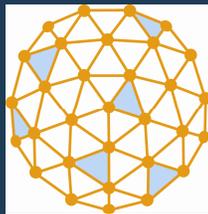


# OVERVIEW OF TRADEMARK PROTECTION IN THE UNITED STATES



UNITED STATES PATENT AND TRADEMARK OFFICE  
GLOBAL INTELLECTUAL PROPERTY ACADEMY



# Purpose of Trademarks

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



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)

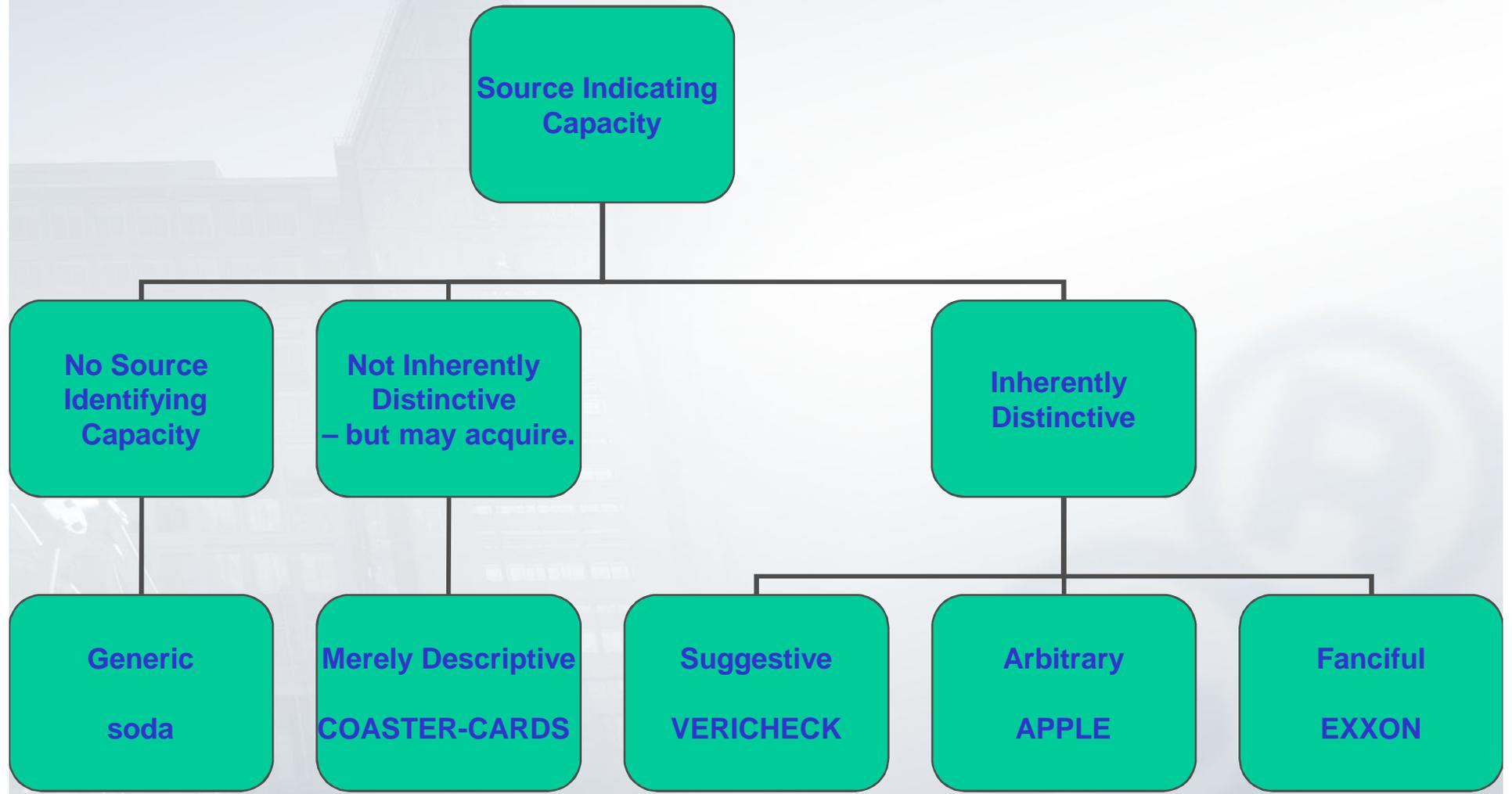
“**Strength**” of a mark refers to its ability to identify and distinguish the goods/services of one party from those manufactured or sold by others and to indicate the source, even if that source is unknown.

“**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



# Part II: LIFE OF A TRADEMARK

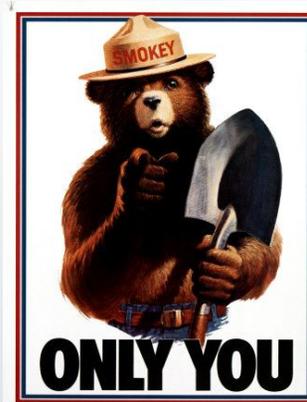


## SCREENING and CLEARANCE



# 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:**

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**\$375** per class of  
goods/services.

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**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.



# 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.



# 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.

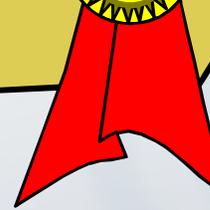
DASHBOARD

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



# 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.



# 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; 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<sup>th</sup> and 6<sup>th</sup> year.
  - **Renewal**: submitted between 9<sup>th</sup> and 10<sup>th</sup> year.
  - Electronic forms can be completed very easily; much of the data is entered automatically.



# The STOPFakes.gov Website



Your resource for IPR information and assistance

AAA 100%

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4 ||

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**China IPR Webinar Series**



Thank You!

