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Trademarks 101

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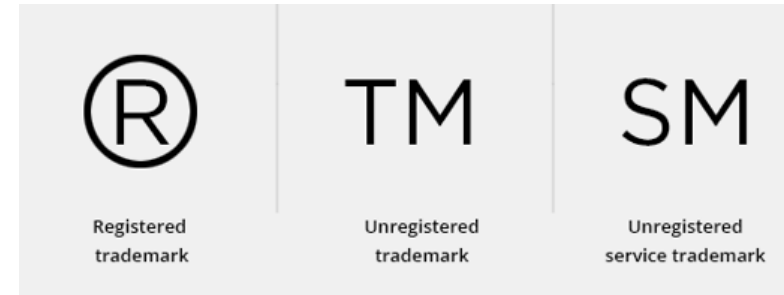
What is a Trademark? ®

- ▶ Any word, name, symbol, or device (or combination of these items) that identifies the source of goods or services used in commerce, and distinguishes them from others to uphold business quality and goodwill
 - ▶ Trademarks related to services may also be called “Service Marks”, though “trademarks” generally cover identifiers for both goods and services
- ▶ A trademark can be a word, logo, slogan, tagline, package design, or anything that allows people to recognize a source, good, or service
 - ▶ GOOGLE = search engine
 - ▶ APPLE Design = computers, phones, laptops
 - ▶ WE HAVE THE MEATS = tagline for Arby’s sandwiches
 - ▶ MCDONALD’S = fast food
- ▶ Sounds, smells, color combinations, or shapes can also function as trademarks
 - ▶ NBC Jingle (G-E-C) = NBC TV Network
 - ▶ Brown paper = service mark for package delivery services like UPS
 - ▶ Hasbro Playdoh smell



Trademark Protection

- ▶ Legal protection at federal, state, and common law levels
 - ▶ Lanham Act - Federal Trademark Statute
 - ▶ Registered with the United States Patent and Trademark Office (“USPTO”) with use required
 - ▶ Recognized by the ® symbol after registration is achieved with protection across the country for 10 years
 - ▶ Registrations can be renewed in perpetuity
 - ▶ State Trademark Laws
 - ▶ Registered at the state level, but does not gain federal registration unless registered with the USPTO
 - ▶ Most states require the mark to actually be used in commerce before the mark can be registered under state law, i.e., no intent-to-use application
 - ▶ Common Law Trademarks
 - ▶ Cannot use ® designation since they are not federally registered marks
 - ▶ Often only enforceable in a specific geographic region where the trademark owner is doing business and people will recognize the mark in association with those goods/services



Trademark Distinctiveness

▶ Four Categories of Distinctiveness

- ▶ 1. Fanciful- made up words that have no other meaning other than as a brand name. This is the strongest level of protection for trademarks

- ▶ XEROX = copiers 



- ▶ KODAK= cameras

- ▶ 2. Arbitrary- marks that include words that have a common meaning, but do not normally mean the goods or services for which they are used as brand names

- ▶ APPLE = computers



- ▶ CAMEL = cigarettes



- ▶ 3. Suggestive- marks that suggest some trait or benefit of the goods or services, but do not describe the goods or services themselves

- ▶ GREYHOUND = buses



- ▶ MICROSOFT = software

- ▶ 4. Descriptive- marks that describe the goods, services, or other aspects of the mark. This is the lowest level of protection for trademarks because marks must have “secondary meaning” or “acquired distinctiveness” in order to be registered

Trademark Distinctiveness (cont.)

▶ Descriptive Marks

- ▶ Generic descriptions of a type of good or service cannot be a trademark on its own because these words do not identify any particular source

▶ BUT THERE IS HOPE FOR DESCRIPTIVE MARKS!

- ▶ If a term is descriptive, but the public at large recognizes these terms as trademarks, the mark has “acquired distinctiveness” or “secondary meaning”

- ▶ If a descriptive word is used as a trademark for so long, such as in advertising campaigns, that it becomes a source identifier in addition to a description of goods or services, a descriptive mark has achieved secondary meaning and can be registered

- ▶ GOLD MEDAL = flour
- ▶ BEST BUY = electronic store services
- ▶ SHARP = televisions

- ▶ Surnames and geographically descriptive words or phrases can also acquire distinctiveness to overcome merely descriptive status

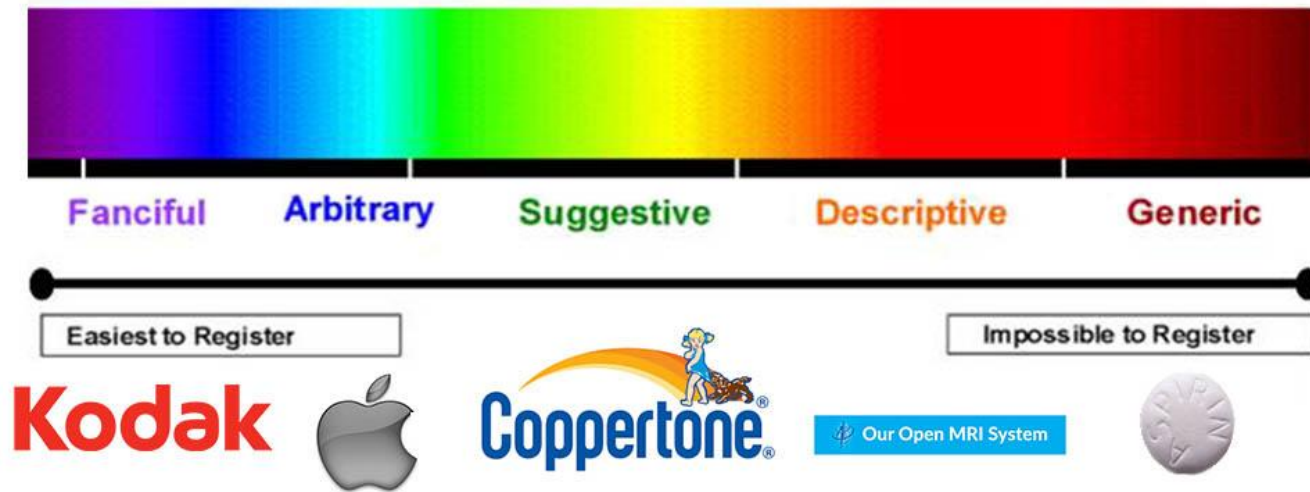
- ▶ FORD = cars
- ▶ CANADIAN = beer



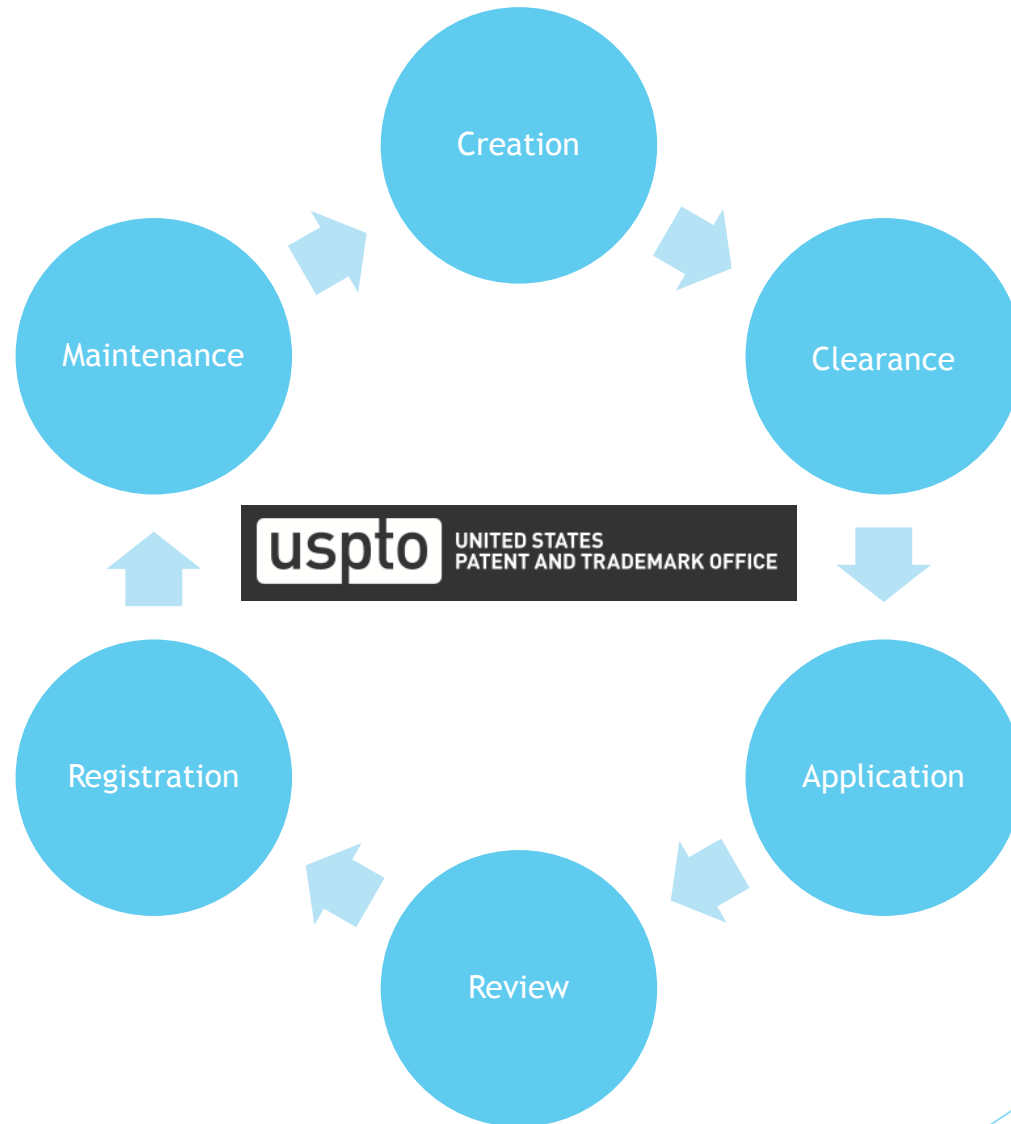
Generic “Trademarks”

- ▶ Trademarks become generic when the mark themselves become the generic name(s) for the goods or services for which the mark is (or was) used
 - ▶ CELLOPHANE
 - ▶ ESCALATOR
 - ▶ LINOLEUM
 - ▶ ASPIRIN
- ▶ Generic Trademarks Leads to Genericide: **AVOID THIS**
 - ▶ International Trademark Association (INTA): “Genericide, when a protectable trademark becomes generic and cannot function as a trademark.”
- ▶ INTA How to Avoid: Run marketing campaigns, educate consumers, and ensure the trademark remains a source identifier rather than leave the trademark to become a generic term
 - ▶ XEROX→ “You can’t Xerox a Xerox on a Xerox. But we don’t mind at all if you copy a copy on a XEROX®”
 - ▶ Chrysler and JEEP→ “They invented ‘SUV’ because they can’t call them JEEP®”
 - ▶ Johnson & Johnson and BAND-AID→ “I am stuck on Band-Aids® brand cause Band-Aid’s stuck on me”

SPECTRUM OF INHERENT DISTINCTIVENESS



The Trademark Life Cycle



Creation

- ▶ The first stage is choosing a name, symbol, or other identifier to become associated with your goods or services for use in commerce
 - ▶ Remember the 4 different types of trademarks (fanciful, arbitrary, suggestive, descriptive), avoiding descriptive, misleading, or generic terms in favor of distinctive traits to increase chances of registerability
 - ▶ Think about how the trademark will or can be used as a domain name
 - ▶ Keep in mind foreign translations of marks as well, especially when avoiding misleading terms
 - ▶ NOVA = cars, but translates to “Doesn’t go” in Spanish... Oops

Clearance

- ▶ Narrow the list of choices for marks by running preliminary or “knock-out” searches to see what marks are in use that may be similar or identical to your mark for similar or identical goods or services
 - ▶ Check the Trademark Electronic Search System database (TESS), online resources, dictionary definitions, domain names, or run preliminary searches with trademark search software to help make quick determinations on the availability or strength of your potential trademark
- ▶ After a preliminary search, a full search from a trademark search agency may be required for a more extensive list of trademarks already in use that are similar to yours
 - ▶ Full searches encompass US, state, and international trademarks, as well as business names, domain names, website usage, and common law marks to help determine if your trademark is available for use and registration

Application

- ▶ After investigating search results and determining your mark can proceed through the registration process, file an application with the USPTO
- ▶ Use the USPTO's online filing forms to fill out your contact information, mark details, class identifications for mark goods and/or services, and attorney of record information
 - ▶ See the USPTO'S ID Master List for class IDs for goods and services: <https://idm-tmng.uspto.gov/id-master-list-public.html>
- ▶ Five filing bases: 1(a) for marks already in use in US commerce, 1(b) for marks not yet in use in the US but filed under a good faith bona fide intent-to-use (ITU), 66(a) for foreign marks filed in the US via the Madrid Protocol using an international registration, 44(d) for new US application filings based on foreign applications that will eventually mature into foreign registrations based on 44(e) for new US application filings that are already or have become based on foreign registrations
 - ▶ 1(a) filing basis requires a specimen showing the mark actually in use in US commerce for the applied-for goods and/or services
 - ▶ Specimens for goods = product labels, containers, or packaging showing the mark
 - ▶ Specimens for services = advertising or promotional materials, brochures, or screenshots of website showing the mark
- ▶ Once a serial number is granted for your application, you can track its progress in TSDR (Trademark Status and Document Retrieval)



Review

- ▶ Within 3 months of filing, the USPTO will review your application by assigning it to an Examining Attorney, who determines mark registerability under federal law
 - ▶ An Office Action may issue if the Examining Attorney finds a basis for refusing to register your mark, such as likelihood of confusion with another mark or the mark is merely descriptive of the goods and/or services
- ▶ If no Office Action issues, or the Examiner approves arguments overcoming refusal(s), the USPTO will approve your mark for publication on the Trademark Official Gazette
 - ▶ The Trademark Official Gazette is a weekly publication giving public notice of the USPTO's plans to register trademarks
- ▶ Oppositions - anyone who believes his or her business will be harmed by registering your mark can file an opposition before the Trademark Trial and Appeal Board ("TTAB")
 - ▶ Oppositions extend the time between publication and registration depending on the length and outcome of the opposition proceedings before TTAB

Registration

- ▶ If no oppositions are filed within 30 days of publication, or any oppositions are dismissed by the Trademark Trial and Appeal Board, use-based marks will proceed to registration
- ▶ ITU applications receive a Notice of Allowance within 6 months of publication
 - ▶ File a Statement of Use (“SOU”), along with specimens, showing the mark is now in use in commerce
 - ▶ USPTO will then review the SOU to approve your mark for registration
 - ▶ File an Extension of Time to file a Statement of Use (“EOT”) if the mark is still being developed or researched and is not yet in use
 - ▶ 5 Extensions of Time allowed every 6 months from the issue date of Notice of Allowance before a final deadline to file a Statement of Use, or the application is abandoned
- ▶ Successful registration of a trademark grants protection from the USPTO for 10 years



Maintenance

- ▶ Proper maintenance of trademarks ensures protection lasts into perpetuity
- ▶ Section 8 Declaration of Use Affidavit: filed between the 5th and 6th year after the date of registration, maintaining that the mark is still being used in commerce with all goods and/or services
 - ▶ Section 8 requires specimens showing the mark with the goods/services and a verified statement that the mark is still in use
- ▶ Section 9 Renewal: filed between the 9th and 10th year after registration with a Section 8 Affidavit if the mark is still in use
 - ▶ Combined Declarations of Use and Renewals can be filed 6 months late with payment of a “grace period” fee
- ▶ Section 15 Incontestability Affidavit: filed after the mark is five years old to obtain “incontestable” status with the USPTO
 - ▶ Incontestability- mark must be in continuous use in commerce over 5 consecutive years after the date of registration to file a Section 15 Affidavit
 - ▶ Increases the mark’s strength, narrowing the grounds that people can use to challenge the mark’s registration

USPTO Application Forms

- ▶ Two different forms for filing trademark applications: TEAS Plus and TEAS Standard
 - ▶ 1. **TEAS Plus** applications cost \$250 per class, lowering costs for each class of goods and services. However, Applicants must meet more requirements before the new trademark application can be submitted, and goods and services must be chosen directly from the Trademark Identification Manual rather than freely chosen and manually entered.
 - ▶ **TEAS Standard** applications cost \$350 per class, allowing Applicants to manually choose and enter the goods and services to be covered by the new trademark application. Filings costs are higher, but Applicants are able to avoid certain requirements, such as not having to immediately designate a US-licensed attorney and not being bound by goods and services listings specifically designated by the Trademark Identification Manual.



USPTO Trademark Filing Fees

- ▶ Filing fees are calculated on a per class basis, with additional costs for multiple classes of goods and/or services added to applications
- ▶ Initial fees for electronic filing are \$250 for TEAS Plus and \$350 for TEAS Standard, following 2021 USPTO Fee Schedule Updates
- ▶ Additional fees include:
 - ▶ \$125 per class to request an Extension of Time to show use of the mark and \$100 per class to file a Statement of Use.
 - ▶ \$225 per class for a Section 8 Affidavit and \$200 per class for a Section 15 Affidavit
 - ▶ \$425 per class for a Combined Sections 8 and 15 Declaration of Use and Incontestability filed during the 5th and 6th year after registration
 - ▶ \$525 per class for a Combined Sections 8 and 9 Declaration of Use and Renewal filed every 10 years
 - ▶ \$200 per class for grace period fees for Section 9 Renewal, \$100 for Section 8 Affidavit, if filed 6 months after the due date.
 - ▶ \$150 fee to petition to revive an application if it falls into abandonment status during any phase of the registration process (i.e., failure to file a Statement of Use or Extensions of Time to file a Statement of Use)

Recent Developments

- ▶ US Trademark Filings Have Surged
 - ▶ According to David Gooder, Commissioner for Trademarks: “Since last fall, trademark applications from US and foreign applicants have surged to unprecedented levels. As of June 17, the increase is roughly 63% over last year, which translates to about 211,000 more applications. And in December 2020 alone, the USPTO received 92,608 trademark applications, an increase of 172% over December 2019. This surge has doubled the number of applications waiting to be examined and increased waiting times at various stages in our processes”
 - ▶ See <https://www.uspto.gov/subscription-center/2021/what-huge-surge-trademark-filings-means-applicants>
- ▶ What Does the Increase in Filings Mean?
 - ▶ The US is a first to use system, where use priority assists with successful trademark disputes. However, it is important to search and file your intent-to-use (ITU) applications quickly so they can be assigned to an Examiner for review to cut down on potential review delays
 - ▶ Priority filing dates matter even if trademarks are not in use yet, and so intent-to-use applications are important for continued and increased trademark prosecution
 - ▶ When an Office Action is received, respond within a month or two, unless there are other circumstances or exceptions delaying response
- ▶ Overall, push through trademark prosecution at a greater pace

Recent Developments

- ▶ Increases in Trademark Filings Will Cause Changes with USPTO Review
 - ▶ USPTO review of new trademark applications is taking a minimum of six (6) months from filing
 - ▶ The Trademark Modernization Act (TMA) shortens Office Action response and amendment deadlines
 - ▶ Section 4 of the TMA amends Lanham Act [Section 12\(b\)](#)
 - ▶ Following refusal of an application, an Examiner may require a response or amendment in less than six months (but at least 60 days)
 - ▶ Applicants may request that their response deadline be extended up to six months from the date of notification from the Examiner
 - ▶ Anticipating about 12-18 months for review at the USPTO from application to registration, noting the time frame can sometimes be longer
 - ▶ Strategic approaches to trademark prosecution may lead to shortened review times, especially if trademarks are already in use

Please contact Rakesh Amin to discuss structured, detailed searches on the USPTO's Trademark Electronic Search System (TESS). This will help to effectively search company trademarks that are on file or registered at the USPTO, as well as searching based on specific classes of goods and services. Searching before filing is also important to get a clearer market picture for your trademarks of interest, especially in a more crowded field of trademark applications.

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Thank You!