A PRIMER ON TRADEMARKS:
Some Dos and Don’ts

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HOW DO TRADEMARKS FUNCTION?

A. CONSUMER PROTECTION

B. SOURCE IDENTIFIER

• Trademarks/service marks are those words, symbols or other indicia that serve to identify a business as the source of goods or services. They denote a particular standard of quality.
• They distinguish one party’s goods or services from those of another.
• They symbolize the goodwill of the owner.
• They protect the public from confusion and deception.

Examples:

**Trademark: COCA-COLA**

**Service Mark: MCDONALDS**

• *Potentially marks can last in perpetuity provided they remain in use and are not abandoned or become generic.*
TYPES OF TRADEMARKS

- Trademarks
- Service Marks
- Collective Marks
- Certification Marks
- Trade Dress
COLLECTIVE MARKS

• Used by members of an organization to identify the goods or services of the members or to identify membership in the organization.
• Organization is the owner of the collective mark.

   Examples:
   - PGA PROFESSIONAL
   - International Brotherhood of Teamsters
CERTIFICATION MARKS

• Unusual marks.
• They do not indicate the source or origin of the goods/services.
• They certify regional or other origin, material, mode of manufacture, quality, accuracy, etc. or they certify that the work or labor on the goods/services was performed by members of a union or other organization.

Examples:
– Certificate of Clinical Competence in Speech-Language Pathology
– FRESH FROM FLORIDA
<table>
<thead>
<tr>
<th>Word Mark</th>
<th>CBP CERTIFIED BUILDING PROFESSIONAL</th>
</tr>
</thead>
<tbody>
<tr>
<td>Goods and</td>
<td>IC B . US B . G &amp; S: certifying that persons in the pool, spa, and hot tub industry have met certain qualifications to design, build, construct, manufacture, and install pools, spas, and hot tubs. FIRST USE: 19961121. FIRST USE IN COMMERCE: 19961121</td>
</tr>
<tr>
<td>Services</td>
<td></td>
</tr>
<tr>
<td>Mark Drawing</td>
<td>(1) TYPED DRAWING</td>
</tr>
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<td>Code</td>
<td></td>
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<td>75250141</td>
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<td>Filing Date</td>
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<td>Number</td>
<td></td>
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<tr>
<td>Registration</td>
<td>March 30, 1999</td>
</tr>
<tr>
<td>Date</td>
<td></td>
</tr>
<tr>
<td>Owner</td>
<td>(REGISTRANT) National Spa &amp; Pool Institute, The CORPORATION VIRGINIA 2111 Eisenhower Avenue Alexandria VIRGINIA 223144698</td>
</tr>
<tr>
<td>Attorney of</td>
<td>TARA A. BRANSCOM</td>
</tr>
<tr>
<td>Record</td>
<td></td>
</tr>
<tr>
<td>Disclaimer</td>
<td>NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE &quot;CERTIFIED BUILDING PROFESSIONAL&quot; APART FROM THE MARK AS SHOWN</td>
</tr>
<tr>
<td>Type of Mark</td>
<td>CERTIFICATION MARK</td>
</tr>
<tr>
<td>Register</td>
<td>PRINCIPAL</td>
</tr>
<tr>
<td>Affidavit Text</td>
<td>SECT 15. SECT 8 (6-YR).</td>
</tr>
<tr>
<td>Other Data</td>
<td>The certification mark, as intended to be used by authorized persons, is intended to certify that the persons using the mark have met, through a training and testing program, certain qualifications to design, build, construct, manufacture, and install pools, spas, and hot tubs.</td>
</tr>
<tr>
<td>Live/Dead</td>
<td>LIVE</td>
</tr>
<tr>
<td>Indicator</td>
<td></td>
</tr>
</tbody>
</table>
TRADE DRESS

• Generally directed to the overall “look” of a product or service.

Examples:

Services: Restaurant service: building exterior, signage, interior floor plan, uniforms, etc.

Goods: Coca-Cola Bottle

*A mere method and style of doing business is not protectable. Concepts are not protectable as trade dress.
FORMS OF MARK PROTECTION

• Common law
• Federal registration
• State registration
COMMON LAW TRADEMARKS

• Trademark rights are primarily created through use and not registration in the U.S.

• Such use establishes common law rights in the mark:
  - in the geographic area in which the mark is used
  - in the channel(s) of trade in which the goods/services are sold
  - for the goods/services with which the mark is used

  Example: Most local businesses

• There is no requirement that a mark be registered, although this may be sensible since this provides greater protection.
FEDERAL REGISTRATION

• With the USPTO
• Can apply on the basis of an intent to use or actual use in interstate or territorial commerce, or commerce with a foreign country
• Provides rights beyond common law
FEDERAL REGISTRATION cont.

- If on principal register:
  - Constructive notice to the public of a registrant’s claim of ownership of exclusive rights in the mark.
  - Constitutes prima facie evidence of registrant’s exclusive right to use the mark, the registrant’s ownership of the mark, validity of the registered mark, and validity of the registration of the mark.
  - Power to grow – registration gives nationwide rights to your mark.
  - Use of ®.
  - Helps to prevent cybersquatting of domain names containing the registered mark.
  - More attractive to potential purchasers of a registrant’s business. Registered marks are more easily quantifiable than common law marks.
STATE REGISTRATION

• Each state has its own trademark laws.
• Registration on the state level is possible.
• Registration is only possible for marks in use.
• The registration only gives the registrant state rights.
• Generally where possible federal registration is obtained instead of state registration
WHAT CAN BE A MARK?

• Word marks – most common
  Example: ADVANCE AUTO PARTS

• Domain names
  Example: AMAZON.COM

• Slogans
  Example: LOW PRICES YOU CAN TRUST EVERY DAY

• Designs and Logos (with or without words)
  Example: NIKE SWOOSH
<table>
<thead>
<tr>
<th>Goods and Services</th>
<th>IC 025, US 039, G &amp; S: Footwear. FIRST USE: 19710618. FIRST USE IN COMMERCE: 19710618</th>
</tr>
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<tbody>
<tr>
<td>Mark Drawing Code</td>
<td>(2) DESIGN ONLY</td>
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<tr>
<td>Design Search Code</td>
<td>261708 261709</td>
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<td>Registration Number</td>
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<td>Registration Date</td>
<td>March 5, 1985</td>
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<tr>
<td>Owner</td>
<td>(REGISTRANT) Nike, Inc. CORPORATION OREGON One Bowerman Drive Beaverton OREGON 97005</td>
</tr>
<tr>
<td>Type of Mark Register</td>
<td>TRADEMARK</td>
</tr>
<tr>
<td></td>
<td>PRINCIPAL</td>
</tr>
</tbody>
</table>
WHAT CAN BE A MARK cont.

• Color
  Example: Owens-Corning – the color pink for insulation products

• Trade dress

• Packaging
  Example: Coke Bottle; KODAK Black and Yellow Packaging

• Decor
  Example: Restaurant service

• Product configuration
  Example: WEBER GRILL
<table>
<thead>
<tr>
<th></th>
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<tbody>
<tr>
<td>Registration Number</td>
<td>1478530</td>
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<tr>
<td>Registration Date</td>
<td>March 1, 1988</td>
</tr>
<tr>
<td>Owner</td>
<td>(REGISTRANT) WEBER-STEPHEN PRODUCTS CO. CORPORATION ILLINOIS 200 E. DANIELS ROAD PALATINE ILLINOIS 60067</td>
</tr>
<tr>
<td>Description of Mark</td>
<td>THE TRADEMARK CONSISTS OF A THREE-DIMENSIONAL PICTORIAL REPRESENTATION OF THE DISTINCTIVE CONFIGURATION OF THE KETTLE PORTION OF APPLICANT'S BARBECUE GRILLS. THE KETTLE PORTION INCLUDES A BOTTOM OF GENERALLY SEMI-SPHERICAL SHAPE HAVING A TOP OF GENERALLY SEMI-ELLIPTOID SHAPE.</td>
</tr>
<tr>
<td>Type of Mark</td>
<td>TRADEMARK</td>
</tr>
<tr>
<td>Register</td>
<td>PRINCIPAL-2(F)</td>
</tr>
</tbody>
</table>
WHAT CAN BE A MARK cont.

• Sounds and Fragrances
• Sounds
  Examples:
  – NBC CHIMES
  – THE YAHOO YODEL
WHAT CAN A MARK BE cont.

• Personae as Trademarks
• Generally will need the consent and release of the personality involved
  Example:
  George Foreman grills
<table>
<thead>
<tr>
<th><strong>Word Mark</strong></th>
<th>GEORGE FOREMAN</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Mark Drawing Code</strong></td>
<td>(1) TYPED DRAWING</td>
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<tr>
<td><strong>Serial Number</strong></td>
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<td><strong>Filing Date</strong></td>
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<td><strong>Current Filing Basis</strong></td>
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<td><strong>Original Filing Basis</strong></td>
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<tr>
<td><strong>Published for Opposition</strong></td>
<td>September 10, 2002</td>
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<tr>
<td><strong>Registration Number</strong></td>
<td>2656646</td>
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<tr>
<td><strong>Registration Date</strong></td>
<td>December 3, 2002</td>
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<tr>
<td><strong>Owner</strong></td>
<td>(REGISTRANT) Salton, Inc. CORPORATION DELAWARE 1955 W. Field Court Lake Forest ILLINOIS 60045</td>
</tr>
<tr>
<td><strong>Assignment Recorded</strong></td>
<td>ASSIGNMENT錄RECORDED</td>
</tr>
<tr>
<td><strong>Attorney of Record</strong></td>
<td>Lorraine Linford</td>
</tr>
<tr>
<td><strong>Type of Mark</strong></td>
<td>TRADEMARK</td>
</tr>
<tr>
<td><strong>Register</strong></td>
<td>PRINCIPAL</td>
</tr>
<tr>
<td><strong>Other Data</strong></td>
<td>The name George Foreman identifies a living individual whose consent is of record.</td>
</tr>
<tr>
<td><strong>Live/Dead Indicator</strong></td>
<td>LIVE</td>
</tr>
</tbody>
</table>
CHOOSING A MARK

• Strong mark
• Distinctive mark
• Not in use by a third party
DISTINCTIVENESS

• Trademarks are measured along a spectrum of distinctiveness, beginning at the bottom with generic and descriptive terms and ending with suggestive, arbitrary or coined terms.

• Generic terms can never acquire distinctiveness. Descriptive marks can acquire distinctiveness over time. Suggestive, arbitrary and coined terms are inherently distinctive and are preferable.

• The pecking order from weakest to strongest...
Generic Terms

• These identify the goods/services rather than the source of the goods/services.
  
  **Example:** car

• Generic terms are incapable of trademark protection, including registration, since public policy demands that generic words be available for use by all.

• Some former trademarks have become generic terms through misuse.
Generic Terms cont.

• Examples:
  Escalator  DOS
  Aspirin    Dry ice
  Cellophane Shredded wheat
  Thermos    Trampoline
  Super Glue Yo-Yo
  Light Beer

• These terms were initially source identifiers, but came to be the word used for the product regardless of source.
Generic Terms cont.

• Some marks have through use of advertising been saved from genericide.

  Examples:
  
  BAND-AID       JELL-O
  KLEENEX        SCOTCH
  XEROX

  *Proper use: Mark + “brand” + real generic name of product

Example:

XEROX brand photocopying machines
Descriptive Terms

...describe the characteristics, functions, quality, uses, ingredients, components or other properties of a product or service. Public policy demands that these terms be generally available to competitors to truthfully describe their products or services.

Examples:
U.S. NEWS AND WORLD REPORT
MOLD-CLEAN
THE OFFICE FOOD PROS (catering services)

Through use descriptive marks can acquire *distinctiveness* or *secondary meaning*, in other words become source identifiers. In order to be registered federally on the Principal Register it is necessary to make a showing of distinctiveness for descriptive marks.
Suggestive Terms

...suggest attributes of a product or service, as opposed to describing the product or service. No proof of secondary meaning is necessary.

Examples:

IVORY soap
CHAMPION sporting goods
ENDURANCE batteries
Arbitrary Terms

...are words or designs recognizable as real words or representations that bear no relationship to the product or service they identify.

Examples:
AMAZON
APPLE – computers, bank and records
Fanciful/Coined Terms

...are made-up words or designs.

Examples:

KODAK
XEROX
NOT IN USE BY A THIRD PARTY

• Avoid similar marks for similar goods/services where there will be a likelihood of confusion
• Avoid identical/similar famous marks
HOW TO MINIMISE CHOOSING AN INFRINGING MARK

- Perform Clearance Searches
- Evaluating Third Party Use or Registration of the Same or Similar Mark

When evaluating possible trademarks for use or registration, the proposed mark should be tested for any likely confusion with a third party’s same or similar mark, whether that mark is federally registered or merely used in commerce.
HOW TO MINIMISE CHOOSING AN INFRINGING MARK cont.

Any third-party marks uncovered in a search should be compared to the proposed mark on a number of points, including the following:

– The similarity of the marks
– The similarity of the goods/services with which each mark is/will be used
– Registration status of the uncovered mark (e.g. registered and alive, pending, abandoned, rejected)
– Common purchasers or users
– Marketed through the same channels of trade
– Manner of use
– Strength and distinctiveness of the marks
– The kind of goods/services involved and consumer sophistication and carefulness in choosing the goods/services

*Note - Co-existence
Similar or identical marks can co-exist for dissimilar goods (exception dilution)
APPLE bank
APPLE computers
APPLE records
USING AND MAINTAINING MARKS

A. Use and Abandonment

B. Use Marks Properly
   - Adjective not noun or verb
     Example – XEROX copying machine
   - Use consistently (will lose registration if change mark too much)
   - Use properly on the relevant goods/services

C. Trademarks should stand out
   - Caps
   - Bold
   - Italics
   - Large font
   - Quotation marks

D. Use the appropriate trademark notice (®, TM or SM)

E. Trademark Audits

F. Protect Your Marks
   - Register where appropriate
   - Stop infringers
   - Monitor third party usage
   - Employ watch services
   - If permitting third party usage – use a written license, restrict usage, ensure proper usage, include quality control
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