

UNITED STATES
PATENT AND TRADEMARK OFFICE



Trademark basics for attorneys: Fundamentals and registration

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Images used in this presentation are for educational purposes only.

Discussion topics

- Definitions and types of marks
- Benefits of federal registration
- Selecting a mark
- Federal registration process

Discussion topic

Definitions and types of marks

What is a trademark?

- Legal protection for a brand
- Word, phrase, design, or combination that:
 - Identifies the source of goods and services
 - Distinguishes them from the goods and services of another party

Traditional types of marks

- Common source identifiers:
 - Brand names
 - Slogans
 - Logos

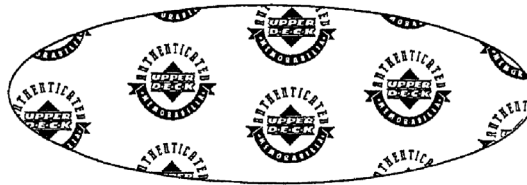
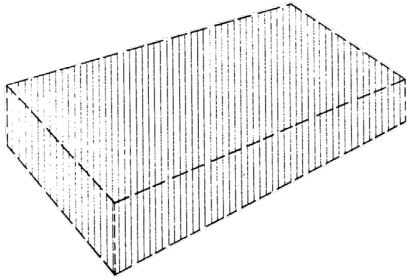
The Coca-Cola script logo, featuring the brand name in its iconic red cursive script.

**IT'S THE
REAL THING**



Non-traditional types of marks

- Anything that functions as a source identifier might be eligible for registration.
 - Sound
 - Color
 - Scent/smell
 - Motion
 - Hologram
 - Configuration/shape





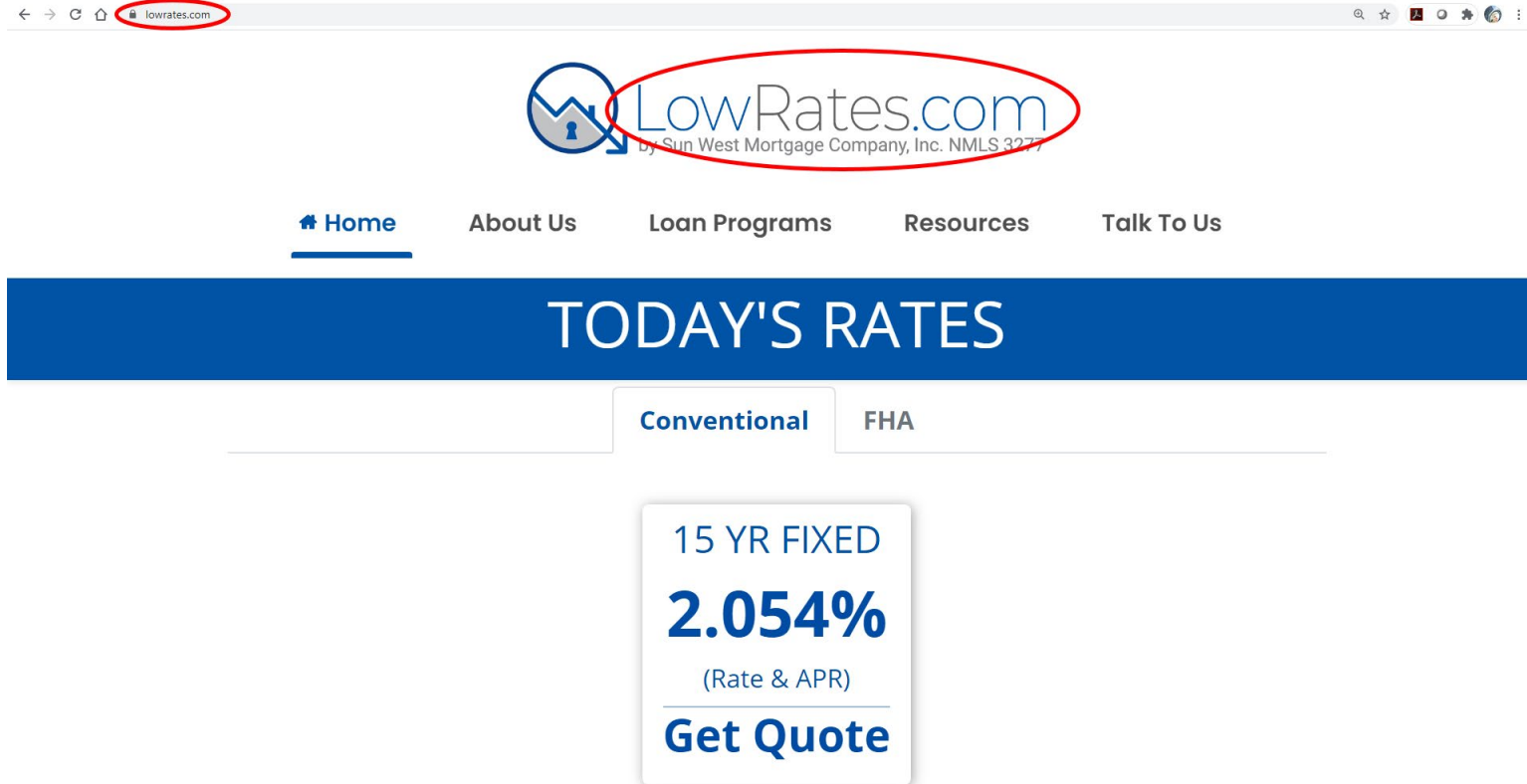
Definitions

- **Patent**
 - Protects an invention.
- **Copyright**
 - Protects an original artistic or literary creation.
- **Trade secret**
 - Protects information that has value because it is not generally known.

Different purposes, different results

- Domain name \neq trademark registration
- Trade name \neq trademark registration

Domain name vs. trademark use



Trade name vs. trademark use



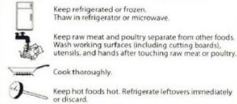
COOKING INSTRUCTIONS

1. Preheat frying pan to 375°F (high).
2. Break up steak into small pieces and place in pan.
3. While cooking, toss and stir with spatula for a few minutes until golden brown.

Raw beef products should be cooked to an internal temperature of 160°F.

Safe Handling Instructions

This product was prepared from inspected and passed meat and/or poultry. Some food products may contain bacteria that could cause illness if the product is mishandled or cooked improperly. For your protection, follow these safe handling instructions.



Try Our Other Tasty
Philly's Best Steak Products
Chicken Philly Sandwich Slices
&
Buffalo Chicken Philly Sandwich Slices

Visit us at www.phillysbeststeak.com

THE PHILLY POUNDER

Premium Beef Sandwich Steaks

SERVING SUGGESTIONS

Philadelphia Style Cheesesteak

Cook Philly's Best Steak Beef Philly Sandwich Slices according to cooking instructions and serve on a fresh Italian roll. Add 3 slices of American cheese. Top with your favorite condiment.

Steak, Egg & Cheese Bagel

Toast your favorite style bagel and add cooked Philly's Best Steak Beef Philly Sandwich Slices, one fried egg and your favorite cheese.

Cheesesteak Stromboli

Pick up your favorite pizza dough and roll out on a sheet pan in the shape of a rectangle. Spread cooked Philly's Best Steak Beef Philly Sandwich Slices loosely over dough. Add shredded mozzarella cheese and Italian seasoning spices. Carefully roll dough into a loaf shape. Tuck the end of dough under loaf. Brush with olive oil and bake at 350°F for 20 - 30 minutes or until crust is golden brown. Serve with marinara sauce for dipping.



MADE IN THE U.S.A.

Nutrition Facts

Serving Size 4 oz. (112g)
Servings Per Container 4

Amount Per Serving

Calories 120 Calories from Fat 50

% Daily Value*

Total Fat 6g 9%

Saturated Fat 2.5g 13%

Trans Fat 0g

Cholesterol 45mg 16%

Sodium 180mg 7%

Total Carbohydrate 1g 0%

Dietary Fiber <1g 2%

Sugars 0g

Protein 16g

Vitamin A 0% • Vitamin C 0%

Calcium 0% • Iron 0%

*Percent Daily Values are based on a 2,000 calorie diet. Your daily values may be higher or lower depending on your calorie needs:

	Calories: 2,000	2,500
Total Fat	Less Than 65g	80g
Sat Fat	Less Than 20g	25g
Cholesterol	Less Than 300mg	300mg
Sodium	Less Than 2,400mg	2,400mg
Total Carbohydrate	300g	375g
Dietary Fiber	25g	30g

Calories per gram:
Fat 9 • Carbohydrate 4 • Protein 4

INGREDIENTS: BEEF, WATER, SOY PROTEIN CONCENTRATE, DEXTROSE, MODIFIED CORN STARCH, SODIUM PHOSPHATE, SALT, ISOLATED SOY PROTEIN, HYDROLYZED SOY PROTEIN, NATURAL FLAVORINGS.
CONTAINS: SOY

Philly's Best Steak Company, Inc.
Yeadon, PA 19050

Discussion topic

Benefits of federal registration

Trademark rights

- Rights can be created two ways:
 - Common law
 - Federal registration



Common law trademark rights

- Rights
 - Created when trademark is used in commerce
 - Limited to geographic area where mark is used
- Symbols
 - Optional: TM SM
 - Never: ®



Federal registration rights

- Rights
 - Created when trademark registers with the USPTO
 - Legal presumption you own the trademark
 - Legal presumption you have the right to use the trademark in all 50 states and U.S. territories (but not other countries)





Federal registration rights

- Rights
 - Can claim notice to the public of your rights in the trademark.
 - Can bring legal action concerning trademark in federal court.
 - Enables recordation of registration with U.S. Customs and Border Protection.





Federal registration rights

- Rights
 - Can be used as a basis for filing in another country.
- Symbols
 - Permitted: ®

Discussion topic

Selecting a mark



Trademark selection challenges

- Remember:
 - The mission of the USPTO is to register any trademark that is eligible for registration.
 - Not every trademark is registrable.
 - Not every trademark is enforceable.
 - Select a trademark that is both federally registrable and legally protectable.



Registrable and protectable

Two main concepts:

- Likelihood of confusion
- Strength of the trademark



Likelihood of confusion

- Confusion as to source:
 - Are the trademarks confusingly similar?
and
 - Are the goods and/or services related?



Likelihood of confusion

X-SEED for “agricultural seeds”

EXCEED for “live plants”



Trademark clearance search

- Basic clearance search:
 - USPTO database
 - TESS (Trademark Electronic Search System)
 - www.uspto.gov/SearchTrademarks
 - The internet
 - Option for searching for common law use

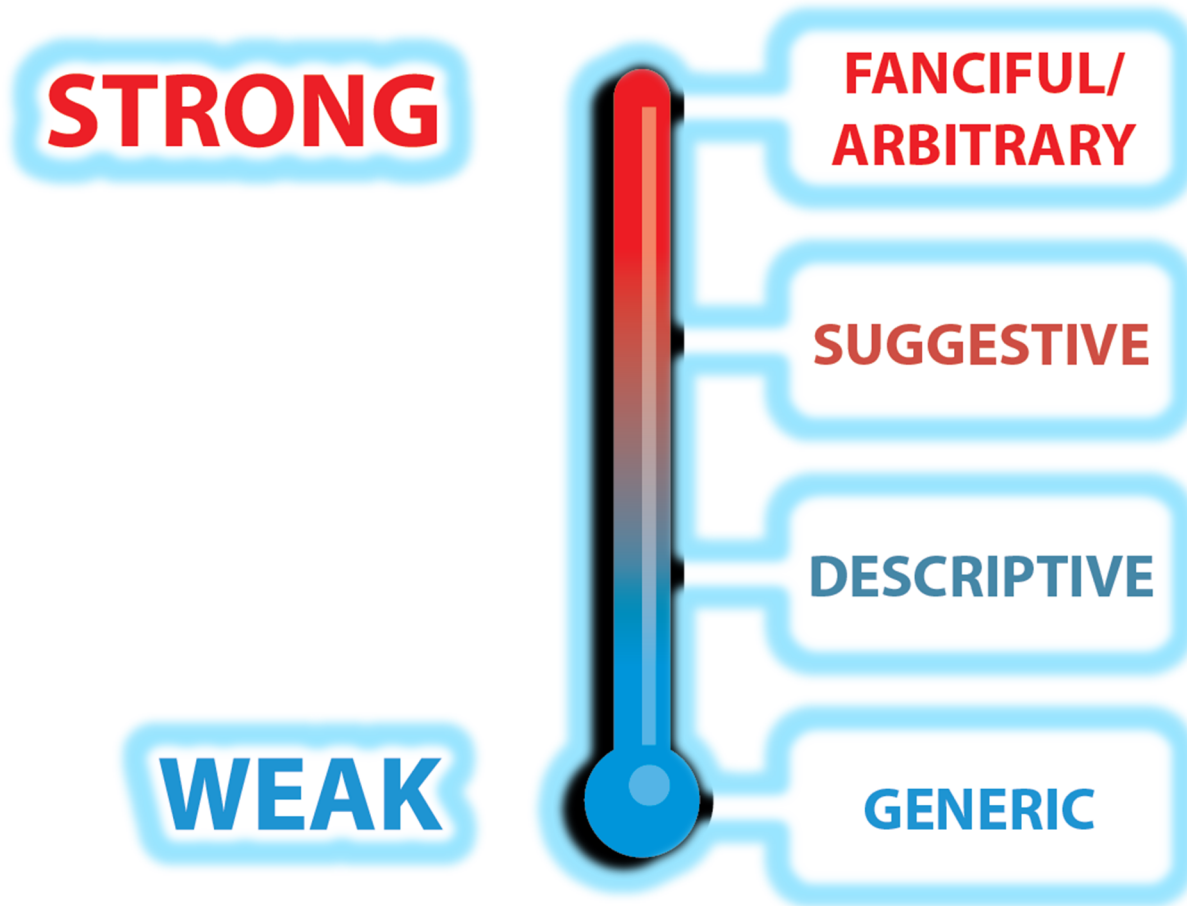




Trademark clearance search

- Full clearance search:
 - USPTO database of registrations and applications
 - State trademark databases
 - Business name registries
 - Foreign trademark databases
 - The internet

Strength of trademark





Strength of trademark examples

- Fanciful
 - XEROX for “photocopiers”
 - KODAK for “cameras”
- Arbitrary
 - APPLE for “computers”
 - GAP for “clothing”



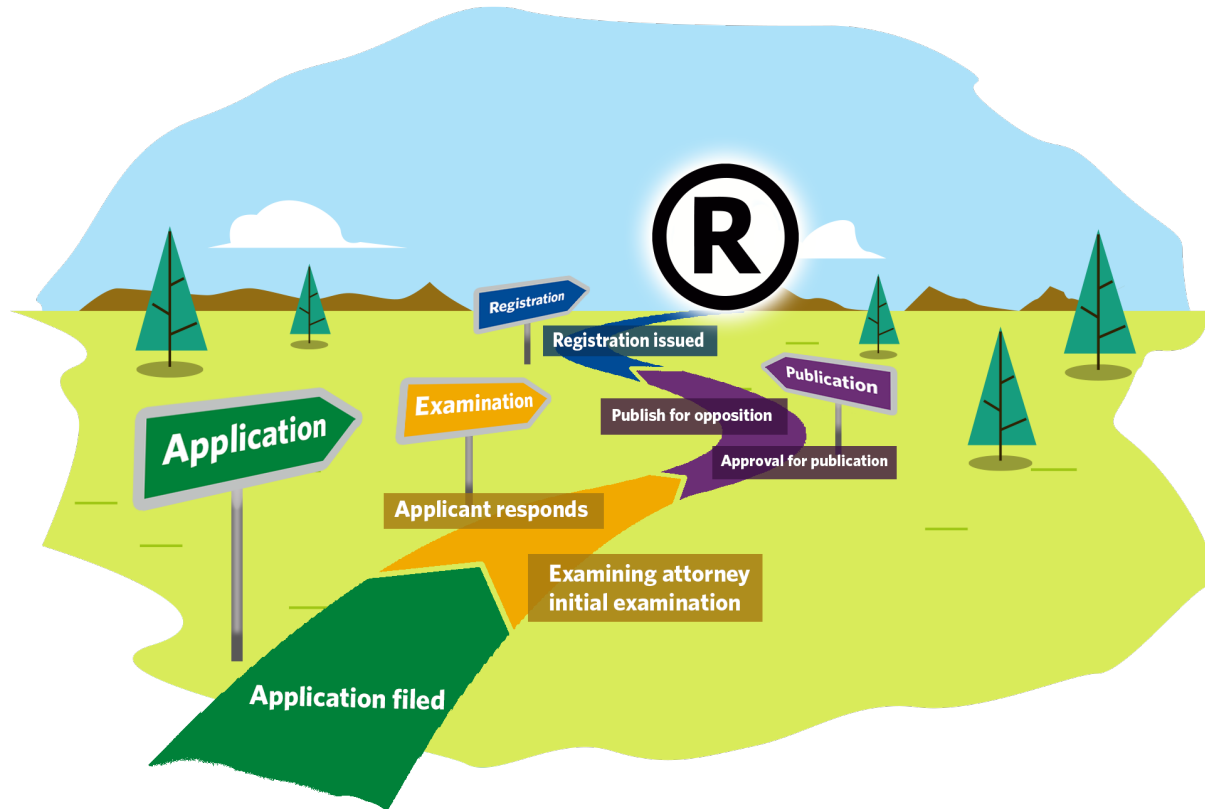
Strength of trademark examples

- Suggestive
 - COPPERTONE for “suntan lotion”
- Descriptive
 - CREAMY WHIP for “whipped topping”
- Generic
 - MILK for “dairy-based beverage”

Discussion topic

Federal registration process

Pathway to trademark registration



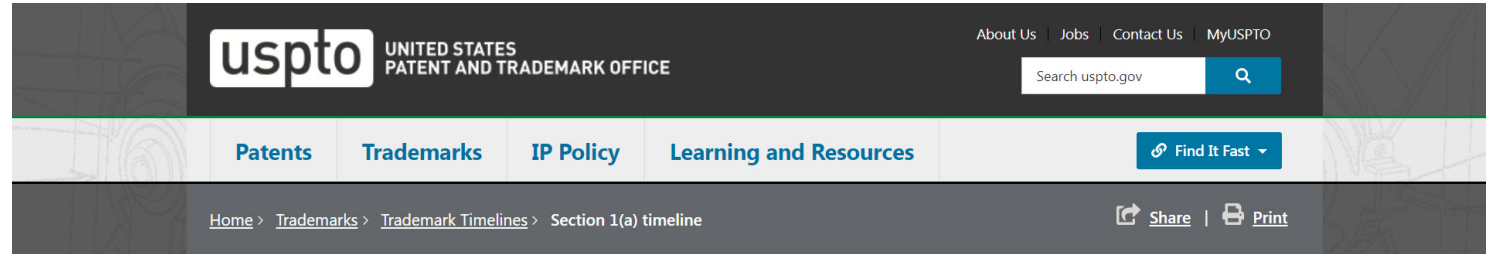


Filing for federal registration

- Common bases for refusal
 - Likelihood of confusion
 - Merely descriptive
 - Geographically descriptive of the origin of the goods/services
 - Specimen does not support use for listed items
 - Trademark used in ornamental manner



Application workflow and timeline



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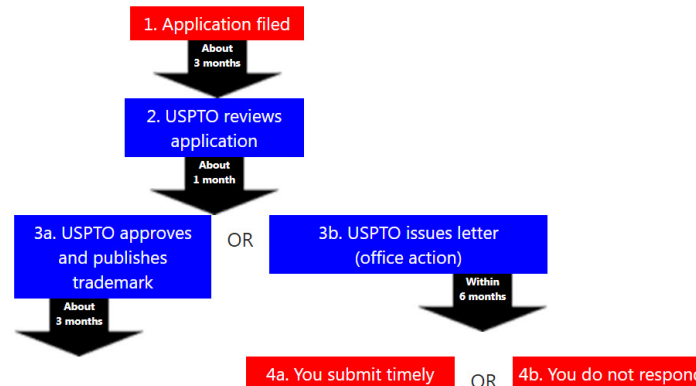
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MyUSPTO

Section 1(a) timeline

Application based on use of your trademark in commerce

Place your mouse over the steps for more information.





Registration responsibilities

- Must enforce your own trademark rights.
 - May use your registration certificate to support a “cease-and-desist” letter.
 - May use your registration to sue an infringing user.
- Must file required post-registration documents with the USPTO.



Questions?

