OVERVIEW OF TRADEMARK PROTECTION IN THE UNITED STATES
Trademarks serve as indications of **origin** and **quality**. They represent the “**goodwill**” or **reputation** your business and its products/services enjoy with the public.

- **Businesses** rely on their marks to identify their products and services and distinguish them from those of their competitors.

- The **public** relies on marks to distinguish among competing producers and as guarantees of quality.
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
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” 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.
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.
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.
Trademark Timeline*

Examination:  **3.0 months** from filing to examination.

Registration:  **10.7 months** after filing.

* Figures are approximate, and based on Q2 FY 2012 performance.
Congratulations!

TRADEMARK REGISTRATION CERTIFICATE
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.
• 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; or
  – Counterfeiting is likely to be a problem.
PART IV: LIFE OF A TRADEMARK

MAINTENANCE
Maintain Registrations!

- **In The U.S.**
  - Evidence of *continued use*: submitted between 5\textsuperscript{th} and 6\textsuperscript{th} year.
  
  - **Renewal**: submitted between 9\textsuperscript{th} and 10\textsuperscript{th} year.
  
  - Electronic forms can be completed very easily; much of the data is entered automatically.
The STOPFakes.gov Website

Global Partners
Discover information and tools developed by partner governments, private sector groups, and international organizations.

Business Tools
Find resources to protect your innovations, spur creativity, and market products safely at home and abroad. Read more

Consumer Tools
Learn how to spot a fake and where you can report counterfeit and pirated goods. Read more

U.S. Government Initiatives
Learn how we are working to improve intellectual property protection and enforcement for our companies in markets around the globe. Read more

Global Partners
Discover information and tools developed by partner governments, private sector groups, and international organizations. Read more

Intellectual Property
Learn about intellectual property. What is it? How do I protect it?

Find Help
Information about U.S. Government offices that can help my business.

Discussion Board
Discuss, share strategies, and get industry insights about business issues, including intellectual property rights.

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Thank You!