

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





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

Jason Lott

Managing Attorney, Trademarks Customer Outreach

Images used in this presentation are for educational purposes only.



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Discussion topics

- Trademarks and intellectual property
- Benefits of federal registration
- Selecting a trademark
- Filing and registration
- How to find help

Discussion topic

Trademarks and intellectual property

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

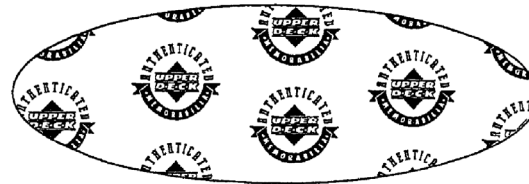
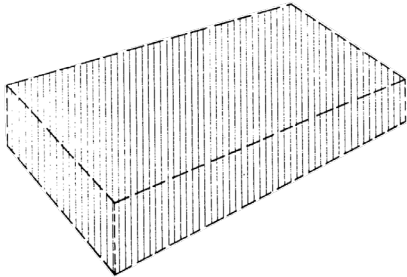
COCA-COLA

**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



Other intellectual property

- **Patent**
 - Protects an invention.
- **Copyright**
 - Protects an original artistic or literary creation.
- **Trade secret**
 - Protects information that has value because it is not generally known.

Other trademark-related concepts

- Domain name registration
 - Provides a web address for your website.
 - Does **not** create a registered trademark.
- Trade name registration
 - Allows you to do business in a particular state or jurisdiction.
 - Does **not** create a registered trademark.



Domain name vs. trademark use

The screenshot shows the homepage of LowRates.com. The browser's address bar displays "lowrates.com", which is circled in red. The website's logo, featuring a house icon and the text "LowRates.com by Sun West Mortgage Company, Inc. NMLS 3277", is also circled in red. The navigation menu includes "Home", "About Us", "Loan Programs", "Resources", and "Talk To Us". A prominent blue banner reads "TODAY'S RATES". Below this, there are tabs for "Conventional" and "FHA". A central callout box displays "15 YR FIXED", "2.054%", "(Rate & APR)", and a "Get Quote" button.

Trade name vs. trademark use



COOKING INSTRUCTIONS

1. Preheat frying pan to 375°F (high).
2. Break up steak into small pieces and place in pan.
3. While cooking, toss and stir with spatula for a few minutes until golden brown.

Raw beef products should be cooked to an internal temperature of 160°F.

Safe Handling Instructions

This product was prepared from inspected and passed meat and/or poultry. Some food products may contain bacteria that could cause illness if the product is mishandled or cooked improperly. For your protection, follow these safe handling instructions.

- Keep refrigerated or frozen. Thaw in refrigerator or microwave.
- Keep raw meat and poultry separate from other foods. Wash working surfaces (including cutting boards), utensils, and hands after touching raw meat or poultry.
- Cook thoroughly.
- Keep hot foods hot. Refrigerate leftovers immediately or discard.

Try Our Other Tasty
Philly's Best Steak Products
Chicken Philly Sandwich Slices
 &
Buffalo Chicken Philly Sandwich Slices
 Visit us at www.phillysbeststeak.com

THE PHILLY POUNDER

Premium Beef Sandwich Steaks

SERVING SUGGESTIONS

Philadelphia Style Cheesesteak

Cook Philly's Best Steak Beef Philly Sandwich Slices according to cooking instructions and serve on a fresh Italian roll. Add 3 slices of American cheese. Top with your favorite condiment.

Steak, Egg & Cheese Bagel

Toast your favorite style bagel and add cooked Philly's Best Steak Beef Philly Sandwich Slices, one fried egg and your favorite cheese.

Cheesesteak Stromboli

Pick up your favorite pizza dough and roll out on a sheet pan in the shape of a rectangle. Spread cooked Philly's Best Steak Beef Philly Sandwich Slices loosely over dough. Add shredded mozzarella cheese and Italian seasoning spices. Carefully roll dough into a loaf shape. Tuck the end of dough under loaf. Brush with olive oil and bake at 350°F for 20 - 30 minutes or until crust is golden brown. Serve with marinara sauce for dipping.



Nutrition Facts

Serving Size 4 oz. (112g)
 Servings Per Container 4

Amount Per Serving

Calories 120 Calories from Fat 50

% Daily Value*

Total Fat 6g	9%
Saturated Fat 2.5g	13%
Trans Fat 0g	
Cholesterol 45mg	16%
Sodium 180mg	7%
Total Carbohydrate 1g	0%
Dietary Fiber <1g	2%
Sugars 0g	

Protein 16g

Vitamin A 0% • Vitamin C 0%

Calcium 0% • Iron 0%

*Percent Daily Values are based on a 2,000 calorie diet. Your daily values may be higher or lower depending on your calorie needs:

	Calories: 2,000	2,500
Total Fat	Less Than 65g	80g
Sat Fat	Less Than 20g	25g
Cholesterol	Less Than 300mg	300mg
Sodium	Less Than 2,400mg	2,400mg
Total Carbohydrate	300g	375g
Dietary Fiber	25g	30g

Calories per gram:
 Fat 9 • Carbohydrate 4 • Protein 4

INGREDIENTS: BEEF, WATER, SOY PROTEIN CONCENTRATE, DEXTROSE, MODIFIED CORN STARCH, SODIUM PHOSPHATE, SALT, ISOLATED SOY PROTEIN, HYDROLYZED SOY PROTEIN, NATURAL FLAVORINGS.

CONTAINS: SOY



MADE IN THE U.S.A.

Philly's Best Steak Company, Inc.
 Yeadon, PA 19050



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

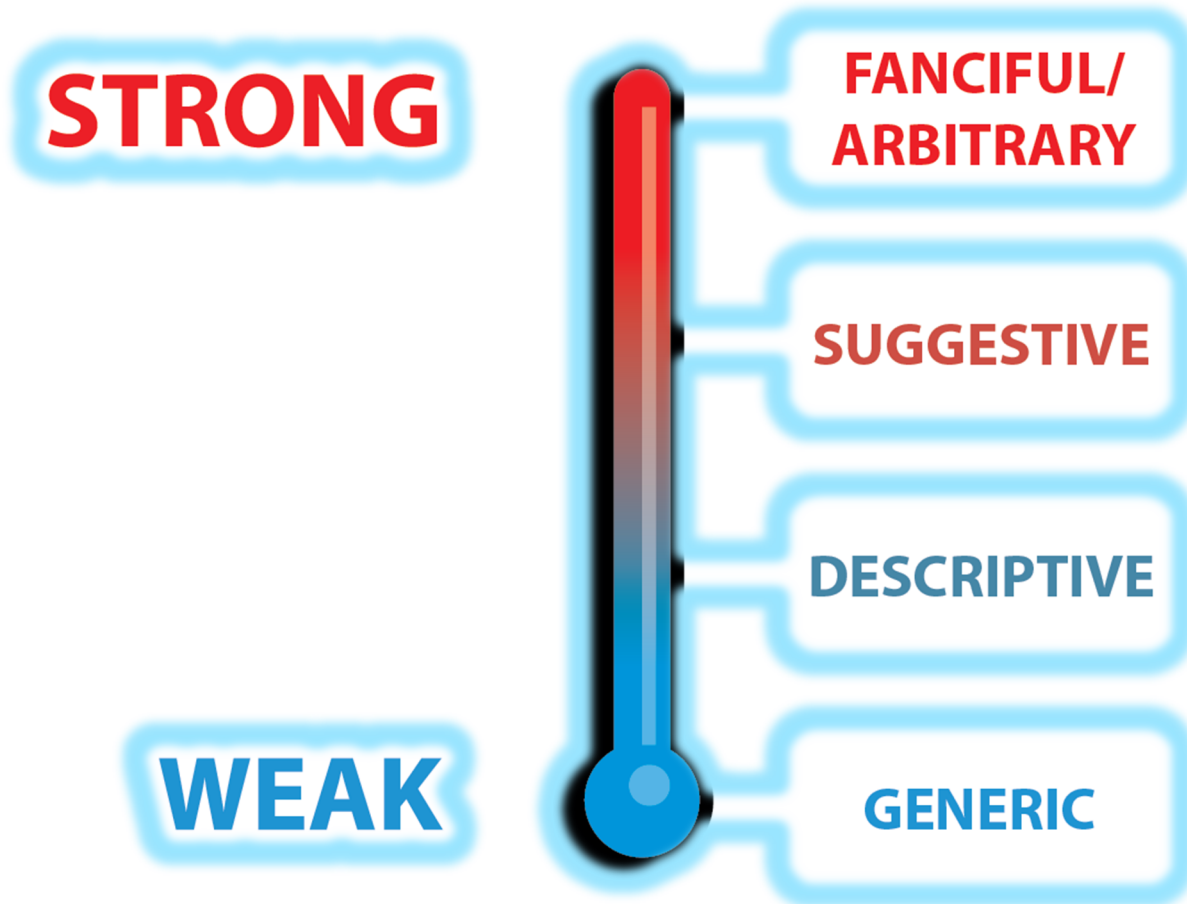
Selecting a trademark: Strength of the trademark



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).
 - Two filing options
 - TEAS Plus
 - TEAS Standard

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

- Filing fees per TEAS filing option
 - TEAS Plus: \$250 per international class
 - TEAS Standard: \$350 per international class
- **Formula for calculating filing fee**
 - Your filing option fee multiplied by the number of international classes in the application



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

- Free services and resources
 - www.uspto.gov/FreeServices
- Women's Entrepreneurship
 - www.uspto.gov/initiatives/we
- Inventor and entrepreneur resources
 - www.uspto.gov/Inventors



USPTO resources

- IP Identifier

- Identify your IP assets by answering six brief questions.
- Learn basic information about your identified IP and access additional resources.
- Download a PDF of your results and resources.



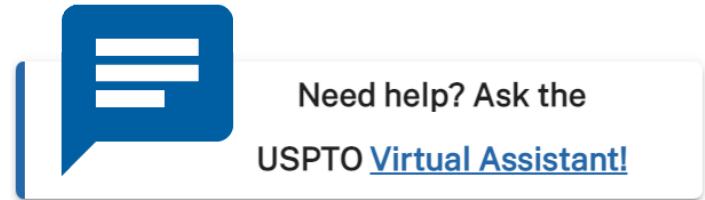


USPTO resources

- USPTO virtual assistant

- Beta testing on trademark questions

- Easy way to look up your application status





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.





Legal resources

- Remember:
 - Best resource is an experienced trademark attorney.
 - Most trademark filing companies can only provide limited services.





Legal resources

- Free or reduced-price legal services
 - USPTO law school clinic certification program
 - www.uspto.gov/LawSchoolClinic
 - American Bar Association
 - www.americanbar.org/groups/legal_services/flh-home
 - International Trademark Association
 - www.inta.org/resources/pro-bono-clearinghouse



Other resources

- Advice and business consulting
 - Patent and Trademark Resource Centers (PTRCs)
 - www.uspto.gov/PTRC
 - Small Business Administration programs
 - www.sba.gov/local-assistance/resource-partners

Questions?

