

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





USPTO's Inventors Conference

INVENTION-CON

The Place for **Inventors**, **Makers**, & **Entrepreneurs**

Trademark basics: What every inventor and entrepreneur should know now, not later

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Discussion topics

- Definitions and types of marks
- Benefits of federal registration
- Selecting a mark
- Filing and registration
- How to find help



Discussion topics

Definitions and types of marks

What is a trademark?

- Any word, symbol, design, or combination of those that:
 - Identifies the source of goods and services
- and
 - Distinguishes them from the goods and services of another party



Traditional types of marks

Word mark (or slogan)

COCA-COLA

IT'S THE REAL THING

Composite mark



Stylized mark

Coca-Cola

Design mark



Non-traditional types of marks

Anything that functions as a source identifier might be eligible for registration.

- Sound
- Color
- Scent/smell
- Motion
- Hologram
- Configuration/shape



Discussion topics

Benefits of federal registration

Trademark rights

- Rights can be created two ways:
 - Common law
 - Federal registration



Common law trademark rights

- Rights
 - Created when trademark is used in commerce
 - Limited to geographic area where mark is used
- Symbols
 - Optional: TM SM
 - Never: ®



Federal registration rights

- Rights
 - Created when trademark registers with the USPTO
 - Legal presumption you own the trademark
 - Legal presumption you have the right to use the trademark in all 50 states and U.S. territories (but not other countries)

Federal registration rights

- Rights
 - Can claim notice to the public of your rights in the trademark.
 - Can bring legal action concerning trademark in federal court.
 - Enables recordation of registration with U.S. Customs and Border Protection.



Federal registration rights

- Rights
 - Can be used as a basis for filing in another country.
- Symbols
 - Permitted: ®



Discussion topics

Selecting a mark

Registrable and protectable

Two main concepts:

- Likelihood of confusion
- Strength of the trademark



Likelihood of confusion

- Confusion as to source:
 - Are the trademarks confusingly similar?
and
 - Are the goods and/or services related?



Suggestions for searching

On your own:

- USPTO database
 - TESS (Trademark Electronic Search System)
 - www.uspto.gov/SearchTrademarks
- The internet
 - Option for searching for common law use



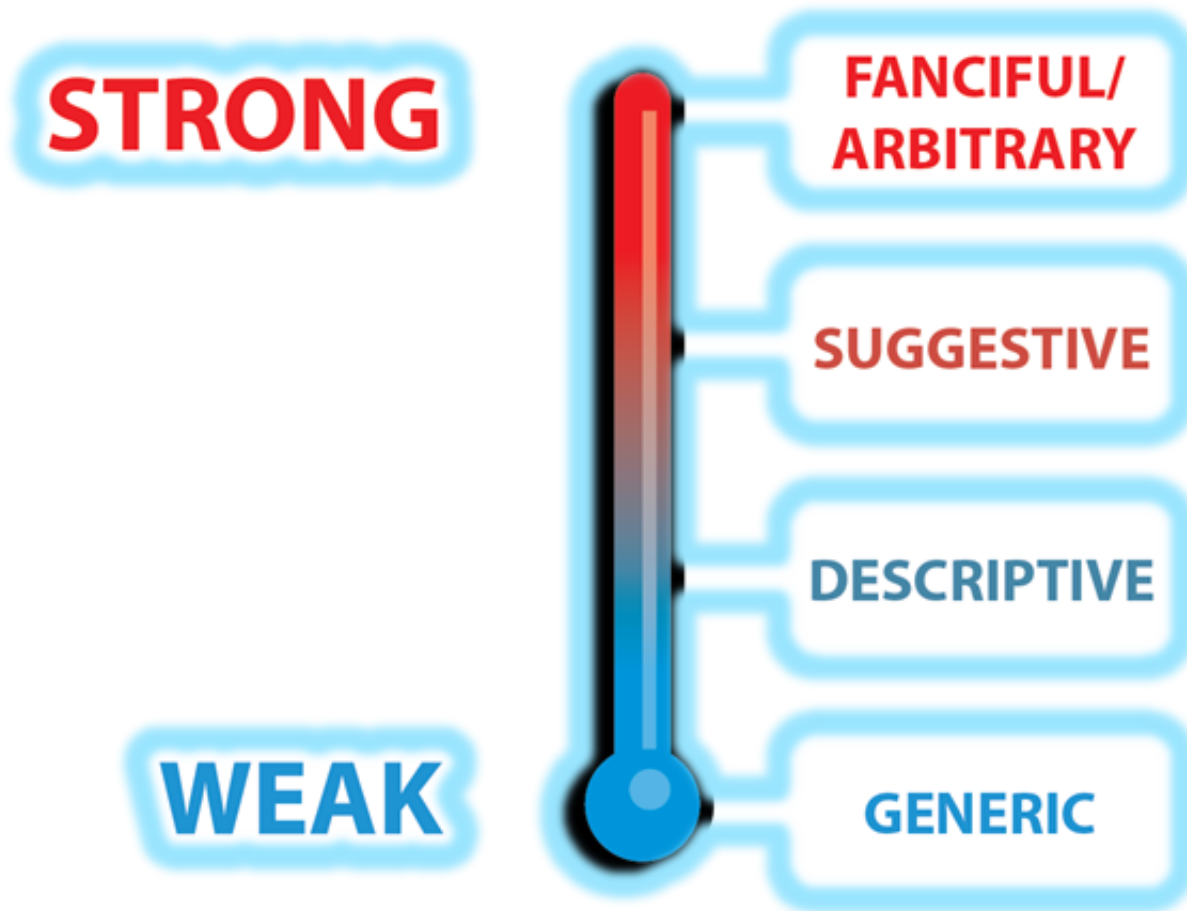
Trademark clearance search

Hire a private trademark attorney:

- Full clearance search
 - USPTO database of registrations and applications
 - State trademark databases
 - Business name registries
 - Foreign trademark databases
 - The internet



Strength of trademark



Discussion topics

Filing and registration

Filing for federal registration

- Create a USPTO.gov account in MyUSPTO.
 - Two-step login process for authentication
 - <https://my.uspto.gov/>
- File using the Trademark Electronic Application System (TEAS).
 - Two filing options: TEAS Plus and TEAS Standard
 - www.uspto.gov/TEAS

Filing for federal registration

- Filing fees per TEAS filing option
 - TEAS Plus: \$250 per international class
 - TEAS Standard: \$350 per international class
- Formula for calculating filing fee
 - Your filing option fee multiplied by the number of international classes in the application



TEAS pre-filing checklist

Pre-filing checklist for your trademark application

Use this checklist to understand the decisions you must make before filing your application.

1. Determine your mark type

Standard character drawing

- To register words, letters, and slogans used as marks, without stylization or design.
- Protects the wording itself without limiting the mark to a specific font style, size, or color.
- Provides broader protection than a special form drawing.

Special form drawing

- To register stylized and design marks.
- If the mark consists of both words and a design, the drawing must depict both the words and the design combined as one image.
- Save a JPG image of your mark to your computer.

2. Check the Trademark ID Manual and identify your goods/services

- The ID Manual lists acceptable identifications of goods and services.
- Find entries that accurately describe your goods/services.
- Inaccurate and unacceptable identifications will result in a refusal to register your mark.

3. Know your filing basis

Section 1(a) - Use-in-commerce filing basis

- To register a mark you have already used in commerce in connection with your goods/services.
- Save a PDF or JPG image of your specimen to your computer. A specimen is evidence of how you actually use the mark in commerce on your goods or with your services.
- For specimen examples, watch the video at www.uspto.gov/Watch/TMINSpecimen.

Section 1(b) - Intent-to-use filing basis

- To register a mark you have not yet used in commerce but have a good faith intent to use in commerce in the future.
- Before we will register your mark, you must:
 - Use the mark in commerce.
 - File an additional form that includes a specimen and an additional fee.

4. Choose your application form

- You must file electronically. There are two online application forms: TEAS Plus and TEAS Standard.
- Learn more at www.uspto.gov/AboutTEAS.

See the reverse side to help determine which TEAS form is right for you.



Registration responsibilities

- Must enforce your own trademark rights.
 - May use your registration certificate to support a “cease-and-desist” letter.
 - May use your registration to sue an infringing user.
- Must file required post-registration documents with the USPTO.



Post-registration requirements

- Required filings
 - Section 8 declaration of use
 - Due between 5th and 6th years after registration
 - Combined Section 8 declaration of use and Section 9 application for renewal
 - Due between 9th and 10th years after registration
 - Then due every 10 years thereafter



Caution: misleading notices

- All application data becomes public information.
- Beware of misleading notices and offers.
 - Usually for fees not required by the USPTO
 - www.uspto.gov/TrademarkSolicitations



Discussion topics

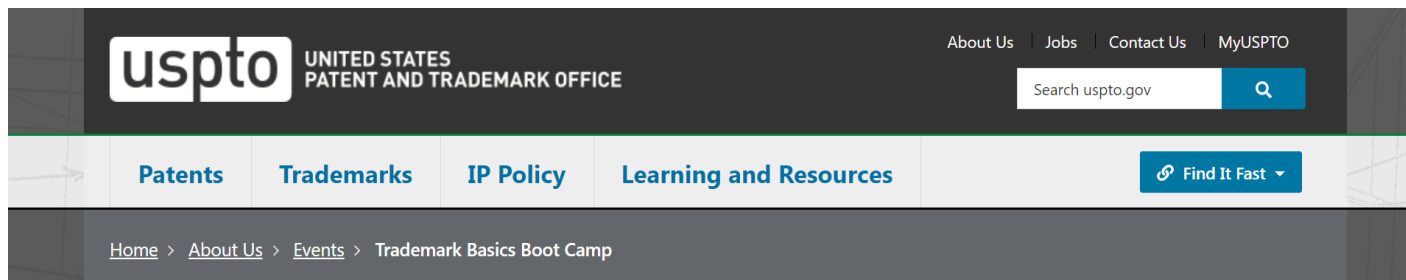
How to find help

USPTO resources

- Website
 - www.uspto.gov
- “Basic Facts About Trademarks” booklet
 - www.uspto.gov/TrademarkBasicsPDF
- Trademark videos
 - www.uspto.gov/TMvideos



USPTO resources



Trademark Basics Boot Camp

This free USPTO event series provides a comprehensive overview of the process for federal trademark registration and maintaining a federal trademark. If you're a small business owner or entrepreneur seeking to protect your brand and product identities, Trademark Basics Boot Camp is for you.

Trademark Basics Boot Camp is offered regularly throughout the year. During each series run, we cover one module weekly for eight weeks, with each module focusing on different aspects of trademarks and the registration process, from filing and examination to post-registration requirements for keeping your registration alive. Each module concludes with a question-and-answer period where you can ask our USPTO trademark experts questions.

You can attend the entire series or just the modules that best match your interests, but you must sign up for each module to attend. If you attend all eight modules, you can request a certificate of attendance. To learn more and sign up, select an individual module from the listing below.



USPTO resources

- Trademark Assistance Center
 - Phone: 1-800-786-9199
 - Email: TrademarkAssistanceCenter@uspto.gov
 - Web: www.uspto.gov/TrademarkAssistance



Questions?

