



Trademark Law 101

Protecting a Company's Name and Brand Identity

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Why Should Businesses Register a Trademark?

- Businesses Are Rarely Local Anymore
- Goodwill and name recognition
- Avoiding trademark disputes or lawsuits

Trademark Law 101: Preview


- Trademark Basics
- Choosing a Good Name for a Business, Product, or Service
- Trademark Search
- Registering the Mark: The Trademark Application
- Trademark Disputes and Infringement

Trademark Basics

“A **trademark** is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others.”

- http://www.uspto.gov/trademarks/basics/trade_defin.jsp
United States Patent and Trademark Office (USPTO) Website

Trademark Examples

- Word (e.g., “Nike”)
- Slogan (e.g., “Just Do It”)
- Logo (e.g., )
- Packaging, or Trade Dress (e.g., “Air Jordan” design)

- Trademarks vs. Service marks
 - Trademarks TM – Identifies goods or products
 - Service marks SM – Identifies services

Basic Trademark Principles

- Federal registration is not required
- First to Use Owns It
- Must be Unique (“Distinctive”), or Have Earned Customer Recognition Through Time
- Trademark Owner Can Enjoin Another’s Use for “Customer Confusion.”
- If a mark is on Principal Register, court will likely find that a mark was deliberately copied

Reasons to Register Trademark

- Exclusive nationwide ownership
- Notice to users that mark is unavailable
- The right to put ® after the mark
- A legal presumption of ownership, and higher likelihood of prevailing in infringement dispute.

Registering a Mark with the USPTO

- Two types of applications with U.S. Patent and Trademark Office (“USPTO”):
 1. Use of Mark in Commerce (“First to Use”);
 2. Intent-to-Use
- Placed on The Principal Register
 - Provides a mark with protections

Trademark Registration Criteria

- Actual Use
 - Intent-to-Use application is not registered until actually used
- Distinctive
- Not confusingly similar to another mark
- Not prohibited by Congress
- Not primarily a surname or geographical name

Choosing a Name to be Trademarked

- Cannot be a Generic Term
 - But a mark can include a Generic Term
- Must be “Distinctive”
 - Made up name
 - Combination of words and letter so creative
 - Clever double meanings to common phrases
 - Clever appearance
 - No ordinary terms

A Marketable Business Name

George Eastman (founder of Kodak) says names should be:

- Short
- Vigorous
- Incapable of being misspelled, and
- Mean nothing.

The Trademark Search

A good search looks for marks that:

- Same as proposed mark
- Used anywhere in the country
- Used in context that would results in customer confusion.

The Trademark Search - Sources

- The Federal Trademark Register
 - Trademark Electronic Search Service (TESS) – tess2.uspto.gov
 - Other Internet resources: Trademark.com and SERION (Thomson Compumark)
- Pending trademark applications
- State trademark registrations

The Trademark Search - Sources (continued)

- Publications with relevant product and service names
- The Internet
 - Google
- Professional Services
 - Thomson Compumark
- Other searches for unregistered marks:
 - Telephone directories, Trade Associations, Business Directories

The Trademark Search

- The results of your trademark search can never be perfect or legally certain.
- Failure to search may be later evidence of “bad faith.”

Criteria for “Customer Confusion” Between Two Marks

- Goods and services related?
- Goods and services compete?
- Similar in sound, appearance, and meaning?
- Strength or Distinctiveness of the Mark
- Same Customer Base?

Registering the Mark - Actual Use

1. Necessary information
 - Date of first use in interstate commerce, specimen
2. Complete and file the application with the USPTO (online)
 - \$325 online per class, \$375 for paper
 - Provide specimen showing use in interstate commerce

<http://www.uspto.gov/trademarks-application-process/filing-online/initial-application-forms>

2. Modify application in response to trademark examiner

Registering the Mark - Intent to Use

Like the steps for “actual use” application (above), but:

- Extra fee of \$100;
- No specimen.
- If the trademark approves the ITU, will issue a Notice of Allowance.
- Six months to put the mark into actual use.
- Advantage: Date of first use = date you filed ITU application.

Response from USPTO

- Three to six months for first response
- Entire process may take more than a year
- Rejections
 - Technical, Substantive, Final
- Approval
 - Published in the Official Gazette
 - 30 days for others to oppose
 - Opposition unlikely but possible – 3% opposed
 - Certificate of Registration

Protecting Your Trademark Rights

- Use “®” symbol next to mark
- Between years 5 and 6 after registration, file two forms:
 - Section 8 Declaration – Mark is still in use
 - <http://teas.uspto.gov/postreg/secto8>
 - Section 15 Declaration – Mark has been in continuous use
 - <http://teas.uspto.gov/postreg/sect15>
- Use It or Lose It
- Police your mark and be vigilant

Trademark Disputes

- Negotiate before jumping litigation
- Cease and Desist Letter
- Usual issues:
 - Customer confusion
 - Priority of Use
 - Conflicts with Registered and Unregistered Marks
 - Dilution

Conclusion

- Do an extensive trademark search before filing an application
- Choose a good, distinctive name that is not confusingly similar to an existing mark
- Refer to a Trademark attorney!



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- Trademark Laws & Regulations

<http://www.uspto.gov/trademark/laws-regulations>

- The information contained in this presentation is general in nature and should not be relied on for any specific situation. Consult a qualified attorney for any specific legal advice.