



SELECTING AND EVALUATING A TRADEMARK

Selecting a Mark

The selection of mark occurs in a variety of ways.

- ❖ companies hold contests and encourages employees to create a mark for a new product line or service
- ❖ Companies engage sophisticated research
- ❖ Branding firms that will conduct surveys and create a mark and a logo or design for the company.
- ❖ There are name creation software programs that help individuals and companies create marks

Once the mark is selected, it must be screened and evaluated for use and registrability, if failed then it leads to wastage in expenditure of time and money in advertising, using, and applying for a mark that is rejected for registration by the PTO or, in the worst case scenario, might subject the owner to damages for trademark infringement and unfair competition.

Reviewing a Proposed Mark

Once a mark is selected, it should be carefully scrutinized to ensure that it will not be excluded from protection under the Lanham Act.

- ❖ Firstly they have check whether the mark contains scandalous (giving offence to moral sensibilities and injurious to reputation)
- ❖ Whether consent from a living person will be required,
- ❖ Whether the mark is generic,
- ❖ Whether it is statutorily protected
- ❖ Whether the mark is descriptive of some feature of the goods and services offered under the mark,
- ❖ It also see that the mark includes foreign terms
- ❖ Many law firms specializing in trademark work use a questionnaire form or data sheet to gather questionnaire form or data sheet to gather basic information from clients about their marks

THE TRADEMARK SEARCH

Scope of search

- ❖ There are a variety of sources that can be reviewed to locate potentially conflicting marks
- ❖ There are literally millions of marks registered or applied for at the PTO, and thousands of journals, trade magazines, directories, telephone books, Internet sources, state records, and state trademark

registrations that might contain other marks or business names, a computer assisted or online search is the most effective method of searching.

- ❖ Both LEXIS and WESTLAW, the computer-assisted legal research system, offer access to vast databases that may point out conflicts.
- ❖ One of the best known databases is TRADEMARKSCAN product OF Thomson & Thomson.

Conducting the trademark search

The trademark searching is a two-step process:

- ❖ *a preliminary search* is conducted of the records of the PTO to make a quick determination as to whether the mark may be available or whether there is conflict that would preclude use of the mark. It is also called a **knockout search**.
- ❖ If the results of the preliminary or knockout search indicate a mark may be available, a comprehensive search of other sources (including state trademark records, telephone directories, Internet records, and trade journals) is then conducted.

Step One: The Preliminary Search

There are a variety of sources that can be used to conduct an initial trademark search, including online subscription services, CD-ROM, the Patent and Trademark Depository Libraries, and the PTO website search services. Following are some resources commonly used for conducting a preliminary search:

Electronic Database and CD-ROM

- ❖ TRADEMARKSCAN is a database owned by Thomson & Thomson, a renowned trademark search firm, which provides information on all active registered trademarks and service marks. The TRADEAMRKSCAN database is primarily used as a quick screening tool to determine the availability of a new mark.
- ❖ DIALOG is another database offered by Thomson & Thomson. Its database includes trademarks from the United States plus numerous foreign countries as well as patent and copyright information. It provides online training and practice and free practice searching at the following web site: <http://training.dialog.com/onlinecourses/trademarks/>.
- ❖ SAEGIS is an entire suite of services provided by Thomson & Thomson that allows online worldwide trademark searching as well as searching of domain name registries and websites to locate common law uses of proposed marks.
- ❖ TRADEMARK.COM is an online search service offered by Micro Patent LLC, offering a variety of searchable databases, including federal marks, and common law uses of potentially conflicting marks.
- ❖ LEXIS and WESTLAW, the computer-assisted research system, offer access to vast trademark databases that may disclose potentially conflicting marks.

Many law firms subscribe to one or more of these services so they can perform an initial screening search in-house.

PTO Web Site : Perhaps the easiest and least expensive way to conduct a very preliminary search is to review the records of the PTO (<http://www.uspto.gov>) and its free public searching called *Trademark Electronic Search System (TESS)*.

Step Two: The Comprehensive Search

A separate professional trademark search firm exists for the companies when they need to search for a trademark. These companies review the records of the PTO (go through existing and pending applications), review state trademark office records for state trademark registration, and they perform a “common law” search of various journals, directories, press releases, domain names and Internet references to locate unregistered names and marks.

These professional search firms can save considerable time and money and more importantly, provide a more thorough search than that which an individual can conduct on his or her own, they also check for identical and phonetically equivalent marks for similar goods and services and will also check for foreign equivalents. They will charge for the searching of the marks. The report is typically divided into three sections: results gained from reviewing PTO registrations and applications; results gained from reviewing state trademark records; and the common law results.

TRADEMARK REGISTRATION PROCESSES

Preparing the application

- ❖ Once a mark has been selected and evaluated for use and registrability, an application for federal registration of the mark should be prepared and filed.
- ❖ An application is provided by PTO
 - ✓ The name of the applicant
 - ✓ The citizenship of the applicant
 - ✓ The address of the applicant
 - ✓ The address of the applicant
 - ✓ An identification of the goods and or services offered under the mark
 - ✓ A drawing of the mark
 - ✓ A verification or declaration signed by the applicant or agent or attorney
- ❖ The application is based on actual use of the mark or the owner's intent to use the mark.
- ❖ The process of moving an application through the PTO is called prosecution [(law) the institution and conduct of legal proceedings against a defendant for criminal behavior]
- ❖ The application must be in English.
- ❖ Electronically filed applications are provided by the PTO
- ❖ Self application is also prepared as the letter size (namely 8 ½ inches by 11 inches) paper, typewriter, double-spaced, with margins of at least 1 ½ inches at the left and top of the pages.
- ❖ The application should be written on only one side of the paper.

- ❖ The filing and prosecution of trademark application are governed by the TMEP [Trademark Manual of Examination Procedure]
- ❖ The PTO introduced an electronic filing system in 1998.
- ❖ The Trademark Electronic Application System [TEAS]. Permits applicants to file numerous documents electronically.
- ❖ PTO considers the electronically filed document after transmission.

The applicant

- ❖ The mark can be made only by the owner of the mark or, in the case of intent –to-use application, by a person who has a bonafide to use the mark in commerce.
- ❖ Application may be natural persons or business entities such as corporation, partnership, association, unions or other organization.
- ❖ Government entities such as nations, states municipalities and other governmental bodies.
- ❖ The applicant name must be in correct legal form
- ❖ A mark should be identified in the application by the name set forth in its articles of incorporation.
- ❖ Clients often make mistakes in their corporate names or in the punctuation
- ❖ The certificate of registration will issue in the name of the application as set forth in the application
- ❖ If the application is a person or business that conducts business under a fictitious [fake] business name, the application will be rejected.
- ❖ The applicant is a partnership **For example:** “Balboa Gardens Partnership”, the application should be made by the partnership itself and the state in which the partnership was organized.
- ❖ A trademark or service mark application is usually filed in the name of one party.
- ❖ The PTO has been reluctant [unwilling] to accept application by joint applicants.
- ❖ A joint venture or a partnership cannot be joint applicants

Identification of Goods or Services

The application must identify the goods and/or services offered or to be offered under the mark that is the subject of the application. Careful consideration must be given to drafting this part of the application. Goods and services are categorized by the PTO into forty-five separate classes, called **International Classes** because many other nations use this same classification system established by WIPO. Until 1973, the PTO used a different classification scheme, called the United States Classification Scheme. Each class requires a filing fee of \$335.

A detailed listing of the International Classes with numerous examples is found in Chapter 1400 of TMEP, available on the PTO’s web site. If a mark is used for more than one class of goods or services, the applicant may either file a combined application, listing all of the goods and services. Some attorneys prefer to file separate application believing that a defect in regard to one class of goods or services in a combined application will hold up registration for the mark in all class.

The PTO requires that the identification of goods or services be as clear, accurate and concise as possible. Once the application filed, no other item can be added in the process of registration, a separate application should be applied.

REGISTRATION

- ❖ A registration will issue about twelve weeks after publication in the official gazette
- ❖ If no notice of opposition is filed to the application
- ❖ For an ITU [Intent-to-Use] application registration will occur after publication in the official Gazette.
- ❖ The PTO will issue a certificate of registration for the mark
- ❖ The term of the registration is presently ten years from the date the mark is registered [for registration issued before November 16, 1989, the term is twenty years]
- ❖ “TM” for Trademark & SM for service mark.

United States of America

United States Patent and Trademark Office



Reg. No. 3,665,378 WISDOM TO GO, INC. (CALIFORNIA CORPORATION) Registered Aug. 11, 2009 1829 WEST LYDIA LANE PHOENIX, AZ 85041

Int. Cls.: 41 and 45 FOR: PERSONAL COACHING SERVICES IN THE FIELD OF SELF-IMPROVEMENT; EDUCATIONAL SERVICES, ~~NAMES~~, CONDUCTING SEMINARS AND WORKSHOPS IN THE FIELD OF SELF IMPROVEMENT; ENTERTAINMENT IN THE NATURE OF ON-GOING SERVICE MARK **DRA O** TELEVISION ANPR DI OGRAMS IN THE FIELD OF SELF-IMPROVEMENT, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).
PRINCIPAL REGISTER

FIRST USE 1-19-2007; IN COMMERCE 1-19-2007.

FOR: PERSONAL ENRICHMENT SERVICES, NAMELY, PROVIDING SELF IMPROVEMENT COUNSELING; PROVIDING INFORMATION IN THE FIELD OF SELF-IMPROVEMENT VIA THE INTERNET AND PORTABLE MEDIUMS INCLUDING CELL PHONES AND VIDEO PHONES, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 1-19-2007; IN COMMERCE 1-19-2007.

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

THE COLOR(S) BLACK, RED, WHITE, GOLD, YELLOW, RUST AND MAGENTA IS/ARE CLAIMED AS A FEATURE OF THE MARK.



THE MARK CONSISTS OF THE WORDING "THE ONE MINUTE ZONE", WITH THE LETTERS "ONE" FORMING BOTH "ONE" AND PART OF THE WORD "ZONE", AND A SUN DESIGN RADIATING OUT FROM THE CENTER OF THE LETTER "O". THE COLORS BLACK, RED, WHITE, GOLD, YELLOW, RUST AND MAGENTA ARE CLAIMED AS A FEATURE OF THE MARK. THE WORDS "THE" AND "MINUTE" ARE IN THE COLOR BLACK, THE LETTER "Z" AND THE LETTERS "ONE" ARE IN THE COLOR RED AND OUTLINED IN THE COLOR WHITE, THE CENTER OF THE SUN DESIGN IN THE LETTER "O" IS IN THE COLOR WHITE, THE OUTER SUN DESIGN IS IN THE COLOR GOLD, AND THE LINES RADIATING FROM THE SUN DESIGN ARE IN THE COLORS YELLOW, GOLD, RUST AND MAGENTA.

David J. Kappas

SER. NO. 76-683,444, FILED 10-29-2007.

JOHN GARTNER, EXAMINING ATTORNEY

Director of the United States Patent and Trademark Office

* Note: The seal will be a gold, embossed seal similar to what appears on the current cover bind.

**REQUIREMENTS TO MAINTAIN YOUR
FEDERAL TRADEMARK REGISTRATION**

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT

FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First /Ten Years

*** What and When to File:**

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §1058. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date. *See* 15 U.S.C. §1059.

Requirements in Successive Ten Year Periods

*** What and When to File:**

- You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period calculated **from the registration date**.

Grace Period Filings*

The above documents will be accepted as timely if filed **six-months** after the deadlines listed above with the payment of an additional fee.

The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or reminder of these filing requirements.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must also timely file the Declarations of Use (or Excusable Nonuse) referenced above at the USPTO based on the U.S. registration date (not the international registration date). However, the grace periods for these registrations are different, as is the time period for filing the declarations of use due every ten years after the registration date. The declarations due every ten years must be filed within six-months before expiration of the ten year period. In addition, there is no grace period for the declaration due between the 5th and 6th years after the registration date, and there is a three-month grace period for the declarations due every ten years. *See* 15 U.S.C. §1141k. Further, owners of these registrations do not file renewal applications at the USPTO, but instead must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. You can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

*** Note:** The seal will be a gold, embossed seal similar to what appears on the current cover bind

UNIT-3

COPYRIGHTS

Introduction

Every year millions of Americans create original works like books, music, research and other forms of creative expression. All these creation are Intellectual Property and all of them are protected by copyright. Writers, editors and publishers, understanding copyrights issues are essential. Especially now that the production of counterfeit [imitating] and pirated goods, including written works, has become so prevalent.

In 2005 more than \$600 billion in pirated and counterfeited goods were recognized by WCO [World Customs Organization]. Now-a-days the internet has made copying and distributing protected material easier than ever before for avoiding copying the material. So, in order to protect yourself from IP theft, it's important to know the basics about rights.

Definition

“The legal protection given to published works forbidding anyone but the author from publishing or selling them. An author can transfer the copyright to another person or corporation, such as a publishing company.”

What is a Copyright?

- ❖ Copyright is a form of protection provided by U.S. Law to the authors of “**Original Works of Authorship**” fixed in any tangible medium of expression.
- ❖ The manner and medium of fixation are virtually unlimited.
- ❖ Creative expression may be captured in words, number, notes, sounds, pictures or any other graphic or symbolic media.
- ❖ The subject matter of copyright is extremely broad, including literary, dramatic, musical, artistic, audiovisual and architectural works.
- ❖ Copyright protection is available for both published and unpublished works.

History

- ❖ In England prompted the first insistence upon protection for publication of books
- ❖ Bookbinders and printers demanded protection from copying of books.
- ❖ Authors also began to demand protection from unauthorized copying and demanded to share in the financial rewards
- ❖ Finally, in 1710, parliament enacted the first copyright statute [Act/law], the Statute of Anne [Named after Anne, Queen of Great Britain, the Statute become the foundation for British and American Copyright Law]

- ❖ The first copyright law is enacted under the new U.S. Constitution, Protecting books maps and charts for 14 years with privilege of renewal for another 14 years
- ❖ Copy right registration is made in the U.S. district court where the author or proprietor resides.
- ❖ The first copyright entry, “The Philadelphia Spelling Book” by John Barry, is registered in U.S. District court of Pennsylvania. Protection is for 14 years with a renewal period of author 14 years.

Common Law Right

- ❖ The enacted the first copyright act in 1790 and the first federal copyright registration were issued.
- ❖ Until January1, 1978 [the effective date of the 1976 copyright Act] the U.S had a dual system of copyright protection.
- ❖ Until 1978, an author has a perpetual common law right to their unpublished works.
- ❖ Once the work was published, however, the common law perpetual copyright was extinguished and protection was afforded by virtue [quality] of the 1909 act, provide protection up to fifty-six years.
- ❖ Publication is the distribution of copies of a work to the public for sale or other transfer of ownership, by rental lease, or lending.
- ❖ The dual nature of copyright protection was complex, often led to controversy
- ❖ The 1976 act eliminated the distinction between unpublished and published works.

For Example: Ernest Heming way’s a farewell to Arms [Published in 1929], are governed by the act in existence on the date of their publication. Heingway’s book would thus be governed by the 1909 act.

- ❖ Just as trademark rights arise from use and not from registration with PTO
- ❖ A copyright registration from the copyright office provides certain advantages to author’s of work, including the following.
 - ✓ Registration establishes a public record of the copyright claim
 - ✓ Before an infringement suit may be filed in court, registration is necessary for works of U.S origin
 - ✓ If made before or within five years of publication, registration will establish Primafacie evidence in court of the validity of the copyright and of the facts stated in the certificate and
 - ✓ If registration is made within three months after publication of the work or prior to an infringement of the work, statutory damages and attorney’s fee will be available to the copyright owner in court action
- ❖ Copyright protection generally lasts until seventy years from the death of the author.
- ❖ The 1976 copyright act is found at 17 U.S.C. §§101-1101 and it was amended for several times.

- ❖ In 1980, specific protection was afforded to computer programs as works entitled to copyright protection.
- ❖ Copyright Act © represents
- ❖ Another 1998 amendment to copyright law is the Digital Millennium Copyright act.

The United States Copyright Office:

Register of Copyright,
 Copyrights office,
 Library of Congress,
 101 Independence Avenue SE,
 Washington,
 DC 20559-6000

- ❖ The copyright office is not permitted to give legal advice and will not offer guidance on matter such as disputes, suits against possible infringers or other matters related to copyright.
- ❖ Among the more useful publications and materials are the following:
 - ✓ Forms for copyright registration
 - ✓ Circular 1, “Copyright Basics”,
 - ✓ Circular 2, “Publication on copyrights”,
 - ✓ Circular 3, “Copyright Notice”,
 - ✓ Circular 4, “Copyright Fees”
 - ✓ Circular 15, “Renewal of Copyright”
 - ✓ Circular 15a, “Duration of Copyright”; and
 - ✓ Circular 38a, “International copyright Relations of the United States”; and
 - ✓ Circular 61, “Copyright Registration for computer Programs”

To order copyright publications, write to:

**Library of Congress,
 Copyright Office,
 Publication section,
 LM-455,
 101 Independence Avenue SE,
 Washington-DC20559-6000**

- ❖ Circulars and announcements are available via facsimile
- ❖ If you do not know the document number of the items you want, you may request that a menu be faxed to you
- ❖ All the data pertaining to copyrights are available in Internet
- ❖ The copyright office provides a free electronic mailing list, “NewsNet”, that issues periodic e-mail messages on copyright issues
- ❖ Copyright office process the application via electronically