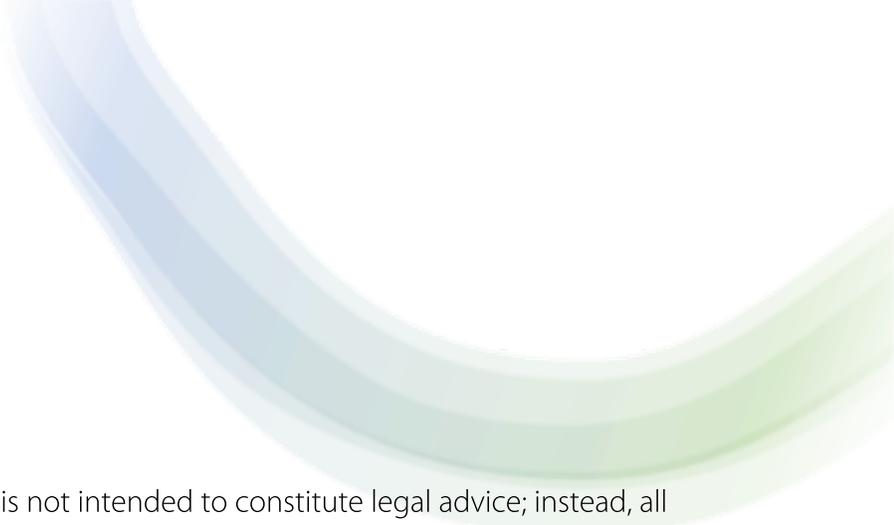




INTRODUCTION TO
TRADEMARKS





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Trademarks

A trademark identifies and distinguishes the origin of particular goods and/or services of a specific brand from those of others. It can be a word, symbol, design, sound, or any combination thereof. Some famous trademarks:

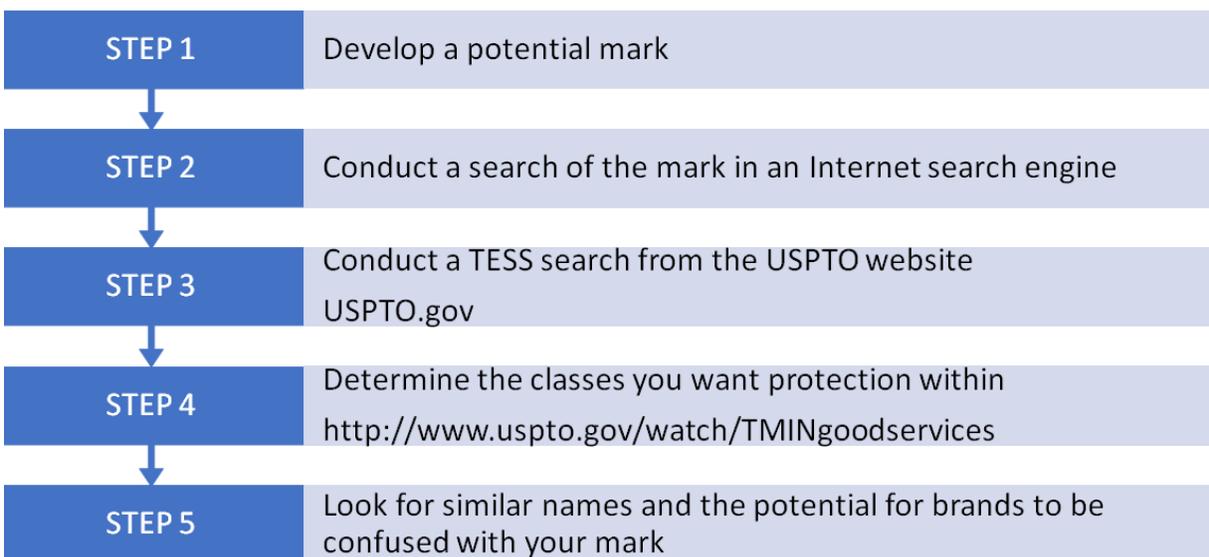
- McDonald's golden arches logo
- Nike's swoosh logo
- NBC's chimes sound

What does a trademark do?

In short, trademarks are the tools that businesses use to create a brand or an identity. Take, for instance, being in a grocery store. Often shoppers look for their favorite brands when determining which type of a product to purchase. Registered trademarks protect a business from competitors and copycats from using the same or similar mark(s) that would create consumer confusion.

I think I need a trademark. Where do I start?

The following chart provides an overview of a process to help you select a company name or logo.

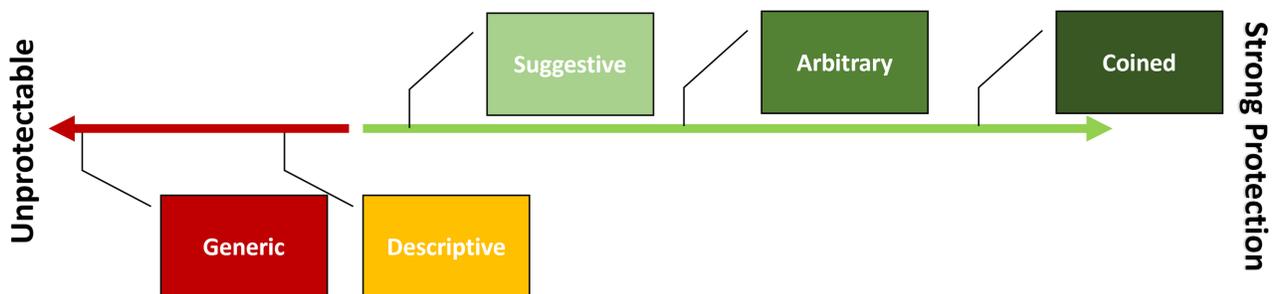


Step 1: Developing a Potential Name (and Logo)

When forming a new business, you will likely want to create a name and logo that establishes a distinct brand for the good or service offered by your company. When doing so, you should ensure that the name and logo are not already in use by somebody else.

Come up with a few names and logos you might want to use, using the following information as guidelines as to what a good mark would be. Specifically, you will want to think about the overall strength of your mark. Trademark strength is generally described based on a scale comprised of generic, descriptive, suggestive, arbitrary, and coined (listed from weakest to strongest).

You will want to keep in mind some key concepts of how to create a strong trademark. Consider the following chart reflecting the spectrum of trademark strength.



GENERIC MARKS cannot get trademark protection because they represent a mark which is used by consumers to identify the product itself, not the brand. Aspirin, trampoline, or linoleum will never be able to be trademarked because the names are now widely used by consumers to identify the goods themselves rather than the particular brand. Avoid developing a generic mark.

DESCRIPTIVE MARKS merely describe the goods/services and are generally not protectable as well. For example, Cold N Creamy when used as a mark associated with ice cream would be merely descriptive of the product itself.

There is an exception to this rule: when a mark has acquired distinctiveness with consumers to the extent that the mark is widely recognized by consumers as being associated with the particular goods and services in which the mark identifies. Acquired distinctiveness is very difficult to achieve unless your brand is established and well-known. You also will want to avoid developing a descriptive mark.

SUGGESTIVE MARKS are those which suggest or allude to the type of product or service and are moderately strong. Some examples of suggestive marks include Coppertone Sunscreen, Airbus, and Netflix. Consider developing a mark that is suggestive.

ARBITRARY MARKS are comprised of words that have a common-language meaning but that meaning is unrelated to the goods/services and are considered strong. Some examples of arbitrary marks include Shell Gasoline and Apple. These are strong marks and you should consider developing a mark that is arbitrary.

COINED MARKS are the strongest marks because they are comprised of characters that form a word or phrase that has no meaning outside of the use of the mark. Some well-known coined marks include Clorox and Google. Consider developing a mark that is coined.

Once you have developed your mark, test it out by researching as to whether it has been used by someone else already as outlined in Step 2.

Step 2: Internet Searching

Conduct a search online using a search engine to determine whether anyone else is using the same or similar name or logo. Based on the results, determine if there is a pre-existing similar mark resulting in a "likelihood of confusion."

How do I determine if there is a "likelihood of confusion" with another mark?

Trademarks prevent the use of similar marks that would cause a likelihood of confusion in consumers. A likelihood of confusion arises when 1) one mark is confusingly similar to another mark and 2) the particular goods and/or services of both companies are also very similar or are related.

A similarity in the marks exists when your marks look and/or sound the same. Similarity in the goods and services are based on the classification of goods and services within the U.S. Patent and Trademark Office (USPTO) Trademark ID Manual, which is the online government resource used to determine to which class a good or services belongs.

Trademarks prevent the use of similar marks that would cause of likelihood of confusion in consumers. A likelihood of confusion arises when one mark is so similar to another mark and the particular goods and/or services of both companies are also very similar or are related.

A similarity in the marks exists when your marks look and/or sound the same, for the same or similar products or services. For example, "SKYE Cosmetics" and "SKY Blush" are similar marks, in the same category of goods (cosmetics), resulting in a likelihood in confusion. If you find another mark that would result in a likelihood of confusion, you should stop at this step and go back to Step 1 of developing another name.

Step 3: TESS Searching

If you have not found any mark on the internet that would result in a likelihood of confusion, you should then repeat your search using the USPTO's Trademark Electronic Search System (TESS). If you are a new user of TESS, it is highly recommended that you utilize the Basic Word Mark Search function to perform your search. In reviewing your TESS results, follow the same process as described above but pay special attention to each result's specific mark and its goods and services description classifications.

If your mark and another similar mark are both in the same class, there is a good chance a likelihood of confusion would be found. More information about classification of goods and services is available at www.uspto.gov/watch/TMINgoodservices.

Step 4: Determining Within Which Class(es) Your Company's Good or Service Fits

As previously mentioned, trademark registrations are filed with specific classifications of goods and services. Therefore, you will be required to identify the applicable classifications you would like to be registered in. Review the USPTO Trademark ID Manual to determine which class you would like, at idm-tmng.uspto.gov/id-master-list-public.html.

You might consider looking up another company which produces a similar good or service, and see which classes its trademark has claimed. For instance, if you want to trademark the name of your company which produces soaps, look up the trademark of a famous soap company and see under which class or classes it is registered. To make sure you know of all classes possible, look up multiple trademarks of similar products.

Step 5: Double-Checking for Likelihood of Confusion

Make sure there is no good or service within the same class as yours that has a sufficiently similar mark that might cause a likelihood of confusion.

Trademark Registration

How do I register my mark for trademark protection?

Below is a step-by-step guide to registering a trademark. However, we still strongly recommend you review your process with an attorney, who can help identify any flaws or issues with your strategy. Remember that this e-book is intended to provide guidance to help you get started; it is not intended to be legal advice or replace the advice of a licensed attorney.

Step 1: Determine dates of first use anywhere and first use "in commerce."

Once you are ready to file your application, you will need several pieces of information including the dates of 1) first use of the mark anywhere, and 2) first use in commerce. Under trademark law, "in commerce" is a term of art that refers to business activities (such as sales) across state lines. In some cases, this can mean the customer lives out-of-state but the transaction occurred in-state; this could also mean that the goods came from out-of-state.

This analysis can become complex, which is why you should seek the advice of an attorney who can determine whether you have met this requirement. More information on whether a good or service qualifies as in commerce available here: tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e7.html

Step 2: Prepare your specimen.

You will be required to submit at least one specimen depicting your mark in commerce within the class you are seeking registration in. A specimen is a document showing your trademark actually is used in commerce with your existing goods/services in a way that directly associates your mark with the goods/services.

More information regarding specimens and their requirements is available at www.uspto.gov/trademarks/laws/specimen-refusal-and-how-overcome-refusal.

Step 3: Determine your classification(s) of goods or services.

As previously mentioned, trademark registrations are filed with specific classifications of goods and services. Identify the applicable classifications you would like to be registered in. Review the USPTO Trademark ID Manual to determine which class you would like at idm-tmng.uspto.gov/id-master-list-public.html.

Step 4: If registering a logo, determine applicable design search codes.

If you are seeking registration of your logo, you must also supply design search codes corresponding to your logo's design elements. This process is particularly important in determining the potential likelihood of confusion with other logos. More information about the design search codes process can be found at www.uspto.gov/trademarks/search/design-search-codes.

How long does trademark protection last?

Initially, a trademark is issued for a period of 10 years. However, the trademark owner **MUST** file a "Section 8 Declaration of Use," between years five and six verifying actual use in commerce with accompanying specimens illustrating use. If this declaration is not filed timely, the trademark will be cancelled.

After filing the "Section 8 Declaration of Use," between years five and six, the trademark owner must file a "Combined Section 8 Declaration of Use and Section 9 Application for Renewal," between years nine and 10. After that, then the same declaration must be filed every 10 years.

What happens if I stop using my mark?

A trademark is considered abandoned when “its use has been discontinued with intent not to resume such use.” A determination of intent to not resume use is typically based on actions and circumstances surrounding the discontinuation of the mark. It is critical to note that three or more years of continued non-use automatically creates a presumption that the mark has been abandoned.

A famous example of abandonment is the Hydrox cookie. For instance, Hydrox cookies were branded and sold by Sunshine biscuits in 1908, and eventually got sold to Keebler, who discontinued the cookie in 1999. In 2015, a company called Leaf began production of the cookie, and was able to claim the trademark since it had not been used by Keebler for well over three years. The bottom line is... USE IT OR LOSE IT.

How much does it cost to obtain a trademark?

If you choose to file your own trademark registration, you will still be required to pay the current USPTO application fee of either \$250 or \$350 per mark, per class, depending upon the customizations needed for your application. If your mark is used in multiple classes, you must pay this application for each class. In the event you select the wrong application, you may be charged additional filing fees.

If you hire an attorney, there will be legal fees as well, separate from the application cost you must pay to the USPTO. According to the legal website UpCounsel, legal fees can range anywhere from \$500 to \$2,000 depending on the complexity of the mark in terms of number of applicable classes and the number of potential conflicting marks.

Even if you would like to cut costs and do it yourself, seeking assistance from an attorney is highly suggested because the application process requires technical knowledge in determining potential registration issues and in adhering to the USPTO guidelines. If the USPTO examiner has questions, it will be worded in highly specialized legal jargon that you might not be familiar with, and it is important to answer those questions as directly as possible.

Interested in learning more?

For additional information, including step-by-step informational videos regarding the application process, visit www.uspto.gov/trademarks/basics/teas-nuts-and-bolts-videos.

While you do not have to have an attorney to file for a trademark registration, it is recommended that you do so in order to avoid common application pitfalls as well as potentially costly future issues arising from clearance search mistakes. Consider hiring one for the first trademark you file.

Conclusion

Operating a business is difficult and takes a lot of time and energy. This toolkit is intended to help you make good decisions about protecting your work.

While there is a lot of legwork you can do on your own for free or for very low cost, you will want to make sure you consult with an attorney to draft the legal documents and forms required, or at minimum, to ensure that you are on the right track if you decide to be responsible for the entire process of protecting your IP. All legwork you do yourself can save your attorney time, and save you attorneys' fees, by making it easier for your attorney to register your IP or draft appropriate legal documents.

What you don't want to do is to complete a trademark registration for the first time by yourself, without any sense of the potential pitfalls that might have a permanent impact. This is why seeking the advice of counsel at the early stages of your process is the most prudent thing you can do to save time and money in the longrun. So it's a great idea to educate yourself as best as possible, in conjunction with the advice of legal counsel. Best of luck on your business adventures!

Useful websites:

- **Trademark basics overview:**
www.uspto.gov/trademarks/basics/teas-nuts-and-bolts-videos
- **Understanding the "in commerce" requirement:**
tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e7.html
- **Selecting the correct classifications:**
www.uspto.gov/watch/TMINgoodservices
- **Submitting acceptable specimens:**
www.uspto.gov/trademarks/laws/specimen-refusal-and-how-overcome-refusal
- **Selecting acceptable design codes:**
www.uspto.gov/trademarks/search/design-search-codes

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