

*So Pure*  
**You can eat it**



## Trademarks



Intellectual Property for the Rest of Us – Class 3

# Class schedule

Class	Topic
9/9	Introduction A ridiculously fast history of intellectual property in America
<b>Note: no class meeting on 9/16 in observance of Yom Kippur</b>	
9/23	Copyrights
9/30	<b>Trademarks</b>
10/7	Patents
10/14	Digital futures

Course materials are on:  
<https://queenlake.com/wise-2021/ip4us/>





[Patents](#)

**Trademarks**

[IP Policy](#)

[Learning and Resources](#)

[Find It Fast](#)



### Trademark basics

- > Do I need a U.S.-licensed attorney?
- > Trademark fee information
- > Timeline to process an application
- > Free resources in your state



### Search trademarks

- > Develop a search strategy
- > How to use the Trademark Electronic Search System (TESS)



### Apply for a trademark

- > How do I apply using the Trademark Electronic Application System (TEAS)?
- > Respond to an office action
- > Select goods & services in ID Manual



### Protect trademarks

- > Scam awareness
- > Protect your trademark rights
- > Watch out for counterfeit goods



### Maintain your registration

- > How do I renew my trademark?
- > What happens if my trademark



### Laws and rules

- > Trademark Modernization Act
- > CARES Act FAQs
- > Rule making

# United States Patent and Trademark Office

<https://uspto.gov/trademarks>



# What we'll cover

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

It depends



# 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 <sup>TM</sup>





A.W. Faber added to U.S. Register of Businesses in 1870



# 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.



# Types of marks

- ▶ Trademark
- ▶ Service marks 
- ▶ Certification marks  
- ▶ Collective marks (associations)



# 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





**Gorski's Design**



**Gymboree's Design**

IP Protection For Novelty T-Shirts: Copyright Or Trademark? [\[Link\]](#)



# What can you protect?

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





## Trademarks in the wild



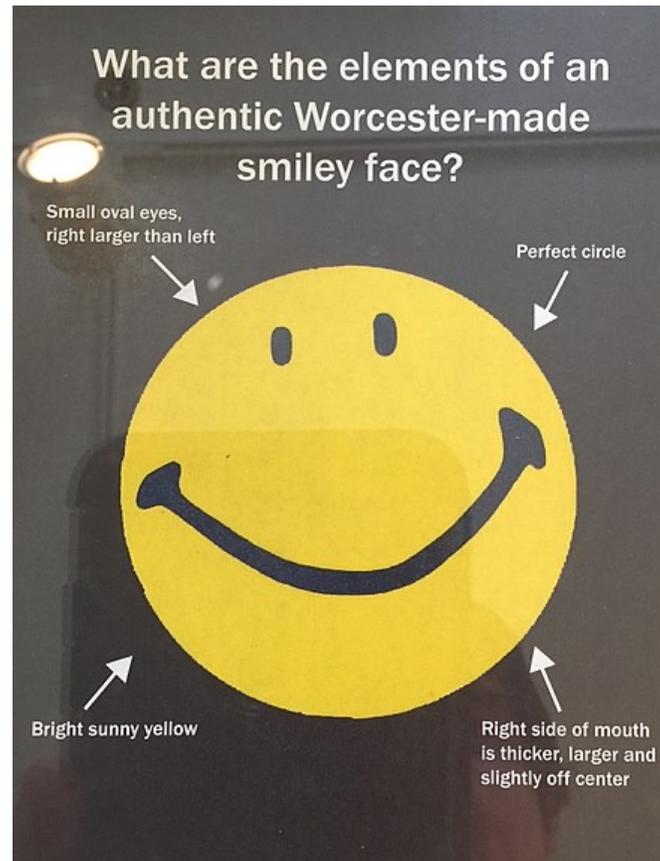


WALT DISNEY ARCHIVES

The image of Mickey Mouse first trademarked in 1928

Trademark separate from copyright





## The complicated case of the Smiley Face

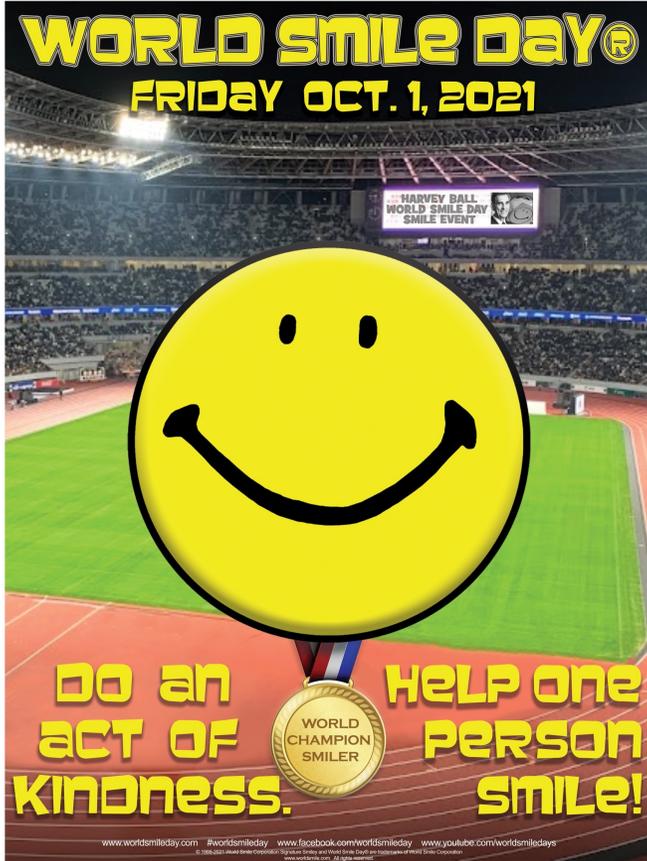




First designed in 1963

First use in commerce in 2008





World Smile Day® is on October 1



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### Features

Commercial production fonts ⓘ	5	5	5
Monotype Fonts seats ⓘ	5	5	5
Monthly web page views ⓘ	10M	10K	10K

## Licensing fonts





# Colors that are trademarked [[Link](#)]



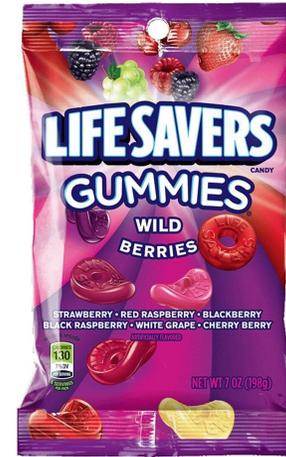
# Sounds can be trademarked [\[Link\]](#)



# Likelihood of confusion

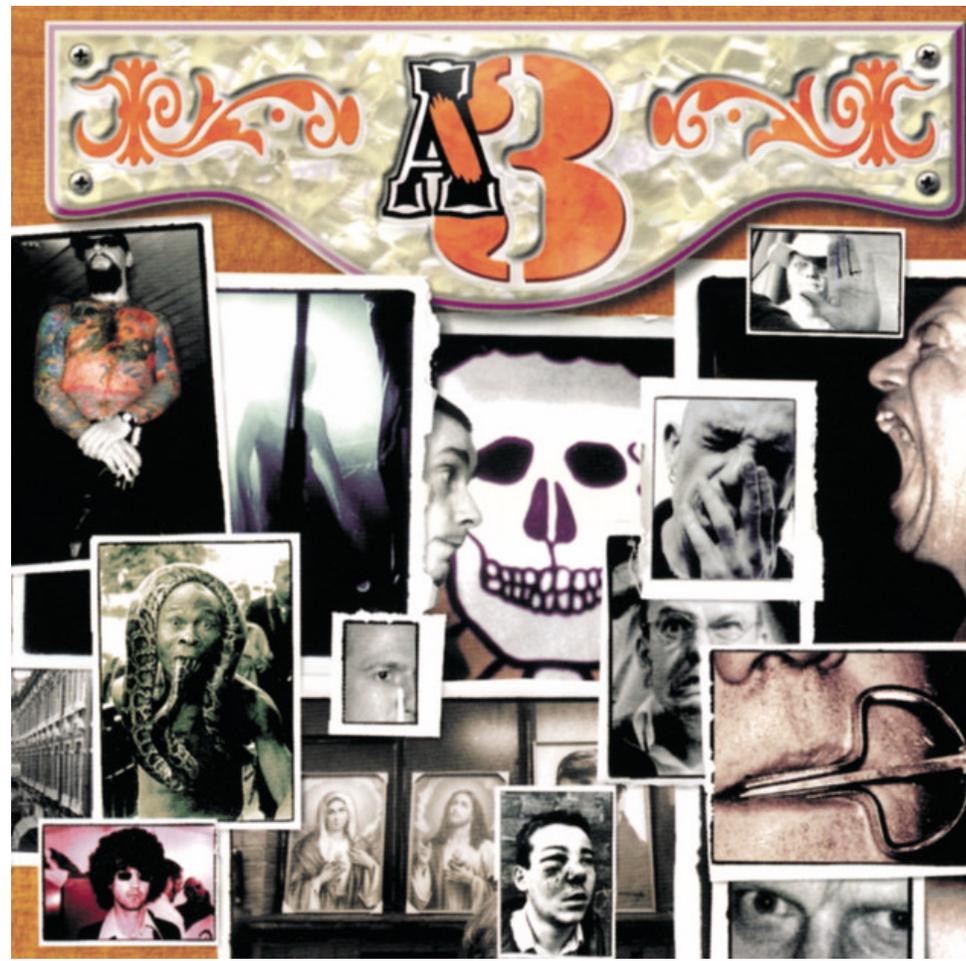
Does this mark look or sound enough like another mark that a reasonable person might be confused?





Big Candy Is Angry [\[Link\]](#)





## Trademarking a Band Name: 5 Things to Know [\[Link\]](#)



# Coke Settles With Coke-Is-It

**GUILFORD, Vt., March 13 (UPI)** — The former Frederick Koch, who legally changed his name to **Coke-Is-It**, has negotiated an agreement with the Coca-Cola Company allowing him to keep his new name, a lawyer said today.

The agreement prohibits Mr. **Coke-Is-It**, 54 years old, from using the name commercially.

Mr. **Coke-Is-It**, father of the Olympic skier **Bill Koch**, changed his name in Windham County Superior Court in November because he was irritated by people who mispronounced his name as "Kotch." But Coca-Cola objected to the use of its trademark.

The two sides reached a settlement that is expected to be filed in court later this week. It prohibits the lawyers involved from disclosing its contents.

"I can say that his name is still **Coke-Is-It**, and he will be able to use it," said John Burgess, who represents Mr. **Coke-Is-It**. "You could speculate that the agreement prohibits any commercial use of the name." Mr. Burgess said the agreement did not involve a financial settlement.

**Bill Koch** became the first American to win an Olympic medal for cross-country skiing when he won a silver medal in the 1980 Winter Olympics.



# 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
  - Litigation
  - Keeping it registered



# 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?



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](http://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](http://www.facebook.com/pages/Unicorn-Meat-The-Other-White-Meat/116348375047769) and [www.thefrisky.com/post/246-unicorn-the-other-white-meat/?TrackID=fool](http://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**<sup>®</sup> in the

Unicorn Meat is not "The Other White Meat"

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





Parody as a defense against infringement



# Trademark infringement and dilution in parodies

- ▶ Is the infringement likely to cause confusion?
- ▶ Does the parody dilute the value of the trademark and tarnish the mark?



# Parody





# 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





'Borat' star Sacha Baron Cohen sues Massachusetts cannabis dispensary over unauthorized billboard [\[Link\]](#)





College Athletes May be Paid for Name, Image, and Likeness [\[Link\]](#)





Is it Madness to Say March Madness®? [[Link](#)]



# 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



# 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 5<sup>th</sup> and 6<sup>th</sup> year after registration
    - Continues until 10<sup>th</sup> year
    - Fee: \$100
  - Renew on the 10<sup>th</sup> year and every 10 years afterwards
- ▶ State
  - Five years
  - Renew within six months for another five





DilbertCartoonist@gmail.com



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# Protecting your trademarks



# 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



# 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





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



It's not that simple

# GED



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- ▶ 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.



# Hasbro vs. Clue Computing, Inc.

The classic mystery game



Investigation and Intelligence Software –  
[clue.com](http://clue.com)



When you're painted into a corner at dinner time

Serve Swanson TV Brand Dinners

You'll be proud of their extra quality and good taste!

Expect extra good eating every time from Swanson! Tonight turn your fork to their juicy beef meat loaf, for example, and you'll find it's topped with a smoothly blended sauce of rich, red tomatoes. What more could you ask for than a meat course like this... with plump garden peas and fluffy whipped potatoes? It's good dining, and good timing, when you serve any of the nine delicious Swanson TV Dinners. Enjoy your special favorites soon.

**FROZEN SWANSON TV DINNERS**

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Only Swanson comes so close to your own home cooking

\*TV and "TV Dinner" are registered trademarks.

Posted in r/vintageads



Genericide [\[Link\]](#)

TV was a registered trademark until abandoned in 1979





What happens if you don't protect your trademark?

Dilution

Genericide - your mark becomes a generic term



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Another casualty of the Great War

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



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Questions?





Next week

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

