



Training Academy Session #14

Introduction to Trademark Practice and Procedures

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Session Overview

1. Understanding Trademarks
2. Applications and Registrations
3. Oppositions, Cancellations and Enforcement
4. Domain Names and Online Enforcement

Understanding Trademarks

Source identifier

- Distinguishes the sources of goods and services
- Protects public's ability to know the source of the goods and services they purchase
- Protects manufacturer's goodwill
- Owner may exclude others from using confusingly similar marks
- Not a verb

Understanding Trademarks

Types of Trademarks

- Trademark
 - Identifies source of goods
- Service mark
 - Identifies source of services
- Collective membership mark
- Certification mark



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Understanding Trademarks

Forms of Trademarks

- Words
 - Designs/Devices
 - Combinations – words and designs
 - Slogans
 - Product packaging
 - Product configurations
- } Trade Dress

Understanding Trademarks

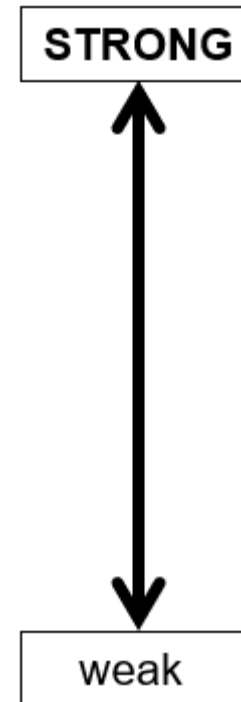
Trade Dress

- Product Packaging
 - Container for goods
 - Motif of business premises
 - May be *inherently distinctive*
- Product Configuration
 - Product design
 - Cannot be functional product feature
 - Product color
 - Requires *acquired distinctiveness, a/k/a secondary meaning*

Understanding Trademarks

Strength of Marks

- Fanciful
- Arbitrary
- Suggestive
- Merely descriptive
 - Acquired distinctiveness
 - Secondary meaning
- Generic



Understanding Trademarks

Trademark Use

- In U.S. rights are use-based
 - No use, no rights
 - *Exception* - Federal Intent-to-Use trademark application

Duration of Protection

- Rights endure *indefinitely* provided use continues, and mark is not abandoned

Applications and Registrations

Clearance

- Trademark rights are somewhat of a monopoly
- Need to ensure no one else has prior rights
- Determine level of risk associated with intended new trademark before adoption

Applications and Registrations

Registration

- U.S. Registration is not necessary, but gives mark owner additional rights
 - Evidentiary tool
 - Can use ® symbol
 - Precludes similar registrations at USPTO
 - Deters infringement

Applications and Registrations

Application Process

- E-file with USPTO
 - Federal "TEAS Plus" trademark applications
 - May reduce filing fees *if* application is *perfect*
 - *Application fees* (per class of goods or services):
 - Range from \$250 "TEAS Plus" to \$350 "TEAS Standard"

Applications and Registrations

Application Process

- Select filing basis:
 - Use in Commerce
 - Intent to Use
 - Foreign Application or Registration
 - Madrid Protocol
- Need registration basis, as well

Applications and Registrations

Application Process

- Federal "Intent to Use" trademark applications
 - "Reserves" ability to use mark exclusively
 - Constructive use
 - Filing date is constructive use date provided mark is registered on the Principal Register
 - Notice of Allowance; Statement of Use
 - Mark must be used no later than 36 months after Notice of Allowance issues

Applications and Registrations

Application Process

- Examination
 - Office Actions
 - Substantive Refusals
 - Likelihood of Confusion
 - Descriptiveness
 - Informalities and Amendments
 - Disclaimers
 - Supplemental or Principal Register

Applications and Registrations

Application Process

- Publication and Opposition Period
 - Extension Requests
 - TTAB Proceedings

Applications and Registrations

Registration and Post-Registration

- Registration Certificate
- Declaration of Use and Incontestability
- Declaration of Use and Renewal Applications
 - *Maintenance fees* (per class of goods or services):
 - \$425 between 5th and 6th year
 - \$525 every 10th year after registration.

Applications and Registrations

State Registrations

- U.S. State Registrations are available
 - Lower application fees
 - Lower maintenance fees every 10th year after registration
 - Registration only effective within a state.
 - Many comprehensive U.S. search reports include state records.
 - State examination process is less comprehensive than federal examination

Applications and Registrations

International

- **Every Country is Different**
- **Convention Priority**
 - Six months to file abroad
 - May unnecessarily limit protection
- **The Madrid Protocol**
 - Makes international *filing* (not registration) easier
 - May reduce costs
 - May unnecessarily limit protection
 - Local counsel will be needed for advanced issues
- **Regional registrations**
 - Community Trademark

Oppositions, Cancellations and Enforcement

Infringement

- Likelihood of confusion
 - Consumer confusion as to source of goods or services
 - Factors
 - Similarity of marks; similarity of goods/services, sophistication of consumers, etc.
- Dilution
 - Famous marks

Oppositions, Cancellations and Enforcement

Remedies for Infringement

- Injunctions
- Damages (Tripled if court deems just)
- Costs
- Attorney fees in exceptional cases

Oppositions, Cancellations and Enforcement

Notice

- TM - If mark is not federally registered
- ® - If mark is federally registered
- Give reasonable notice of claim of protection
- Failure to give notice may affect ability to recover profits and damages in infringement suit

Domain Names and Online Enforcement

Protection of Domain Names

- Uniform Domain-Name Dispute-Resolution Policy (UDRP)
 - The registrant registered the domain name *and* is using it in bad faith
- Anticybersquatting Consumer Protection Act
 - The registrant has a bad faith intent to profit from the mark, and
 - He/she registers, traffics in, or uses a domain name that is identical or confusingly similar to a protected mark

Speakers



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