

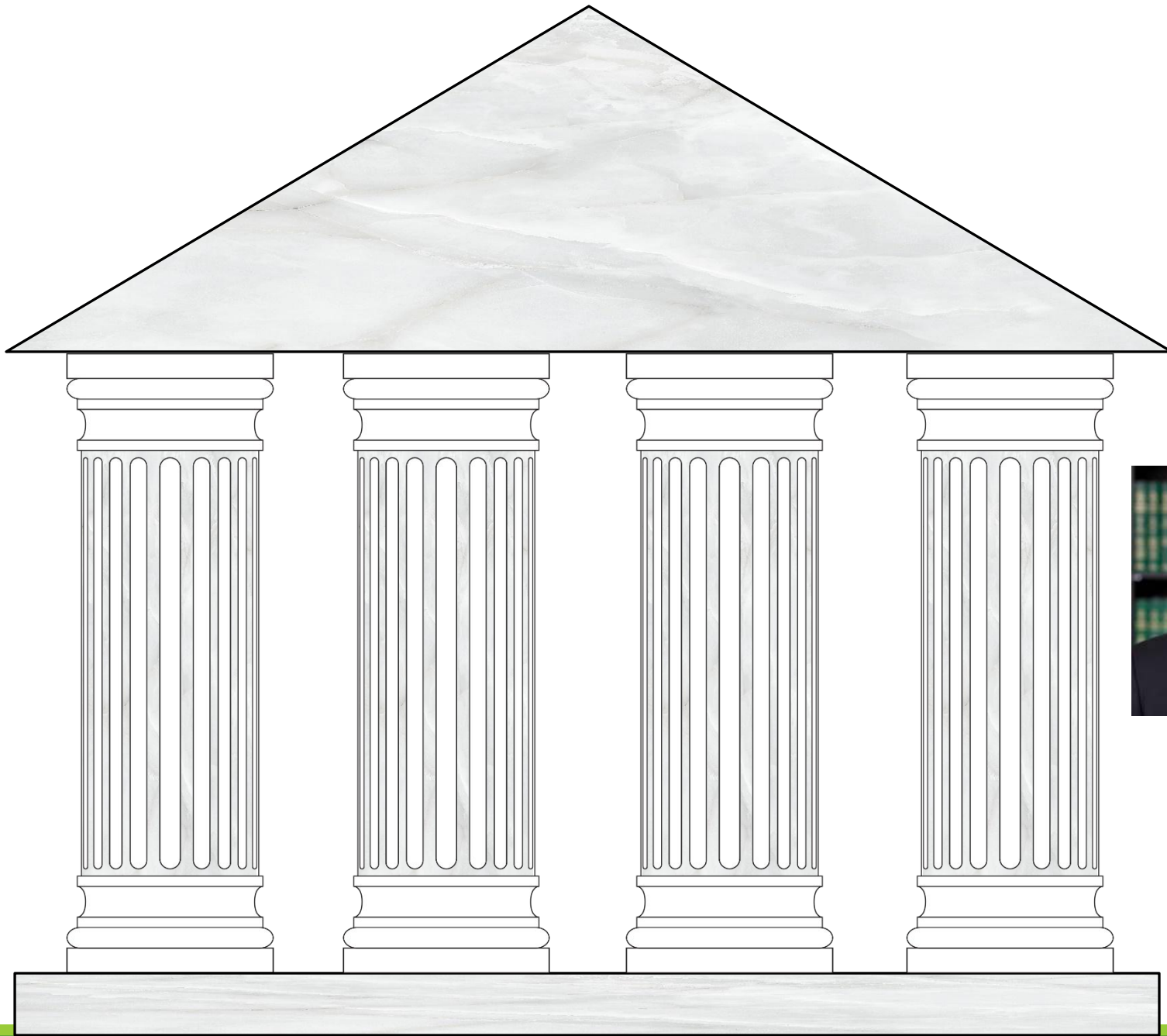
Trademark Basics: Protecting Your Brand!

Welcome to the presentation!

Please :

- Sign up using the iPad to get newsletter, e-book, consult
- Take a copy of *Bold Ideas: The Inventor's Guide to Patents*
- Handout slide packet (with space for taking notes)

We will get started around 12:00 PM!

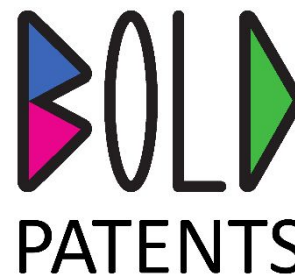


Trademark Basics: Protecting Your Brand!



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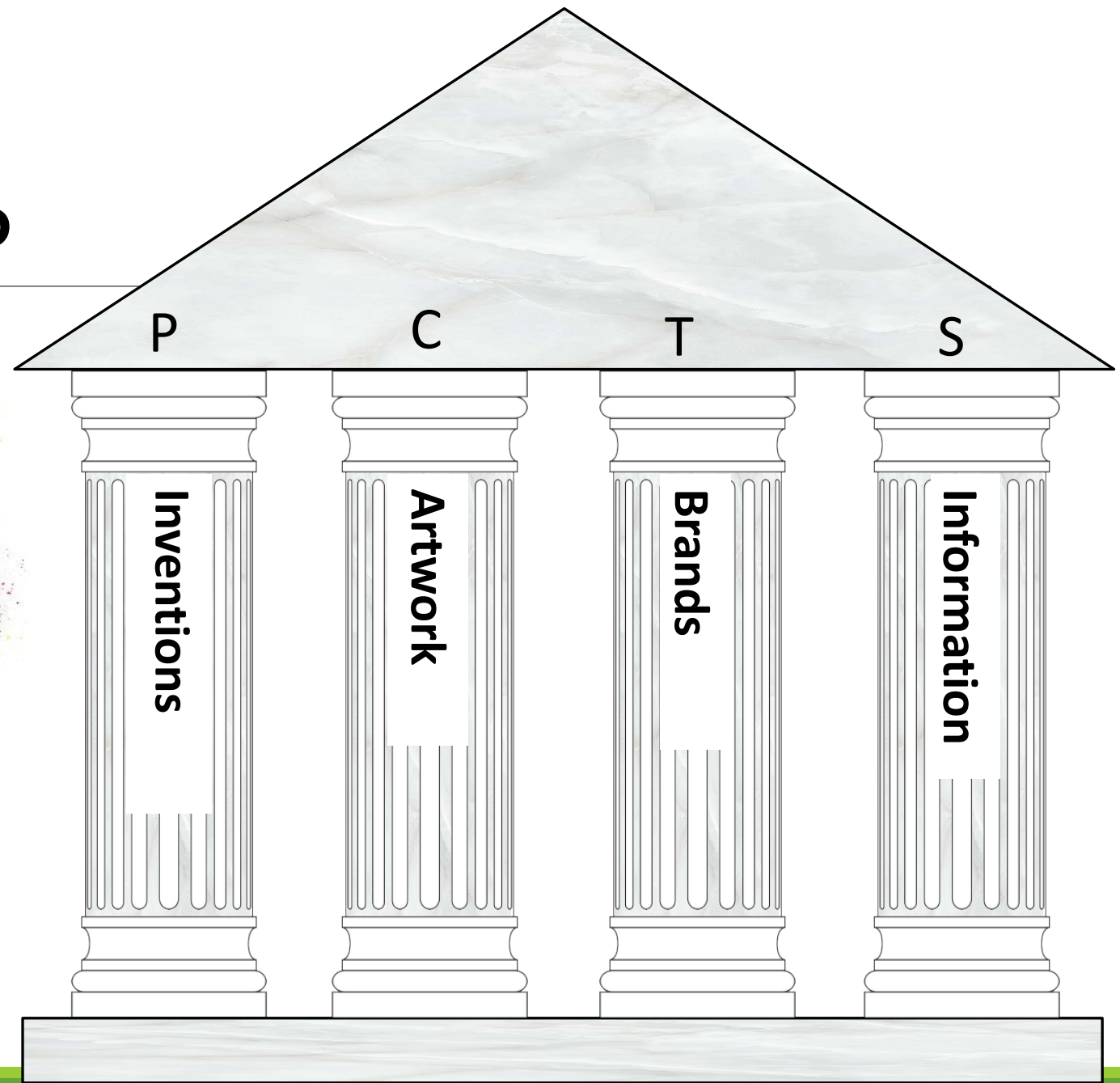
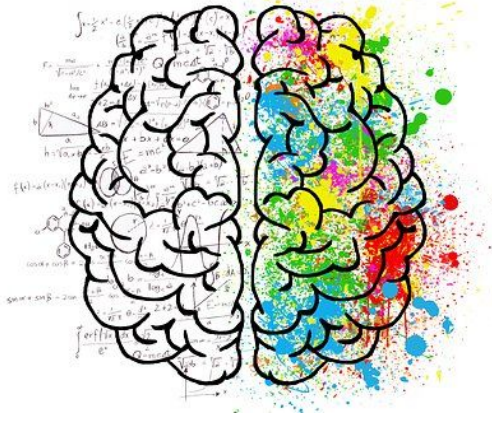
Agenda

- 12:00-12:10 Introductions & Around the Room
- 12:10-12:20 The 4 Pillars of IP
- 12:20-1:15 Primer on Basics of Trademark Laws
- 1:15-1:30 Q&A

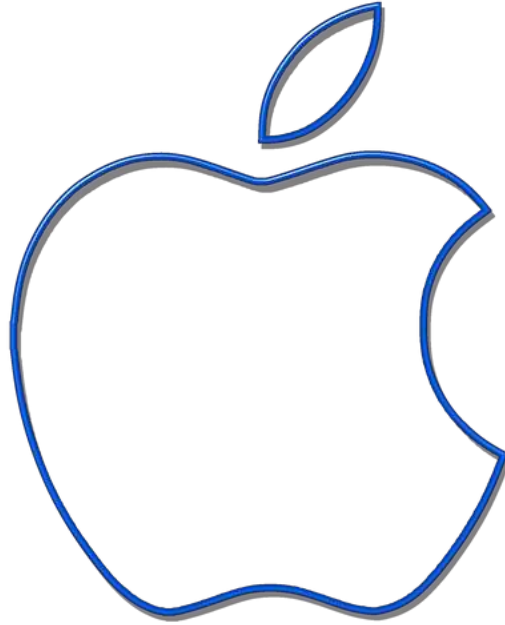


The 4 Pillars of IP

- Patents
- Copyrights
- Trademarks
- Trade Secrets



Trademark Law



Trademark Law Premise

A Federal Trademark registration gives a business or brand owner the right to exclude others from using a word or design mark within one or more legal classifications for as long as the mark is in use.

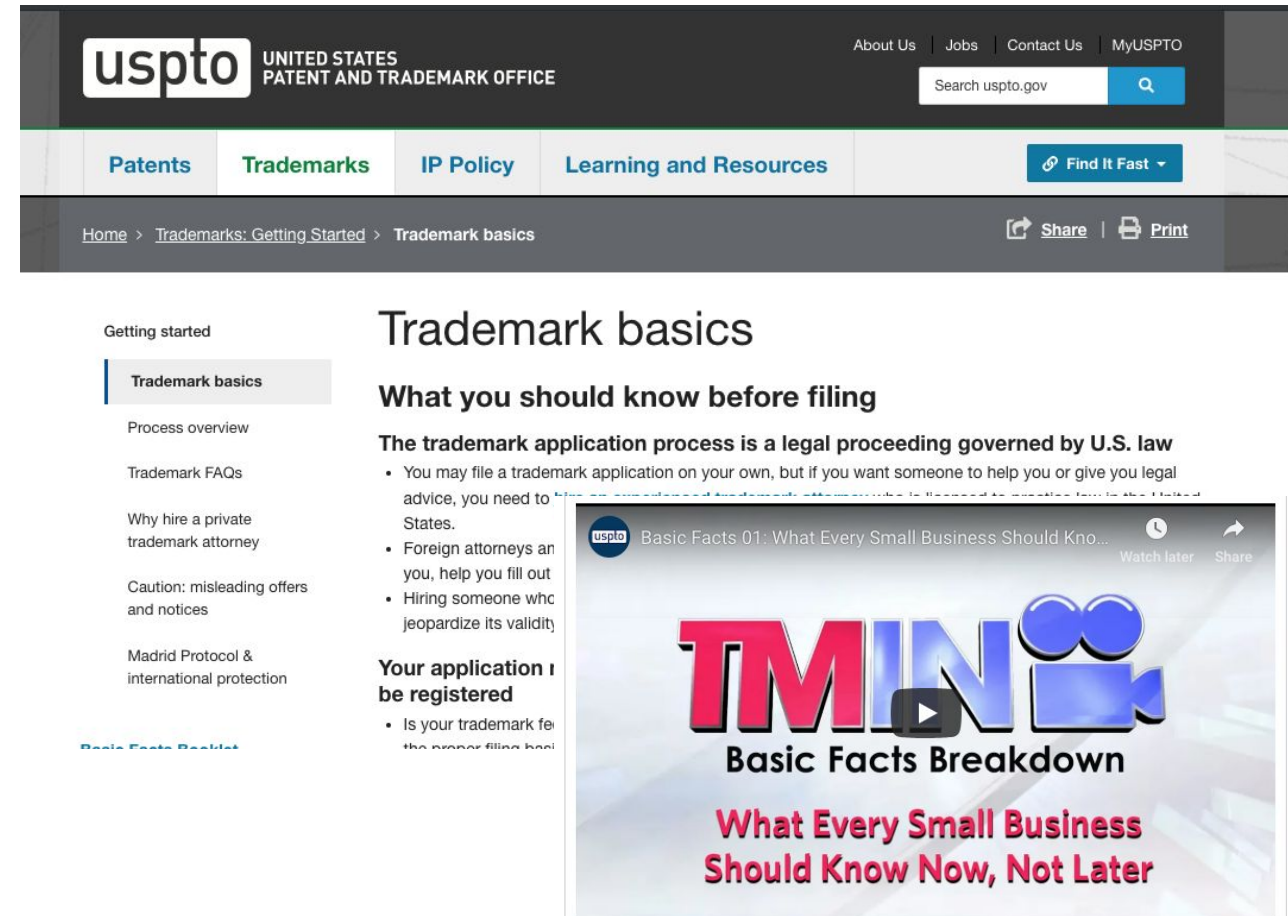


Shout out to USPTO!!!

Incredibly Well Done Trademark Intro Course:

- <https://www.uspto.gov/trademarks-getting-started/trademark-basics>

Great Resource - Trademark Examination Manual (What Examiners Use): <https://tmep.uspto.gov>



The screenshot shows the USPTO website's 'Trademark basics' page. The header includes the USPTO logo, 'UNITED STATES PATENT AND TRADEMARK OFFICE', and navigation links like 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. A search bar is also present. Below the header, there's a navigation menu with 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. The 'Trademarks' section is active, showing a breadcrumb trail: 'Home > Trademarks: Getting Started > Trademark basics'. On the left, a sidebar lists 'Getting started' topics: 'Trademark basics' (selected), 'Process overview', 'Trademark FAQs', 'Why hire a private trademark attorney', 'Caution: misleading offers and notices', and 'Madrid Protocol & international protection'. The main content area is titled 'Trademark basics' and 'What you should know before filing'. It states that the trademark application process is a legal proceeding governed by U.S. law. A list of bullet points follows: 'You may file a trademark application on your own, but if you want someone to help you or give you legal advice, you need to...', 'Foreign attorneys an you, help you fill out', and 'Hiring someone who jeopardize its validity'. Below this, it says 'Your application i be registered' and lists 'Is your trademark fe the proper filing basi'. At the bottom right, there's a video player thumbnail for 'Basic Facts 01: What Every Small Business Should Know...' with the text 'TM IN Basic Facts Breakdown What Every Small Business Should Know Now, Not Later'.

Do I Have a Trademark?

3-Part Test for Trademark Protection:

- Distinctiveness
- Used in Commerce
- Source Identifying



Distinctiveness

Automatically Qualifies

Arbitrary Marks (Fairly Strong)

- Usually a common word which is used in a meaningless context of the product/service
- Requires *some* imagination
- Example is Blu-Ray (light is actually violet)

Fanciful Marks (Strongest)

- An invented word!
- Not in dictionary prior to registration
- Examples are Kodak or Xerox

Might Qualify:

Suggestive Marks

- Tends to indicate the nature, quality, or a characteristic of the products or services in relation to which it is used
- Requires *some* imagination
- Example is “Blu-Ray” (light is actually violet)

Descriptive Marks

- Dictionary meaning which is used in connection with products or services directly related to that meaning
- Example is “Salty” for Saltine Crackers or “Lektronic” for Electronics
- Generally NOT registrable without a *secondary meaning*

Does NOT Qualify:

Generic Marks

- The common name for the products or services in connection with which it is used
- Example is “Salt” for Sodium Chloride
- Brands that are not able to maintain distinction, can be subject to becoming generic for the good or service, this happened to many brands (Band-Aid, Escalator, Aspirin, Frappuccino, Photoshopped, Xerox)

Distinctiveness Workshop

Marks of Distinction! (Or Not?)

- Boeing
- Northwest Innovation Resource Center
- Everett Community College
- Completely Floored
- GroWashington
- Everett Steel
- Succurri



Use in Commerce

Test for When Mark is “Used in Commerce”

- Goods
 - Placed in any manner **on the goods** or their containers or the displays associated therewith or on the tags or labels affixed thereto or on papers related to item (if cannot put a mark on it)
 - Goods are sold or transported in commerce
- Services
 - Used or displayed in the **sale or advertising** of services and the services are rendered in commerce
- Intent to Use Filing
 - (Up to 18 months to provide SOU)



Not Confusingly Similar

Key Tests for Trademark Confusion:

- Relatedness of Goods/Services
- Similarity of Marks Themselves
- Appearance
- Meaning
- *Based on Ordinary Customer's Perspective*

Not Confusingly Similar

Examples:

- Bold IP vs. Bold Legal - [boldip.com v. bold.legal](#)

Conversely, here are some marks the courts found to be too similar in meaning:

- MR. CLEAN vs. MR. RUST
- THIRTY FORTY FIFTY vs. 60 40 20
- PLEDGE vs. PROMISE

Marks Found to Be Too Similar in Appearance:

- Magnavox vs. Multivox
- Simoniz vs. Permanize
- Platinum Puff vs. Platinum Plus
- Zirco vs. Cozirc
- Maternally Yours vs. Your Maternity Shop

The courts found the following marks too similar in sound:

- SEYCOS vs. SEIKO
- CRESCO vs. KRESSCO
- ENTELEC vs. INTELECT

Different Types of Trademarks?

Different Types of Trademarks:

- Word Marks
- Design Marks
- Service Marks
- State Marks



Trademark Law: The Lanham Act

Key Legal Concepts:

- First in Use Gets Priority
- USPTO Search & Examination
- Trademark Trial and Appeal Board (TTAB)
- Common Law rights prior to Registration



What Timing Considerations are There?

Timing Considerations

- Best to FILE even before use as an “intent-to-use” to make sure no one else files before you or shows evidence of use in commerce
- USPTO will Publish for Opposition (30 days)
- Must show *Continuous use* throughout
- Proper Notice of Trademark is TM until you have registration, then it's [®]

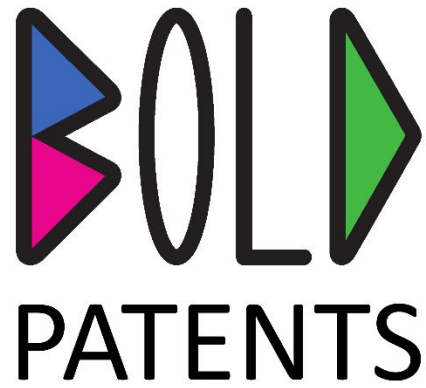


What if Someone Infringes my Trademark?

Mechanisms for Enforcement

- Infringement Opinion
- Cease & Desist
- Settlement
- Arbitration
- TTAB
- Federal Court





Simplified

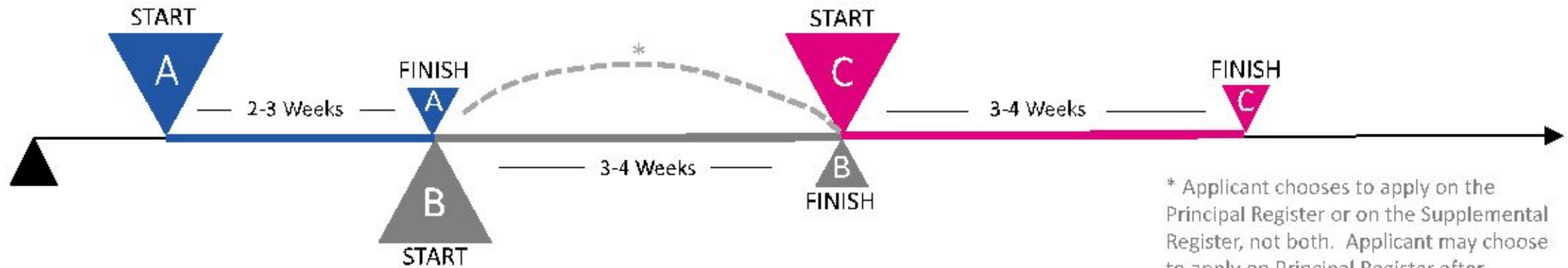
A-B-C Trademark Application Process Flow

Trademark Search:

- Takes 2-3 Weeks
- Answer on Trademark Availability
- Recommended Path Forward

Principal Register Trademark Application:

- Takes 3-4 Weeks
- Detailed list of goods/services **
- Description of the mark
- Grants trademark national recognition and protects from infringement throughout US



Initial Consultation:

- Eligibility Issues
- Ownership
- Areas of Commerce
- Goals of Business

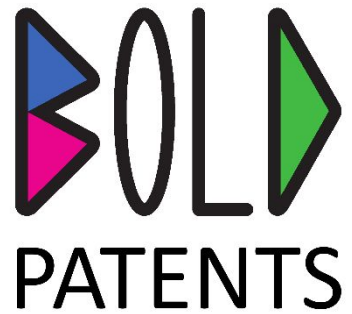
Supplemental Register Trademark Application:

- Takes 3-4 Weeks
- Detailed list of goods/services
- Description of the mark
- Grants trademark recognition in specific state and protects from infringement in that state

* Applicant chooses to apply on the Principal Register or on the Supplemental Register, not both. Applicant may choose to apply on Principal Register after trademark is registered on Supplemental Register, but usually not vice versa.

**When applying for a trademark on the Principal Register, can apply for a mark already in use or can apply on an intent to use basis.

Thank you! Questions?



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let's
DISCUSS

