

U.S. TRADEMARK LAW

Intellectual Property

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Disclaimer

- This presentation is for informational purposes only.
- This presentation is not to be construed as providing legal advice.
- The author does not guarantee the accuracy of this presentation.
- It is impossible to cover the entire subject of US trademark law, therefore only a number of topics or issues will be discussed. For further information contact Hackett & Hackett to discuss your personal needs.

Introduction

- About Hackett & Hackett
- Topics of Discussion
- Next Steps / Alternative Options
- Contact Hackett & Hackett to discuss your IP needs

Hackett & Hackett PC

Hackett & Hackett is a boutique law firm with offices in Michigan, which specializes in intellectual property law in the fields of:

1. Trademark law, prosecution and litigation;
2. copyright law and litigation; copyright work for hire agreements;
3. trade secret law and litigation; audits of trade secret policies;
4. international IP law, practice and litigation;
5. counsels on protecting and enforcing IP assets through legal principles and business practices and models;
6. protection and enforcement of foreign IP rights in the US;
7. domain name protection, resolution, enforcement and litigation;
8. trademark clearance opinions before filing with the USPTO;
9. licensing of intellectual property and taxation of IP;
10. International trademark filings, registration and protection.

Hackett & Hackett is supported and dedicated by highly qualified attorneys, legal specialists and support staff nationally and internationally.

Topics of Discussion

U.S. Trademark Law

- What is a Trademark
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- Choosing a Trademark and Searching
- USPTO and Trademarks
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- Continual obligations
- Trademark Infringement
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- USPTO Failure to Register Mark What Next?
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WHAT IS A TRADEMARK

- What is a Trademark?

A U.S. trademark includes any *word, name, symbol, device or a combination therefore, 15 U.S.C. §1127*. This also includes *service marks, collective marks and certification marks, 15 U.S.C. §1051*. In U.S. trademark law the first to use a trademark is granted protection, *15 U.S.C. §1051*.

GOVERNING LAW(S)

- Governing Law(s)

The primary U.S. legislation that governs trademark law is known as the *Trademark Act* of 1976 as amended (commonly known as the *Trademark Act* or *Lanham Act*), which is located at *15 U.S.C. §1051 et seq.*, as well as the governing *Code of Federal Regulations* found in *37 C.F.R. §1, et seq.*, and the *Trademark Manual of Examining Procedures TMEP*. This also includes case law i.e. such as *De Pont* factors, Fed. Cir. applying the various factors for likelihood of confusion, the governing test for trademark Infringement followed by the TTAB.

CHOOSING A TRADEMARK/SEARCHING

Choosing a trademark involves a number of important considerations that you need to be mindful of and any potential legal implications. Such consideration need to address:

1. Strength of the mark (dilution or tarnishment).
2. Market and consumer focus (sophistication of consumers).
3. Identical marks always a serious risk.
4. Trade channels and expansion geographically.
5. Foreign equivalents and international obstacles.
6. Licensing to others versus assignments of rights.
7. Avoids disputes with 3rd parties, damage awards, loss of investment, lost of profits.
8. Use v. Federal registration (trademark rights before and after registration).
9. Cost analysis and risk management, budgeting and cost planning.

An initial knock-out search can be helpful for any proposed trademark and a full comprehensive search is always recommended, even though there is no legal duty to search: *Ross & Mastracco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 1266 (Fed. Cir. 1983) & *Nabisco, Inc. v. PF Brands, Inc.*, 1981 F.3d 208, 226 (2nd Cir. 1999).

USPTO & TRADEMARKS

- USPTO and Trademarks

All applications for federal registration are filled with the United States Patent and Trademark Office (“USPTO”) and are governed by internal procedures. One can also file for a state trademark registration.

TEAS or *TEAS Plus* either manually or on-line and fees vary according to type of Application filed with the USPTO.

1A & 1B APPLICATIONS

- 1A and 1B Applications (drawing/specimen)

1A application is filed when the applicant is already using the mark in commerce and submits a drawing and specimen of how the mark is being used in commerce. The applicant must state each international class in which the mark is going to be used, which is a separate fee for each class. The application must also state whether the mark is a standard mark or special form mark (i.e. with a logo).

1B intent-to-use application is filed when the applicant is not currently using the trademark in commerce + must file statement of use or apply for extension maximum of 6 extension requests and must submit drawing and specimen of how the mark is being used in commerce. The applicant must state each international class in which the mark is going to be used, which is a separate fee for each class. The application must also state whether the mark is a standard character mark or special form mark (i.e. with a logo).

Principal & Supplemental Register

- Principal and Supplemental Register

Almost all applications are filed with the view that it will be placed onto the Principal Register for maximum protection. Applications that are not deemed suitable or do not meet the requirements for the principal register can at the discretion of the examining attorney, be placed onto the supplemental register. An applicant cannot request for placement on the supplemental register. The Principal Register grants broader protection than the Supplemental Register. But in each case the applicant is permitted to use the ® whether it appears on the Principal or Supplemental Register.

Overcoming USPTO Objections and Refusal

- Overcoming USPTO objections and refusal

There is always the possibility that a pending application can either be refused (for being generic) or an objection can be raised because it causes the likelihood of confusion with another registered or pending trademark. In such instances either position can be addressed and overcome, but where an examiner issues a refusal to register the trademark mark recourse lies with the Trademark Trials and Appeals Board (TTAB). In the event that a decision is unfavorable the next available recourse lies with the United States Court of Appeals for the Federal Circuit sitting in Washington D.C. or a local federal district court. Remember that a refusal to register or an objection issued by the trademark examiner may be for a number of reasons and not just limited to what was state above.

Continuing Obligations

- Continuing Obligations

Once an application is placed either on the principal register or supplemental register, an applicant has a continuing obligation to comply with the federal Lanham Act (Trademark Act) and USPTO procedures by filing appropriate documents to maintain federal registration. Failure to meet these continuing obligations can result in the loss of a federal trademark registration.

Trademark Infringement

Trademark infringement occurs when a trademark appears to be similar to another trademark with respect to sight, sound and appearance. An action for trademark infringement is generally brought against a trademark owner that gives a commercial impression similar to an existing or senior trademark holder or user.

Before a determination is made that a trademark infringes or causes consumer confusion the USPTO or court will go through a number of factors that assist in reaching a determination that a mark is likely to cause confusion. Such factors range from the similarity of the marks when compared together, strength of the mark, sound of the mark, channels of distribution, etc. No single factor is determinative.

If you are seeking to register a mark or being served with a lawsuit for trademark Infringement It is best to consult with legal counsel regarding your legal rights and options. It has been pointed out that reasonable good faith reliance on an opinion of legal counsel doesn't mean there is not infringement or likelihood of confusion. *Dreamworks Production Group, Inc. SK6 Studio*, 142 F.3d 1127 (9th Cir. 1997).

Madrid Protocol International Registration

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks-the Madrid Protocol- is one of two treaties comprising the Madrid System for international registration of trademarks. The protocol is a filing treaty and not a substantive harmonization treaty. It provides a cost-effective and efficient way for trademark holders-individuals and businesses- to ensure protection for their marks in multiple countries through the filing of one application with a single office, in one language, with one set of fees, in one currency. Moreover, no local agent is needed to file the application. While an International Registration may be issued, it remains the right of each country or contracting party designated for protection to determine whether or not protection for a mark may be granted.

Once the trademark office in a designated country grants protection, the mark is protected in that country just as if that office had registered it. The Madrid Protocol also simplifies the subsequent management of the mark, since a simple, single procedural step serves to record subsequent changes in ownership or in the name or address of the holder with World Intellectual Property Organization's International Bureau. The International Bureau administers the Madrid System and coordinates the transmittal of requests for protection, renewals and other relevant documentation to all members.

The US laws governing the filing of international marks are the *Madrid Protocol Implementation Act* and the *Trademark Technical and Conforming Amendment Act* of 2010.

USPTO Failure to Register Mark What Next?

If the USPTO fails to register a trademark that you have applied for, this could be for a number of reasons, you should consider what legal protection and alternative options that are available to you. Most people and businesses feel that since the USPTO failed to register a trademark that they have no legal protection. Of course, experience legal counsel can provide legal advice and assistance on how best to proceed and protect and enforce a non-registrable federal trademark in the US and provide additional or alternative options is seeking registration, protection and enforcement.

Next Steps

- Taking a proactive approach.
- Eliminating any risk factors.
- Pursuing your trademark.
- Filing your trademark.
- Addressing any issues or concerns.
- Exploring Alternative Options if USPTO refuses to register mark.

CONTACT

- Whether you are seeking to register a trademark, protect, enforce or are facing a potential lawsuit relating to trademark infringement, experienced attorneys can provide you with assistance.
- If you have been denied a federal trademark registration contact our offices to discuss your legal rights to protect and enforce your trademark even without a federal trademark registration.
- If you are seeking registration, protection and enforcement internationally, contact our office to find out how you can apply for an international trademark to ensure the best possible protection and enforcement of your rights.