



# Trademarks and Unfair Competition Law

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# What is a Trademark?

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- ❑ Source identifier and an indicator of quality
- ❑ Protects consumers from confusion and mistake.

# VARIABLE 1: TYPE

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Trademarks



Service Marks



Certification Marks



Collective Membership Marks



# VARIABLE 2: POWER



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Use + Distinctiveness =  
Goodwill

# Generic

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SOUP  
SYSTEM  
BALL  
COMMUNICATION  
SOFTWARE  
INVESTMENTS

# Descriptive

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**The Direct Marketing Association**  
*Helping Direct and Interactive Marketers Succeed!*



# Suggestive

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# Fanciful

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XEROX®

# Arbitrary

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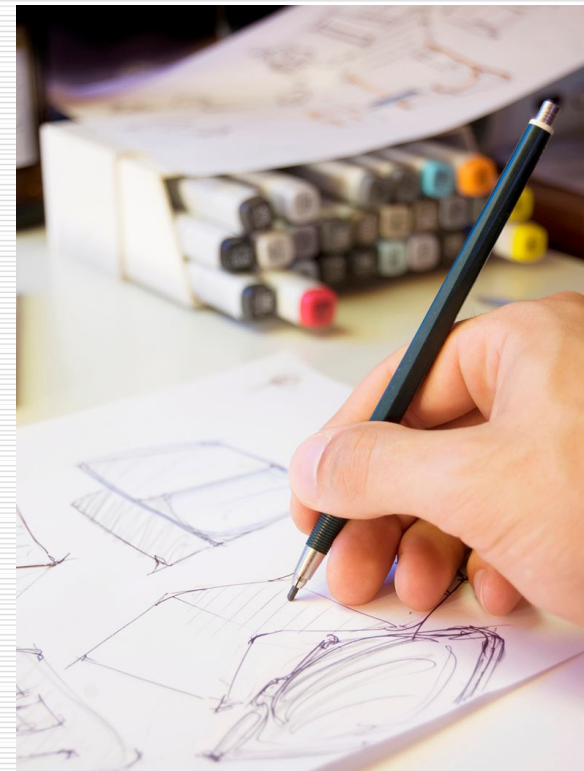


**YAHOO!**<sup>®</sup>



# VARIABLE 3: FORM

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Typed Word

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**MERCEDES BENZ®**

Stylized Word

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Mercedes-Benz

# Design

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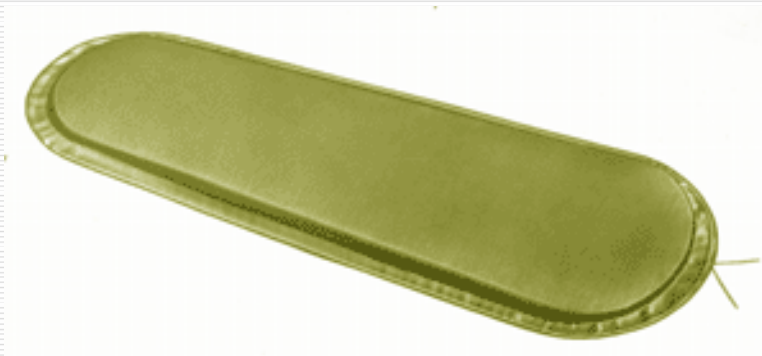
# Combination Mark

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# Colors

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# Smells

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“Oil based metal cutting fluid and oil based metal removal fluid for industrial metal working.”

“The mark is a scent having the scent of bubble gum”

# Sounds

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# Trademark Registration Procedure

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# Is Registration Necessary?

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- How is Your Client Using its Mark?
  - Distinguish the mark from surrounding words
  - Use the TM or SM symbol
  - Use the mark consistently
  - Use the mark as an adjective



# Assess Risks

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- ❑ Searches – preliminary and advanced
- ❑ Assess needs and use
- ❑ Weigh against benefits of registration:
  - Infringement cause of action in Fed. Ct.
  - Resolve disputes based on Fed. Stat.
  - Appear in subsequent searches
  - Use the ® notice
  - Helps with foreign registrations
  - Helps prove exclusive use after 5 years
  - PTO will cite against subsequent apps
  - Constructive notice of ownership/right to use
  - Basis for seizing grey/black market imports

# Prepare the Application

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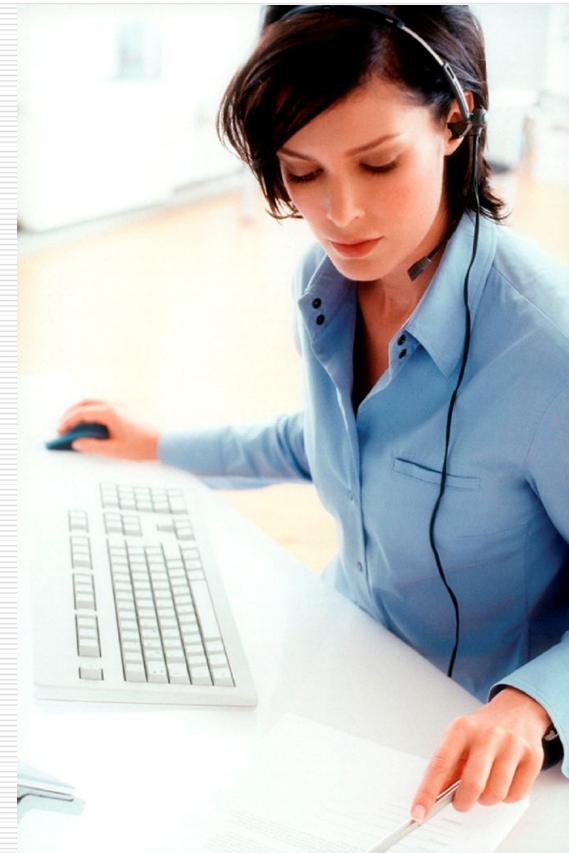
- ❑ Decide Form
- ❑ Craft Goods/Services Description
  - Accurate
  - Broad
  - Consistent
- ❑ Decide Basis
  - Use
  - Intent to use
  - Foreign
  - Multiple bases



# File the Application

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- Attorney advantages
  - Better application
  - Communications protocol
  - Docketing
- Online advantages
  - Instant confirmation
  - Easy
  - Reduces costs
  - Instant access
  - Flexibility
  - Client e-signature



# File an International Application

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- ❑ Determine Importance
- ❑ Work through counsel in country
- ❑ Explore transnational Applications (EU, Madrid Protocol)



# Know Examination Procedure

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- Tell them to use the Mark
- Assigns to Examining Attorney
- Office Action – Substantive or Technical
- Response
- Publication
- NoA or Registration



# Post Registration

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- Docket
- Evidence of Use
- Watching
- U.S. Customs registration
- Devise Enforcement/Defense program
- Find Profit sources



# Enforcement: Policing

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- Benefits
  - Stand Out
  - Strengthens
  - Protects against loss
- Assess risk
- Assess resources



# Types of Policing

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- ❑ Simple – uses resources available
- ❑ Basic – uses counsel but at low cost
- ❑ Advanced – uses counsel and watch services and is more complete



# Before You Attack

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- Follow Client Policy
- Monitor systematically
- Research!
- Evaluate
- Report



# Preliminary Actions

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- Cease and Desist Letters
- Internet Options
- Protest Letter
- Extensions of Time
- Settlement Options



# Appropriate Actions

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	<b>Opposition</b>	<b>Cancellation</b>	<b>TM Infringement</b>
<b>When Filed?</b>	When published or during extension	After registration	When a mark is causing damage
<b>Grounds</b>	Client will be damaged by the registration	Likelihood of confusion, descriptiveness, generic, abandonment, fraud	Likelihood of confusion, dilution

# Licensing As Enforcement

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- ❑ Broadens use
- ❑ Establishes proper use
- ❑ Another basis for action



# Trademark and Trade Dress Infringement

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# Using Court as Enforcement

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## □ Advantages

- Valid threat
- Favor commerce and prior user
- High profile

## □ Disadvantages

- Coordination
- Capacity
- Cost



# Effective Trade Dress Case

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- ❑ Inherent Distinctiveness
- ❑ Non-Functional



# Effective Trademark Infringement Case

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- ❑ Protectable Mark
- ❑ Used Mark Before Defendant's Mark
- ❑ Likelihood of Confusion
  - Marks identical/similar
  - G/S identical/similar
  - Close proximity of g/s
  - Similar consumer
  - Low degree of care in selection
  - Product line likely to expand
  - Actual confusion
  
- ❑ Damage



# Dilution

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- Famous Mark
- Blurring
- Tarnishing



# Federal Trademark Dilution Act

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## □ Must Show:

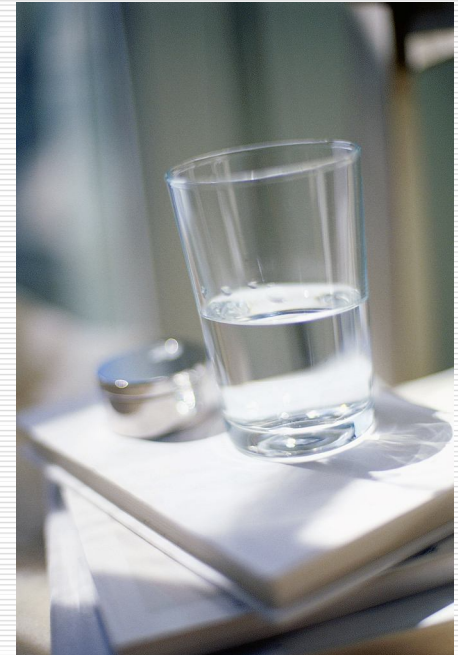
- Mark is famous
- Defendant using mark in commerce
- Defendant mark adopted after fame
- Defendant's use dilutes plaintiff's Mark



# The Future of Dilution

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- Trademark Dilution Revision Act
  - Blurring, tarnishment = dilution
  - No niche fame
  - Likelihood, not actual, dilution
  - Willfulness, intention
- Lingering Controversy
  - Likelihood of dilution measurement
  - Court interpretation of blur and tarnish
  - Fair use?
  - Damage measurement



# Trademarks and Targeted Online Advertising

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- Metatagging
- Keying search terms
- Suggesting search in adwords
- Cybersquatting
- Cyberjacking
- Typosquatting
- Targeted online advertising



# Online TM Action Problems

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- No Use in Commerce
  - Product placement?
  - No actual use
  - Comparative advertising?
- Use in Commerce
  - Taking advantage of goodwill
  - Diverting customers
  - At least initial interest confusion

# Other Online TM Causes of Action

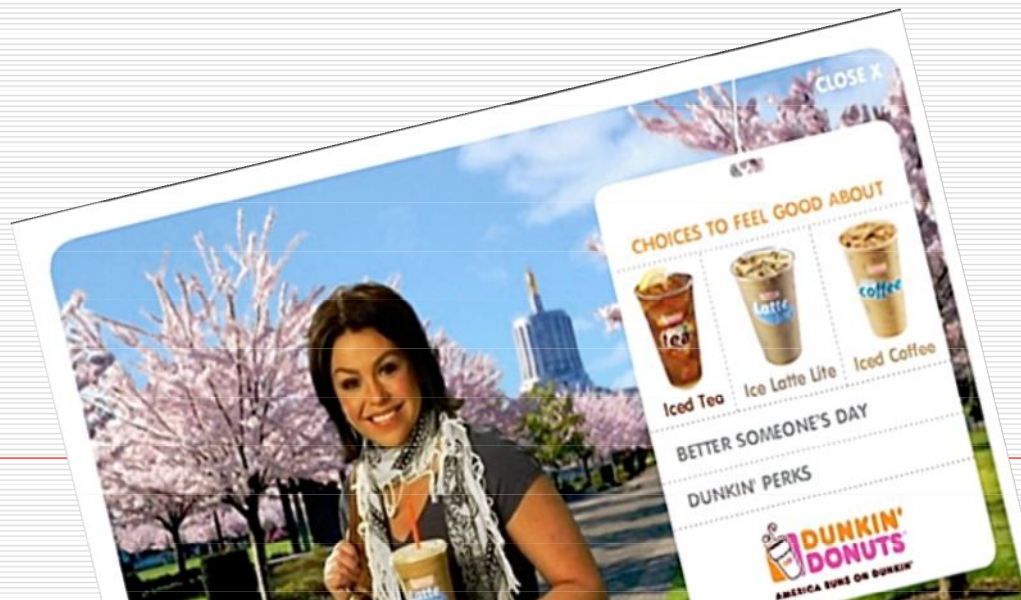
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- Dilution
- Unfair competition
- False Advertising
- Cybersquatting

# Recommendations

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- ❑ State source for ad
- ❑ Understand increased risk
- ❑ Watch state/fed legislation
- ❑ Watch tech/industry self-regulation





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