



TRADEMARK SMARTS

THOMSON COMPUMARK
You can't be more certain.™



THOMSON REUTERS

ABOUT THIS BOOK



The first edition of this booklet was published in 1994 as *The Trademark Shuffle*. The new edition, *Trademark Smarts*, was written to serve as an even better educational tool, with more information and detail.

Like *The Trademark Shuffle*, *Trademark Smarts* originated from course material developed to help teach students interested in the paralegal profession and trademarks. This booklet now serves as a useful resource not only for students, but also for anyone with an interest in trademarks. If you are a trademark owner, an attorney, a paralegal, a product manager, a teacher or someone interested in the related concepts and procedures, *Trademark Smarts* is for you.

Even though reading *Trademark Smarts* will make you smarter about trademarks in general, readers should be cautioned not to assume they are trademark experts. Always consult a trademark attorney regarding the implementation of specific trademark procedures.

DIRECTORY

About the Author	4
SECTION 1: TRADEMARK BASICS	5
The Importance of Trademarks.....	5
Trademark Definitions	5
Obtaining Trademark Rights	6
Trademark Strength.....	7
Infringement	8
SECTION 2: U.S. TRADEMARK PROCEDURES	10
Trademark Searching.....	10
Federal Applications.....	11
Processing U.S. Federal Trademark Applications	12
Maintenance	13
Enforcement of Trademark Rights	14
Proper Trademark Usage.....	14

AUTHORED BY:
 Colleen Sarenpa
 Copyright © 2007/2009 Colleen Sarenpa

PUBLISHED BY:
 Thomson CompuMark
 500 Victory Road
 North Quincy, MA 02171-3145
 Tel (800) 692-8833
 compumark.thomson.com

ABOUT THE AUTHOR



Colleen Sarenpa is the Intellectual Property Manager at Polaroid Corporation, a company that pioneered instant photography, and has become a leading consumer electronics company under the Polaroid brand. Ms. Sarenpa’s prior experience was at International Multifoods Corporation as the Trademark Manager and as a Senior Trademark Specialist with the Minneapolis law firm of Faegre & Benson LLP. This experience as well as her extensive corporate experience at General Mills, Inc. where she worked for 23 years has given her a wide perspective on trademark related issues. She holds a certificate in Paralegal Studies as well as a B.A. in Organizational Studies from Bethel College.

Ms. Sarenpa is a past member of the INTA Board of Directors. She also served as the project team leader for developing advanced level educational materials and exams for non-lawyer trademark professionals. Other volunteer work with INTA includes serving as Chair of the INTA Trademark Administrator’s Committee and Co-Chair of the 2001 INTA Trademark Administrator’s Forum. Currently, she is a member of the Leadership Development Subcommittee of the Membership Services Committee and the Annual Meeting 2009 Project Team. Ms. Sarenpa also developed and taught the trademark class in the post-baccalaureate paralegal program at the Minnesota Paralegal Institute.

Ms. Sarenpa may be reached via email: colleen.sarenpa@polaroid.com.

SECTION 1:

TRADEMARK BASICS



THE IMPORTANCE OF TRADEMARKS

Need proof of the importance of trademarks?

Just look around you, at names like Coca-Cola®, McDonalds® and Polaroid®. It could easily be argued that trademarks are a company's most valuable asset. Effective trademarks are more than just names. They help define the level of quality the customer will receive, and tie products to an overall corporate image. In fact, trademarks serve as the basis for many of our everyday decisions and choices, establishing some order in a chaotic world of choices.

Following are some short definitions of the terms used most often in the world of trademarks, along with answers to some frequently asked questions.

TRADEMARK DEFINITIONS

What is meant by Intellectual Property (IP)?

IP is much like any real or tangible property you might own, such as a house, car or boat, except that it is intangible. You can't touch it because it emanates from the mind as an idea for a product or service.

Rights Protected by U.S. Copyright:

- Copyrights—Original works of authorship or artistic creation that are fixed in a tangible form (e.g., a song, photo or poem).
- Patents—Novel inventions such as a machine, formula or process for making something. Or, an improvement to an existing invention.
- Trademarks—Identifiers of source and quality for the products/services they identify.
- Trade Secrets—Confidential business or technical information.

In addition to trademarks, where can I find more IP information?

Thomson CompuMark has a number of educational references available, including:

- Life Cycle of a Trademark
- Life Cycle of a Copyright
- The Client Times newsletter

For more information, visit compumark.thomson.com or call (800) 692-8833.

What is a trademark?

Trademarks are words, names, symbols, slogans, tag lines, characters and designs. Trademarks can also be colors (e.g., pink insulation), sounds (e.g., lion roar), scents (e.g., scented yarn), product configuration (e.g., shaped bottle), or trade dress (e.g., look/feel of a restaurant). Depending on the nature of the trademark, issues such as distinctiveness and secondary meaning may need to be considered to determine registrability and protectibility.

Why are trademarks important?

Trademarks identify goods and services coming from a single source and serve to establish good will with the consumer, enticing that consumer to repurchase the goods or services based upon the name or source of the goods or services. They also distinguish a manufacturer's or merchant's goods or services from those manufactured or sold by others. In other words, TRADEMARKS = REPUTATION.

If trademarks are source identifiers, do I need to know the name of the manufacturer of the goods?

NO. What is important is that you know the product comes from a single source—even though the source may be unknown. For example, when a consumer buys a POLAROID digital camera in New York, that same consumer wants to know that the POLAROID digital camera he/she may later purchase in California is of the same quality.

How can I tell if a word is a trademark?

When a word is used in connection with a product or service, but it is not used as it is defined by the dictionary, it is probably capable of being a trademark. The display of a ™ symbol or ® symbol also indicates that a word is considered a trademark.

What is the difference between a trademark and a service mark (SM)?

A service mark is a trademark that is used in the sale or advertising of services (e.g., restaurant services, banking services, etc.). However, since the distinction between goods and services is not always clear, the term trademark is often used to encompass service marks as well. For purposes of this booklet, both are referred to as trademarks.

What is the difference between a trademark and a trade name?

A trademark is used with specific goods or services and identifies the source of those goods or services. A trade name identifies a company and its business.

Because words can be used interchangeably as both a trademark and a trade name, depending on the context of use, close attention to trade names should be given in determining the use of a trademark.

For example:

- If used as an adjective: "Get your Thomson CompuMark trademark search." It is a trademark.
- If used as a noun: "Get your trademark search from Thomson CompuMark." It is a trade name.

OBTAINING TRADEMARK RIGHTS

How do I establish trademark rights?

USE, USE, USE. In the U.S. you don't have to register a trademark to earn certain rights and protections.

So, if I use my trademark without a federal trademark registration, what kind of rights do I have?

Common law rights. The level of protection depends on the jurisdiction involved, and remedies are determined from interpretation of relevant case law(s).

What trademark protection do I get under common law rights?

Without a federal trademark registration, your trademark rights may only cover the geographic area in which the trademark is being used.

A problem may occur when the territories of two common law trademark owners with similar trademarks on similar goods overlap. Most often, the owner that first used the trademark in the contested market will prevail and the other owner will be prevented from expanding into the overlapping territory. However, it is important to note that these situations are not categorical—the facts for each circumstance need to be examined to determine the outcome.

What trademark rights do I get with federal trademark registration?

The primary benefit of obtaining a federal trademark registration is that it establishes nationwide protection to registered marks, regardless of the areas in which the mark is actually being used.

NOTE: If use can later be provided, filing an application based on an intent to use (ITU) will provide the Applicant with a constructive use date, effective from the filing date of the application (See Section 2).



TRADEMARK STRENGTH**What determines the strength of a trademark?**

Trademark strength can be determined by fitting a mark into one of the following categories:

	DEFINITION	EXAMPLES
Coined	No dictionary meaning	CHEX – Cereal, HYDROX – Cookies POLAROID – TV
Arbitrary	Words used out of context	OCEAN SPRAY – Juice CAMEL – Cigarettes
Suggestive	Hints at or suggests the nature/attribute of a product	HAMBURGER HELPER – Dinner Mix SLIM FAST – Meal Replacement Drinks
Descriptive*	Describes product, ingredients or attributes	VISION CENTER – Optical Center EXTRA STRENGTH – Aspirin
Generic	Common description, can never be a trademark	Baking soda, telephone

* A descriptive term (including surnames) may be capable of becoming a trademark if it is shown that the term is recognized as emanating from a single source or possessing a "secondary meaning." In other words, it is not just an identifier of a thing or person.

How important is professional input when determining the strength of a trademark?

There are a lot of fine lines to consider when evaluating the strength of a trademark, especially when determining if a trademark is suggestive, descriptive or generic. Even the best trademark experts will disagree on this very subjective topic, emphasizing the need for professional input.

Even though analysis and expertise are required to determine trademark strength, are there some general guidelines I can follow?

YES. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it conveys an immediate idea as to the ingredients, qualities or characteristics of the goods. A term is generic if it has significance to the public as the principal name for something.

What are some other advantages of obtaining federal trademark registration?

- Enables you to use the registration notice "®" and notifies others of your trademark rights.
- Safeguards future opportunities for nationwide expansion.
- Provides access to federal courts.
- Allows for the possibility of greater recovery of damages for infringement.
- An application or registration acts as a deterrent. By placing the mark on the register, you alert others who may want to use your trademark that it is already being used.
- Gives the registrant the ability to stop importation of goods that utilize infringing marks, by depositing a copy of the registration certificate (and subsequent renewal certificates) with U.S. Customs.

What is the difference between the symbols ™ and ®?

No formal filing is necessary to use a ™. It can be used at any time to inform the public that trademark rights are being claimed by the owner. The ®, on the other hand, can only be used if the trademark is federally registered.

What act are trademark rights defined under?

The Lanham Act, passed by Congress on July 5, 1946, provides for a federal registration system and establishes remedies for trademark infringement. It was first introduced as a bill in 1945 by Congressman Fritz Lanham.

What makes a trademark owner eligible to obtain a federal trademark registration?

Use of a trademark in interstate commerce in direct association with a product or service. Generally, use of the trademark only in advertising does not constitute trademark use for purposes of obtaining a federal trademark registration. Service marks are an exception to this rule, with each situation requiring the appropriate assessments.

What is the definition of "commerce"?

The Lanham Act defines "commerce" as any commerce lawfully regulated by Congress. Lanham defines "use in commerce" as the bona fide use of a mark in the ordinary course of trade. This use generally comprises commerce between two states (i.e., interstate commerce) or between the U.S. and a foreign country.

What if I don't use my mark in more than one state?

You still have common law rights. You can obtain a state trademark registration, which functions as a public record, alerting others to your common law rights within that state. State trademark registrations can also provide certain state statutory rights. State registrations are quick and cheap, serving, at the very least, as a deterrent to third parties who may be searching the state databases in an effort to clear a mark for use and/or registration.

If you intend to eventually use your trademark in interstate commerce, you should consult with your trademark attorney about filing a federal trademark application based on intent to use (see Section 2).

Do trademark rights extend from one country to another?

NO. Every country has its own trademark laws. There are over 200 countries with individual trademark laws. While trademark rights are territorial, and many of the basic concepts found in U.S. trademark law hold true in other countries, there are also many differences, including the establishment of trademark rights. Consultation with an attorney is recommended.

How far do trademark rights extend?

To avoid confusion between trademarks, the courts and the Trademark Office usually look at the relationship of the goods/services in which the mark is used. In other words, with the exception of famous marks (e.g., COCA-COLA, POLAROID, TIFFANY), trademark registration does not give you a total monopoly over every use of a mark. A mark which is similar to another mark may still be registrable if the marks are used in connection with sufficiently different goods or services, and such simultaneous use is not likely to confuse a consumer.

What is meant by the uniqueness of a trademark?

In addition to registrability, the relative strength or weakness of a mark also affects the scope of protection. In other words, is the mark unique enough to distinguish the goods or services of one from the goods/services of another.

INFRINGEMENT**How can I be sure that someone else isn't already using my proposed trademark on similar goods or services?**

By researching your proposed mark through an attorney who is well versed in trademark law. Taking these steps will tell you if it can be adopted and used without infringing on someone else's rights (see Section 2).

Whether clearing a mark or protecting an existing mark, how is trademark infringement determined?

Infringement occurs when the marks used on two respective goods are likely to cause confusion, mistake or deception with regard to source, affiliation or sponsorship. Because Trademark Law is a way to proactively prevent consumer confusion, actual confusion is not necessary to claim infringement, just the likelihood of confusion.

What are some tests for likelihood of confusion?

- Similarity between trademarks in appearance, sound, and/or meaning. (e.g., "RAID" vs. "RAZE" for insecticide or EASY SPRAY vs. EZ SPRAY for window spray or HURRICANE vs. CYCLONE for fencing).
- Similarity between goods/services (e.g., breakfast cereal vs. breakfast bars).
- Marketing environment or channels of trade. Does one user sell exclusively at retail and the other exclusively to commercial buyers?
- Strength of senior trademark. BETTY CROCKER/COKE/MCDONALDS, for instance, are so well known that use of these trademarks even in unrelated areas is likely to be damaging.
- Likelihood of a senior trademark expanding into the product category of a junior trademark. (e.g., women's apparel vs. women's shoes).
- Intent of a junior trademark user's adoption. (e.g., knowingly adopting a trademark to benefit from the reputation of a well-known trademark).
- Buyer sophistication. Are the goods inexpensive and purchased with little thought, or are they expensive and therefore warrant careful consideration with regard to purchasing?





Does any other cause of action exist to stop someone else from using my trademark?

YES. There is the possibility of a dilution action either under Federal law or the laws of several states. As defined by Section 45 of the Lanham Act, “the term ‘dilution’ means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties OR (2) likelihood of confusion, mistake or deception.” Determining whether dilution exists is a very complex aspect of trademark law, requiring the expertise of a trademark attorney.

Where do domain names come into play with trademark rights?

In many ways, the “click & mortar” world is no different than the “brick & mortar” world from the standpoint of evaluating trademark infringement. Remembering that simultaneous use of mark by different owners can exist, it is important to remember that two or more companies can have a legitimate good faith basis for seeking the same domain name.

If someone is using my trademark within their domain name, what should I consider?

In addition to considering the “brick & mortar” elements of infringement, you should look for elements of bad faith on the part of the domain name owner such as:

- Did the domain name owner register a domain name that is identical or similar to your well-known mark and then tried to sell the domain to the you for inflated sums of money.
- Is the domain name owner using your trademark in the meta tags for the vendor’s own website so that search engines will direct customers looking for the trademark products to the competitor’s website instead.
- Is your trademark being used on a third party’s website and using them on their own website to imply some authorized connection to your mark and product.

How can someone else be stopped from using my trademark as a domain name?

Either the Anticybersquatting Consumer Protection Act (ACPA) which is a suit brought in Federal Court or The Uniform Domain Name Dispute Resolution Policy (“UDRP”). To familiarize yourself with the processes, visit www.icann.org/udrp.

Remember, given that trademark rights are territorial and usually limited to related products/services, and domain names tend to cross product/service categories and countries, the issues can be complex and uncertain. Because of these complexities and uncertainties, it is clearly advisable to consult an expert.

CONGRATULATIONS!

You are ready to proceed to Section 2.

SECTION 2: U.S. TRADEMARK PROCEDURES

TRADEMARK SEARCHING

What should be included in a U.S. trademark search?

Most often, coverage should include U.S. Federal and State trademark registers as well as common law sources (Dun & Bradstreet® references, telephone directories, business/trade directories, Internet, domain names, etc.).

What are the steps in the research process?

First, a preliminary (screening or knock-out) search should be conducted. A full (clearance) search should follow.

What is a preliminary search?

This type of search consists of an on-line search of federal and state trademark registers and sometimes the Internet to find common law uses. It narrows your list of potential trademarks by “knocking out” possible conflicting trademarks. It is usually conducted through trademark counsel within an internal law department or through outside trademark counsel.

What is a full search?

Once you have screened your list of potential marks using an outside searching service, such as Thomson CompuMark, you can conduct a full search on your best remaining possibilities. This comprehensive search examines multiple permutations of your mark, checking them against U.S. state, federal and common law (including Internet) databases—providing a basis for final clearance of your trademark.

Should domain names also be searched?

YES! Domain names may be registered for use in connection with a business that offers products/services related to your proposed products/services. Also, people often try to find a web site by searching for a well-known trademark. Additionally, you’ll want to find out in what context your proposed trademark is being used on the web, and also if it is available as a domain name.

How difficult is it to analyze a trademark search to determine if I can use my trademark?

On the surface, it may seem easy to review the results. However, there are many elements that need to be considered in evaluating a full search, and an expert in trademark law is often necessary to help avoid misinterpretations.

Several factors must be considered by this expert including the strength of the trademark, the likelihood of confusion, whether or not further investigation into a cited trademark is necessary, whether a business name will be a problem, or if some minor alterations to the proposed trademark can make it work. In addition to determining the availability of your trademark, an expert will also be able to tell you if your trademark is capable of being federally registered, how protectable your trademark is based on its strength, and how many similar names exist.





Once I have cleared a trademark with a trademark availability search, what happens next?

You are now ready to file a U.S. Federal Trademark Application.

FEDERAL APPLICATIONS

What types of trademark applications can I file?

- USE-BASED
- INTENT TO USE (ITU)

What is a use-based trademark application?

As mentioned in Section I, to obtain a federal trademark registration, a trademark must be used in commerce in direct association with a product or service. A use-based application is filed when actual use of the trademark in commerce has commenced prior to the time when one first considered filing an application.

What is an ITU trademark application?

Before actual trademark use takes place, an ITU (Intent To Use) application can be filed on the basis of good faith intent (bona fide intention) to use the mark in commerce. Eventual use of the mark in commerce is required before issuance of a registration.

What is bona fide intention to use?

This term indicates that the intention to use a mark is in good faith (without deceit, and not merely to reserve a mark).

What is the benefit of filing an ITU application?

Subject to the issuance of a registration, an ITU application constitutes constructive use of the mark, effective as of the filing date. As suggested in Section I's discussion regarding establishing rights, this constructive use date affords the applicant a nationwide right of priority on the mark for the specified goods or services, until such time that they can show use.

Is this right of priority granted against prior users of, or applicants/registrants for, the trademark?

NO. The right of priority is only given with regard to all subsequently filed applications and any other party who subsequently commences use of the mark on similar goods or services.

How much is the application fee?

Currently, depending on the form used in the Trademark Office, the fee ranges from \$275 to \$375 per international class, subject to change at any time. (ITUs incur additional fees as they progress to registration).

What is meant by per class?

For purposes of internal administration, the U.S. Patent and Trademark Office places goods and services into the International Classification System (e.g., toys are placed in International Class 28).

What is the International Classification System?

Most countries use international classes to categorize trademarks. Classes serve as a guideline for filing trademark applications, searching trademarks and maintaining records. There are currently 45 classes. (A breakdown of these classes can be found in the Thomson CompuMark rate guide, or in the IP Resources section of the Thomson CompuMark website, compumark.thomson.com.)

Is one type of application preferred over the other?

YES. Most of the time an ITU is the preferred application. For reasons previously discussed regarding constructive use, it rarely makes sense to wait until actual use of a mark has commenced to file a use-based application.

PROCESSING U.S. FEDERAL TRADEMARK APPLICATIONS

How much time is allowed before proof of use must be shown for ITU applications?

Proof of use must be confirmed within 36 months of the Notice of Allowance date.

What is the Notice of Allowance date?

It is a date issued once the ITU application passes initial examination and is published for opposition. The Notice of Allowance establishes due dates (in six-month increments from the mailing date of the Notice of Allowance) within which a Statement of Use or an Extension of Time must be filed.

What is an Extension of Time?

After the initial six-month filing period for the Statement of Use, up to five additional six-month extensions may be granted. A bona fide intention to use the mark is necessary to obtain an extension. Extensions cost \$150 per class.

What is a Statement of Use?

A Statement of Use is a document providing the ITU applicant with an opportunity to allege use of the mark in commerce on all or some of the goods or services. It can only be filed after issuance of the Notice of Allowance or within a given six-month extension, but within 36 months from the Notice of Allowance date. Statements of Use cost \$100 per class.

What is meant by examination?

Examining attorneys and paralegals at the Trademark Office examine both the use-based and ITU applications for technical and substantive problems. The attorneys determine factors such as: whether any conflicts exist on the register; if the trademark is merely descriptive; and if the description of goods and the classification are properly set forth.

NOTE: The examining attorneys in the Trademark Office only determine whether one can register a trademark, not whether one can use a trademark.

How do I know if my trademark application has passed through the examination process?

You will receive a Notice of Publication from the Trademark Office if no issues are found by the examining attorney. However, if there is an issue, you will receive an Office Action from the Trademark Office stating the concerns of the examining attorney. A reply must be made to the examining attorney within six months from the mailing date of the Office Action. The absence of a response will result in the loss of the application. If the response is not satisfactory to the examining attorney, further Office Actions can be issued. Upon a satisfactory response to the examining attorney, the application will be published for opposition. If a satisfactory response to an issue is not achieved, the application may be finally rejected.

What is meant by Published for Opposition?

Printed materials like the Official Gazette inform the public of applications for trademark registration with the United States Patent and Trademark Office (USPTO) and offer third parties an opportunity to stop registration of a published trademark by filing a notice of opposition. This review of trademark application publications is called policing. Many companies use trademark watching services to police Official Gazettes and other publications throughout the world. In the U.S. there is a 30-day deadline beyond the publication date to file an opposition or obtain an extension of time to file the opposition.

What if my application is opposed?

Usually, a challenging party will obtain an extension of time to oppose the published trademark in the hopes of reaching an amicable settlement. If settlement efforts are unsuccessful, an opposition is filed and the case will be heard before the Trademark Trial and Appeal Board of the U.S. Trademark Office.

What if my application is not opposed?

If you filed a use-based application, the certificate of registration will issue shortly. If you filed an ITU application, the Notice of Allowance will issue. Once the Statement of Use is submitted and accepted, the certificate of registration will issue.

CONGRATULATIONS!

You are now the owner of a U.S. Federal trademark registration.





MAINTENANCE

What changes occur when a U.S. Federal Trademark Registration is issued?

The trademark notice changes from ™ to ®.

Once registered, do trademark rights last forever?

NO. Since Federal trademark rights are based on use, a Registrant must inform the U.S. Trademark Office from time to time through Section 8 Affidavit and renewal filings of its continued use of the mark in order to maintain its registration.

What is a Section 8 Affidavit of Use?

A Section 8 Affidavit of Use is a verified statement attesting to the continued use of a mark. In other words, the registrant affirms that the trademark is being used in commerce in connection with all or some of the goods and services specified in the original registration.

When does the Section 8 Affidavit of Use need to be filed?

A one-time Section 8 Affidavit has a deadline of the sixth anniversary after the issuance of the registration. This filing can occur at any time after the five-year mark. A Section 8 Affidavit must also be filed ten years from the initial registration date as well as all subsequent ten-year periods throughout the life of the registration. This filing can occur at any time after the nine-year mark, ending at the ten-year mark of each ten-year increment. An example of the trademark being used must accompany the affidavit. Failure to file the Section 8 Affidavit will result in cancellation of the federal registration. The filing fee is currently \$100 per class. A 6-month grace period is granted over the six-year and ten-year deadlines at an additional cost of \$100 per class.

.....
NOTE: There are special situations where an Affidavit of Non-Use can be filed. These circumstances should be reviewed by a trademark attorney.

What is a Section 9 renewal?

It is a request for renewal, filed every ten years from the registration date. Remember, if a Section 8 is also not filed, the Section 9 renewal will not be accepted. Therefore, the Section 8 is typically filed along with the Section 9. The filing fee is currently \$400 per class. A six-month grace period is granted over

the ten-year deadline at an additional cost of \$100 per class. Failure to file the Section 9 renewal will result in cancellation of the federal registration. The combined Section 8 & 9 renewal filing fee is currently \$500 per class.

Are there any other documents that I am required to file?

NO. However, at any time after the mark has been used continuously for a five-year period, the registrant has the option to file an affidavit of incontestability—referred to as the Section 15 Affidavit. With the Section 15 Affidavit the validity of the registration becomes incontestable, making it immune from most challenges. The filing fee is currently \$200 per class.

Why are affidavits and renewals necessary?

To eliminate “dead wood” in the Trademark Office.

Can trademarks be sold or rented?

YES. A trademark can be sold through an assignment. This grants the buyer all rights to the trademark, including the good will associated with the trademark. Through a license, a trademark can be “rented” exclusively or non-exclusively to others.

Does a trademark assignment or license need to be recorded anywhere?

NO. However, if the transaction is an assignment involving applications or registrations (i.e., not common law rights), such a transaction should be made a matter of record in the Trademark Office to avoid complications when subsequent filings with the Trademark Office are made. In other words, disruption in the chain of title will require explanation and a recording of the assignment in order to obtain and/or maintain the registration. The current recordation fee per document is \$40 for the first trademark record, and \$25 for each additional trademark record.

If the transaction is a license, there is no need to record. In fact, most companies choose not to record licenses because they are not documents that will affect ownership of the trademark.

Do other documents affecting the owner’s title need to be filed?

As with assignments, if a name change, a merger or state of incorporation has changed the status of the owner, the document should be recorded. This step keeps the chain of title clear.

ENFORCEMENT OF TRADEMARK RIGHTS

What steps can I take to make sure others are not infringing my marks?

Watch for similar/same trademarks in use on similar/same goods.

What resources are available for watching (policing) my marks against infringement?

Day to day efforts can include employee awareness, sales people awareness, newspaper circulars, television advertising, and day to day marketplace exposure.

Other methods include monitoring the Official Trademark Gazette, available at www.uspto.gov/web/trademarks/tmog, or subscribing to a trademark watching service that will notify you of potentially confusingly similar trademarks that have been published. Domain name watch services are also available. Thomson CompuMark offers a comprehensive range of trademark and domain name watching services.

What is the risk of not policing my marks?

If not done or done too little, your mark can be weakened and its value diminished which can possibly result in a loss of rights.

PROPER TRADEMARK USAGE

Why is it important to use trademarks properly?

Misuse of a trademark diminishes its strength. Loss of distinctiveness can result in marks becoming public domain. The term “genericide” is used to reflect that a trademark has become the generic term for the goods or services.

What are the rules of thumb for using a trademark properly?

Trademarks are adjectives—not nouns or verbs. A trademark is not a thing or a kind of thing. It is a brand for a thing.

Example: Make a Polaroid® picture, NOT take a Polaroid.

Suggestions:

- Follow a trademark by its generic name (Kleenex® tissues)
- Place a ™ or ® next to a trademark (Kleenex® tissues)
- Follow a trademark with brand (Kleenex® brand tissues)

DO: “Polaroid® cameras are fun!”

DON’T: “A Polaroid® is fun.”

DO: HUNGRY JACK syrup is thick.

DON’T: HUNGRY JACK is a thick syrup.

CONGRATULATIONS!

You now have Trademark Smarts!



IF YOU ARE A
TRADEMARK OWNER,
AN ATTORNEY, A PARALEGAL,
A PRODUCT MANAGER,
A TEACHER OR SOMEONE
INTERESTED IN THE RELATED
CONCEPTS AND PROCEDURES,
TRADEMARK SMARTS
IS FOR YOU.

500 Victory Road
North Quincy, MA 02171-3145
Phone (800) 692-8833

thomsonreuters.com
compumark.thomson.com

THOMSON COMPUMARK
You can't be more certain.™



THOMSON REUTERS