

# **Trademarks 101**

**09-14-2022**



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## **TRADEMARK**

A trademark includes any word, name, symbol, device, or any combination, used in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods.



## **SERVICE MARK**

A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.

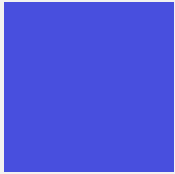
# USPTO

The United States Patent and Trademark Office (USPTO) examines and registers trademarks, and examines and issues patents. The USPTO was established in 1952 “to promote the progress of science and the useful arts by securing for limited times to inventors the exclusive right to their respective discoveries for a certain period of time.”





# DIFFERENT SCOPES OF PROTECTION



## **Common Law Right**

Trademark protection is solely based on using your trademark in commerce within a particular geographical area



## **State Trademark Registration**

Creates rights only in that state



## **Federal Trademark Registration**

- Registering your mark with the USPTO creates rights through the entire U.S. and its territories
- You can use the ® symbol

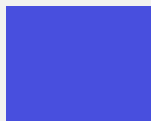


## **International Trademark Registration**

No such thing as a worldwide trademark, however you can register your mark in multiple countries though the Madrid Protocol

Note: You are not required to register your trademark, but where or whether you decide to register your trademark can determine the scope of your rights.

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# PRINCIPLE REGISTER

The Principle Register is reserved for trademarks that are considered under the law to be “distinctive” as opposed to, say, descriptive. The Principle Register offers more protection than the Supplemental Register, in that owners with marks on the PR have the exclusive right to the use that mark, and they can also record their mark with the US customs service to prevent import of items violating their mark.



# SUPPLEMENTAL REGISTER

The Supplemental Register is a second trademark register where trademarks can be registered that are not yet eligible for registration on the Principle Register, but may, over time, become an indicator of source. Supplemental Register registrations do not receive the same legal advantages and presumptions of PR registrations. The supplemental register is for non-distinctive marks, which are trademarks that have not yet acquired distinctiveness or “secondary meaning” in the minds of consumers.

# CERTIFICATION MARKS

A certification mark is a type of trademark that is used to show consumers that particular goods and/or services, or their providers, have met certain standard.

Main distinguisher: A certification mark shows that goods, services, or providers of those goods and/or services have met certain standards. A trademark, however, shows the commercial source or brand of particular goods or services.



**02**

# **Trademark Timeline**



**1a.**

## **Use-Based**

You are currently using  
your trademark in  
commerce with your goods  
and/or services.

**1b.**

## **Intent-to-Use**

You have a bona fide  
intention to use your  
trademark in commerce  
with your goods and/or  
services in the near future.



# Goods

International Classes  
001-034



# Services

International Classes  
035-045

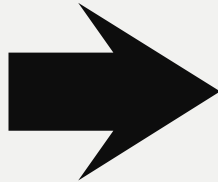
Note: There are many items listed in each class; however goods and services are never in the same class.



# 1a. Use-Based

## Application Filed

- ★ Signed declaration and POA
- ★ Specimen (per class)

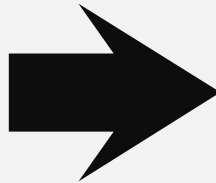


LTC Regarding Filing  
Particulars

1

## 1a. Use-Based

USPTO reviews,  
approves and  
issues  
publication in  
Official Gazette



LTC Regarding Notice of  
Publication

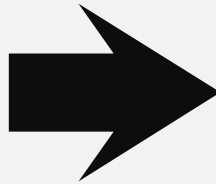
2

---



## 1a. Use-Based

USPTO Issues  
Registration if no  
opposition filed



LTC Regarding Trademark  
Registration

3

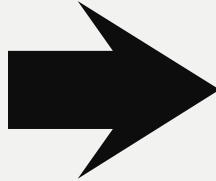
---

# 1a. Use-Based

OR

USPTO reviews  
and issues an  
office action

We prepare a response  
or application goes  
abandon

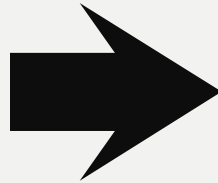


LTC Enclosing Office Action  
LTC Enclosing Response of  
Office Action

2

## 1a. Use-Based

USPTO accepts  
response and  
issues publication  
or  
They issue final  
office action

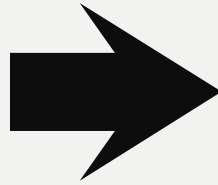


LTC Regarding Notice of  
Publication  
  
LTC Enclosing Final office  
Action

## 1a. Use-Based

We file an appeal  
or response to  
office action

USPTO then  
issues publication  
or TTAB processes  
appeal



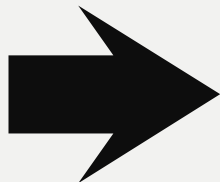
If no opposition, USPTO  
issues registration

LTC Regarding Trademark  
Registration

## 1b. Intent-to-Use

Application Filed

- ★ Signed declaration and POA

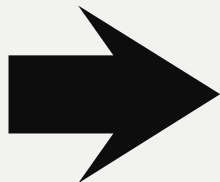


LTC Regarding Filing Particulars

1

## 1b. Intent-to-Use

USPTO reviews,  
approves and  
issues  
publication in  
Official Gazette



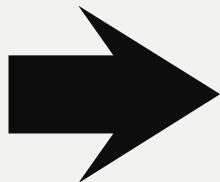
LTC Regarding Notice of  
Publication

## 1b. Intent-to-Use

OR

USPTO reviews  
and issues an  
office action

We prepare a response  
or application goes  
abandon



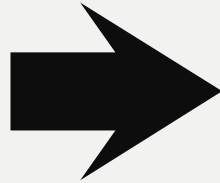
LTC Enclosing Office Action

LTC Enclosing Response of  
Office Action

2

## 1b. Intent-to-Use

USPTO accepts  
response and  
issues publication  
or  
They issue final  
office action



LTC Regarding Notice of  
Publication

LTC Enclosing Final office  
Action

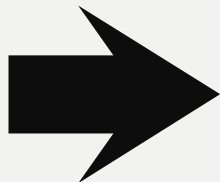


## 1b. Intent-to-Use

OR

We file an appeal  
or response to  
office action

USPTO then  
issues publication  
or TTAB processes  
appeal



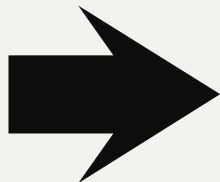
If no opposition, USPTO  
issues Notice of Allowance

LTC Regarding Notice of  
Allowance

2

## 1b. Intent-to-Use

USPTO Issues  
Notice of  
Allowance if no  
opposition filed



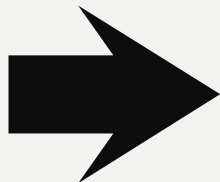
LTC Regarding Notice of  
Allowance

## 1b. Intent-to-Use

File a statement  
of use within 6  
months of NOA

★ Specimens

LTC Regarding Acceptance of  
Statement of Use



Registration of trademark or  
office action

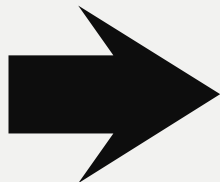
3

## 1b. Intent-to-Use

OR

File an extension  
request (up to 5  
with 6 month  
deadlines  
between each  
one)

LTC Regarding Acceptance of (first,  
second, etc.) Extension Request



Within 30 months, file a  
statement of use

Registration of trademark or  
office action

3

# State Trademark Timeline

State trademarks are quicker to get than federal trademarks. Once you mail in the:

1. Original signed application mailed in from client
2. 3 identical specimens
3. Drawing page
4. Check to Secretary of State
5. Letter to Secretary of State
6. Acknowledgement postcard

The mark should be registered within the month if all is correct.



A Trademark or Service Mark registration is active for five (5) years from the date the mark was filed with the California Secretary of State's office. The mark must be renewed every 5 years as long as it is in continual use.

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# Post Registration

Maintenance after the federal mark is registered



## Sections 8 & 15

**Between 5-6th year**

Combined Declaration of  
Use and Incontestability  
Under Sections 8 & 15

*Signed declaration*

*Specimens to prove mark is still in use*

## Sections 8 & 9

**10-year renewal**

Combined Declaration of Use or  
Excusable Nonuse/Application  
for Renewal

*Signed declaration*

*Specimens to prove mark is still in use*

# **Trademark Status & Documents Retrieval (TSDR) Basics**





Mat Ref	Matter No	Staff	Firm	Contact	ConNo	Status	Code
88 BUBBLYBLASTER (Logo) (Class 8)	21-43214	Daniel M Colo	Bubbly Blaster, LLC	Hall, Bradley	20626	In/L...	Fed Trnk(usr)

Matter Form - Change

File Edit View Process Help

Save & Close Save

Binary | Secondary | Additional | Custom | Related | Notes | Docs | Phone | E-Mail | Web | Billing | Timeline | A/R | Outline | To-Do

Mat Ref: 88 BUBBLYBLASTER (Logo) (Class 8) Code: RIFed Trnk(usr)

Matter No: 21-43214 Court: Delinquent Staff: DANDaniel M Colo

Plaintiff: Contact: Hall, Bradley 20626

Client Contact: Address: Bradley Hall

Firm: Bubbly Blaster, LLC

Address: 9003 W Sunset Blvd #963

City: Los Angeles CA 90046

Tel -> Email: (205) 936-5985 brad@sonuleep.com; steven@sonuleep.com

Box No: Serial No: 87764.473

Filing Date: 9/08/2016

OA Date: Opp/Can: For Ref No: Comments:

Delinquent: ☐ Notify ☒ Trigger ☐ Review ☒ B/Bable ☐ Private Status: Part, Issue

Adverse App: Opp-Atty: Firm: Email: Address: City: Tel -> Fax: Appc. Issue Info: Allow Date: Reg No: 5,195,940 Issue Date: 4/18/2017 Open Web Site: TTAB Stat: GCC Person: TARI

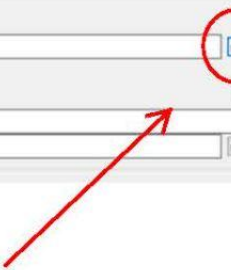
Matter Form - Change

File Edit View Process Help

Save & Close Save [Icons] Cancel ?

Primary \ Secondary \ Additional \ Custom \ Related \ Notes \ Docs \ Phone \ E-Mail \ Web \ Billing \ Timeline \ AR \ Outli

Mat Ref	BB BUBBLYBLASTER (Logo) (Class 8)		Code	RIFed Trnk(use)
Matter No	21-43314	Court	Staff	DANDaniel M Ciso
Plaintiff			Defendant	
Contact	Hall, Bradley	20626	<input type="checkbox"/> Notify <input checked="" type="checkbox"/> Trigger <input type="checkbox"/> Review <input checked="" type="checkbox"/> Billable <input type="checkbox"/> Pr	
Client Contact			Adverse Atty	
Addressee	Bradley Hall		Opp Atty	
Firm	Bubbly Blaster, LLC		Firm	
Address	8033 W Sunset Blvd. #963		Email	
			Address	
City	Los Angeles	CA	City	
Tel -> Email	(205) 936-5865	brad@sonusleep.com; stason@sonusleep.com	Tel -> Fax	
Area -104			Applic. Issue Info	
Box No			Allow Date	
Serial No.	87/164,473		Reg. No.	5,185,840
Filing Date	9/08/2016		Issue Date	4/18/2017
QA Date			Open Web Site	
Opp/Can			TTAB Stat.	
For Ref.No.			QCC Person	TAR
Comments				



Trademark Status & Document Retrieval (TSDR) ?

SEARCH MULTI-SEARCH ?

US Serial, Registration, or Reference No. 87164473 Status Documents

Status results found

STATUS DOCUMENTS MAINTENANCE ? Download Print Preview

Generated on: This page was generated by TSDR on 2022-09-13 13:33:52 EDT

Mark: BB BUBBLYBLASTER


US Serial Number: 87164473 Application Filing Date: Sep. 08, 2016

US Registration Number: 5185840 Registration Date: Apr. 18, 2017

Filed as TEAS Plus: Yes Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TMS Common Status Descriptor:  LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Apr. 18, 2017

Publication Date: Jan. 31, 2017

Expand All

- Mark Information
- Goods and Services
- Basis Information (Case Level)
- Current Owner(s) Information
- Attorney/Correspondence Information
- Prosecution History
- TM Staff and Location Information
- Assignment Abstract of Title Information - Click to Load
- Proceedings - Click to Load

Download Adobe Reader

If you are the applicant or the applicant's attorney and have questions about this file, please contact the Trademark Assistance Center

Trademark Status & Document Retrieval (TSDR) ?

SEARCH MULTI-SEARCH ?

US Serial, Registration, or Reference No. 87164473 Status Documents

STATUS DOCUMENTS MAINTENANCE ? Download Print Preview

Status: Maintenance filings have been received and will be reviewed by the Post Registration Team in due course

**\$8 (6 year) Declaration Due Dates:**

Latest date \$8 can be filed without paying additional fee: Apr. 18, 2023

Latest date \$8 can be filed by paying an additional fee: Oct. 18, 2023

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If you are the applicant or the applicant's attorney and have questions about this file, please contact the Trademark Assistance Center

**uspto** UNITED STATES PATENT AND TRADEMARK OFFICE

**BROWSE BY TOPIC**

- Patents
- Trademarks
- Learning & Resources
- About the USPTO
- Glossary
- Careers

**ABOUT THIS SITE**


- Accessibility
- Privacy Policy
- Terms of Use
- Security
- Systems Status
- Site Map

**USPTO BACKGROUND**

- Federal Activity
- Inventory Reform Act (FIRA)
- USPTO Budget and Performance
- Freedom of Information Act

**FEDERAL GOVERNMENT**

- Regulations.gov
- StopFakes.gov
- USA.gov
- Department of Commerce
- Strategy Targeting
- Organized Piracy



tsdr.uspto.gov/#caseNumber=87/164.473&caseType=SERIAL\_NO&searchType=statusSearch

Status Date: Apr. 18, 2017  
Publication Date: Jan. 31, 2017

▶ Mark Information [Expand All](#)

▶ Goods and Services

Note:  
The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [ ] indicate deleted goods/services;
- Double parenthesis ( ( ) ) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \* \* identify additional (new) wording in the goods/services

For: Hand-operated spray guns

International Class(es): 008 - Primary Class U.S Class(es): 023, 026, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 22, 2016 Use in Commerce: Mar. 22, 2016

▶ Basis Information (Case Level)

▶ Current Owner(s) Information

▶ Attorney/Correspondence Information

Attorney of Record:

Attorney Name: Daniel M. Cislo, Esq. Docket Number: 21-43314

Attorney Primary Email: [tmk@cislo.com](mailto:tmk@cislo.com) Attorney Email Authorized: Yes

Address:

Correspondent

Correspondent Name/Address: Daniel M. Cislo, Esq.  
Cislo & Thomas LLP  
12100 Wilshire Blvd, Suite 1700  
Los Angeles, CALIFORNIA UNITED STATES 90025

Phone: 3109799190 Fax: 310-394-4477

Correspondent e-mail: [tmk@cislo.com](mailto:tmk@cislo.com) [cgrant@cislo.com](mailto:cgrant@cislo.com) Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

▶ Prosecution History

▶ TM Staff and Location Information

▶ Assignment Abstract Of Title Information - Click to Load

▶ Proceedings - Click to Load

[Download Adobe Reader](#)

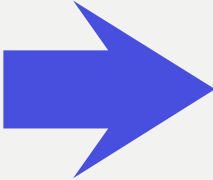
If you are the applicant or the applicant's attorney and have questions about this file, please contact the Trademark Assistance Center.

# Specimens

# When do you need specimens?

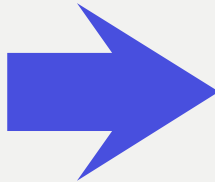
- You need specimens when filing a:
  - ◆ Use-Based 1(a) application
  - ◆ Statement of Use
  - ◆ Sections 8 & 15
  - ◆ Sections 8 & 9
  - ◆ Response to Office Action (not always - depends on the issues)

# Specimens for Trademarks

- ❑ Hang tags
  - ❑ Labels
  - ❑ Packaging
  - ❑ The goods themselves
  - ❑ Displays near the goods being offered for sale
  - ❑ Social Media pages (use in a business fashion – goods offered for sale where the mark is used as a source indicator for the goods)
  - ❑ Webpage displaying the mark sufficiently near the goods at their point of sale
- 
- ❑ “Hang tag/label/packaging displaying the mark”
  - ❑ “Photograph of the goods displaying the mark” (except for clothing and jewelry (unless there is secondary meaning))
  - ❑ “Webpage displaying the mark sufficiently near the goods at their point of sale “

# Specimens for Service Marks

- ❑ Flyers
- ❑ Advertisements
- ❑ Brochures
- ❑ Signage
- ❑ Social Media pages (use in a business fashion – services offered on the site)
- ❑ Webpages showing the mark used in association with the services



- ❑ “Flyers/advertisement/brochure/web page displaying the mark used in association with the services”
- ❑ “Public sign displaying the mark used in association with services”
- ❑ “Screenshots of Twitter and Instagram pages displaying the mark used in association with the services being offered and as a source indicator”





# **Specimen Game!**

# Specimen 1 - Logo



OAKS CHRISTIAN

SCHOOL



Class 25: Clothing, namely, sweatshirts, t-shirts, hats, polo shirts, jackets, oxford shirts

---



## Specimen 2 - Word Mark

OFFICEFRONT

Class 40: Manufacture of glass products and glass related products, namely, patch hardware, patch fittings, patch connectors, inserts, pivots, locks, latches, closers, handles, hinges, gaskets, cover plates, keepers, wall mounting plates, door stops and strike plates, customized to the order and specification of others; technical consultation in the field of custom manufacturing of glass products

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# OfficeFront™ 487 Series Pivot System

Use the filters below to narrow your selection.

[TECHNICAL REFERENCES & CAD DRAWINGS](#)**Attributes**[Clear](#)**Sub Category**

- ☐ OfficeFront™ 487 Series Pivot System (18)

**Finish**

- ☐ Black Bronze Anodized (9)  
☐ Clear Anodized (9)

**Configuration**

- ☐ Single (12)  
☐ Pair (6)

Showing 1-12 of 18

Page Size  
12Sort by  
Relevance

CRL Clear Anodized 487  
OfficeFront™ Office Partition LH  
3'0 x 7'0 Single Door Frame

Item #: 487F371IL



CRL 487 Clear Anodized  
OfficeFront™ Office Partition RH  
3'0 x 7'0 Single Door Frame

Item #: 487F371IR



CRL Bronze Anodized 487  
OfficeFront™ Office Partition LH  
3'0 x 7'0 Single Door Frame

Item #: 487F3722L

Home / All Products / Glass Entrance & Interior Systems / Interior Office Partitions / OfficeFront™ 487 Series / OfficeFront™ 487 Series Extrusions [More Choices](#)

# OfficeFront™ 487 Series Extrusions

Use the filters below to narrow your selection.

TECHNICAL REFERENCES & CAD DRAWINGS

Attributes [Clear](#)

**Sub Category**

☐ OfficeFront™ 487 Series Extrusions (29)

**Finish**

☐ Black Bronze Anodized (14)

☐ Clear Anodized (14)

☐ Kynar Painted (1)

**Glazing Thickness (Inches)**

☐ 1/2 (17)

☐ 1/4 (17)

☐ 3/8 (17)

☐ 9/16 (17)

Showing 1-12 of 29

Page Size: 12

Sort by: Relevance

CRL 487 Clear Anodized OfficeFront™ Face Trim - 24'-2"

Item #: 487X01511

CRL 487 Custom KYNAR® Paint OfficeFront™ Face Trim - 24'-2"

Item #: 487X01571

CRL 487 Bronze Anodized OfficeFront™ Face Trim - 24'-2"

Item #: 487X01522

# Specimen 3 - Word Mark

HAPPY HOMES SMILING GARDENS

Class 28:

Holiday decorations, namely artificial Christmas trees and Christmas and Halloween characters in the nature of toy figures and dolls

---





Happy homes. Smiling gardens.

## Nutcracker Soldier

FOR DECORATIVE USE ONLY.

NOT TO BE GIVEN TO CHILDREN AS A TOY.

©2020 Exhart - Chatsworth, CA 91311.

Made in China/Fabrique en Chine. All Rights Reserved.

**exhart.com**



1. Insert 2 "AA" batteries (not included)
2. Press switch to ON position to set the timer to turn on for 4 hours at the same time every day.



# Specimen 4 - Logo



- Class 024 for “*cotton fabric*”
- Description of mark from TSDR: “The mark consists of red letters "RJR" in a box outlined in red, hot pink, and orange, with the expression "#quiltwithlove" in gray below. The color white represents background, outlining, shading and/or transparent areas and is not part of the mark.”

# Round 1 of Specimens from Client



# Round 2 of Specimens from Client



# Specimen 5 - Logo



- Class 041 for “*Online gaming **services** in the nature of competitive computer game tournaments; providing online computer games*”



Search results: 10 results for "Pepperdine Esports" | Pepperdine Esports (@peppesports)

Pepperdine Esports  
205 Tweets

**PEPPERDINE CAMPUS RECREATION**

**Pepperdine Esports**  
@peppesports

Welcome to Pepperdine Esports! Follow for info on events, tournaments, news, and highlights from PeppGamers!

[linktr.ee/peppesports](#) Joined April 2019

49 Following 132 Followers

Tweets Tweets & replies Media Likes

**Pepperdine Esports** @peppesports · Apr 6  
Update on Pepperdine's Super Smash Bros Team! Let's go team!  
@Sophisttsb @KRD006

**SUPER SMASH BROS**

Don't miss what's happening  
People on Twitter are the first to know.

Log In Sign Up

Search results: 10 results for "Pepperdine Esports" | Pepperdine Esports (@peppesports)

Pepperdine Esports  
205 Tweets

**PEPPERDINE CAMPUS RECREATION**

**Pepperdine Esports**  
@peppesports

Update on Pepperdine's Super Smash Bros Team! Let's go team!  
@Sophisttsb @KRD006

**SUPER SMASH BROS OPEN ENTRY TOURNAMENT**  
Hosted by USC  
March 25th

PLACEMENT RESULTS (OUT OF 55)  
Theodore Plunker 8th  
Rhyo Pascual 13th  
Anthony Lima 17th

143 views

1 7

Don't miss what's happening  
People on Twitter are the first to know.

Log In Sign Up

**You might like**

- Oso Esports at Baylor... @Oso\_Esports Follow
- Lubbock High School... @WesternerSport Follow
- Cal Poly Esports @calpolyesports Follow

Show more

**What's happening**

US elections - LIVE  
US elections are safe and reliable, according to fact-checkers

New Scientist @ This morning  
Did life on Earth begin on land or in water? Ancient rocks are helping to piece together the origins of life

The Wall Street Jou... Yesterday

11:37

peppesports

111 Posts 386 Followers 80 Following

**Pepperdine Esports**  
Esports Team

Welcome to Pepperdine Esports, the official competitive gaming program at Pepperdine University.  
Run by @pepperdinecampusrec  
Linktree  
linktr.ee/peppesports  
24255 Pacific Coast Highway, Malibu, California

Follow Message Email

WCC E3

WCC 2019 E3

GRADUATED PLAYERS  
A celebration post for all the newly alumni of the Pepperdine Esports Team

LEAGUE OF LEGENDS PLAYOFFS  
VS LMU

SCORES UPDATE  
VALORANT MORTAL KOMBAT

We Have Esports Hats  
New Pepperdine Esports Hats  
\$20 Cash or Check Available at the HAWK Front Desk

11:36

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**LEAGUE OF LEGENDS PLAYOFFS**  
Watch it on Twitch now!

**VS LMU**

WCC ESports

8 likes  
peppesports Cheer on the League Team today!! 🙌🙌  
April 2

peppesports

1/2

# Fun Facts!

Coca-Cola was registered as a “nutrient or tonic beverage” in 1893.



The shape of a Hershey Kisses chocolate is a registered trademark.



Paris Hilton successfully trademarked “that's hot” for a line of clothing and alcohol.



Kim Kardashian's kids names are trademarked - Palm, North, Saint, and Chicago.



Many trademarks have become generic, such as Aspirin.





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**[09-14-2022] [CG/MD]**

Check all that apply to record with U.S. Customs and Border Protection:

- a. Clothing
- b. Cosmetics
- c. Furniture
- d. Restaurant services
- e. All of the above

A U.S. federal trademark application can only be filed in foreign countries within six (6) months of the U.S. filing date.

- a. True
- b. False

Federal and state trademark registrations may use the ® symbol.

- a. True
- b. False

Owners may only use the ™ symbol if they have a pending federal trademark application.

- a. True
- b. False

A Federal trademark registration provides worldwide protection.

- a. True
- b. False

Trademark registrations expire after 10 years.

- a. True
- b. False

Check all that apply – the following can be trademarked:

- a. A word(s)
- b. Symbols or Logos
- c. A sound
- d. A Color
- e. A government insignia
- f. The shape of a bottle
- g. A generic term

Trademarks do not need to be actively reinforced by an owner; they are automatically protected from infringement once used and/or registered.

- a. True
- b. False

A “senior” user of a trademark is determined by the date their mark is registered.

- c. True
- d. False

Acceptable specimens for goods are (circle the following that apply):

- a. Labels
- b. Brochures/Advertisements
- c. Tags
- d. Packaging
- e. Press releases
- f. Displays
- g. Signage
- h. Internet pages displaying the mark sufficiently near the goods at their point of sale

Registration of a domain name with a domain name registrar does give the owner trademark rights.

- a. True
- b. False

The most common reason to refuse registration is a “likelihood of confusion” between the mark of the applicant and a mark already registered or in a prior-filed pending application owned by another party.

- a. True
- b. False

The USPTO decides whether you have the right to use a mark (which differs from the right to register).

- a. True
- b. False

The USPTO can assist you with policing your mark against infringers and also assist you with recordation of your mark with U.S. Customs and Border Protection.

- a. True
- b. False





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## **TRADEMARKS 101**

### **WHAT IS A TRADEMARK?**

- A trademark includes any word, name, symbol, device, or any combination, used in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods.
  - Just a word, or multiple words, with no design element and without claim to any particular font, style, size or color are known as standard character marks
  - Logos will typically have literal elements (any words), a description of the mark detailing the design elements, and sometimes specific colors claimed
- A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.
- Simple terms: trademarks identify the source (maker or provider) of products and services
- Use the “®” symbol only with federally registered marks, and use “™” for unregistered marks or state trademark registrations.
- Trademark watch service is available to see if others are trying to register similar marks
- A common misconception is that having a trademark means you legally own a particular word or phrase and can prevent others from using it. However, you don’t have rights to the word or phrase in general, only to how that word or phrase is used with your specific goods or services. For example, if you use a logo as a trademark for your small shoe shining business to distinguish your services from others in the shoe-shining world, you cannot prevent others from using a similar logo for non-shoe shining related goods/services.



## **USPTO**

- The United States Patent and Trademark Office (USPTO) examines and registers trademarks. The USPTO's headquarters are located in Alexandria, Virginia, close to Washington, D.C.
- Once you get a registration, you have the right to use the ® symbol next to your trademark. A trademark can last as long as the owner keeps using it!

## **DIFFERENT SCOPES OF PROTECTION**

You are not required to register your trademark, but where or whether you decide to register your trademark can determine the scope of your rights.

- Common law rights:
  - With no state or federal filing, your trademark protection is solely based on using your trademark in commerce within a particular geographical area. This limits your rights to enforce your rights outside that specific region.
- State trademark registration:
  - Creates rights only in that state
  - Not all states have trademark registration databases, which can cause confusion with third parties and it is your responsibility to prevent others from using your trademark
- Federal trademark registration
  - Registering your mark with the USPTO creates rights through the entire U.S. and its territories
  - You can use the ® symbol
  - Important to note that the USPTO is not an enforcement agency however, so you are still responsible for pursuing any infringing users
- International trademark registrations
  - No such thing as a worldwide trademark, however you can register your mark in multiple countries through the Madrid Protocol
  - International treaty allows you to file a single application that can then be applied to any of the over 100 member countries. While this simplifies applying for a trademark registration in different countries, there is no automatic guarantee the trademark will be registered in each country.

## **TWO MAIN REGISTERS**

### Principle vs. Supplemental Registers

- The Principle Register is reserved for trademarks that are considered under the law to be “distinctive” as opposed to, say, descriptive. Alternatively, the supplemental register is for non-distinctive marks, which are trademarks that have not yet acquired distinctiveness or “secondary meaning” in the minds of consumers.
- The Supplemental Register is a second trademark register where trademarks can be registered that are not yet eligible for registration on the Principal Register, but **may, over time, become an indicator of source**. Marks registered on the Supplemental Register, like those registered on the Principal Register, are protected against conflicting marks in later-filed USPTO applications. However, Supplemental Register registrations do not receive the same legal advantages and presumptions of Principal Register registrations.

## **CERTIFICATION MARKS:**

- A certification mark is a type of trademark that is used to show consumers that particular goods and/or services, or their providers, have met certain standards. Certification marks show:
  - 1. The goods or services come from a specific geographic region, as shown by the examples of registered certification marks below.



- 2. The goods or services meet standards with respect to quality, materials, or how they are manufactured, as shown by the examples of registered certification marks below.



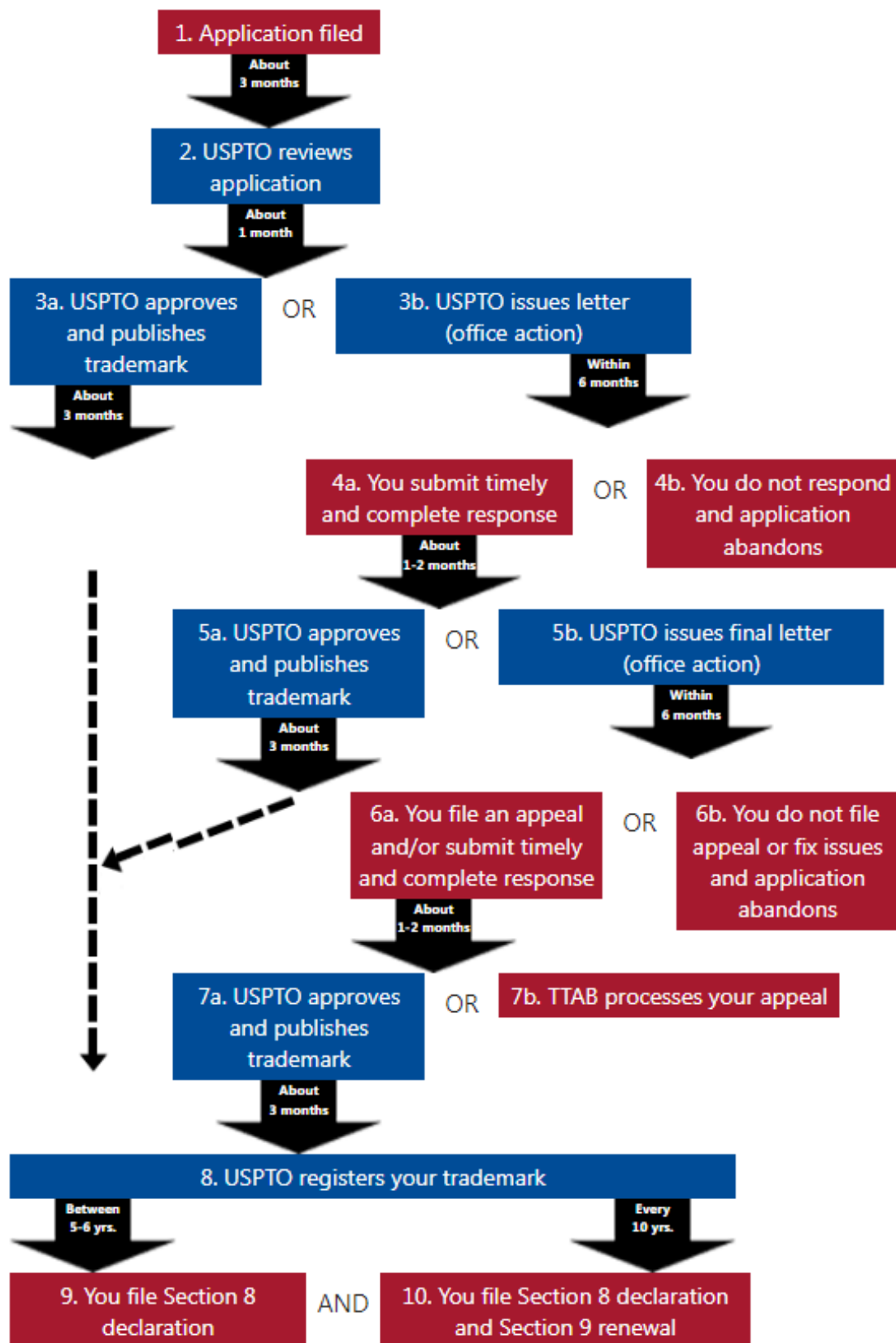
- 3. The work or labor on the goods or services was performed by a union member or member of another organization or the provider of those services met certain standards, as shown by the examples of registered certification marks below.



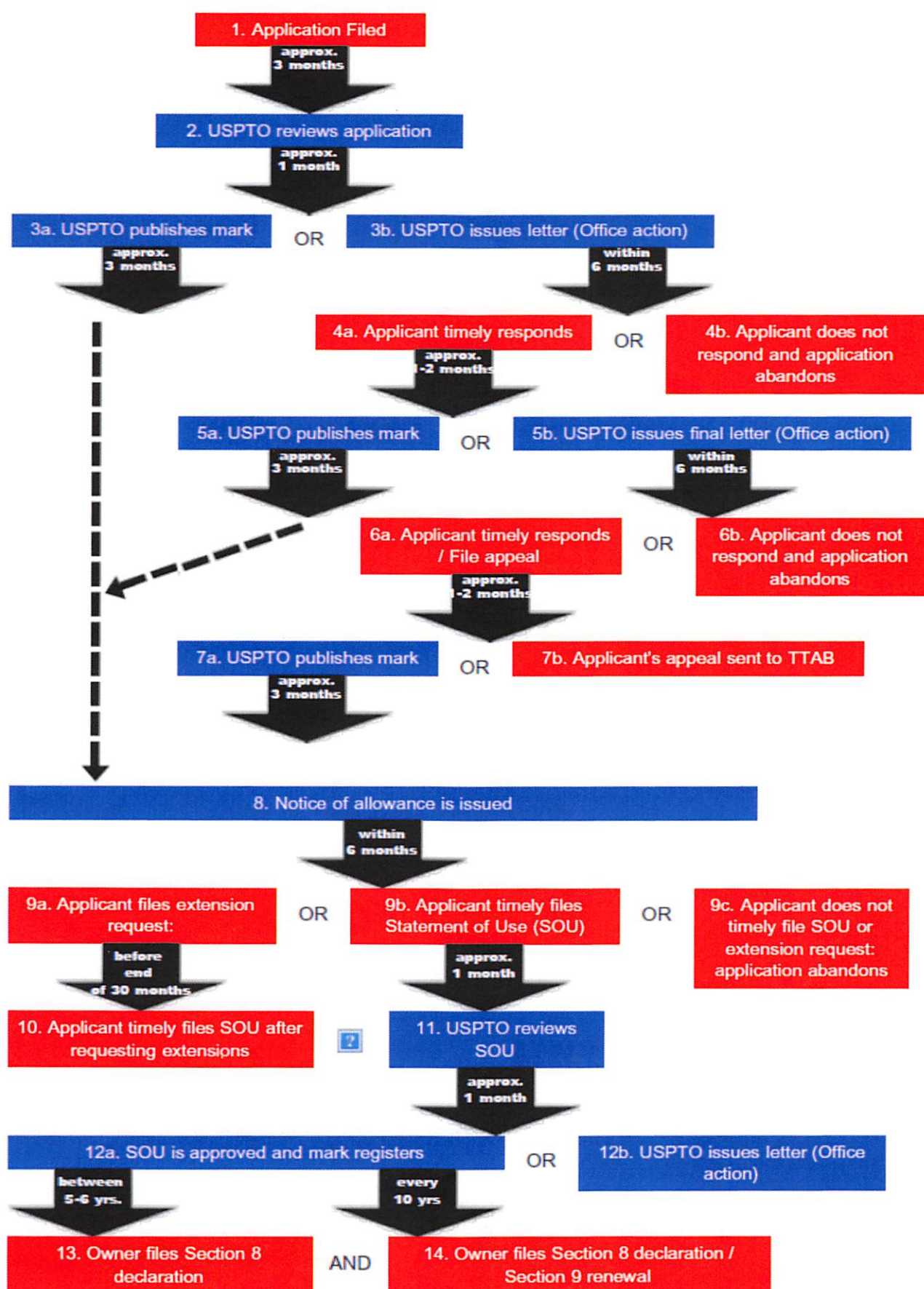
- Main distinguisher: A certification mark shows that goods, services, or providers of those goods and/or services have **met certain standards**. A trademark, however, shows the commercial source or brand of particular goods or services.

# Application based on use of your trademark in commerce

Place your mouse over the steps for more information.



## Section 1(b) Timeline: Application based on intent to use





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## **Trademark Timeline**

Step 1: First decide if it is intent-to-use or use-based filing basis --- this will determine the timeline

**1a: Use-Based** - You are currently using your trademark in commerce with your goods and/or services.

**1b: Intent-to-Use** - You have a bona fide intention to use your trademark in commerce with your goods and/or services in the near future.

---

### **1a Use-Based:**

Step 1: LTC Regarding Filing Particulars

Once the client has provided specimens and the executed application, the application can be filed.

Step 2:

USPTO Reviews the application

### **Three scenarios:**

*Scenario 1 -*

Step 3a: LTC Regarding Notice of Publication

If approved, the USPTO publishes the mark in the Official Gazette for a 30-day opposition period. During that time, anyone who believes that registering the mark would be harmful may file an opposition with the trademark Trial and Appeal Board.

Step 8: LTC Regarding Trademark Registration

If no opposition was filed or any opposition has been resolved, the USPTO issues a registration.

---

*Scenario 2:*

Step 3b: LTC Enclosing Office Action

USPTO Issues Office Action

- Common examples of issues brought up in office actions are: specimen refusals, likelihood of confusion, identification of the goods and/or services, etc.

Step 4a: LTC Enclosing [Proposed] Response to Office Action

File a response to the office action

- Must have client's OK to respond
- Sometimes includes a Declaration Supporting Substitute Specimen that we need signed by the client and must upload to the USPTO

- Also would need a different specimen than what client provided if specimen was refused

Step 4b: LTC Regarding Notice of Abandonment

No response is filed and application goes abandoned

Step 5a: LTC Regarding Notice of Publication

USPTO approves response to office action and step 3a and step 8 occur

*~end of scenario 2~*

---

*Scenario 3:*

Step 5b: LTC Enclosing Final Office Action

USPTO issues final office action

Step 6a: LTC Enclosing [Proposed] Response to Final Office Action

You file an appeal and/or submit a response to office action

Step 6b: LTC Regarding Notice of Abandonment

We do not file a response or the client chooses to not move forward with the application.

Application is abandoned.

Step 7a: USPTO approves response and publishes trademark (step3a)

Step 7b: TTAB processes appeal

*~end of scenario 3~*

---

Step 8: LTC Regarding Trademark Registration

USPTO registers trademark

---

**1b Intent-to-Use:**

Step 1: LTC Regarding Filing Particulars

Once client has provided the executed application, the application can be filed.

Step 2:

USPTO Reviews the application

**Three scenarios:**

*Scenario 1 -*

Step 3a: LTC Regarding Notice of Publication

If approved, the USPTO publishes the mark in the Official Gazette for a 30-day opposition period. During that time, anyone who believes that registering the mark would be harmful may file an opposition with the trademark Trial and appeal Board.



Step 8: LTC Regarding Notice of Allowance

If no opposition was filed or any opposition has been resolved, the USPTO issues a notice of allowance.

---

*Scenario 2:*

Step 3b: LTC Enclosing Office Action

USPTO Issues Office Action

- Common examples of issues in office actions are likelihood of confusion, identification of the goods and/or services, mark is merely descriptive etc.

Step 4a: LTC Enclosing [Proposed] Response to Office Action

File a response to the office action

- Must have client's OK to respond

Step 4b: LTC Regarding Notice of Abandonment

No response is filed and application goes abandoned

Step 5a: LTC Regarding Notice of Publication

USPTO approves response to office action and step 3a and step 8 occur

*~end of scenario 2~*

---

*Scenario 3:*

Step 5b: LTC Enclosing Final Office Action

USPTO issues final office action

Step 6a: LTC Enclosing [Proposed] Response to Final Office Action

You file an appeal and/or submit a response to office action

Step 6b: LTC Regarding Notice of Abandonment

We do not file a response or the client chooses to not move forward with the application.

Application is abandoned.

Step 7a: USPTO approves response and publishes trademark (step3a)

Step 7b: TTAB processes appeal

*~end of scenario 3~*

---

Step 8: LTC Regarding Notice of Allowance

A Notice of Allowance is issued. This is not a registration, but indicates that the mark will be allowed to register after a statement of use is filed.

**Two scenarios:**

*Scenario 1:*

Step 9a: LTC Regarding Acceptance of (first, second, etc.) Extension Request

Applicant files an extension request if they are not using the mark in commerce for the goods and/or services in the application. Applicants must continue to file an extension every 6 months, and can only file up to 5. After the fifth extension, a statement of use must be filed or the application will go abandoned.

Step 10:

Applicant files a statement of use within 6 months from the extension request. Applicant must provide a specimen showing use of the mark used in association with the goods and/or services.  
~end of scenario 1~

---

*Scenario 2:*

Step 9b: Applicant files a Statement of Use within 6 months of the Notice of Allowance issuance.

*~end of scenario 2~*

---

Step 11: USPTO reviews Statement of use

Step 12a: LTC Regarding Acceptance of Statement of Use --- LTC Regarding Trademark Registration

Statement of Use is approved and the mark is registered

Step 12b:

USPTO could issue an office action in which we would go through the same process as mentioned above

---

**State Trademark Timeline**

State trademarks are quicker to get than federal trademarks. Once you mail in the:

1. Original signed application mailed in from client
2. 3 identical specimens
3. Drawing page
4. Check to Secretary of State
5. Letter to Secretary of State
6. Acknowledgement postcard

The mark should be registered within the month if all is correct.

A Trademark or Service Mark registration is active for five (5) years from the date the mark was filed with the California Secretary of State's office. The mark must be renewed every 5 years as long as it is in continual use.



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## **POST REGISTRATION MAINTENANCE**

In order for the owner of the mark to maintain their registration, they must:

- Show continued use of the trademark in interstate commerce (specimens!)
- File their registration maintenance documents with the USPTO, and pay the required fees at the required times
- Keep their correspondence information updated (address, owner info, attorney info, etc)

## **Maintenance forms**

Due	Filing	Description	Required/Optional
Between years 5 - 6	Section 8 Declaration of Use	A form filed by the owner requiring a verified statement of <u>use in commerce</u> , a specimen for each class, and a fee per class.	Required
After 5 years of continuous use	Section 15 Declaration of Incontestability	A form filed by the owner requiring a verified statement claiming incontestable rights as to the validity of the registration, and a fee per class.	Optional
After 5 years of continuous use, between years 5 - 6	Combined Section 8 Declaration of Use and Section 15 Declaration of Incontestability	A form filed by the owner that combines two declarations, Section 8 and Section 15, into a single filing. See Section 8 and Section 15 descriptions above.	Optional
Between years 9 - 10 (then every 10 years)	Combined Section 8 Declaration of Use and Section 9 Application for Renewal	A form filed by the owner that combines two declarations, Section 8 and Section 9. See Section 8 description above. Section 9 is a request to renew the registration before it expires, and a fee per class.	Required



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## TRADEMARK STATUS & DOCUMENT RETRIEVAL (TSDR) BASICS

How to Access from Time Matters:

The screenshot shows the 'Matter Form - Change' window in the Time Matters software. The window is titled 'Matter Form - Change' and has a menu bar with 'File', 'Edit', 'View', 'Process', and 'Help'. Below the menu bar is a toolbar with icons for 'Save & Close', 'Save', 'Print', 'Find', 'New', 'Open', 'Close', 'Cancel', and 'Help'. The main area of the window is divided into several tabs: 'Primary', 'Secondary', 'Additional', 'Custom', 'Related', 'Notes', 'Docs', 'Phone', 'E-Mail', 'Web', 'Billing', 'Timeline', 'AR', 'Outline', and 'Outli'. The 'Primary' tab is selected. The form contains the following fields: 'Mat Ref' (BB BUBBLYBLASTER (Logo) (Class 8)), 'Matter No' (21-43314), 'Court' ( ), 'Code' (RIFed Tmk(use)), 'Staff' (DANIDaniel M Ciso), 'Plaintiff' ( ), 'Defendant' ( ), 'Contact' (Hall, Bradley), 'Address' (Bradley Hall), 'Firm' (Bubbly Blaster, LLC), 'Address' (8033 W Sunset Blvd. #963), 'City' (Los Angeles), 'State' (CA), 'Zip' (90046), 'Tel -> Email' ((205) 936-5865 brad@sonusleep.com; stason@sonusleep.com), 'Box No' ( ), 'Serial No.' (87/164,473), 'Filing Date' (9/08/2016), 'QA Date' ( ), 'Opp/Can' ( ), 'For Ref.No.' ( ), 'Comments' ( ), 'Applic. Issue Info' ( ), 'Reg. No.' (5,185,840), 'Issue Date' (4/18/2017), 'Open Web Site' ( ), 'TTAB Stat.' ( ), and 'QCC Person' (TAR). The 'Matter No' field is highlighted with a yellow background.

The screenshot shows the 'Matter Form - Change' window in the Time Matters software. The window is titled 'Matter Form - Change' and has a menu bar with 'File', 'Edit', 'View', 'Process', and 'Help'. Below the menu bar is a toolbar with icons for 'Save & Close', 'Save', 'Print', 'Find', 'New', 'Open', 'Close', 'Cancel', and 'Help'. The main area of the window is divided into several tabs: 'Primary', 'Secondary', 'Additional', 'Custom', 'Related', 'Notes', 'Docs', 'Phone', 'E-Mail', 'Web', 'Billing', 'Timeline', 'AR', 'Outline', and 'Outli'. The 'Primary' tab is selected. The form contains the following fields: 'Mat Ref' (BB BUBBLYBLASTER (Logo) (Class 8)), 'Matter No' (21-43314), 'Court' ( ), 'Code' (RIFed Tmk(use)), 'Staff' (DANIDaniel M Ciso), 'Plaintiff' ( ), 'Defendant' ( ), 'Contact' (Hall, Bradley), 'Address' (Bradley Hall), 'Firm' (Bubbly Blaster, LLC), 'Address' (8033 W Sunset Blvd. #963), 'City' (Los Angeles), 'State' (CA), 'Zip' (90046), 'Tel -> Email' ((205) 936-5865 brad@sonusleep.com; stason@sonusleep.com), 'Box No' ( ), 'Serial No.' (87/164,473), 'Filing Date' (9/08/2016), 'QA Date' ( ), 'Opp/Can' ( ), 'For Ref.No.' ( ), 'Comments' ( ), 'Applic. Issue Info' ( ), 'Reg. No.' (5,185,840), 'Issue Date' (4/18/2017), 'Open Web Site' ( ), 'TTAB Stat.' ( ), and 'QCC Person' (TAR). The 'Matter No' field is highlighted with a yellow background. A red arrow points to the 'Open Web Site' button.

tsdr.uspto.gov/#caseNumber=87/164,473&caseType=SERIAL\_NO&searchType=statusSearch

### Trademark Status & Document Retrieval (TSDR)


SEARCH MULTI-SEARCH ?


US Serial, Registration, or Reference No. 87164473 Status Documents

Status results found

Generated on: This page was generated by TSDR on 2022-09-13 13:33:52 EDT

Mark: BB BUBBLYBLASTER



US Serial Number:	87164473	Application Filing Date:	Sep. 08, 2016
US Registration Number:	5185840	Registration Date:	Apr. 18, 2017
Filed as TEAS Plus:	Yes	Currently TEAS Plus:	Yes
Register:	Principal		
Mark Type:	Trademark		
TM5 Common Status Descriptor:		LIVE/REGISTRATION/Issued and Active	
		The trademark application has been registered with the Office.	
Status:	Registered. The registration date is used to determine when post-registration maintenance documents are due.		
Status Date:	Apr. 18, 2017		
Publication Date:	Jan. 31, 2017		

Expand All

- Mark Information
- Goods and Services
- Basis Information (Case Level)
- Current Owner(s) Information
- Attorney/Correspondence Information
- Prosecution History
- TM Staff and Location Information
- Assignment Abstract Of Title Information - Click to Load
- Proceedings - Click to Load

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Trademark Status & Document Retrieval

tsdr.uspto.gov/#caseNumber=87/164,473&caseType=SERIAL\_NO&searchType=statusSearch

Trademark Status & Document Retrieval (TSDR)

SEARCHMULTI-SEARCH

US Serial, Registration, or Reference No.87164473StatusDocuments

STATUSDOCUMENTSMAINTENANCE

Status : Maintenance filings have been received and will be reviewed by the Post Registration Team in due course

§8 (6 year) Declaration Due Dates:

Latest date §8 can be filed without paying additional fee: Apr. 18, 2023

Latest date §8 can be filed by paying an additional fee: Oct. 18, 2023

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Status Date: Apr. 18, 2017  
Publication Date: Jan. 31, 2017

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Goods and Services

Note:  
The following symbols indicate that the registrant/owner has amended the goods/services:  
• Brackets [ ] indicate deleted goods/services;  
• Double parenthesis ( ( ) ) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and  
• Asterisks "\*" identify additional (new) wording in the goods/services.

For: Hand-operated spray guns

International Class(es): 008 - Primary Class U.S Class(es): 023, 028, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 22, 2016 Use in Commerce: Mar. 22, 2016

Basis Information (Case Level)

Current Owner(s) Information

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Daniel M. Cislo, Esq. Docket Number: 21-43314

Attorney Primary Email: [tmk@cislo.com](mailto:tmk@cislo.com) Attorney Email Authorized: Yes

Address:

Correspondent

Correspondent Name/Address: Daniel M. Cislo, Esq.  
Cislo & Thomas LLP  
12100 Wilshire Blvd. Suite 1700  
Los Angeles, CALIFORNIA UNITED STATES 90025

Phone: 3109799190 Fax: 310-394-4477

Correspondent e-mail: [tmk@cislo.com](mailto:tmk@cislo.com) [cgrant@cislo.com](mailto:cgrant@cislo.com) Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

TM Staff and Location Information

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### SPECIMENS

\*Important note: you always need one specimen per class showing use of the mark for the goods/services in that class (if an application has five (5) classes, you will need five (5) specimens)

\*Important note: specimens must be current

- You need specimens when filing a:
  - Use-Based 1(a) application
  - Statement of Use
  - Amendment to Allege Use
  - Sections 8 & 15
  - Sections 8 & 9
  - Response to Office Action (not always - depends on the issues)
- For trademarks (goods)
  - Examples of specimens include:
    - hang tags
    - Labels
    - Packaging
    - The goods themselves
    - Displays near the goods being offered for sale
    - Social Media pages (use in a business fashion – goods offered for sale where the mark is used as a source indicator for the goods)
    - Webpage displaying the mark sufficiently near the goods at their point of sale
  - Language used when filing
    - “Hang tag/label/packaging displaying the mark”
    - “Photograph of the goods displaying the mark” (except for clothing and jewelry (unless there is secondary meaning)
    - “Webpage displaying the mark sufficiently near the goods at their point of sale “
- For service marks (services)
  - Examples of specimens include:
    - Flyers
    - Advertisements
    - Brochures
    - Signage
    - Social Media pages (use in a business fashion – services offered on the site)
    - Webpages showing the mark used in association with the services
  - Language used when filing:
    - “Flyers/advertisement/brochure/webpage displaying the mark used in association with the services”
    - “Public sign displaying the mark used in association with services”
    - “Screenshots of Twitter and Instagram pages displaying the mark used in association with the services being offered and as a source indicator”





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### **FUN FACTS/GOOD TO KNOWS**

™ - stands for a trademark; can be used even if you haven't filed an application to register yet

® - stands for a registered trademark; protected by a federal registration issued by the USPTO

© - stands for copyright.

UPS owns a trademark for the color brown.

When you open up a Burberry® raincoat, the check design you see is a registered trademark.

Product design and product packaging are types of trade dress.

The shape of a Hershey Kisses chocolate is a registered trademark.

A trademark can last indefinitely, so long as the owner can continue to show current use, and stays up to date with filing maintenance documents and fees.

The name of the state Idaho is a registered certification mark for potatoes.

The famous under-the-helmet inhale and exhale from Anakin Skywalker is trademarked by Lucasfilm (sound mark).

Paris Hilton successfully trademarked "that's hot" for a line of clothing and alcohol.

The below is a list of trademarks that have become **genericized** meaning a mark becomes identified with a type of product or service in the public's mind, rather than a particular brand:

1. Aspirin: Formally known as acetylsalicylic acid, aspirin was created in 1897 and originally trademarked by Bayer AG. The name means "pain relief, speed, reliability and tolerability," according to Bayer. Aspirin comes from "acetyl" and Spirsäure, a German name for salicylic acid. Its time as a trademarked word would be short — in 1917 many of Bayer's U.S. assets were confiscated as a result of World War 1, including its patents and trademarks.
2. Heroin: Speaking of losing trademarks, heroin was also stripped from Bayer in 1917. The drug derived from morphine was named trademarked by the company in 1898 based on the German word heroisch, which means "heroic, strong." Couldn't find mention of its heroin history on Bayer, which is unsurprising.

3. Cellophane: Cellophane gets its name from regenerated cellulose (the stuff that makes up much of plant's cell walls) and diaphane, or transparent. It was created by Swiss chemist Jacques E. Brandenberger and patented in 1912. In 1923, DuPont chemists created a moisture-proof system for cellophane. It has since become genericized in the U.S., though still trademarked in other countries. Plastic wrap isn't cellophane, by the way — it's polyvinyl chloride.
4. Escalator: First coined by Charles Seeberger of Otis Elevator Co. in 1900 when he debuted his device. The word comes from the root the word scala for "steps" in Latin, with "E" as the prefix, and a suffix of "Tor." Roughly, that means "traversing from." It was also supposed to be pronounced with the accent on the middle syllable — es-CA-lator. Otis lost the trademark when the U.S. Patent Office ruled that even Otis had used escalator as a generic descriptive term in its own patents. It was officially genericized.
5. Trampoline: The first modern trampoline was built by George Nissen and Larry Griswold in 1936, and comes from the Spanish for "diving board" — trampolin. The generic term for it before was actually the "rebound tumbler." It's unclear when it lost its trademark, but anyone can now sell a trampoline.
6. Thermos: The predecessor to the thermos was Sir James Dewar's "vacuum flask," invented in 1892. The Thermos first hit the market in 1904 for commercial use, named as such by German glass blowers who held a contest to name the product. A Munich resident suggested Thermos from the Greek Therme for "heat." Thermos GmbH sold trademark rights to three independent companies in 1907, who then began producing it and selling it around the world. It was named a generalized trademark in the U.S. in 1963, but remains a registered trademark in some other countries.
7. Dry Ice: Trademarked in 1925 by the DryIce Corporation, dry ice is solid CO<sub>2</sub>. It lost its trademark in 1932.
8. Kerosene: Abraham Gesner registered a trademark for combustible hydrocarbon liquid, derived from the Greek "kerns" for wax, in 1854. The North American Gas Light Company and the Downer Company were the only ones allowed to use the term for some years, until it eventually became genericized.
9. Laundromat: Named by George Edward Pendray, Westinghouse Electric introduced the Laundromat in 1940, the first automatic washing machine that could be wall-mounted. It was last registered to Westinghouse in 1952, and has since expired as a trademark, according to USPTO.gov. Westinghouse Nuclear still maintains a history page for the original company.

10. Linoleum: While Linoleum — from the Latin linum for “flax” and oeum, “oil” — was considered to be the first term to become generic, it was never trademarked by its English inventor, Frederick Walton. He established the Linoleum Manufacturing Company Ltd in 1864, but apparently never trademarked the term in the first place. That fact came to light when Walton was facing competitors in court in the late 1870s. By that time, the generalization had already happened, and it was too late.
11. App Store: Apple sued Amazon in 2011 claiming consumers could be confused by its “Appstore for Amazon” but then abandoned the trademark and the lawsuit in 2013.
12. Yo-Yo: Trademarked in the U.S. in 1932 by entrepreneur Donald F. Duncan, his company lost a case brought by ac competitor in 1965, when a federal appeals court ruled that the trademark was improperly registered and therefore invalid.
13. ZIP code: Otherwise known as the Zone Improvement System, the ZIP code was originally registered as a servicemark by the United States Postal Service in 1976 but has since expired due to non-renewal.
14. Zipper: The word zip was already around as a noun and a verb, referring to sound it makes when you make the motion that accompanies that kind of noise. You zip and it goes “zip!” It was first registered as a trademark in 1925 by B.F. Goodrich for overshoes with fasteners invented by Gideon Sundback. An executive is said to have slid the fastened up and down saying, “zip ‘er up,” thus, Zipper. The company sued to protect the trademark in 1930 but only got to keep the rights to Zipper Boots, as zipper had entered the common lexicon by then as a generic term.
15. TV Dinner: C.A. Swanson & Sons developed the pre-packaged, frozen dinner meal in 1953 and trademarked it as TV Brand Frozen Dinner, but stopped using TV Dinner in 1962. Today, any kind of frozen meal you can eat in front of a screen could be called a TV dinner.



PROCUREMENT AND ENFORCEMENT  
OF INTELLECTUAL PROPERTY

CISLO & THOMAS LLP  
*Attorneys at Law*

PATENT, TRADEMARK  
COPYRIGHT & RELATED MATTERS

C&T Staff Training  
[09-14-2022] [CG/MD]

Check all that apply to record with U.S. Customs and Border Protection:

- a. Clothing
- b. Cosmetics
- c. Furniture
- d. Restaurants
- e. All of the above

A U.S. federal trademark application can only be filed in foreign countries within six (6) months of the U.S. filing date.

- a. True
- b. False

Federal and state trademark registrations may use the ® symbol.

- a. True
- b. False

Owners may only use the ™ symbol if they have a pending federal trademark application.

- a. True
- b. False

A Federal trademark registration provides worldwide protection.

- a. True
- b. False

Trademark registrations expire after 10 years.

- a. True
- b. False

Check all that apply – the following can be trademarked:

- a. A word(s)
- b. Symbols or Logos
- c. A sound
- d. A Color
- e. A government insignia
- f. The shape of a bottle
- g. A generic term

Trademarks do not need to be actively reinforced by an owner; they are automatically protected from infringement once used and/or registered.

- a. True
- b. False

A “senior” user of a trademark is determined by the date their mark is registered.

- c. True
- d. False – common right law

Acceptable specimens for goods are (circle the following that apply):

- a. Labels
- b. Brochures/Advertisements
- c. Tags
- d. Packaging
- e. Press releases
- f. Displays
- g. Signage
- h. Internet pages displaying the mark sufficiently near the goods at their point of sale

Registration of a domain name with a domain name registrar does give the owner trademark rights.

- a. True
- b. False → Registration of a domain name with a domain name registrar **does not** give you any trademark rights. For example, even if you register a certain domain name with a domain name registrar, you could later be required to surrender it if it infringes someone else’s trademark rights.

The most common reason to refuse registration is a “likelihood of confusion” between the mark of the applicant and a mark already registered or in a prior-filed pending application owned by another party.

- a. True → The USPTO determines that a likelihood of confusion exists when both (1) the marks are similar, and (2) the goods and/or services of the parties are related such that consumers would mistakenly believe they come from the same source.
- b. False

The USPTO decides whether you have the right to use a mark (which differs from the right to register).

- a. True
- b. False → No law requires that you federally register your mark in order to acquire rights in the mark.

The USPTO can assist you with policing your mark against infringers and also assist you with recordation of your mark with U.S. Customs and Border Protection. FALSE

- a. True
- b. False



# Security Tip (ST04-010)

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## Using Caution with Email Attachments

Original release date: September 10, 2009 | Last revised: November 14, 2019

While email attachments are a popular and convenient way to send documents, they are also a common source of viruses. Use caution when opening attachments, even if they appear to have been sent by someone you know.

### Why can email attachments be dangerous?

Some characteristics that make email attachments convenient and popular also make them a common tool for attackers:

- Email is easily circulated – Forwarding email is so simple that viruses can quickly infect many machines. Most viruses do not even require users to forward the email—they scan a users' mailbox for email addresses and automatically send the infected message to all of the addresses they find. Attackers take advantage of the reality that most users will automatically trust and open a message that comes from someone they know.
- Email programs try to address all users' needs – Almost any type of file can be attached to an email message, so attackers have more freedom with the types of viruses they can send.
- Email programs offer many "user-friendly" features – Some email programs have the option to automatically download email attachments, which immediately exposes your computer to viruses within the attachments.

### What steps can you take to protect yourself and others in your address book?

- **Be wary of unsolicited attachments, even from people you know.** Just because an email message looks like it came from someone you know does not mean that it did. Many viruses can "spoof" the return address, making it look like the message came from someone else. If you can, check with the person who supposedly sent the message to make sure it's legitimate before opening any attachments. This includes email messages that appear to be from your internet service provider (ISP) or software vendor and claim to include patches or antivirus software. ISPs and software vendors do not send patches or software in email.
- **Keep software up to date.** Install software patches so that attackers can't take advantage of known problems or vulnerabilities. Many operating systems offer automatic updates. If this option is available, you should enable it. (see Understanding Patches and Software Updates for more information)
- **Trust your instincts.** If an email or email attachment seems suspicious, don't open it, even if your antivirus software indicates that the message is clean. Attackers are constantly releasing new viruses, and the antivirus software might not have the signature. At the very least, contact the person who supposedly sent the message to make sure it's legitimate before you open the attachment. However, especially in the case of forwards, even messages sent by a legitimate sender might contain a virus. If something about the email or the attachment makes you uncomfortable, there may be a good reason. Don't let your curiosity put your computer at risk.

- **Save and scan any attachments before opening them.** If you have to open an attachment before you reach the source, take the following steps:
  1. Be sure the signatures in your antivirus software are up to date.
  2. Save the file to your computer or a disk.
  3. Manually scan the file using your antivirus software.
  4. If the file is clean and doesn't seem suspicious, go ahead and open it.
- **Turn off the option to automatically download attachments.** To simplify the process of reading email, many email programs offer the feature to automatically download attachments. Check your settings to see if your software offers the option, and make sure to disable it.
- **Consider creating separate accounts on your computer.** Most operating systems give you the option of creating multiple user accounts with different privileges. Consider reading your email on an account with restricted privileges. Some viruses need "administrator" privileges to infect a computer.
- **Apply additional security practices.** You may be able to filter certain types of attachments through your email software (see Reducing Spam) or a firewall (see Understanding Firewalls).

## Authors

CISA

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