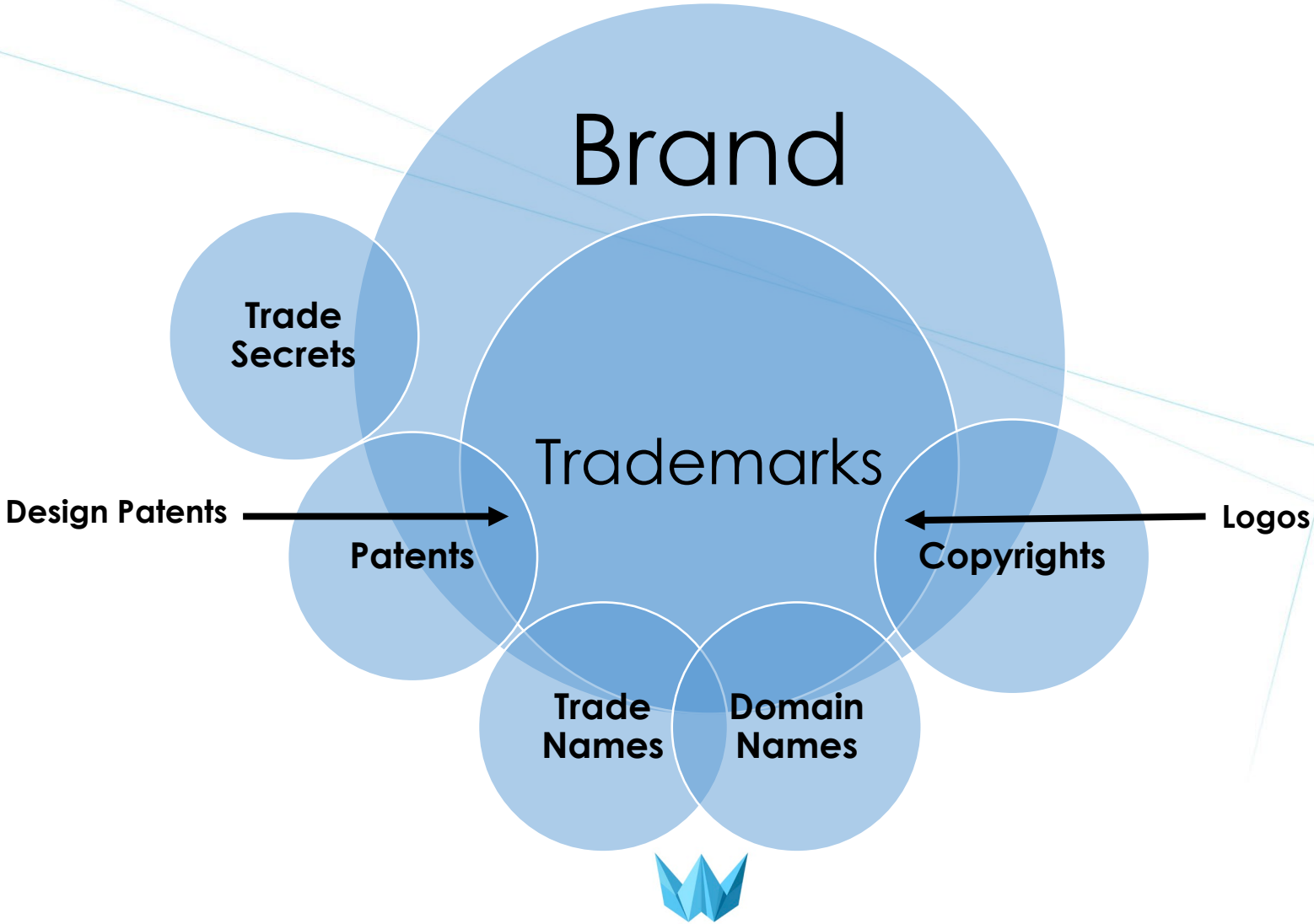
Smart Branding Starts Early

Considerations to make before the lawyers show up

August 2020

WINTERFELDT
IP GROUP

The Relationship of Marks to Brands



What Can Be a Trademark?

Int. Cls.: 38 and 42

Prior U.S. Cls.: 100, 101 and 104

Reg. No. 2,806,075

United States Patent and Trademark Office

Registered Jan. 20, 2004

SERVICE MARK
PRINCIPAL REGISTER

GOOGLE

What Can Be a Trademark?

United States of America

United States Patent and Trademark Office

Google

What Can Be a Trademark?

United States of America

United States Patent and Trademark Office

Google

What Can Be a Trademark?

United States Patent Office

640,606
Registered Jan. 29, 1957

PRINCIPAL REGISTER
Trademark

Ser. No. 4,328, filed Mar. 12, 1956

IBM

What Can Be a Trademark?

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,875,307
Registered Jan. 24, 1995

TRADEMARK
PRINCIPAL REGISTER

JUST DO IT.

What Can Be a Trademark?

What Can Be a Trademark?

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent Office

Reg. No. 1,084,299

Registered Jan. 31, 1978

SERVICE MARK

Principal Register

What Can Be a Trademark?

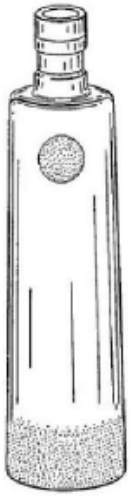
United States of America

United States Patent and Trademark Office

What Can Be a Trademark?

United States of America

United States Patent and Trademark Office



What Can Be a Trademark?

Int. Cl.: 30

Prior U.S. Cl.: 46

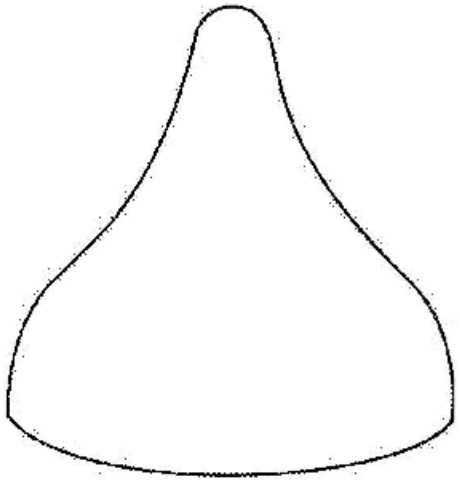
Reg. No. 3,028,381

United States Patent and Trademark Office

Registered Dec. 13, 2005

TRADEMARK

PRINCIPAL REGISTER



What Can Be a Trademark?

Int. Cl.: 12

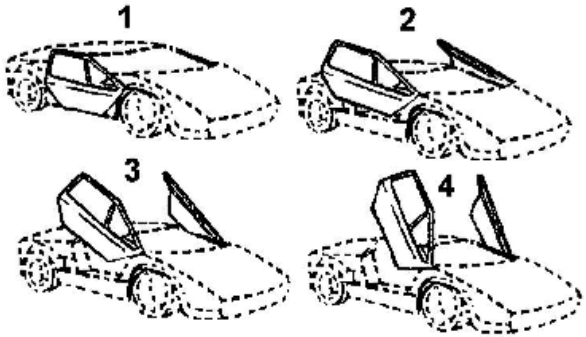
Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

Reg. No. 2,793,439

United States Patent and Trademark Office

Registered Dec. 16, 2003

TRADEMARK
PRINCIPAL REGISTER



What Can Be a Trademark?

United States Patent Office

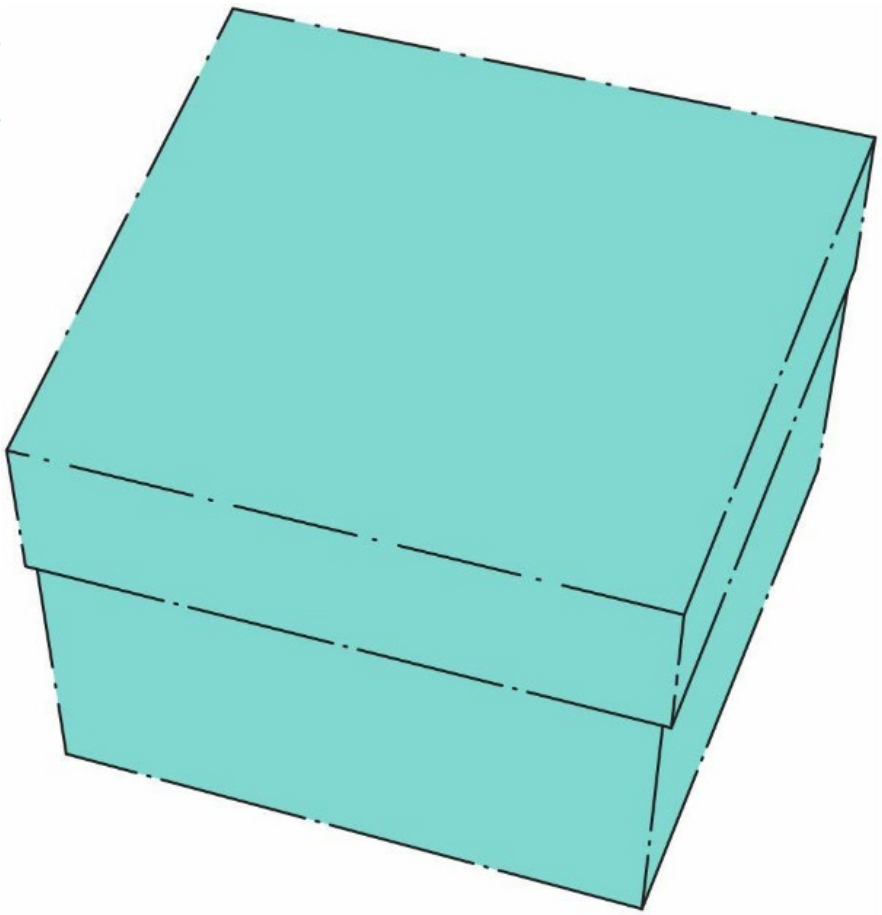
916,522
Registered July 13, 1971

PRINCIPAL REGISTER
Service Mark

Ser. No. 349,496, filed Jan. 23, 1970

THE MARK COMPRISES THE MUSICAL NOTES G, E, C PLAYED ON CHIMES

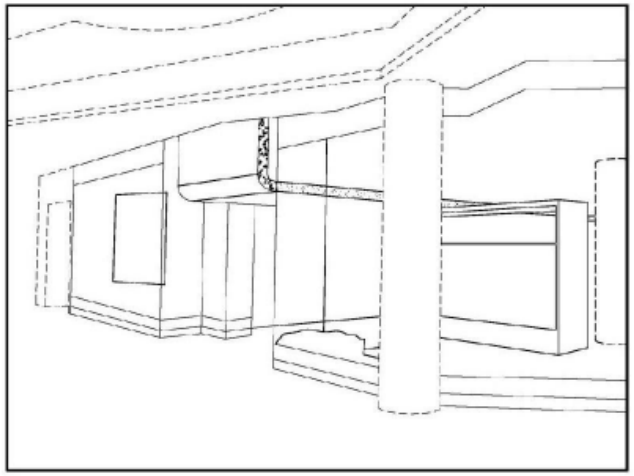
What Can Be a Trademark?



What Can Be a Trademark?

United States of America

United States Patent and Trademark Office



Reg. No. 4,741,062

CELLCO PARTNERSHIP (NEW JERSEY PARTNERSHIP), DBA VERIZON WIRELESS, VC52N058

What Can Be a Trademark?

Int. Cl.: 42

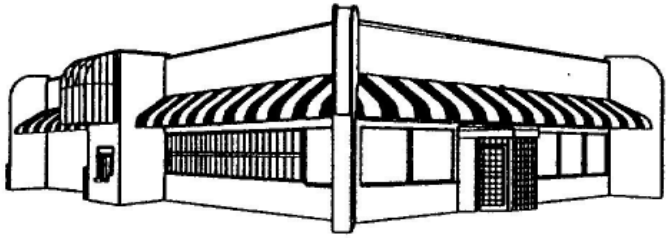
Prior U.S. Cls.: 100 and 101

Reg. No. 2,294,116

United States Patent and Trademark Office

Registered Nov. 23, 1999

SERVICE MARK
PRINCIPAL REGISTER



STEAK N SHAKE, INC. (INDIANA CORPORATION)
36 SOUTH PENNSYLVANIA STREET, SUITE 500
INDIANAPOLIS, IN 46204

THE MARK IS LINED FOR THE COLOR RED.

THE MARK CONSISTS OF A THREE-DIMENSIONAL CONFIGURATION OF THE EXTERIOR OF A BUILDING.

SEC. 2(F).

What Can Be a Trademark?

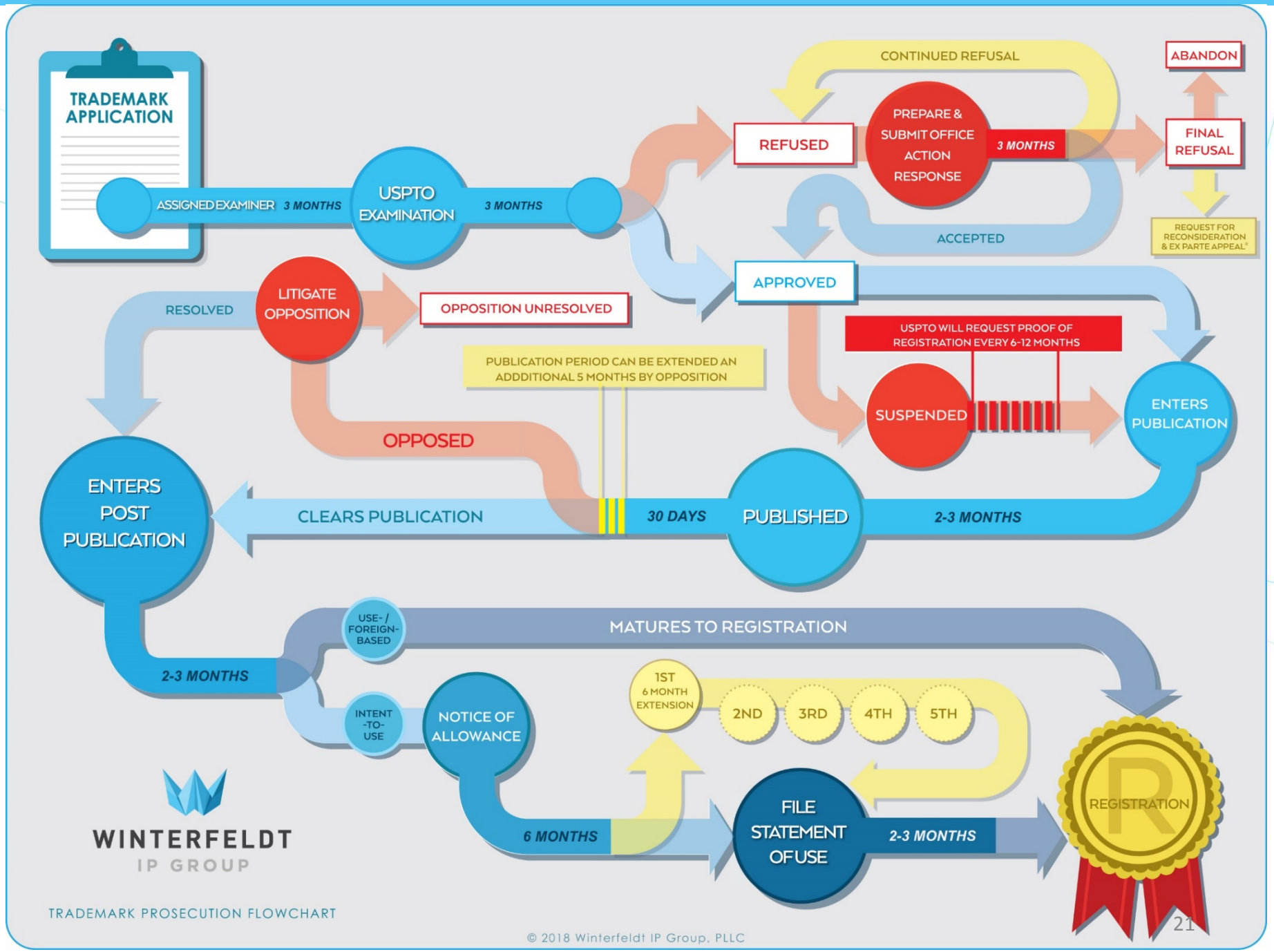
What Can Be a Trademark?

United States of America

United States Patent and Trademark Office

NON-VISUAL PLAY-DOH SCENT
MARK

What Can Be a Trademark?


TRADEMARK APPLICATION
ASSIGNED EXAMINER
3 MONTHS
USPTO EXAMINATION
3 MONTHS
REFUSED
PREPARE & SUBMIT OFFICE ACTION RESPONSE
3 MONTHS
CONTINUED REFUSAL
ABANDON
FINAL REFUSAL
REQUEST FOR RECONSIDERATION & EX PARTE APPEAL
ACCEPTED
APPROVED
RESOLVED
LITIGATE OPPOSITION
OPPOSITION UNRESOLVED
PUBLICATION PERIOD CAN BE EXTENDED AN ADDDITIONAL 5 MONTHS BY OPPOSITION
USPTO WILL REQUEST PROOF OF REGISTRATION EVERY 6-12 MONTHS
SUSPENDED
ENTERS PUBLICATION
OPPOSED
ENTERS POST PUBLICATION
CLEARS PUBLICATION
30 DAYS
PUBLISHED
2-3 MONTHS
MATURES TO REGISTRATION
USE- / FOREIGN-BASED
2-3 MONTHS
INTENT -TO- USE
NOTICE OF ALLOWANCE
1ST 6 MONTH EXTENSION
2ND
3RD
4TH
5TH
6 MONTHS
FILE STATEMENT OF USE
2-3 MONTHS
REGISTRATION
WINTERFELDT IP GROUP
TRADEMARK PROSECUTION FLOWCHART
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How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Have Placed **Goodwill**

Because it Represents a Standard of **Quality**

Due to its **Use in Commerce**

How Can Something Become a Trademark?

Indication of **Type**

In Which Consumers Have Placed **Goodwill**

Because it Represents a Standard of **Quality**

Due to its **Use in Commerce**

Levels of Protection

Generic

- CAR
- HIGH YIELD MUTUAL FUND
- THE WEATHER CHANNEL

Descriptive

- INTERNATIONAL BUSINESS MACHINES
- GENERAL ELECTRIC

Suggestive

- COPPERTONE
- GREYHOUND
- UNDER ARMOUR

More Distinctive

- APPLE
- BLACKBERRY
- GOOGLE
- EXXON
- EQUIFAX

Levels of Protection

It is important to **use distinctive terms** as trademarks, because:

- "Merely descriptive" designations **cannot receive the full protection** of the "principal" trademark register
- If they are on the principal register, "merely descriptive" registrations **can be cancelled**
- "Generic" designations **cannot be registered** under any circumstances
- A prior user **cannot enforce trademark rights** to prevent third parties from using descriptive or generic terms to accurately describe their goods or services

Trademark clearance can help identify descriptive or generic elements

Levels of Protection

Descriptive marks can **become distinctive**

- Descriptive marks can be relatively easy to register on the "**supplemental trademark register**" and exclude similar registrations
- Marks may "acquire distinctiveness" through **continuous and exclusive use** in commerce in addition to any or all of the following:
  - Time (more than five years)
  - Investment (marketing and promotion to build goodwill)
  - Supplemental registration

Legal can provide guidance on planning these kinds of investments

Levels of Protection

Otherwise distinctive marks can **become descriptive or generic**

- DRY ICE
- FLIP PHONE
- HEROIN
- LANOLIN
- LAUNDROMAT
- LINEOLEUM
- TRAMPOLINE
- APP
- APP STORE
- TOUCHTONE
- ZIPPER

How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Have Placed **Goodwill**

Because it Represents a Standard of **Quality**

Due to its **Use in Commerce**

How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Place **No Goodwill**

Because it Represents a Standard of **Quality**

Due to its **Use in Commerce**

Levels of Protection

Dilute
- ACME
- RAY'S (for Pizza)
- JOE'S (for Diners)

Weak
- ???

Strong
- CHEVRON
- BMW
- VISA
- BOSS
- ORACLE

Famous
- COCA-COLA
- MICROSOFT
- WALMART
- ROLEX

Levels of Protection

Exercise of exclusive rights in a trademark is one of the strongest ways to maintain those rights

- Enforcement **must be consistent** or it won't be successful
  - Use and registration of marks containing a feature or element similar to your mark can be used to prevent subsequent enforcement against third parties who are also seeking to use or register that element
- "Dilute" elements of trademarks **cannot be enforced** against junior users
- Failure to enforce can sometimes be deemed as **evidence of abandonment** of a mark

Key Point on Focus Groups:

- Consumers' goodwill in a mark reflects consumers' positive associations with a designation
- Consumers can hold goodwill in designations that cannot function as a trademark
- Consumers often have strong positive associations with designations that:
  - Describe desirable characteristics (and are "**descriptive**")
  - Identify the goods or services they seek to purchase (and are "**generic**")
  - Are familiar when used with the goods and services (and are "**dilute**" or "**infringing**")
- Submit proposed marks to legal **FIRST** to clear these issues

Key Point on Focus Groups:

- The cost to earn goodwill through advertising, marketing and use of a trademark is often less than the cost of:
  - Overcoming USPTO refusals to register a designation
  - Risk that a third party might coopt a designation after a significant investment
  - Disputes with third parties over a designation

How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Have Placed **Goodwill**

Because it Represents a Standard of **Quality**

Due to its **Use in Commerce**

How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Have Placed **Goodwill**

With no relationship to **Quality**

Due to its **Use in Commerce**

Licensing Relationships with Third Parties

- Trademarks don't need to **literally** indicate source
  - **White Label Products**
  - **Licensing Relationships**
  - **Co-Branding Relationships**
- If you do not maintain **quality control**, however, its trademarks can be deemed abandoned.

Licensing Relationships with Third Parties

- Quality control has several important components:
  - How the trademarks are used
  - Qualities and characteristics of the goods and services
  - Means of monitoring compliance
  - Enforcement mechanisms

Licensing Relationships with Third Parties

- What happens if you don't exercise quality control?
  - Poor quality products and services **damage goodwill**
  - Inconsistent and non-trademark use by licensees can **impair the strength and distinctiveness** of your trademarks
  - Failure to have quality control can make your trademark registrations **vulnerable to challenge** by third parties for "naked licensing"
  - Defective products from your licensees can subject trademark owners to **liability** under the "apparent manufacturer" or "apparent agent" doctrine

How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Have Placed **Goodwill**

Because it Represents a Standard of **Quality**

Due to its **Use in Commerce**

How Can Something Become a Trademark?

Indication of **Source**

In Which Consumers Have Placed **Goodwill**

Because it Represents a Standard of **Quality**

But is **not in Use**

Proper Use of Trademarks

The universally recognized "ACID" test for proper use is:

- **A – Adjective** – don't use as a noun or verb.
- **C – Consistent and Conspicuous**- use it the same way every time; don't rephrase it.
- **I – Identification or status** – use the "TM" or "®" symbol, whichever is appropriate.
- **D – Distinctive and Distinguished**-- needs to stand-out, be prominent, in an attention-getting manner. Not lost or embedded in text or a voice over.

How Are Trademarks Abandoned?

- Trademarks are abandoned in the United States when:
  - A trademark owner ceases use as a trademark **AND**
  - There is no intention to resume use
- Trademark owners must prove that they are using their trademarks:
  - To the USPTO when registering their mark (usually)
  - To the USPTO during the sixth year of registration
  - To the USPTO during the tenth year of registration and every ten years thereafter
  - Sometimes, to foreign trademark offices
  - To a court or tribunal, in the event of a dispute

How Are Trademarks Abandoned?

- **Ten percent of all trademark registrations will be audited** by the United States Patent and Trademark Office if:
  - They contain either four categories of goods and services in a single class or at least two categories of goods and services in at least two classes; and
  - The owner submits a mandatory declaration (required during the sixth and every ten years from registration)
- If audited, the registrant must deliver proof of use with as many as three categories of goods and services chosen by the Office in each class
- **Failure to prove use as to these categories will result in cancellation** as to any and all categories of goods and services in the registration for which use cannot be proven
- It is important to **collect and maintain specimens** of use for all categories of goods and services.

Key Takeaways

- Identify the brand elements you want exclusive control of before using them.
- Consider whether they are protectable or *can be* protectable.
- Exercise consistent control over how those elements are used.
- Use those elements continuously and consistently.

Thank You

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