

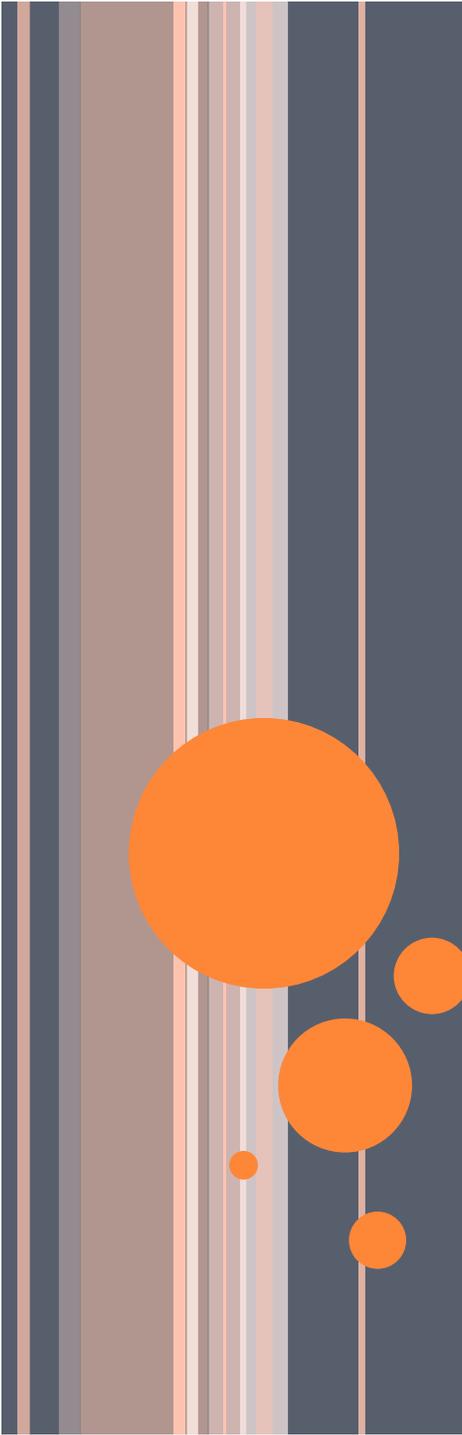


# TRADEMARKS

## THE BASICS OF REGISTRATION

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

Ashley K. Long  
Carney Badley Spellman, PS



# TODAY'S PRESENTATION COVERS 3 MAIN POINTS

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



# TRADEMARK BASICS

WHAT EXACTLY IS A TRADEMARK?



# TRADEMARKS

- 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.

**A source indicator for a particular good or service.**



# 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.?

**What’s the  
“identifier”  
really  
mean?**





**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.





## TRADEMARK CLEARANCE

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?

United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Are you filing electronically through TEAS?

**TEAS**  
file online

## Trademarks > Trademark Electronic Search System (TESS)

Welcome to the **Trademark Electronic Search System (TESS)**. This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to a **likelihood of confusion** refusal.

**WARNING:** Before conducting your search, you must understand the following: (1) what the database includes; (2) how to construct a complete search; and (3) how to interpret the search results. Click **TESS TIPS** for detailed information on these and other important search topics.

If mark images do not appear when viewing search results, clear the cache in the Internet browser. If you need detailed instructions for clearing the cache, contact [tess@uspto.gov](mailto:tess@uspto.gov). Thank you.

[HELP](#) [News!](#)

### Select A Search Option

- ▶ Basic Word Mark Search (New User)**  
This option cannot be used to search design marks.
- ▶ Word and/or Design Mark Search (Structured)**  
This option is used to search word and/or design marks. **NOTE:** You must first use the [Design Search Code Manual](#) to look up the relevant Design Codes.
- ▶ Word and/or Design Mark Search (Free Form)**  
This option allows you to construct word and/or design searches using Boolean logic and multiple search fields. **NOTE:** You must first use the [Design Search Code Manual](#) to look up the relevant Design Codes.



# HOW DO I START?

## Get the parameters

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

## Review the results

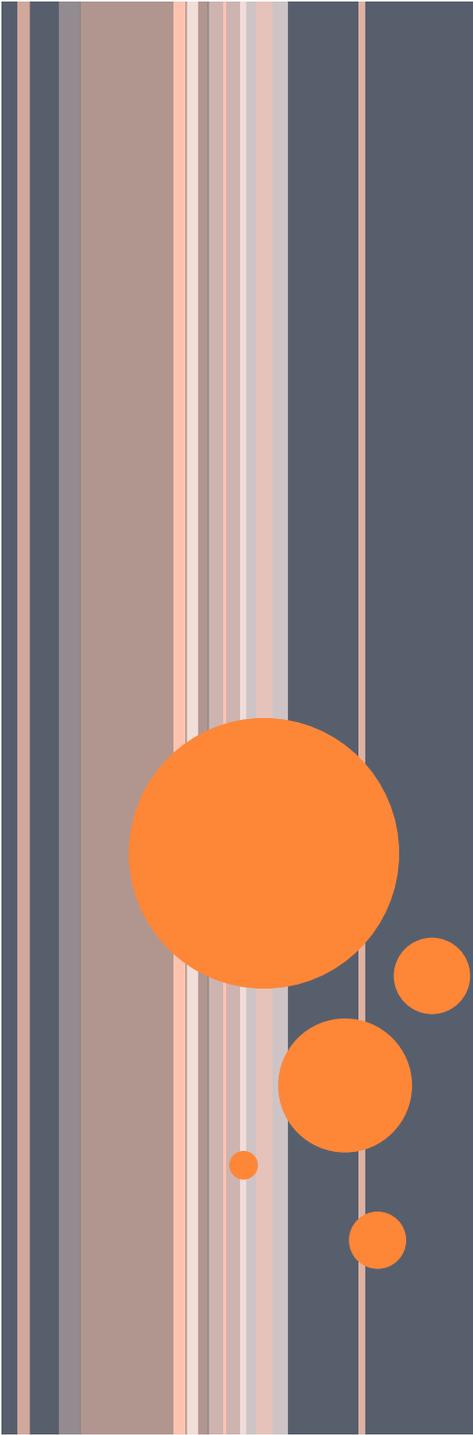
- Look beyond exact matches.
- Consider synonyms.
- Remember it's a sight, sound, and meaning analysis.
- Think about the likely areas of expansion.



## 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**



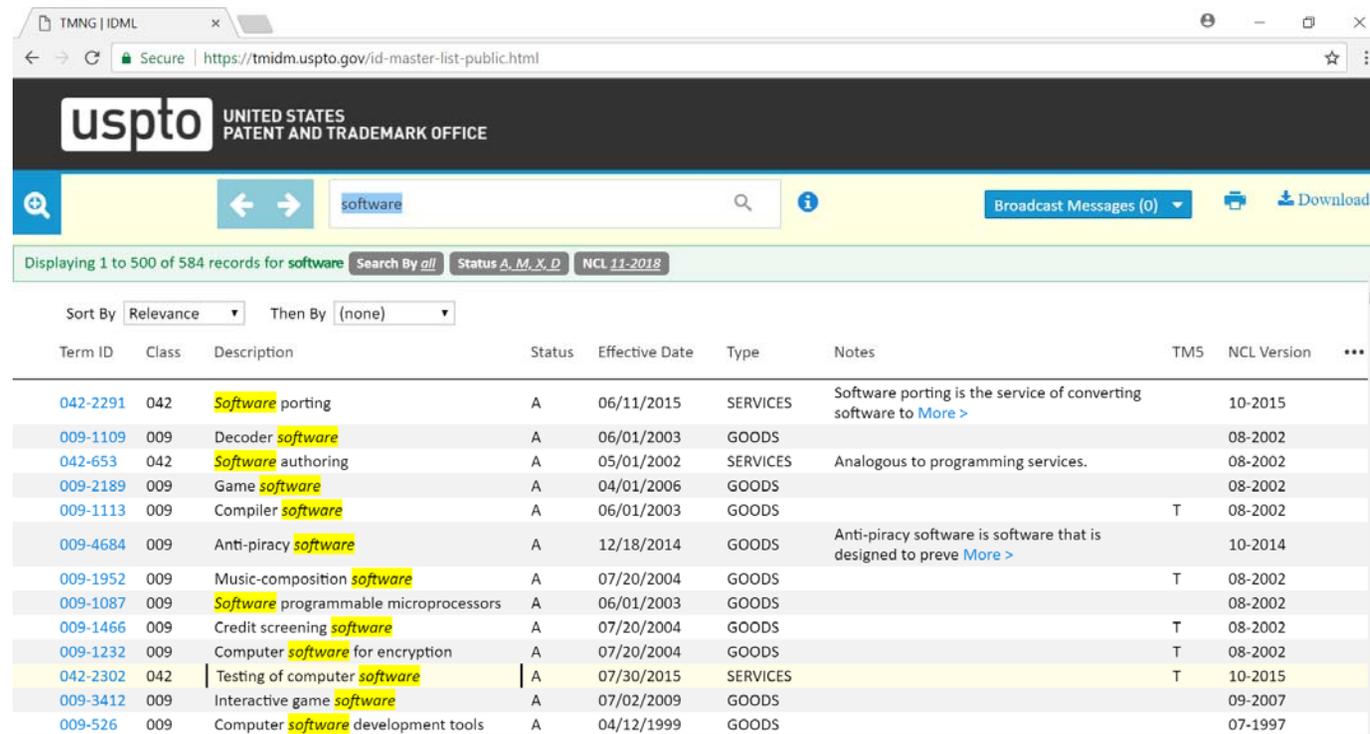
# TRADEMARK

- 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



The screenshot shows the USPTO IDML search results for the term 'software'. The search results are displayed in a table with columns for Term ID, Class, Description, Status, Effective Date, Type, Notes, TM5, and NCL Version. The results are sorted by Relevance. The table contains 15 rows of data, with the 10th row highlighted in yellow.

Term ID	Class	Description	Status	Effective Date	Type	Notes	TM5	NCL Version	...
042-2291	042	Software porting	A	06/11/2015	SERVICES	Software porting is the service of converting software to <a href="#">More &gt;</a>		10-2015	
009-1109	009	Decoder software	A	06/01/2003	GOODS			08-2002	
042-653	042	Software authoring	A	05/01/2002	SERVICES	Analogous to programming services.		08-2002	
009-2189	009	Game software	A	04/01/2006	GOODS			08-2002	
009-1113	009	Compiler software	A	06/01/2003	GOODS		T	08-2002	
009-4684	009	Anti-piracy software	A	12/18/2014	GOODS	Anti-piracy software is software that is designed to prevent <a href="#">More &gt;</a>		10-2014	
009-1952	009	Music-composition software	A	07/20/2004	GOODS		T	08-2002	
009-1087	009	Software programmable microprocessors	A	06/01/2003	GOODS			08-2002	
009-1466	009	Credit screening software	A	07/20/2004	GOODS		T	08-2002	
009-1232	009	Computer software for encryption	A	07/20/2004	GOODS		T	08-2002	
042-2302	042	Testing of computer software	A	07/30/2015	SERVICES		T	10-2015	
009-3412	009	Interactive game software	A	07/02/2009	GOODS			09-2007	
009-526	009	Computer software development tools	A	04/12/1999	GOODS			07-1997	



# 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.





## CONTACT INFO

Ashley Long  
[long@carneylaw.com](mailto:long@carneylaw.com)  
206-622-8020

