Trademark

- device in almost any form capable of identifying and distinguishing specific goods or services

- letters and words
- logos
- pictures
- combination of words and a logo
- slogans
- colors
- product shapes
- sounds

Strength of Trademarks

Best to worst strength in descending order:

- fanciful
- arbitrary
- suggestive
- descriptive (including surnames)
- generic

Common Law Trademark Rights

- developed through use

- judicially defined rights under state law

- limited to geographic area within which used

Federal Trademark Applications and Registration

BENEFITS:

- National in scope
- Ability to recover profits, damages and costs for infringement, with potential for treble damages
- Recover attorney's fees
- After five years of registration, incontestable status

BENEFITS: (continued)

- Right to use Registration symbol
- Increased ease of discovery by others
- Right to sue in federal courts
- Block importation of goods into US bearing your mark
- Prima facie evidence of trademark ownership and use

Trademark Searching

Scope: registration is not required and thus search must extend well beyond registers judicially defined rights under state law
     Search:
- federal trademark registrations *
- state trademark registrations *
    * include pending & abandoned applications & expired registrations
- common law trademark rights **
    ** databases, periodicals, web, etc.

Trademark Searching

- less than comprehensive search will result in problems with examiner (often hire specialist)
- after search, typical to acquire "availability of use opinion" from attorney

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Some marks can't be trademarked

• confusingly similar marks if likely to cause confusion
• merely descriptive or misdescriptive marks
• immoral, deceptive or scandalous marks
• marks that disparage or suggest false relationship with person, institution, belief or national symbol or which brings them into contempt or disrepute
• etc.

Types of Trademark Applications to PTO

1. **Use Application** - already using mark in commerce
2. **Intent-to-Use Application** - can't acquire registration until actually used
3. **Application based on application in another country**
4. **Supplemental Registration** - marks that are descriptive in nature but at present do not have secondary meaning (secondary meaning assumed after 5 years)

Registration

typically most efficient through a trademark attorney to:

- minimize and address USPTO examining attorney grounds for rejection and

- deal with objections by other parties

Duration

- ten years with ten year renewals as long as proof of use continues

Infringement Criteria

 - plaintiff needs to prove defendant's use of a mark has created a likelihood of confusion about the origin of the goods or services

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Dilution
- only famous trademarks protected from dilution of the distinctive quality of the mark, no need to show confusion or competition
• Blurring (McDonald's sushi - consumer might assume relation) or
• Tarnishment (unsavory, unwholesome or inferior products - JJ Bean Cheap Tents)

Relief
 - injunction against further infringement & attorneys fees if federally registered
 - monetary damages seldom awarded

Further Burdens in Using Trademark

- Must police use of the mark & pursue infringement or lose mark
- Easy to find on web so must routinely pursue
- Domain names identical to famous company trademarks are particularly challenged

IV. Trade Secret

A trade secret is information that:
• is not generally known to the public;
• confers some sort of economic benefit on its holder;
• is the subject of reasonable efforts to maintain its secrecy.

What does trade secret protect?
> - typically "information" that might be in the form of a formula, pattern, compilation, program, device, method, technique or process
>> e.g. *formula* for Coca Cola but also the *methods* and *processes* by which ingredients are created and combined

What might be legally constitute reasonable measures to keep the information secret?
- confidentiality and non-disclosure statements with employees and clients
- require marking by employees of all information to be kept confidential (documents, files, programs, etc) , logging of access, and regular audits of security measures

How long does trade secret last?
> - indefinite period of time (e.g. perpetual monopoly possible)
> … but no protection from independent discovery of the secret (e.g. reengineering is legal, chemical analysis of Coca Cola is legal)

Benefits of trade secrets

• not limited in time duration,
• no formal registration or other formalities,
• immediate effect,
• no disclosure to the public

Limitations of trade secrets

• burden to keep confidential,
• independent discovery may allow others to use,
• others may protect same secret through patent,
• more difficult to protect than through patent.

As between *trademark in their brand* or *trade secret in their product*, which is more valuable to Coca Cola?

As between *patents* and *trade secrets*, what is more valuable to most private companies in protecting their market share or in gaining market position?