

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



USPTO Inventor Info Chat Series: Trademark Basics

Office of Innovation Development
Scott Baldwin & Zandra Smith
June 15, 2017

Email questions to:
inventorinfochat@uspto.gov

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Office of Innovation Development

- In Person Assistance (by appointment) for Pro Se Applicants
- Assistance Hotline 1-866-767-3848
- Patent Email Support innovationdevelopment@uspto.gov
- PTRC Partnership for Patent Education Courses
 - Virtual Assistance Pilot Program
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 - Independent Inventor Conferences
 - Education for Inventor Organizations
- <http://www.uspto.gov/inventors>

Overview

- Purpose of Trademarks
- Life of a Trademark
 - Creation
 - Screening and Clearance
 - Protection
 - Maintenance (of Registration)
- Navigating the Trademark Application Process

Send your questions to: inventorinfochat@uspto.gov

Purpose of Trademarks

Trademarks serve as indications of origin and quality.

They represent the “**goodwill**” or reputation your business and its products/services enjoy with the public.

- Businesses rely on their marks to identify their products and services and distinguish them from those of their competitors.
- The public relies on marks to distinguish among competing producers and as guarantees of quality.

Life of a Trademark

I CREATION

- Choosing a trademark or service mark

II. SCREENING and CLEARANCE

- Making sure the proposed mark is available

III. PROTECTION

- Seeking protection, country-by-country

IV. MAINTENANCE

- Renewing trademark registrations



Part I: LIFE OF A TRADEMARK

CREATION

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Types of Trademarks

- Word Marks:

PARKING PANDA

GULP OIL SKIMMERS

- Design Marks:



- Composite Marks containing both words and design:

Samsonite



- Slogans:

EVERY SOMEDAY NEEDS A PLAN

BLAST THE PAST



Some Unusual Trademarks

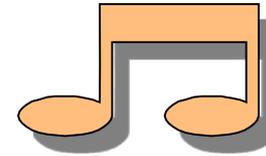
- Shape: Bottle shape for soda pop



- Color: Pink color for insulation



- Sound: Drums, trumpets and strings for entertainment / motion picture films



20thCenturyFox.mp3

- Scent: Plumeria flower blossom scent for sewing thread



- Motion: Flying pegasus for movie studios



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Select Strong Trademarks!



In general, the more "distinctive" a mark is, the "stronger" it is and the greater the scope of protection the mark will receive in court against uses of the same or similar marks.

Because all trademarks do not receive or deserve the same scope of protection, the type of mark a business selects will have a direct effect on its ability to protect the mark.



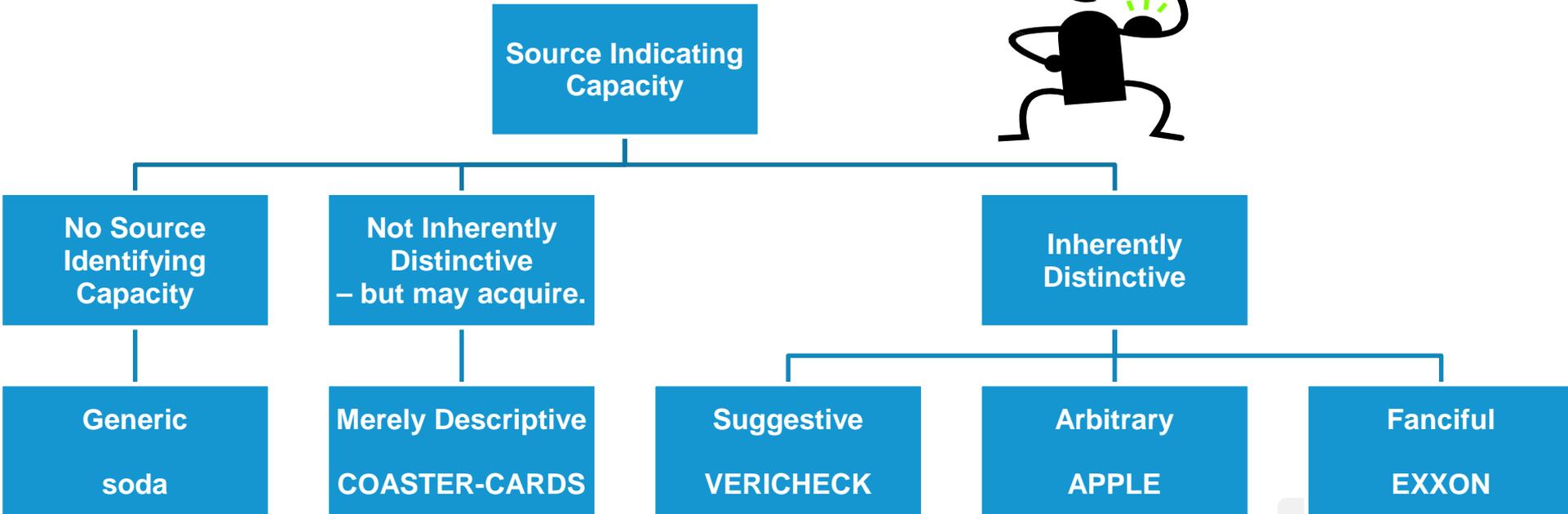
Strength (inherent and marketplace)

“**Strength**” of a mark refers to its ability to identify and distinguish the goods/services of one party from those manufactured or sold by others and to indicate the source, even if that source is unknown.

“Strength” can be measured by two factors:

- 1) The degree to which the mark is **inherently distinctive** (fanciful/coined, arbitrary or suggestive).
 - The more unusual, arbitrary, and fanciful a mark, the more **unlikely** it is that two independent entities would have chosen it.
- 2) The degree to which it is distinctive in the **marketplace**.
 - Fame, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition.
 - Even a mark that had to acquire distinctiveness may qualify as a very strong mark for likelihood of confusion analysis.

Trademark Continuum



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Part II: LIFE OF A TRADEMARK

SCREENING and CLEARANCE

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Types of Trademark Protection in the U.S.

- Common Law – unregistered; derived from use. “TM”
- State Registration – the “truly local.” Registered with one or more U.S. states
- Federal Registration® - interstate commerce or between the U.S. and another country.
- Other Federal Statutes
 - Smokey Bear
 - Woodsy Owl



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SCREENING and CLEARANCE in the U.S.

- **USPTO DATABASE**
 - Federally registered trademarks and pending applications for registration
- **STATE TRADEMARK REGISTRIES**
- **DOMAIN NAME SEARCH**
 - Generic Top Level Domains (gTLDs)
 - Country Code Top Level Domains (ccTLDs)
- **COMMON LAW SEARCH**
 - the Web, trade names, trade directories, etc.

Obtaining a “**full search**” helps to ensure that these other sources of information will be considered in clearing trademarks.



PART III: LIFE OF A TRADEMARK

PROTECTION (Country-by-Country)

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Does a Company Need to Register its Mark in the U.S.?

- Not required, because trademark rights (in the U.S.) arise from use on or in connection with goods or services

BUT...

- There are significant advantages to having a federal trademark registration.

Advantages of Federal Registration on Principal Register

- Public notice of your claim of ownership of the mark;
- A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in federal court;
- The use of the U.S. registration as a basis to obtain registration in foreign countries;
- The right to use the federal registration symbol ®;
- Listing in the United States Patent and Trademark Office's online databases; and
- Registration may be recorded with U.S. Customs and Border Protection to prevent importation of infringing foreign goods.
 - The recordation fee for trademarks is US\$190 per International Class of goods.

How Do I Get a Federal Trademark Registration?



- File an application at the U.S. Patent and Trademark Office.
- You can complete an application online, check it for completeness, and file it over the Internet using the Trademark Electronic Application System (TEAS).
- Three ways to pay: credit/debit card, automated deposit account or electronic funds transfer.

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Filing Fees

Filing fee for
paper filing:



\$600 per class of
goods/services.

Filing fee for
e-filing:



\$400 per class of
goods/services if filed
using the “regular” TEAS
form.



\$275 per class of
goods/services if filed
using the TEAS “RF”
form.



\$225 per class of
goods/services if filed
using the TEAS Plus
form.

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Legal Basis to File

On what legal basis can I file an application to register a trademark in the United States?

- **Use** of the mark in commerce
 - bona fide use of a mark in the ordinary course of trade, and ***not*** made merely to reserve a right in a mark.
- A **bona fide intention to use** the mark in the future
 - Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), provides that an applicant may file an application based on a bona fide intention to use a mark in commerce "*under circumstances showing the good faith of such person.*"
- **Foreign** application or registration.

Some Possible Substantive Grounds for Refusal

- (1) The applicant is **not the owner** of the mark (TMEP §1201) ;
- (2) The subject matter for which registration is sought does not function as a mark (15 U.S.C. §§1051, 1052, 1053, and 1127) because, for example, the proposed mark:
 - (a) is used solely as a **trade name** (TMEP §1202.01);
 - (b) is **functional**, i.e., consists of a utilitarian design feature of the goods or their packaging (TMEP §§1202.02(a) *et seq.*);
 - (c) is a **nondistinctive configuration** of the goods or their packaging (TMEP §§1202.02(b) *et seq.*);
 - (d) is mere **ornamentation** (TMEP §§1202.03 *et seq.*);
 - (e) is the **generic name** for the goods or services (TMEP §§1209.01(c) *et seq.*); or
 - (f) is the **title of a single creative work** or the **name of an author or performing artist** (TMEP §§1202.08 *et seq.* and 1202.09 *et seq.*);
- (3) The proposed mark comprises **immoral or scandalous** matter (TMEP §1203.01) ;
- (4) The proposed mark is **deceptive** (TMEP §§1203.02 *et seq.*);
- (5) The proposed mark comprises matter that may **disparage or falsely suggest a connection** with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute (TMEP §§1203.03 *et seq.*);
- (6) The proposed mark comprises the **flag, coat of arms, or other insignia** of the United States or any State, municipality, or foreign nation (TMEP §§1204 *et seq.*);

- (7) The applicant's **use of the mark is or would be unlawful** because it is **prohibited by statute** (TMEP §§1205 *et seq.*);
- (8) The proposed mark comprises a **name, portrait, or signature identifying a particular living individual without the individual's written consent**, or the name, portrait, or signature of a deceased president of the United States during his widow's life, without written consent of the widow (TMEP §§1206 *et seq.*);
- (9) The proposed mark so resembles a previously registered mark as to be likely, when used with the applicant's goods and/or services, to **cause confusion or mistake, or to deceive** (TMEP §§1207 *et seq.*);
- (10) The proposed mark is **merely descriptive or deceptively misdescriptive** of the applicant's goods and/or services (TMEP §§1209 *et seq.*);
- (11) The proposed mark is **primarily geographically descriptive** of the applicant's goods and/or services (TMEP §1210.01(a));
- (12) The proposed mark is primarily **geographically deceptively misdescriptive** of the applicant's goods and/or services (TMEP §1210.01(b));
- (13) The proposed mark is **primarily merely a surname** (15 U.S.C. §1052(e)(4); TMEP §§1211 *et seq.*); or
- (14) The proposed mark merely identifies a **character in a creative work** (TMEP §1202.10).

TMEP = [Trademark Manual of Examining Procedure](#)

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Trademark Registration Timeline*

Examination: **2.7** months from filing to examination.

Registration: **9.8** months after filing.

* Figures are approximate, and based on Q2 FY17 performance.





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Is Federal Registration Valid Outside the United States?

- **No.**

Trademark rights are *territorial*: rights in particular trademarks exist only within the country whose laws granted those rights.



Protecting Trademarks Abroad

- Be proactive in protecting trademarks!
- Have you considered registering your mark in countries in which:
 - Your goods or services are **marketed**;
 - Products or parts for your products are **manufactured**;
 - **Research and development facilities** are located;
 - Your products are **trans-shipped**;
 - You **might expand your business** in the future; or
 - **Counterfeiting** is likely to be a problem.



PART IV: LIFE OF A TRADEMARK

MAINTENANCE (of Registration)

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- In The U.S.
 - Evidence of **continued use**: submitted between 5th and 6th year.
 - **Renewal**: submitted between 9th and 10th year.
 - Electronic forms can be completed very easily; much of the data is entered automatically.



TM Owners Must Be Alert!

Read every piece of IP correspondence Carefully!

- Trademark filing information is public information.
- Private companies not associated with the United States Patent and Trademark Office (USPTO) often use trademark application and registration information from the USPTO's databases to mail or e-mail trademark-related solicitations.
 - Many include offers:
 - (1) for legal services;
 - (2) for trademark monitoring services;
 - (3) to record trademarks with U.S. Customs and Border Protection; and
 - (4) to "register" trademarks in the company's own private registry.

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TM Owners Must Be Alert: Example

UNITED STATES TRADEMARK REGISTRATION OFFICE

Trademark Registration and Monitoring Division

633 West Fifth Street

28TH Floor

Los Angeles CA 90071-2005

**IMPORTANT NOTIFICATION REGARDING
YOUR FEDERAL TRADEMARK**

[Redacted]
[Redacted]
Nashville, TN [Redacted]



TRADEMARK

[Redacted]
[Redacted]

Serial Number: [Redacted]
Filing Date: [Redacted]
Primary Code: 041
Intl Code: 041

PROCESSING FEE → **\$375.00**

DESCRIPTION

Owner

[Redacted]

Trademark

[Redacted]

Serial Number

[Redacted]

Registration Number

[Redacted]

Filing Date: [Redacted]

U.S. Customs & Border Protection (CBP), a bureau of the Department of Homeland Security, maintains a trademark recordation system for marks registered at the **United States Patent and Trademark Office**. Parties who register their marks on the Principal Register may record these marks with CBP, to assist CPB in its efforts to prevent the importation of goods that infringe registered marks. The recordation database includes information regarding all recorded marks, including images of these marks. CBP officers monitor imports to prevent the importation of goods bearing infringing marks and can access the recordation database at each of the 317 ports of entry.

Upon receipt of this form and your payment **United States Trademark Registration Office** will:
A) Record your **U.S. Trademark Registration** with the **U.S. Customs & Border Protection (CBP)** and send you notice(s) when the blocking of such goods occurs. B) Monitor your trademark using USTRO's proprietary search engine and notify you regarding possible third party trademark infringement(s) **(enforcing your intellectual property rights and protecting a trademark from confusingly similar names is essential and the sole responsibility of the owner and not the USPTO (United States Patent and Trademark Office))**. C) Send you reminder notices of the following filing requirements. 1)

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Navigating the Trademark Application Process at the USPTO: **Resources**

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Getting Started

Application Process

Maintaining a Trademark

Getting Started with Trademarks

Before you apply for a trademark, you should familiarize yourself with the basics. Determine if you need a trademark or another form of Intellectual Property protection.

Helpful Resources:

- > [Trademark basics](#)
- > [Using Private Legal Services](#)
- > [Non-USPTO Solicitations](#)
- > [Trademark FAQs](#)
- > [Trademark process](#)
- > [Madrid Protocol](#)

Trademark Tools & Links



Search trademark database

Search database for trademark registrations and applications by mark, owner, or serial/registration number with Trademark Electronic Search System (TESS)

TESS



Apply online

File forms for the trademark application, maintenance and other trademark processes with Trademark Electronic Application System (TEAS)

TEAS



Check Status & View Documents

Check the status of an application and view and download application and registration records using Trademark Status and Document Retrieval (TSDR)

TSDR



Trademark Trial and Appeal Board (TTAB)

The TTAB is an administrative board that hears and decides adversary proceedings between two parties, namely, oppositions and cancellations. The TTAB also handles interference and concurrent use proceedings, as well as appeals of final refusals issued by USPTO Trademark Examining Attorneys.



Trademark Assignments: Change & Search Ownership

During the examination of a pending trademark application as well as after a trademark has registered, the owner of a trademark may change for various reasons

ETAS

AOTW



Trademark Application and Post-Registration Process Timelines

The timelines provide an overview of the process steps and time frames for filing a trademark application with a particular filing basis and for maintaining a trademark

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[Order Certified Copies](#)

Order certified documents with the USPTO ribbon and seal as well as the signature of an authorized certifying officer

[United States Patent and Trademark Office's](#)

[Trademark Educational Outreach Program](#)

The United States Patent and Trademark Office (USPTO) is looking to partner with colleges and universities, entrepreneurship clubs, and similar groups to present informational lectures on trademarks

[Trademark Information Network](#)

A news broadcast-style video series that explains the federal trademark application process from beginning to end.

[Basic Facts Booklet](#)

Learn how to protect your trademark and enhance your rights through federal registration. (PDF version)

[Recursos en Español para Registrantes de Marcas](#)

Librete de Información Básica Sobre Las Marcas Registradas. Videos de Información Básica Sobre Las Marcas Registradas. Videos de la Red de Información Sobre Marcas Registradas.

[Basic Facts About Trademarks Videos](#)

An animated video series that provides all of the basic information you need to know about trademarks.

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ESTTA

TTABVUE

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ETAS

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Apply online

First timer? Get basic information before filing to avoid mistakes that cost you time, money, and potentially your legal rights.

To apply for a trademark or servicemark, **select your form from the table heading below**. Once you select the form, you will be directed to our Trademark Electronic Application System (TEAS) where you can begin filing your application.

Need more help deciding which form to use or how to fill it out? **Watch the TEAS Nuts and Bolts video.**



Trademark application forms (select one to start) --->	TEAS Plus form	TEAS Reduced Fee form	TEAS Regular form
Filing fee per class of goods/services	\$225	\$275	\$400
E-mail address required for USPTO application-related correspondence?	Yes	Yes	No
Additional submissions, like responses to Office actions, must be filed online?	Yes	Yes	No
Goods/services listing must be selected from the USPTO Trademark Identification (ID) Manual?	Yes	No	No
Full Filing fee paid upfront (per class for all classes listed on the application)?	Yes	No	No
Certain statements regarding the mark be provided in the application as filed, if applicable (e.g., translation statement, claim of ownership, color claim and description)?	Yes - see TMEP §819.01	No	No
Additional processing fee if applicant does not satisfy the relevant filing option requirements ?	Yes - \$125 per class of goods/services	Yes - \$125 per class of goods/services	No

Email questions to:
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Trademark Assistance Center

The Trademark Assistance Center (TAC) is the main support center for all customers, from first-time filers to legal professionals and experienced trademark applicants. We can answer your questions on a variety of trademark topics.

Contact us for:

- General information about registering a trademark
- Trademark literature and publications
- Updates on the status of trademark applications and registrations
- Answers to case-specific questions about an application or registration
- Help navigating electronic forms and systems
- Help finding information on our website about the meaning of trademark terms and concepts, how to start the application process, application and registration timelines, and more.

We cannot give legal advice. This includes:

- Advising applicants on proper responses to USPTO Office actions
- Conducting pre-filing searches for potentially conflicting trademarks
- Analyzing or pre-approving documents before filing
- Advising applicants on substantive examination issues, such as the acceptability of specimens and classification of goods and services.

Hours

Type of assistance	Hours and contact information
Contact center	Monday-Friday, 8:30 a.m. to 8 p.m. ET

Email questions to:
inventorinfochat@uspto.gov

Trademark Assistance Center (TAC)

600 Dulany Street
Madison East, Concourse Level
Alexandria, VA 22314

Local: 571-272-9250 (press 0)

Toll-Free: 800-786-9199 (option 1)

TrademarkAssistanceCenter@uspto.gov 

Upcoming OID Events

- **Upcoming Inventor Info Chat Webinar**
 - Office of Petitions – Overview and Helpful Tips 7-20-17
- **USPTO Invention Con (Independent Inventor Conference) at Alexandria Headquarters August 11-12, 2017**
 - Conference will include seminars, panels and breakout sessions related to patents and trademarks

For more information or to register for any of the above events contact us at oidevents@uspto.gov

<https://www.uspto.gov/patents-application-process/inventor-info-chat>





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Thank You!

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To inquire about OID services please contact us at:

InnovationDevelopment@uspto.gov

1.866.767.3848

Presented By:
Scott Baldwin
Zandra Smith



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Intellectual Property Rights (IPR) Basics

Learn how to protect your innovations, spur creativity, and market products safely at home and abroad

GET THE BASICS



[Business Guide to Intellectual Property Rights](#)



[Consumer Guide to Counterfeits & Pirated Goods](#)



[Get Help Resolving IPR Issues](#)



[U.S. & Global IPR Initiatives](#)

Email questions to:
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The STOPFakes.gov Website

ONLINE INTELLECTUAL PROPERTY TRAINING MODULE

Use the free Online IPR Training Module to learn about evaluating, protecting, and enforcing your intellectual property rights!

BENEFITS OF THIS COURSE

- Learn about the different types of IPR, including copyright, patent, and trademark, as well as the legal protections available for each of them.
- Understand the process and benefits of acquiring and protecting your IPR.
- Discover resources to help you enforce your IPR.
- **Choose your language to get started!** This course is available in English, French, and Spanish.
- Download the full training module in [Adobe PDF English](#), [French](#), [Spanish](#).

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