



BOOTH UDALL FULLER

INTELLECTUAL PROPERTY LAW

Trademarks 101

1.

Types of Trademarks

Types of Trademarks

- ▷ Word
- ▷ Name
- ▷ Symbol
- ▷ Logo
- ▷ Color
- ▷ Sound
- ▷ Scent
- ▷ Trade Dress
- ▷ Collective mark
- ▷ Certification mark

2.

Requirements

The trademark must be both:

Distinctive

A mark must be able to identify a single source of goods or services.

Used in Commerce

A protectable mark must be used to offer and sell goods and services across state lines

2.

Registration

An application is classified as either:

In Use

For marks currently being used in commerce

Intent to Use

The applicant intends to use the mark in commerce, though actual use has not yet taken place

Trademark applications require the following elements:

- ▷ Applicant's information
- ▷ Attorney's information
- ▷ A clear image of the mark
- ▷ A list of the specific goods and services

and....

3. Specimens

What is a specimen?

- ▶ The USPTO requires proof that the proposed mark is actually being used in commerce, in association with the goods and services listed on the application



What counts as a specimen?



Website Screenshots

For services, a screenshot showing the proposed mark in association with promoting those services.



Business Cards, Signage, etc

For services, a picture of business cards, signage, or a point-of-sale display



Clothing Label

For clothing, a picture of the label showing the proposed mark.



Product Itself

A picture of the product itself with the proposed mark visible



Product Packaging

For physical goods, the product packaging itself, or a picture of the packaging showing the proposed mark.



Other

If you have any questions regarding whether a particular specimen will be sufficient, we'd be happy to advise you.

4.

Why Register?

Advantages of registration:

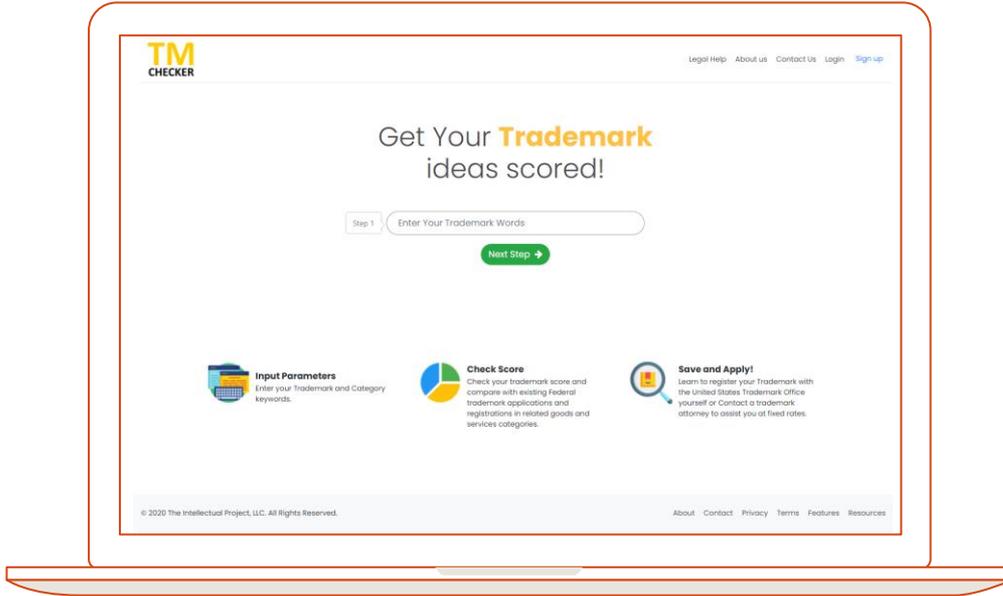
- ▷ Serves as proof of trademark validity and ownership
- ▷ Provides nationwide protection
- ▷ Makes available increased damages if infringement occurs
- ▷ Right to use ®

5.

Trademark Clearance

Initial Search

TMchecker.com is a free resource you can use to check the availability and strength of a mark being considered, but it's not exhaustive.



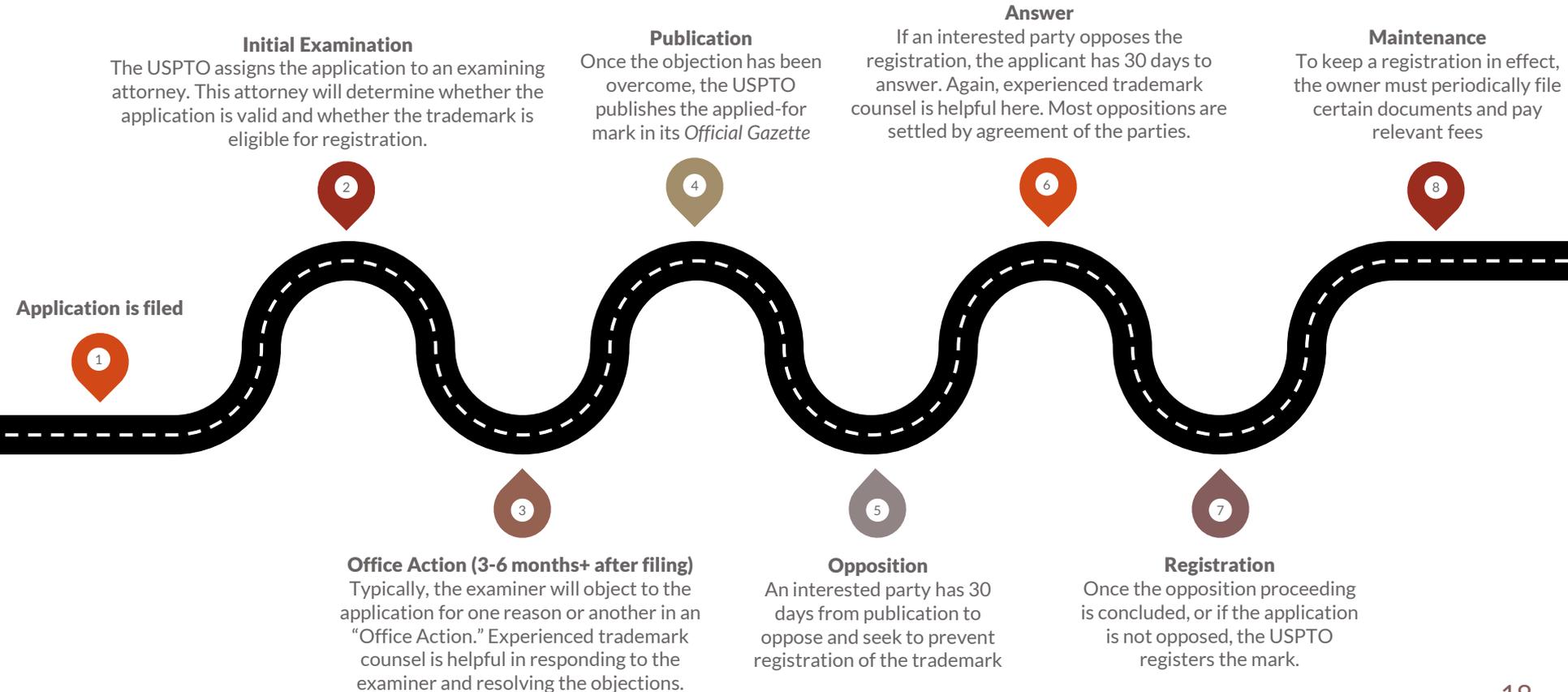
We'd be happy to conduct a full search, which may include:

- ▷ The internet
- ▷ Business/trade name directories
- ▷ Periodical databases
- ▷ Domain name registries
- ▷ Dictionaries
- ▷and more

6.

Post-Application Procedure

Roadmap



7.

Self-Audit

Periodically, you should conduct an audit of your trademark portfolio

- ▶ **Which trademarks have been registered?** Ensure registration still reflects current business offering. Ensure appropriate personnel are being notified well in advance of maintenance fee/filing deadlines.
- ▶ **Which trademarks have pending applications?** Ensure relevant personnel are being notified of application updates and responding accordingly.
- ▶ **Which products/services are being offered for which trademarks need to be registered?** If new products are services are added, a new mark may need to be registered, or an existing mark expanded.
- ▶ **Identify any trademarks that are no longer of business interest.** Determine a strategy. Either abandon or seek third-party purchaser/licensee.
- ▶ **Assess trademark conflicts.** Existing and potential litigation, opposition/cancellation proceedings, cease and desist letters, etc.
- ▶ **Assess compliance with trademark agreements.** Ensure obligations are met, maintenance tasks are being completed, and key agreement deadlines are known.
- ▶ **Assess policies and procedures.** Establish and evaluate style guides and internal/external trademark usage guidelines.

Of course, we'd be happy to conduct a more thorough, in-depth audit of your portfolio.