

IM 450-01
Intellectual Property Law and New
Media
Fall 2022
September 27, 2022
Class 10
Trademarks

A trademark is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others.

- Trademarks are granted in specific product/service categories.**
- Trademarks are granted in geographic areas.**

A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.

Wordmarks fill the same functions, using distinctive lettering of names/marks



Funny thing about that one.

When this class did an IP audit fall 2017, students discovered that “Bradley University” was not registered. Only “Bradley” was, and it was only registered in one category (higher education).

The institution’s leaders did not know about the faulty registration and often claim way more protection than our registration merits.

BU is reconsidering its position and registration; no word on their actions.

- **Kodak**
- **Exxon**
- **Coca Cola**
- **Mc Donald' s**
- **Starbucks**
- **Walmart**
- **MTV**
- **Victoria' s Secret**

- **Polaroid**
- **Xerox**
- **Lego**
- **Beanie Babies**
- **Kraft**
- **Playboy**
- **Apple**
- **Dell**

The law protects:

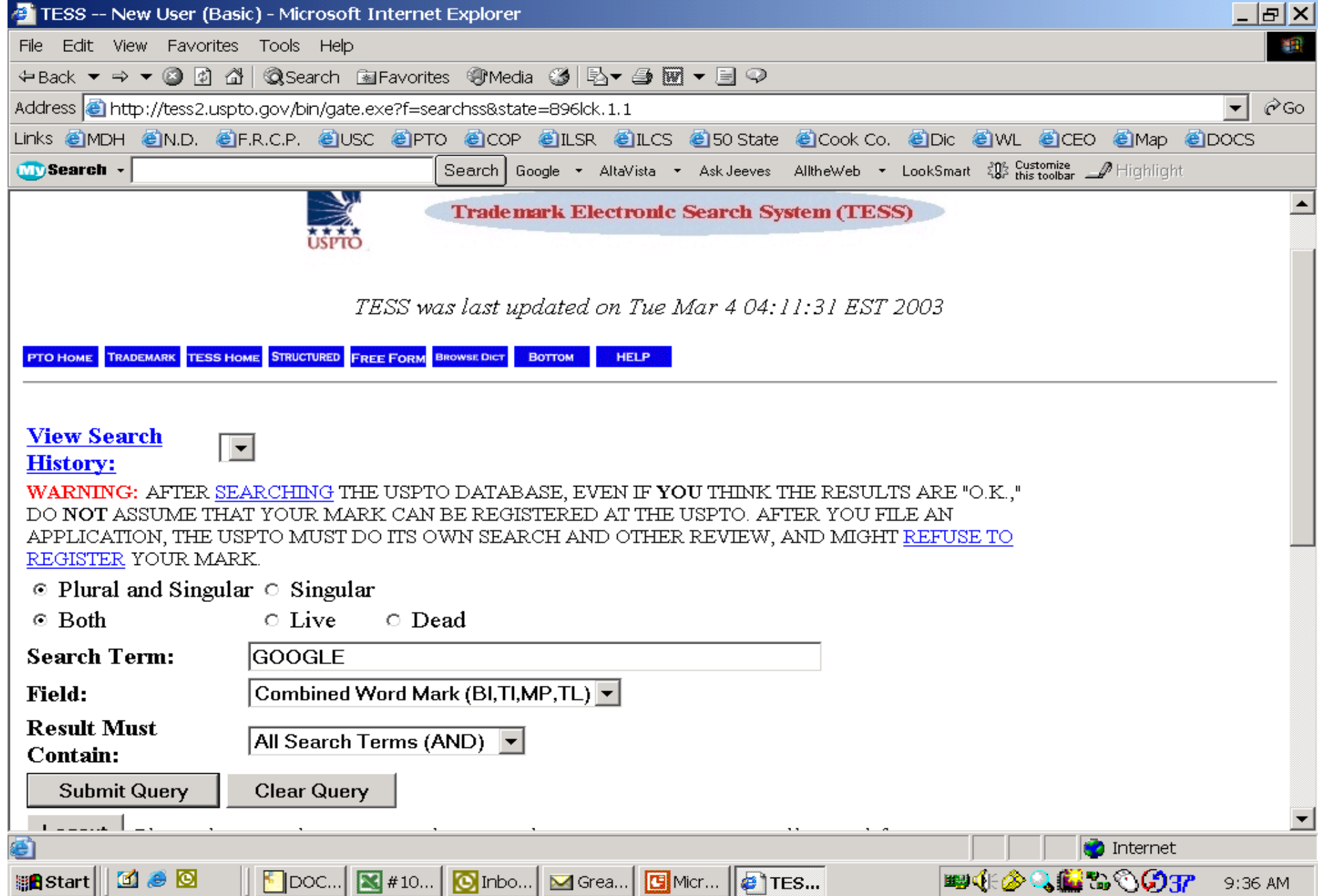
- **Consumers**
 - **The public's right not to be confused**
- **Mark owners**
 - **The right to develop brand awareness**
 - **The right to prevent free-loaders from trading on the mark owner's good will and reputation in the market place**

Before using a mark, or applying to register one, you should search to see if it's already registered for use

- **Trademark Searches (available to public)**
 - www.uspto.gov
- **Private search firms**
 - **Might discover “common law” uses**
 - **Can be expensive (\$400 - \$500) per mark searched**

Trademark Official Gazette

- (TMOG) is published each Tuesday and contains bibliographic information and a representative drawing for each mark published, along with a list of cancelled and renewed registrations.
- <http://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog>
- The TMOG is searchable.



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Goods and Services

IC 009. US 021 023 026 036 038. G & S: Computer software for searching, compiling, indexing and organizing information on computer networks; computer hardware, computer software for searching, compiling, indexing, and organizing information within individual workstations, personal computers; computer software for electronic mail and workgroup communications over computer networks; computer software for creating indexes of information, indexes of web sites and indexes of other information resources; mouse pads, calculators. FIRST USE: 20010400. FIRST USE IN COMMERCE: 20001211

IC 011. US 013 021 023 031 034. G & S: Flashlights, lamps. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

IC 012. US 019 021 023 031 035 044. G & S: License plate frames and holders. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

IC 016. US 002 005 022 023 029 037 038 050. G & S: Books, notebooks, pens, greeting cards, stickers, decals. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

IC 018. US 001 002 003 022 041. G & S: Bags, namely, tote bags, duffle bags, backpacks; luggage tags; umbrellas. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

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graphic and audio visual information, by means of global computer information networks. FIRST USE: 19970900. FIRST USE IN COMMERCE: 19970900

Mark

Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 76314811

Filing Date September 18, 2001

Owner (APPLICANT) Google Inc. CORPORATION CALIFORNIA 2400 Bayshore Parkway Mountain View CALIFORNIA 94043

Attorney of Record Julia Anne Matheson

Description of Mark The first letter "G" is blue; the second letter "O" is red; the third letter "O" is yellow; the fourth letter "G" is blue; the fifth letter "L" is green; and the sixth letter "E" is red.

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT TOP HELP PREV LIST CURR LIST NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

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Acquiring trademark rights

- **From use of the mark in commerce**
 - **Within a particular segment of the economy (as defined by the Trademark office)**
 - **Within a specified geographic area (as specified by where you do business and/or the area for which you apply)**

Use in commerce: Goods

The mark must appear on the goods, the container for the goods, or displays associated with the goods, and the goods must be sold or transported in commerce.

Use in commerce: Services

The mark must be used or displayed in the sale or advertising of the services, and the services must be rendered in commerce.

Again, the economic niche(s) and geographic area(s) in question.

Trademarks cannot:

- **Be reserved (for future use)**
 - **Although, there is an “intent to use” process for marks that are going to be used in commerce, but that have not yet been so used; 12 month “hold” by registration.**
- **Protect ideas**

Marks Must Be “Distinctive”

Fanciful Arbitrary Suggestive Descriptive Generic/- Generic/+

Mark Must Be “Distinctive”

- Fanciful (Exxon)
- Arbitrary (Apple)
- Suggestive (Coca-Cola)
- Descriptive (Expert Plumbers)
- Generic yes (Xerox)
 - When a trademark from “above” category falls into “Generic,” there is a risk of loss of rights. Xerox and Kleenex (for example) have to fight hard to protect their marks.
- Generic: NO TRADEMARK (Tissues)

A note about Generics

➤ <https://youtu.be/rRi8LptvFZY>

**Registration of a mark is not required for
basic legal protection**

**One can establish rights in a
mark based on legitimate use of
the mark in commerce.**

Benefits of Registration

- **Constructive notice to the public of the registrant's claim of ownership of the mark;**
- **A legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or 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; and**
- **The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.**

State/Federal Registration

➤ State Registrations

- Cheaper (Illinois = \$15)
- Statewide protection

➤ Federal Registrations

- The cost to apply for a U.S. trademark is now \$325 per class of goods and services (if you use the electronic filing system). It may be even lower (\$275) if the applicant uses a pre-ordained description of good and services

Using the trademark symbols TM and SM

- Any time you claim rights in a mark, you may use TM (trademark) or SM (service mark) designations to alert the public to your claim, regardless of whether you have filed an application with the USPTO.

Use the trademark symbol ®

- You may use the federal registration symbol "®" only after the USPTO actually *registers a mark*, and not while an application is pending. Also, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration.

Applications Include

- **the name of the applicant;**
- **a name and address for correspondence;**
- **a clear drawing of the mark;**
- **a listing of the goods or services; and**
- **the filing fee for at least one class of goods or services.**

Trademark Terms

- **10 years**
- **Renewable for successive 10 year periods**
- **After 5 years, with proper filings, mark becomes “incontestable”**

Trademark Infringement and Dilution

The laws

- Federal Statutes
 - The Lanham Act
 - [15 U.S.C. § § 1051 - 1127](#)
- State Statutes
 - Counterfeit Trademark Act
 - 765 ILCS 1049
 - <http://www.legis.state.il.us/legislation/ilcs/ch765/ch765act1040.htm>
- Judicial Decisions

Types of Trademark Infringement

- **Senior user owns mark**
- **Junior user begins to use the same or similar mark on the same or similar goods or services**
- **Likelihood of confusion in market**

Types of Confusion

➤ Forward

- Small Junior trades on the mark of a Big Senior User

➤ Reverse

- Big Junior saturates market and overwhelms Small Senior User

➤ Initial Interest

- Confusion that creates an initial customer interest (e.g. meta-tags, domain names)
 - Courts have, generally, ruled out confusion by initial customer interest in cases involving internet search.
 - This protects the business model(s) used by Google and other search engines that sell/auction terms that are generally protected trademarks

➤ Post-Sale

- Confusion of someone other than purchaser

Likelihood of Confusion Factors

- **Similarity of the Marks**
- **Similarity of the Products**
- **Area and Manner of Concurrent Use**
- **Degree of Care Exercised by Consumers**
- **Strength of Plaintiff' s Mark**
- **Actual Confusion**
- **Intent of Defendants**

Trademark Dilution

- **Lessening of a famous mark to identify and distinguish goods and services**
- **Irrespective of:**
 - **Competition between owner of mark and other parties; or**
 - **Likelihood of confusion, mistake or deception**
- **“Blurring” distinctiveness of mark**
- **“Tarnishing” reputation of mark**

Anticybersquatting Consumer Protection Act (ACPA)

- Enacted in 1999
- Addresses the problem of domain name hi-jackers
- Liability Under ACPA:
 - Bad faith intent to profit from mark
 - Register, traffic in or use a domain name that:
 - (I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;
 - (II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or
 - (III) is a trademark, word, or name protected by reason of section [706](#) of title [18](#) or section 220506 of title [36](#).

Liability Under ACPA

- (I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;
- (II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or
- (III) is a trademark, word, or name protected by reason of section [706](#) of title [18](#) or section 220506 of title [36](#).

“Bad Faith” Elements under ACPA

- (1) trademark or other IP rights in domain name;**
- (2) domain name consists of legal name of person or name used to identify person;**
- (3) person's prior use of domain name in connection with offer of goods or services;**
- (4) person's noncommercial or fair use of the mark in site;**
- (5) intent to divert consumers from the mark owner's online location to a site accessible under the domain name;**
- (6) offer to transfer domain name to the mark owner or any third party for financial gain without having used or intended to use domain name to offer goods or services;**
- (7) provision of false contact information when applying for the registration of the domain name;**

“Bad Faith” Elements under ACPA

(8) registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names;

(9) the extent to which the mark incorporated in the domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of this section.

Domains v. Search Terms

The protection afforded trademarks as URLs/domain names is not extended to the use of trademarks as search terms.

Generally, the courts have not limited the use of trademarks as search terms (or the related auctions and commerce that goes with them).

Although claims based on keyword bidding have sometimes withstood motions to dismiss (so get to trial), apart from a single district court summary judgment decision from over ten years ago no court has found bidding on trademark keywords to constitute trademark infringement, absent some additional factor, such as a misleading use of the trademark in the ad text that confuses consumers as to the advertisement's source, sponsorship, or affiliation.

Rather, “[c]ourts have consistently rejected the notion that buying or creating internet search terms, alone, is enough to raise a claim of trademark infringement.” [Tempur-Pedic N. Am.](#), 2017 WL 2957912, at *7

Trademark Modernization Act

- **Many of the changes embodied in the Trademark Modernization Act are rather esoteric, “inside baseball” styled changes that are likely meaningful only to trademark lawyers.**
- **The most significant change is to codify that there is a “rebuttable presumption of irreparable harm” upon a showing of trademark infringement. That means it will be a bit easier for trademark owners to get a temporary restraining order, preliminary injunctions and permanent injunctions against infringers.**
 - **Although their claim of harm is rebuttable (the other side can say “no it’s not”), once infringement has been shown,**
 - **claimants can say that they’ve suffered irreparable harm and up-the ante for (potential) punishments**

Top Trends In Trademark

Trademarks in search and keyword advertising

Using trade dress to protect website designs

Inappropriate uses of trademarks in virtual worlds.

**Imagine how this will work/not work in the
“Metaverse.”**