTLDs) (e.g., .com)
(Uniform Domain Name Dispute Resolution Policy)
www.icann.org/udrp
 - Country-code TLDs (e.g., .us, .ca, .mx)
http://arbiter.wipo.int/domains/cctld_db/index.html

Thank You!

