

USPTO/MBDA Webinar Series: GOING GLOBAL WITH INTELLECTUAL PROPERTY



PRACTICAL STRATEGIES FOR PROTECTING YOUR COMPANY'S TRADEMARKS IN THE NATIONAL AND INTERNATIONAL MARKETPLACES

Susan M. Richey

*Deputy Chief Administrative Trademark Judge
Trademark Trial and Appeal Board, USPTO*



Trademarks

A trademark is a word, name, symbol, device, or any combination used to **distinguish the source of particular goods or services of one entity from those of another**. A trademark assures the owner of the exclusive right to use the mark in conjunction with its goods or services. Trademark rights endure as long as the mark is in use in commerce. Trademark may, but need not be, registered in the USPTO.



Different Forms of Trademarks

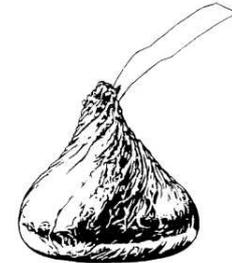
Trademark



Service Mark

weightwatchers

Trade Dress



Trade Name

Weight Watchers International, Inc.

Collective Mark



Certification Mark





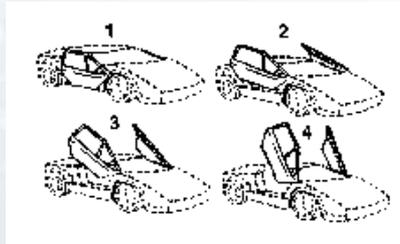
Non-traditional Forms

- Sounds:

<http://www.uspto.gov/trademarks/soundmarks/>

- Scent: Peppermint scent for lubricating oil for high performing automobiles

- Movement:



- Texture: Velvet texture of wine bottle



Hierarchy of Distinctiveness

Fanciful—
invented term

Arbitrary—
uncommon
association

Suggestive—
requires
imaginative steps

Descriptive—describes
characteristics of goods/
services



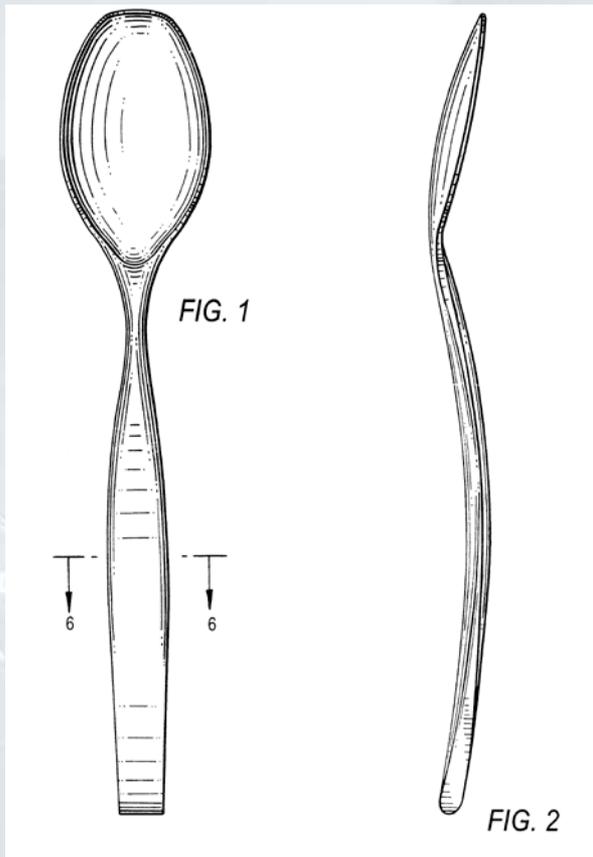
Suggestive vs. Descriptive

The word "VISA" in a bold, black, sans-serif font, set against a white rectangular background. The logo is positioned on the left side of the slide, with a faint background image of a classical building.

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services



Descriptive vs. Generic



“‘Deep bowl’ identifies a significant characteristic of the article. It is ‘merely descriptive’ of the goods, because it informs one that they are deep in the bowl portion. . . . ‘Deep bowl’ is not, however, the . . . name of the article since the implement is not a deep bowl, it is a spoon. ‘Spoon’ is not merely descriptive of the article--it identifies the article—[and therefore] the term is generic.”

Fletcher, Actual Confusion as to Incontestability of Descriptive Marks, 64 Trademark Rep. 252, 260 (1974).

Not even Xerox can Xerox.

In fact, nobody can Xerox. Or have something Xeroxed. You can copy or have something copied, but you just can't Xerox.

That's because the Xerox trademark is not a verb. It's a proper adjective that should always be followed by a word or phrase describing one of our products. As in Xerox copiers, Xerox electronic typewriters, Xerox laser printers, etc.

We're proud of our trademark. It's valuable to us. And to you. It's how you can be sure that when you ask for a Xerox product, you'll get a Xerox product. Not something else.

So, if you would, make a copy of this advertisement and place it near your Xerox copier. Then everyone who copies will know that no one can Xerox.

Not even Xerox.

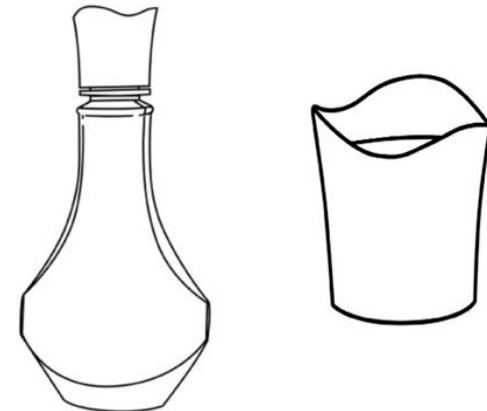
XEROX® is a trademark of XEROX CORPORATION.



Distinctive Trade Dress

T.T.A.B. finds mouthwash bottle and cap to be inherently distinctive product packaging, using the Seabrook test. The three factors in Seabrook really ask the same question: Is the design so unique or unusual that one can assume that it will be automatically perceived by consumers as an indicator of source? Comparison to competitors' bottles and caps revealed that the packaging for Scope mouthwash, which had won design awards and had been touted in the popular press, was unique in its field.

In re Proctor & Gamble Co.,
105 USPQ2d 1119 (TTAB 2012).





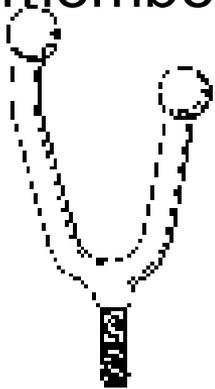
Functional Trade Dress

“‘[A] product feature is functional’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’” . . . That is, “a functional feature is one the ‘exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.’” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).



Example of Functionality

Patent claims “a holding member having an upper half and a lower half, said lower half being formed with a U-shape comprising two upright arms and. . .said upper half including an open section between opposing ends of the holding member.”



U.S. Patent

Aug. 26, 1986

4,607,772

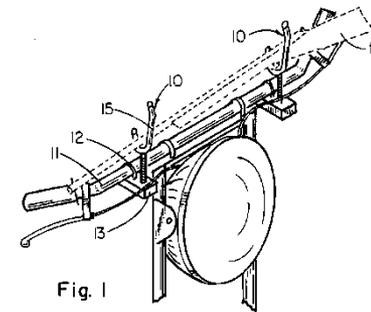


Fig. 1

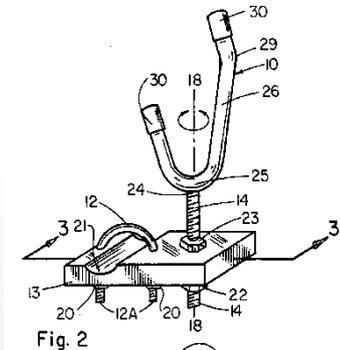


Fig. 2

“Although other shapes exist, applicant’s design is one of only a small number of superior designs. . . . [W]e view applicant’s utility patent as strong evidence that the design is functional.” *In re All Rite Products, Inc.*, 2001 WL 1182932 (TTAB 2001).



Common Law vs. Civil Law

The United States, unlike many civil law nations, has a rule of ownership and priority that is based on first-to-use, not first-to-register.* First-to-register is the majority approach on the world stage.

Additionally, in many countries, it is not necessary to use the trademark in order for a trademark registration to issue (although use may have to be undertaken at some point in order to maintain the registration).

*Exceptions to priority rule in the United States: Intent-to-use provisions and treaty obligations (Paris Convention, Madrid Protocol)



Benefits of Federal Registration

- Legal presumption of exclusive right to use nationwide in conjunction with listed goods/services;
- Public notice of claim of ownership of mark;
- Right to use ®;
- Use of federal registration as a basis to obtain registration in foreign countries;
- Federal court jurisdiction; in counterfeiting cases, enhanced \$\$\$ and possible criminal penalties;
- Ability to record registration with U.S. Customs.



Filing Bases for Applications under the Lanham Act

§ 1(a) [use-based application]—applicant must allege date of first use in commerce in U.S.

§ 1(b) [ITU application]—applicant must state a bona fide intent to use the mark in commerce in U.S. Application matures into a registration when applicant notifies the USPTO that use in commerce has occurred.



Filing Bases, cont'd

- § 44(d) [Paris Convention, foreign application]—
eventually applicant must provide a § 1(a), § 1(b), or a § 44(e) basis.
- § 44(e) [Paris Convention, foreign registration]—
declaration of bona fide intent to use required for
issuance of registration but actual use in commerce in
U.S. is not.
- § 66 [Madrid Protocol, international registration]—
declaration of bona fide intent to use required for
issuance of registration but actual use in commerce in
U.S. is not.



Presumption of Registration

Preamble to § 2

“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature ***unless*** it—”

falls within one of the bars to registration listed in § 2.



Principal vs. Supplemental Register

The United States has two sections of the Federal Trademark Register: the Principal Register and the Supplemental Register. Most marks are registered on the Principal Register. The Supplemental Register is reserved for nondistinctive marks that are capable of acquiring distinctiveness (i.e. “secondary meaning”), but have not yet done so.



Monitor the Marketplace

- Trademark owners have an obligation to police third party use of the owner's marks. Otherwise, trademark rights could be lost.
 - Commercial watch services
 - Official Gazette
 - Auction sites, blogs and other websites
 - Defensive domain name and internet keyword registrations



Opposition or Cancellation

- File an *inter partes* proceeding with the USPTO's Trademark Trial and Appeal Board (TTAB) which has jurisdiction to uphold an opposition to, or grant a request to cancel, a registration.
- File a claim for cancellation in any federal court action involving a registered mark. The court may determine the right to registration, order cancellation of registrations, restore cancelled registrations, and otherwise rectify the register.



Enforcement of Trademark Rights under the Lanham Act

So long as a mark has been used in commerce that Congress can lawfully regulate, whether or not the mark has been federally registered, the owner may seek enforcement of that mark in federal district court. Enforcement under the Lanham Act is available under one of several theories.



Infringement--likelihood of confusion-- § 32(a)(1)(A) or § 43(a)(1)

“[T]he products in this case differ in ways that may be deemed material to consumers.”

- only the crackers are buttered
- only the crackers are served w/hors d'oeuvres
- the crackers are flour-based and bland
- the crackers are baked
- the chips are corn-based, heavily salted and spicy
- the chips are fried



Vitarroz Corp. v. Borden, Inc.,
644 F.2d 960 (2d Cir. 1981)

Within retail stores, the crackers are shelved in the “cookies and crackers” section; the chips are shelved in the section for “salty, crunchy snacks.” Moreover, consumers of the crackers tend to shop for them in specialty stores that do not carry the chips.



Counterfeiting—a subset of infringement

Use of “a spurious mark that is identical with, or substantially indistinguishable from, a registered mark” of the trademark owner; and the trademark owner’s mark must be registered on the USPTO’s Principal Register in connection with identical goods or services for which the defendant uses the mark.



Possible flood of counterfeit sports merchandise if cancellation decision upheld on appeal.



Dilution—likelihood of dilution of famous mark § 43(c)

Blurring

Association arising from similarity between a mark and a famous mark that impairs the distinctiveness of the famous mark.



TARNISHMENT

Association arising from the similarity between a mark and a famous mark that harms the reputation of the famous mark.



Cybersquatting—trademarks in domain names § 43(d)

Cybersquatting--Refers to registration of an internet domain name that incorporates some version of a trademark owner's mark and that does so with bad faith, either in registration or use of the domain name or both.

\$ 7.2 M judgment against Chinese cybersquatter who registered 100 domains using the company's mark, including pinterests.com, pimterest.com, and pinterost.com.

Pinterest



International Trademark Rights

- Trademark rights are territorial—remember that many countries have a first-to-file system.
- Select registration in those countries in which the company will make use of the mark directly or by licensing the mark to a third party. Think about where your customers, distributors, or manufacturers are located—if outside the United States, consider seeking protection in the countries in which they are located.



National Protection

- Paris Convention—167 countries have agreed that each will provide “national treatment” for the citizens of each of the member countries for trademark registration purposes. Applicant can claim filing date of original trademark application when filing a subsequent application in a member country if filed within 6 months of the original filing.



Regional Registration Systems

- European Community Trademark (CTM)—one application that, if granted, provides protection in all 27 countries which are members of the EU
- Madrid System—85 countries agree to allow nationals of any of those countries to file one application in their home country and extend it to any of the other countries applicant designates. A single registration issues but it is dependent upon the home application and registration.



Regional Systems cont'd

- Benelux—one joint application which, if granted, provides protection in Belgium, the Netherlands, and Luxembourg.
- ARIPO—one application which, if granted, extends protection to many of the English-speaking African nations but must designate specific countries.
- OAPI—corollary of ARIPO for French-speaking African nations. Registration, if granted, extends protection automatically to all nations in the group.



Resources

- www.uspto.gov/trademark
- <http://www.inta.org/GlobalTrademark/Pages/main.aspx>
- <http://www.wipo.int/trademarks/en/>



Questions?

***Thank you for participating in the webinar,
and I hope the presentation was helpful.***