



Training Academy Session # 24

Trademark Law for the Patent Attorney

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Session Overview

1. Your Trademark Attorneys
2. What is a Trademark?
3. Types of Trademarks
4. Contrast with U.S. Patent Law
5. US Trademark Statute
6. Trademark Registrations
7. International Trademark Treaties
8. Trademark Searches
9. Trademark Enforcement

Your Trademark Attorneys



- Not a Patent Lawyer
- Knows products and services in a multitude of industries.



- Not a Scientist or Engineer
- Jack of All Trades
- Did not take the patent bar

What is a Trademark?

A word, name, symbol, device, or combination thereof that is used or intended to be used in commerce in the United States to identify the source of a particular good or service.

- Right connected to a business
- Protects the public from confusion
- Protects the owner's goodwill
- AKA “mark” or “brand”
- Not a verb.
- Owner may exclude others from using *confusingly similar* marks



What is a Trademark?

A trademark is an exclusive right to prevent others from using your same or similar mark on the same or related goods and services within the same geographic area.

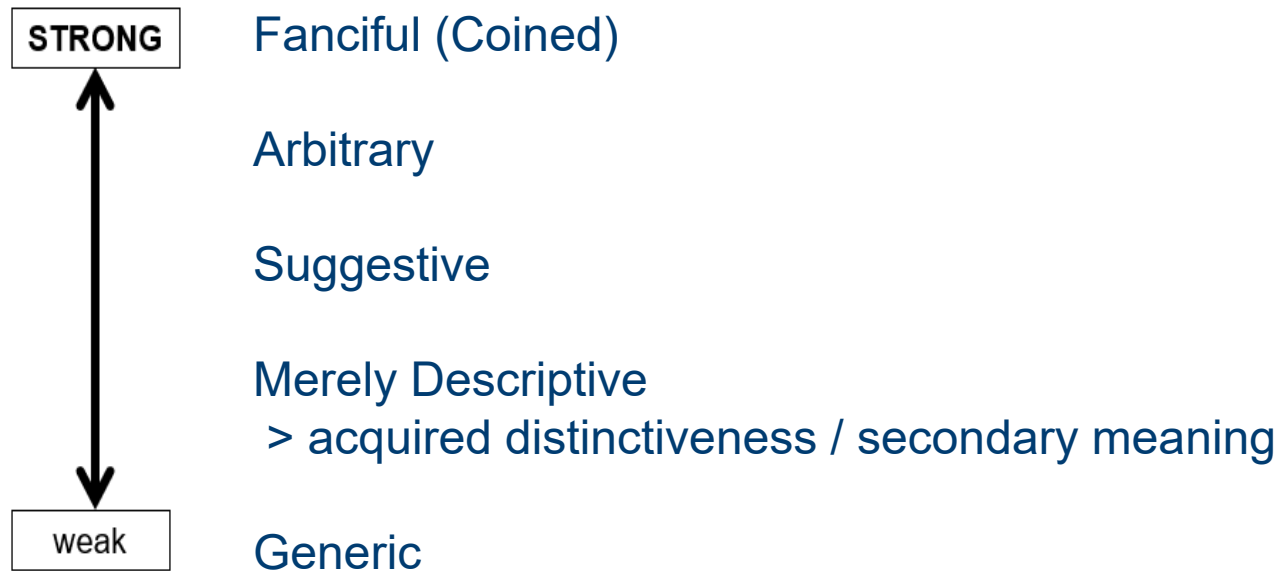
CONFUSINGLY SIMILAR

VOCAB!

- Need to ensure no one else has **PRIORITY**.
- Determine the level of risk associated with an intended new trademark before adoption
- Conduct a search

What is a Trademark?

DISTINCTIVENESS



Types of Trademarks



TRADEMARK identifies the source of goods (products) and services



SERVICE MARK identifies the source of services, specifically



COLLECTIVE MEMBERSHIP MARK identifies goods and services offered by members of a collective group



CERTIFICATION MARK identifies goods or services that meet certain standards set by the owner

Types of Trademarks

TRADE DRESS

Product Packaging

- > Containers for goods
- > Motif of business premises
- > May be inherently distinctive



Product Configuration

- > Product design that is NOT functional
- > Product color
- > Requires acquired distinctiveness



Contrast with U.S. Patent Law

Basics of Patent Law:

- Grant of limited monopoly
 - Not a right to make and sell a product
 - Only a right to exclude others from making, using, and selling products
- Utility patents –
 - Inventions, methods, and ideas
 - New, useful, non-obvious
 - Scope of rights is determined by “claims”
 - Limited duration – 20 years from filing
- Design patents
 - Ornamental designs
 - Scope of rights determined by solid lines in drawings
 - Limited duration – 15 years from grant

U.S. Trademark Law

U.S. Trademark Law is codified at 15 U.S.C. 1051 *et. seq.*

LANHAM ACT

Governs how to register a trademark and how to enforce a trademark

Named after Representative Fritz G. Lanham of Texas

Took effect July 6, 1947, and has been amended over the years

U.S. Trademark Law

A mark used in the U.S. need not be registered to be enforceable.

COMMON LAW

Common Law trademark rights are acquired simply by being the first entity to use a mark on a specific product or service within a particular geographic area.

You can sue for trademark infringement / unfair competition under the Lanham Act.

Can create conflicts in the marketplace, but not in the USPTO.

Impacts searching.

Trademark Notice

TM

Indicates the owner claims trademark rights, whether or not they are registered

®

Indicates the mark is registered in the jurisdiction in which it is used

Notice is NOT mandatory but highly recommended: failure to give notice may affect ability to recover profits and damages in infringement suit

Trademark Registrations

United States Patent & Trademark Office

PRINCIPAL REGISTER reserved for marks that are inherently distinctive or have acquired distinctiveness

SUPPLEMENTAL REGISTER reserved for marks that are not inherently distinctive but are still capable of distinguishing the owner's goods or services from those of another.

Trademark Registrations

United States Patent & Trademark Office

BENEFITS:

- Nationwide trademark rights
- Legal presumption that you own the mark, which moves to the plaintiff the burden of proof that they have priority
- Trademark is listed on the USPTO's register, providing public notice to anyone else searching
- The USPTO will refuse to register any subsequently-filed application for a mark they deem to conflict with yours
- Record your trademark with CBP
- Entitled to use ® trademark notice

Trademark Registrations

In most cases, you must **USE** a mark to own, register, and enforce it.

TRADEMARK USE

Use in commerce means using your trademark in selling or transporting your goods out of state or in providing services to customers who live outside your state.

Trademark Registrations

The USPTO requires proof of use in the form of

SPECIMENS OF USE

A specimen for goods is typically a photograph of the trademark stamped on the actual product or its packaging.

A specimen for services is typically a true copy of promotional materials, such as a web page, on which the trademark is used to promote the services.



Trademark Registrations

You must select a filing basis for any application submitted to the USPTO.

- > Actual use in commerce
- > Intent to use
- > Foreign application or registration
- > Madrid Protocol

Then, you also need a registration basis.

Trademark Registrations

The application process involves a rigorous examination.

In addition to **lack of distinctiveness** and **likelihood of confusion** with a prior applied-for or prior registered mark, the USPTO will refuse to register a mark on the following grounds, among other:

- > primarily merely a surname
- > deceptive matter
- > flag, coat of arms, or other insignia
- > matter protected by statute or convention
- > a living person's name, without consent

Trademark Registrations

The application process involves publication for opposition purposes.

The application is published in the USPTO's **Official Gazette** to allow third parties the opportunity to object to the registration of the applied-for mark.

TTAB

The **Trademark Trial and Appeal Board** is the forum in which to file **oppositions** against a pending application or **cancellation** against an issued registration.

Trademark Registrations

INCONTESTABILITY

A trademark owner can file a Declaration of Incontestability if they can attest that the mark has been in continuous use in commerce for any five-year period after the date of registration on the Principal Register.

May be filed with the Declaration of Use during the 5th to 6th year from issuance date.

Limits the grounds that a third party can raise in a petition to cancel a registered mark.

Trademark Registrations

As long as you continue to use your trademark, you can maintain your trademark rights and your federal registration indefinitely.

Registrations are renewed every 10 years from issuance date.

The USPTO also requires the filing of maintenance documents during the 5th to 6th year from issuance date.

Both types of filing require a **Declaration of Use**.

Trademark Registrations

There is in the U.S. a system for state trademark registrations.

- Local (statewide) protection
- Lower application and maintenance fees
- Less comprehensive examination

International Trademark Treaties

Trademark rights are territorial by country –

There is no “international” trademark, valid throughout the world.

The PARIS CONVENTION allows for a priority filing date.

If you file a foreign application within six months of your U.S. application filing date, your foreign application will be granted the same U.S. application filing date. This works both ways, in all member countries.

The MADRID PROTOCOL makes international filing easier.

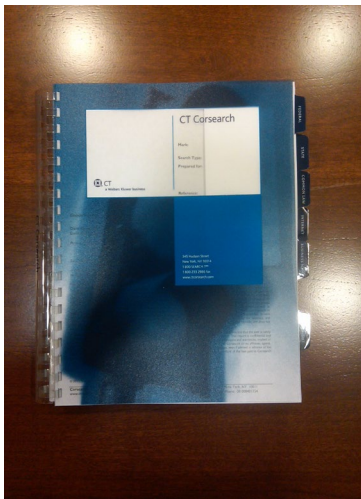
Your U.S. application/registration can be the basis for an “international registration,” but that does not create worldwide rights. It simply allows you to seek to protect your trademark in foreign countries through one filing.

Trademark Searches

Best way to stay out of trouble

- Knock-Out
- Preliminary
- Comprehensive

“You never know what you’re gonna get.” – *Forrest Gump*



Trademark Searches



- Congested market?
 - each member of the crowd is relatively 'weak' in its ability to prevent use by others in the crowd
 - “hemmed in on all sides” by similar marks
 - consumers have learned to carefully pick out one from the other
- Examine differences between: marks, goods/services, consumers, channels of trade, etc.

Trademark Enforcement

Due Diligence and Chain of Title/Assignments

Monitoring

Watch Services

Cease and Desist Letters, public perception

Oppositions

Cancellations

Infringement lawsuits

Trademark Enforcement

Remedies for Infringement

- Injunctions
- Damages
- Costs
- Attorney fees

Insurance

- General Corporate Liability Policy
- Advertising injury
- Insurance may pay for defense if plaintiff demands damages



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