Trademark Basics for Business

- Whopper® burger
- Chuck Taylor® shoes
- F150® truck
- Just Do It® t-shirts

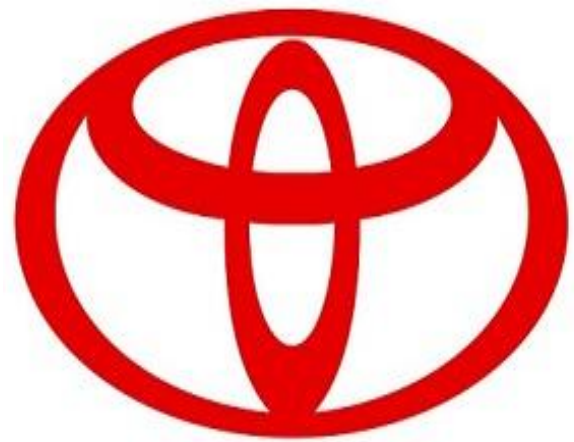
- Burger King
  - Converse
    - Ford
    - Nike



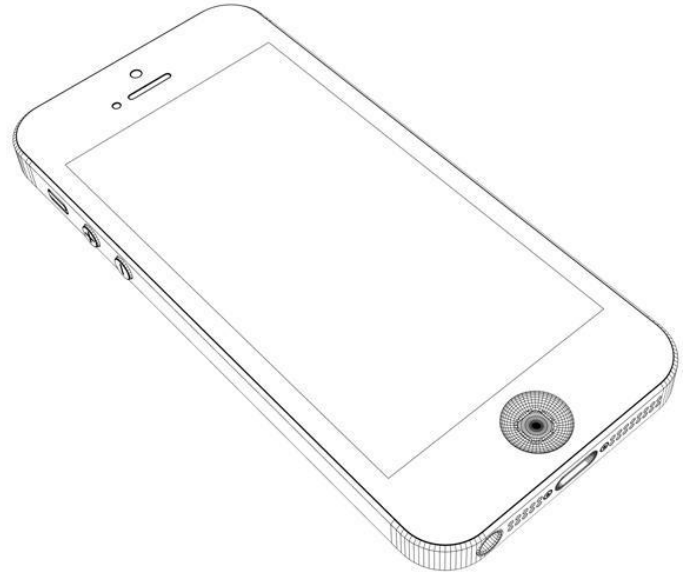




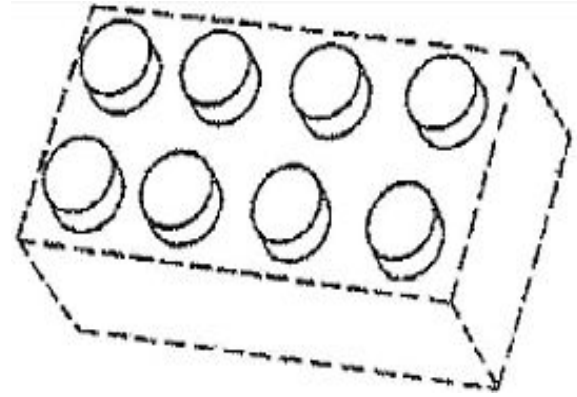








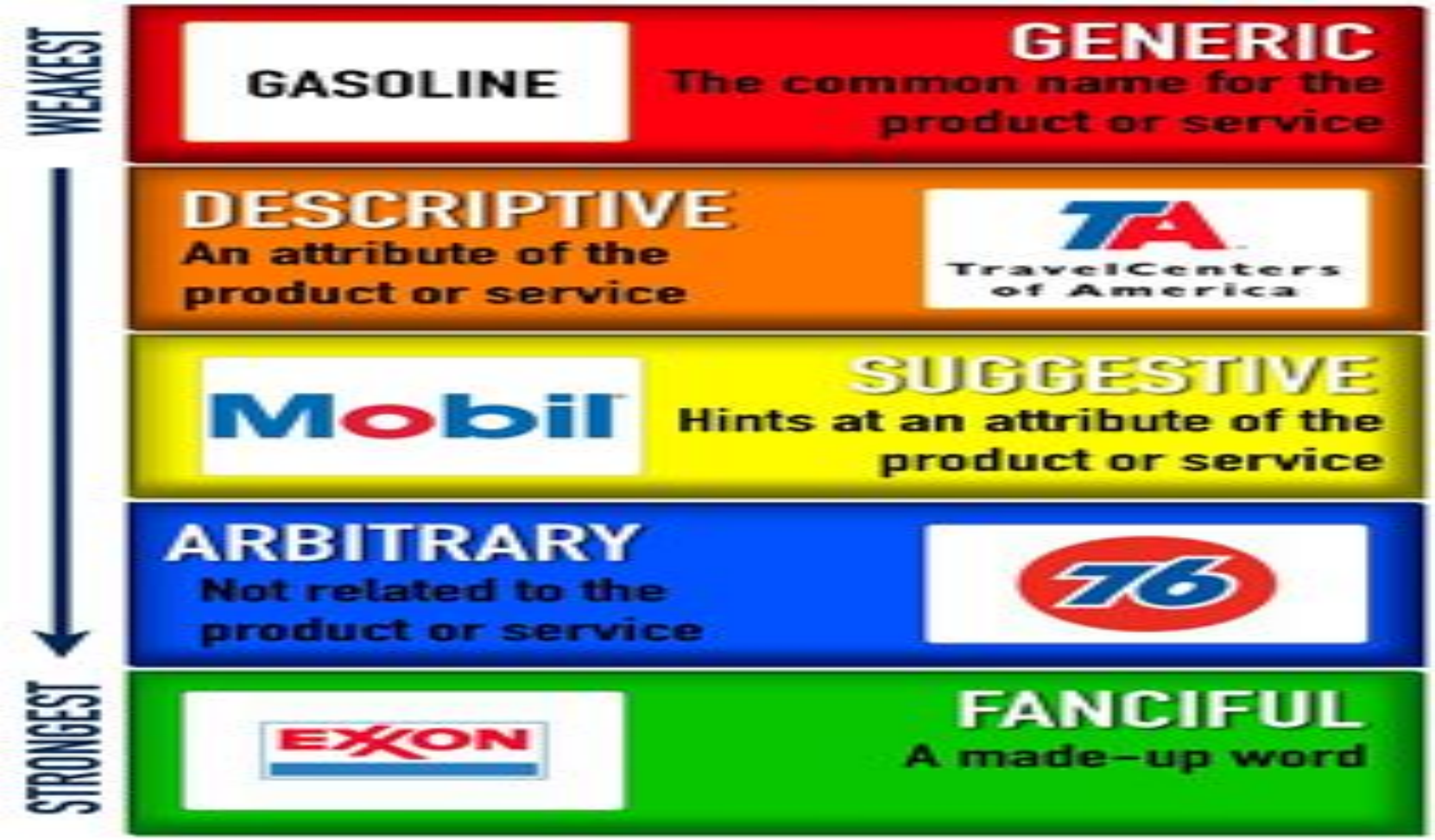




What Is A Trademark?

- Symbol used in commerce to indicate source of good or service
- Takes form of word, phrase, design and/or image
- Can last forever if mark continues to be used

Strength of a Trademark



Why Register a Trademark?

- Nationwide Protection
- Constructive Notice of Right to Use
- Refusal of Later-Filed Applications That Are “Confusingly Similar”
- Ability to use ® symbol
- Can obtain registration in a foreign country
- Statutory damages and attorneys’ fees available in federal litigation relating to infringement

Trademark Process

- Search
- File
- Maintain



Trademark Search

- “Knockout Search”
  - TESS (Trademark Electronic Search System)
  - Search Engines
- Extensive Search
  - Use Search Service
  - Attorney Opinion



Determine Before You File:

- Type of Mark
- Description of Goods/Services and Respective Classes
  - ID Manual
  - *Nice* Classification System
- Use-Based vs. Intent-to-Use
  - Specimens of Use
  - *Bona fide* Intent to Use
- Type of Application



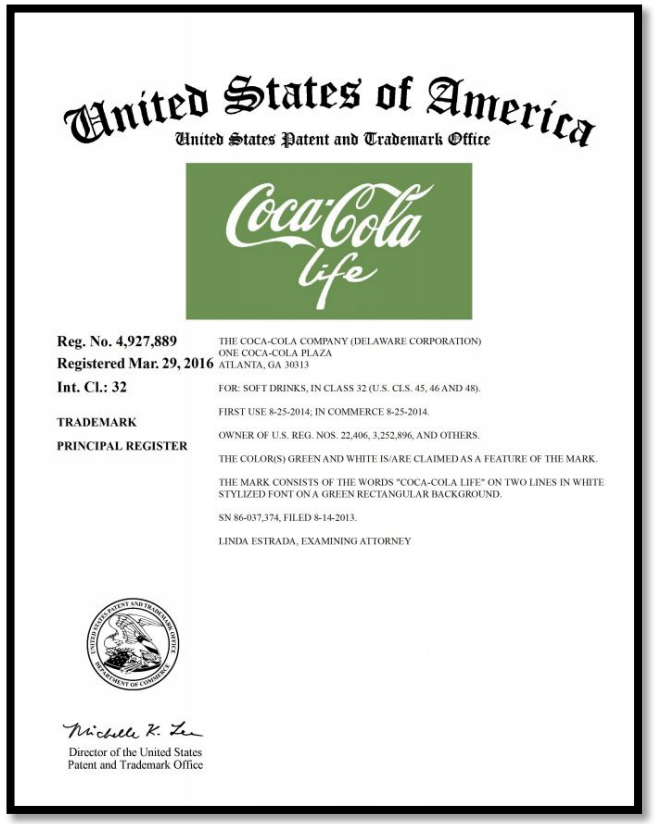
File – What's Next?

- Examining Attorney assigned
- Application Examined in accordance with TMEP
- Office Action and Possible Amendments
- Publication in *Trademark Official Gazette*
- Opposition Period
- Trademark Trial and Appeal Board (TTAB)



Trademark Allowed – What's Next?

- Certificate of Registration
  - Use-Based Application
- Notice of Allowance
  - Intent-to-Use application
  - Must file Statement of Use or Extension Request



United States of America
United States Patent and Trademark Office

Coca-Cola life

Reg. No. 4,927,889
Registered Mar. 29, 2016
Int. Cl.: 32

TRADEMARK
PRINCIPAL REGISTER

THE COCA-COLA COMPANY (DELAWARE CORPORATION)
ONE COCA-COLA PLAZA
ATLANTA, GA 30313

FOR: SOFT DRINKS, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 8-25-2014; IN COMMERCE 8-25-2014.

OWNER OF U.S. REG. NOS. 22,406, 3,252,896, AND OTHERS.

THE COLOR(S) GREEN AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE WORDS "COCA-COLA LIFE" ON TWO LINES IN WHITE STYLIZED FONT ON A GREEN RECTANGULAR BACKGROUND.

SN 86-037,374, FILED 8-14-2013.

LINDA ESTRADA, EXAMINING ATTORNEY

Michelle K. Lee
Director of the United States
Patent and Trademark Office

Maintain Trademark

- Check Trademark Status and Document Retrieval (TSDR) Website Periodically
- Ensure Contact Information Up to Date
- “Courtesy” Electronic Reminders on Day 1 of Filing Period for Maintenance Documents
- Failure to Maintain Can Result in Cancellation of Registration



Need Help?

- USPTO Online Tutorials (https://www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos)



Need Help? Trademark Assistance Center

- General information about registration process
- Assist with status inquiries
- 8:30am-8:00pm EST, Monday through Friday
- Phone: (571) 272-9250 or (800) 786-9199
- Email: TrademarkAssistanceCenter@uspto.gov

Trademark – Possible Pitfalls

- Failure to adequate select enforceable trademark
- Failure to meet USPTO requirements
- Failure to adhere to “less is more” principle
- Failure to maintain or even complete registration

Use of Another's Trademark in Ads

- Use ads to inform consumer, not unfairly attack competitor
- Mark competitors' trademarks with the trademark symbol (TM or ®)
- Cannot suggest competitor endorses or sponsors product advertised
- Cannot take unfair advantage of reputation of competitor's trademark to promote own business

Comparing Products in Ads

- No derogatory or defamatory comparisons
- Do not take unfair advantage of reputation of competitor’s trademark to promote own business
- Claims of comparison must be completely true and accurate
- Opinions should never be expressed as facts
- Cannot compare and cause confusion with competitor’s products

False Advertising and Infant Formulas

- Enfamil advertising suggests PBM formulas inferior and will cause poor eye/brain development
- Nutritional claims concerning two fats (DHA and ARA) – from same source
- False advertising lawsuit
  - $13.5 million jury verdict
  - Enjoin false statements about competitor's formula



Dannon, Activia and Probiotics

- Advertisements for Activia® yogurt promoting probiotic bacterial cultures
- No proof of superior health benefits
- $35 million settlement of false advertising lawsuit
- Settlement of class action lawsuit ($100 to individual consumers who were misled by “health claims”)



Splenda Lawsuits

- False advertising allegations
  - “Made from sugar, so it tastes like sugar”
  - “Good for the whole family”
- Settled lawsuit during trial against Merisant (maker of Equal®)



Corn Sugar – Advertising and FDA

- Lawsuit sought to end corn-refining industry's marketing of high-fructose corn syrup as "corn sugar" – resulted in settlement
- FDA ruled consumers would be too confused by name change
  - HFCS is a liquid syrup not a granular, dried, crystallized food as "sugar" implies
  - Could put people sensitive to fructose at risk

Ozarka Water Wars

- Two types of Ozarka water
  - Ozarka Drinking Water – Oklahoma City (Eureka)
  - Ozarka Spring Water – East Texas (Nestle)
- Eureka can use name in 60-county area in Oklahoma

Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp. (3rd Circuit 2021)

- In a functionality analysis, the question is whether the particular shape or form chosen is useful, not whether the product or feature as a whole is useful.
- Functionality should be analyzed "not at the level of the entire product or type of feature, but at the level of the particular design chosen for [the] feature(s)."
- Pocky's product configuration was functional and not protectable as trade dress.

Perry v. H.J. Heinz Brands, L.L.C. (5th Circuit 2021)

- Even de minimis use, outside of a trademark maintenance program or merely defensive use, is sufficient to sustain a registration.
- Finding no likelihood of confusion between the MAYOCHUP and METCHUP marks and no likelihood of confusion created by Heinz's brief use of Metchup in advertising, the district court dismissed Perry's claim on summary judgment and adjudicated Perry's mark abandoned.
- The Fifth Circuit reversed as to abandonment. The Fifth Circuit reasoned that just as one need not direct goods across state lines for Congress to regulate activity under the Commerce Clause, there is no cross border requirement to satisfy the Lanham Act's "use in commerce" requirement.

Royal Crown Company v. The Coca-Cola Company (Federal Circuit 2020)

- Court directed the Board to consider whether ZERO is generic because it refers to a key aspect of at least a sub-group or type of the claimer beverage goods.
- Court also vacated the Board's finding of acquired distinctiveness holding that the Board must make an express finding regarding the degree of the marks' descriptiveness on the scale from generic to merely descriptive, and must explain how its assessment of the evidentiary record reflects that finding
- RC obtained what it requested in its opposition, namely a disclaimer of ZERO in each of the trademark applications at issue. Consequently, there is no case or controversy for the court to decide and the appeal was dismissed.

Schlafly v. St. Louis Brewery, LLC (Federal Circuit 2018)

- SCHLAFLY word mark application for beer and ale was opposed by two relatives of Thomas Schlafly (co-founder of The SLB) but TTAB denied opposition.
- Rejected the Opposers' argument that TTAB should have determined whether the mark was "primarily merely a surname" and the Opposers' proposed new "change in significance test."
- Words that are primarily merely a surname can be registered trademarks if they have acquired secondary meaning in trademark use.

Are "LE CHOCOLAT DES ILES" and "ISLAND CHOCOLATES" Confusable for Chocolate Candy?

- *In re Iatichand R. Goojha*, Serial No. 88479529 (TTAB March 21, 2022)

Le Chocolat des Iles



E.D. Va. District Court Upholds TTAB Decision Finding "GRUYERE" Generic for Cheese

- *Interprofession du Gruyère et al. v. U.S. Dairy Export Council et al.*, Civil Action No. 1:20-cv-1174 (E.D. Va. December 15, 2021)





QUESTIONS?

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