

# Trademarks in the United States

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# 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

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# Types of Trademarks

- Word Marks: **GULP OIL SKIMMERS**      **MILK MONEY RECORDS**

- Design Marks:



- Composite Marks containing both words and design:



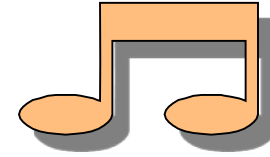
- Slogans:

**FROM OUR HEARTS TO YOUR HANDS**

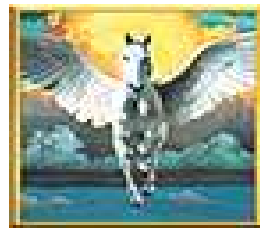
**CAN'T BEAT 'EM, EAT 'EM!**

# Some 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



uspto

# 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)

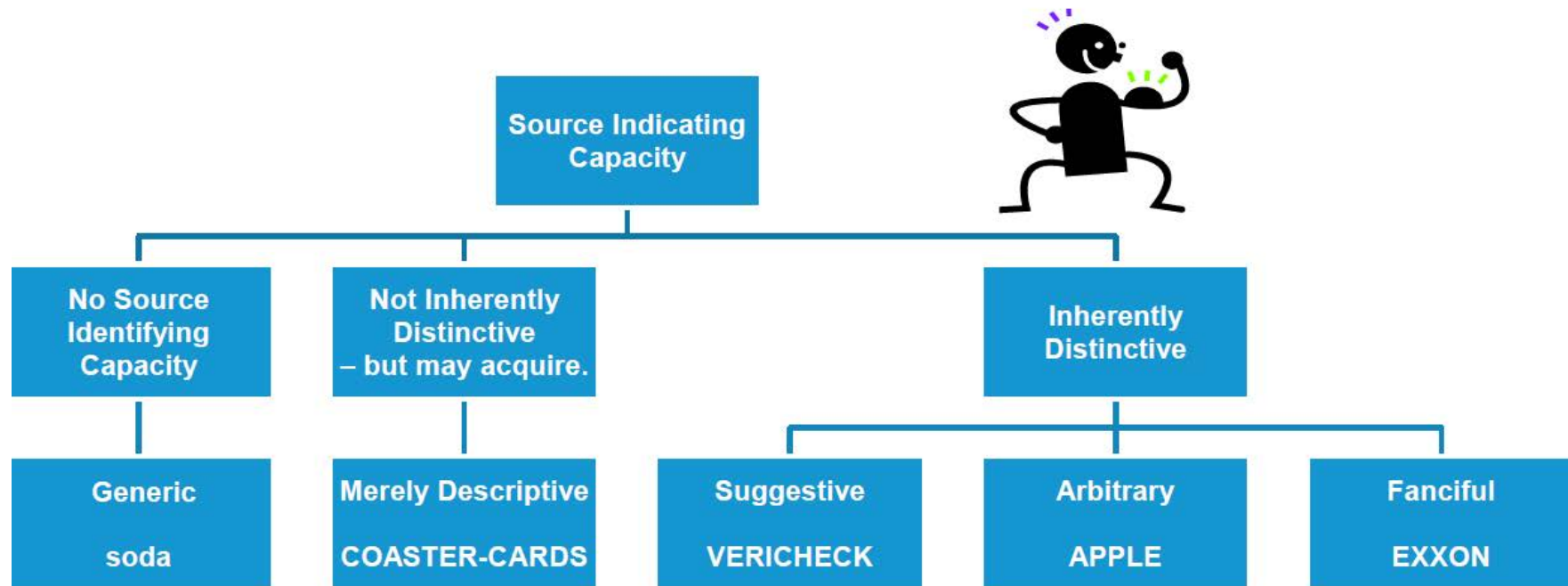
**“Strength”** of a mark refers to its ability to identify and distinguish the goods/services of one party from those manufactured or sold by others and to indicate the source, even if that source is unknown.

“Strength” can be measured by two factors:

- 1) The degree to which the mark is **inherently distinctive** (fanciful/coined, 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**

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# Types of Trademark Protection in the U.S.

- Common Law – unregistered; derived from use. “TM” “SM”
- 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)

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# 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).
- Three ways to pay: credit/debit card, automated deposit account or electronic funds transfer.



# Filing Fees

Filing fee for  
paper filing:

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**\$600** per class of  
goods/services.

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Filing fee for  
e-filing:



**\$400** per class of  
goods/services if filed  
using the “regular” TEAS  
form.



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



**\$225** per class of  
goods/services if filed  
using the TEAS Plus  
form.

# Legal Basis to File

On what legal basis can I 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 = **2.9** 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.

# Some Possible Substantive Grounds for Refusal

- (1) The applicant is **not the owner** of the mark (TMEP §1201) ;
- (2) The subject matter for which registration is sought does not function as a mark (15 U.S.C. §§1051, 1052, 1053, and 1127) because, for example, the proposed mark:
  - (a) is used solely as a **trade name** ( TMEP §1202.01);
  - (b) is **functional**, i.e., consists of a utilitarian design feature of the goods or their packaging (TMEP §§1202.02(a) *et seq.*);
  - (c) is a **nondistinctive configuration** of the goods or their packaging (TMEP §§1202.02(b) *et seq.*);
  - (d) is mere **ornamentation** (TMEP §§1202.03 *et seq.*);
  - (e) is the **generic name** for the goods or services (TMEP §§1209.01(c) *et seq.*); or
  - (f) is the **title of a single creative work** or the **name of an author or performing artist** ( TMEP §§1202.08 *et seq.* and 1202.09 *et seq.*);
- (3) The proposed mark comprises **immoral or scandalous** matter (TMEP §1203.01) ;
- (4) The proposed mark is **deceptive** (TMEP §§1203.02 *et seq.*);
- (5) The proposed mark comprises matter that may **disparage or falsely suggest a connection** with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute (TMEP §§1203.03 *et seq.*);
- (6) The proposed mark comprises the **flag, coat of arms, or other insignia** of the United States or any State, municipality, or foreign nation (TMEP §§1204 *et seq.*);

- (7) The applicant's **use of the mark is or would be unlawful** because it is **prohibited by statute** ( TMEP §§1205 *et seq.*);
- (8) The proposed mark comprises a **name, portrait, or signature identifying a particular living individual without the individual's written consent**, or the name, portrait, or signature of a deceased president of the United States during his widow's life, without written consent of the widow (TMEP §§1206 *et seq.*);
- (9) The proposed mark so resembles a previously registered mark as to be likely, when used with the applicant's goods and/or services, to **cause confusion or mistake, or to deceive** (TMEP §§1207 *et seq.*);
- (10) The proposed mark is **merely descriptive or deceptively misdescriptive** of the applicant's goods and/or services (TMEP §§1209 *et seq.*);
- (11) The proposed mark is **primarily geographically descriptive** of the applicant's goods and/or services (TMEP §1210.01(a));
- (12) The proposed mark is primarily **geographically deceptively misdescriptive** of the applicant's goods and/or services (TMEP §1210.01(b));
- (13) The proposed mark is **primarily merely a surname** (15 U.S.C. §1052(e)(4); TMEP §§1211 *et seq.*); or
- (14) The proposed mark merely identifies a **character in a creative work** (TMEP §1202.10).

TMEP = [Trademark Manual of Examining Procedure](#)



# Trademark Registration Timeline\*

Examination: **2.9** months from filing to examination.

Registration: **9.9** months after filing.

\* Figures are approximate, and based on Q1 FY17 performance.





# PART IV: LIFE OF A TRADEMARK

## MAINTENANCE (of Registration)

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- 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.

# \*\*\*TM Owners Must Be Alert!\*\*\*

Read every piece of IP correspondence Carefully!

- Trademark filing information is public information.
- Private companies not associated with the United States Patent and Trademark Office (USPTO) often use trademark application and registration information from the USPTO's databases to mail or e-mail trademark-related solicitations.
  - Many include offers:
    - (1) for legal services;
    - (2) for trademark monitoring services;
    - (3) to record trademarks with U.S. Customs and Border Protection; and
    - (4) to "register" trademarks in the company's own private registry.



# TM Owners Must Be Alert: Example

## UNITED STATES TRADEMARK REGISTRATION OFFICE

Trademark Registration and Monitoring Division

633 West Fifth Street

28<sup>TH</sup> Floor

Los Angeles CA 90071-2005

### IMPORTANT NOTIFICATION REGARDING YOUR FEDERAL TRADEMARK

Nashville, TN



### TRADEMARK

Serial Number: [REDACTED]

Filing Date: [REDACTED]

Primary Code: 041

Intl Code: 041

PROCESSING FEE → \$375.00

### DESCRIPTION

Owner

Trademark

Serial Number

Registration Number

Filing Date:

U.S. Customs & Border Protection (CBP), a bureau of the Department of Homeland Security maintains a trademark recordation system for marks registered at the United States Patent and Trademark Office. Parties who register their marks on the Principal Register may record these marks with CBP, to assist CBP in its efforts to prevent the importation of goods that infringe registered marks. The recordation database includes information regarding all recorded marks, including images of these marks. CBP officers monitor imports to prevent the importation of goods bearing infringing marks and can access the recordation database at each of the 317 ports of entry.

Upon receipt of this form and your payment United States Trademark Registration Office will:

A) Record your U.S. Trademark Registration with the U.S. Customs & Border Protection (CBP) and send you notice(s) when the blocking of such goods occurs. B) Monitor your trademark using USTRO's proprietary search engine and notify you regarding possible third party trademark infringement(s) (enforcing your intellectual property rights and protecting a trademark from confusingly similar names is essential and the sole responsibility of the owner and not the USPTO (United States Patent and Trademark Office)). C) Send you reminder notices of the following filing requirements. 1)

# Navigating the Trademark Application Process at the USPTO: **Resources**

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PATENT AND TRADEMARK OFFICE



[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



### Search trademark database

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

[TESS](#)

### Apply online

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

[TEAS](#)

### 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)

[TSDR](#)

### Trademark Assignments: Change & Search Ownership

During the examination of a pending trademark application as well as after a trademark has registered, the owner of a trademark may change for various reasons

[ETAS](#)[AOTW](#)

### Trademark Application and Post-Registration Process Timelines

The timelines provide an overview of the process steps and time frames for filing a trademark application with a particular filing basis and for maintaining a trademark

### Madrid Protocol

The Madrid Protocol is a treaty which provides a way to ensure protection for marks in multiple countries through the filing of one application with a single office

### Contact Trademarks

Through the above link, access all relevant trademark contact information, including that for the Trademark Assistance Center, TMFeedback, Law Office Managing and Senior Attorneys, Division Managers, and Trademark Electronic Application System.

### Order Certified Copies

Order certified documents with the USPTO ribbon and seal as well as the signature of an authorized certifying officer

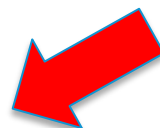


### United States Patent and Trademark Office's Trademark Educational Outreach Program

The United States Patent and Trademark Office (USPTO) is looking to partner with colleges and universities, entrepreneurship clubs, and similar groups to present informational lectures on trademarks

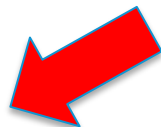
### Trademark Information Network

The Trademark Information Network (TMIN) presents news broadcast-style videos that cover important topics and critical application filing tips.



### Basic Facts Booklet

Learn how to protect your trademark and enhance your rights through federal registration. (PDF version)



### Recursos en Español para Registrantes de Marcas

Librete de Información Básica Sobre Las Marcas Registradas. Videos de Información Básica Sobre Las Marcas Registradas. Videos de la Red de Información Sobre Marcas Registradas.

### Basic Facts About Trademarks Videos

An animated video series that provides all of the basic information you need to know about trademarks.



# Trademark Tools & Links



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TESS



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ETAS

AOTW



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The timelines provide an overview of the process steps and time frames for filing a trademark application with a particular filing basis and for maintaining a trademark

ESTTA

TTABVUE

# Apply online

**First timer?** [Get basic information before filing](#) to avoid mistakes that cost you time, money, and potentially your legal rights.

To apply for a trademark or servicemark, **select your form from the table heading below**. Once you select the form, you will be directed to our Trademark Electronic Application System (TEAS) where you can begin filing your application.

**Need more help** deciding which form to use or how to fill it out? [Watch the TEAS Nuts and Bolts video](#).



Trademark application forms (select one to start) --->	TEAS Plus form	TEAS Reduced Fee form	TEAS Regular form
Filing fee <a href="#">per class of goods/services</a>	\$225	\$275	\$400
E-mail address required for USPTO application-related correspondence?	Yes	Yes	No
Additional submissions, like responses to Office actions, must be filed online?	Yes	Yes	No
Goods/services listing must be selected from the USPTO Trademark Identification (ID) Manual?	Yes	No	No
Full Filing fee paid upfront (per class for all classes listed on the application)?	Yes	No	No
Certain statements regarding the mark be provided in the	Yes -	No	No

## 2. TEAS Nuts and Bolts: Applicant Information

This video explains how to fill out the Applicant Information page of the USPTO's federal trademark registration application. The information applies to TEAS Plus, TEAS RF, and TEAS Regular applications.



[http://helix-1.uspto.gov/player/TEAS\\_ApplicantInformation\\_508.html](http://helix-1.uspto.gov/player/TEAS_ApplicantInformation_508.html)

Printable Transcript of video [https://www.uspto.gov/sites/default/files/documents/nb\\_applicant\\_information\\_transcript.docx](https://www.uspto.gov/sites/default/files/documents/nb_applicant_information_transcript.docx)

# Intellectual Property Rights (IPR) Basics

Learn how to protect your innovations, spur creativity, and market products safely at home and abroad

GET THE BASICS



Business Guide to Intellectual Property Rights



Consumer Guide to Counterfeits & Pirated Goods



Get Help Resolving IPR Issues



U.S. & Global IPR Initiatives



# The STOPFakes.gov Website

## ONLINE INTELLECTUAL PROPERTY TRAINING MODULE

Use the free Online IPR Training Module to learn about evaluating, protecting, and enforcing your intellectual property rights!

### BENEFITS OF THIS COURSE

- Learn about the different types of IPR, including copyright, patent, and trademark, as well as the legal protections available for each of them.
- Understand the process and benefits of acquiring and protecting your IPR.
- Discover resources to help you enforce your IPR.
- **Choose your language to get started!** This course is available in English, French, and Spanish.
- Download the full training module in [Adobe PDF English](#), [French](#), [Spanish](#).

# Thank You!

