



The Metro IBA Education Committee welcomes you to the webinar:

Protecting your Brand – Trademarks 101

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This webinar will be recorded



Trademarks 101

Smart legal strategies to grow and protect your business.



About Jambor Heyman

- “Lawyers for Good Food”
 - Specialty, Natural, Organic, Healthy, Non-GMO
 - Over 20 combined years of experience
- One-stop shop for food businesses
 - Business, Trademark, Regulatory
 - Entrepreneurial Education
 - Valuable Resource Network



Presentation Road Map

- What is a Trademark?
- Why Trademark?
- Federal Registration Basics & Benefits
- Trademark Searches
- Trademark Applications: Refusals & Timeline
- Trademark Issues
 - Governmental
 - Private
- After Registration



What Is A Trademark?

- Symbol, logo, words used to identify your goods/services & distinguish them from others.
 - Company/brand name
 - Logo
 - Tagline
 - Graphics, color, or shape of packaging



What is a Trademark?

- **NOT:** Domain name registration
- **NOT:** Reserving your business name with the Secretary of State
- **NOT:** Generic terms that describe product/services – only distinctive words or images are trademarks.



What is a Trademark?

- Trademark law protects marks, which are distinctive/out of the ordinary.
- Examples of inherently distinctive marks:
 - Unique logos (the Nike[®] swoosh);
 - Made up words (Kodak[®]);
 - Arbitrary marks, words that are surprising or unexpected (Apple[®] for computers); and
 - Suggestive marks, words that cleverly describe the qualities of the product or service (Contact[®] for self-adhesive shelf paper).



What is a Trademark?

- Philia Foods:
 - Cheese spreads
- Gustola Granola:
 - Cereal bars; Granola
- Cold Front:
 - Café and restaurant services; Coffee shops; Ice cream shop services
- Brooks High Beer Battered:
 - Providing of food and drink via a mobile truck.
- Growing Green Hearts:
 - Educational Services



Trademark Basics

- First user in commerce acquires rights & may prevent others from using the mark
- Common-law rights arise from use - only protect in area of actual use
- Using a distinctive mark within Minnesota-can register with the Minnesota Secretary of State
 - But that protection is only within Minnesota



Trademark Basics

- Federal registration requires actual use in interstate commerce, or
- “Bona fide intent to use” the mark – Intent To Use (ITU) filing
- Federal registration provides nationwide protection



Trademark Basics

- Use of TM, SM, ®
 - TM: Commonlaw rights for Goods – use if unregistered
 - SM: Common Law Rights for Services – use if unregistered
 - ®: Registered Trademark – use once registered



Why Trademark?

- Right to exclude others from use of mark with goods/services
- Primary purpose of trademark law:
 - Prevent unfair competition – trademark infringement =s one form of unfair competition.
- Rationale:
 - Owner of trademark spent time & money presenting service/product to consumers, so owner should be able to protect this investment by preventing others from using the trademark and profiting from the owner's investment.



Why Trademark?

- Protect investment in value of brand name
 - Marketing key in many small business sectors
 - Protects the mark(s) that buyers associate with your product
- Your brand is a business asset with monetary value
- Certainty
 - You own your IP; helps with investor/sale
 - Avoid bad surprises down the line that jeopardize your brand
 - Cease and desist letters
- Trademark bullying
 - Registration helps avoid/find issues
 - Economic inability to defend



Why Trademark?

Rule of Thumb – Trademark If . . .

- You sell products/advertise services across state lines;
- You plan on expanding regionally/nationally;
or
- You are planning to take on investors sell your business eventually (or want to have the option of doing so).



Federal Registration Basics

U.S. Patent & Trademark Office

- “PTO” → Federal agency in charge of TM
- Apply to PTO for federal TM registration
- Staff of “Patent Examiners” make decisions
 - They compare your proposed TM to:
 - Rules for what can be trademarked
 - Existing TMs or TM applications
 - Then: Ask for more information or changes
 - Last: Decide whether PTO thinks TM is okay



Federal Registration Benefits

- With federal registration:
 - Nationwide rights to block trademark infringement.
 - Presumption of mark’s validity, ownership, & right to use mark.
 - After 5 years, “incontestability” status, which makes it much harder for anyone to attack the mark in court.
- No federal registration:
 - Rights extend only to the geographic area where the mark is used.
 - No right to block a competitor in another state from using the same or a similar mark.



New Name: TM Search

- Searching
 - Self Search: PTO, MN SOS search, Google
 - “Knockout” searches
 - USPTO “TESS”, etc.
 - Attorney Search
 - Searches & analyzes based on TM law & potential opposers
 - Commission Professional Search (if necessary)
 - Still requires attorney analysis
- Reserving Brand Name
 - Intent to Use TM application
 - Reserve name w/ MN SOS
 - Only reserves right to use; no TM



What If You Already Have a Name?

- Attorney Search
 - Attorney Search & Analysis
 - Find Potential Issues, Strategic Decisions Re: Application
 - Report to Client
 - TM Application & Monitoring
- Professional Search Company + Attorney Analysis
 - Professional search company (\$450+)
 - Attorney analysis of results
 - Potential: Formal Clearance Opinion – Determines TM strategy
 - Anticipates potential roadblocks, determines ability to register
 - Provides good faith defense
 - If it makes sense, TM application



TM Application General Information

- \$225-\$325 filing fee per mark in one class
- Strict requirements
 - If the application isn't correct, you will be denied
 - Strict deadlines – serious consequences
- Anticipate
 - Office Actions, Pushback from TM owners
 - On average, 1 year+ for no-problems app



TM Application Refusals

- Likelihood of Confusion
- Merely Descriptive
- Deceptively Misdescriptive
- Primarily Geographically Descriptive
- Primarily Geographically Deceptively Misdescriptive
- Primarily Merely a Surname
- Ornamentation
- Disparaging



TM App Timeline

- Knockout Search – 1-2 Days
- Professional Search – up to 1 week
- Analysis & Drafting Clearance Opinion – up to 2 weeks
- TM Application Completion – 1-2 Days
- PTO Assigns Examiner – 3-4 months from filing date
- Office Action (6 months to respond)
 - Minor (Edit description, request for information) – 1 week
 - Serious (Suspension, refusal) - Indefinite delay
- Notice of Publication
 - Published in Trademark Official Gazette (30 days)
- Opposition
 - Filed w/in 30 days from publication, or
 - Request for extension of time – up to 90 days w/out applicant consent
 - Notice of Opposition – Indefinite delay
 - Settlement negotiations – Indefinite delay
- Registration
 - Section 8 filings, monitoring, etc.



TM Issues: Government

- PTO Office Action
 - More information, Disclaimer, Goods Description
- Suspension
 - Waiting for a PTO decision on another application
- Refusal
 - PTO doesn't think your TM is registrable
 - Doesn't meet basic requirements for TM, Confusion
- What to do? → Appeal



TM Issues: Private Party

- During Application
 - Extension of Time
 - Formal Opposition
- Any Time
 - Cease and desist
 - TM Infringement Lawsuit
- Options
 - Defend
 - Coexistence Agreement
 - Licensing



After Registration

- Affidavit of Use ("Section 8"):
 - File during the sixth year after registration and every ten years during the life of the registration.
 - Affidavit stating mark is still in use, with a specimen of the mark as used on the goods.
- Incontestability ("Section 15"):
 - File any time after the mark has been registered for five years.
 - Affidavit stating that no one has questioned your use of the mark during the five year period. Upon acceptance of the affidavit, the mark becomes "incontestable", meaning an infringer may no longer question your right to use the mark.
- Renewal ("Section 9"):
 - Registration must be renewed every ten years.



After Registration

- Monitor : Watch for confusing and infringing uses (Google alerts, Talkwalker, paid service)
- Use trademark registration notice:
 - The symbol ®
 - The phrase “Registered U.S. Patent and Trademark Office,” or the abbreviation “Reg U.S. Pat. & Tm. Off.”



Bottom Line

- Protect your brand investment & exit options
- Be careful
- Understand the timeline
- Be prepared for pushback
- Protect your TM after registration
 - Monitor
 - Required Filings
 - Have written license agreements
- Feel free to contact us with questions



THANK YOU!



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Please note:

This presentation includes general legal information and is not intended to be legal advice or to create a client relationship. You should contact your attorney to obtain advice specific to your situation.



Thank you for attending today's webinar!

We hope to see you at these upcoming events:

- **1st Tuesday Networking Event**
 - Tue Sept 6, 2016 4:30 – 6:30pm at Birchwood Cafe
- **MORE-B (MetroIBA Owners' Roundtable for Excellence in Business)**
 - Members Only
 - Tue Aug 16, 3:30 – 5:00pm CHES
 - Thurs Aug 25, 7:30-9:00am Wilde Cafe
- **Members – Save the Date**
 - **Public Policy Caucus**
 - September 27, 2016 5:30 pm - 8:30 Hellmuth & Johnson, PPLC

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