

UNITED STATES
PATENT AND TRADEMARK OFFICE





Trademark basics: What every small business should know now, not later

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

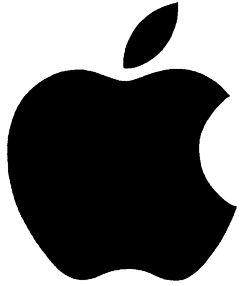
Discussion topics

- Trademark fundamentals
- Benefits of federal registration
- Selecting a trademark
- Filing and registration
- How to find help

Discussion topic

Trademark fundamentals

What is a trademark?





What does a trademark do?

- Trademark
 - Identifies the source of goods and services.
 - Distinguishes them from the goods and services of another party.
 - Provides legal protection for a brand.



What does a trademark not do?

- Trademark
 - Does **not** mean you legally own a word or phrase.
 - Does **not** mean you can stop other people from saying a word or phrase.
 - Does **not** mean people owe you money if they say a word or phrase.



Definitions

- **Trademark**
 - Indicates the source of goods or products.
- **Service mark**
 - Indicates the source of services.

Traditional types of marks

- Common source identifiers:
 - Brand names
 - Slogans
 - Logos

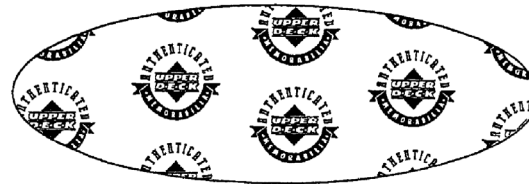
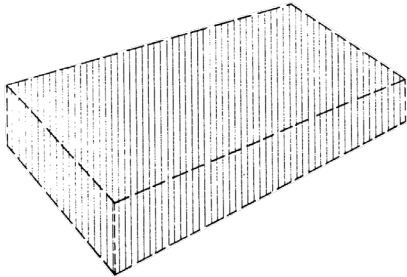
COCA-COLA

**IT'S THE
REAL THING**



Non-traditional types of marks

- Anything that functions as a source identifier might be eligible for registration.
 - Sound
 - Color
 - Scent/smell
 - Motion
 - Hologram
 - Configuration/shape





Knowledge check

Does a federally registered trademark mean that you own a word or phrase?

Yes

No



Knowledge check

Do you have to use your business name as your trademark?

Yes

No

Discussion topic

Benefits of federal registration

Trademark rights

- Traditional ways of creating rights:
 - Common law
 - Federal registration



Common law trademark rights

- Rights
 - Created when you use trademark in commerce
 - Limited to geographic area where mark is used
- Symbols
 - Optional: TM SM
 - Never: ®



Federal registration rights

- Rights

- Created when you federally register trademark
- Legal presumption you own the trademark
- Legal presumption you have the right to use the trademark in all 50 states and the U.S. territories
- Notice to the public of your rights in the trademark





Federal registration rights

- Rights
 - Can bring legal action concerning trademark in federal court.
 - Enables recordation of registration with U.S. Customs and Border Protection.
 - Can be used as a basis for filing in another country.





Federal registration rights

- Symbols
 - Unnecessary: TM SM
 - Permitted: ®



Knowledge check

Are you required to register your trademark with the USPTO?

Yes

No





Knowledge check

Does registering your trademark with the USPTO give you international protection?

Yes

No



Discussion topic

Selecting a trademark



Trademark selection challenges

- Remember:
 - The mission of the USPTO is to register any trademark that is eligible for registration.
 - Not every trademark is registrable.
 - Not every trademark is enforceable.
 - Select a trademark that is both federally registrable and legally protectable.





Registrable and protectable

Two main concepts:

- Likelihood of confusion
 - Likelihood of confusion refusal
- Strength of the trademark
 - Descriptiveness refusal

Discussion topic

Selecting a trademark: Likelihood of confusion



Likelihood of confusion

- **Concept:**
 - Avoid confusing consumers about the source of the goods and services.
- **Test:**
 - Are the trademarks confusingly **similar**?
 - and
 - Are the goods and/or services **related**?





Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

T.MARKEY

for

pants





Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

TEE MARQEE

for

pants





Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

TEE MARQEE

for

golf flags





Suggestions for searching

- On your own
 - USPTO database
 - Federally applied-for and registered trademarks
 - The internet
 - One option for searching for common law use



Suggestions for searching

- Hire a private trademark attorney
 - Comprehensive clearance search includes
 - USPTO database of registrations and applications
 - State trademark databases
 - Business name registries
 - Foreign trademark databases
 - The internet





Knowledge check

Your trademark

X-SEED

for

agricultural seeds

Registered trademark

EXCEED

for

live plants



Discussion topic

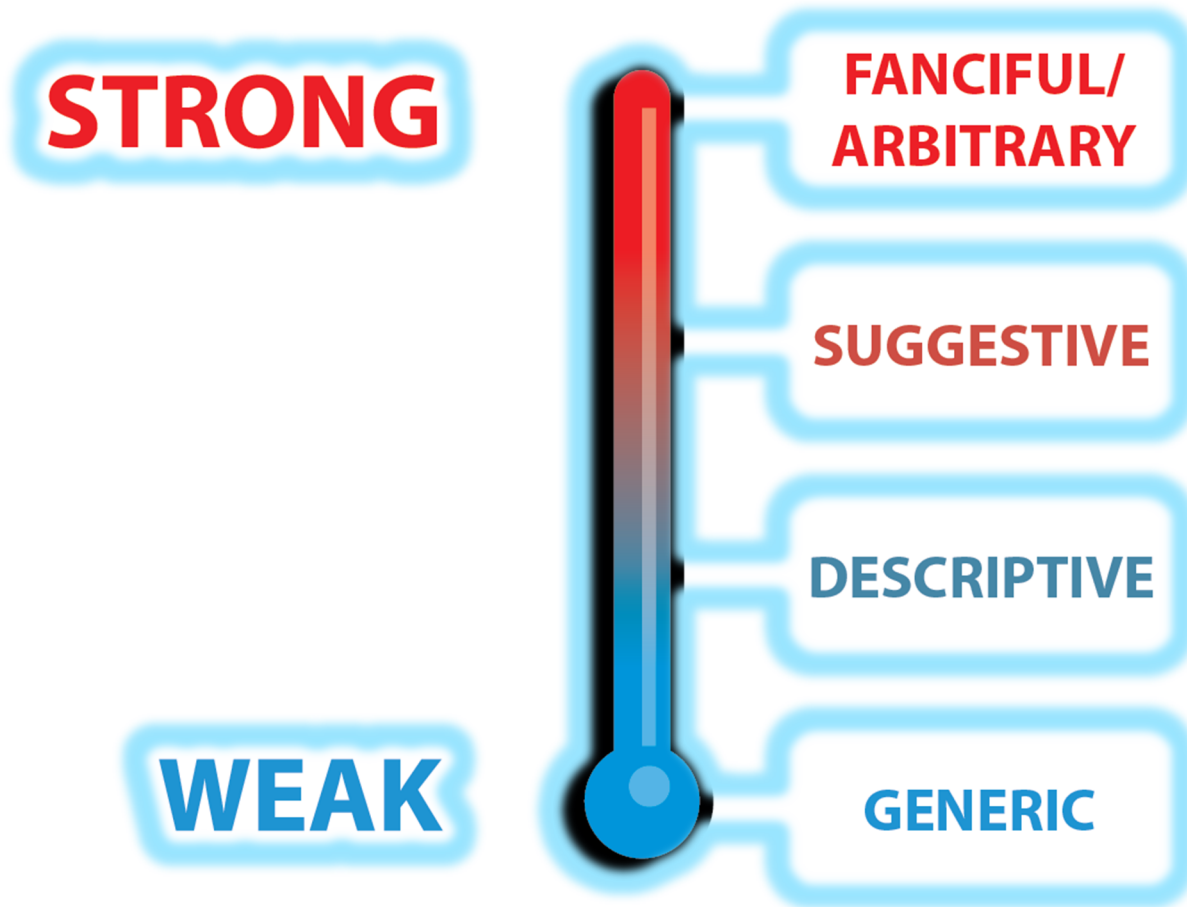
Selecting a trademark: Strength of the trademark



Strength of trademark

- Concept:
 - Avoid using trademarks that fail to indicate the source of goods and services.
- Test:
 - Does the trademark **merely describe** the goods and services?

Strength of trademark





Strength of trademark examples

- **Generic terms**
 - Common, everyday name for the good or service
 - Unregistrable
- **Example**
 - MILK for “dairy-based beverage”



Strength of trademark examples

- **Descriptive trademarks**
 - Directly describe something about the goods and services
 - Unregistrable on the Principal Register
 - Except with showing of acquired distinctiveness
- **Example**
 - CREAMY WHIP for “whipped topping”





Strength of trademark examples

- Suggestive trademarks
 - Suggest a quality of the goods and services
 - Registrable
- Example
 - COPPERTONE for “suntan lotion”



Strength of trademark examples

- Fanciful trademarks
 - Invented words with no meaning in any language
 - Registrable
- Example
 - XEROX for “photocopiers”



Strength of trademark examples

- Arbitrary trademarks
 - Actual words, but no association with the goods and services
 - Registrable
- Example
 - APPLE for “computers”



Knowledge check

Which is registrable?

BICYCLE

for

bicycles

BICYCLE

for

playing cards



Discussion topic

Filing and registration

Filing for federal registration





Filing for federal registration

- File using the Trademark Electronic Application System (TEAS).
 - TEAS filing options
 - TEAS Plus: \$250 per international class
 - TEAS Standard: \$350 per international class
 - Total fee determined by how many classes you include in the application



Filing for federal registration

- Application requirements
 - Clear **drawing** of the trademark
 - Listing of the **goods and services** used with the trademark
 - Application **filing basis** for each good or service
 - **Contact information** for the trademark owner
 - Filing **fee**





Filing for federal registration

- Common bases for refusal
 - Likelihood of confusion
 - Merely descriptive
 - Geographically descriptive of the origin of the goods/services
 - Specimen does not support use for listed items
 - Trademark used in ornamental manner





Registration responsibilities

- Must enforce your own trademark rights.
 - May use your registration certificate to support a “cease-and-desist” letter.
 - May use your registration to sue an infringing user.
- Must file required post-registration documents with the USPTO.





Knowledge check

Are you guaranteed registration of your trademark?

Yes

No



Knowledge check

If your trademark registers, do you have to do anything to keep your registration alive?

Yes

No

Discussion topic

How to find help



Caution: scam alert

- Beware of scams.
 - www.uspto.gov/TMFraud
- Beware of filing firms.
 - www.uspto.gov/trademarks/protect/filing-firms
- Beware of misleading notices and offers.
 - www.uspto.gov/TrademarkSolicitations



USPTO resources

- Website
 - www.uspto.gov
- Trademark videos
 - www.uspto.gov/TMvideos
- Trademark basics registration toolkit
 - www.uspto.gov/TrademarkBasicsToolkit



USPTO resources

The screenshot shows the USPTO website header with the logo and navigation links. The main navigation bar includes 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources'. A search bar is located in the top right. Below the navigation bar, a breadcrumb trail reads 'Home > About Us > Events > Trademark Basics Boot Camp'. The main heading is 'Trademark Basics Boot Camp'. The text describes the free event series and provides details about the modules. A testimonial box on the right contains quotes from boot camp veterans.

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Home > About Us > Events > Trademark Basics Boot Camp

Trademark Basics Boot Camp

This free USPTO event series provides a comprehensive overview of the process for federal trademark registration and maintaining a federal trademark. If you're a small business owner or entrepreneur seeking to protect your brand and product identities, Trademark Basics Boot Camp is for you.

Trademark Basics Boot Camp is offered regularly throughout the year. During each series run, we cover one module weekly for eight weeks, with each module focusing on different aspects of trademarks and the registration process, from filing and examination to post-registration requirements for keeping your registration alive. Each module concludes with a question-and-answer period where you can ask our USPTO trademark experts questions.

You can attend the entire series or just the modules that best match your interests, but you must sign up for each module to attend. If you attend all eight modules, you can request a certificate of attendance. To learn more and sign up, select an individual module from the listing below.

Trademark Basics
BOOT CAMP

Here's what our boot camp veterans are saying:

"It's a terrific program. I may take it again as it is a wealth of knowledge."
"Great information and very thorough explanation of the process and requirements for trademarks."
"Fantastic program. Have already recommended it to several people."

USPTO resources

- IP Identifier
 - <https://ipidentifier.uspto.gov>
- Free services and resources
 - www.uspto.gov/FreeServices
- USPTO virtual assistant
 - www.uspto.gov/trademarks/basics





USPTO resources

- Trademark Assistance Center
 - Main support center for all trademark customers
 - Phone: 1-800-786-9199
 - Email: TrademarkAssistanceCenter@uspto.gov

USPTO resources

- The USPTO does not:
 - Provide legal advice.
 - Enforce legal rights.
 - Recommend specific private attorneys.

Questions?

