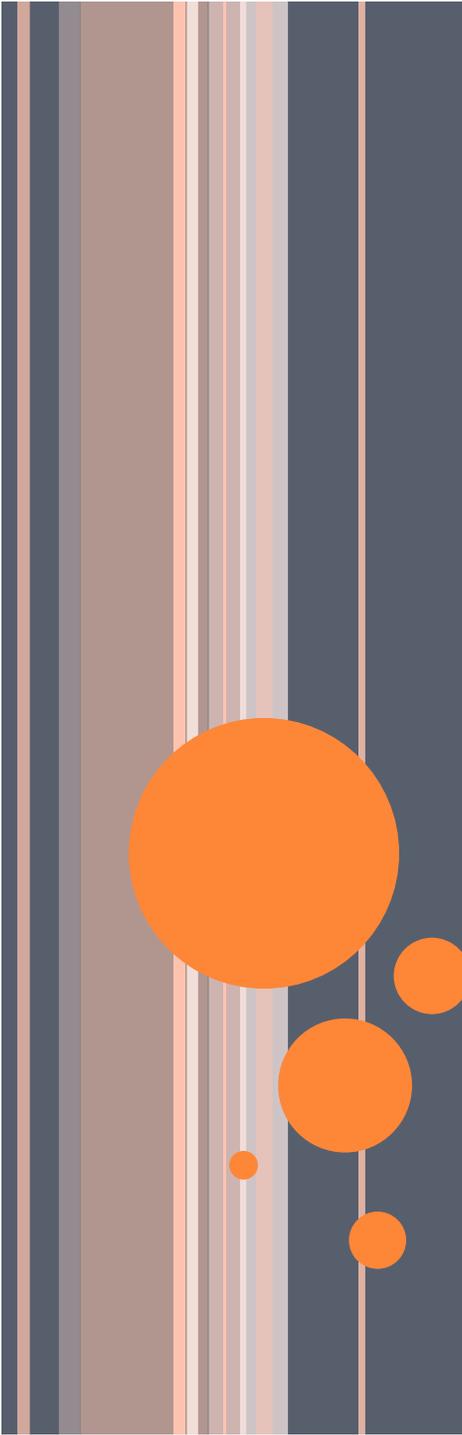# TRADEMARKS
THE BASICS OF REGISTRATION

How to identify, apply for, and protect you client's trademarks.

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TODAY'S PRESENTATION COVERS 3 MAIN POINTS

1. Trademark Basics.
2. Trademark Clearance.
3. Trademark Registration.

TRADEMARK BASICS

WHAT EXACTLY IS A TRADEMARK?

TRADEMARKS

A source indicator for a particular good or service.

- Trademarks, copyrights, and patents are three distinct types of IP.
- A trademark can be thought of with a simple formula:
  - An "Identifier" + Goods or Services = Source.

TRADEMARKS

- The "identifier" is typically what we think of when we say "brand." It can be….
  - A word or words
  - Image
  - Sound
  - Smell
  - Product Packaging
  - Product Configuration
  - Color
  - Etc.?

JUST DO IT.

The "Roar"

WHAT DOES THAT MEAN?

- Examples….
  - **Word Mark:** The word "Kindle" + e-reader = Amazon.
  - **Color Mark:** The cherry red lacquer finish + shoes = Louboutin.
  - **Sound Mark:** The "G-E-C" musical sequence + television = NBC.

An "identifier" isn't really a trademark until it's associated with some kind of good or service.

This association allows consumers to identify the source of the goods or services.

How do you identify, clear, and register your client's marks?

TRADEMARK SELECTION

- **Strong Marks versus Weak Marks**
  - Arbitrary/Fanciful Marks (Reebok, Apple)
  - Suggestive Marks (Habitat, Greyhound)
  - Descriptive Marks (FashionKnit, World Book)
  - Generic Marks (Shoes, App)

- **Which Types Are Best?**
  - Both a legal and commercial consideration. **Suggestive marks** are often the best of both worlds!

CLEARANCE

- **Legal versus Business Considerations**
  - Legal:
    - Likelihood of Confusion
    - Realm of Expansion
  - Business
    - Big Brand Owners
    - Trademark Bullies

WHERE DO WE START?

HOW DO I START?

Get the parameters

- What's the mark?
- What are the goods and services?
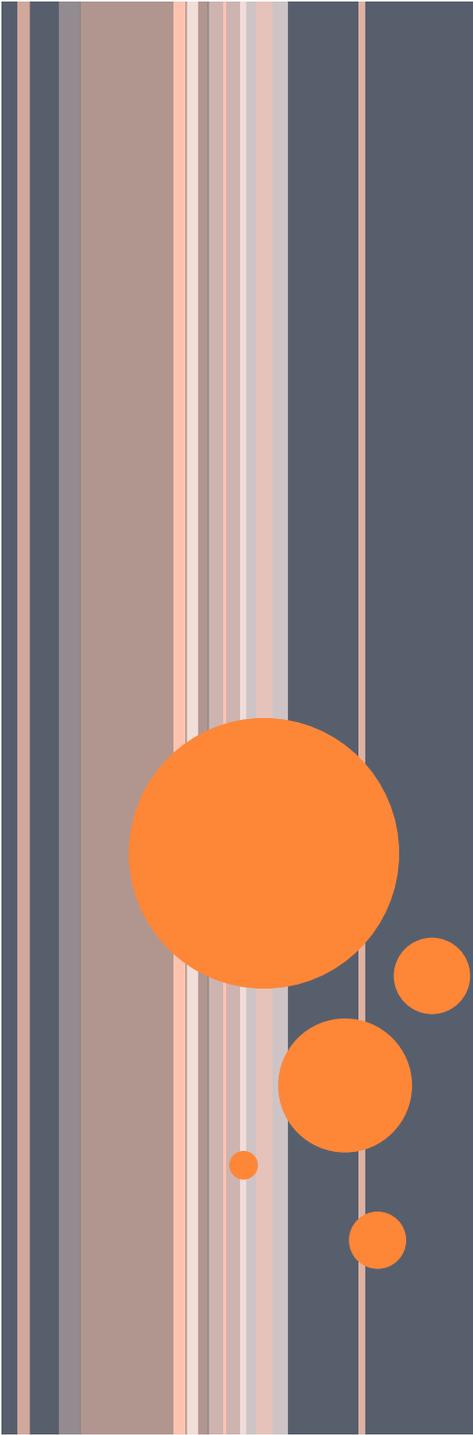
Review the results

- Look beyond exact matches.
- Consider synonyms.
- Remember it's a sight, sound, and meaning analysis.
- Think about the likely areas of expansion.

IS THAT ALL THERE IS TO IT?

- No!
- Common law trademarks can have priority over registered marks.
- State registrations can also be problematic.
- Also consider international filings.

ONTO REGISTRATION!

If your client's mark is clear after the clearance search, you can move onto registration.

WHY SHOULD I REGISTER?

- **Presumption of Validity.**
- **Nationwide Exclusivity.**
- **Easy Online Enforcement.**
- **Customs Registration.**

REGISTRATION

- **First to Use and First to File**
  - What are your rights at home and abroad?
- **State/Federal/International**
  - *State Registrations*: Only provide registration on a per state basis. May not be used in many enforcement situations.
  - *Federal Registrations*: Available to brand owners with multi-state use of their marks.
  - *Int'l Registrations*: Most jurisdictions require registration to enforce your mark.

WHAT'S IN THE APPLICATION?

- **Trademark**
- **Identification of Goods/Services**
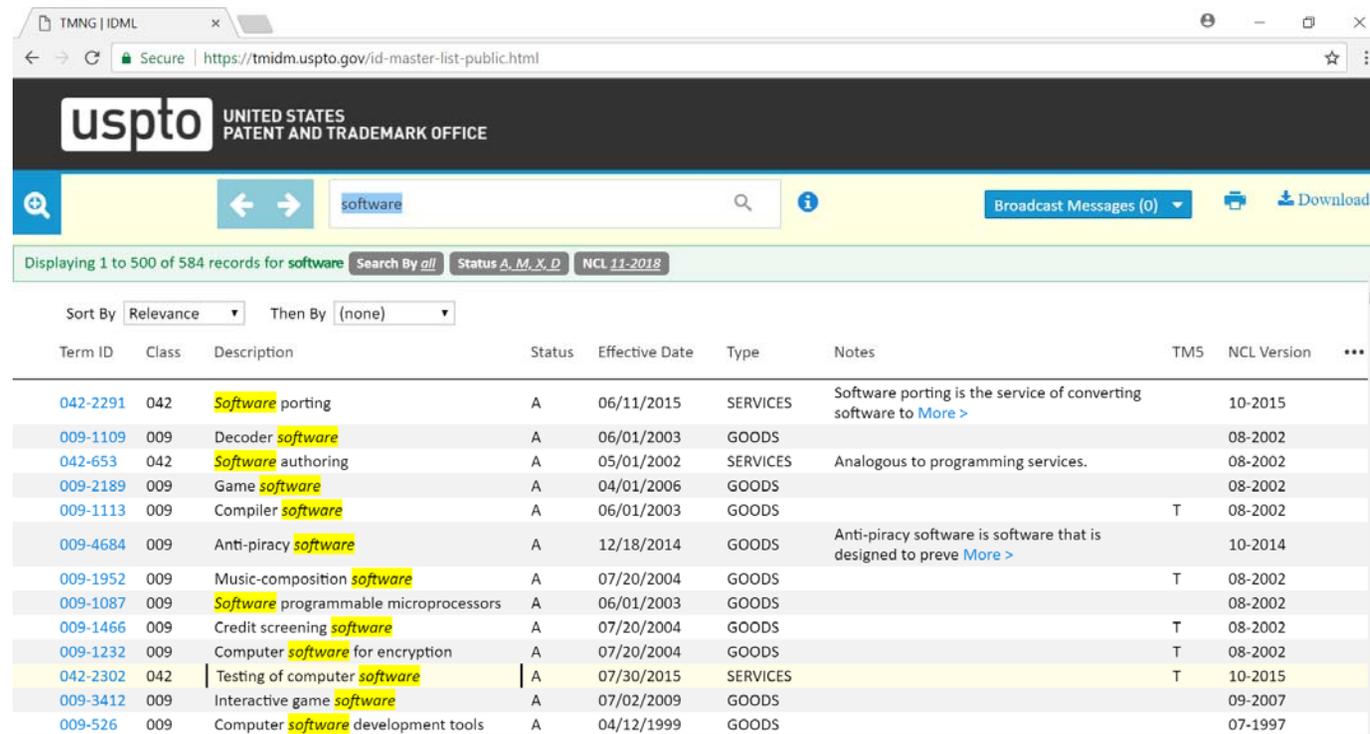- **Filing Basis**
- **Applicant Information**

TRADEMARK

- Is the mark a standard character trademark, design mark, or a combination?
- Is it a sound?
- 3-D object?
- Color

IDENTIFICATION OF GOODS/SERVICES

- International Classes
- Goods/Services

WHAT'S THE FILING BASIS?

- 1a (in use) – specimen!!!
- 1b (intent-to-use)
- 44d/e (foreign filing)
- 66a (international application for registration)

APPLICANT INFO

- Name of entity
- Entity Type
- State/Country of Incorporation
- Address
- Phone/email/website NOT required

- You'll also need correspondent/attny info, but you can supply that without feedback from client.

FILED! NOW WHAT?

You wait. There's no racing at the USPTO. It will be three months until your application is reviewed!

THE END?

- Review by the USPTO; issuance of registration.
- Different process for ITU applications.
- First renewal due in 5 years, then every 10 years after the registration date.

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