

# TRADEMARKS

Clearance, Protection & Enforcement Strategies

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# What is a Trademark?

## Definitions

# What is a Trademark?



- Word, phrase, symbol or design
- Can also protect sound or motion mark
- Way to protect a brand name or logo used in connection with products or services
- Business name or domain name alone, without more, is not necessarily trademark use

# US Trademark Rights

## Priority and Use v. Filing



## First to Use Rights

- Product or service must be available to the public
- Transfer or download OK for mobile app (does not have to be sale)
- Must be interstate (across state lines) – although some intrastate activity OK
- Generally limited to the geographic market which the product or service has penetrated



## First to File (Federal)

- Can file even if no use (intent-to-use)
- Three years from notice of allowance to demonstrate use in commerce
- Good way to gain priority over later filers or later users (but you have to begin using your mark in commerce in order to enforce)

# US Trademark Rights – Benefits of Federal Filing



- Valid across the U.S.
- Presumption of validity
- Priority based on date of application
- Prima facie evidence of ownership
- Conclusive evidence after five years - incontestable
- Nationwide constructive notice
- Customs recordation
- Enhanced enforcement remedies (treble damages and statutory damages for counterfeits)
- IP asset in sale/merger/acquisition or series funding
- Circle R symbol ®

# US and Global Trademarks Clearance





## Why?

- Weed out marks/brands that will be difficult to use, register, protect or enforce
- Spend money now in lieu of lawsuit or brand change later
- Global filings can be expensive and class analysis strict – searches can save you from wasting money



## How?

- [www.uspto.gov](http://www.uspto.gov) – use TESS basic search to look for similar marks
- Google, Bing or other search engines
- Vendors – Thomson Compumark, Corsearch, etc.



## What are you looking for?

- “Likelihood of confusion”
- Similar visual or commercial impression (including phonetic)
- Similar goods or services
- Same channels of trade
  - In software, identical marks can coexist if field of use/subject matter is different enough

# US and Global Trademarks

## Filing Strategies



## Online Application (TEAS)

- [www.uspto.gov/teas](http://www.uspto.gov/teas)
- \$275 per mark per class
- Information needed: applicant, state of incorporation, address, name of mark or drawing, goods/services, filing basis, fee and signature
- Can file intent-to-use or use-based (include specimen and date of first use in commerce)



## Typical Prosecution Timeline

- Assigned to an examiner within 3-4 months
- Office actions have six-month deadlines
- Publication period – 30 days
- Notice of allowance (intent to use) or certificate of registration (use based)
- Timing is one to one and half years to registration
- Renewals between 5th and 6th years (incontestability) and 9th and 10th years



## Madrid Protocol

- Within six months of US filing date, can retain US priority date as international filing date
- One application through WIPO designating multiple countries (if members)
- Benefit – can save hundreds or thousands of dollars
- Downside – linked to your US application



## National Filings

- Within six months of US filing date, can retain US priority date as international filing date
- Application is unique to particular country (must use local counsel or local agent)
- Benefit – not linked to your US application
- Downside – expensive



# Global Trademarks – Considerations Before Filing



- Does business plan include international jurisdictions?
- Will you be providing goods/services within 3-5 years? (non-use cancellation risk)
- Risk of squatting? (China, Russia)
- Do you need the trademark registration to own a domain name in that jurisdiction? (Canada)

# US and Global Trademarks

## Enforcement Options

# US Enforcement Options



- Cease and desist letter
- Opposition or Cancellation proceeding at the Trademark Trial and Appeal Board (only impacts registration)
- Litigation (court, use)
- Considerations:
  - Budget (time/resources)
  - Consistency
  - Impact/PR



- Cease and desist letter
- Opposition or Cancellation proceeding (usually for non-use)
- Litigation (court, sometimes based on unfair competition)
- Raids (China typically where counterfeiting)
- Considerations:
  - Potential risk to your mark – make sure in use!
  - Budget (time/resources)
  - Leverage – if US or other jurisdictions impacted
  - Impact/PR

# Trademark Usage

## Frequently Asked Questions

# Trademarks – Frequently asked questions



- Social media – check policies for Twitter, etc. – you may need to own the TM registration in order to enforce, online complaints are easiest
- How to use a trademark the right way – use a TM or SM superscript; use as an adjective NOT a noun or verb
- Domain name transfer – must show bad faith or registration – check for domains when you are deciding on your brand
- Filing logos – assess staying power; standard word marks give broadest protection (any style/font); color or black and white
- Logo usage of customers/partners – only with permission



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# TOTAL ACCESS

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