

Introduction to Trademarks

Trademark Law for the Non-IP Attorney

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Types of Intellectual Property (IP)

- Intellectual Property (IP) Generally Refers to Four Distinct Categories of Property:
 1. Trademarks - Designations Used to Indicate Source of Goods/Services
 2. Copyrights - Protects a Wide Variety of Original Works
 3. Patents - Protects Qualified Inventions for a Limited Time
 4. Trade Secrets - Confidential & Commercially Valuable Information (e.g. Coca-Cola Formula, KFC Recipe, Customer Lists, etc.)

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What Is a Trademark?

- ® Used By Individuals, Businesses, Organizations, and Associations to Identify and Distinguish Their Products/Services and to Indicate the Source of Their Products/Services
 - ® Names
 - ® Logos
 - ® Slogans / Taglines
 - ® Characters
 - ® Symbols
 - ® Colors
 - ® Sounds
 - ® Scents

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Examples of Famous Trademarks

Disney



i'm lovin' it®



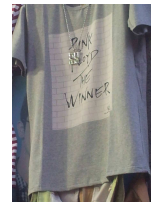
Coca-Cola®



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“Lesser Known” Trademarks



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Every Business Has a Trademark!

- ® Consumers Use Trademarks to Identify and Compare Products/Services, and to Distinguish Between Products/Services
- ® Trademarks Embody the Qualities and Characteristics of the Products/Services with Which They are Used
- ® Trademarks Offer Consumers Assurances of Quality and Consistency (Whether Good or Bad)
- ® MOST VALUABLE ASSETS - Embody the Goodwill and Reputation of the Business or Organization

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Corporation/LLC ≠ Trademark

- ® Forming a Corporation or LLC Provides Limited Liability, **NOT** Trademark Protection
- ® Some Companies Use Their Legal Corporate Names as a Trademark (e.g. McDonald's and Dell)
- ® Some Don't (e.g. BBY Solutions, Inc. and Quality Is Our Recipe, LLC)
- ® Fictitious Name Registrations ≠ Trademark Protection

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How Are Trademark Rights Acquired?

- ® Just Use It!
- ® You Acquire “Common Law” Trademark Rights Where the Trademark is Used (Geographically)
- ® Federal Registration with the United States Patent and Trademark Office Acknowledges and Enhances Prior-Acquired Common Law Rights
- ® Federal Registration is Not the **SOURCE** of Your Trademark Rights
- ® Trademark Is Not a Verb: You Cannot *Trademark* a Name, Only Register It

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Trademark Distinctiveness

- ® Trademarks Are Categorized by Their Strength
- ® More Distinctive Trademarks = Stronger Trademarks = Broader Protection
- ® Trademark Distinctiveness Categories (Weakest to Strongest)
 - ® Generic (Does Not Function as a Trademark)
 - ® Descriptive (U.S. BANK, SPORTS ILLUSTRATED)
 - ® Suggestive (JAGUAR, TIDE, AIRBUS, BURGER KING)
 - ® Arbitrary (APPLE for computers, CAMEL for cigarettes)
 - ® Coined/Fanciful (BUICK, TWITTER, KODAK)

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Why Perform a Trademark Search?

- ® Because You Don't Want to Be Sued for Trademark Infringement
- ® Because You Don't Want to Risk Losing the Goodwill and Public Recognition Associated with Your Trademarks
- ® Because You Don't Want to Spend Time, Money, and Resources Developing a Trademark that Isn't Available
- ® Because You Want to Know if Your Trademark is Eligible for Federal Registration with the United States Patent and Trademark Office ("USPTO")

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What Is a Trademark Conflict?

- ® Purpose of Trademark Search is to Look for Conflicts
- ® Legal Standard for Conflicting Marks is Called “Likelihood of Confusion”
- ® Can Be Highly Subjective
- ® While Several Factors Are Considered for Likelihood of Confusion, 2 Factors Are Determinative in Most Cases
 - ® Similarity of the Marks
 - ® Relatedness of the Products/Services Provided Under the Marks

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Types of Trademark Searches

- ® Common Law Trademark Search
 - ® Reveals Trademarks Being Used But Not Registered
- ® State Trademark Search
 - ® Reveals Trademarks Registered at the State Level
- ® Federal Trademark Search
 - ® Reveals Trademarks Registered with the United States Patent and Trademark Office (“USPTO”)
 - ® Recommended in **ALL** Cases

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The Federal Trademark Search

- ® Conduct “Knockout” Search on the USPTO website (tmsearch.uspto.gov)
- ® This is NOT a Comprehensive Federal Trademark Search
- ® **Obvious Conflict** = Don’t Use or Apply to Register
- ® **No Obvious Conflicts** = Consider Hiring a Trademark Attorney to Perform a Comprehensive Federal Search and Issue Legal Opinion
- ® **Positive Search Results** = Seek Federal Registration of Trademark

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Benefits of Federal Registration

- ® Obtain Exclusive Rights to Use Trademark Nationwide
- ® Prevents Registration of Confusingly Similar Trademarks
- ® Advantages in Trademark Infringement Litigation
- ® Puts World on Constructive Notice of Trademark Rights
- ® Can Prevent Importation of Infringing Products
- ® Obtain Cancellation of Infringing Domain Names
- ® Ability to use the ®

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Trademark Registration Process

- ® Prepare and File Trademark Application at [USPTO.gov](https://www.uspto.gov)
 - ® U.S. Attorney Recommended, Not Required, for Domestic Applicants
 - ® U.S. Attorney Required for Foreign Applications

- ® Trademark Examining Attorney Reviews Application in 3-4 Months
 - ® May Approve for Publication
 - ® May Issue Office Action for Administrative or Substantive Issues - Response Due in 6 Months

- ® Trademark is Published for Opposition by 3rd Parties

- ® Preparation and Filing of Statement of Use (Intent to Use Applications Only)
 - ® If **In Use**, Registration Will Issue After Publication Period
 - ® If **Intent to Use**, Notice of Allowance Issues Instead, With 6-Month Deadline to File
 - ® File Statement of Use *if* Trademark Used in Commerce, or Request 6-Month Extension

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Trademark Advice for Clients

DO:

- ® Conduct a Comprehensive Federal Trademark Search Prior to Adopting New Name/Slogan

- ® Consider Registering Your Most Commercially Valuable Trademarks

- ® Use ™ for Unregistered Marks or ® for Registered Marks

- ® Purchase Domain Names Related to Trademark, Especially Prior to Filing Application (e.g. [trademark.com](https://www.trademark.com), [trademark.net](https://www.trademark.net), [trademark.org](https://www.trademark.org))

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Trademark Advice for Clients

DO:

- ® Reserve Usernames on Social Media (e.g. Facebook, Twitter, YouTube, Instagram)
- ® Use Google Alerts to Monitor Use of Trademark (and What is Being Said About You)
- ® Periodically Use Google Search and USPTO Search to Check for Possible Infringements
- ® Consider Hiring a Trademark Monitoring Company

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Trademark Advice for Clients

DO NOT:

- ® Send Cease & Desist Letters Without Knowing All the Facts
- ® Ignore or Take Lightly Cease & Desist Letters or Other Allegations of Infringement
- ® Adopt, Use, or Attempt to Register a Trademark That Would Dilute the Distinctive Quality of a “Famous” Trademark
- ® Forget Federal Registration Renewal Deadlines
 - ® Years 5-6 from Registration Date
 - ® Years 9-10 from Registration Date
 - ® Every 10 Years After That (e.g. Years 19-20, 29-30)

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Trademark Advice for Clients

DO NOT:

- ® Rely on Results of a Basic USPTO Search (www.tmsearch.uspto.gov)
- ® Delay Registering Your Most Valuable Trademarks (USPTO is First-to-File System)
- ® Use Document Preparation Services for Searches and Registration (e.g. LegalZoom, Trademarkia, Trademark Engine)

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Thank You!

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