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SLO TECH NETWORKING

OVERVIEW OF TRADEMARKS

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Q #1: What are “trademarks”?

A trademark (or “service mark,” in the case the subject is services and not tangible goods) is “anything that acts to identify a product or service *as originating from a particular source.*” A “brand.”

Q #2: What kinds of things could qualify as a trademark?

A: Many kinds:

- words (“NIKE”)
- visual designs (still or moving) (the Nike “swoosh”)
- slogans (“Just do it”)
- colors (individual (pink insulation), or combinations (sports teams))
- sounds (Windows startup chime)

shapes of product or packaging (Coca-Cola bottle)
elements of interior/exterior design of businesses or buildings

Q #3: Can *any* word/design/slogan, etc. that I might use qualify as a trademark?

A: No. Examples of things that are *not* trademarks, or at least not protectable by trademark registration:

The name of the business *itself* (although in the case of services, the name of the business can *also* qualify as a trademark, depending on how it is used in front of the public.)

The common name of the subject good/service (“SHOES”)

Merely descriptive of the good/service (“GOOD SHOES”)

Merely provides information about the good/service (“PROUDLY MADE IN THE USA”)

Merely geographically descriptive (“CENTRAL COAST SHOES”)

Textual or visual *content* (text or artwork on individual t-shirts, vs. on the label of all)

Things, or elements of tangible things, that perform a *function* (as would need to qualify for a patent.)

Things, or elements of tangible things, as are purely *ornamental*, i.e., *not* used as an indicator of source, such as if the ornamental element were used across a whole line of products.

The title of a *single* creative work (book, song, movie, etc.)

Deceptive, immoral, etc.

Includes the name of, or falsely suggests association with, a person/organization

[quite a few more exceptions, mostly narrow...]

Q #4: Does my use of something have to be absolutely the first use of it?

A. No, just the first to have made qualifying use of it within your particular market space, i.e., to describe the source of your particular good/service to the customers you serve. It is not like a patent, where it has to be novel. There are sometimes many registrations granted by the Trademark Office for exactly the same word or phrase, but each is will be found to be for market spaces that are sufficiently different from each other such that the relevant consumers would not be confused.

Q #5: Do I have to register my trademark anywhere? How can I protect them?

- a) No, in the US at least, the first person merely to *use* a mark in the qualifying manner
- b) within a given field of use and in the applicable geographic market has the prior right protectable by gov't lawsuit, ("common law," i.e., not by any particular government statute). It does not have to be *registered* with any gov't entity. No fees required.

(Well, don't do *absolutely* nothing: Always put the "TM" on it (but not the ®; see below). Always use it *as a brand*, e.g., prominently, consistently, not just as name of business, etc.; see above.)

Also, if you have used something, and someone else later uses it and registers it, your "common-law" rights mean you win, even if you had *not* registered it.

BUT...you do get *more* rights by...

b) ...Government registration.

1) *Federal* registration. Advantages:

- i. Stronger lawsuit rights (Federal vs. State law and courts; higher damages available.)
- ii. Others (potential adversaries *and* allies) have better means of finding owner, seeing your solid, pre-existing rights.
- iii. Entitle you to use the ®, instead of just the generic "TM."
- iv. Registration gives solid rights in ICANN domain-name arbitration.
- v. Supports having infringing goods from abroad seized by U.S. Customs.

Disadvantages: Cost (a few *thousand* \$\$s). Takes about a year. Sometimes overkill for a business with limited geographic reach.

2) *California* (or other State) registration. Advantages:

- i. Much cheaper (only a few hundred \$\$s in CA) than Federal registration
- ii. Much quicker than Federal (a month in CA)
- iii. Somewhat stronger lawsuit rights than just common law
- iv. Is sufficient to give *some* rights in ICANN domain-name arbitration.

Disadvantage: Protection only within the state issued, so not much use for anything sold or delivered over Internet. No Customs rights

3) *Foreign* registration, etc..., if any use outside US.

Note: Unlike government protection of *patents*, which are for only a fixed term (currently 20 years), trademark registrations can be maintained indefinitely, so long as the mark continues to actually be used, and as long as the required periodic filings continue to be made (once every 5/10 years).

Also note: Registration, even if granted by the government, does not give you rights over somebody who had been actually using it earlier, even if they had never registered it.

c) Also, protect your marks by *contract*, with your customers, business partners, etc..

Q #6: Could *my* business be misusing someone *else's* trademarks? How can I protect myself?

A: Unfortunately, quite probably yes....

Red flag: Almost *any* use by your business of a brand or business name you already know is being used by someone else in your field represents likely exposure. Doesn't necessarily mean you *can't*, but is a warning sign to investigate further before doing so.

Problem areas in tech: Competitor's trademarks as metatags, adwords

As to potentially infringing on marks of which you are *not* already aware, before you do start using something as a brand, *search*:

If the brand/mark you are considering is a *word*:

Search the Internet (using all search engines) for any uses, as will find marks, of your contemplated mark; investigate them *all*.

Search for U.S. registered marks: uspto.gov, TESS search system

Consider hiring a professional search company to find unregistered uses (dubbed a "common-law search"), especially if it is a good/service as to which perhaps not all providers in the relevant market space would be expected to have a web presence. Professional common-law searches cover such sources as local telephone directories, business directories, etc..

If the brand/mark you are considering is a *graphic* or something other than words:

Searches for *non-word* marks are not as simple, and results not always reliable, as there is considerable subjectivity

Search for U.S. registered marks: uspto.gov, TESS search system.

Consider proceeding directly to the professional search, to find both registered and unregistered uses.

Mr. Mistretta is the principal of The Law Offices of Kim Mistretta. His 34 years of practice have consisted mainly of advising businesses (at present mostly in computers, aerospace, and other technology areas) on their corporate, employment, contract, intellectual property, and real estate matters. He is a member of the Intellectual Property, Business Law, and Real Property sections of the State Bar of California. He is a graduate of the University of Southern California (A.B. Magna Cum Laude 1974 Economics; Juris Doctor, 1977). * Mr. Mistretta does not hold a *patent* license, so everything above relating to patents is intended as general information only, and licensed patent counsel must be consulted for any definitive advice.

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