

# **Trademarks: Selection, Searching & Registration**

1. Select potential trademark(s)
2. Search for availability/evaluate risk
3. Seek federal registration of the mark with the PTO

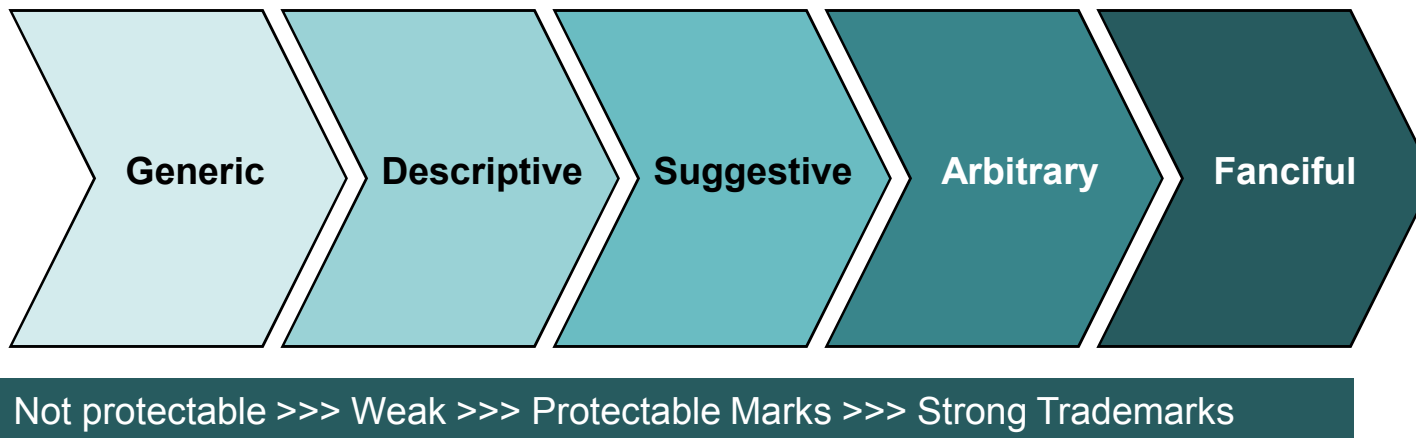


# Trademark Selection

- Goal: Choose a protectable trademark
  - Is it registrable and enforceable (distinctive)?
  - Are you first?
- Choose several marks in the initial stages

# Trademark Selection

## Spectrum of Distinctiveness:



Generic: term describes the class of products/services (ASPIRIN for aspirin)

Descriptive: describe goods or services (VISION CENTER for an optics store)

Suggestive: indirectly allude to a quality of the product (ORANGE CRUSH for orange soda)

Arbitrary: common word used in a unique way (APPLE for computers)

Fanciful: “coined” terms that had no meaning prior to adoption (KODAK, STARBUCKS)



# Trademark Selection

- Tension between marketing goals and trademark protection goals
  - Marketing: want a name that describes the goods or services for an instant connection by consumers
  - Trademark: descriptive marks are not immediately protectable
  - Compromise: suggestive mark? Easily register and easier to market than fanciful or arbitrary



# Trademark Selection

- DUTCH BOY for paint
- COPPERTONE for suntan oil
- PARK N FLY for airport parking lots
- REEBOK for athletic shoes
- BLUE DIAMOND for nuts
- ROACH MOTEL for insect traps



# Trademark Selection - *Answers*

- DUTCH BOY : Arbitrary
- COPPERTONE: Suggestive
- PARK N FLY: Descriptive
- REEBOK: Fanciful
- BLUE DIAMOND: Arbitrary
- ROACH MOTEL: Suggestive



# Trademark Searching

- Clearing a Trademark: Are you first?
- Two Steps:
  - Knock-out search
    - TESS
    - Google/Internet search
  - Comprehensive search
    - Outside vendors compile report
    - Typically \$600 - \$1200 per mark (unlimited classes/goods; search only)



# Trademark Searching

- Knock-out search: [TESS](#)
- New User Form Search
  - Search by Registration No.
    - Reg. No. 3440643
  - Search by Application No.
    - Serial No. 78796863
  - Search by Owner Name
    - “UnitedHealth Group”

Trademark Electronic Search System (TESS) - Microsoft Internet Explorer provided by UnitedHealth Group

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Address http://tess2.uspto.gov/bir/gate.exe?searchdate=4009.06n03.1.1

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## Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Aug 30 04:35:45 EDT 2011

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**WARNING:** AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

View Search History:

Plural and Singular
  Singular  
 Live and Dead
  Live
  Dead

Search Term:

Field: 

- Combined Word Mark (BUTLMP:TL)
- Serial or Registration Number
- Owner Name and Address
- ALL

Result Must Contain:

Submit Query Clear Query

Logout Please logout when you are done to release system resources allocated for you.

This **New User (Basic)** search form allows for searching of the most commonly searched fields: word marks, serial or registration numbers, and owners.

The **Combined Word Mark** is the default search field and includes the **word mark** and **translations**.

Use the \$ for truncation in any field. For **Combined Word Mark** searches, the \* is a more efficient truncation operator for left and/or right truncation. For example, the search term "D06\*" with the **Combined Word Mark** will retrieve marks with common variations of the word DOG in the word mark or translation statements. Use of the \$ truncation operator sometimes results in a truncated hit list.

For serial number or registration number searches, enter the 8-digit serial number (e.g. 75123495) or 7-digit registration number (e.g., 1234567) and select **Serial or Registration Number** as the Field for the search. If multiple serial or registration numbers are searched, separate the numbers by spaces and change the Results Must Contain value to Any Search Terms (OR). (Alternatively, separate the number by the Boolean OR operator without adjusting the Result Must Contain value.)

Do **NOT** include the apostrophe for contractions. For example, search for the word **DON'T** by searching **DON T**. Including Boolean operators (e.g., AND, OR, NOT) or proximity operators (e.g., ADJ, NEAR, SAME, WITH) in your search will override the Result Must Contain setting for the search. To actually search for these Boolean or proximity operators, include quotes around the operator.

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# Trademark Searching

- TESS
- Structured Form Search
  - Two-word mark search
    - Example: WINNER'S WHEEL = (winner's)[bi] and (wheel)[bi]
      - Record for identical mark and related goods is a knock-out
      - Record for highly similar mark for similar goods usually a knock-out
  - Search for a Product Configuration
    - Bunny Configuration
      - (bunny)[DE] and (configuration)[DE]
        - 8 records revealed
      - (configuration)[TC] and (bunny)[DE]
        - 2 record revealed
        - Also Design Search Code Manual



Trademark Electronic Search System (TESS) - Microsoft Internet Explorer provided by UnitedHealth Group

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Address http://tess2.uspto.gov/bir/gate.exe?searchdatabase=4009.0&nd3.1.1

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View Search History:

Records Returned: 100

Search Term:  Field: ALL Operator: OR

Search Term:  Field: ALL

Please logout when you are done to release system resources

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- ALL
- Abandonment Date
- Alidivits
- Assignment Recorded
- Attorney of Record
- Basic Index (combined MP+PM+MIN)
- Coordinated Class
- Cancellation Date
- Change in Registration
- Current Filing Basis
- Decimal Mark
- Description of Mark
- Design Code
- Design Description
- Disclaimer Statement
- Distinctiveness Limitation Statement
- Filing Date
- Full Mark
- Goods & Services
- International Class
- International Registration Number
- Live/Dead Indicator
- Mark Drawing Code
- Mark Index
- Mark Punctuated/Word Mark
- Non-Punctuated Word Mark
- Original Filing Basis
- Other Date
- Owner Name
- Owner Name and Address

Done Trusted sites

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# Trademark Searching

## ■ TESS

## ■ Free Form Search

- Two-word mark search plus goods
  - WINNER'S WHEEL
    - In connection with “gaming machines”
    - Only live applications or registrations
      - (“Winner’s wheel”)[BI] and (“gaming machines”)[GS] and (live)[LD]
      - No references found
  - Bunny Configuration
    - In connection with Candy, which falls in International Class 30
    - (bunny)[DE] and (configuration)[de] and (030)[IC]
    - 8 records found



Trademark Electronic Search System (TESS) - Microsoft Internet Explorer provided by UnitedHealth Group

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Address http://tess2.uspto.gov/bin/gate.exe?f=search&state=4008:be7re3.1.1

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View Search History:

Records Returned: 100 Plurals: Yes [Quick Tips](#)

Search Term:

Please logout when you are done to release system resources allocated for you.

#### US Trademark Field Codes

Code & Name	Code & Name	Code & Name
[AD] Abandonment Date	[IC] International Class	[RD] Registration Date
[AF] Affidavits	[IR] International Registration Number	[RE] Renewals
[AR] Assignment Recorded	[LD] Live/Dead	[RG] Register
[AT] Attorney of Record	[MD] Mark Drawing Code	[RN] Registration Number
[BI] Basic Index	[MI] Mark Index	[SF] Section 44 Indicator
[CB] Current Filing Basis	[MN] Mark Non-Punctuated	[SD] Single Design Code
[CC] Coordinated Class	[MP] Mark Punctuated/Word Mark	[SN] Serial Number
[CD] Cancellation Date	[OB] Original Filing Basis	[SO] Serial - Other Formats
[CR] Change in Registration	[OD] Other Data	[ST] Standard Characters Claimed
[DC] Design Search Code	[ON] Owner Name	[SR] Supplemental Register Date
[DD] Design Description	[OW] Owner Name and Address	[TC] Trademark Search Facility Classification Code(limited to 8-28-07 through 1-31-11)
[DE] Description of Mark	[PD] Priority Date	[TD] Total Designs
[DM] Decimal Mark	[PF] Physical Filing Date	[TF] Distinctiveness Limitation Statement
[DS] Disclaimer	[PO] Published for Opposition	[TI] Translation Index
[FD] Filing Date	[PM] Pseudo Mark	[TL] Translation
[FM] Full Mark	[PI] Pseudo Mark Index	[TM] Type of Mark
[GS] Goods and Services	[PR] Prior Registrations	[UD] Update/Load Date
		[US] US Class

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http://www.uspto.gov/helpdesk/status/status.htm

Trusted sites

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# Trademark Selection & Searching

- Trademark Search Example: XYZ, an athletic shoe company, has created a new line of ultra-light running shoes.
  - Three Potential Marks
    - CHEETAHZ
    - ZOOMZ LITE
    - FEATHER FLYERZ
  - Where do the proposed marks fall re: Distinctiveness?
    - Suggestive
  - Do the marks appear available in connection with the goods?
    - CHEETAHZ – knocked out by a registration for CHEETAH for athletic shoes;
    - ZOOMZ – potentially knocked out a registration for ZOOMLITE for roller skate shoes and athletic bags
    - FEATHER FLYERZ – mark for PF FLYERS for athletic shoes and FEATHERLITE for orthopedic shoes; best choice?
  - Any Google references of concern?
    - Featherflyers.com for flying hunting decoys



# Trademark Registration Process

- Once you have selected and cleared a mark for use and registrability, an application for federal registration of the mark should be prepared and filed.
- Trademark Manual of Examining Procedure (“TMEP”) – Governs the requirements relating to the filing and prosecution of trademark applications.



# Preparing the Application

- An Application Includes:
  - Name of Applicant
  - Citizenship of Applicant
  - ID of Goods/Services
  - Specimen and Date of First Use (use-based)
  - Drawing of the Mark
  - Verification/Declaration Signed by Applicant
  - Filing Fee
  - Basis for Filing the Applicant



# The Applicant

- Must be the owner of the mark, or the person who has a bona fide intent to use the mark in commerce
- Applicants may be natural persons, business entities, or government entities
- Applicant's name must be in correct legal form
- Must specify the applicant's citizenship or the state or nation under whose laws the applicant is organized



# ID of Goods/Services

- Application must include a list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark
- Should designate the International Class appropriate for the identified goods/service
- 45 separate International Classes by category of goods/services



# ID of Goods/Services

- Each class requires a filing fee
- A registered mark only receives protection for those classes in which it is registered
- Trademark Acceptable Identification of Goods/Services
- If mark is used for more than one class of goods/services, applicant may either (1) file a combined application, or (2) file separate applications for each class of goods/services
- Once filed, applicant cannot add to or expand an ID



# Basis for Filing

- Five Bases for Filing:
  - Use of a mark in commerce under §1(a) of the Trademark Act
  - Bona fide intention to use a mark in commerce under §1(b) of the Act (“Intent-To-Use” Application)
  - A claim of priority, based on an earlier-filed foreign application under §44(d) of the Act
  - Ownership of a registration of the mark in the applicant’s country of origin under §44(e) of the Act
  - Extension of protection of an international registration to the United States, under §66(a) of the Act
- An applicant is not required to specify the basis for filing to receive a filing date



# Drawing of Mark

- Shows the mark sought to be registered
- Two Types of Drawings:
  - Standard Character Drawing: must show the mark in black on a white background
  - Special Form Drawing: a drawing that presents a mark comprised, in whole or in part, of special characteristics such as elements of two- or three-dimensional design, color (e.g., style(s) of lettering, or unusual form(s) of punctuation



# Specimens

- Required for §1(a), use-based applications (each class)
- Must show the manner in which the mark is seen by the public; showing use of the mark on or in connection with the goods, or in the sale or advertising of the services, in commerce.
- §1(b) (intent-to-use), no specimen is required at the time the application is filed. However, before a registration will issue, the applicant must file an allegation of use showing use of the mark in commerce on or in connection with the goods or in the sale or advertising of the services (each class).



# Specimens

- A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods.
- A service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. Acceptable specimens may include newspaper and magazine advertisements, brochures, billboards, handbills, direct-mail leaflets, menus (for restaurants), and the like.



# Declaration & Signature

- The application must be signed by and include a declaration by the applicant or its agent or attorney.
- Declaration is at the end of the application.
- Signatory acknowledges that the statements in the application are true and that the signatory understands that willful false statements are punishable by fine or imprisonment and may jeopardize the validity of the application.



# Principal Register

## Benefits of Registration:

- Constructive notice nationwide of the registrant's claim of ownership of the registered mark.
- Permits recordal with United States Customs Service to block importation of products/materials bearing infringing/counterfeit trademarks.
- Registration can become incontestable (after five years).
- An action for infringement can be brought in federal court.



# Additional Benefits

- The registration is *prima facie* evidence that the:
  - Trademark is valid (i.e., eligible subject matter, complies with all legal requirements, operates as a trademark, not abandoned)
  - Registrant is the owner of the registered trademark
  - Registrant has the exclusive right to use the trademark nationwide
- Registration is on file with USPTO and can be cited against a third-party's subsequent application to register a confusingly similar mark;
- Registration will be located through standard searching of USPTO records, thus possibly deterring others from using or applying for a similar mark



# Docketing

- Trademark applications/registrations are deadline intensive.
- Keeping track of deadlines and dates is part of the professional responsibility of trademark attorneys and paralegals.
- Critical to docket the filing date of application
  - Initiates various time limits
  - Should receive Official Filing Receipt immediately after electronically filing application or weeks after filing paper application
    - Filing Receipt confirms filing date, provides a serial number and confirms all details of the application
    - Carefully scrutinize and immediately contact USPTO if find mistakes



# Examination Procedure

- Examining Attorney (“EA”) assigned to application
- Office Action – written communication sent by the EA to the applicant stating that the mark has been refused registration and explains why registration has been refused
  - Must be responded to within **6 months**



# Examination Procedure

- Office Actions & Refusals to Register
  - Curing Informalities & Technical Defects
  - Substantive Refusals
    - Immoral/Scandalous
    - Deceptive
    - Disparages a person or national institution or displays the flag or insignia of a nation
    - Displays a portrait of a living person without consent
    - Geographically deceptively mis-descriptive
    - Primarily merely descriptive
    - Confusingly similar to another registered or applied-for mark



# Examination Procedure

- Office Actions & Refusals to Register
  - Refusal on the Basis of Descriptiveness
    - If cannot overcome refusal, Applicant can amend to the Supplemental Register if use of the mark has begun
    - If only a portion of the mark is descriptive or generic, that portion may be disclaimed
  - Refusal on the Basis of Confusing Similarity



# Examination Procedure

- Refusal on the Basis of Confusingly Similar

- Some of the *DuPont* factors are as follows:

- Similarity of the marks – sight, sound, connotation, and commercial impression;
    - Similarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use;
    - Similarity of established, likely-to-continue trade channels;
    - Conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;
    - Fame of the prior mark;
    - Number and nature of similar marks in use on similar goods;
    - Nature and extent of any actual confusion.



# Examination Procedure

- Office Actions & Refusals to Register
  - Response to Office Actions
    - Failure to respond in a timely fashion to an Office Action with result in abandonment of the application unless the delay was unintentional
    - If applicant's initial response to the first Office Action does not succeed in overcoming the refusals, Applicant will receive a second Office Action
    - If applicant's response to the second Office Action does not succeed in overcoming the refusals, Applicant will receive a Final Office Action
    - At this point, Applicant can comply with EA's requirements, request reconsideration by bringing new matter before the EA, or appeal the refusal to the Trademark Trial & Appeal Board ("TTAB")



# Postexamination Procedure

## ■ Publication in the Official Gazette

- Once applicant responds satisfactorily to any Office Actions, the EA will approve the mark for publication in the weekly Official Gazette
- The purpose of the publication is to afford third parties the opportunity to review the mark and oppose its registration
- Most trademark owners hire a third party to conduct a watch service to review the OG
- A Notice of Opposition or Request for Extension of Time to Oppose must be filed with the Trademark Trial & Appeal Board within 30 days of publication of the mark
  - Extensions may be obtained, but the time for filing an opposition may not be extended beyond 180 days from the date of publication
  - Docketing of these dates is critical



# Post Publication

- If application was based upon applicant's actual use of the mark in commerce, the actual use application will proceed to registration after the publication period
- If application was based on a bona fide intent to use the mark in commerce, the application cannot proceed to registration until actual use has been shown



# Statement/Amendment of Use

- Statement of Use
  - Verifies mark is in use
  - Specifies date of first use
  - Includes a specimen showing actual use of the mark
- Amendment to Allege Use (“AAU”)
  - If use of the mark commenced during the application process of an ITU application, applicant may file an amendment to the application alleging that use has occurred and providing a specimen showing such use
  - Only significant difference between AAU and SOU is time of filing
  - An AAU cannot be filed after the EA approves application for publication and before a NOA issues – this is the Blackout Period



# Application Based on Intent to Use (§1(b))

- Once a mark achieves registration, the **filing** date of the application is deemed to be the date upon which the owner of the registration first use the mark (“Constructive Use” Date)
- This is particularly important to ITU applicants who may not have been using the mark at the time of filing



# Registration

- Time from Application to Registration
  - Actual Use Applications – approx. 12 – 18 months
  - ITU Applications – approx. 18 – 24 months
- Certificate of Registration issued upon registration
  - Includes all pertinent information about the mark, the owner and will set forth a registration date and number
  - Review carefully and request a correction for any errors with the USPTO



# Registration

- Upon registration, applicant now referred to as “Registrant”
- Registrant can now mark the trademark as registered
  - Most common way is to use the circle R following the mark
    - E.g., POST-IT<sup>®</sup> Note
  - Registrant is not required to use the notice, but using notice gives actual notice which is required for monetary damages in an infringement lawsuit
- Law firm will send Certificate of Registration to client and docket the date of registration to make certain the necessary post-registration filings get done