

# TRADEMARK Basics

WHAT IS IT? HOW DOES IT WORK? WHAT IS INFRINGEMENT?



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# Genna S. Hibbs & Hibbs Law, LLC

Founded 1Jan2013, Hibbs Law, LLC is an Intellectual Property Boutique law firm focused on Patents, Trademarks, Copyrights, and Trade Secrets for individuals and small business.

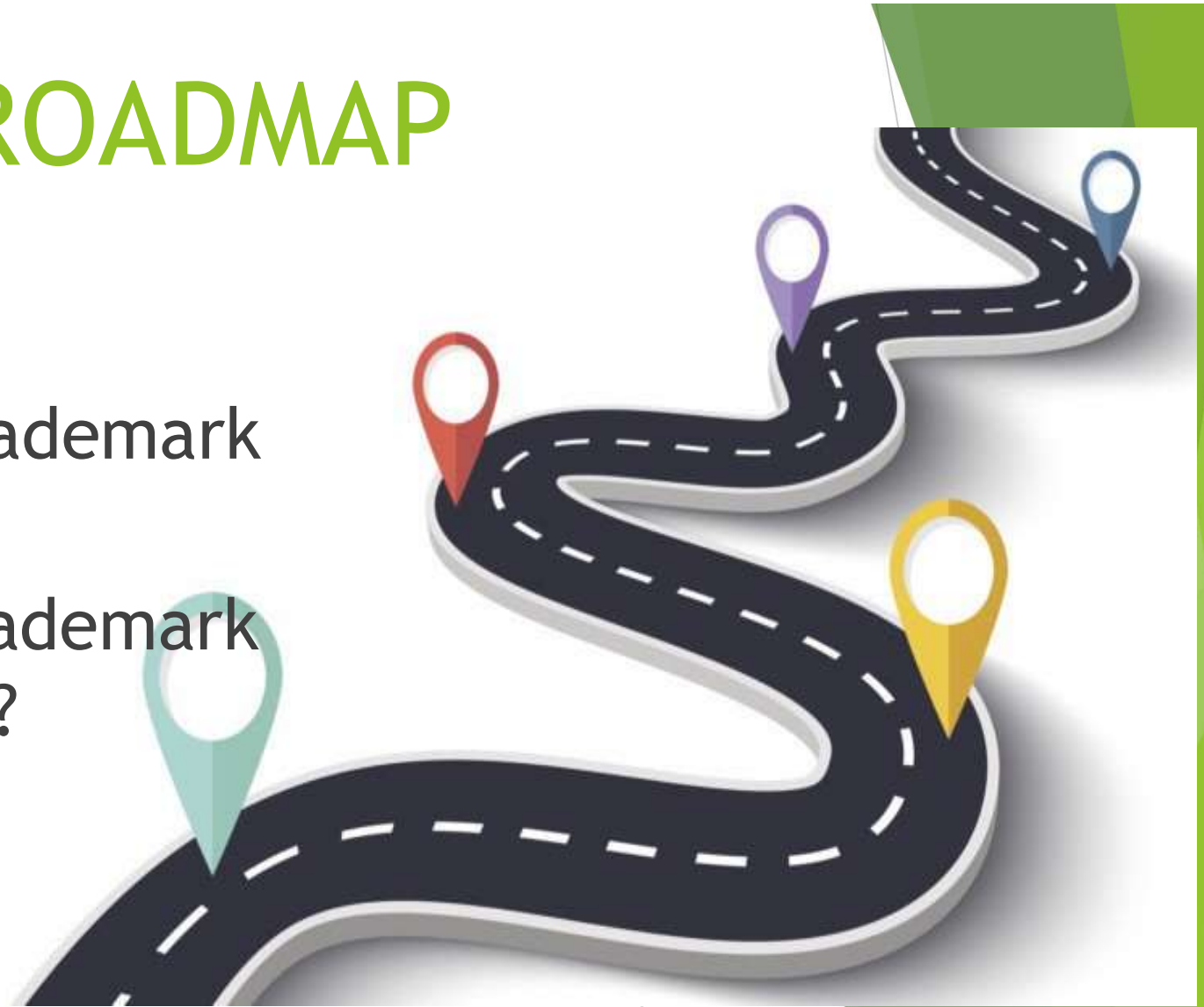
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**DISCLAIMER:** This presentation is not legal advice! Legal advice is a confidential and privileged communication, involving an analysis of your exact factual positioning.



# ROADMAP

- ▶ 1. What is a Trademark?
- ▶ 2. How do Trademark rights work?
- ▶ 3. What is Trademark infringement?



# 1. What is a Trademark?

- ▶ Trademark rights: common law origins and statutory policy basis in CONSUMER PROTECTION
  - ▶ Brand loyalty
  - ▶ Expected quality
- ▶ Trademark is the goodwill identifier that the public associates with YOU as the source of origin of your product/service.
  - ▶ Rights are based on USE, IN COMMERCE
  - ▶ Source of origin ≠ goods/services
- ▶ Balance trademark rights with 1<sup>st</sup> Amendment Free Speech (FAIR USE: Nominative and Descriptive) and Functionality.

Many things can be a protectable trademark, not just words and logos.

Colors

Sounds

Smells

Interior  
decorating

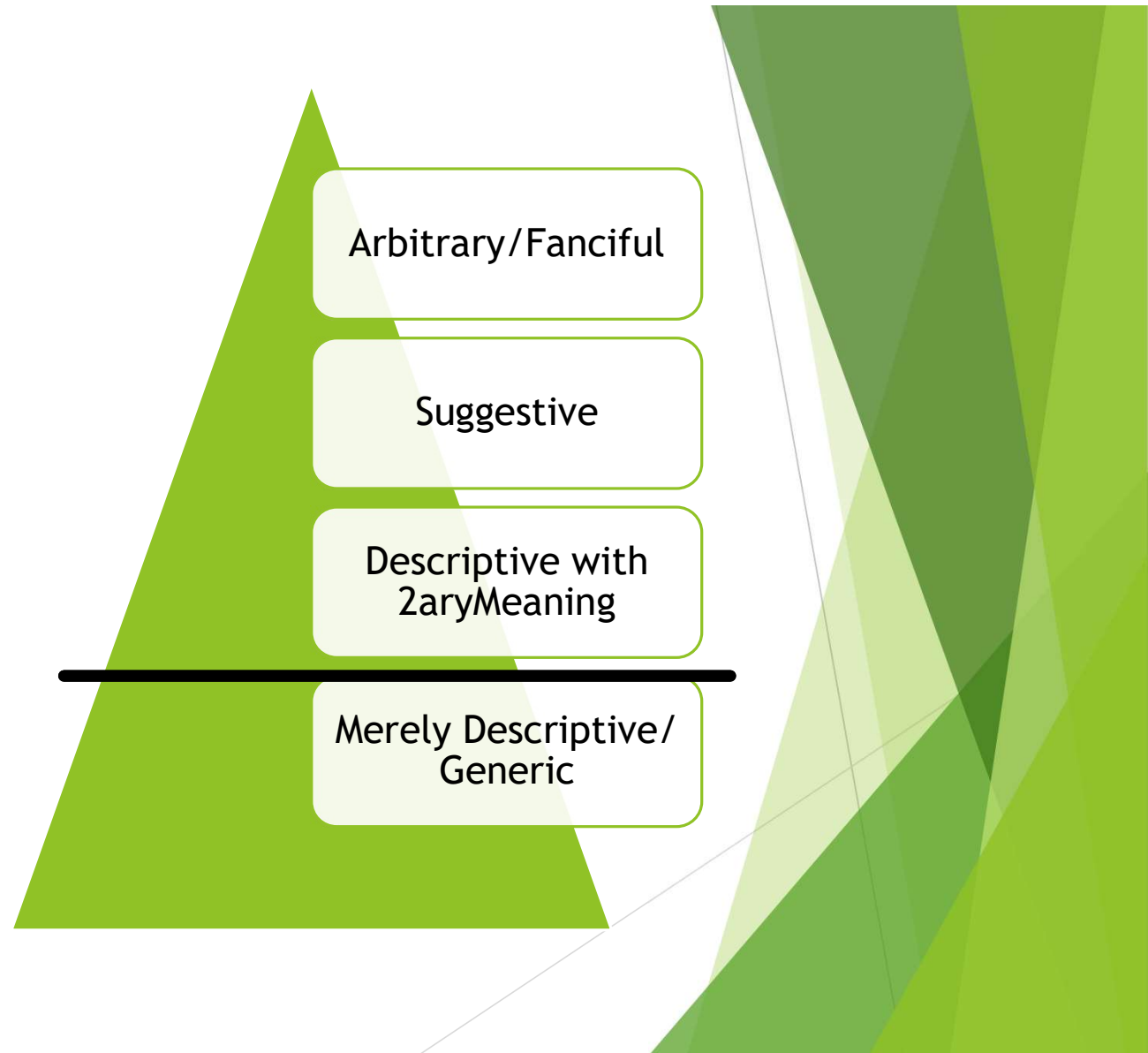
Package  
design



## A Trademark's strength is based on time, market, and **DISTINCTIVENESS**

Important for choosing your brand/trademark.

Secondary Meaning: primary source in public's mind; time and market strength factors can bolster a descriptive mark into protectability; presumed after 5yrs (incontestability)



## ARBITRARY or FANCIFUL



SUGGESTIVE





# DESCRIPTIVE



# GENERIC

# A Great New Escalator

## AT A NEW LOW PRICE!



**WIDE ENOUGH** for adult and child — or traveling and luggage. The new Escalator carries 5000 people an hour comfortably. It is designed for any vertical rise up to 37 feet.

**It's big in capacity throughout**

**HERE NOW** — the first Escalator designed especially for the medium-sized and smaller building. The result of many years' research, this new Escalator has all the time-tested features of earlier models, plus a wealth of post-war design features... it is truly the last word in Escalator design.

Capable of carrying 5000 people an hour, it handles more persons per dollar investment than any other moving stairway. Wide enough to comfortably carry an adult and child on one step, it is the ideal size for most stores, stations, plants, banks and other public buildings. Yet for all its spaciousness, it requires less space and structural work than narrower moving stairways.

Best of all there has been no compromise with quality. In eye-appeal, in safety, in the inherent ruggedness that makes for long life and low upkeep, it is the equal of any Escalator we ever built. And remember, only Otis makes Escalators.

**NEW FREE BULLETIN B-7007** tells the whole story. Write for your copy to Otis Elevator Company, 260 Eleventh Avenue, New York 1, N. Y.

**SAFETY FEATURES** include interlocking metal treads, semi-circular, extended nose, continuous slip-proof rubber hand rails... the world's safest transportation.

**A LIFETIME OF BEAUTY.** The modern Escalator's graceful lines and gleaming aluminum balustrade combine to give buildings the New Look in level-to-level travel.

"Escalator" is a U. S. Patent Office registered trademark of the Otis Elevator Company. Only Otis makes Escalators.



**OTIS ELEVATOR COMPANY**  
Offices in All Principal Cities

TUE, DECEMBER 8, 1947 115

# THERMOS

# DRY ICE

## 2. How do trademark rights work?

### Common Law @ court, §43(a)

- ▶ Starts when you begin to use your mark, aka are identifying the source of origin of your goods/services with the particular TM.
- ▶ Limited to your geographic area and reasonable expansion (gets fuzzy with internet).
- ▶ Use <sup>TM</sup> to identify common law TMs.

### Federal registration @ USPTO, §1(a)/§1(b)

- ▶ Once registered, provides nationwide protection from the filing date against all junior users.
- ▶ USPTO registration can be extended internationally (1yr priority deadline for filing date).
- ▶ States also offer registration (limited value).
- ▶ Use ® to identify registered TMs.

# USPTO Registration, general overview

Before

- Self Knock-out search
- Decide on what to protect
- Clearance Search
- Gather information for application

USPTO  
1st

- File application
- Examiner's review/search
- Amendments/ Office Actions

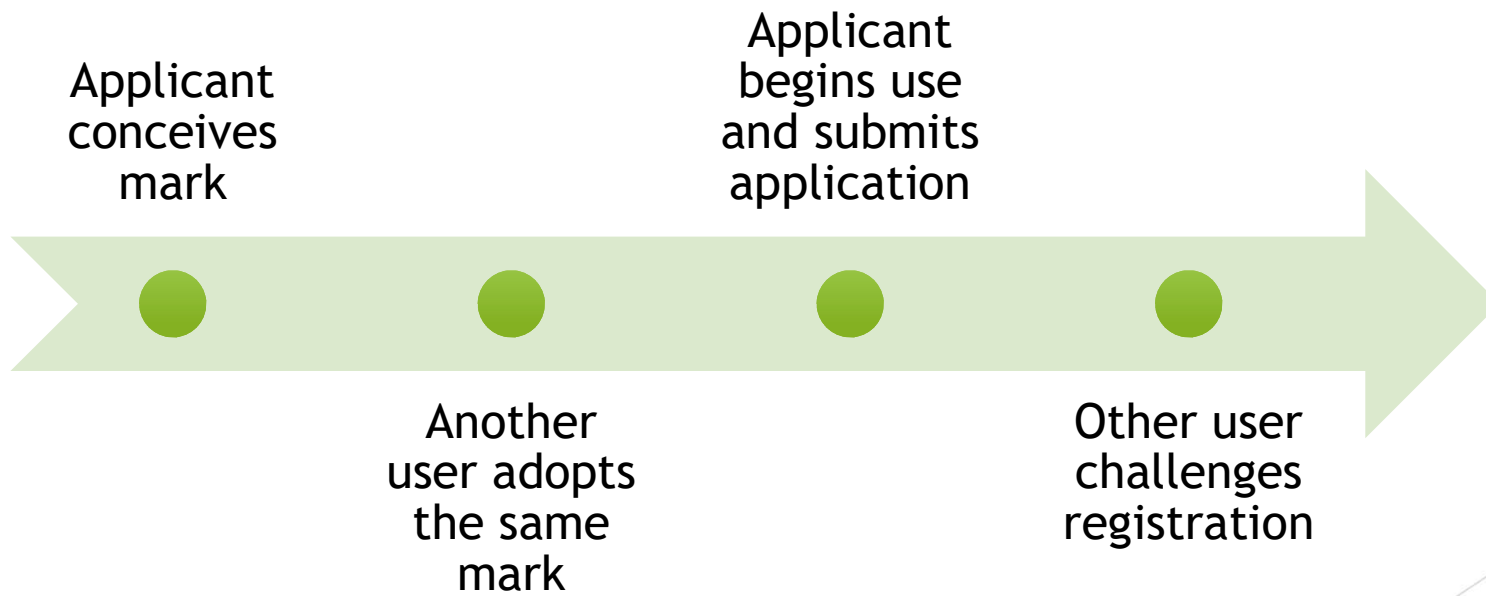
USPTO  
2nd

- 6mo Publication period
- Challenger?
- Registration

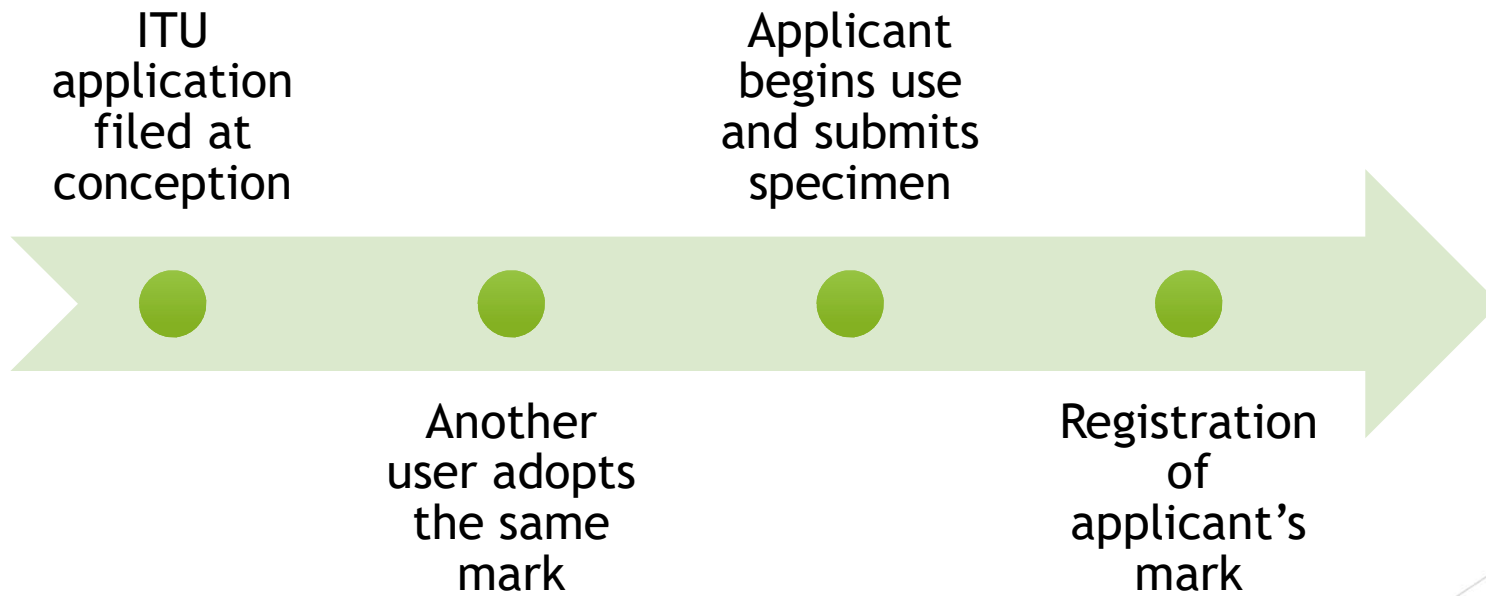
After

- Enforcement Searches
- Reviewing use as business evolves
- Maintenance of USPTO registration

## Priority: Junior and Senior users, §1(a)



## Priority: Junior and Senior users, §1(b)



## 3. What is Infringement?

- ▶ Likelihood of Confusion is the legal test for trademark infringement: is there a likelihood that a potential consumer would be confused as to the source of origin? Is the junior user attempting to capitalize and steal the senior user's goodwill?
- ▶ LoC Factors Analysis:
  - ▶ Similarity of marks
  - ▶ Similarity of goods/services
  - ▶ Sophistication of consumers
  - ▶ Strength of mark
  - ▶ Length and market of use
  - ▶ Willfulness to infringe by junior user
  - ▶ Actual confusion

# Infringing or Non-infringing?

*Mrs. Fields*

*Marshall Field's*



Non-infringing! Goods and services  
too dissimilar.

*Mrs. Fields*

*Marshall Field's*

# The Enforcement Process:

## Full-Tilt



## Small Steps



## Other side



# QUESTIONS?



*\*not final!\**