

Vinson & Elkins
Established 1917

TRADEMARKS

Overview






Trademark:

- **A symbol used in commerce to indicate the source of a good or service**
 - Goods → Trademark TM
 - Services → Service marks SM
- **Trademark “form” – a sign, word, figure, label, sound, scent, color, or slogan that a person or business uses to identity their goods or services**
- **~ *Branding***

TRADEMARKS

OVERVIEW

TM Type	Example
<i>Word</i>	Coca-Cola
<i>Logo</i>	
<i>Slogan</i>	JUST DO IT.
<i>Product/ Packaging Design</i>	

TM Type	Example
<i>Scent</i>	"Flowery Musk Scent" in Verizon Wireless Stores
<i>Color</i>	
<i>Sound</i>	Taco Bell "Bong" 

TRADEMARK

HOW TRADEMARK RIGHTS ARE ACQUIRED

Common-Law Rights (State Law)

- Step 1: Pick a name
- Step 2: Do a search
- Step 3: Use the name for goods/services

You have common law rights.
(limited to a geographic area)

Lanham Act 15 U.S.C. 1051-1141 (Federal Law)

- Step 1: Pick a name
- Step 2: Do a search
- Step 3:
 - (a) Use the name for goods/services and file an application, or
 - (b) File “Intent-to-Use” application
- Step 4: Prosecution
- Step 5: Maintain/Enforce

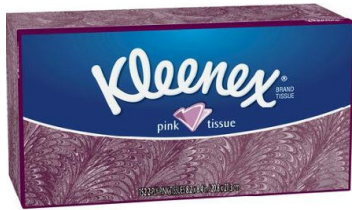


Benefits of Federal Registration:

- Nationwide Protection
- Constructive Notice of Right to Use
- USPTO will refuse later-filed applications that are “confusingly similar”
- Ability to use ® symbol
- Ability to prevent importation of infringing goods
- Can be used as a basis for obtaining registration in a foreign country

TRADEMARK

STEP 1: PICKING A NAME



Fanciful – An invented word- usually doesn't have a dictionary meaning

Arbitrary – has a dictionary meaning, but is unrelated to your products or services

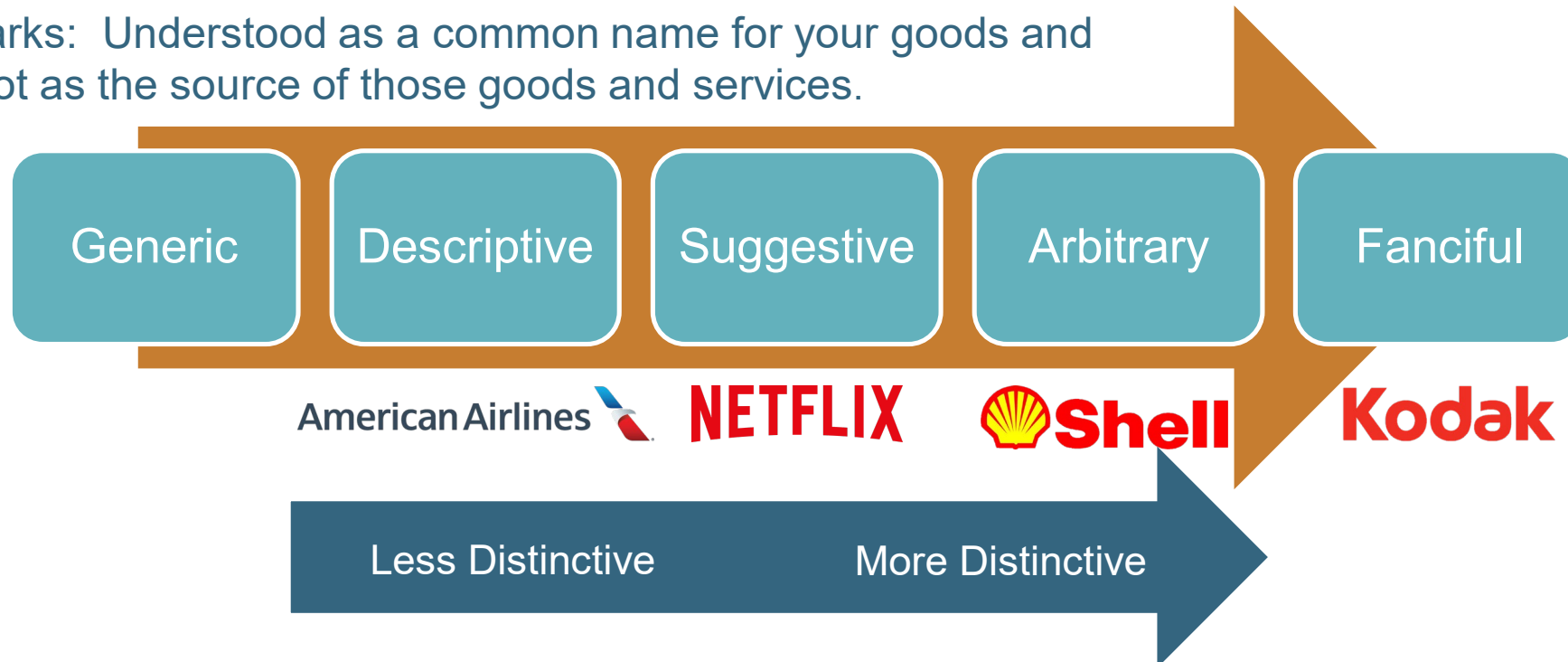
Suggestive – almost describes a feature of your goods or services, but requires an imaginative step

Descriptive – has a dictionary meaning that describes a feature of your goods or services

TRADEMARKS

STRENGTH OF A MARK

- More Distinctive = Stronger
- Inherent Distinctiveness v. Acquired Distinctiveness
- Principal v. Supplemental Registers
- Descriptive Marks require **secondary meaning**.
- Generic Marks: Understood as a common name for your goods and services, not as the source of those goods and services.



TRADEMARKS

PROHIBITED MARKS

Marks prohibited from being a trademark

- Marks likely to cause confusion as to source with a previously used or registered mark
- Deceptive matter
- Functional matter
- Matter that falsely suggests a connection with a person or institution
- Government insignia
- Names, portraits, and signatures identifying particular living individuals without their written consent

Recent Cases Allowing Registration

- *Matal v. Tam* (2017)
- *In re Brunetti* (Fed. Cir. 2017)



TRADEMARKS

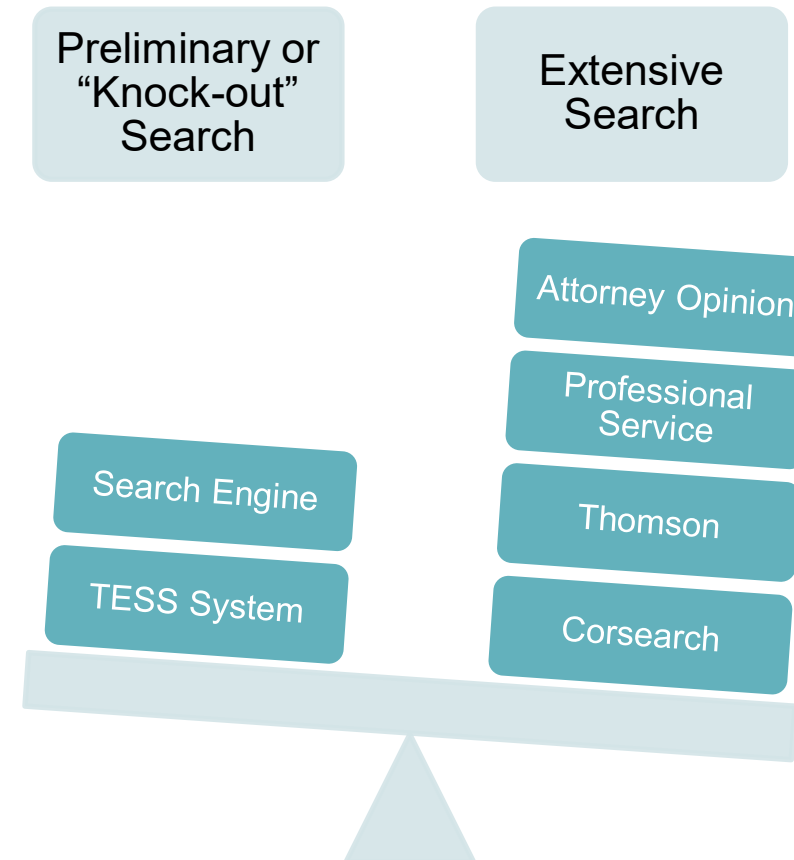
STEP 2: PERFORMING A SEARCH

Not Required, but:

- Note that filing fees are nonrefundable
- May ease prosecution/registration
- May avoid confusion/improve protection
- May avoid litigation

Two Types of Searches:

- Preliminary Search
- Extensive Search



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STEP 3: FILING AN APPLICATION

Two Types of Applications

- Mark not yet in use
- “Placeholder” to protect your mark
- Must show use of the mark on your goods or services within 3 years of Notice of Allowance

Intent-to-Use

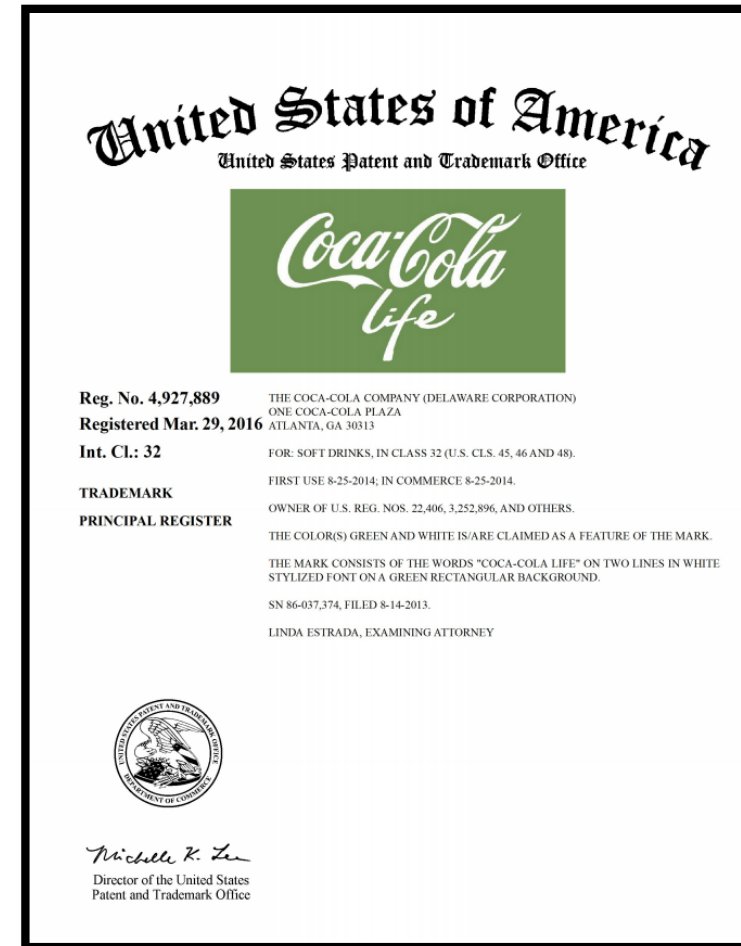
Use-in-Commerce

- Mark is in use on products or services in U.S. Commerce
- Must disclose when first started using the mark
- Must submit specimens (i.e. evidence) of use

TRADEMARKS

STEP 4: PROSECUTION

- Office Actions
- Amendments
- Publication in *Trademark Official Gazette*
- Opposition Period
- Trademark Trial and Appeal Board (TTAB)
- Certificate of Registration (Use-based application)
- Notice of Allowance (ITU application)
- File Statement of Use or Extension Request



TRADEMARKS

STEP 5: MAINTENANCE

- **You periodically need to renew a trademark registration to keep it**
 - Between 5-6 years after date of registration, you must file evidence of use of your mark in commerce for the goods/services in the registration
 - Must do this again between 9-10 years after date of registration, and every 10 years afterward
- **Common law marks: use it or lose it**
- **Check Trademark Status and Document Retrieval (TSDR) website periodically**
- **Ensure that contact information is up to date**
- **“Courtesy” Electronic Reminders on Day 1 of filing period for maintenance documents**
- **Failure to file can result in cancellation of registration**

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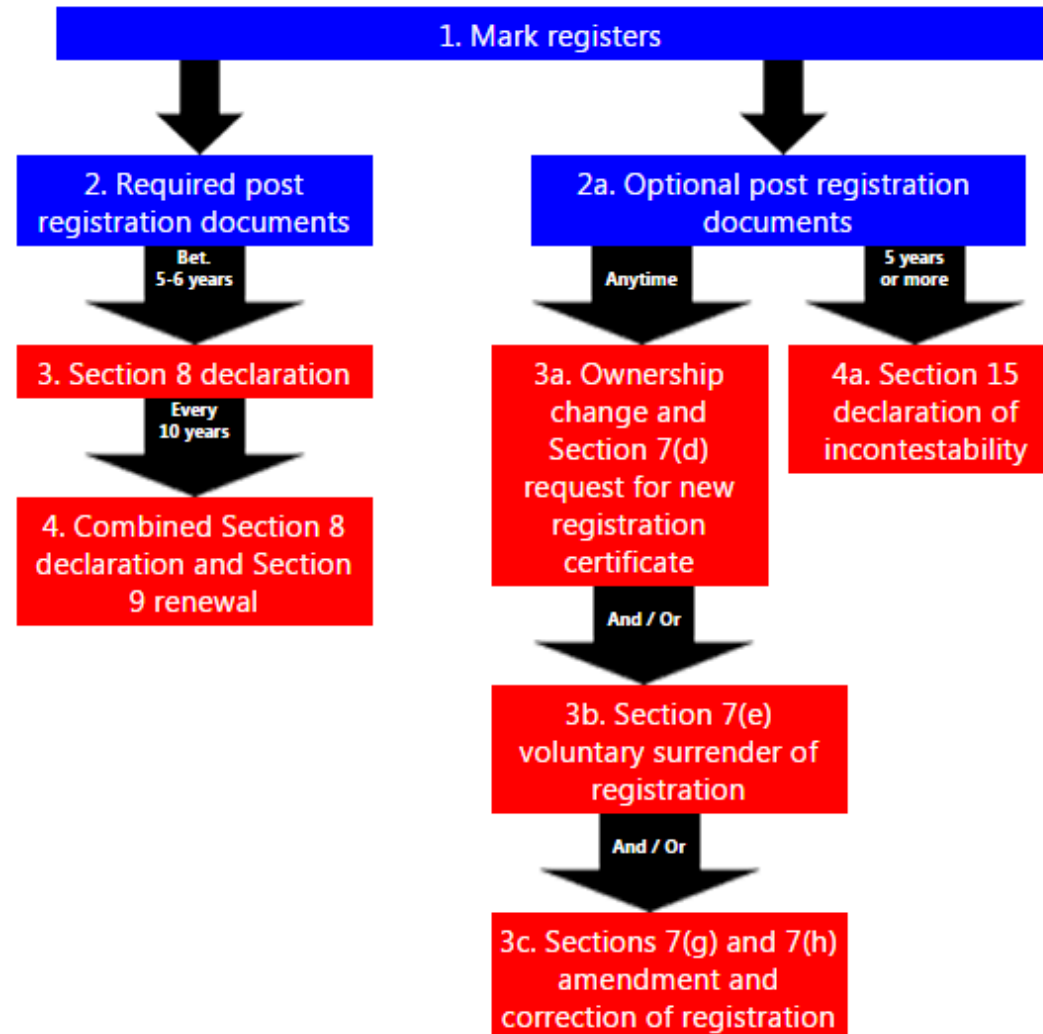
STEP 5: MAINTENANCE

- Must continue to use the trademark in the **same way** you registered it
 - Word mark: You can change the font/size/design of the words
 - Design mark: More stringent rules. You cannot make material changes to the design
- You are required to monitor renewal deadlines and timely file renewal documents



TRADEMARKS

STEP 5: MAINTENANCE



TRADEMARK

STEP 5: MAINTENANCE - HOW TO USE YOUR MARK

COLOR

Microsoft software

QUOTATION MARKS

“Microsoft” software

ALL CAPITAL LETTERS

MICROSOFT software

LARGER-SIZED PRINT

Microsoft software

INITIAL CAPITALS

Microsoft software

DISTINCTIVE PRINT

Microsoft software

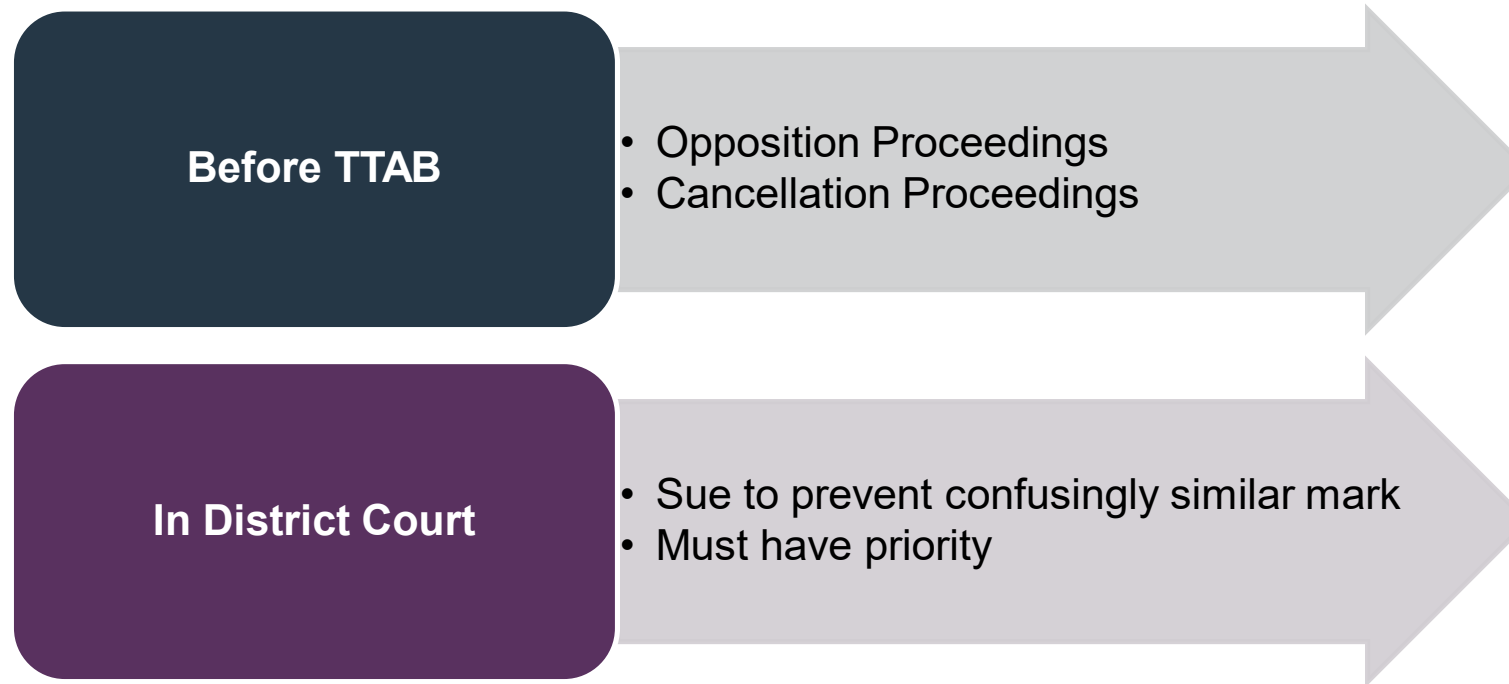
USE THE SYMBOLS ® OR TM/SM

Microsoft®

PROSECUTION PRACTICE

STEP 5: ENFORCEMENT

- Failure to enforce may result in loss of rights
- Two methods of enforcement:



TRADEMARK MODERNIZATION ACT OF 2020

EFFECTIVE DECEMBER 18, 2021

New Procedures

- Expungement for nonuse
- Reexamination proceeding

Changes to Existing Procedures

- New ground of expungement for TTAB cancellation proceeding
- Three-month response period for office actions
- Letters of protest

Other Rule Changes

- Attorney designations that are mistaken, false, or fraudulent
- Court orders concerning registrations