



Free Legal Workshop Series at the
Lyles Entrepreneurship Center




WHAT'S MY TRADEMARK?





The Legal Game Show That's Got
Everyone Protecting Their Brand!

March 16, 2018, 12pm – 12:30pm


With Legal Celebrity Guest Panel!



Featuring: The 15-Minute Lawyer
*A legal issue explained in 15 minutes,
followed by Q&A in-person/online*



The VALLEY
CALIFORNIA
Law • Real Estate • Business • Insurance • Estate Planning • LLC • Personal Services • Tax



(SNAPCHAT)

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“DESCRIPTIVE” MARKS

Descriptive marks simply describe a product’s ingredients, use, purpose, quality, characteristic or function.

E.g. “Cold and Creamy” Ice Cream.

Only protected if consumers associate the mark with a single source of the product.



3

“SUGGESTIVE” MARKS

Suggestive marks suggest a connection between the mark and the product, like “Microsoft” or “CitiBank”



4

“ARBITRARY” or “FANCIFUL” MARKS

Arbitrary marks take a common thing and connect it with unrelated products or services. Fanciful marks create a whole new word.



5

3 DOUG NIGHT



CRAFT BEER

6

“You don't need a lawyer to file a Trademark”

True, USPTO site is relatively lay-friendly.

7

“If you make a mark, you should go file with the USPTO right away, because until then you have NO PROTECTION.”

- (False, if you've simply used it in commerce, then you'd get common law protection, but it's limited).

8

“All you have to do is go on the USPTO’s website and do a basic word search”

- (False – that will only turn up any registered trademarks that might conflict – you also have to worry about those with common law rights. You find those by doing an internet search. You should always do BOTH before applying.

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“If you have name and a logo, you should always trademark those TOGETHER.”

- (False, unless you ALWAYS will USE them TOGETHER).

10

“Once you get your trademark approved by the USPTO you automatically get some international protection as well”

- (True, for countries that have signed on to the Madrid Treaty and Protocol).

11

“You don’t have to worry about trademark protection if you’re using your own name for your business or product.”

- (False. Your use would be denied if it could cause customer confusion. (e.g., if your name was really “Louis Vuitton” you couldn’t just start marketing suits).

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“Buying the domain address for your desired name provides the same protection as filing a trademark.”

- (False. It’s also not true that registering a trademark gives you ownership of a domain name. However, if someone else has registered the domain in bad faith, there are ways to get that voided for "cybersquatting").

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“I can use the symbol of “R” in a circle to show others that I have registered my Trademark.”

- (True. If your trademark has not yet been granted then you may only use the TM symbol or nothing at all).

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CLASS 32:

Coverage includes:

- beers
- mineral waters, and
- other non-alcoholic beverages

15

CLASS 33:

Coverage includes:

- wine and spirits
- does not include beer

16

CLASS 35:

Coverage includes:

- sale of clothing
- operation of a retail clothing store, and

17

CLASS 25:

Coverage includes:

- Clothing and footwear manufacturing

18

CLASS 43:

Coverage includes:

- Services for providers of food and drinks

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INFRINGING MARK?

- A dog food rating blog uses dog pictures to give high or low marks. The best products are referred to as "3 Dog Nice"

20

INFRINGEMENT MARK?

- A new wine for dog lovers has this logo:



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INFRINGEMENT MARK?

- Glade decides to start marketing an air freshener with different dog smell "flavors" – poodle, etc.

22

INFRINGEMENT MARK?

- A pet supply company has different size dog beds – (picture of 3 Golden Retrievers in a bed, looks a little like 3 Doug Night Beer logo)

23

INFRINGEMENT MARK?

- A popular singer, Doug Knight starts selling his third album, which he simply calls “3” (Picture)

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INFRINGING MARK?

- A creator of hangover remedies puts out a new product called “Hair of the Dog that Bit You”

...it smells like dog..

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Free Legal Workshop Series at the
UC Merced Venture Lab

WHAT'S MY TRADEMARK? ?? QUESTIONS ??



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