



Trademarks

Law 115 | Week 5 | Lecture 9
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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

1. **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 through **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...

