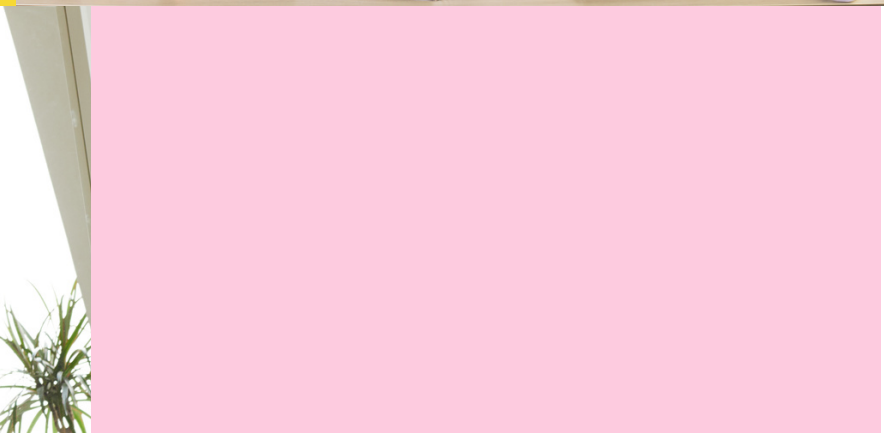




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TRADEMARK REGISTRATION

Common Mistakes No
One Talk to You ABout



Nothing in these presentations should be interpreted as legal advice. These presentations are intended to help a person to understand the area of law to help ask the right questions with the attorney of their choice. Your time to act may be very limited and this could substantially reduce your rights and options. YOU CANNOT rely on anything contained here in. These information are not intended to substitute for professional legal advice and does not create an attorney-client relationship. You should accept legal advice only from a licensed legal professional with whom you have an attorney-client relationship. You should contact a lawyer in your area immediately, to assist you in any of these matters.



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The Law Office of Giselle Ayala Mateus is focused on providing excellent legal services to families and individuals, start-ups, small businesses, and non-profits. Considering the challenges of today's world, personal contact with the lawyer, easy access to information, and short deadlines are pillars.

Whether you have a home-based business, you run a non-profit project or you have a business entity, you are an entrepreneur! One of the most common challenges entrepreneurs face at the beginning is dealing with legal issues. Our office understands these and the fact that working under a budget creates concerns in regard to legal expenses.



What is Trademark?

A trademark is generally a word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others. •



**The More
Unique A
Trademark
the Better**

Trademark Rights...

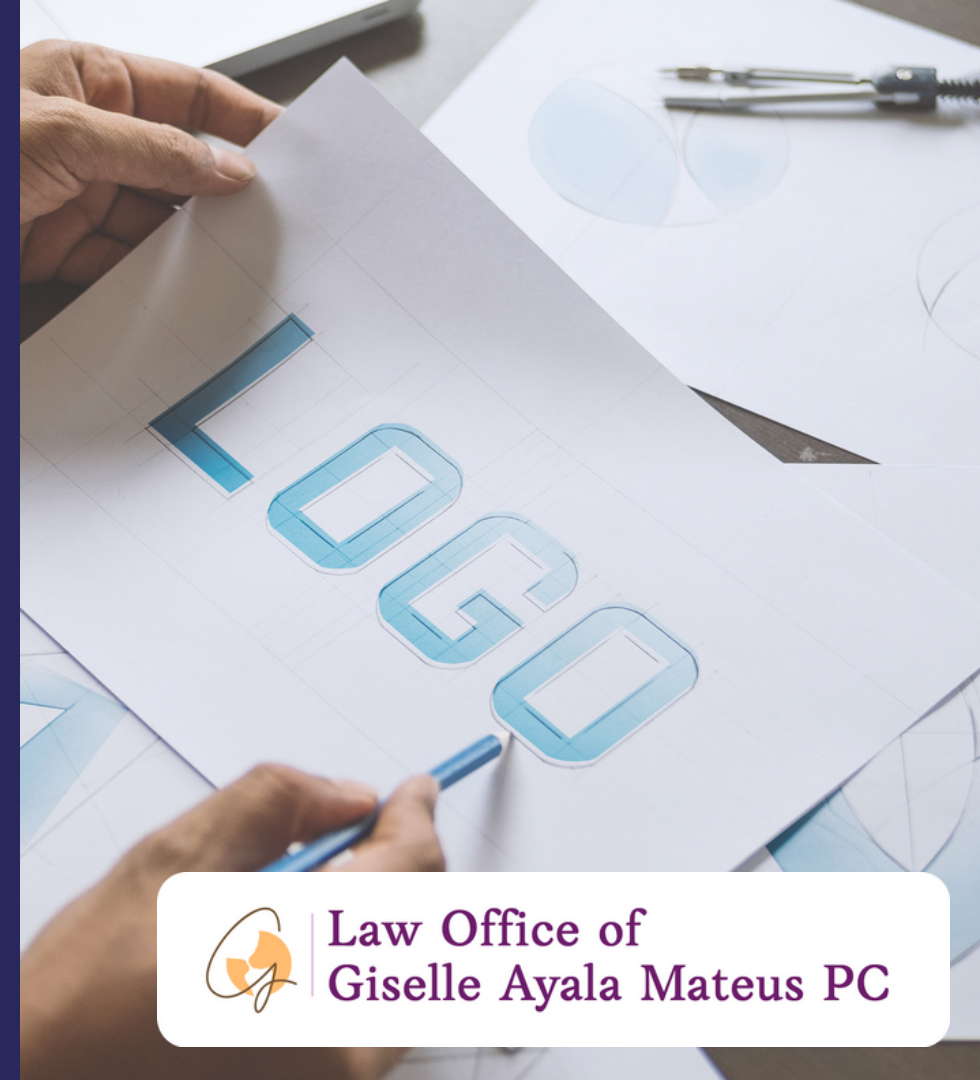
Unlike other countries in the United States trademark rights are acquired by the use of the trademark in commerce and also by registration.

Use is fundamental for legal protection



Why do We need Registration?

Although use in commerce creates Common Law rights registration gives trademark owners a more stronger legal protection against unauthorized use.



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Benefits of Trademark Registration

Discourages others from using confusingly similar marks

The trademark is easy to find and the registration is a basis for refusal of other registrations that are similar

Evidence of the validity and exclusive ownership of the mark

Trademark litigation can be very expensive. A trademark registration can end a litigation before it may commence.

A trademark registration is the best basis for a Cease and Desist Letter.

Ability to request statutory damages in the case of counterfeiting.

In litigation a party usually must offer evidence of damages to recover. A trademark registration allows a trademark owner to request the damages established by law and there is no need to prove actual damages.

Provides a basis for foreign registrations, facilitating protection of a marks worldwide as your business expands.



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**Companies register
trademarks every day
why they make
mistakes and lose
money?**

1. Lack of Understanding About the Level of Distinctivity of Trademarks

- **Generic Marks:** Use a common word for a product or service.
- **Descriptive Marks:** Describe, per the United States Patent and Trademark Office, an "ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services."
- **Suggestive Marks:** Need imagination, thought, or perception to arrive at an understanding of what the mark represents.
- **Arbitrary Marks:** Have no relation to the goods or services the mark represents.
- **Fanciful Marks:** Consist of a coined phrase or invented name.



Generic Trademarks

A generic trademark is incapable of acquiring distinctiveness.



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**CASH MANAGEMENT
ACCOUNT**

STEELBUILDING.COM

CHURRASCOS

BUYAUTOPARTS.COM

Descriptive Marks

The major reasons for not protecting such marks are:

(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and

(2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.



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**MY FINANCE
ADVANTAGE**

**FITNESS PLACE
OF HAPPINESS**

**BOOK THAT ARE
COOL**

SNO-RAKE

Suggestive Marks

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.



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SPEEDI BAKE



TINT TONE



DRI-FOOT





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Fanciful and Arbitrary Marks

Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language or are completely out of common usage.

Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services.



2. Incorrect or Inconsistent Description of Services or Products or the mark



The Examining Attorney does not know your product or service...

Ambiguity or lack of clarity can negatively impact your trademark registration

What do we need to understand?

There is list that of classes for each kind of goods and services.

The definition must be coherent to what the applicant actually promotes with the trademark.



The description of the goods or services must be precise



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Proper Classification

There are 45 classes of good and services from which an applicant may choose to register a trademark, precision is vital.

Identify your indented user and or client

It is very important to understand that user and client are not the same, you want the examining attorney to understand who will be the buying customer and who will be the user. Those two aspects differentiate you from others in the market and make your trademark registration stronger.

The description of the product or services must be consistent with the specimen

Most trademark registrations are delayed because the specimen used does not show the mark in connection to the services or products described.

One description of goods or services per class

It is very important that you apply for each class independently. Each class requires to pay a different fee and sometimes a different specimen.



**BE
SPECIFIC**

The description of the goods or services must be precise



Mark: Good Money Chips

Description: Dominoes; Poker chips

Specimen:

Good money chips



USPTO Non-Final Action

Registration is refused because the specimen in International Class 28 is merely a photocopy of the drawing or a picture or rendering of the applied-for mark, and thus fails to show the applied-for mark in use in commerce with the goods for each international class.



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The description of the goods or services must be precise



Mark: ACADEMIX

Description: Office supplies and school supplies.

Class 16: Class 16: Paper goods and Printed Matter

USPTO Non-Final Action

The wording “office supplies and school supplies” in the identification of goods needs clarification because it is too broad and could include goods classified in other international classes.

Applicant Correction:

Proposed: Class 016 for Office supplies and school supplies, namely, pens, pencils, highlighting markers, felt tip markers, drawing brushes, paint brushes, binder clips, paper clips, push pins, erasers, pencil holders, drawing compasses, scissors, shipping labels, rulers, paper hole punchers, pencil sharpeners, staplers



The description of the goods or services must be precise



Mark: ACADEMIX

Description: Office supplies and school supplies.

Class 16: Class 16: Paper goods and Printed Matter

USPTO Second Non-Final Action

The **wording “rulers”** in the identification of goods needs clarification because it is too broad and could include goods classified in other international classes. The applicant must identify each and every type of ruler it will provide to consumers and classify the goods accordingly. Additionally, **scissors are properly classified in International Class 8.**



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EXAMPLE



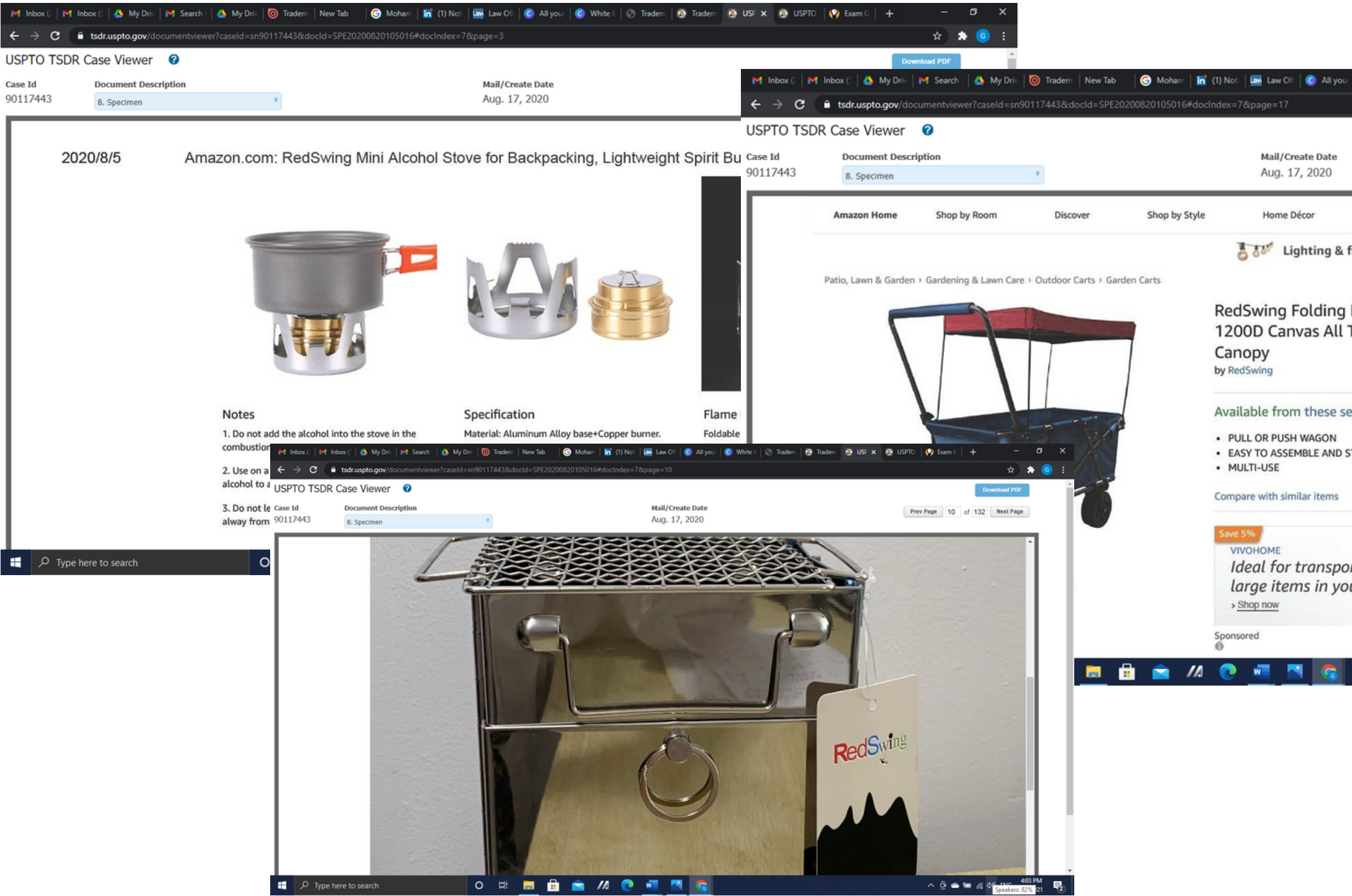
Each class is identified



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Marks register in different classes

EXAMPLE



Each class is identified and had a corresponding piece of evidence or specimen



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The description of the goods or services must be precise

Proper Classification

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**BE
SPECIFIC**



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Specimens

Evidence of use of the mark



Goods

The product must MARKED with the mark

Consistency is fundamental



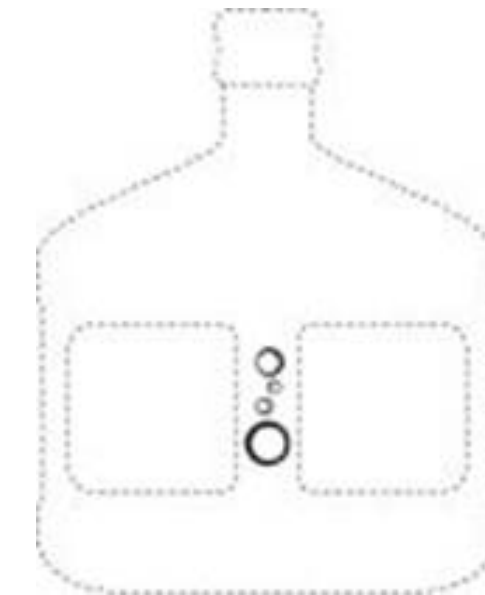
Services

The mark should be place in marketing materials near to the description of the services.

The description of the mark



The mark consists of the word "LULU" in stylized font having a backwards second "L" adjacent to an abstract symbol of a sun and the word "COMPANY" in stylized font positioned underneath the second "U" and the sun.



The mark consists of a series of circles stylistically representing a group of bubbles, such series being located on the handle of a water bottle. The outline of the bottle depicted in broken lines in the drawing is intended to show the placement of the mark when used and is not part of the mark.

Note: Any mark whose drawing includes broken lines must have a printed description.

3. Lack of a Preliminary Clearance Report



What do we do in a clearance report?

National Search in Principal TM Databases

We research not only the USPTO but also any state database where the client wants to promote services or products.

Persons, Legal Entities and Copyright Search Name

If a trademark is equal or substantially similar to a common name or the name of a company this may raise problems with the USPTO.

Open Search Online

We determine if a term is popular, is recognized in the industry, is offensive in other languages, has a meaning that can be descriptive, is being by others, is the name of a place, among others. The search covers different data bases and social media platforms.

Pictures and Images Code Search

To evaluate the distinctiveness of the mark and any possible ground for refusal on the basis of likelihood of confusion.



What do we do in a clearance report?

National Search in Principal TM Databases

We research not only the USPTO but also any state database where the client wants to promote services or products.

Start List At: OR Jump to record: 2626 Records(s) found (This page: 1 ~ 50)

Refine Search Submit

Current Search: S1: (LOOP)[COMB] docs: 2626 occ: 4998

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	90621315		LOOP-A-LOT	TSDR	LIVE
2	90231073		HOMELOOP	TSDR	LIVE
3	90354920		BOTTLELOOP	TSDR	LIVE
4	90354741		BOTTLELOOP	TSDR	LIVE
5	90351846		BOTTLELOOP	TSDR	LIVE
6	90351774		BOTTLELOOP	TSDR	LIVE
7	90029746		LOOPS AND LASHES	TSDR	LIVE
8	90289878		LOOP CARRIER	TSDR	LIVE
9	90287693		CHABLE	TSDR	LIVE
10	90285315		LOOPHOLZ	TSDR	LIVE
11	90274953		ORTHOLOOP	TSDR	LIVE
12	90185306		CARE LOOP POWERED BY CARE SOLACE	TSDR	LIVE
13	90105196	6306414	AIRLOOPS	TSDR	LIVE
14	90033655		NATURELOOP	TSDR	LIVE
15	90033649		NATURELOOP	TSDR	LIVE
16	90016265	6310942	DOORLOOP	TSDR	LIVE
17	90432708		DIMLOOP	TSDR	LIVE
18	90029057		NEW ALBANY LOOP ISLAND WETLANDS	TSDR	LIVE
19	90029053		LOOP ISLAND WETLANDS	TSDR	LIVE
20	90008490		INTERNATIONAL LOOPS	TSDR	LIVE
21	90430266		LOOPSUN	TSDR	LIVE
22	90265426		ARE YOU IN THE LOOP?	TSDR	LIVE
23	90589359		FULL-LOOP DEEP LEARNING	TSDR	LIVE



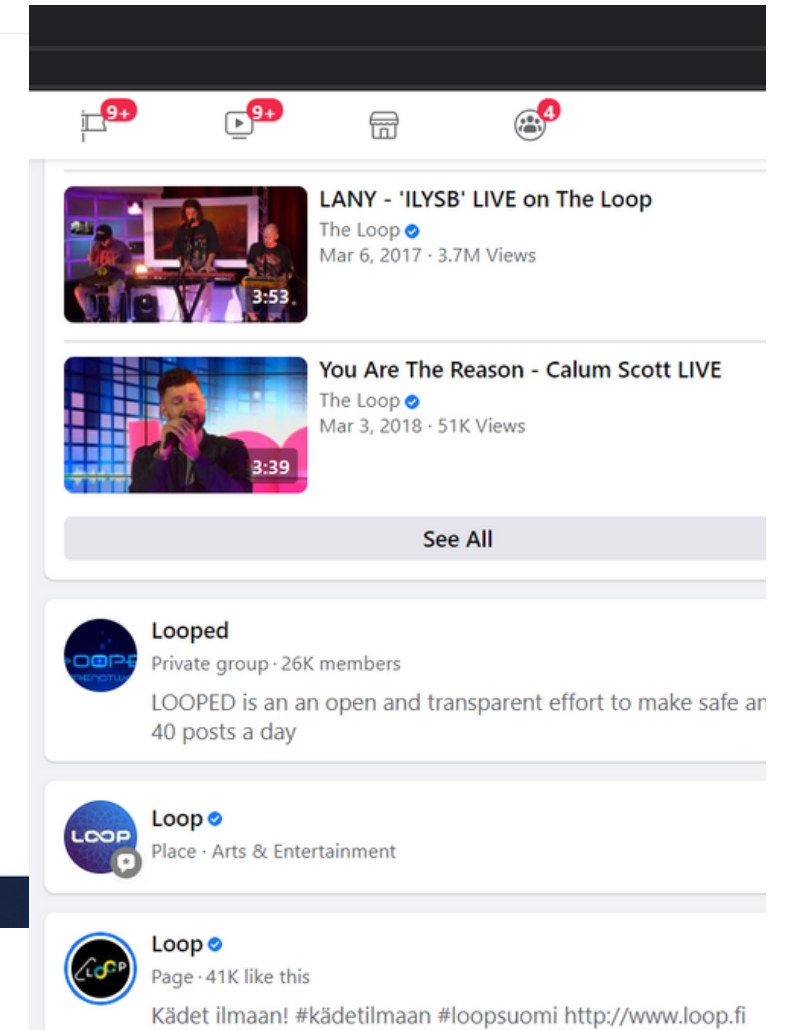
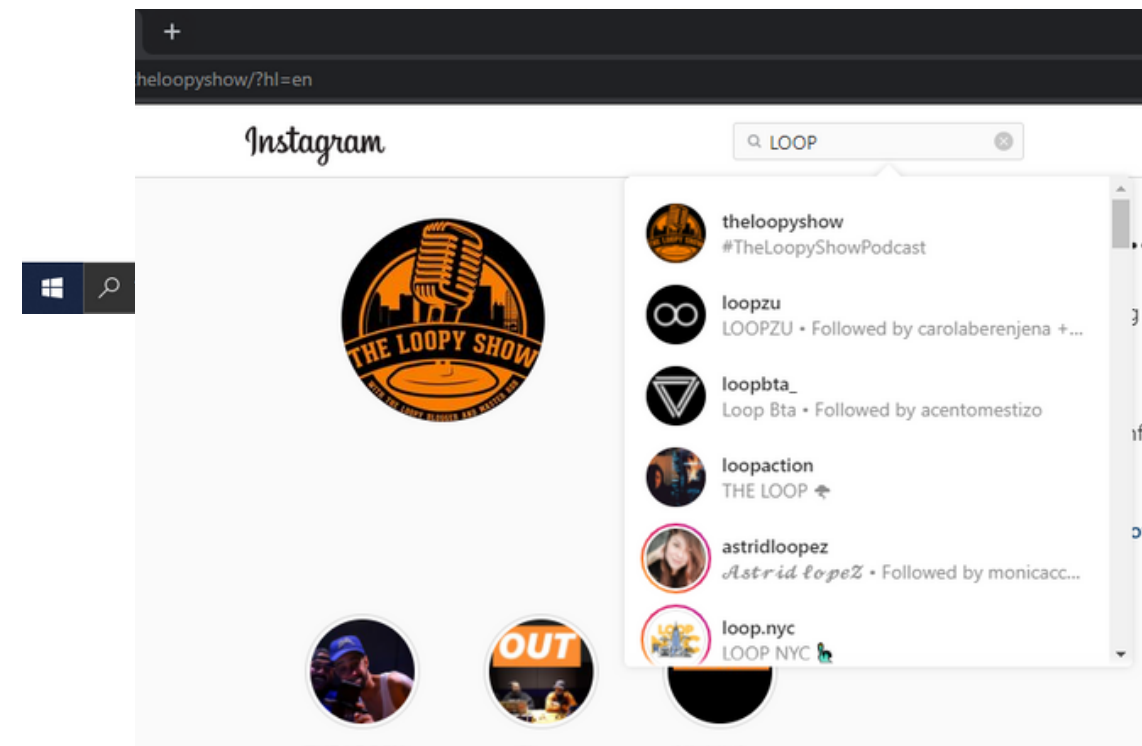
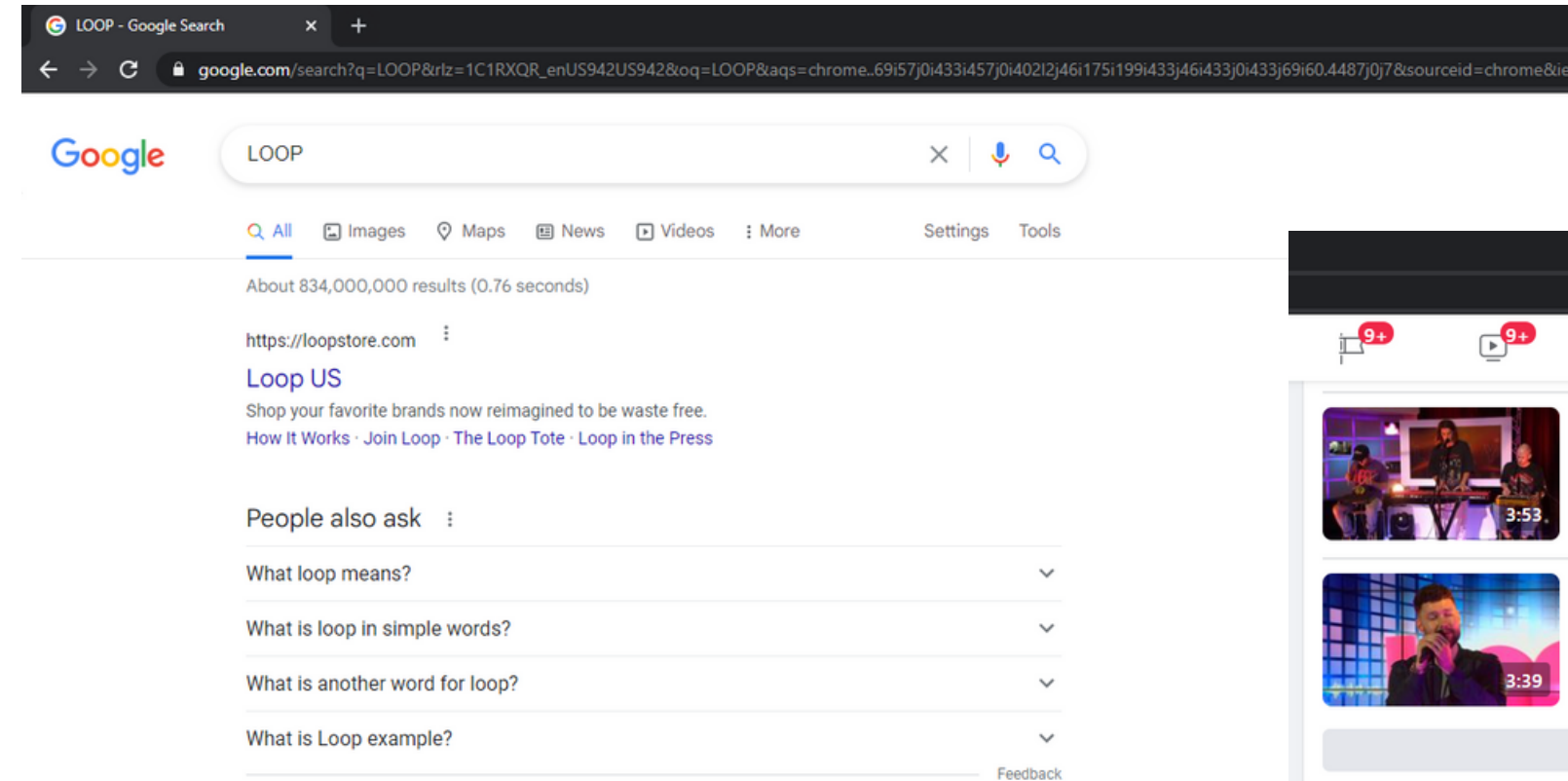
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What do we do we a clearance report?

Open Search Online

We determine if a term is popular, is recognized in the industry, is offensive in other languages, has a meaning that can be descriptive, is being by others, is the name of a place, among others. The search cover different data basis and social media platforms.



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What do we do in a clearance report?

Persons and Legal Entities Search Name

If a trademark is equal or substantially similar to a common name or the name of a company this may raise problems with the USPTO.

A total of 203 entities were found.

Entity Name
1 COMAC LOOP OWNER LLC
10 ASHLEY LOOP LLC
125 MEADE LOOP CORP.
138 LOOP LLC
14 DARTMOUTH LOOP CORP.
141 DARTMOUTH LOOP LLC
145 COMAC LOOP LLC
200 INDUSTRIAL LOOP PROPERTIES, LLC
202 LOOP REALTY, LLC
22 SEGUINE LOOP LLC
26 ASHLEY LOOP LLC
28 EAST LOOP ROAD REALTY LLC
28 INDUSTRIAL LOOP REALTY LLC
301 MACHINE LOOP LLC
33 COMAC LOOP OWNER LLC
330 MUIRFIELD LOOP LLC
40 INDUSTRIAL LOOP, LLC
41 LUCY LOOP LLC
44 FIELDSTONE LOOP, LLC
45 INDUSTRIAL LOOP LLC
45 MARBLE LOOP, LLC
47 ANJALI LOOP LLC
4800 BARBADOS LOOP, CORP
5 LOUDEN LOOP HOLDING COMPANY, LLC
566 INDUSTRIAL LOOP, LLC



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What do we do in a clearance report?

Copyright Search Name

If a trademark is equal or substantially similar to a common name or the name of a company this may raise problems with the USPTO.



"I solemnly swear that I am up to no good"



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What do we do we a clearance report?

Pictures and Images Code Search

To evaluate the distinctiveness of the mark and any possible ground for refusal on the basis of likelihood of confusson.



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Benefits of Trademark Clearance Report

A preliminary trademark clearance reports allows you to:

- Anticipate possible grounds for refusal.
- Anticipates defenses to overcome refusals such as, likelihood of confusion, the most common.
- Avoid waste money applications.
- Avoid trademarks that are weak.



4. Selection of a plain word trademark in a crowded market or when using names



A logo or other added elements can make the difference

A trademark is group of different elements

Sometimes the more elaborated the trademark the better.





Selection of a plain word trademark in a crowded market



USPTO Makes an Overall Analysis of the Mark

When it comes to the analysis of a trademark courts and attorneys consider the marks "in their entirety as to appearance, sound, connotation and commercial impression."



Words Accompanied by a logo have better chance to be registered

The commercial impression of trademark is usually visual. However, there are simple and single words that may convey a strong impression.



Crowded Markets...

There are market where the use of certain words is necessary to create trust in the customer of a service or a product,

A trademark with an stylized font and other added elements makes a better case before an examining attorney.

Selection of a plain word trademark in a crowded market

Trusted
Advisors



TRUSTED
ADVISORS



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Names...

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual. Specifically, a consent is required only if the individual will be associated with the goods or services, because the person is publicly connected with the business in which the mark is used, or is so well known that the public would reasonably assume a connection.



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Names...

Megan Rikers

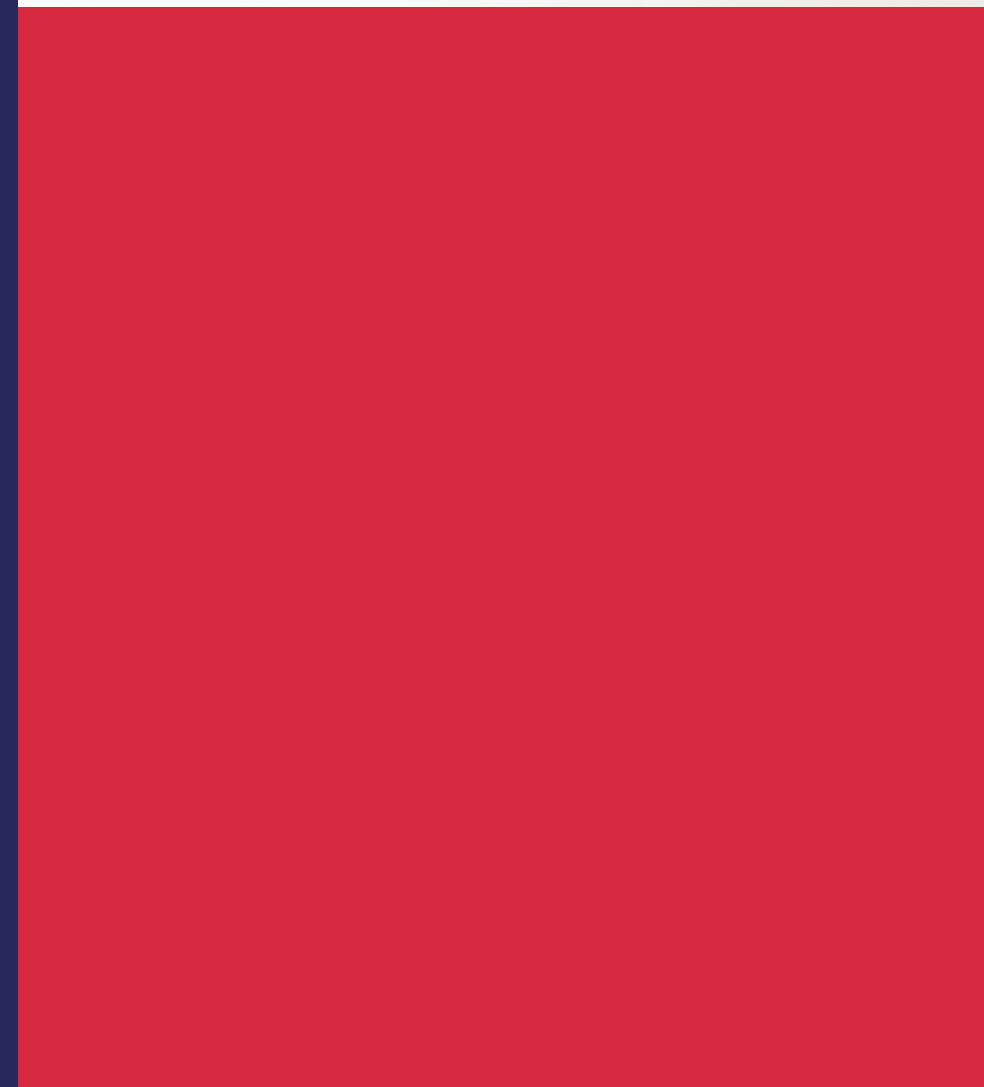


The use different elements can make a better case for the registration involving a name.



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4. Wrongful believe that a descriptive trademark is unprotectable



4. Wrongful believe that a descriptive trademark is unprotectable

- (1) Use of the registration symbol ® with the registered mark in connection with the designated goods and/or services, which provides public notice of the registration and potentially deters third parties from using confusingly similar marks.
- (2) Inclusion of the registered mark in the USPTO's database of registered and pending marks, which will (a) make it easier for third parties to find it in trademark search reports, (b) provide public notice of the registration, and thus (c) potentially deter third parties from using confusingly similar marks.
- (3) Use of the registration by a USPTO trademark examining attorney as a bar to registering confusingly similar marks in applications filed by third parties.
- (4) Use of the registration as a basis to bring suit for trademark infringement in federal court, which, although more costly than state court, means judges with more trademark experience, often faster adjudications, and the opportunity to seek an injunction, actual damages, and attorneys' fees and costs.
- (5) Use of the registration as a filing basis for a trademark application for registration in certain foreign countries, in accordance with international treaties.



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CONCLUSION

Make a Plan

It is fundamental that you make a plan because a trademark registration can be costly, specially if you do not anticipate grounds for refusal.



**Any report
is better
than no
report**

**A clearance
report can
answer many
questions**

About registrability, possible denials, how crowded is the market, what possible oppositions you may encounter among others.



**The ideal would
be to register
your trademark
with the help on
an attorney**

It is a best practice to have an attorney. However, you can start on your own do research and USE your mark, that is fundamental to obtain registration .



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Q & A



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One Talk to You About



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