

Trademarks

Class schedule

Class	Topic
9/10	Introduction
9/17	Copyrights
9/24	Trademarks
10/1	Patents
10/8	Digital futures



Clare OR Nikki



Google's Deal for Polar Shows It Has Not Given Up
On Google+

Polar as a trademark



POLAR CORP., Plaintiff, v. THE COCA-COLA CO.,
Defendant.

It's not that simple

What we'll cover

- ▶ The basics of trademarks
- ▶ What you need to remember
 - Use it or lose it
 - Likelihood of confusion
 - And, of course, ...
It depends
- ▶ Selecting and using your mark
- ▶ The law and registration process
- ▶ Care and feeding of your mark
- ▶ Trademarks you know but don't

What is a trademark?

- ▶ A word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others.
- ▶ The main purpose of a trademark is to designate the source of goods or services.
- ▶ To receive federal protection, a trademark must be
 1. Distinctive rather than merely descriptive or generic
 2. Affixed to a product that is sold in the marketplace
 3. Registered with the U.S. Patent and Trademark Office.
- ▶ Unregistered trademarks are protected under common-law and distinguished with the mark TM

Types of marks

- ▶ Trademarks
- ▶ Service marks
- ▶ Certification marks
- ▶ Collective marks

Relationship to copyright

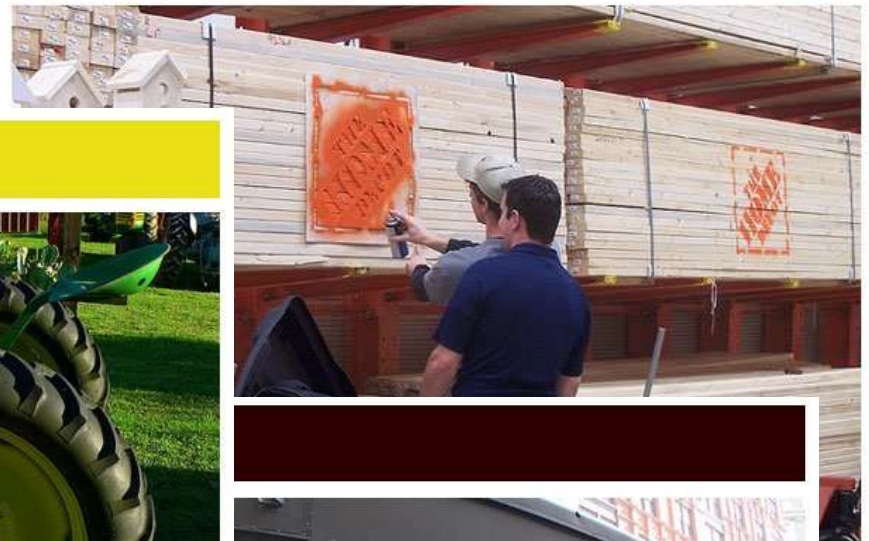
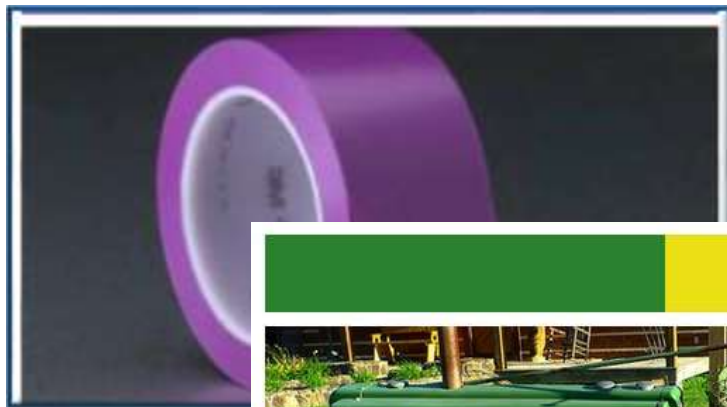
- ▶ Copyright refers to the content
- ▶ Trademark refers to the distinctive mark
- ▶ Something can be protected by both a copyright and a trademark
- ▶ All are managed by contracts and licensing

What do those symbols mean?

- ▶ “TM” (trademark) or “SM” (service mark)
- ▶ You may use the designation to alert the public to your claim of ownership of the mark.
- ▶ You may only use the federal registration symbol “®” after the USPTO actually *registers a mark*, and **not** while an application is pending.

What can you protect?

- ▶ Trade names and business names
- ▶ Images
- ▶ Fonts
- ▶ Colors



Colors

Colors that are trademarked

Likelihood of confusion

- ▶ Does this mark look or sound enough like another mark that a reasonable person might be confused?

Use it or lose it

- ▶ In most cases, you use your trademark before you register it.
 - There are rare cases where you register prior to use
- ▶ Using your mark establishes the relationship between the mark and your product.
- ▶ You protect your mark by
 - Using it
 - Guarding against dilution
 - Keeping it registered

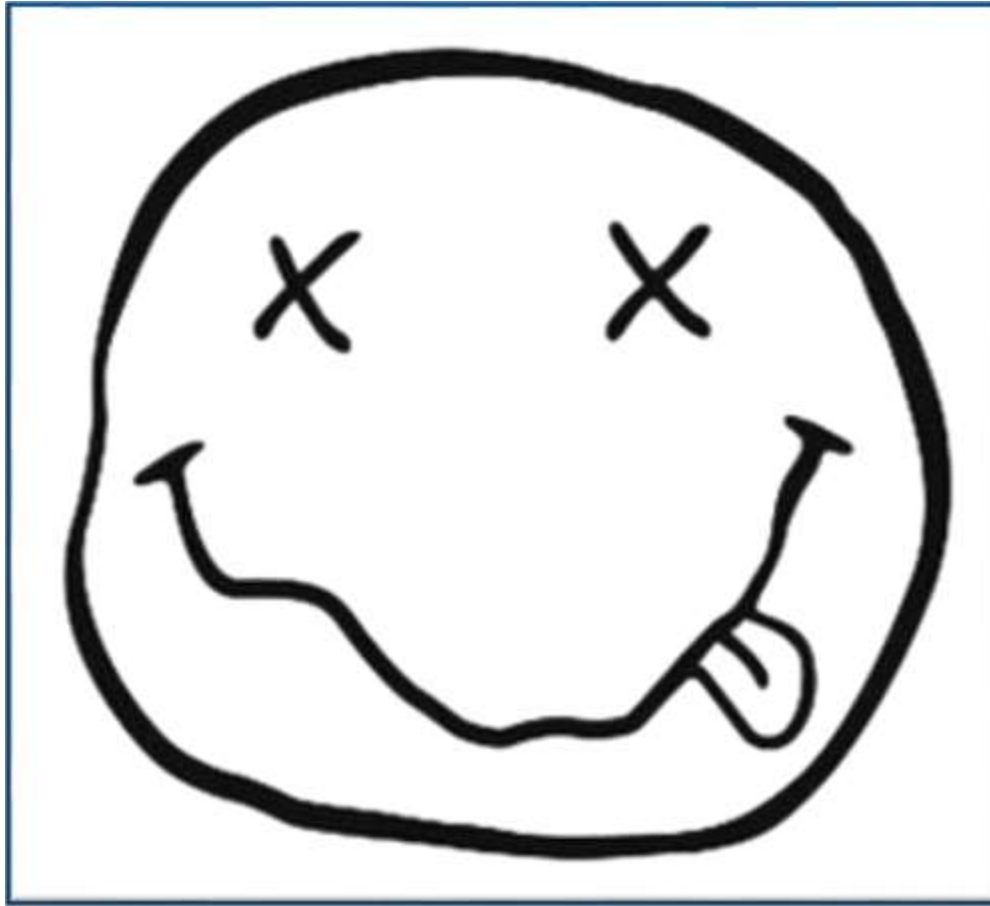


Trademarks in the wild



Is this the Smiley Face we know and love?

The drawing shows a configuration of the goods, namely processed potatoes shaped like a three-dimensional smiley face.



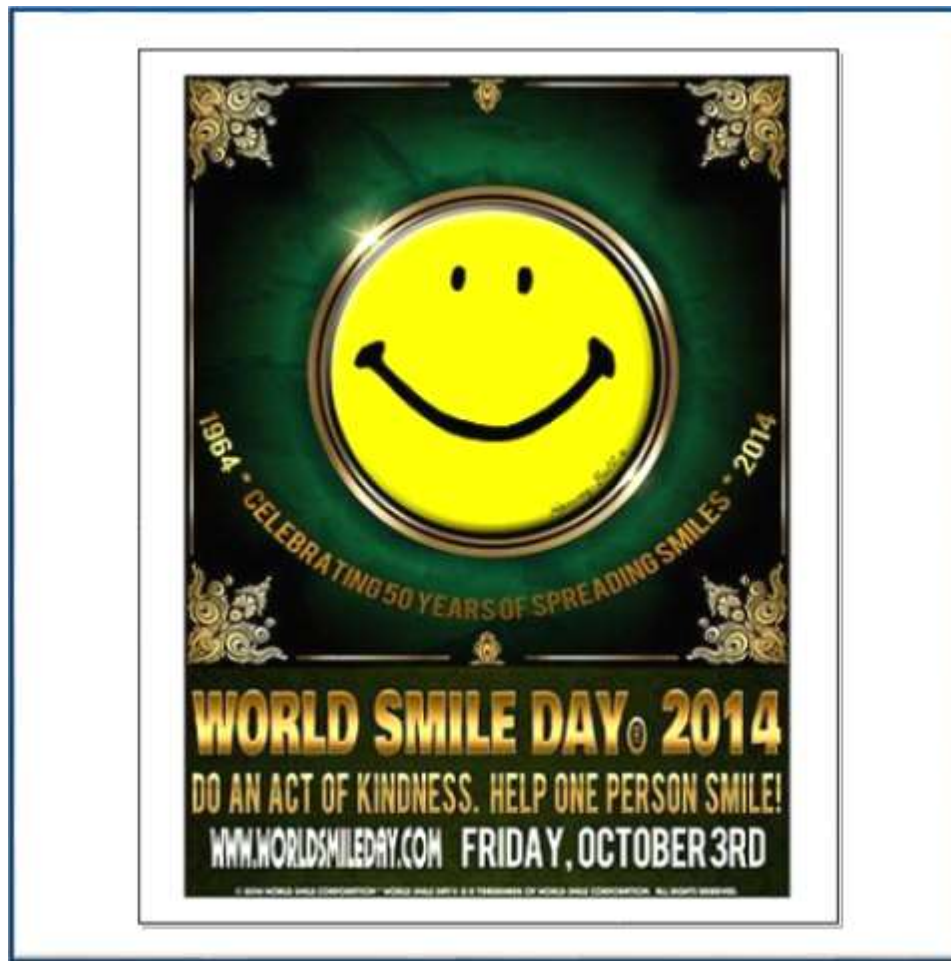
How about this?

Filed by [Harvey Ball Smile Limited](#) in April 2014. Not yet registered.



First designed in 1963

First use in commerce in 2008



World Smiley Day is on October 3

For \$14.99, you, too, can have a poster.



Parody as a defense against infringement

Suite 100
Fairfax, VA 22030
Facsimile: 703.839.8611

Re: Infringement and Dilution of Trademark Rights of National Pork Board

To Whom It May Concern:

This law firm represents National Pork Board in connection with its intellectual property rights.

We are writing to you in connection with your activities at the website www.thinkgeek.com, wherein you have been marketing a product called "Radiant Farms Canned Unicorn Meat" using the slogan "Unicorn - the new white meat." A copy of the website page advertising the unicorn meat is attached for your reference. In addition, it appears that a number of other websites that refer to this product use the wording "The Other White Meat" in connection with the product, including www.facebook.com/pages/Unicorn-Meat-The-Other-White-Meat/116348375047769 and www.thefrisky.com/post/246-unicorn-the-other-white-meat/?TrackID=fool (see attached copies of website pages).

National Pork Board is the owner of the mark **THE OTHER WHITE MEAT®** in the United States and elsewhere around the world, and owns the following federal trademark

Unicorn Meat is not "The Other White Meat"

[Against an April Fool's article](#)





Branding and Publicity

Whose is this?

- ▶ Trademarks give assurance regarding the manufacturer and the manufacturer's standards.
- ▶ Akin to a signature
- ▶ Right to publicity
- ▶ Easily recognized
 - Words
 - Graphics
 - Sounds
 - Textures
 - Smells

Catch phrases

- ▶ “That’s hot!”
 - Paris Hilton Reg. Num. [3209488](#)
- ▶ “there’s an app for that”
 - [Apple trade marks 'There's an app for that'](#)
- ▶ “for a cure”
 - [Susan G. Komen Foundation Elbows Out Charities Over Use Of The Word 'Cure'](#)
- ▶ “Three-peat” –
L.A. Lakers Pat Riley via Riles & Co.
Reg. Num. 1552980



The Law

Federal and State

- ▶ Federal Law:
[Lanham \(Trademark\) Act \(15 U.S.C.\)](#)
- ▶ Massachusetts Law:
 - [Labels, trade marks, names and registration thereof \(M.G.L. ch.110\)](#)
 - Administered by the Secretary of State:
[About Trademarks and Service Marks](#)
- ▶ Why do we have both?

How it works

- ▶ When you file for a trademark, you receive a serial number. The serial number is the record of your case. It does not mean that your trademark is registered yet.
- ▶ When your trademark has been approved, you receive a registration number. This number means that you can use the ® after your trademark.

How long does a trademark last?

- ▶ Unlike copyrights and patents, trademarks remain valid for as long as you use it
- ▶ You must renew your trademark
- ▶ Federal
 - A §8 Declaration of Continued Use – between 5th and 6th year after registration
 - Continues until 10th year
 - Fee: \$100
 - Renew on the 10th year and every 10 years afterwards
- ▶ State
 - Five years
 - Renew within six months for another five



Protecting your trademarks

You have the right and obligation to sue

- ▶ You must use the mark in commerce
- ▶ You must protect your mark
 - Other trademark holders can prevent your from registering your mark (See Polar case)
 - You can prevent others from registering their marks

What happens if you don't?

- ▶ Dilution
- ▶ Genericide
Your mark become a generic term
- ▶ Examples
 - Phillips-head screwdriver – Henry Phillips
 - Yo-Yo – Duncan

Familiar, but trademarked

- ▶ Naked Cowboy® – [Do Not Wear a White Cowboy Hat, Boots & Underwear : Duets Blog](#)
- ▶ Thumb Drive™ - not registered, but affirmed as a trademark
[ThumbDrive maker finally wins trademark – PCWorld](#)
- ▶ March Madness® - 74360563
[Is it Madness to Say "March Madness" On the Air? - The Trademark Issue : Broadcast Law Blog](#)

BAYER Pharmaceutical Products
HEROIN—HYDROCHLORIDE

is pre-eminently adapted for the manufacture of cough elixirs, cough balsams, cough drops, cough lozenges, and cough medicines of any kind. Price in 1 oz. packages, \$4.85 per ounce; less in larger quantities. The efficient dose being very small (1-48 to 1-24 gr.), it is

The Cheapest Specific for the Relief of Coughs

(In bronchitis, phthisis, whooping cough, etc., etc.)

WRITE FOR LITERATURE TO

FARBENFABRIKEN OF ELBERFELD COMPANY

SELLING AGENTS

P. O. Box 2160

40 Stone Street, NEW YORK



Another casualty of the Great War

Bayer lost its US trademark and patent in the Treaty of Versailles

GED

GED® and GED Testing Service® are registered trademarks of the American Council on Education® and may not be used or reproduced without the express written permission of the American Council on Education.

- ▶ The GED is commonly known as a General Education Diploma, General Equivalency Diploma, or Graduate Equivalency Degree.
- ▶ The American Council on Education® owns the rights to the trademarked terms “GED” and “GED Testing Service.”
- ▶ Always used as an adjective.

The logo



WAKE UP

You're not in a movie.
This is life, get back to
reality

www.healthythoughts.in

**Church of Reality founder granted Trademark on
REALITY®**



United States Patent and Trademark Office
 An Agency of the Department of Commerce

[Home](#) | [Help](#) | [Site Index](#) | [Contact Us](#)

SEARCH:

HOW DO I:

[About USPTO](#) [Patents](#) [Trademarks](#) [IP Law & Policy](#) [Products & Services](#) [Careers](#) [Inventors](#) [News & Notices](#) [eBusiness/Alerts](#) [FAQs](#) [For Kids](#)

NMTI Deadline March 31



The USPTO is seeking nominations for the 2011 National Medal of Technology and Innovation (NMTI). The medal is presented each year by the President of the United States and is this country's highest award for technological achievement.

[Read more](#)

USPTO Self Service

Information Services and Data Products:

- Select a Product or Service -

 Find us on Facebook
  Follow Us On twitter

Patents

- Patents Process**
Visit the Patents Process page
- Search**
Search patent databases
- View Fee Schedule**
Check on the current fees and information related to the patent process
- File Online**
Apply for a patent using the Electronic Filing System (EFS-Web)
- Check Status**
Check the status via the Patent Application Information Retrieval (PAIR) system

Trademarks

- Trademark Basics: Start Here**
View How-To Videos; FAQs; Basic Facts Booklet; Processing Timelines; ID Manual; TMEP
- Search Marks**
Search pending and registered marks (TESS)
- File Forms Online**
File application and other documents online (TEAS)
- Check Status**
Check the status of an application or registration (TARR)
- View and/or Order Documents**
View and download application and registration

IP Law & Policy

- National Medal of Technology and Innovation**
The deadline for this country's highest award for technological achievement is March 31
- IP Policy and Enforcement**
USPTO leads efforts to develop and strengthen both domestic and international IP protection
- Training and Education**
The Global IP Academy (GIPA) offers IP related programs around the world
- Office of the General Counsel**
General Counsel, Office of the Solicitor, Office

United States Patent and Trademark Office



Questions?



Next week

The who, what, when, where, why, and how of patents