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Helen Hall
Host

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TRADEMARKS 101:

What you Need to Know When Trying to Brand Your Products



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Topics to be Discussed

- What is a Trademark
- Types of Trademarks
- Levels of Trademark Protection
- How to Effectively use Trademarks in Marketing
- How to Obtain Trademark Rights

What is a Trademark?

- Intangible asset protectable at law
- Identifies and distinguishes goods and services (“Products”) in the marketplace
- Distinguished by the symbols:

TM ® SM



What is a Trademark (cont.)



- Distinguished from other intellectual property (IP) assets
 - Patents – protect inventions (machines, processes, designs, etc.)
 - Copyrights – protect “original work of authorship” (books, music, architectural works, etc.)

Functions of a Trademark

- Indicates source of origin of Product
- Can be used as a marketing tool to build a brand
- Helps guarantee the quality of Product with the mark
- Creates and maintains demand for the Product
- Acts as an asset to a company

Types of Trademarks



Word



GUESS

Crest

Brushing beautiful smiles for life

Name



TIFFANY & CO.



Symbol



Sound

MGM's Lion Roar



NBC Chimes



Pillsbury doughboy



Color

- Home Depot - orange



- Owens-Corning - pink



Device



Scent

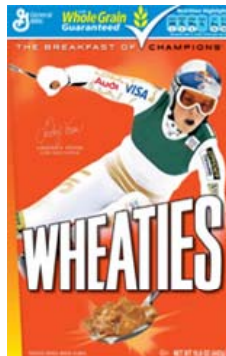
Clarke – plumeria scented
thread



Slogan



"The king of beers"



"Breakfast of champions"

Domain Name

www.google.com



www.amazon.com



Service Marks



Levels of Trademark Protection



Fanciful

No meaning before use of trademark



Arbitrary

Common word, but use is not related to their definition(s)



Suggestive

Allude to some characteristic of the Product



Descriptive

Describe the Product they are marketed alongside



Generic

If used, it would identify a whole class of Product



BEWARE OF “GENERICIDE”!

Must be careful how
your trademark is
used, otherwise, can
“fall” all the way from
protected to
unprotected

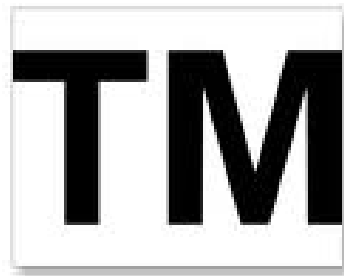


How to Effectively use Trademarks in Marketing



Use Symbols

Puts everyone on notice!



Use as Adjectives

Trademarks are adjectives, not nouns!

Drink a cup of Starbucks[®] coffee.

NOT

Drink a cup of Starbucks.[®]



Don't use Trademarks in Possessive Form

Aveeno[®] lotion's active ingredient is dimethicone.

NOT

Avenno's[®] active ingredient is dimethicone.



Make your Trademarks Stand Out

Use bold font, italicize, use all caps or underline your trademarks



SHERWIN-WILLIAMS.

Sherwin-Williams® Paint

Sherwin-Williams® Paint

SHERWIN-WILLIAMS® Paint

Sherwin-Williams® Paint

Do Not Use Trademarks as Verbs

Make a copy on a Xerox[®] machine.

NOT

Xerox[®] a copy.

Do Not Make Trademarks Plural

Buy a dozen Shipley[®] do-nuts.

NOT

Buy a dozen Shipleys.[®]



How to Obtain Trademarks

- Use
(Common Law – even if you seek Federal Registration, must use the trademark!)
- Trademark rights are based on territory and type of Product

Make it Yours

- You do not need to register your trademark before you use the symbol TM!
 - » Use it early, use it often!
- You DO need federal registration to use the symbol ®

Why Register Your Trademark in the USPTO?

- Nationwide protection (greater territory!)
- Use of ® has better benefits than ™
- Evidence of the validity of your trademark
- Better protects your brand
- Your right to a federal registered trademark becomes incontestable after 5 years of continuous use
- You can sue in Federal Court
 - Better recovery for infringement – statutory damages, attorney's fees, etc.
- You can claim priority for registration in foreign countries
- You can stop importation of goods which infringe

Process of Obtaining a Registered Trademark

- File application with USPTO
 - Application is Examined
 - May have to go back and forth with Examining Attorney to get the green light – “Trademark Prosecution”
 - Approval of Application
 - Application is “Published for Opposition”
 - Notice of Allowance or Certificate of Registration Issues
 - 10 Year Term + Renewals
- (* *Entire process is ~2 years)



Bringing a Few Points Together

- When coming up with a brand for your Product, think outside the box...strive for fanciful or arbitrary
- Do a search to find out if there are any competitors with similar trademark in advance to avoid chance of infringement
- As soon as you start using a brand for your Product, use TM until you can use ®

Any Questions?

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