

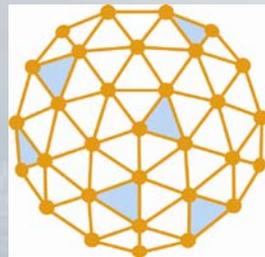
Overview of Trademark Protection in the United States and Abroad



**ITC Workshop: Branding & Marketing of
Tribal Forest Products**

Seattle, Washington

March 1-2, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE
GLOBAL INTELLECTUAL PROPERTY ACADEMY



Definition of a Trademark

U.S. Law

Any word, name, symbol, or device, (or any combination thereof) used to identify and distinguish goods or services and to indicate their source.

Section 45 of the Trademark Act 15 U.S.C. 1127



Life of a Trademark

I. CREATION

- Choosing a trademark or service mark

II. SCREENING and CLEARANCE

- Making sure the proposed mark is available

III. PROTECTION

- Seeking protection, country-by-country

IV. MAINTENANCE

- Renewing trademark registrations

Part I: LIFE OF A TRADEMARK



CREATION



Types of Trademarks

- Word Marks **NAVAJO ARTS & CRAFTS GUILD**
(Reg. No: 3829700)

- Design Marks
(Reg. No: 3108053)



- Composite Marks containing both words and design
(Reg. No: 3308305)

- Slogans (Reg. No: 3643524)

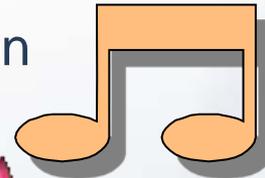


THERE'S SOMETHING IN THE WIND



Unusual Trademarks

- Shape: Bottle shape for soda pop
- Color: Pink color for insulation
- Sound: Three chimes sound for television broadcasting services
- Scent: Plumeria flower blossom scent for sewing thread
- Motion: Flying pegasus for movie studios





Certification Marks

A certification mark is any word, name, symbol or device (or any combination thereof) that can:

- certify that goods or services **originate** in a specific geographic region, or
- certify that the goods or services **meet certain standards in relation to quality, materials, or mode of manufacture, or other characteristics** or
- certify that the **work or labor on the products or services was performed by a member** of a union or other organization, or that the performer meets certain standards



Certified Financial Crimes
Investigator



Certification Mark Characteristics

- A certification mark does **not indicate origin in a single commercial or proprietary source**.
 - In certifying, the same mark is used on the goods or services of many different producers.
 - Certification Mark **cannot be “used” (in the trademark sense) by the owner of the mark**.
 - In other words, the owner of a certification mark does not apply the mark to his or her goods/services and, in fact, usually does not attach or apply the mark at all.
- ***The certification mark really is saying that the goods/services have been examined, tested, inspected or in some way checked by a person who is not their producers, by methods determined by the certifier/owner.



Certification Mark: Exercising Legitimate Control

- The owner must assert that the he/she is exercising legitimate control over the use of the certification mark in commerce.
- The **purpose** of requiring a certification mark owner to control use of its mark is to **protect the value of the mark** and **to prevent the public from being misled.**
- There is a substantial risk of misleading the public because a certifier makes specific representations about the characteristics of the certified goods or services. Thus, the certification mark owner has an **affirmative duty to monitor the activities of those who use the mark** in order to ensure the compliance with its standards.



Certification Mark: Standards

- The applicant (certifier) **must submit a copy of the standards** established to demonstrate how they exercise control over the use of the mark and to establish that they are, in fact, engaged in a certification program.
- The standards do **not** have to be original with the applicant. They may be standards established by another party, such as specifications promulgated by a government agency or standards developed through research of a private research organization.



Collective Marks

- A **collective mark** indicates commercial origin of goods or services in **members of a group** rather than origin in **one party**.
 - The mark is **used by all members** of the group, therefore no one member can own the mark.
- The **collective organization holds the title** to the collectively used mark for the benefit of all members of the group.
 - The collective may advertise or otherwise promote the goods or services sold or rendered by its members under the mark.



Collective Marks: Special Elements

The application must:

- specify the **class of persons** entitled to use the mark,
- indicating their **relationship to the applicant**, and
- the nature of the applicant's **manner of control over** the use of the mark.



Collective Membership Mark

- A *collective membership mark* is a mark adopted for the purpose of indicating membership in an organized collective group, such as a union, an association, or other organization.
- **Not** used by the collective nor its members to identify and distinguish goods or services.
 - the *sole function* of such a mark is to **indicate that the person displaying the mark is a member of the organized collective group.**



Collective Membership Mark

- The sole purpose of a collective membership mark is to **indicate that the user of the mark is a member of a particular group.**
- The *owner* exercises control over the use of the mark, but use is by the *members*.
- The owner is usually a collective organization whose members use the mark.



Example: Collective Membership Mark

Prior U.S. Cl.: 200

Reg. No. 2,326,707

United States Patent and Trademark Office

Registered Mar. 7, 2000

**COLLECTIVE MEMBERSHIP
PRINCIPAL REGISTER**



COWLITZ INDIAN TRIBE

COWLITZ INDIAN TRIBE, THE (WASHINGTON FEDERALLY-RECOGNIZED INDIAN TRIBE)
1417 - 15TH AVENUE #5
LONGVIEW, WA 986328594

FIRST USE 0-0-1949; IN COMMERCE 0-0-1949.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INDIAN TRIBE", APART FROM THE MARK AS SHOWN.

SER. NO. 75-703,827, FILED 5-12-1999.

FOR: INDICATE MEMBERSHIP IN AN INDIAN TRIBE, IN CLASS 200 (U.S. CL. 200).

KATHY DE JONGE, EXAMINING ATTORNEY



Collective vs. Collective Membership Marks

COLLECTIVE MARK

- A mark adopted by a “collective” (*i.e.*, an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members.
- Members use the mark to **identify their goods or services and distinguish** them from those of nonmembers.
- The “collective” itself neither sells goods nor performs services under a collective trademark or collective service mark, but the collective may advertise or otherwise promote the goods or services sold or rendered by its members under the mark.

COLLECTIVE MEMBERSHIP

- (1) adopted for the purpose of indicating membership in an organized collective group, such as a union, an association, or other organization.
- (2) Neither the collective nor its members uses the collective membership mark to identify and distinguish goods or services;
- (3) **the sole function of such a mark is to indicate that the person displaying the mark is a member of the organized collective group.**



Comparison

Certification Marks

Certifies characteristics and features of the goods/services.

Collective Marks

Indicates origin of goods/services in the **members** of an organized collective group - **distinguishes** them from those of nonmembers.

Collective Membership Marks

Indicates **membership in an** organized collective group.

Part II: LIFE OF A TRADEMARK



SCREENING and CLEARANCE



Types of Trademark Protection in the U.S.

- **Common Law** – unregistered; derived from use. “TM”
- **State Registration** – the “truly local.”
- **Federal Registration®** - interstate commerce or between the U.S. and another country.
- **Other Federal Statutes**
 - Smokey Bear
 - Woodsy Owl





SCREENING and CLEARANCE in the U.S.

- **USPTO DATABASE**
 - Federally registered trademarks and pending applications for registration
- **STATE TRADEMARK REGISTRIES**
- **DOMAIN NAME SEARCH**
 - Generic Top Level Domains (gTLDs)
 - Country Code Top Level Domains (ccTLDs)
- **COMMON LAW SEARCH**
 - the Web, trade names, trade directories, etc.



Why Should a Business do a Trademark Search Before Filing?

- Before beginning to use a trademark, a business should first determine whether some *other* business is already using an *identical or similar* trademark, on or in connection with the *same or related* goods or services, or whether some other company otherwise has any rights in the mark.
 - By making that determination, a company reduces the risk of violating another company's trademark rights.



Conducting a Search Can Save a Company Time, Money and Grief!

- Avoid having to **change your mark** – in every place it appears.
- Avoid having to **recall existing products** that bear the infringing mark.
- Avoid having to **destroy existing product** with the infringing mark.
- Avoid being held **liable for damages** to the owner of the mark – and possibly even for **attorney's fees**.

PART III: LIFE OF A TRADEMARK



PROTECTION (Country-by-Country)



Does a Company Need to Register its Mark in the U.S.?

- Not required, because trademark rights (in the U.S.) arise from **use** on or in connection with goods or services, BUT...
- There are significant **advantages** to having a federal trademark registration.



Advantages of Federal Registration

- **Public notice** of your claim of ownership of the mark;
- A **legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide** on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in **federal court**;
- The use of the U.S. registration as **a basis to obtain registration in foreign countries**;
- The right to use the **federal registration symbol ®**;
- Listing in the United States Patent and Trademark Office's **online databases**; and
- Registration may be recorded with **U.S. Customs and Border Protection** to prevent importation of infringing foreign goods.
 - The recordation fee for trademarks is US\$190 per International Class of goods.



How Do I Get a Federal Trademark Registration?



- File an application at the U.S. Patent and Trademark Office.
- You can complete an application online, check it for completeness, and file it over the Internet using the Trademark Electronic Application System (TEAS) at www.uspto.gov/teas/index.html
 - **97.8%** of trademark applications were filed electronically in FY 09!
- Three ways to pay: credit card, automated deposit account or electronic funds transfer.



Filing Fees

Filing fee for paper filing:

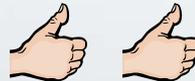


\$375 USD per class of goods/services.

Filing fee for e-filing:



\$325 USD per class of goods/services if filed using the “regular” TEAS form.



\$275 USD per class of goods/services if filed using the **TEAS Plus** form.



Examination Process at the USPTO

1. **File** Application (Current pendency = **3.0 months**)
2. **Examination** by Trademark Examining Attorney → Allowed, Amended, or Refused.
 - Common grounds for refusal?



Examination Process at the USPTO – continued...

3. **If Allowed**, publication in the *Official Gazette* and Notice of Allowance (if intent-to-use).

4. **If Refused**, appeal to the Trademark Trial and Appeal Board (TTAB)
 - **If Refusal is affirmed:**
 - A) Appeal to a U.S. District Court *de novo*: or
 - B) Appeal to the United States Court of Appeals for the Federal Circuit (CAFC) on the administrative record.



Examination Process at the USPTO – continued.

5. After Publication, Opposition period. Both parties (Opposer and Applicant) have right to appeal the TTAB decision regarding opposition.
6. If no Opposition, Registration issues.
7. Cancellation proceeding available to cancel a registration. Both parties (Petitioner and Registrant) have right to appeal the TTAB decision. In general, the USPTO is not involved in inter partes appeals of TTAB decisions.



Trademark Timeline*

Examination: **3.0 months** from filing to examination.

Registration: **10.3 months** after filing.

* Figures are approximate, and based on Q1, FY 2011 performance.



Congratulations!





Is Federal Registration Valid Outside the United States?

- **No.**

Trademark rights are *territorial*: rights in particular trademarks exist only within the country whose laws granted those rights.



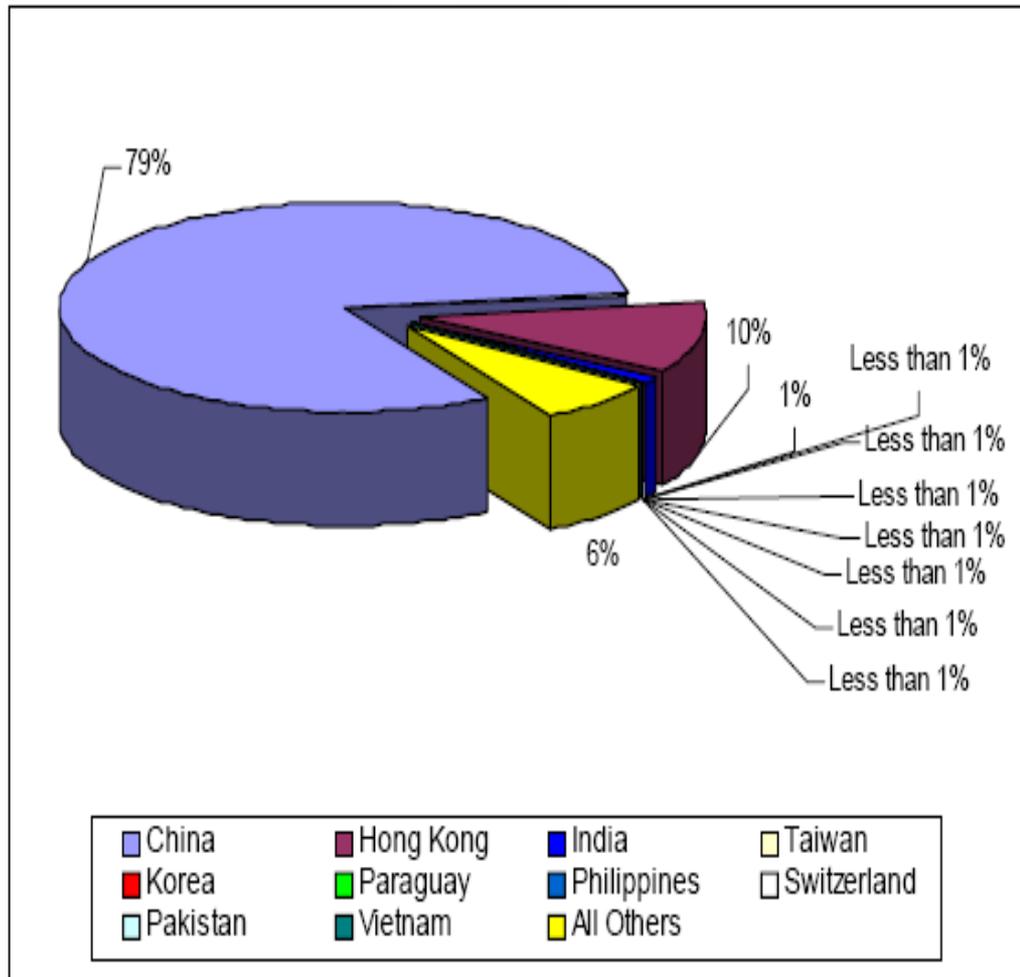
Protecting Your Trademarks Abroad

- Be proactive in protecting your trademark!
- Have you considered registering your mark in countries in which:
 - Your goods or services are **marketed**;
 - Products or parts for your products are **manufactured**;
 - **Research and development facilities** are located;
 - Your products are **trans-shipped**;
 - You **might expand your business** in the future; or
 - **Counterfeiting** is likely to be a problem.



Increased Trade Flow Has Led to Increases in Counterfeit Goods

FY 2009 Trading Partner	Domestic Value	Percent of Total
China	\$ 204,656,093	79%
Hong Kong	\$ 26,887,408	10%
India	\$ 3,047,311	1%
Taiwan	\$ 2,453,914	Less than 1%
Korea	\$ 1,510,443	Less than 1%
Paraguay	\$ 1,496,043	Less than 1%
Philippines	\$ 1,479,958	Less than 1%
Switzerland	\$ 1,277,646	Less than 1%
Pakistan	\$ 710,658	Less than 1%
Vietnam	\$ 603,529	Less than 1%
All Others	\$ 16,574,934	6%
Total FY 09 Domestic Value	\$ 260,697,937	
Number of Seizures	14,841	



Source: U.S. CBP FY 09



Protecting Your Trademarks Abroad

Directory of Intellectual Property Offices - Microsoft Internet Explorer

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorites History Mail Print Edit Discuss

Address <http://www.wipo.int/directory/en/urls.jsp> Go Links SnagIt

WIPO About WIPO Search Contact Home

Español · Français

Home > About WIPO > Members & Observers

Information by Country
Member States
Observers
Directory of Intellectual Property Offices
Criteria for Admission
Links

[Printable version]

Directory of Intellectual Property Offices

Afghanistan Quick access!

[Alphabetical List of Regional Offices](#)

Alphabetical List of Intellectual Property Offices

Country	Type	Office	Contact
Afghanistan	Copyright Office	Ministry of Information and Culture	
	Industrial Property Office	Ministry of Mines and Industries	
Albania	Copyright Office	Ministry of Culture, Youth and Sports	
	Industrial Property Office	Albanian Patent and Trademark Office, Council of Ministers, General Directorate of Patents and Trademarks	
Algeria	Copyright Office	National Office of Copyright and Related Rights	
	Industrial Property Office	Algerian National Institute of Industrial Property (INAPI)	
Andorra	Copyright Office	Ministry of the Presidency	

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Protecting Your Trademarks Abroad: The Madrid Protocol

- **What is the Madrid Protocol?** It is an international trademark filing treaty administered by the World Intellectual Property Organization, WIPO.
- Currently **83** member countries. (Jan. 15, 2011)



FILINGS UNDER THE MADRID PROTOCOL

- Under the Madrid Protocol, the owner of a “**basic application**” or a “**basic registration**” issued by the USPTO can -
 - File a single application, in English, at the USPTO Web site, pay in U.S. dollars, and seek registration in any or all of the countries who are members - as designated by the applicant.
 - Each of those countries then determines whether, under its trademark laws, the U.S. trademark owner is entitled to an *extension of protection*, i.e., whether the international registration will be in force in its country.

PART IV: LIFE OF A TRADEMARK



MAINTENANCE



Maintain Registrations!

- **In The U.S.**
 - Evidence of **continued use**: submitted between 5th and 6th year.
 - **Renewal**: submitted between 9th and 10th year.
 - Electronic forms can be completed very easily; much of the data is entered automatically.



The STOPFakes.gov Website

STOPFAKES.GOV

Protecting Intellectual Property Rights

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Initiatives

- ▶ **SME IPR Training Tutorial**
English
Français
Español
- ▶ **International IP Advisory Program**
- ▶ **DHS-Customs Recordation Tool**
- ▶ **USPTO Small Business Page**

Toolkits

- ▶ **Brazil Toolkit**
- ▶ **Brunei Toolkit**
- ▶ **China Toolkit**
- ▶ **Croatia Toolkit**
- ▶ **Egypt Toolkit**
- ▶ **European Union Toolkit**
- ▶ **India Toolkit**
- ▶ **Italy Toolkit**
- ▶ **Korea Toolkit**
- ▶ **Malaysia Toolkit**
- ▶ **Mexico Toolkit**
- ▶ **Pakistan Toolkit**
- ▶ **Paraguay Toolkit**
- ▶ **Peru Toolkit**
- ▶ **Russia Toolkit**
- ▶ **Taiwan Toolkit**
- ▶ **Thailand Toolkit**
- ▶ **Vietnam Toolkit**

File an IPR Complaint

- ▶ **How do I file a Complaint about**

What's New in StopFakes



Our SME IPR Training Tutorial has been translated into French and Spanish!

Now available in three languages (English, French and Spanish), our online IPR training tutorial, Understanding Intellectual Property Rights, helps you to assess your intellectual property assets, protect them in the United States, and enforce them worldwide. Learn more by clicking on the links to the left!

Commerce Issues Call for Input on U.S. Government IPR Assistance Programs

In coordination with the Intellectual Property Enforcement Coordinator, the Department of Commerce is conducting a comprehensive review of existing U.S. Government efforts to educate, guide, and provide resources on intellectual property rights (IPR) to U.S. businesses. The goal of the review is to improve efforts to support U.S. businesses facing barriers related to IPR protection and enforcement in overseas markets. The Department of Commerce invites public input

Programs

- ▶ **China IPR Webinar**

Publications

- ▶ **ACTA Fact Sheet**
- ▶ **IP Quarterly Update**
- ▶ **STOP! Accomplishments and Initiatives**
- ▶ **2008 NIPLECC Report**
- ▶ **STOP! Brochure link**
- ▶ **Top 10 Ways to Protect Yourself**



China IPR Resources

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FAQs

- ▶ **Frequently Asked Questions**

Independent Organizations

- ▶ **APEC intellectual property explorer**
- ▶ **Coalition Against Counterfeiting and Piracy**
- ▶ **WTO**
- ▶ **WCO**
- ▶ **WIPO**



The STOPFakes.gov Website

STOPFakes.gov Website:

STOP HOTLINE: 1-866-999-HALT (or web form)

IPR Country Toolkits (18 thus far)

DHS – Customs Recordation Tool

Information about events, e.g., USPTO “IP Basics” Road Shows, USPTO “China Road Shows”, Commerce China IPR webinar series

“International IPR Advisory Program” with American Bar Association (ABA) (1-hour free consultation with expert attorney) for certain countries.

A list of “Who’s Who” in the U.S. Govt. involved in IP:
http://www.stopfakes.gov/sf_who.asp



Resources on STOPFakes.gov: “SME IP Training Tutorial”

“SME IP Training Tutorial” on STOPFakes.gov --

- Module 1 - Introduction
 - Module 2 - IP Protection and Your Business
 - Module 3 - Understanding Different Types of IPRs
Introduction
 - Module 4 - How to Obtain and Protect Your IPRs in the U.S.
 - Module 5 - Obtaining and Protecting Your IPRs Abroad
 - Module 6 - Enforcing Your IPRs
- The average time to complete this course is 1.5 hours. You may complete the course more quickly or more slowly depending on your experience and individual learning style.

Thank You!

