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Trademarks for Municipalities

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#195513

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What is a trademark?

- *Definition:* a trademark is a –
 - Word, name, symbol, device
 - Used
 - To identify and distinguish source

What is a trademark?

- *Types:* there are many types of marks, including –
 - Words, slogans
 - Stylized logos, designs, symbols
 - Color
 - Devices
 - Sound
 - Phone numbers, web addresses
 - Scents

Different types of marks

- Categories – there are four different types of marks
 - Trademark
 - Service mark
 - Certification mark
 - Collective (membership) mark
- Distinguish trade names

What is the purpose of a trademark?

- To identify and distinguish source
- To assure quality
- To build brand recognition
- To build good will
- To reinforce first impressions

What is a registered mark vs. a common law mark?

- Federally registered mark
- State registered mark
- Common law mark
- Use of ®, TM , SM
- Use ® only with federally registered marks

When do priority rights in a mark arise?

- Common law:
 - first use in geographic area
- Federal registration:
 - nationwide constructive use from application date
- Senior user vs. junior user

What are the advantages of federal registration of a mark?

- Nationwide priority based on constructive use
- Incontestability after five years
- Treble damages and attorney fees
- Federal court jurisdiction
- Ability to obtain foreign registrations
- Basis to bar importation of products with infringing marks

What is appropriate to use as a mark?

- Distinctiveness levels
 - Generic (not distinctive/cannot function as a mark)
 - Descriptive (functions as a mark only when acquires distinctiveness/secondary meaning)
 - Suggestive
 - Arbitrary/fanciful
 - Coined

What kinds of marks cannot be federally registered?

- Mark that is likely to cause confusion with a federally registered mark
- Generic mark
- Merely descriptive mark (except on Supplemental Register)
- Immoral, deceptive or scandalous mark
- Geographic description

Trademark Searching

- First step in the trademark process should be to conduct one or more searches
- Searches
 - help determine whether use of a mark will infringe someone else's rights
 - help determine if someone else is infringing your client's rights
 - help determine the registrability of a mark

What is trademark infringement

- Likelihood of confusion test
 - Not a side-by-side comparison
 - Similarity of appearance
 - Phonetic similarity
 - Similarity of meaning
 - Channels of trade
 - Direct competition
 - Degree of customer care
 - Strength of famous mark
- The USPTO will not register a mark that it determines is likely to cause confusion with a prior federally registered mark

Trademark searching strategies

- Preliminary “knock out” or screening search
 - U.S. Patent and Trademark Office (USPTO) website search for searching federal registrations or applications
 - Lexis or Westlaw search of state databases for searching state registrations
 - Internet search for conducting basic search of common law marks

Trademark searching strategies

- Formal Searches
 - Outside company searches for confusingly similar marks whether registered (federal or state) or common law

Federal application process

- General bases for federal trademark application
 - Use application
 - Intent to Use application
 - Application based on foreign application or registration

Federal application process

- Application requirements
 - Depiction of mark (drawing)
 - Standard character marks
 - All letters are Latin characters; all numbers are Roman or Arabic numerals; and common punctuation – no claim to particular font, style, size or color
 - Design marks
 - “Stylized or special form” drawing
 - Color claims – name the colors that are a feature of the mark and description of where the colors appear on the mark

Federal application process

- Application requirements
 - Accurate and complete description of goods or services for which registration is sought – common commercial names
 - Identification of goods or services using international classification system
 - Goods: 34 categories
 - Services: 11 categories

Federal application process

- USPTO Review
 - Examining attorney assigned
 - Office actions containing refusals and requirements
 - Likelihood of confusion refusal
 - Merely descriptive refusal
 - Inadequacy of specimen requirement
 - Identification of goods or services requirement

Federal application process

- Responses to office actions
- Notice of Publication in Official Gazette
- Opposition Period (30 days)
- Notice of Allowance
- Issuance of Registration Certificate
- Timing: generally at least seven months after application filing date
- Appeals to Trademark Trial and Appeal Board

Federal application process

- Post-Registration Matters
 - 10-year term, subject to renewals
 - Declaration of Use, filed with specimen after fifth year (or cancellation) and ability to make mark incontestable with additional filing
 - Cancellation Petitions

Federal application process

- Federal registration on Principal Register
 - Inherently distinctive or acquired distinctiveness
- Federal registration on Supplemental Register
 - Descriptive

Proactive protection of trademarks

- Register
 - All trademarks and service marks
 - All domain names
 - Foreign registrations
- Use trademark continuously, consistently and distinctively

How are trademark rights retained and enforced?

- Continuous use
 - Non-use for three years may be abandonment
- Monitoring use by others
 - Trademark monitoring services
 - Internet specific watching services
 - Internet search

What are proper trademark usage guidelines?

- Use mark as adjective, not noun or verb
 - **OKAY:** KRISPY KREME donuts
 - **NOT:** KRISPY KREMES

 - **OKAY:** Please photocopy this page
 - **NOT:** Please XEROX this page

What are proper trademark usage guidelines (cont'd.)

- Do not use mark in plural or possessive form
 - **OKAY:** KRISPY KREME donuts
 - **NOT:** KRISPY KREMES
 - **NOT:** KRISPY KREME'S donuts
- Distinguish mark from surrounding material
 - **OKAY:** KRISPY KREME donuts
 - **NOT:** KRISPY KREME DONUTS

How can I proactively protect my trademark?

- Register
 - All trademarks and service marks
 - All domain names
 - Foreign registrations
- Use trademark consistently and distinctively

How can I proactively protect my trademark?

- Use ®, TM or SM designation appropriately:



Colorado Springs Utilities®
It's how we're all connected

Multi-class federal registration owned by the City of Colorado Springs



Multi-class federal registration owned by the City of Colorado Springs

MIKE THE HEADLESS CHICKEN®

Federally registered mark of City of Fruita



DENVER
THE MILE HIGH CITY

Multi-class federal registration owned by the City and County of Denver

THE GREATEST SNOW ON EARTH.®

Federal registration owned by Utah Division of Travel Development

THE KALAMAZOO PROMISE®

Multi-class federal registration owned by Kalamazoo Public Schools

How can I proactively protect my trademark?

- Use ®, TM or SM designation appropriately:

GET THE GREEN BACK™

Application for federal registration
owned by the City of Colorado Springs

City of Ouray Switzerland
of America™

Application for federal registration owned by the City of Ouray



Application for federal registration owned by the
City of Aspen



Multi-class application for federal registration
owned by the Town of Vail

The Art and Soul of Aspen™

Multi-class application for federal registration owned by the City of Aspen

How can I proactively protect my trademark?

- Maintain quality control over licensees' use
- Monitor use by others
- Stop unauthorized use



Remember

Trademarks are like muscles –
they get stronger through proper use

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