



Trademarking Tricks and Treats

They're fun (the USPTO Certificate arrives from Alexandria, Virginia with Ribbon and Seal memorializing your Logo-Design and Name), you get the ® instead of just the ™, your logo design and buz name are protected in perpetuity with minimal maintenance fees, you can enforce and expand your brand without fear of copycats, you can collect lost profits and market share from an infringing competitor, and it's tangible i.p. if you ever sell the show.

But not all Marks will be Trademarked (they won't all enter the Principal USPTO Registry upon application). Here are some pitfalls to avoid *before* you visit your ip lawyer:

1. Likelihood of confusion: if your mark looks or sounds substantially similar to a mark in *any related* industry anywhere in the USA, your application will fail. Note: this doesn't mean you can't continue to cautiously use your mark under the radar. The USPTO doesn't have enforcement ninjas. Nor does the USPTO phone your competitors to notify.

But if your mark is rejected for alleged confusion with another US mark, your appeals to the Supervising Examiner and the Trademark [] Appeal Board will also fail. It's a subjective judgment call & they're the gatekeepers. You can submit Exhibits from dozens of experts and consumers who (rightly) swear they are not confused between your product and the product(s) cited by your TM Examiner in his rejection. Know: the Examiner is asking whether "there could be confusion," which is all he needs to affirm his rejection.

*Note: there's a technique to avoid this pitfall by packaging your TM application in a novel way and then prosecuting it through a lesser-known channel



FOUNDATION PATENTS, LLP

at the USPTO to avoid this "likelihood of confusion rejection" problem; out of respect for my Practice, I won't publish it (just call and I'll tell you).

2. Pitfall #2, Your mark is merely descriptive. Examples of the problem: "Awesome Sharp Nails, ltd." will not get a Trademark. Neither will "Precision Accurate Watches," nor "Super-strong Leak-Proof Trash Bags." Your Trademark must be Trademark-worthy since the words become your monopoly within your industry. Generally, the *less* the name corresponds to the business, the greater its chance for getting the TM. Shoot for bizarre.

3. Pitfall #3: Your mark is really just a surname: "Jennings' Jump Ropes" will not get a Trademark. This guideline is occasionally overcome with years of brand-goodwill and industry dominance (and other subjective factors the USPTO says matter). Advice: don't try it unless you're Ford or Channel.

4. Pitfall #4: Your mark is purely geographical: Please don't try to TM "Danville Doughnuts." Just sell said doughnuts.

5. Pitfall #5: The USPTO won't accept your "specimen in commerce" proving you truly use your own TM. The USPTO explains the guidelines for specimen submission by publishing sections of the Code of Federal Regulations, the United States Code and the Manual of Trademark Examination Procedure. Difficult reading that *must* be written to keep patent attorneys in business.

Here's the rule in English: get a screenshot or a photo of your product with your TM on sale on a living website or display case shelf at a real store, with a specific price listed on or near the product, and a working "click to pay" icon. Any less and the USPTO will bounce your specimen. Yes, modern products and



FOUNDATION PATENTS, LLP

services are sold without the above, therein making the draconian USPTO "specimen" rules untenable. Solution? Just give them what they want. Even if you need to temporarily reorganize your website, your pricing methodology or your advertising venue to satisfy the USPTO Specimen rule, make it so.

-by Richard Bennett

Patent Attorney

Foundation Patents Utah