

2012 TRADEMARK SEMINAR

SPEAKERS

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Techniques for Protecting Weak Trademarks

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Brinks Hofer Gilson & Lione

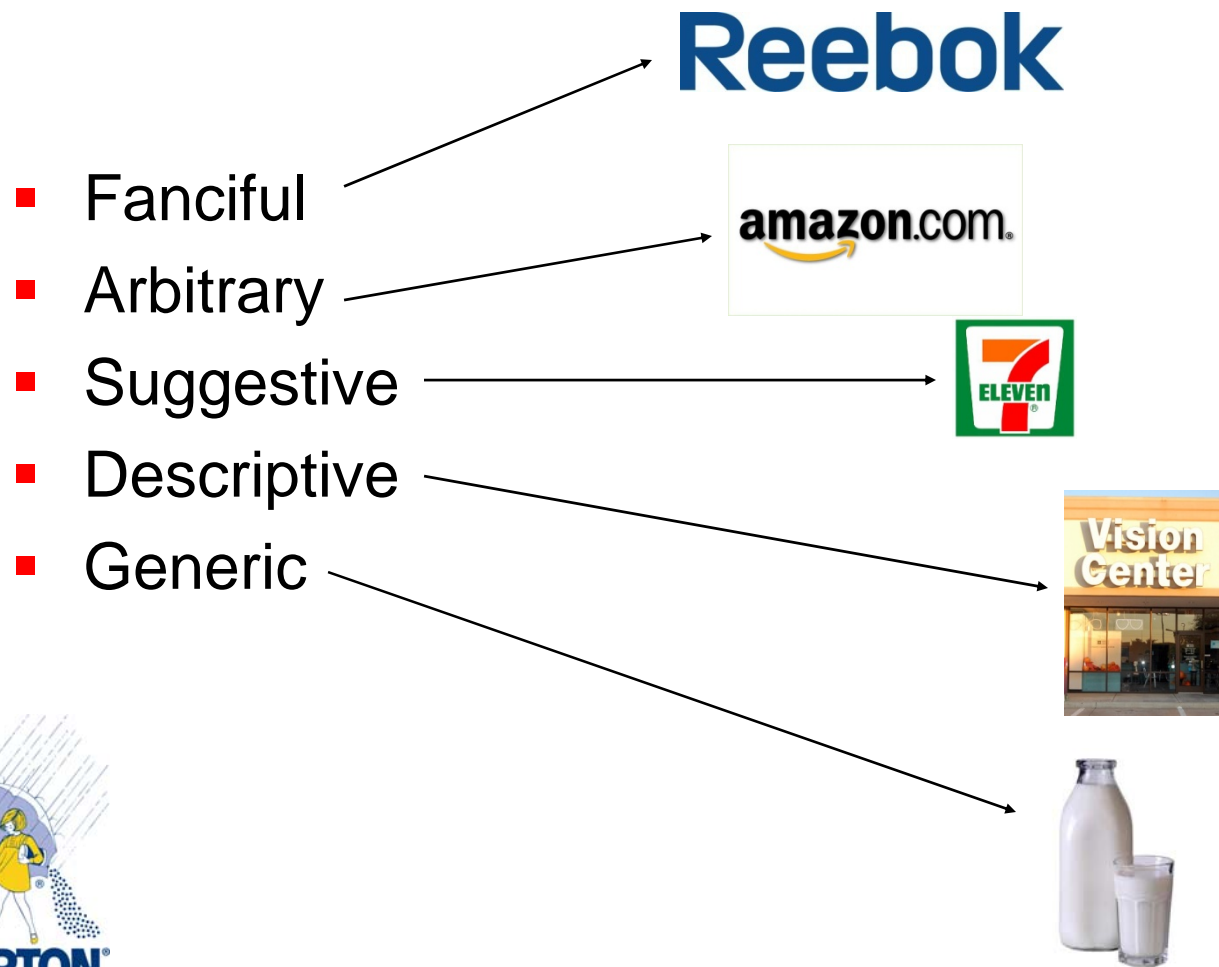
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Spectrum of Trademark Distinctiveness



Issue 1: Trademark Registration

- High Standard for Federal Registration
- Descriptive if it Describes:
 1. Ingredient
 2. Quality
 3. Characteristic
 4. Function
 5. Feature
 6. Purpose
 7. Use



Solution 1: Getting Mark Registered

- A Descriptive Mark Attains Secondary Meaning if the Producer so Effectively Markets the Product with the Mark that Consumers come to Immediately Associate the Mark with only that Producer
- Secondary Meaning Evidence:
 - Five Years of Use
 - Declarations
 - Advertising
 - Sales
 - Surveys
- Add Distinctive Term
- Add Logo
- Be Creative with Identification of Goods



Declarations

- Not Conclusory
- Fill Record with Evidence
- Third parties
 1. Consumers
 2. Distributors
 3. Competitors



Advertising

- Proper Trademark Use
- Photographs
- Media Mentions
- Internet Traffic
- Social Media

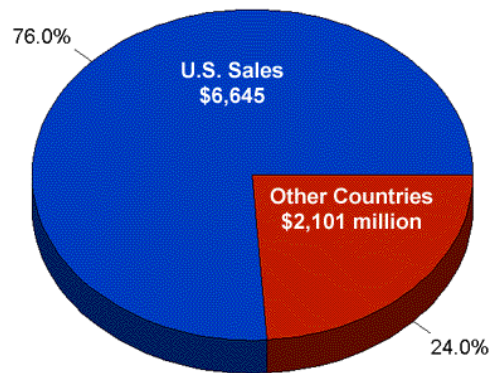
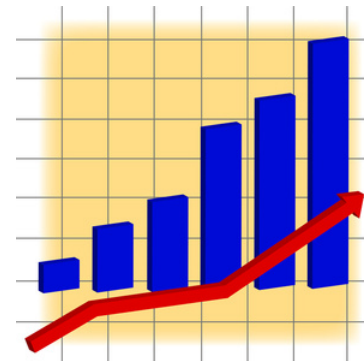


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Sales

- The Higher, the Better
- Possibly a Range
- Increasing
- Be Creative



Surveys

- A Trademark Survey, not a Marketing Survey
- Focuses on:
 - How Survey is Set Up
 - How Survey is Conducted
 - How the Results are Interpreted
 - Special Experts



Additional Suggestions

- Add House Mark or a Distinctive Term
- Add Logo / Stylization / Color / Font
- Get Creative with Identification of Goods

Coca-Cola

Google™



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Issue 2: Descriptive Use

- “Buy new HEALTHY™ hamburgers!”

VS.

- “Both healthy and wholesome at the same time, our hamburgers are the best.”



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Solution 2: Protecting Against Descriptive Use

- Get your Mark Registered
 - Even if You have to Add other Elements
- Be Realistic about your Scope of Protection
 - Evidence of Actual Consumer Confusion
- Add other Distinctive Elements to your Product
 - Trade Dress, Colors, other Marks
- Searching
 - Still Search even if You Plan to Use it Descriptively
- Verify Descriptive Use



Conclusion

- Select Distinctive Trademarks
- If not, then:
 - Be Realistic
 - Be Smart



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Product Configuration Marks and the Functionality Doctrine

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January 19, 2012



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Product Configuration Marks and Functionality

- Define Product Configuration Marks
- Discuss Functionality Doctrine
- Practice Tips



What is a Trademark?



- The term "trademark" includes any word, name, symbol, or device, or any combination thereof used . . . in commerce . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

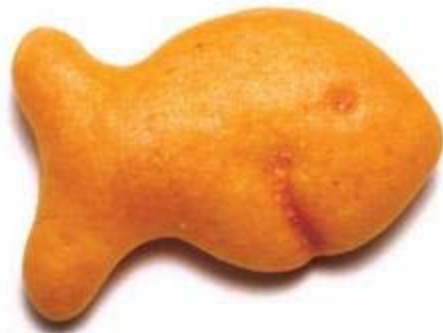


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'Trade Dress'

- The distinctive packaging or design of a product that promotes the product and distinguishes it from other products in the marketplace.
 - Product Packaging
 - Product Configuration



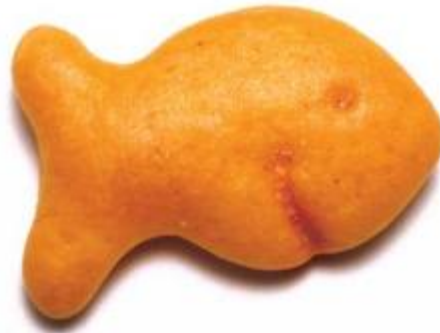
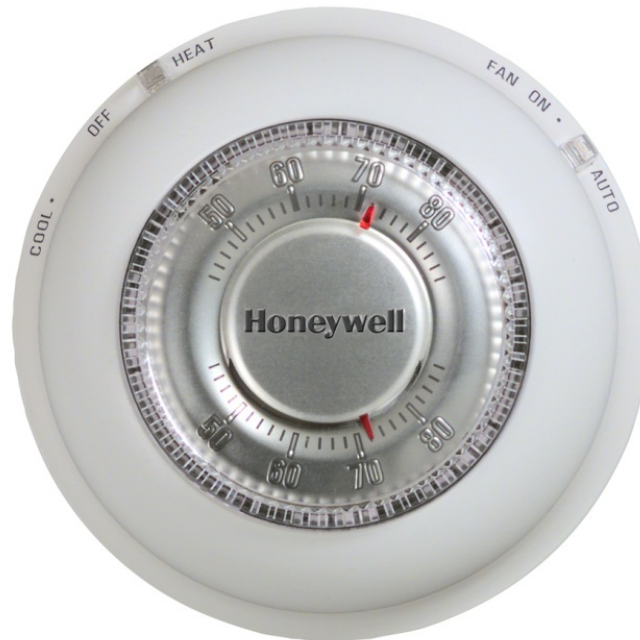
Trade Dress Product Packaging



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Trade Dress Product Configuration



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Functionality Doctrine

“The functionality doctrine polices the division of responsibilities between patent and trademark law by invalidating marks on useful designs.”



The Patent and Copyright Clause U.S. Constitution - Article 1 Section 8

To Promote the Progress of Science and Useful Arts, by Securing for **Limited Times** to Authors and Inventors the Exclusive Right to their Respective Writings and Discoveries.



Functionality Doctrine

- Key goals of the functionality doctrine:
 - To separate the spheres of patent and trademark law; and
 - To ensure that the term of a patent is not extended beyond the period authorized by Congress. (“The Backdoor Patent”)

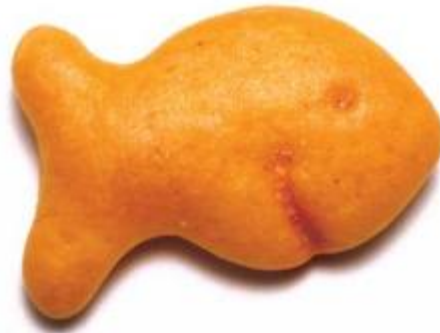


Functionality Doctrine

- A Design is Functional if:
 - It is essential to the use or purpose of the article, or
 - It affects the cost or quality of the article.



Trade Dress Product Configuration



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Functionality Factors

- The Seventh Circuit has set forth this test for determining whether a design is functional:
 1. Existence of utility patent
 2. Utilitarian properties of unpatented design elements
 3. Advertising touting utilitarian advantages
 4. Alternative designs
 5. Effect on quality or cost



Second Factor – Unpatented Elements

- The utilitarian properties of the item's unpatented design elements;



Third Factor - Advertising

- Advertising of the item that touts the utilitarian advantages of the item's design elements;
 - Example: Razor with distinctive looking handle. Advertising that touts added comfort due to handle weighs against trademark rights.



Fourth Factor - Alternative Designs

- The dearth of, or difficulty in creating, alternative designs for the item's purpose;
 - A Court is more likely to conclude that a design is functional if it is difficult to create alternative designs.



Fifth Factor – Effect on Quality

- The last functionality factor addresses the effect of the design feature on an item's quality or cost.
 - A Court is more likely to conclude a design is functional if it serves to increase quality or decrease costs.



Practice Tips

- Consider Trademark/Trade Dress Protection for Product Configurations.
- Coordinate with Patent Filings and Review Existing Utility Patents Before Challenging Third Party's Use.
- Carefully Review Promotional Materials.



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Advising Business Managers on Proposed Trademarks

Winnie Kuo

Morton Salt, Inc.

January 19, 2012



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Hypothetical Example

- You are in-house counsel for the company SPICEBRAND, which wants to promote its new product – an hourglass shaped container that can hold two different spices at the same time.
- Unlike a sand hourglass, the space in the middle between the top and bottom of the container is sealed so that no material can flow between both ends.
- Each end has a twist cap that allows you to dispense the spice to that end.

SALT →

PEPPER →



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Hypothetical Example

- **Marketing has some ideas.**
- **Possible Trademarks for the New Product:**
 1. Salt & Pepper Shaker with a Flip
 2. DuoSpice
 3. Tastelicious
 4. The hourglass shape



Common Trademark Questions

Marketing wants to know:

- Can we use any of these marks?
- Can we register any of these marks?
- How long does the process take?

What is your recommendation?



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Trademark Analysis

Step One

Pre-Clearance (Can or should we use the proposed trademark?)

- *Understanding Context*
- *Checking Availability*
- *Cost/Benefit Analysis*

Step Two

Trademark Registration (Can we register the proposed trademark?)

Step Three

Alternative Options (How else can we protect the proposed trademark?)



Pre-Clearance: Understanding Context

How will the proposed trademark be used?

- Generic/descriptive use?

Where will it be used?

- In print ads?
- On packaging?
- On the company website or Internet?
- On in-store displays?

Scope

- Short-term v. Long-term
- **Narrow down the options to the most important ones**



Pre-Clearance: Checking Availability

Is the Mark Available for Use?

- Do preliminary trademark search of the US Patent Trademark Office (PTO) records:
(<http://www.uspto.gov/trademarks/index.jsp>)
- Do overall Internet search
- If important enough, ask outside trademark counsel to conduct comprehensive trademark search



Pre-Clearance: Cost/Benefits Analysis

Do we want to register it?

- Costs: Initial trademark filing fees, outside counsel fees, ongoing maintenance fees
- Benefits: Exclusive use, increased brand awareness



Trademark Registration

Going back to the Hypo - **Can we register the proposed trademark?**

1. Salt & Pepper Shaker with a Flip – *not likely registrable*
2. DuoSpice – *likely registrable, upon showing of secondary meaning*
3. Tastelicious – *likely registrable immediately*
4. The hourglass shape – *product configuration may be registrable upon showing of secondary meaning*



Alternative Options

How else can we protect the proposed trademark?

- Use as Common Law Mark without Applying for Federal Trademark Registration
- Use Descriptively (not as a trademark)
- Add Distinctive Element
 - House Mark
 - Additional Distinctive Term
 - Logo
- Consider non-trademark options (if applicable) such as copyright



Descriptive Example

SHE SELLS SEA SALT BY THE SEASHORE.



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