

# Trademarks Essentials: What You Should Know for Your Business

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# Overview

- ◆ What Are Trademarks
- ◆ Purpose/Use
- ◆ Types
- ◆ Sources of Protection
- ◆ Federal Registration
- ◆ Selection
- ◆ Prosecution
- ◆ Term
- ◆ Notice
- ◆ Investment Costs
- ◆ Scenarios

# Trademarks

- ◆ What is a Trademark/Service Mark?
  - Any word, name, symbol, or device used to identify and distinguish goods and/or services
  - Used to identify the source of goods and/or services

# Purpose/Use

- ◆ Branding Tool
  - ◆ Identify Origin of Products or Services
  - ◆ Symbols of Quality
  - ◆ Symbols of Goodwill
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- ◆ Likelihood of confusion, Dilution, Counterfeiting issues
- ◆ Offensive/Defensive Uses

# Types

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- ◆ Trademarks
- ◆ Service Marks
- ◆ Certification Marks
- ◆ Collective Marks
- ◆ Trade Names

# Trade Dress

- ◆ Total image or overall appearance of product/product packaging/business
- ◆ Must be associated with the business
- ◆ Non-functionality
- ◆ Distinctiveness

# Sources of Protection

- ◆ “TRAATTU”
- ◆ Federal Registration (Lanham Act)
  - Principal Register
    - ◆ 1<sup>st</sup> tier level of protection
    - ◆ Advantages
  - Supplemental Register
    - ◆ 2<sup>nd</sup> tier level of protection
    - ◆ Advantages/Disadvantages
- ◆ State Registration
- ◆ Common Law

# Supplemental Register

- ◆ Limited Benefits
- ◆ 5 year USE
- ◆ Secondary meaning
- ◆ Transfer to Principal Register

# Why Obtain Federal Registration?

- ◆ Ability to bring action in Federal Court
- ◆ Federal remedies
- ◆ Constructive notice of ownership to public
- ◆ Legal presumption of ownership of mark and exclusive use of mark nationwide
- ◆ U.S. Customs Service filing and enforcement
- ◆ Added value
- ◆ Basis for foreign filing
- ◆ Benefit of USPTO Examination
- ◆ Incontestability
- ◆ Protection against counterfeiting

# Selecting A Trademark

## ◆ Levels of Distinctiveness

- Fanciful/Coined Mark
- Arbitrary Mark
- Suggestive Mark
- Descriptive Mark
- Generic Mark

# Fanciful/Coined Mark

- ◆ Highest level of distinctiveness
- ◆ Made up mark
- ◆ No ordinary meaning
- ◆ Examples – KODAK, EXXON, Xerox, Nike

# Arbitrary Mark

- ◆ Next level of distinctiveness
- ◆ Ordinary word used in arbitrary and non-descriptive manner
- ◆ Totally unrelated to the goods or services
- ◆ E.g. Ivory Snow, TIDE for soap/detergent, Apple for computers etc.

# Suggestive Mark

- ◆ Third level of distinctiveness
- ◆ Mark that suggests a feature/nature of the good or service – without describing the feature
- ◆ Example – Greyhound – alluding to speed of the carrier, Coppertone – suggestive of suntan lotion

# Descriptive Mark

- ◆ Describes a feature/nature of goods/service
- ◆ Normally denied registration by the USPTO
- ◆ Example – Weight Watchers, Holiday Inn, Vision Center
- ◆ Options

# Generic Mark

- ◆ General category to which a product/service belongs
- ◆ Not protectible - Denied during application process
- ◆ In the public domain
- ◆ Example – “FRUIT” for oranges

# Some Unregistrable Marks

- ◆ Geographic
- ◆ Surnames
- ◆ Generic Marks
- ◆ Laudatory Marks
- ◆ Immoral or Scandalous Marks
- ◆ National Insignia
- ◆ Descriptive and Deceptive Marks

# The Federal Registration Application

- ◆ Use - Based
- ◆ Intent-To-Use Application
- ◆ Prior Foreign Application or Registration

# Federal Application Prosecution – Initial Timeline

- ◆ Application Filing
- ◆ Filing Receipt
- ◆ Office Action Communication
  - Within 5-7 Months after filing
- ◆ Notice of Publication

# Prosecution – Office Action

- ◆ Examination of Application
  - Search for conflicting marks
  - Examination of the written application, drawing and any specimen
- ◆ Mark Refusal by Examiner
  - Substantive Refusal
  - Procedural or Formal Refusal

# Some Common Refusals/Objections

- ◆ Likelihood of Confusion
- ◆ Descriptiveness
- ◆ Ornamental
- ◆ Ambiguous description

# Application Status: Favorable or Unfavorable?

## Favorable - Use Application

- ◆ Notice of Publication
- ◆ Publication – 30 day period open for opposition + extension period as allowed
- ◆ Certificate of Registration

# Application Status: Favorable or Unfavorable?

## Favorable - ITU Application

- ◆ Notice of Allowance (ITU App.)
- ◆ Statement of Use
  - Extensions
- ◆ Notice of Publication
- ◆ Registration Certificate

# Application Status: Favorable or Unfavorable?

Unfavorable - Use/ITU Application

- ◆ Office Action Response
- ◆ Examiner Interview
- ◆ Appeal to the TTAB
- ◆ Appeal to the Ct. of App. Federal Circuit (CAFC)
- ◆ Strategic Options

# Term

- ◆ Registrations granted PRIOR to November 16, 1989 have a 20-year term
- ◆ Registrations granted on or after November 16, 1989 have a 10-year term.
- ◆ Renewals
- ◆ Indefinite provided:
  - Continued Use
  - Renewal

# Notice – Registered Mark

- ◆ Provided by words, “Registered in the U.S. Patent & Trademark Office” or
- ◆ “Reg. U.S. Pat. & Tm. Off.” or
- ◆ ® or “SM” Symbol
- ◆ Failure to provide notice will preclude recovery of profits or damages in an infringement suit.

# Notice – Unregistered/Pending Mark

- ◆ Provided by symbols, “TM” or “SM”
- ◆ Can't use ® Symbol

# Investment Costs (Not All-Inclusive)

- ◆ USPTO Costs
  - Registration fees, Filing fees, Extension fees etc.
- ◆ Attorneys' Costs
  - Consultation fees, Preparation & filing, Research, Responding to USPTO correspondence etc.
- ◆ Search Costs
  - Clearance Search Fees, Opinion, Investigation

# Summary

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- ◆ Understand what a trademark is
- ◆ Advantages and applications to your business
- ◆ Investment costs
- ◆ Timeline
- ◆ Notice
- ◆ USE

# Scenarios

# Scenario 1

◆ Do I have trademark protection for my registered business name?

## Scenario 2

- ◆ I do not use my mark on all of the goods/services listed in my Use-based application. Do I have to do anything till I start using the mark in conjunction with these goods/services?

# Scenario 3

- ◆ I received my registration certificate from the USPTO. Do I have to do anything else?

# Scenario 4

◆ I received a letter from a company asking that I stop using my unregistered mark. What should I do?

# Scenario 5

- ◆ I received my registration certificate for my mark.  
Do I still have to place the Notice symbol even though my registration is public record?

# Scenario 6

- ◆ A competitor is importing goods with my registered mark on them. What can I do to stop this?

# Scenario 7

◆ Can I obtain Federal trademark protection for my name, secret recipe or secret process?

# Scenario 8

◆ What do I do now?

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