

Trademarks

As a reality show...



You can create something from nothing!

- Why use a trademark? What is a trademark? How should you go about selecting a mark? What factors should be considered during selection of a mark? What do I have to do to acquire or own the mark? Why should I register a mark? How do I know what to register? Why are some marks better than others? How does a mark accrue value? How does a business increase the value of its marks?

Why use a trademark?

- Efficient way to communicate with customers
- Create an image!

Public Policy

- Consumer Protection
 - They get what intend to buy
- Economic efficiency
 - Encourages consistent (good or bad) quality
 - Reduces customer search time and cost

What does a trademark do?

- Identifies seller's goods and services and distinguishes them from goods or service sold by others.
- Signify that all goods or services bearing the mark come from a single source. (can be anonymous)
- Signify that all goods or services are of an equal level of quality or have consistent characteristics
- Serve as an instrument in advertising

- This is the ultimate in text language LOL and ROFLOL!

How does owning a trademark help your business?

- Helps your customer identify your product
- Protects your customer to obtain the product they are seeking – specific qualities or characteristics
- Helps you communicate effectively – advertising and print media can be used to increase demand! (*create goodwill!*)
- Enables us to prevent fraud or confusion among our customers
- Builds value in the mark (which is a negotiable asset!)
 - Note that the stronger the mark the more transportable the asset

What is a trademark?

- Something that identifies you as the source of products or services – like your name
- (Note this can be anything)
- Think of Trademark Infringement as identity theft-

What does a trademark look like?

- Trademark/Service Mark – A designation used to identify and distinguish the goods or services of a person
 - Word – XEROX, APPLE, STARBUCKS
 - Slogan – JUST DO IT

- Logo –



- Sound – NBC bells, Harley Davidson
 - Color – pink for insulation, yellow for fish
 - Scent – for thread
- Trade Name – the name of a business

Types of Marks

- Trademarks (Goods)
- Service Marks (Services)
- Collective Marks (Organizations)
- Certification Marks (e.g., quality or Regional Origin)

How do I choose a mark?

- Professionals design companies can help
- Key factors –
 - Availability
 - Effectiveness (“Oak” if possible)
 - Distinctive
 - Usable
 - Appropriate (foreign, domestic, culturally)
- Lena passed away and Ole called 911. The 911 operator told Ole that she would send someone out right away.
"Where do you live?" asked the operator.
Ole replied, "At the end of Eucalyptus Drive."
"Can you spell that for me?" the operator asked.
There was a long pause and finally Ole said, "How 'bout if I drag her over to Oak Street and you pick her up der?"

Clearance: is the mark or name available?

- Distinctiveness and Strength
 - Fanciful or Suggestive
 - not Descriptive or Generic
 - Risk of confusion
 - Risk of litigation

How do I acquire the mark

- Rights are obtained through use
- But contingent constructive use can be made by filing an application for federal registration; Use is required before the registration will issue and constructive use is effective if registration issues.

What do I own? Scope of Rights

- U.S. Common law
- U.S. Federal registration – Breadth
- U.S. State Registration
- Foreign rights

Why are some marks better than others?

- Strong marks have a wide scope of protection
- Strong marks more effectively identify your goods
- Strong marks are easier to protect - infringement is more obvious and customers often tell you about infringements!
- Strong marks are cheaper to enforce through litigation because the cases tend to have cleaner issues

How do I know what to register?

- Budget –
- Shelf life
- Ideally register every mark that creates a distinct commercial impression
- May be background, words, and all elements of a composite mark that are so distinct they create an independent commercial impression
- What will third parties steal if they are trying to assume your identity?

ITU or USE

- ITU. Bona fide intention to use the mark in commerce
- USE. Use in commerce regulated by Congress.
 - Intra-state commerce not sufficient
 - Generally, use of a mark in “interstate” commerce will suffice.
- Can combine USE and ITU in single application

Principal Register

- Constructive notice to the public
- Legal presumption of ownership and exclusive right to use the mark nationwide
- A date of constructive use of the mark as of the filing date; ITU
- Prevent import of infringing goods by filing registration with U.S. Customs
- Exclusive use by registrant in commerce (5 years) will render the registration incontestable, subject to certain statutory defenses
- Basis for foreign registration

Supplemental Register

- Marks not eligible for Principal Register, but are capable of distinguishing the owner's goods or services
 - Descriptive marks
 - Not generic marks
- Admission that the mark is descriptive or not inherently distinctive
- May become registrable on Principal Register under Section 2(f); acquired distinctiveness

How does a mark accrue value

- Increase the strength of the mark
- Use the mark
- Use the mark consistently
- Stop infringers

What Does This Mean?

- Select strong marks where possible
- Use the mark consistently
 - In form (appearance)
 - In context (all of one media e.g. business cards or particular ad campaign)
- Identify the mark ® or ™ or SM

Maintenance of Rights

- Separate from increasing the value of a mark – what is required simply to maintain any rights in the mark
- Use of Mark
- Enforcement of Exclusive Rights
- Abandonment
- When you decide to change your name or mark remember that the mark still identifies you for a while – control your reputation for so long as this is true! E.g., Rainier, Weyerhaeuser, etc.

What cannot be registered as a trademark?

- Immoral, scandalous, deceptive
- Matter which may disparage, falsely suggest a connection or bring into contempt or disrepute
- Flag, Coat of Arms, or other insignia of the United States, state and municipality, or foreign nation
- Matter protected by Statute or Convention
- Name, portrait, or signature of living individual or deceased U.S. President without consent