#### Library

## Start Your Business: Trademark Basics

Azalea Ebbay Librarian, San Diego Public Library

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May 27, 2020



UNITED STATES

PATENT AND TRADEMARK OFFICE

**USDTO** 

The City of



## Overview

- Patent and Trademark Resource Center with Azalea Ebbay
- San Diego Volunteer Lawyer Program, Inc. with Roya Bagheri
- Trademark Basics with Jason Lott
- Questions & Answers



## Patent and Trademark Resource Center

- Provide free access to patent and trademark resources provided by the USPTO
- Direct you to information and explain the application process and fee schedule
- Demonstrate how to use patent and trademark search tools
- Show you a directory of local patent attorneys and agents who are licensed to practice before the USPTO
- Assists with patent searches for an ancestor's inventions
- Offers free educational programs

Note: We cannot provide business or legal advice. We cannot perform patent or trademark searches.



2019 Start Your Business event with San Diego Volunteer Lawyer Program, Inc. and Procopio





Kid's Invent It Month, a children's themed program



Teaching patents to high school students for UCSD Rady School of Management's LaunchPad program









You can borrow free small business eBooks with your library card on CloudLibrary.

You can also pick up your holds at select San Diego Public Library locations as of May 26<sup>th</sup>.

### Contactless Pickup Service

at the San Diego Public Library

11 LOCATIONS · WEEKDAYS · 10:30 A.M. - 5:30 P.M. BEGINS TUESDAY, MAY 26



sandiego.gov/pickupservice



## Upcoming WebEx Events

All events take place from 2:00-4:00 p.m. PST.





#### June 10th: Learn How to Draft a Patent Application with Paul Yen

https://sandiego.librarymarket.com/events/start-your-business-learn-how-draft-patent-application-webexevent

#### June 17th: Trademark Application Walk-through with Jason Lott

https://sandiego.librarymarket.com/events/start-your-business-trademark-application-walk-throughwebex-event San Diego Volunteer Lawyer Program, Inc.

## Microbusiness and Nonprofit Support Program (MNSP)



Pursuing justice Transforming lives

### San Diego Volunteer Lawyer Program, Inc.

SDVLP is a 501(c)(3) nonprofit law firm that has provided free legal help to disadvantaged San Diegans since 1983.

### Microbusiness and Nonprofit Support Program:

Provides free legal services to:

- qualifying entrepreneurs and microbusinesses in San Diego, and
- nonprofit organizations whose primary purpose is to serve disadvantaged, low-income San Diegans.



## **Microbusiness Support:**

Staff and volunteer attorneys provide legal help in a variety of transactional legal areas, including:

- Business Entity Formation (LLCs, Partnerships, Sole Proprietorships, etc.)
- Review and Drafting of Business Contracts
- Lease Agreements
- Intellectual Property (Trademarks, Copyrights and Patents)
- Employment Issues
- Insurance
- Permitting



### Microbusiness Application and Eligibility:

- Application is available on our website: <u>www.sdvlp.org</u>
- Individual must be low-income and a resident of San Diego County. We will evaluate an individual's financial situation as well as all business partners.
- In some cases, if you are starting a new business, we will need to see a business plan.



### Microbusiness Support Screening Form



IMPORTANT: Due to limited resources, we can only help residents of San Diego County. If you do not live in San Diego County, please do not complete this form. There may be similar assistance available where you live. IMPORTANTE: Debido a los recursos limitados, sólo podemos ayudar a los residentes del Condado de San Diego. Si usted no vive en el Condado de San Diego, favor de no llenar este formulario. Es posible que haya una asistencia similar disponible donde usted vive.

Please do not complete this form if you are seeking help for a <u>nonprofit organization</u>. Please <u>click here</u> to download the Application for Legal Services for nonprofit organizations.

Your information / Su información

First Name / Nombre \* Middle Name / Segundo Nombre Last Name(s) / Apellido(s) \*

Maiden Name or Other Name(s) Used / Apellido de Soltera u otros nombres utilizados

How did you hear about SDVLP's legal services? / ¿Cómo se enteró de los servicios legales de SDVLP?

Date of Birth / Fecha de Nacimiento \* Last 4 digits of your Social Security Number / Últimos cuatro números de seguro social

### **MNSP** Process:

- If you are deemed eligible for our services, we will discuss your business and issue spot the potential legal issues.
- We will reach out to pro bono attorneys to place your case with a subject matter expert.
- You will work one-on-one with your assigned pro bono attorney.
- SDVLP remains involved throughout the process until the case is fully completed.



## **Microbusiness Support:**

- Intellectual Property:
  - Trademarks:
    - Assist entrepreneurs with protecting the name and logo of their business.
  - Copyrights:
    - Assist entrepreneurs protect their own original works of authorship, and properly use other copyrighted work.
    - For example: A catering business using photographs that other people took for their website.
  - Patents:
    - Will assign a patent attorney to assist entrepreneur with entire patent application, including designs, filing, and follow up communication with USPTO.



### **COVID-19 Small Business Brief Legal Advice Clinic**

- Our program just launched a brief legal advice clinic to assist small businesses and nonprofit organizations impacted by the pandemic.
- Volunteer attorneys will provide remote consultations to eligible businesses on legal issues arising out of the pandemic, including questions relating to:
- Labor and Employment
- Real Estate/Commercial Leases
- Insurance
- Contracts
- Tax Law
- Paycheck Protection Program

- SBA Economic Injury Disaster Loans/Grants
- Small Business Debt Relief Program
- Business Operations (e.g., operating as an essential business)
- Bankruptcy/Restructuring
- Other COVID-19 Related Questions



### **COVID-19 Small Business Brief Legal Advice Clinic**

- Consultations will last up to 45 minutes, and are provided free of charge.
- Small Businesses can apply at: <u>SDVLP.ORG/COVID-19-MNSP</u>
- Or Call: (619) 235-5656 ext. 130



### **Questions?**

Roya Bagheri, Esq. Staff Attorney rbagheri@sdvlp.org (619) 235-5656, ext. 131



#### UNITED STATES PATENT AND TRADEMARK OFFICE



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

Attorney Advisor for Trademark Educational Outreach Jason Lott

May 27, 2020

Images used in this presentation are for educational purposes only.

UNITED STATES PATENT AND TRADEMARK OFFICE

### **BUSINESS PLAN?**

## TRADEMARK COMPONENT IN YOUR BUSINESS PLAN?

## **Discussion topics**

- What is a trademark?
- Benefits of federal registration
- Selecting a trademark
- How to find help



### WHAT IS A TRADEMARK?

#### Interbrand

#### **Best Global Brands 2019**

01	02	03	04	05	06	07	08
Ú	Google	amazon	Microsoft	Coca:Cola	SAMSUNG	ΤΟΥΟΤΑ	
<b>+9%</b> 234,241 \$m	<b>+8%</b> 167,713 \$m	+ <b>24%</b> 125,263 \$m	+ <b>17%</b> 108,847 \$m	<b>-4%</b> 63,365 \$m	<b>+2%</b> 61,098 \$m	<b>+5%</b> 56,246 \$m	<b>+5%</b> 50,832 \$m
09	10	11	12	13	14	15	16
M	Disnep		IBM.	(intel)	6	cisco	-
+ <b>4%</b> 45,362 \$m	<b>+11%</b> 44,352 \$m	<b>+1%</b> 41,440 \$m	<b>-6%</b> 40,381 \$m	<b>-7%</b> 40,197 \$m	<b>-12%</b> 39,857 \$m	<b>+3%</b> 35,559 \$m	<b>+7%</b> 32,376 \$m
17	18	19	20	21	22	23	24
LOUIS VUITTON	ORACLE	E	SAP	HONDA	CHANEL	AMERICAN EXPRESS	pepsi.
+ <b>14%</b> 32,223 \$m	+ <b>1%</b> 26,288 \$m	<b>-22%</b> 25,566 \$m	<b>+10%</b> 25,092 \$m	<b>+3%</b> 24,422 \$m	+ <b>11%</b> 22,134 \$m	<b>+13%</b> 21,629 \$m	<b>-1%</b> 20,488 \$m
25	26	27	28	29	30	31	32
J.P.Morgan	TREA	ups	HERMÉS	ZABA	HaM	accenture	Budweiser
<b>+8%</b> 19,044 \$m	<b>+5%</b> 18,407 \$m	+ <b>7%</b> 18,072 \$m	<b>+9%</b> 17,920 \$m	<b>-3%</b> 17,175 \$m	<b>-3%</b> 16,345 \$m	+ <b>14%</b> 16,205 \$m	+ <b>3%</b> 16,018 \$m

https://www.interbrand.com/best-brands/best-global-brands/2019/ranking

## **Trademark definition**

Any word, slogan, symbol, design, or combination of these that:

Identifies the source of your goods and services

and

• **Distinguishes** them from the goods and services of another party.

## **Trademark definition**

Any word, slogan, symbol, design, or combination of these

### Can also be a **sound**, a **color**, or a **smell**



### **Trademark examples**

Sound

### Smell

THE MARK COMPRISES THE MUSICAL NOTES G, E, C PLAYED ON CHIMES

THE MARK CONSISTS OF THE STRAWBERRY SCENT OF THE GOODS



### **Trademark examples**

### Color







#### **Mark Information**

Before the USPTO can register your mark, exactly what the mark is must be clear. You may present your <u>mark</u> in one of the following ways: (1) <u>standard characters</u>, if not claiming a particular font style, size, and/or color; (2) <u>special form</u>, if the mark includes a design or word(s) combined with a design, or **is** displayed in a particular font style, size, and/or color; or (3) non-visual sound mark (for this type of mark, you should include a musical score, and an audio file, as well as a detailed mark description). Do **not** upload your specimen of use (sample of actual use, e.g., a label or advertisement) here. This will be required in a different part of the form (if appropriate for your filing basis). **WARNING:** You may submit only **one** mark per application, if your application includes multiple marks, it may be denied a filing date or refused registration.

When you click on one of the three circles presented below, and follow the specific instructions, the form will automatically create a separate page that displays the mark for which you are applying or permits the applicant to attach an audio file for a sound mark. Please carefully review this page prior to final submission to the USPTO, to ensure that it accurately depicts or represents your mark. You may not be permitted to <u>change or correct your mark</u> after filing this application. While minor changes in the mark may *sometimes* be permitted, changes that result in a <u>material alteration</u> of the mark as originally filed will result in the USPTO issuing a refusal on that ground.

NOTE: For an instructional video on the importance of conducting a search of existing trademarks or service marks before filing your application, <u>click here</u>.

\* Click the appropriate circle to indicate the Mark type: 

<u>Standard Characters</u>
<u>Special Form (Stylized and/or Design)</u>
<u>Sound mark</u>

NOTE: For an instructional video on the importance of selecting the proper mark type, <u>click here</u>. NOTE: For an instructional video explaining how to fill out the Mark Information page, <u>click here</u>.

Enter the mark here: (Note: The entry can be in capital letters, lower case letters, or a combination thereof. Do not include the <sup>TM</sup>, <sup>SM</sup>, (B), or (C) symbols after the mark entry, because they are not part of the actual mark. If using Internet Explorer, the entry cannot exceed **2036** characters; otherwise, you must switch to another browser.)

Preview USPTO-Generated Image

**NOTE**: For how the USPTO determines what the display of the entered mark will be, click <u>here</u>.

NOTE: For information about mark display in USPTO databases, click here

## **Types of trademarks**

Word mark

COCA-COLA

Stylized mark



Composite mark



Design mark uspt

## **Types of trademarks**

Word mark

COCA-COLA

Stylized mark



Composite mark



Design mark

## TRADEMARKS, PATENTS, AND COPYRIGHTS

## **Trademark** Brand for goods and services

## Patent

Protects inventions

## **Copyright** Protects original artistic works





#### Patent



Copyright



#### **Trademark**



## **Trademark** Can last indefinitely

### **Patent** Utility: 20 years

### Design: 15 years

**Copyright** Life of the author, plus 70 years



## DOMAIN NAMES AND BUSINESS NAMES

### **Domain name**

# Web address for finding a site on the internet

Examples: USPTO.GOV COPYRIGHT.GOV






### **Business name**

Name under which you do business in a particular state

Examples: ABC MANUFACTURING, INC. XYZ CONSULTING, LLC





# **Different types of registration**

Domain name registration **≠** Federal trademark registration

### Business name registration **≠** Federal trademark registration



### Trademark

Brand for goods and services

### Patent

Protects inventions

# Copyright

Protects original artistic works

### Domain name

Web address

### **Business name**

Entity name under which you do business



### BENEFITS OF FEDERAL REGISTRATION

### **Common law trademark**

Trademark that is used in commerce in connection with specified goods and services.

Rights are limited to a particular geographic area.



# Federally registered trademark

Trademark that is used in commerce in connection with specified goods and services **and** is registered with the USPTO.

Rights are granted throughout the United States and its territories.



# Federally registered trademark

- Legal presumption that owner of the mark
- Legal presumption of right to use the mark
- Puts public on notice of ownership of the mark
- Mark is listed in the USPTO database
- Can record registration with U.S. Customs and Border Protection
- Right to bring law suit regarding mark in federal court

USD

- Can use registration as a basis for foreign filing
- May use the federal registration symbol: ®

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### **SELECTING A TRADEMARK**

### **Trademark selection challenges**

- Not every trademark registers.
- Even if the mark registers, it might not be enforceable.
- Your mark should be **federally registrable** and **legally protectable**.



# **Registrable and protectable**

Two main concepts:

- Likelihood of confusion
- Strength of mark



Consumers are likely to assume a relationship between the mark in your application and a mark registered to another party.



### Two-prong test:

### 1. Marks are **similar**.

Look alike; sound alike; have similar meanings; and/or create similar commercial impressions.

### and

### 2. Goods and services are **related**.

Consumers mistakenly believe the goods and services come from the same source.

### X-SEED for "agricultural seeds"

### EXCEED for "live plants"



LUPO for "pants"

WOLF for "shirts"



### Trademark clearance search

- Trademark Electronic Search System (TESS) www.uspto.gov/SearchTrademarks
- State trademark databases
- Internet search





#### **United States Patent and Trademark Office**

Home Site Index Search FAQ Glossary Guides Contacts eBusiness eBiz alerts News Help

#### Trademarks > Trademark Electronic Search System (TESS)

Welcome to the **Trademark Electronic Search System (TESS)**. This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to **likelihood of confusion**.

#### **Select A Search Option**

Basic Word Mark Search (New User) This option cannot be used to search design marks.

Word and/or Design Mark Search (Structured) This option is used to search word and/or design marks.

Word and/or Design Mark Search (Free Form) This option allows you to construct word and/or design searches using Boolean logic and multiple search fields.

#### **Additional Search Options**

Browse Dictionary (Browse Dictionary)

This option browses all fields in the database unless you limit to a particular field.

#### Search OG Publication Date or Registration Date (Search OG)

This option searches the Official Gazette for marks published or registered on a particular date.

### Additional search assistance

- Hire a private trademark attorney.
- Contact the Law School Clinic Program.
- Watch the USPTO trademark videos.
  www.uspto.gov/TMVideos





# Strength of mark

Determines how easy or hard it is to protect your mark against other marks





### **Generic terms**

# Common, everyday terms for goods and services

Examples: BICYCLE for "bicycles" MILK for "a dairy-based beverage"



### **Descriptive marks**

Directly describe something about the goods and services

Examples: CREAMY for "yogurt" THE BREATHABLE MATTRESS for "mattresses"



### **Suggestive marks**

Suggest some quality of the goods and services

Examples: QUICK 'N NEAT for "pie crust" GLANCE-A-DAY for "calendars"



### Fanciful marks/Arbitrary marks

Inherently distinctive



### **Fanciful marks**

### Invented words



# 





### **Arbitrary marks**

Actual words, but no association with the goods and services





**BlackBerry** 



# Marketing concerns

Descriptive marks:

May be easy to understand, but hard to protect

Fanciful and arbitrary marks: May be easy to protect, but hard to understand



### "Genericized" marks

Trademarks that have lost their trademark significance

Examples: ZIPPER ESCALATOR YO-YO



# **Policing your mark**

### Educating consumers how to use it properly









### **Trademark selection concerns**

- Likelihood of confusion
- Strength of mark
- Primarily merely a surname
- Geographically descriptive
- Deceptive or falsely suggesting a connection
- Misspelling of descriptive/generic wording
- Title of a single creative work
- Ornamental matter



### HOW TO FIND HELP

### **USPTO resources**

- USPTO.GOV
- Basic Facts About Trademarks booklet
  www.uspto.gov/TrademarkBasicsPDF
- Basic Facts About Trademarks videos
- Trademark Information Network videos
- TEAS Nuts and Bolts videos

www.uspto.gov/TMVideos





### Trademark videos

For an overview of trademarks, watch **Basic Facts About Trademarks: What Every Small Business Should Know Now, Not Later** (approximately 40 minutes).

#### Browse all our videos

Click below to browse the videos we recommend.

> If you haven't started your application

> If you are filing out your application

> If you successfully filed your application

### **USPTO contact**

**Trademark Assistance Center** 

### Contact:

Web: www.uspto.gov/TrademarkAssistance Email: TrademarkAssistanceCenter@uspto.gov Phone: 1-800-786-9199


# **USPTO** restrictions

The USPTO does not:

- Provide legal advice
- Enforce trademark rights



# Advantages of hiring attorney

- Obtain or conduct pre-application clearance search
- Interpret search results
- Navigate the application process
- Advise you on the scope of your rights
- Advise you how to police and enforce your rights

# Finding an attorney

- Free information on USPTO.GOV
- Check local telephone listings
- Search online
- Check with local or state bar associations
- Check with American Bar Association





# **Other sources of assistance**

- Free and reduced-price legal services
- USPTO Law School Clinic program
- SCORE program
- Patent and Trademark Resource Centers www.uspto.gov/PTRC
- Free information on USPTO.GOV





About INTA Member Resources Public Resources Programs and Events Membership and Committees Newsletters and Media Job Bank Membership Directory



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Login



#### Mission

Through its Pro Bono Committee, INTA has established the Trademark Clearinghouse pilot program to bolster the protection of intellectual property by matching eligible clients facing trademark issues with INTA member attorneys so that legal services can be provided free of charge. The Clearinghouse is intended to serve low-income individuals and/or directors of nonprofit or charitable organizations with low operating budgets (1) who might otherwise not know where to turn or (2) who don't have access to legal assistance in the area of trademarks. This clearinghouse is the only one currently in existence that is dedicated primarily to trademarks.

One of INTA's core beliefs is that all consumers and businesses benefit when trademark rights are protected in a meaningful and consistent manner. The Clearinghouse allows INTA and its members to fulfill a commitment to the



Intellectual property legal

assistance programs

Patent pro bono program

Law school clinic program

## Law School Clinic Program

### What It Is

The Law School Clinic Certification program allows law students enrolled in a participating law school's clinic program to practice Intellectual Property Law before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor. The program currently consists of students practicing in both patent and trademark law before the USPTO. The program is administered by the Office of Enrollment and Discipline. The Director of the Office of Enrollment and Discipline grants the law students limited recognition to practice before the Office.

Students gain experience drafting and filing either patent applications or trademark applications for clients of the law school clinic. Further, as they are authorized to practice before the USPTO, they gain experience answering Office Actions and communicating with either patent examiners or trademark examining attorneys for the applications they have filed.

Donate Volunteer Log In

SCORE //

Enter Terms

#### SEARCH

#### FIND A MENTOR TAKE A WORKSHOP

**BROWSE THE LIBRARY** 

SUCCESS STORIES ABOUT US

### Your Success is Our Success. SCORE is Here to Help.

For over 50 years, SCORE has served as America's premier source of free, confidential business education and mentoring.

Get Free Business Advice ►





Home / Learning and Resources / Support Centers / Patent and Trademark Resource Centers

### Patent and Trademark Resource Centers

A Patent and Trademark Resource Center (PTRC) is part of a nationwide network of public, state, and academic libraries designated by the USPTO to support the public with trademark and patent assistance.



### How PTRCs help you

Patenting an invention and trademarking a product name can be challenging. PTRC library staff are

#### Contact

#### Patent and Trademark Resource Centers Program

P.O. Box 1450 Alexandria, VA 22313-1450

Local: 571-272-1000 Fax: 571-273-0088



### **FIVE THINGS TO REMEMBER**

# Five things to remember

- A trademark is a brand.
- Federal registration provides nationwide protection.
- Select a mark that is strong and not likely to cause confusion.
- Hiring a trademark attorney is recommended.
- Your trademark is the face of your business.

### Interbrand

### **Best Global Brands 2019**

01	02	03	04	05	06	07	08
Ú	Google	amazon	Microsoft	Coca:Cola	SAMSUNG	ΤΟΥΟΤΑ	
<b>+9%</b> 234,241 \$m	<b>+8%</b> 167,713 \$m	+ <b>24%</b> 125,263 \$m	+ <b>17%</b> 108,847 \$m	<b>-4%</b> 63,365 \$m	<b>+2%</b> 61,098 \$m	<b>+5%</b> 56,246 \$m	<b>+5%</b> 50,832 \$m
09	10	11	12	13	14	15	16
M	Disnep		IBM.	(intel)	6	cisco	-
+ <b>4%</b> 45,362 \$m	<b>+11%</b> 44,352 \$m	<b>+1%</b> 41,440 \$m	<b>-6%</b> 40,381 \$m	<b>-7%</b> 40,197 \$m	<b>-12%</b> 39,857 \$m	<b>+3%</b> 35,559 \$m	<b>+7%</b> 32,376 \$m
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J.P.Morgan	TREA	ups	HERMÉS	ZABA	HaM	accenture	Budweiser
<b>+8%</b> 19,044 \$m	<b>+5%</b> 18,407 \$m	+ <b>7%</b> 18,072 \$m	<b>+9%</b> 17,920 \$m	<b>-3%</b> 17,175 \$m	<b>-3%</b> 16,345 \$m	+ <b>14%</b> 16,205 \$m	+ <b>3%</b> 16,018 \$m

https://www.interbrand.com/best-brands/best-global-brands/2019/ranking

## **QUESTIONS?**

# Appendix

- Slide 10: Reg. 0523616 and 2596156
- Slide 11: Reg. 2131693 and 3361597
- Slide 13: Reg. 0238145, 0238146, 1867757, and 2085197
- Slide 14: Reg. 0238145, 0238146, 1867757, and 2085197
- Slide 21: Reg. 2572639
- Slide 47: Reg. 3719198, 4263591, and 4552363
- Slide 48: Reg. 1078312, 1745875, and 3102687
- Slide 51: Reg. 3719198, 1785525, and 4202570





## Please type your questions in the Q&A chat box. Thank you for attending!

### Contact Us Azalea Ebbay, San Diego Public Library

<u>AEbbay@sandiego.gov</u> (619) 238-6683

### Roya Bagheri, San Diego Volunteer Lawyer Program, Inc.

<u>rbagheri@sdvlp.org</u> (619) 235-5656, ext. 130

### Trademark Assistance Center at the U.S. Patent and Trademark Office

Website: www.uspto.gov/TrademarkAssistance TrademarkAssistanceCenter@uspto.gov 1 (800) 786-9199