

UNITED STATES
PATENT AND TRADEMARK OFFICE





Trademark basics: What every small business should know now, not later

Mariessa Terrell

Attorney Advisor, Trademarks Customer Outreach

Images used in this presentation are for educational purposes only.



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Discussion topics

- Trademark fundamentals
- Benefits of federal registration
- Selecting a trademark
- Filing and registration
- How to find help

Discussion topic

Trademark fundamentals

What is a trademark?



Discussion topic

Benefits of federal registration



Common law trademark rights

- Rights
 - Created when you use trademark in commerce
 - Limited to geographic area where mark is used
- Symbols
 - Optional: TM SM
 - Never: ®





Federal registration rights

- Rights
 - Created when you federally register trademark
 - Legal presumption you own the trademark
 - Legal presumption you have the right to use the trademark in all 50 states and the U.S. territories
 - Notice to the public of your rights in the trademark
 - Permitted: ®



Discussion topic

Selecting a trademark



Trademark selection challenges

- Remember:
 - The mission of the USPTO is to register any trademark that is eligible for registration.
 - Not every trademark is registrable.
 - Not every trademark is enforceable.
 - Select a trademark that is both federally registrable and legally protectable.





Registrable and protectable

Two main concepts:

- Likelihood of confusion
 - Likelihood of confusion refusal
- Strength of the trademark
 - Descriptiveness refusal

Discussion topic

Selecting a trademark: Likelihood of confusion



Likelihood of confusion

- **Concept:**
 - Avoid confusing consumers about the source of the goods and services.
- **Test:**
 - Are the trademarks confusingly similar?
and
 - Are the goods and/or services related?





Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

T.MARKEY

for

pants





Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

TEE MARQEE

for

pants





Likelihood of confusion example

Your trademark

T.MARKEY

for

shirts

Registered trademark

TEE MARQEE

for

golf flags





Suggestions for searching

- On your own:
 - USPTO database
 - New trademark search system
 - www.uspto.gov/trademarks/search
 - The internet
 - Option for searching for common law use



Discussion topic

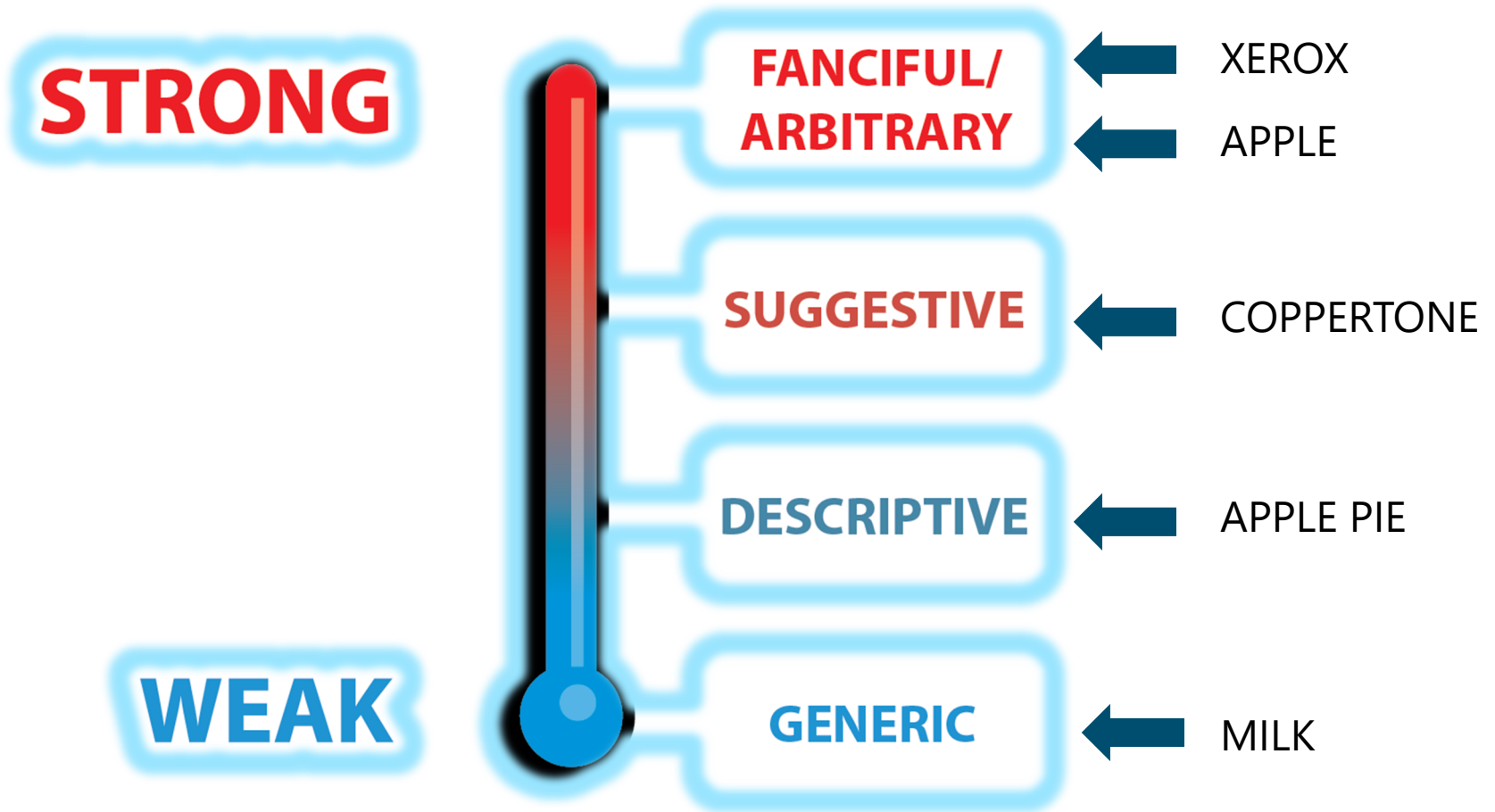
Selecting a trademark: Strength of the trademark



Strength of trademark

- **Concept:**
 - Avoid using trademarks that fail to indicate the source of goods and services.
- **Test:**
 - Does the trademark merely describe the goods and services?

Strength of trademark



Discussion topic

Filing and registration



Filing for federal registration

- Use the Trademark Electronic Application System (TEAS).
 - TEAS filing options
 - TEAS Plus: \$250 per international class
 - TEAS Standard: \$350 per international class
 - Total fee determined by how many classes you include in the application



Filing for federal registration

- Application requirements
 - Clear **drawing** of the trademark
 - Listing of the **goods and services** used with the trademark
 - Application **filing basis** for each good or service
 - **Contact information** for the trademark owner
 - Filing **fee**





Registration responsibilities

- Must enforce your own trademark rights.
 - May use your registration certificate to support a “cease-and-desist” letter.
 - May use your registration to sue an infringing user.
- Must file required post-registration documents with the USPTO.



Discussion topic

How to find help



How to find help

- Trademark Assistance Center
 - www.uspto.gov/TrademarkAssistance
- Trademark basics registration toolkit
 - www.uspto.gov/TrademarkBasicsToolkit
- Trademark Basics Boot Camp webinars
 - www.uspto.gov/about-us/events/trademark-basics-boot-camp



Questions?

