



CORPORATION SERVICE COMPANY

Trademarks 101:

*Everything you've always wanted to know about
trademarks but were afraid to ask*

Presented by:



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Innovating Service and Technology for Over 100 Years.

Do I have your attention?



Photo: Getty Images

Naked Cowboy v. M&M's

- Robert Burck plays his guitar daily in NYC in Times Square wearing “tightie whities” and a cowboy hat and boots
- M&M Mars erected a billboard in Times Square with the blue M&M character in underwear, wearing a guitar, cowboy hat and boots
- Mars claims it has a right under the 1st Amendment to parody Burck’s character
- Burck says the right does not include the right to use him image to sell a product
 - *Files a \$6 million lawsuit for use of his likeness*
- Is there consumer confusion?



Trademarks 101

- Trademarks Basics
- Proper Usage
- Trademark Filing Process
- Screening and Clearing Trademarks
- Post Registration Protection
- Q&A



Intellectual Property

- Intangible Assets
- Protectable by law
- Original and creative thoughts, ideas and works

Types of Intellectual Property

- **Copyright** – protects “original work of authorship” ex., literary, music, dramatic, artistic work. ©
- **Patent** – protects inventions – original ideas or new processes ex., machines, formulas, product designs
- **Trademark** - ™ ®



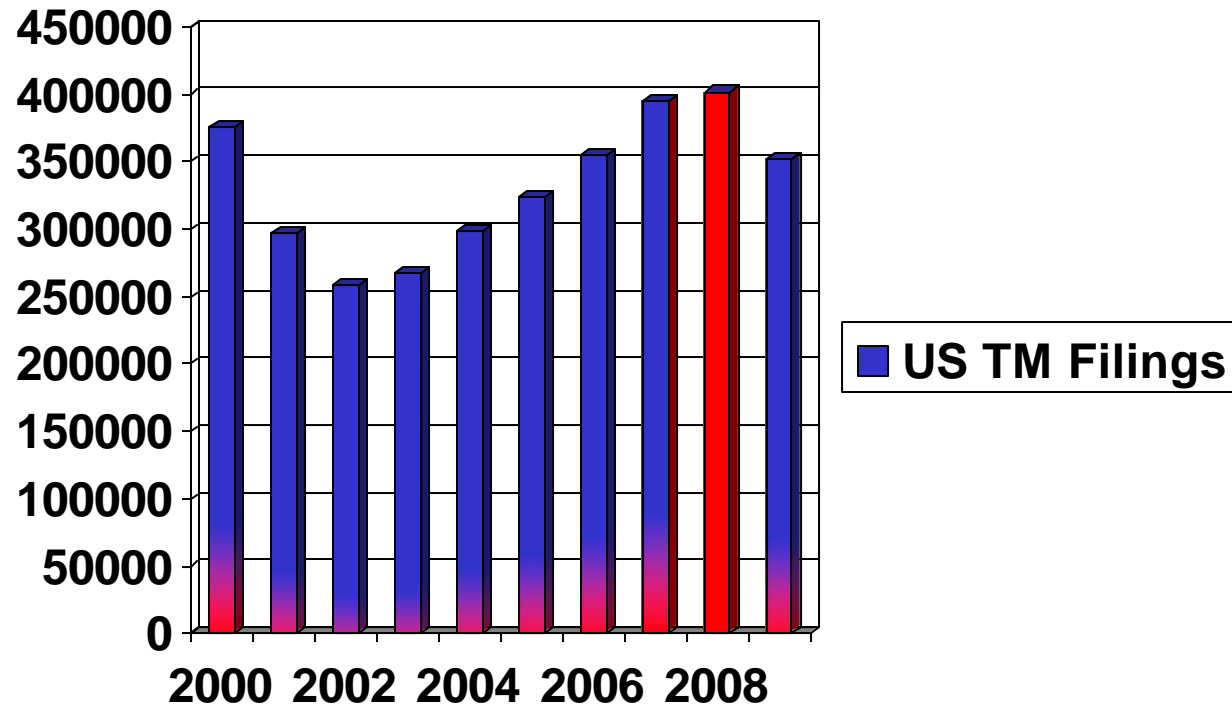


Trademarks

- A trademark identifies and distinguishes a specific product from others in the marketplace.
- Trademark registration is authorized by Federal Law under the Lanham Act and also by the laws of each State.
- Trademark registration can also be accomplished overseas under different international treaties such as the Paris Convention, Vienna Agreement, Nice Agreement, etc.

Current Market Trends

U.S. Trademarks





Trademark vs. Trade Name

- Trade name: identifies a company or business (KRAFT®)
 - *Name under which the business trades for commercial purposes*
- Trademark: identifies the goods of a company (ALTOIDS®)
- Service Mark: identifies the services of a company (Weight WatchersSM)
 - *Identifies the source of the service rather than the product*

Word





Name

DELL™

Smith's
FOOD & DRUG STORES

Clarks

Symbol



Slogan



*Melts in your mouth.
Not in your hands.*



Don't leave home without it



The King of Beers

Design



Device



Sound



Color



- Must have secondary meaning
- Must be non-functional
- Look at:
 - Length and manner of use of the mark
 - Volume of sales
 - Advertising
 - Nature and use of the mark

What trademark has the most loyal customers in the US?



Harley-Davidson



Functions of a Trademark

- Indicates the source of origin of goods or services
- Helps guarantee the quality of goods bearing the mark
- Creates and maintains a demand for the product
- Used as a Marketing tool to build a brand
- Can have great \$ value to a company



Spectrum of Trademark Distinctiveness & Levels of Protection

Fanciful/Coined

Kodak

Zappos
.com

Arbitrary

Dove

Tide

Hard Rock
CAFE

Suggestive



Descriptive



Generic



**HOW ARE
TRADEMARKS
PROPERLY USED?**



Don't Leave Your Trademarks Naked!

TM



Using these symbols puts the industry on notice!

Distinguish Trademarks!

Bold → **CLOROX[®] Bleach**

ITALICS → *Clorox[®] Bleach*

ALL CAPS → **CLOROX[®] Bleach**

Underline → Clorox[®] Bleach



Trademarks are Adjectives, Not Nouns



VISINE[®] Eye Drops are excellent for getting the red out my eyes.

AquaFresh[®] Toothpaste is great for my teeth.



VISINE[®] is excellent for getting the red out of my eyes.

Trademarks Should Not be Used in Possessive Form



The acne-clearing power of
CLEARASIL[®] Gel



CLEARASIL'S[®] acne-clearing power

Trademarks are Not Verbs

TRADEMARKS ARE NOT
USED AS VERBS –

YOU CANNOT **DOVE**[®]
YOUR FACE!



Trademarks Should Not Be Used in Plural Form



Enclosed are a dozen bottles of
VISINE[®] Eye Drops



Enclosed are a dozen **VISINES**

Obtaining Trademark Rights

- Rights are obtained by:
 - *Use*
 - Common Law
 - *Registration*
 - US Patent & Trademark Office
 - Individual State Registration
- Rights are territorial



First party to Use or first to file an application, whichever comes first, has superior rights.



Common Law Trademarks

- In the U.S., whoever can establish “First Use” in interstate commerce has superior rights.
- All you have to do is begin using it the TM on your goods to put the public on notice that you believe the mark to be yours.
- You would also note the date of First Use in interstate commerce in your records.
- Rights are limited to territory of use.

Benefits of Federal Registration

- Evidence of the validity of the registered mark and your ownership to it
- Nationwide protection of trademark
- The right to sue in Federal Court
- Use of the circle R symbol: ®
- Gives the ability to stop importation of goods which infringe (US Customs)
- Protects the brand and safeguards opportunities for future expansion



Trademark Application Process

- Application Filed
- Application is “Examined”
- Application becomes approved and “Published for Opposition”
- Application obtains Notice of Allowance

TM





Trademark Application Process

- Trademark is registered for 10 years.
- Renewals are indefinite as long as continuous use in commerce is provided, or it becomes “generic”
 - *Section 8 & 15 Declarations are filed with USPTO to prove use between 5-6th year*
- Process = approximately 18-24 months, barring any obstacles
- Application fee is \$325 per class (electronic); \$375 (paper)



International Classifications

- The US is a signatory to the Nice Agreement and uses the International Classification system under this agreement
- The international classification system is used by 78 countries around the world
- Trademark classes are descriptive categories of goods or services
- There are currently 45 different IC's in use
- When you file your application you pay by class
 - *Ex. Class 5 pharmaceuticals, 16 paper goods, 25 clothing, 43 restaurants & hotels, etc.*



TM Vulnerability

- Examination: after application
- Opposition: after publication
- Cancellation: after registration
 - *Grounds:*
 - Non-use on the goods or services covered by the application/registration
 - Confusing similarity
 - Generic/Diluted (aspirin, escalator, etc...)



Screening & Clearing Trademarks

- Prior to attempting registration or use of a TM, you need to screen and clear your mark
- Does your proposed mark infringe on another's rights?
- Step 1 – Trademark Screening
 - *Conduct a quick “knockout” search using online tools (Federal Trademarks & Internet)*
- Step 2 - Trademark Clearance Report
 - *Covers Federal, State, Common Law, Domain Names and Internet content*
- Step 3 – Investigation and Opinion
- Step 4 – File for Trademark



Protecting Your Trademark

- Post-Registration Protection, Policing & Enforcement
 - *Trademark owners are required to use reasonable efforts to police unauthorized and improper uses of their marks*
 - *Trademark/Domain Watching*
 - *Internet Policing*
 - *Social Media Monitoring*



Trademark Notes

- CHOOSE DISTINCTIVELY
- DO YOUR RESEARCH
- USE YOUR TM PROPERLY WITH TM OR ®
- FILE TIMELY AND NOTE DATE OF FIRST USE
- PROTECT YOUR BRAND



Questions & Answers



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About CSC

- Privately-held, 110+ year old company headquartered in Wilmington, Delaware
- CSC operates offices in the US, Canada, Germany, France and the UK and employs over 1,000 people worldwide
- CSC is dedicated **reducing risks and costs** for our clients by providing:
 - Corporate Governance & Compliance Services
 - Corporate Identity Protection Services
 - Litigation & Matter Management Services
 - Deal & Transaction Support Services.
- The CSC suite of Corporate Identity Protection services includes:
 - Trademark Screening, Searching and Watching
 - Internet Brand Monitoring
 - Domain Name Registration, Management and Monitoring
- CSC is the trusted partner of 47 of the Top 100 Best Global Brands* for global domain name registration and management