



Training Academy Session # 32

Trademark Law for the Patent Attorney, Continued

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Session Overview

1. Your Trademark Attorney
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
- 10. New USPTO Trademark Center Application System**

Your Trademark Attorney



- 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"
- Owner may exclude others from using *confusingly similar* marks



- Not a verb.

What is a Trademark?

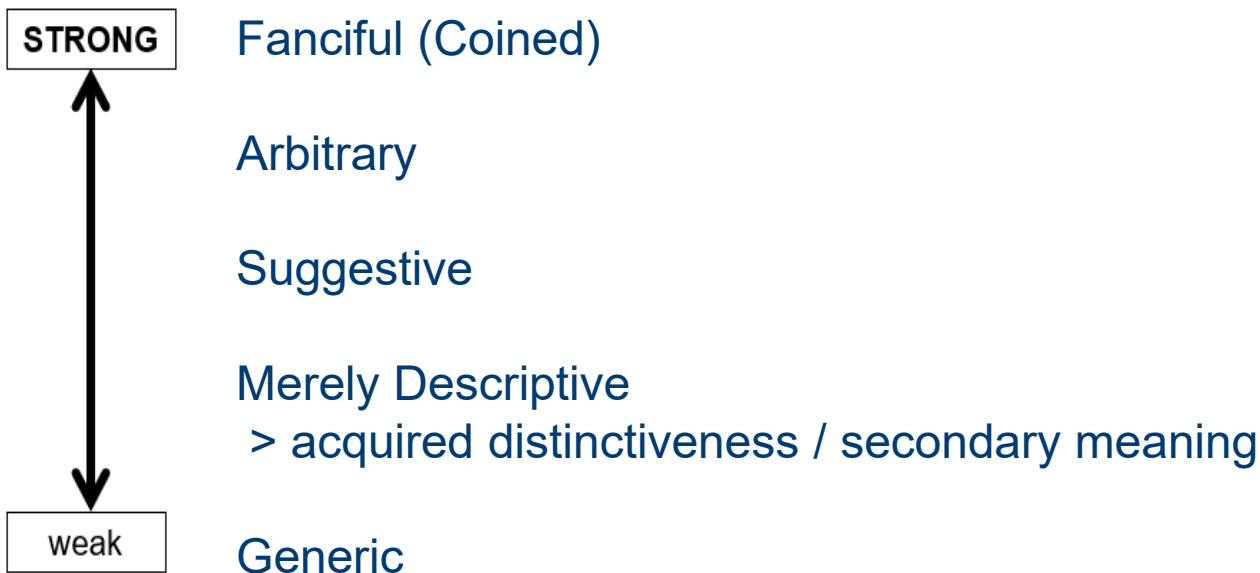
A trademark is an exclusive right to prevent others from using your same or similar mark on the same or related goods and services within the same geographic area.

Prevent a Likelihood of Consumer Confusion

- 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

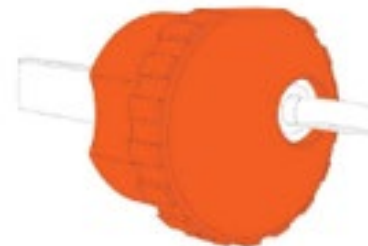
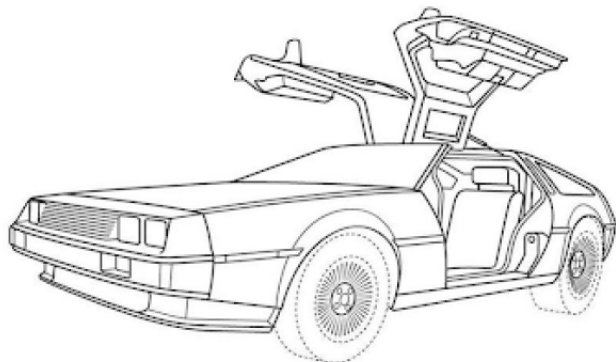
Product Packaging

- > 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:

- **Certificate of proof of 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.

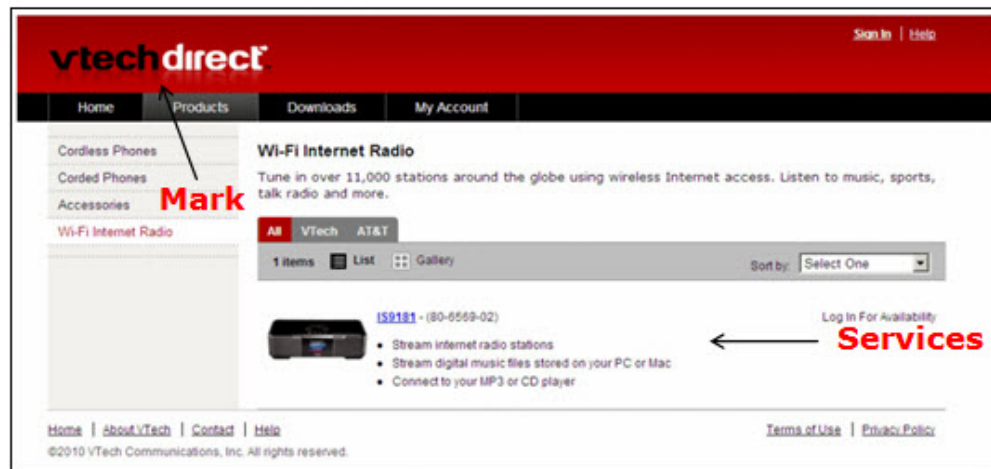
Trademark Registrations

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.

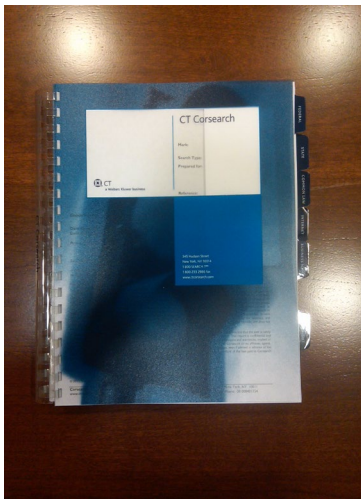
Your U.S. application/registration can be the basis for an “international registration,” but that does not create worldwide rights. It simply allows you to seek to protect your trademark in foreign countries through one filing.

Trademark Searches

Best way to stay out of trouble

- Knock-Out
- Preliminary
- Comprehensive

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



Trademark 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

New USPTO Trademark Center Application System

- Awful.
- Just awful.
- Not designed to benefit the trademark owner.
- Designed to benefit the Trademark Office and Examination Corps.
- Terrible.
- Makes a practitioner's job much more complicated and time consuming.

New USPTO Trademark Center Application System

- Understanding New USPTO Trademark Fees:

| Fee description | Current fee | New fee |
|---|-------------|---------|
| TEAS Standard application | \$350 | n/a |
| TEAS Plus application | \$250 | n/a |
| Base application (Sections 1 and 44), per class | n/a | \$350 |
| Application fee filed with WIPO (Section 66(a)), per class | \$500 | \$600 |
| Subsequent designation fee filed with WIPO (Section 66(a)), per class | \$500 | \$600 |
| Insufficient information (Sections 1 and 44), per class | n/a | \$100 |
| Using the free-form text box instead of the Trademark ID Manual within Trademark Center to identify goods and services (Sections 1 and 44), per class | n/a | \$200 |
| Each additional group of 1,000 characters in the free-form text box beyond the first 1,000 (Sections 1 and 44), per affected class | n/a | \$200 |

New USPTO Trademark Center Application System

- Getting Started:



A note about using Trademark Center

All trademark applications must now be submitted through Trademark Center. Your usage and feedback will help us improve and expand it. For all other filing needs, including all post-application filing, please continue to use the [Trademark Electronic Application System \(TEAS\)](#).

Please carefully review the following before using Trademark Center:

- **Be cautious if anyone contacts you about your trademark.** Your contact information, trademark details, and application status are publicly viewable on our systems. Scammers and private companies often use it to call, mail, or email you, with trademark-related solicitations and scams. This may include posing as the USPTO. See [recognizing common scams](#) to learn how you can protect yourself.
- Once you submit this application, we will not cancel the filing or refund your fee. The fee is a processing fee, which we do not refund even if we cannot issue a registration after our substantive review.
- Trademark applications and registrations are permanent public records, and all information you submit to the USPTO is considered part of those public records, including your name, phone number, email address, and street address. By filing this application, you acknowledge and agree that YOU HAVE NO RIGHT TO CONFIDENTIALITY in the information disclosed.
- Only enter payment information in the secure payment section after submission.

By checking this box, you confirm that you have read the information above and agree to the [terms of use for USPTO websites](#).

I agree

The [Trademark Manual of Examination Procedure, Chapter 800](#) covers all trademark filing options and requirements.

Have you done this before?

If you've never filed a trademark application, we strongly encourage you to check out our [Trademark Basics webpages](#) and read through each section to understand the federal registration process.

New USPTO Trademark Center Application System

- No .obj files to save templates.
- Pro Tip – Create draft applications and save them as “Drafts”

Trademark Center

Home Start application Drafts and docket Sponsorship tool

Drafts and docket

My drafts My trademarks

Showing 1 to 3 of 3 entries

Search my drafts

| Draft name ↑↓ | Mark ↑↓ | Owner name ↑↓ | Docket number ↑↓ | Last modified date ↑↓ | Share | Actions |
|---|------------------------------------|---------------|------------------|-----------------------|---------|---------|
| > Untitled draft (1)_copy (2) | TEMPLATE USE-BASED APPLICATION | [REDACTED] | [REDACTED] | 03/26/2025 | > Share | Actions |
| > Untitled draft (1)_copy (1)_co_cop... | TEMPLATE INTENT-TO-USE APPLICATION | [REDACTED] | [REDACTED] | 03/26/2025 | > Share | Actions |

New USPTO Trademark Center Application System

- Attorney Information:

Trademark application, Principal Register

Application selection **Contact information** Trademark details Goods and services Review and sign Pay and submit

Application selection

Contact information

→ Attorney information

✓ Owner information

✓ Correspondence information

Trademark details

Goods and services

Review and sign

Pay and submit

Attorney information

(*) asterisk denotes a required field.

Warning

If you make any changes, the signer must re-sign the application. You'll need to generate and forward a new email link by returning to the **Declaration and signature** page and completing the information again.

[Import my info from MyUSPTO account](#) [Clear form](#)

First name *

Middle name or initial

Last name *

Your total cost
\$350
[Show summary](#)

New USPTO Trademark Center Application System

- Adding Trademark:


Mark selection 

(*) asterisk denotes a required field.

Warning

If you make any changes, the signer must re-sign the application. You'll need to generate and forward a new email link by returning to the **Declaration and signature** page and completing the information again.

[Hide explanation](#)

 **What is a trademark?**

A trademark can be any word, phrase, symbol, design, or a combination of these things that identifies your goods or services. It's how customers recognize your goods and services in the marketplace and distinguish them from the competition.


Your application must include a clear representation of your trademark. This is called a "drawing." Your drawing can be stylized wording like a slogan, a design, a combination of these, or even just the wording of your mark without any particular design or stylization.

These [trademark examples](#) may help you determine which format to register.

Which format of your trademark do you want to register?*

I want to protect wording alone
Standard character format

The standard character format protects wording, such as your brand name or slogan, regardless of what font style, size, or color you use. The mark can consist of only [words, letters, numbers, or symbols](#). You can't upload an image.

 *This option provides the broadest scope of protection for your wording.*

I want to protect what my trademark looks like
Stylized wording and designs

This option includes designs of visual elements, stylized text, or a visual element with text. Image upload is required.

Examples:






 *Protection will be limited to this specific depiction of your mark.*

I want to protect something else (uncommon)
Other formats

This option includes three-dimensional product design and packaging, sound, motion, color, sensory, and other non-traditional formats.

 *These trademark formats are used infrequently and have highly technical application requirements.*

New USPTO Trademark Center Application System

- Adding Goods/Services:

Search the Trademark ID Manual to select your goods and services

Choose terms that the general public would recognize and use to describe your goods or services. Don't select something that is just similar or "close enough." See [tips and resources](#) for finding an identification.

non-downloadable software 







Can't find the right goods or services in the ID Manual? You can write your own identification for an additional cost. If you choose to [write your own identification](#) the cost of each class in the application will increase by \$200, even if you selected some or all of your goods and services from the Trademark ID Manual. There is also an additional fee of \$200 per 1000 characters that applies after the first 1000 characters.

Search results

 Detailed view

Sorted by Relevance 

Displaying 51 to 60 of 94 results

| Class | ↑↓ Description | ↑↓ Action |
|---|--|--|
| 042  | Providing on-line non-downloadable software for specify the function of the programs, e.g., for |  Add Notes |
| 042  | Providing online non-downloadable game software for playing indicate type of game, e.g., treasure hunting |  Add Notes |
| 042  | Providing online non-downloadable software development tools for creating blockchain-based applications provided by a blockchain as a service (BAAS) provider |  Add |

New USPTO Trademark Center Application System


- Adding Goods/Services:

Want to save money and avoid processing delays? Switch back to [using only the Trademark ID Manual](#) to add your goods and services. Any free text identifications you've entered will be lost.

Trademark ID Manual

Free-form entry

Add free-form entries

Select a class 

Select a class

Add your goods and services separated by semicolon and space (up to 2000 characters at a time)

Add entries

New USPTO Trademark Center Application System

- Assigning Filing Basis:

What goods does this specimen apply to?

- Information technology consulting relating to computer software design
- Computer software consulting
- Consultation services relating to computer software
- Technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services
- Consulting services in the field of cloud computing
- Computer services, namely, integration of computer software into multiple systems and networks
- Computer systems integration services
- Data migration services
- Customizing computer software
- Developing customized software for others
- Cloud computing featuring software for use **in database management and student information systems for higher education institutions**
- Platform as a service (PAAS) featuring computer software platforms for **database management and educational data systems**

Save specimen

Date of first use anywhere * ⓘ

Date of first use in commerce * ⓘ

For website screenshots, capture the URL and date of access in the screenshot or provide them below.

URL

Date of access

What goods does this specimen apply to?

- Business management consulting and advisory services
- Business management consultation
- Consulting services in business organization and management
- Business management consultation in the field of **database management**
- Business consulting services in the field of organizational change management
- Business project management services
- Business process re-engineering services
- Business consultation in the field of business process improvement and enterprise architecture development
- Business consultancy services for digital transformation
- Business consulting services for digital transformation

Save specimen

Speaker



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PANITCH
Intellectual Property Law
SCHWARZE



PANITCH TRAINING ACADEMY

Insights From Leaders In IP Law

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<https://www.panitchlaw.com/panitch-training-academy-sessions/>