

FOLEY EXECUTIVE BRIEFING SERIES



Maximize Your Branding Dollar To Get The Most From Your Trademarks





Trademark Basics: What is a Trademark?

- Trademark
 - Identifies a source of goods from other sources
- Service Mark
 - Distinguishes a source of services from other sources
- Trade Name
 - Identifies and distinguishes a business organization from other companies



What is a Trademark? *(cont'd)*

TYPES OF MARKS

basic word mark:

CVS/pharmacy

logo & word mark:



stylized word mark:

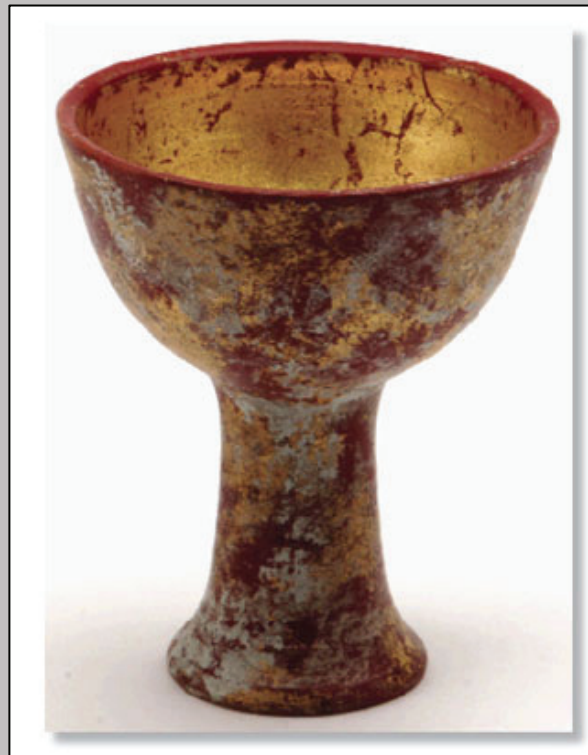


letter logo mark:





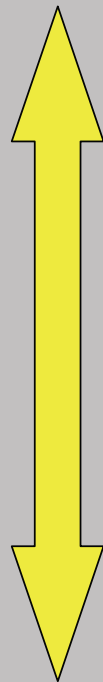
CHOOSE WISELY





What Makes a Strong Mark?

Protectable



Unprotectable

- **Arbitrary/Fanciful**
KODAK (film); EXXON (oil);
APPLE (electronics)
- **Suggestive**
COPPERTONE (suntan lotion);
CHICKEN OF THE SEA (tuna)
- **Descriptive**
WINDOWS (software); CHAPSTICK (lip balm);
MRS. FIELDS (cookies)
- **Generic**
PC, modem, apple (for apples)



What Makes a Strong Mark? *(cont'd)*

■ “Inherently Distinctive” Marks

- arbitrary or fanciful marks
- some suggestive marks

These are the types of marks that you want to select for the best trademark protection!



Marks That Require Time and \$\$

- Descriptive marks (describing a quality or feature of the goods/services)
- Marks that are primarily surnames
- Primarily geographically descriptive marks
- Product configurations
- Color, scent, sound

These types of marks may be protectable but only if there is a showing of “acquired distinctiveness” such that the consuming public perceives the descriptive term as a source identifier



Unregisterable Marks

- Generic Marks
 - Generic marks primarily refer to a type of good/service not a source
 - Warning: A term once trademarked can become generic, e.g., aspirin, escalator, thermos, shredded wheat. **Avoid this by properly using and policing your marks!**
- Deceptive Marks
- Immoral/Scandalous/Disparaging Marks
- Flag/Coat of Arms
- Name or likeness of living individual without written consent
- Functional Shapes



Selecting and Developing a Trademark

- CHOOSE a mark that is arbitrary, fanciful, or suggestive (inherently distinctive)
- CHOOSE a mark that is easy to pronounce and remember
- Do NOT choose a mark that is merely descriptive or generic
- Do NOT choose a mark that has negative connotations in foreign languages
- Do NOT choose a mark that may become passé in a few years (at least do not invest heavily in such a mark)



SEARCH NOW Reduce Risk For Later

- Searching marks before using
 - In-house /Self-Help
 - Outside Preliminary
 - Full Search Using Outside Vendor



Why Register?

- “Reserve” marks for future use
- Evidence of Ownership through use of ®
- Heightened protection after 5 years
- Protection against registration of similar marks
- Nationwide constructive notice
- Right to block imports that infringe the mark
- In many countries outside of the U.S. valid registration will trump earlier use



What, Where & When to File

■ What:

- Company name (only if also product or service)
 - Trade names (business names alone are not registerable in the US)
- Product name or separable key feature/function

Products with short term or lesser import may not be worth the expense



What, Where & When to File *(cont'd)*

■ Where:

- Key countries/markets where you are doing business
- Countries/markets where you expect to be active in the next 3-5 years and/or piracy is a concern
 - Most countries are “first to file” and licensees/distributors/pirates may be able to prevent you from using your own mark if you are not proactive



What, Where & When to File *(cont'd)*

■ When:

- File BEFORE you announce mark publicly!
 - ITU application in the US allows for 3 years of extensions before use must be shown. This is in addition to the PTO examination time.
 - In most foreign countries it is not necessary to show use to obtain a registration but registrations may be cancelled by third-parties if use has not commenced within 3-5 years after registration.
 - 6-month grace period to extend original application into additional countries under base application filing date.



Domain Name Ownership

- Think about where your audience is most likely to look
 - gTLDs
 - Countries
 - “popular” domain extensions
- Have a plan
 - No need to own everything
 - Set priorities
- Acquisition



Don't Throw It Away Use It Correctly





Make Your Mark Stand Out

- Trademark should ALWAYS be **highlighted** by display in CAPITAL LETTERS, **bold**, *italics* or similar so it is easily distinguishable from other words in close proximity



Proper Notice

- Use proper trademark notice
 - Unregistered marks (including marks with pending applications) use TM or SM
 - U.S. federally registered marks use ®
 - Do Not use ® if not registered or where not registered
 - If materials used in the US will also be used abroad alternative indications of ownership may be necessary
 - If company marks are used with non-company owned marks, appropriate indications of ownership should also be given (i.e., X, Y and Z are trademarks of ABC, Inc., R and Z are trademarks of DEF, Inc.)
 - Alternatives indicating appropriate ownership may be used



Using Your Trademarks Properly

- DO adopt and use guidelines for trademark usage
 - Include typography, color, graphics, placement, style, etc.
- DO use the mark in a consistent manner
 - Review advertising, promotion, packaging routinely to ensure this is done
- DO use trademark as an adjective (e.g., **Wave**[®] music system)



Using Your Trademarks Properly *(cont'd)*

- DO use your mark in association with the relevant goods and/or services (on the actual product whenever possible)
- DO make sure licenses are in place and enforce proper trademark use and attribution by licensees and have licensors do same
- DO correct improper use by others



What Not To Do

- A trademark should **NEVER** be used as a noun, verb, plural or possessive as this will risk genericness
- If the mark is or may be descriptive, do NOT also use the descriptive term(s) in a non-trademark sense in promotional materials/advertising/white papers, etc.
- Do NOT hyphenate, combine, abbreviate as this may blur the trademark
- Try to avoid using two adjacent marks
 - Use of house brand may be the exception



ENFORCEMENT...

What Others Do Can Hurt You



- Scale relative to importance of mark and offense
- Don't let problems build
- Letters and ISP take-down requests
 - Know what you want as a result
- UDRP
- If its worth litigation act quickly and decisively



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THANK YOU

