

The Business of Trademarks

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A Practical Guide to Trademark
Management for Attorneys and Paralegals

Carol Chadirjian



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*The Business of Trademarks:
A Practical Guide to Trademark Management for Attorneys and Paralegals*

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Dedication

I dedicate this book to my mother, Rose Bajakian Chadirjian. When she became seriously ill, and inspired me to write this book. I worked from my home office while being available to care for her at the same time. She urged me to go on and told me that I became so motivated and excited about the book.

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Preface

The *Business of Trademarks: A Practical Guide to Trademark Management for Attorneys and Paralegals* is intended as a practical guide for legal professionals seeking to learn about trademark prosecution. The United States Patent and Trademark Office (hereinafter “PTO”) publishes the Trademark Manual of Examining Procedure (hereinafter “TMEP”), which is the official reference manual used by the Trademark Examining Attorney (hereinafter “Examiner”), however, as a practical matter, it is too detailed and technical to be useful for training purposes for someone who is new to trademarks. The United States Trademark Association (now known as the International Trademark Association, hereinafter as “INTA”) published “*Trademark Management*” in 1982, but no other comparable training guide has been published since that time. *The Business of Trademarks: A Practical Guide to Trademark Management for Attorneys and Paralegals* aims to fill the gap. It will enable legal professionals or students of law to acquire the skills and knowledge necessary to perform day-to-day trademark work diligently, confidently and with efficiency.

Trademark law is a highly specialized area of law. Training attorneys and paralegals in trademark law with no prior knowledge can be difficult and very time-consuming. Often corporate or litigation attorneys and paralegals do not know much about trademark law; it is an area unto itself. Many law firms and companies do not have dedicated trademark departments, or even intellectual property departments. I worked at a large firm and was the only trademark paralegal and was assigned to work with two litigation attorneys who were given the responsibility of handling the firm’s trademark prosecution. The firm did not have a systematic training process for bringing attorneys or paralegals up to speed on how trademark

prosecution works. As the trademark manager, training attorneys and paralegals became my responsibility. We could certainly have used a book like this!

The book is organized by first defining what trademarks are and their function and how the areas of intellectual property – trademarks, copyrights, and patents – differ. I have included a number of visual aids to define and differentiate trademarks, patents, and copyrights, in addition to, providing examples of different types of trademarks being word marks, slogans, standalone designs, and wordmark with design.

Next, I address the trademark registration process beginning with selection of a trademark, trademark searching for clearance, filing the application, proving use of the trademark, having the trademark published for opposition, acceptance of the application for registration, and issuance of the Certificate of Registration to the registrant. I also review post-registration matters, such as maintenance and renewal required to keep trademarks valid and enforcement of trademark rights for the rest of the life of the trademark, until perpetuity.

We will also cover important business considerations related to trademarks, such as corporate transactions; an important segment of trademarks often overlooked, but is pure evidence that trademarks are valuable assets. A full chapter is devoted to outlaying the role trademarks play in corporate transactions and the important preclosing due diligence process. All actions up to commercial closing are explained. The appendices provide examples of PTO forms, closing lists, and other forms to track documents throughout the process. In addition, proper use of trademarks and the use of proper trademark symbols in advertising and publications.

A wealth of resources and tools are available on the PTO website. The trademark section is divided into trademark prosecution, trademark trial and appeal board (hereinafter “TTAB”) for adversarial filings, and the assignments division for recordal of assignments and other changes in ownership for trademarks and patents. Within that division there is a searchable database which extracts chains of titles. The three separate divisions of the PTO are mutually exclusive and there is no intercommunication between divisions.

Additionally, the full text of the TMEP is online. Also, searching, electronic filing, document retrieval and trademark status can be found on the site. All trademark laws and United States statutes, code of federal

regulations, and the guide for identification of international classes of goods and services and appropriate language for the description of goods and services are available in full text.

Also, there are trademark training videos and other educational materials that far exceed the scope of this book.

Trademark management involves much more than merely filing applications. It has greatly expanded and involves areas such as trade dress, domain names, famous marks, marketing, packaging, and unfair advertising. The development and use of the Internet gives trademark owners a huge area that needs careful policing against not only trademark infringement, but typo squatters, cybersquatters, and counterfeiters.

It is a fascinating area of law. I have spent most my professional working life in this area because I am passionate about it. My goal is that *The Business of Trademarks: A Practical Guide to Trademark Management for Attorneys and Paralegals* will be on many bookshelves and desks of those new to trademarks that require training in trademark law in a concise, comprehensive, and understandable guide to trademark prosecution. Nothing gives more satisfaction than having the official Certificate of Registration, the U.S. government's gold corporate seal, in your hand after all the work is done!

Introduction to Trademarks

Basic Principles

Consumers are constantly being bombarded with brand names in the marketplace. Manufacturers are constantly creating new and improved versions of their products, with logos with new colors, motion, and sound. The constant pulse of advertising on television, on the Internet, and in printed publications threaten to make consumers jaded. In this context, brand management is a challenging endeavor. How do you create a trademark that is so memorable that whenever consumers encounter this brand, they at once think of you, the producer? How do you catch and hold the customer's attention? What branding strategies will attract customers to buy one brand over another? How can you select a trademark that represents your sterling reputation and quality products in the marketplace? How can you create a trademark suggestive enough of the product, that is still registrable? How does your brand recognition function better than your competitors? How about quality products? Inventing clever brand names and logos is critical to commercial success. But cleverness is not enough. Understanding what makes a trademark memorable is great; making a great trademark registrable and strong over time is our challenge. This is the perfect coordination of marketing and trademark management.

Many elements go into effective brand management. Creating a distinctive trademark, whether a wordmark or a wordmark with a logo requires selecting carefully chosen words to effectuate a distinctive mark with a positive connotation in the minds of the consumer that indicate the source. Trademarks are source identifiers—they function to identify and distinguish the products from one company to another. The success of a brand owner is measured by how its trademark is perceived in the eyes of

the consumers in the marketplace. A strong, distinctive trademark distinguishes one owner's products from that of the competitor, while promising consistent quality, reputation, and goodwill associated with the owner. It is the trademark attorney's job to evaluate the registrability of marketing's choices for a proposed trademark. A trademark that aids in selling the product and is registrable is our goal. Trademarks protect the consumers from confusion as to the source of the goods or services.

A trademark may be a word, logo, package design, device, trade dress, sound, scent, color, or a combination thereof used in commerce to distinguish a product or service from one source to that of another source.¹

Trademarks are most often words (word marks) and logos (design marks) or a combination of words and logo. They can also be names, personal or business, a title of a book or movie, names of fictional characters, corporate names, or domain names, provided that the trademark functions as a trademark.

Trademark rights accrue through actual use in the marketplace. This is known as common law usage. This simply means that the owner has the right to use the trademark and accrue value without the benefit of a federal registration, although a federal registration will greatly enhance the value of the trademark.

Applications must claim a basis under which they are filed. The main bases are use based or 1(a), or intent-to-use (hereinafter "ITU") or 1(b). In a 1(b) application, use of the trademark on the goods or in connection with the services must be proven prior to registration. The first use date is the earliest date that the trademark is used on the goods or in connection with the services claimed in the trademark application. Most importantly, the specimens submitted to the PTO in support of the application must show the trademark exactly as it appears in the application and as currently used on the goods or in connection with the services. It is important to be aware that, from a trademark perspective, use in commerce must be interstate, rather than intrastate and forbids merely reserving a mark that may or may not be used in the future. Trademark rights are signified by use of the mark on the goods or in connection with the services. In an application based on 1(a), the applicant already proved use of the mark in the initial application.

¹Trademark Act of 1946, as amended ("Lanham Act"), 15 U.S.C. § 1051 et. seq., 1127; PTO, *TMEP* (Washington, D.C.: Dept. of Commerce, Patent and Trademark Office), October 2017.

Trade dress is another type of trademark or source identifier, and of late, this area of intellectual property law has become very litigious and newsworthy. Trade dress is a “symbol” or “device” within the meaning of §2 of the Lanham Act. Trade dress consists of a product’s shape, design, color, texture, or packaging that identifies the product’s source. To function as trade dress, the features of a product need to be distinctive and but not functional to the use or purpose of the product or its services. An example of trade dress is COCA COLA’s shape of the classic Coca Cola bottle. The Coca Cola bottle is a splendid example of trade dress and a famous trademark combined in the same mark. The shape of Coca Cola bottle is recognized worldwide. Once consumers see the bottle, there is an immediate connection to the product and the company that produces it, the Coca Cola Company. The overall commercial impression allows consumers to connect and distinguish the Coca Cola or Coke bottle products from other cola manufacturers.

The main function of a trademark is to be a source indicator. Trademarks are a product of the company producing those goods or services and seek to protect consumers from the likelihood of confusion as to who the producer or manufacturer is. It is the responsibility of the Examiner to reject any trademark that has the likelihood of confusion to a trademark with prior use or priority dates.

“Famous trademarks” are given an extra layer of protection. This added protection is designed to protect the owner of a famous trademark from later users seeking to profit from another company’s investment in its brand. Willful infringers aim to steal the fame and reputation of the owner, along with confusing the public as to the source. These infringers cause what is known as trademark “dilution”—the lessening of the effect of a trademark. A trademark owner’s reputation and goodwill attached to its marks and are important components of a mark’s value.

The Lanham Act provides that “a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner”² A famous mark is considered “famous” if it meets the following requirements:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

²15 USC § 1125(c)(2)(a).

- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

The prohibition against conduct that dilutes a famous trademark protect famous trademark owners from subsequent users trying to profit from the famous mark's goodwill and reputation, thus, lessening the value of the famous trademarks creating dilution and tarnishment. "Dilution by blurring" is the association arising from the similarity between a famous trademark and a similar mark. Statutes states that "dilution by tarnishment is an association arising from the similarity.... That harms the reputation of the famous mark.

Trademarks as a form of Intellectual Property

Trademark's Relationship to Other Forms of Intellectual Property

Intellectual property is defined by the Convention Establishing the World Intellectual Property Organization (WIPO), Stockholm on July 14, 1967 (Article 2 (viii)) as:

- literary, artistic and scientific works
- performances of performing artists, phonograms and broadcasts
- inventions in all fields of human endeavor
- scientific discoveries
- industrial designs
- trademarks, service marks and commercial names and designations
- protection against unfair competition

There is much confusion about difference between the types of intellectual property. Intellectual property consists of trademarks, patents, and copyrights which are intangible assets to the company that owns it. During corporate transactions, intellectual property plays a significant part as being a valuable corporate asset. The chart differentiates between patents, trademarks, and copyrights:

A patent grants the owner a time-limited monopoly over new and original inventions, processes, or designs, or new and original updates to existing inventions, processes, or designs. There are design patents, plant patents, and utility patents. While designs may be protectable both as patents and trademarks, only patent law protects the useful or utilitarian function of an invention, while trademark law protects the nonfunctional

Different Types of Intellectual Property

	Trademarks	Patents	Copyrights
Governing Body	Patent and Trademark Office	Patent and Trademark Office	Library of Congress
Who owns them?	Businesses, individuals, government, not-for-profit organizations, or estates	Businesses, individuals, government, or inventors	Creators of works—writers, artists, architects
What do they protect?	Word, logo, word and logo, slogans, sound, smell, color, or trade dress	New or improved functional processes	Original works of authorship, artwork, productions in all mediums
What rights do they confer?	Exclusive rights of the trademark. Protection against competitors trading on good will. Ability to sue infringers	Exclusive rights to prevent others from making, using, selling, or importing the invention or design	Exclusive rights of the work. Evidence of copyright ownership of creative works and ability to sue infringers
Duration	Registrations are valid for 10 years, maintenance between 5 th and 6 th years and renewal at the 10 th anniversary of date of registration until perpetuity	Nonprovisional patent protects inventions for 20 years without the benefit of renewal; design patent is 14 years	Endures throughout the author's lifetime and 70 years thereafter. Nonrenewable

and distinctive elements. The existence of a utility patent on a trademark indicates that it is not registrable.

Copyrights protect creative and original literary works, artwork, and music. Copyrights protect the creator's rights for a certain period. The Creator has the right to protection of the copyright, whether a copyright application is filed or not. Copyright sometimes overlaps with trademark rights. For example, the copyrighted titles of books or films can function as trademarks.

Types of Trademarks

As previously stated, a trademark is a word, combination of words or random letters, group of numbers, business name, personal name, surname, domain name, stylized lettering, a stand-alone design mark, slogan, sound, scent, or trade dress, or some combination of these elements as a composite mark. It is used to distinguish the source of a product or service from that of others.

Most trademarks are wordmarks, such as OZ in plain text or logos. Some have stylized typeface; others are slogans like PLAY ON WORDS FOR SUCCESS. A mark's lettering or logos may have sound or motion as a part of the mark. The MGM's roaring lion was one of the first sound trademarks. A logo may be in black and white or in color. When color is claimed as part of the mark, it must always be used in that color; use of a version of the mark in the wrong color will not be protected.

Another type of trademark is trade dress. Trade dress is defined as: "the total image of a product, including features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques."³ There are two versions of trade dress, product packaging or product design. A hint as to whether it is product packaging or product design is that if there is a live utility patent registration for the trade dress sought to be registered as a trademark, the trademark is considered functional and not entitled to registration on the Principal Register. Prima facie evidence of a functional trade dress is if a utility patent exists. Trade dress will be discussed in detail in Chapter 7.

Business or corporate names can function as trademarks if the name is used about the goods and service, not merely on a letterhead or business

³*Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065 (2000).

card. Corporate names are governed by the Secretary of State's office in the state in which the corporation was formed. In the corporate section, there is a corporate name search database containing all the registered corporations formed in that state which is used to find if a corporate name is available for use. Note that the database only has records of companies that were formed or qualified to do business in the state. Many corporate entities do business in more than one state, so filing for authority to do business in a foreign state or states is required. An authorization to do business in a foreign state must be filed in each state that business is conducted in. Business names that are "doing business as" (DBA) filings may also qualify to function as a trademark if they are used on the goods or about the services for which they were created. The governing agencies for this are the county in which the business was established and the Secretary of State's office retains a copy of the records. States are only concerned with a corporate name not being used in that state only. It should be noted that trademarks and corporate entities may both be entitled to be registered as a federal trademark; the trademarks are awarded national rights.

Personal names, surnames, and signatures of persons living or deceased may be entitled to trademark protection if they are used as trademarks. This applies to both fictitious and real names, living or deceased. If an applicant is seeking to register a personal name of a living person, then written consent must be obtained to use the person's name. On the other hand, if the name is fictitious, then a statement in the application needs to be added that it is merely a fictitious name, not the name of any living individual.

Less common trademarks are certification marks and collective marks. Certification marks are used to symbolize a quality or excellence. An example a certification trademark is PC Editor's Choice which certifies a certain quality of products contained in the magazine, rather than the maker. According to TMEP §1304(b), "the purpose of a certification mark is to inform purchasers that the goods or services of a person possess certain characteristics or meet certain qualifications or standards established by another person". A certification mark does not indicate a sole source the way trademarks do. The message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or checked by an objective person or organization, who is not their producer, using methods determined by the certifier/owner. The placing of the mark

on goods, or its use in connection with services, constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.

Collective marks are marks used to show members of a collective organization. Members of the UNITED BROTHERHOOD OF CARPENTERS® or Kosher Symbol U® use the marks.

A trademark that is used in connection with services, rather than products or goods, is called a service mark. The Lanham Act defines “service mark” as follows:

The term “service mark” means any word, name, symbol, or device, or any combination used by a person, or which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this [Act], to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks despite that they, or the programs, may advertise the goods of the sponsor.⁴

Evidence of use of a service mark is somewhat different than a trademark. Service marks use must be shown on the services described in the application for the benefit of someone other than the manufacturer. Acceptable specimens showing use of the service mark on the services are advertising, promotional, marketing or materials from the website showing the nature of the services. It should be noted that a mere domain name does not qualify as a trademark, unless the services provided are clear and the applicant provides information so that consumers may order the services. It cannot be for a service to be used in the future.

⁴*Lanham Act, 15 U.S.C. §1127.*