

# Trademarks

Law 115 | Week 5 | Lecture 9 Rachael Vaughn

## Agenda

- 1. Purpose of Trademark Law
- 2. What Can Be A Trademark
- 3. Requirements for Protection
- 4. How to Get Protection
- 5. TM, SM and ® Symbols
- 6. Developing a Strong Mark

### Purpose of Trademark Law





What assumptions do you make about the cereal on the left vs. the cereal on the right based on the branding?

### Purpose of Trademark Law

# Consumer Benefits

- Prevent consumer confusion
- Lower search costs
- Guarantee a level of consistency

## Business Incentives

- Recoup investment in the form of goodwill
- Distinguish themselves from competitors

### What Can Be a Trademark

Anything that distinguishes the source of a product or service from the products or services of others.

- Symbols
- Tag lines/slogans
- Colors
- Smells, sounds
- Product shapes









### Requirements for Protection

Federal Trademark Statute: The Lanham Act (15 U.S.C. § 1051)

#### Not Confusing

 Cannot be confusingly similar to another mark

#### Distinctive

- Inherently distinctive
- Acquired
  distinctiveness
  through
  secondary
  meaning

#### Limitations

- Cannot be functional
- Cannot be generic

### How to Get Protection

- Use: use your mark in commerce to secure state (common law) or federal protection
- 2. Register: register your mark with the USPTO with the "intent to use" it in commerce at a later time



### How to Get Protection

If you acquire rights though **use**, you must:

- 1. Use the mark in a commercial context; AND
- 2. Display the mark so that it is physically associated with the product or service

If you register with an **intent to use**, you must file a "statement of use" (describing the actual use in commerce) within 6 months after allowance (can be extended for up to 36 months)

### TM, SM and ® Symbols



TM or SM is used to identify a common law trademark or service mark, and puts the public on notice that your use of the mark is a common law trademark.

® is used to identify trademarks or service marks that have been registered with the USPTO. Use of the symbol puts the public on notice that the mark is a registered trademark.



## Developing a Strong Mark

**Tip 1:** Select a mark that is not **confusingly similar** to another mark. A mark is considered confusingly similar if it's likely to cause deception/confusion as to:

- Source of the goods or services; or
- Affiliation or connection with a company that uses similar mark; or
- Whether the mark is actually sponsored/owned/approved by the company that owns the similar mark.





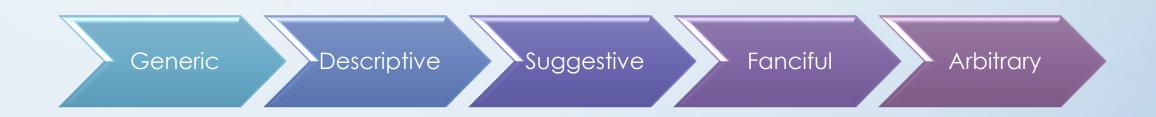
# Developing a Strong Mark

**Tip 2:** Do not use a mark in a manner that **avoids genericide**. A trademark becomes generic when it becomes the generic name that is synonymous with a general class of goods or services.



### Developing a Strong Mark

**Tip 3:** Select a mark that is **distinctive**. Strength of protection and ability to register depend on the mark's distinctiveness. The spectrum of distinctiveness from weakest to strongest...



Weakest

Strongest