

WELCOME

*To the Advanced CBA
ReadyTalk Webinar Training on
Intellectual Property: Trademarks
October 31, 2006
11:00 a.m. Eastern Standard Time*



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Check Browser for plug-ins
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SBA
U.S. DEPARTMENT OF COMMERCE
*SBCDC...the driving force behind
small business success!*


**Trademarks:
Identifying & Protecting
Your Rights**



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**STOP
FAKES
.GOV!
SMALL BUSINESS** 2



**Ari Leifman, Attorney-Advisor,
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- Ari is a member of the U.S. Patents and Trade Office's trademark team and assists the office in providing advice on domestic and international trademark matters. Additionally, Ari provides technical assistance and training to different intellectual property offices. Before joining the Office of International Relations, Ari was a staff attorney at the Office of the Commissioner for Trademarks at the USPTO. His duties there included drafting official legal decisions regarding petitions submitted to the Director of the USPTO, drafting official legal notices issued by the USPTO, assistance in the preparation of official legal rules promulgated by the USPTO, and general legal assistance. Ari has presented lectures on trademark law to various bar and other professional groups on the USPTO's behalf. Ari is a graduate of Brandeis University and Fordham Law School, and is admitted to practice in New York State.

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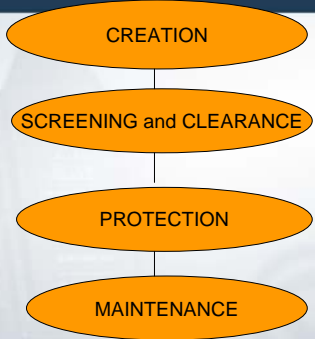
What is a Trademark?

- A word, phrase, symbol or design, or a combination of words, phrases, symbols or designs that identifies and distinguishes the source of the goods or services of one party from those of others. Even colors, smells and sounds may be trademarks in the U.S. (and in some other countries).

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LIFE OF A TRADEMARK



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Life of a Trademark

- CREATION
 - Choosing a trademark or service mark
- SCREENING and CLEARANCE
 - Making sure the proposed mark is available
- PROTECTION
 - Seeking protection, country-by-country
- MAINTENANCE
 - Using trademarks properly and renewing registrations

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PART I: LIFE OF A TRADEMARK

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Why are Trademarks Important?

- A trademark identifies you and your goods/services to your customers.
- A trademark allows your customers to distinguish you from your competitors.

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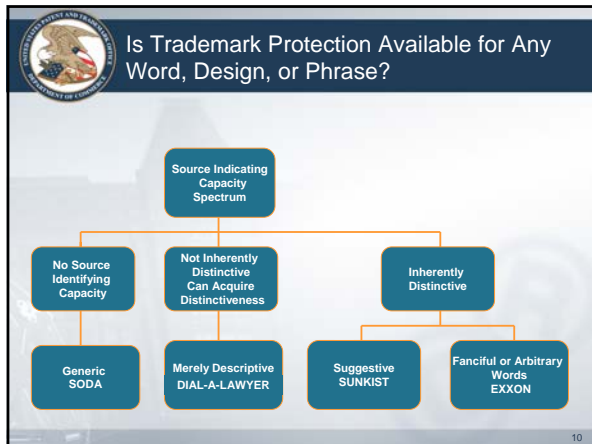


Examples of Trademarks

- We bring good things to life.



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Can an Internet Domain Name be Registered as a Trademark?

- Yes, if:
 - If the domain name is functioning not only as a domain name but also as a trademark, i.e., as a *source indicator*.
 - Does the domain name include a distinctive component?
 - Is it displayed only as a domain name on the address line of a browser, or is it also displayed elsewhere, in a *source indicating* manner.

www.amazon.com v. www.trademark.com

Part II: LIFE OF A TRADEMARK

SCREENING and CLEARANCE

 **Types of Trademark Protection in the U.S.**

- Common Law - unregistered
- State Registration – the “truly local”
- Federal Registration® - interstate
- Other Federal Statutes
 - Smokey Bear
 - Woodsy Owl

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 **Trademark Protection Overseas**

- Trademark rights are territorial.
- Most countries follow a “first-to-file” rule:
 - Protection is granted to the first party who files an application and receives a registration.
- You must search and file in each country in which you wish to sell your goods or services.



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 **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.

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Why Should a Business do a Trademark Search Before Filing?

- Before beginning to use a trademark, a business should first determine whether some *other* business is already using an *identical or similar* trademark, on or in connection with the *same or related* goods or services, or whether some other company otherwise has any rights in the mark. By making that determination, a company **lessens the risk** of violating another company's trademark rights.

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Conducting a Search Can Save a Company Time, Money and Grief!

- Avoid having to change your mark – in every place it appears.
- Avoid having to recall existing products that bear 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 for attorney's fees.


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Searching, a First Step: USPTO

- How do I find out whether the same or similar mark is federally registered, or the subject of a pending TM application to obtain registration for the same or related goods/services?
- Start by performing a search, free of charge, using the Trademark Electronic Search System (TESS) at the USPTO Web site www.uspto.gov


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 **Searching...designs!**



- Likewise, enter the *design* - - i.e., images rather than words - - you wish to search; images can of course also be used as marks.
- If a mark is *composite* - - i.e., if it has both words and a design - - then all elements should be searched.

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 **USPTO Search – Only One Part of the Equation**


- The USPTO database does not include:
 - Trade names.
 - State trademark registrations.
 - Common law marks.
 - Domain names.
- Obtaining a “full search” helps to ensure that these other sources of information will be considered in clearing marks.

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 **Searching Domain Names**




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Searching the Web




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Almost Ready to File...

- Searches: Done!
 - Preliminary
 - Full
- Some possible grounds for refusal:
 - Likelihood of Confusion
 - Merely Descriptive
 - Other grounds?



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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 **advantages** to having a federal trademark registration.

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Advantages of Federal Registration

- Constructive notice nationwide of TM owner's claim.
- Evidence of ownership of the trademark.
- Jurisdiction of the federal courts may be invoked.
- Registration can be used as a basis for obtaining registration in foreign countries.
- Registration may be recorded with U.S. Customs Service to prevent importation of infringing foreign goods.

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So you've decided to file...

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

- Use of the mark;
- A *bona fide intention* to use the mark in the future; or
- Foreign application or registration.

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What Constitutes "Use"?

- What constitutes "use" of a trademark?
- What constitutes use of a trademark in "interstate commerce"?



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Intent-to-Use Basis

- If you have not yet used the mark, but plan to do so in the future, you may file an application to register the mark based on a good faith or bona fide *intention* to use the mark in commerce in the future.
- However, the USPTO will not issue a registration unless you begin to use the mark in commerce (and meet other requirements for registration) within certain time periods.
- A benefit of filing via this basis: the successful registrant has *constructive use* of the mark as of date the application was filed.

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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) at www.uspto.gov/teas/index.html




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Am I Required to Hire an Attorney to File the Application on my Behalf?


- No. However:
 - It may be highly beneficial to be represented by an attorney who is familiar with trademark matters, and;
 - Trademark applicants must meet all the procedural and substantive requirements of the Lanham Trademark Act and Trademark Rules of Practice, whether or not they are represented by an attorney.
- The USPTO cannot aid in the selection of a search firm or an attorney.

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Application

- The five elements that must be included in an application for registration:
 - **Fee:** The filing fee.
 - **Address:** A correspondence address.
 - **Mark:** A clear representation of the mark.
 - **Identification:** The goods or services.
 - **Name:** The mark-owner's name.



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Filing Fees or, "You do the Math!"

- Filing fee for paper filings: ⚡ \$375 per class of goods/services
- vs.
- Filing fee for e-filing: 🖱️ \$325 per class of goods/services

Or

\$275 per class if filed using the TEAS Plus form.

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Benefits of Filing Online...

- In addition to a lower filing fee...
 - You minimize chances of making a mistake!
 - You get instant acknowledgement of receipt!
 - You're assured that the data you provide will be properly entered into the USPTO databases, since the data entry is accomplished electronically, not manually.

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Filing with TEAS PLUS



- All the benefits of TEAS ---plus
- Complete application minimizes procedural problems
- Electronic communications allow more efficient processing
- Party agrees to receive USPTO communications via e-mail

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Brief Overview of the Examination Process at the USPTO

- The application is received and processed.
- The examining attorney conducts a substantive legal examination that results in:
 - An approval for publication;
 - A requirement for an amendment; or
 - A refusal, (perhaps accompanied by a requirement for an amendment).
 - The applicant or its attorney can submit written arguments as to why the refusal or requirement should be withdrawn. If the examining attorney is not convinced by those arguments and repeats the refusal or requirement, an appeal can be taken to the *Trademark Trial and Appeal Board*.

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Brief Overview of the Examination Process at the USPTO

- If the mark is *approved for publication*, and, if after publication, no one *opposes* the issuance of a registration, a registration will issue.
 - If the application was based on an *intent to use* the mark, the applicant must submit a *statement of use* before a registration is issued.
 - If an *opposition* was filed, it is considered by the Trademark Trial and Appeal Board.

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Trademark Timeline [Times are Approximate]

- Examination: **6.3 months** after filing (average pendency)
- Registration: **19.6 months** after filing


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Congratulations!



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Is Federal Registration Valid Outside the United States?

- No. "Trademarks are territorial."
- You must search and file for trademark protection in each country in which you want to use the mark.
- However, you may use your application or federal registration as a basis to file a single "International Application" under the Madrid Protocol in various foreign countries... (More in a moment)

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Protecting Your Trademarks Abroad

- Be proactive in protecting your trademark!
- 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.

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Protecting Your Trademarks Abroad




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 **Protecting Your Trademarks
Abroad: The Madrid Protocol**



- **What is the Madrid Protocol?** It is an international trademark *filing* treaty administered by the World Intellectual Property Organization, WIPO.
- The U.S. is a member of the Madrid Protocol.

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 **General Requirements
Under the Madrid Protocol**

- A “basic application” pending in, or a “basic registration” issued by, the USPTO.
- Payment of Fees:
 - USPTO Certification fee of \$100.00 per class.
 - International Registration fee(s) required by the selected country(ies).

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 **Benefits to U.S. Companies**

- Under the Madrid Protocol, the U.S. TM owner can -
 - File a single application, in English, at the USPTO Web site, pay in US dollars, and seek registration in any or all of the countries who are members, as the applicant designates.

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 **FILINGS UNDER THE MADRID PROTOCOL**

- Applying for an international registration:
 - use either the [electronic application for registration](#), available at the USPTO's web site, or;
 - a [paper form](#) provided by the World Intellectual Property Organization (WIPO), the international organization that administers the Madrid Protocol.

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 **FILINGS UNDER THE MADRID PROTOCOL**

- The international application cannot set forth information not provided in the underlying U.S. application or registration. Otherwise, the USPTO will not certify the application.
- Example: the international application cannot identify goods or services not listed in the U.S. application or registration.

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 **FILINGS UNDER THE MADRID PROTOCOL**

- What happens after the international application is transmitted to the USPTO?
 - If everything is in order, the USPTO *certifies* the application, and forwards it to WIPO.
 - If WIPO finds that its requirements were met, it issues an *international registration*.
 - WIPO then sends the international registration to each of the countries that the applicant identified in the international application.

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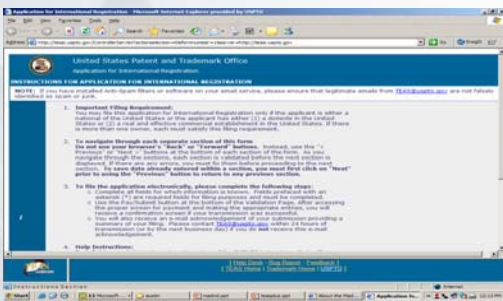
FILINGS UNDER THE MADRID PROTOCOL

- Each of those countries then determines whether, under its trademark laws, the U.S. trademark owner is entitled to an *extension of protection*, i.e., whether the international registration will be in force in its country.
- A country must issue any refusals within either one year, or eighteen months, from the day the international application was forwarded to the Office by WIPO (depending on whether the country opted for the one year or eighteen month limit).
- If the country decides to issue a refusal, it sends a refusal letter to WIPO, which then mails the letter to the applicant.

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MADRID PROTOCOL APPLICATION



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More Benefits to U.S. Companies

- Under the Madrid Protocol, after rights are granted in any of those countries:
 - Assignments can be effected by filing a single document with WIPO.
 - Renewal of all rights can be effected by the payment of a single fee at WIPO.


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PART IV: LIFE OF A TRADEMARK



MAINTENANCE

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Maintain 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.

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Maintaining Your Company's Trademarks: Tips on Proper Trademark Usage

- Distinguish your trademark from surrounding text, e.g., use capital letters or italics.
- 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 ®.

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Maintaining Your Company's Trademarks: Don't Lose Your Rights!

- Register your marks and maintain the registrations.
- 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.
- Use your mark, use your mark as a mark, and use your mark consistently. Use notices of prior right.
- Monitor the USPTO *Official Gazette* (and similar publications in other countries), monitor the marketplace, and STOP unauthorized third-party uses.

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TRADEMARK DISPUTES

- Administrative (Registration)
 - Opposition @ Trademark Trial and Appeal Board (TTAB)
 - Cancellation @ TTAB
- Court (Use)
 - Federal
 - State
- Domain Names
 - (U.S.) Anticybersquatting Consumer Protection Act
 - UDRP (gTLDs)
(Uniform Domain Name Dispute Resolution Policy)
www.icann.org/udrp
 - ccTLDs
http://arbitrator.wipo.int/domains/cctld_db/index.html

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Trademark Resources at USPTO.GOV

- “About Trademarks, Patents & Copyrights”
- “Basic Facts About Trademarks”
- “FAQs – Questions and Answers”
- “Acceptable Identification of Goods and Services Manual”
- “Trademark Manual of Examining Procedure”
- “TTAB Manual of Procedure”
- “Register Trademarks with CBP”

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THANK YOU!



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