

**ROBINSON** § **SON**  
LAW • MEDIATION • CONSULTING

Trademark  
&  
Copyrights

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# Types of Intellectual Property



TRADEMARKS



COPYRIGHTS



PATENTS

# Explanation of the Intellectual Property

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## **Patent**

Invention

Invent a New Kind of Product

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## **Trademark**

Brand Names and Logos used on Goods or Services.

Protect the Brand Name of the Product

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## **Copyright**

Original Artistic or Literary Work

The TV Commercial to Market the Product

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# Copyrights

USPTO

# What is a Copyright?

Protection provided by U.S. Law

To the Authors of

**“Original Works of Authorship”**

Fixed in any Tangible Medium of Expression

# What type of works can be a Copyright?



Literary



Dramatic



Musical



Artistic



Audiovisual



Architectural  
works

# What can be a Copyright?



WORDS



NUMBERS



NOTES



SOUNDS

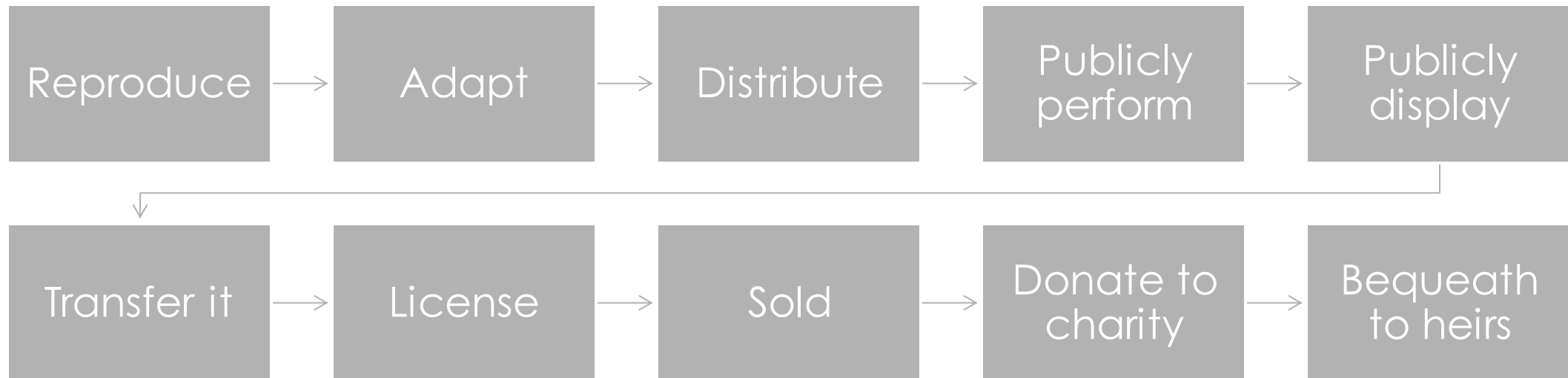


PICTURES



ANY OTHER  
GRAPHIC OR  
SYMBOLIC MEDIA

# The Copyright Owner has Exclusive Right:





# US Copyright Registration NOT required, but HIGHLY recommended

Establishes a public record of the copyright claim.

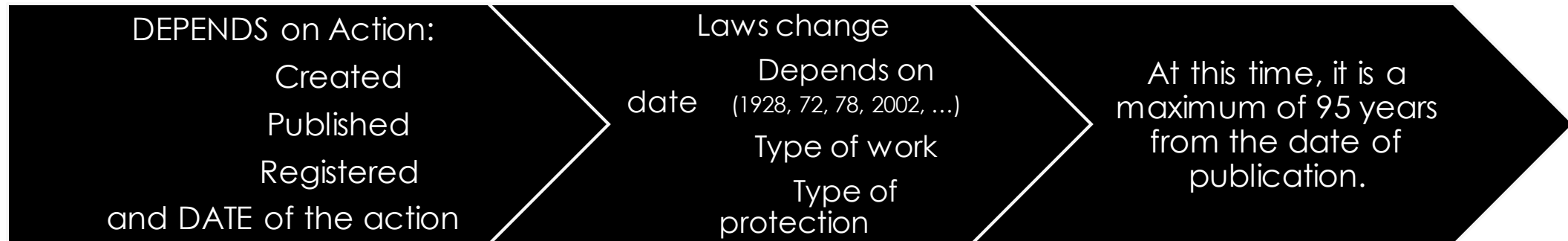
Necessary BEFORE an infringement suit may be filed in court

5 years: Establishes prima facie evidence in court of the validity of the copyright and of the facts stated in the certificate.

3 months after publication of the work or prior to an infringement of the work: Statutory damages and attorney's fees will be available to the copyright owner in court actions instead of only actual damages and profits is available to the copyright owner.

Protection against the importation of infringing copies

# What is the Length of Protection of a Copyright?



# Where in the world is it protected by a Copyrighted? – IT DEPENDS

Each country has different laws, but treaties since 1889, because of Victor Hugo.

1889

1989

1998

World Intellectual Property Organization (WIPO Copyright Treaty) is named the Digital Millennium Copyright in 1998. It even protects websites.

The Berne Convention started in 1887, but the US signed on in 1989 and about 176 UN member states.

# Trademark

USPTO

# What is a Trademark?

Protection provided by U.S. Law

To an Owner of Goods or Services

Using Something in the Marketplace that

Identifies the Source of your Goods or Services

# Federal Registration Provides Protection

Public Notice of registered and pending trademarks.

Right to bring a lawsuit concerning the trademark in federal court.

Legal presumption that you own the trademark and have the right to use it.

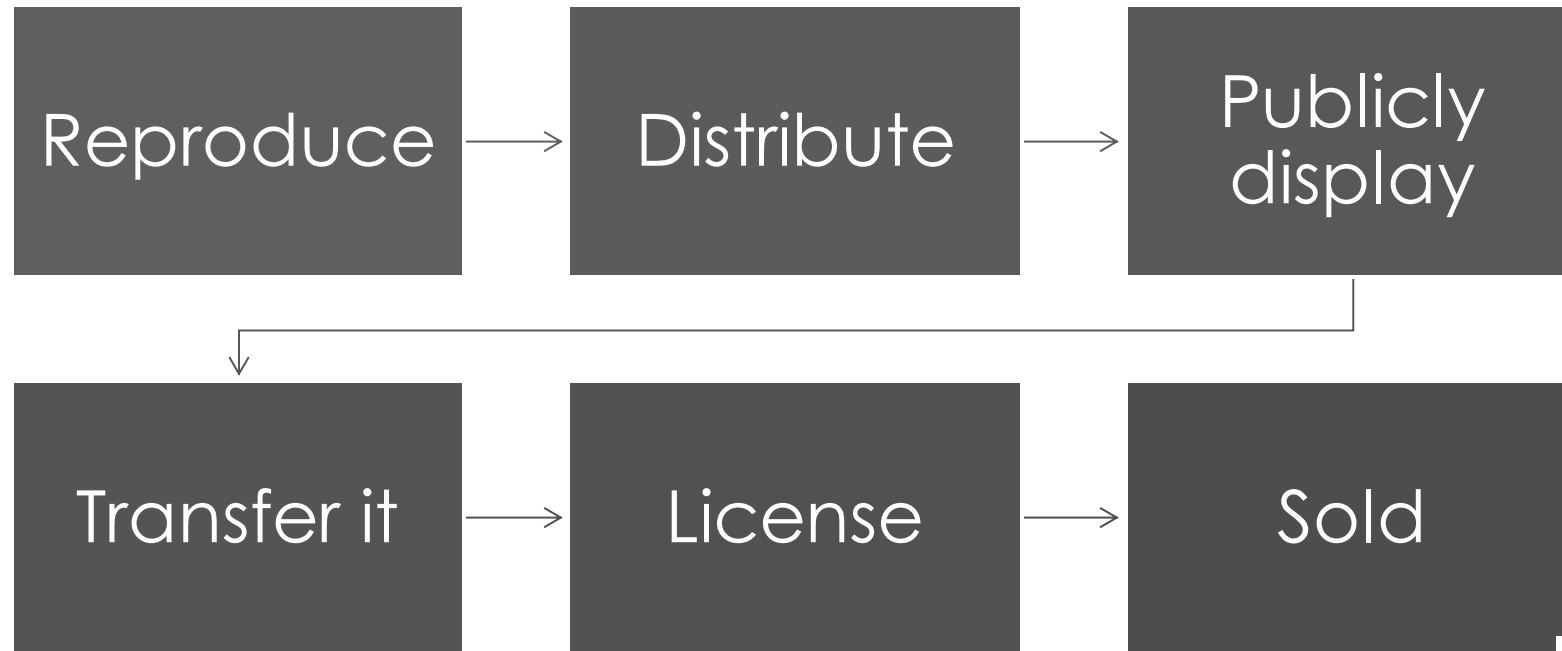
Can use your registration as a basis for filing for trademark protection in foreign countries.

May use the federal trademark registration symbol ®.

# Why do you need a Trademark?

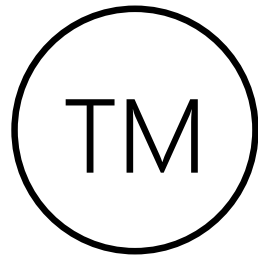
- ❑ Online Stores offering Goods and Services make naming and Trademarks more important.
  - ❑ 1990: Local Store Opens (County DBA) – Protection in that 1 county (Another County can have another company with same name)
  - ❑ 2000: Incorporated with State possibly with a DBA – Protection in that 1 State
  - ❑ 2010: Opened Online Store with Incorporated DBA and Domain Name
  - ❑ 2011: Receives a Cease & Desist Letter from a company with a Federal Trademark in the same class.
    - ❑ Many Options: Pay for License, Fight in Court, Change Name and file, etc.

# The Trademark Owner has Exclusive Right:



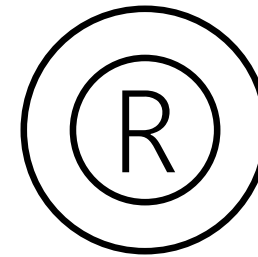


# What type of Commerce can be Trademarked?



**Trademarks**

Goods



**Service Marks**

Services

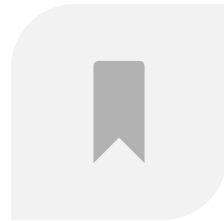
# What can be Trademarked?



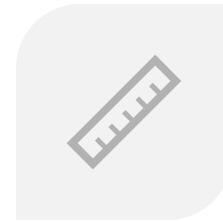
WORD



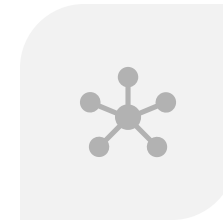
PHRASE



SYMBOL



DESIGN



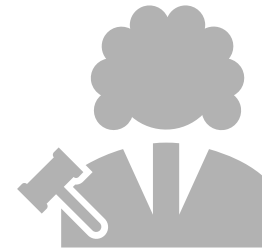
COMBINATION

# Types of Filings



## **Use in Commerce: Section 1(a)**

Interstate Commerce  
Between the US and another county



## **Intent to Use in Commerce: Section 1(b)**

Bona fide intent to use trademark in the  
future

# Why do we need a Specimen?



Evidence of how it is actually used



Proof of what consumers see in the marketplace



Direct connection between the trademark and the goods or services

# What is a Good Specimen for a Product?

Label

Hangtag

Packaging

Trademark used on the Goods Themselves

Point of Sale Display

Screenshot of Website showing

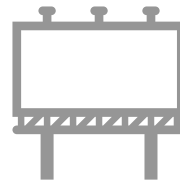
- Mark
- Picture of directly purchasing the goods
- Means of Directly Purchasing the Goods
- Buy Button
- Add to Cart Button
- Click to Purchase Button

# What is a Good Specimen for a Service?



## Website

Must include URL and date of capture



## Advertisement



## Advertising Brochure

# Types of Drawing

**Standard Character:** protection for the wording alone, regardless of font, style, size, color



<b>Word Mark</b>	<b>NIKE</b>
<b>Goods and Services</b>	IC 035. US 100 101 102. G & S: retail store se sports and fitness products and accessories. F
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	88831783
<b>Filing Date</b>	March 12, 2020

**Design Mark:** just a design alone, with no wording



<b>Word Mark</b>	<b>NIKE</b>
<b>Goods and Services</b>	IC 014. US 002 027 028 050. G & S: timepieces of all types, n
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) 26.17.12 - Angles (geometric); Chevrons 26.17.25 - Other lines, bands or bars
<b>Serial Number</b>	75977827
<b>Filing Date</b>	October 24, 1996

# Types of Standard Character

Word

**NIKE**

Phrase

**JUST DO IT**



# Types of Special Form of Drawing

Stylized



Composite



# What are the Classes of Trademarks?

- ❑ **45** Different classes
  - ❑ 34 Products
  - ❑ 11 Services

You can file into as many classes as the good and service is being used in commerce.

# Example of Multiple Class Filings for Nike

18 different classes for the Standard Character Word – NIKE

- 022 018 009 Ear Plugs
- 039 025 Footwear 028 Nose Plugs
- 018 Balls 016 035 Retail Store
- 025 Casual Wear 018 Bags 041 Sport Events
- 042 Apparel Store 014 Timepieces 030 Sandwiches
- 025 009 Cell Phones 009 Eyewear

The word "NIKE" is displayed in a bold, black, serif font, centered within a white rectangular box with a thin grey border.

# Example of Multiple Class Filings for Nike

9 different classes for the Standard Character Word – Just Do It.

- 025 Shirts      035 Retail Store      018 Bags
- 009 Eyewear      035 Online Store      021 Bottles
- 009 Cellphone      025 Headbands      026 Hair
- 

JUST DO IT

# Example of Multiple Class Filings for Nike

17 different classes for the Special Form Drawing – Swoosh

022	021	009
039	028	025
042	009	014
025	028	041
025	009	018
016	028	



# Example of Multiple Class Filings for Nike

9 different classes for the Special Form Drawing – Composite

025	018	028
042	028	014
025	009	009



# What are Office Actions?

Questions from the USPTO about the Trademark. Must respond within 6 months.  
The most common are:

## ❓ **Technical deficiencies**

- ❓ Insufficient identification of goods and services
- ❓ Need for disclaimers
- ❓ Improper specimens

## ❓ **Substantive refusals**

- ❓ Likelihood of confusion
- ❓ Merely descriptive

# Timeline of Trademark Registration





What to do before naming a Business, Domain, Good, or Service?

Google  
Search

State  
Trademark

State  
Secretary  
of State

Federal  
USPTO

Online  
Search  
Programs

Attorney  
Search

# Cristal Robinson, JD/MBA

## Website

- [www.CristalRobinson.com](http://www.CristalRobinson.com)
- or
- [www.ALT789.com](http://www.ALT789.com)

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