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

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

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)
<table>
<thead>
<tr>
<th>Benefits of trade secrets</th>
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<tr>
<td>• not limited in time duration,</td>
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<tr>
<td>• no formal registration or other formalities,</td>
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<td>• immediate effect,</td>
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<td>• no disclosure to the public</td>
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<th>Limitations of trade secrets</th>
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<tr>
<td>• burden to keep confidential,</td>
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<td>• independent discovery may allow others to use,</td>
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<tr>
<td>• others may protect same secret through patent,</td>
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<td>• more difficult to protect than through patent.</td>
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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?