U2
Trademark Basics
Trademarks.

From Apple to Xerox and everywhere in between.
What is a trademark?

The term “trademark” includes any word, name, symbol, or device, or any combination thereof... used by a person...

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.

Trademarks vs. Service Marks

• Trademarks are generally used in conjunction with goods

• Service marks are generally used in conjunction with services

• Not a critical distinction; often used interchangeably
Trademarks vs. Copyrights vs. Patents

- **Trademarks** protect brand identity, customer good will
- **Copyrights** protect original artistic expressions in a tangible medium
- **Patents** protect inventions, must have utility

- Each grants a bundle of rights to its respective owner; either the exclusive right to do OR the right to exclude others from doing
Trademarks vs. Copyrights

• Overlap between Trademarks and Copyrights is possible
  – Logos
  – Mascots
  – Graphic designs
Copyrights vs. Patents vs. Trademarks

• Overlap between Trademarks and Copyright is possible
  – Logos
  – Mascots
  – Original graphics or designs
• Separate registration is required
• Different government agencies
  – US Patent and Trademark Office
  – US Copyright Office
Marking your marks

®

Used only with US Registered marks

™  ®

Used with non-registered or pending marks
Who owns a trademark?

• Generally speaking, the party using the mark

• Consider divergent copyright interests

• The owner of a trademark must benefit from the good will associated with the mark
Procter & Gamble
Developing a brand

• BE CREATIVE!!!

• Minimizes chances of infringement

• Maximizes chances of getting your mark registered

• ‘Arbitrary’ and ‘Fanciful’
## Creativity Counts

<table>
<thead>
<tr>
<th>NOT CREATIVE</th>
<th>BETTER</th>
</tr>
</thead>
<tbody>
<tr>
<td>First National Bank</td>
<td>First National Bank of Oz</td>
</tr>
<tr>
<td>First Bank</td>
<td>Billy Bob’s Big Bad Bank</td>
</tr>
<tr>
<td>FirstBankCorp</td>
<td>The Money Depot</td>
</tr>
<tr>
<td>Bank First</td>
<td>Banks-a-million</td>
</tr>
<tr>
<td>Bank One</td>
<td></td>
</tr>
</tbody>
</table>

**BEST**

Wealthmatron Banking Depositorium℠
Confusing Similarity is the Rule

• For Infringement as well as Registration
• Determination turns on a LIKELIHOOD OF CONFUSION as between the marks and their respective goods and services
• Actual confusion is not required
• Even actual confusion may not be enough if it is unreasonable
Confusing Similarity is the Rule

• Analysis and comparison of the marks
  – Every literal aspect of the marks matters
    • Prefixes
    • Suffixes
    • Add-ons
    • Deletions
    • Misspelled words (usually deliberate)
    • Hybrid words
    • Made-up words
Confusing Similarity is the Rule

• Non-literal elements matter, too
  – Typefaces
  – Designs
  – Fonts
  – Colors

• Must compare the marks in their respective entireties
Confusing Similarity is the Rule

SLIDING SCALE

• As the similarity of the marks increases, the similarity of the goods and services becomes less important

• For example,

  KAR KRAZY
  An oil change and tire repair shop

  KRAZY KARZ
  A hobby shop selling remote control cars
Confusing Similarity is the Rule

SLIDING SCALE

• As the similarity of the goods and services increases, the similarity of the marks becomes less important

• For example,

  KAR KRAZY  CURT’S CRAZY CARS
  An oil change and tire repair shop  A custom race and performance shop
Zone of Natural Expansion

• Areas of commerce in which a trademark owner might reasonably and naturally be expected to expand

• For example, KAR KRAZY for an oil change and tire repair shop could be said to have muffler and brake shops within its zone of expansion, thereby preventing another from using the mark on a muffler and brake shop.
Search it!

• Why search?
  – Saves money
    • Prevents nuisance cease-and-desist letters
    • Staves off nuisance lawsuits
    • Avoids need to re-brand or recall marketing efforts
  – Advice of counsel is a defense to willfulness
Search it!

• Select a search strategy
  – Do-it-yourself
    • Telephone directories – local
    • Telephone directories – desired market(s)
    • Internet/Google®
    • US Patent and Trademark Office
    • Secretaries of State
Search it!

• Select a search strategy
  – PROFESSIONAL
    • Basic search (e.g., USPTO)
    • Enhanced search (e.g., USPTO + states)
    • Preferred search (e.g., USPTO + states + business names + Internet)
  – Rates increase with scope and expedience
Search it!

• Why use a third-party?
• Demonstrated expertise in searching:
  – similar marks
  – related goods and services
  – phonetic equivalents
  – sound-alikes
  – misspelled words
  – common variants
• Why search business/corporate names?
  – Notwithstanding distinction between corporate and brand identity
  – XYZ Corp. manufactures widgets and is registered with Secretary of State
  – If XYZ engages in the widget trade under its corporate name, it has common law rights in the XYZ mark even if it has not been registered
Search it!

- Foreign Searching?
  - Informally, one can search European Community and Madrid Protocol marks online
  - Formal searching can get expensive
  - Ultimately, depends on your business objectives
UND Registered Trademarks

- “University of North Dakota”
- (flame)
- (seal)
- “INMED”
UND Registered Trademarks

- (EERC)
- (drop)
- “Center for Air Toxic Metals”
- “CATM”
UND Registered Trademarks

- “Coal Ash Resources Research Consortium”
- “CARRC”
- “Plains Organization for Wind Energy Resources”
- “POWER”
- “National Alternative Fuels Laboratory”
- “NAFL”
UND Registered Trademarks

• “Center for Biomass Utilization”
• “CBU”
• “RRWMC”
• “The Waffle”
• “International Center for Applied Energy Technology”
UND Pending Trademarks

- “Aerocam”
- “AgCam” *
- “Studio One”
- “Great Plains Applied Energy Research Center”
- “Great Plains Applied Energy Technology Center”
“Common Law” Rights

• No registration necessary
• Rights and benefits accrue automatically upon use of the mark
• Limited to areas in which mark is used
• “Sioux”
• “Fighting Sioux”
• Indian head
YOU...

...are the eyes and ears of the University

If you see something that doesn’t look right, let us know!
Can I use that mark?

• Two “safe harbors”
  – Get permission
  – Don’t do it
• Everything else involves risk
• Likelihood of confusion is a GRAY area
• What if you’re wrong?
• Is it worth it?
• Alternatives?
Nominative Fair Use

- “Nominative Fair use” of a trademark is allowed
- May only use so much of the mark as is required to identify the good or service
- May not suggest an affiliation, relationship or endorsement
- Basis for comparative advertising
- Editorializing and criticism
Domain Names

- Cybersquatting
- Typosquatting
- New Top Level Domains
- Like anything else, be careful
Enforcement and Remedies

- May bring lawsuit in federal court
- Money damages
- Injunctions
- Block importation of infringing goods at the US border or port of entry
- Forfeiture and destruction
Contact Information

- Office of Intellectual Property Commercialization and Economic Development
- Twamley Hall, Room 102
- 777-6772
- Michelle Meyer, Marketing and Legal Assistant
- Tara Kopplin, Licensing Assistant
- Jason Jenkins, Patent Attorney
- On the web: www.und.edu/dept/ipcomm
Thank you.
Upcoming U2 Seminars

• Copyright Basics
  – Tuesday, May 11, 9:00 a.m.

• Office of IP Commercialization & Economic Development – What Does it Do
  – Tuesday, June 1, 9:00 a.m.

• Both sessions meet here in Swanson 16-18