Trademark and Unfair Competition Law

Slides 1: Introduction; Trademark Registration Process Overview
Class Outline

• Welcome & Introduction
• Tenets of Trademark Law
• Trademark Legislation
• Policy Justifications
• Overlap with and Distinction from Other IP
• What is a Trademark?
• Establishing trademark rights overview
Interbrand Best Global Brands 2019

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<tr>
<th>Rank</th>
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<th>Change</th>
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2 Tenets of Trademark Law:

(1) Unfair Trade Practices (*a property right)

(2) Consumer Protection
"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."
Current view of Trademark’s dual purposes:

(1) Minimize search costs for consumers/make it easier for them to identify and purchase what they want

(2) Incentivize manufacturers of goods to produce consistently high quality products (as their reputations/goodwill depend on it)
What is a “Trademark”? 

LA §45: “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.”

LA §32 – protects registered marks

LA §43(a) – protects unregistered marks (aka “common law” protection)
Words & Names

Coca-Cola (first used 1887; registered 1892)

Coke (first used 1941; registered 1945)

Diet Coke (first used 1982; registered 1982)
Phrases

• 1929 “The Pause That Refreshes”
• 1938 “The Best Friend Thirst Ever Had”
• 1952 “What You Want Is A Coke”
• 1963 “Things Go Better With Coke”
• 1970 “It's The Real Thing”
• 1982 “Coke Is It!”
• 1987 “You Can't Beat the Real Thing”
• 1993 “Always Coca-Cola”
Images/Symbols/Logos

Coca-Cola’s Graphic Symbol (first used 1968; registered 1977)

**Color:** Coca-Cola Red
Product Packaging/Product Shapes

Coca-Cola Bottle Shape and Trade Dress

First use 1916; registered 1960
Types of Marks

1) Trademark - for sale of goods:

(2) Service mark - for sale of services:
Types of Marks (cont.)

3) Collective mark – identification of cooperative, association:

4) Certification mark – owner permits others to use as sign of quality/origin:
Requirements for TM protection:

1. Trademark must be “distinctive.”
2. Trademark must not be disqualified in some way, e.g., functionality.
3. Trademark must be “used in [interstate] commerce.”
4. Registration recommended, but not required.
Benefits of Federal Registration

1. Secures nationwide priority (a step away from use-based system)
2. Can be used in litigation as prima facie evidence of registrant’s ownership of mark
3. After 5 years, registration can become “incontestable,” resulting in owner’s use of the mark being subject to fewer challenges
4. Registrants can get assistance from U.S. Customs Service in excluding infringing imports
5. Registrants can use ® symbol
The Supplemental Register

• Available for descriptive terms that have not yet been proven to have gained secondary meaning

• Gives no rights in the United States...

• ..but does notify others of use, and may discourage them from adopting identical or similar marks

• And can serve as a basis for pursuing a foreign registration (under the Paris Convention) if foreign country won’t deny on basis of descriptiveness
Paris Convention Art. 6bis

“The countries of the Union undertake . . . to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered . . . to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.”
Filing Bases under the Lanham Act

1. **Section 1(a):** for marks already in use in commerce
2. **Section 1(b):** ITU
3. **Section 44(d):** for marks with a foreign application for registration filed within 6 months prior
4. **Section 44(e):** for marks with existing registration in a foreign jurisdiction
5. **Section 66(a):** for extension of protection under the Madrid Protocol
U.S. APPLICANT/REGISTRANT SEEKING INTERNATIONAL REGISTRATION

FILE OR OBTAIN U.S. TRADEMARK APPLICATION ("BASIC" APPLICATION OR REGISTRATION)

FILE MADRID APPLICATION IN U.S. PATENT AND TRADEMARK OFFICE (USPTO)

USPTO CERTIFIES THAT CONTENT OF MADRID APPLICATION SAME AS BASIC APPLICATION OR REGISTRATION

USPTO SENDS APPLICATION TO WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

WIPO CONFIRMS WHETHER NECESSARY MADRID REQUIREMENTS ARE MET AND NECESSARY FEES ARE PAID (APPLICATION FORMAL?)

NO

WIPO NOTIFIES USPTO THAT APPLICATION INFORMAL (3 MONTH TIME LIMIT TO CORRECT)

YES

MARK LOGGED IN AND PUBLISHED IN WIPO GAZETTE OF INTERNATIONAL MARKS

EXAMINATION PROCESS BEGINS IN EACH DESIGNATED NATIONAL OFFICE

NATIONAL OFFICE ALLOWS MADRID APPLICATION FOR THAT COUNTRY

NATIONAL OFFICE REJECTS MADRID APPLICATION FOR THAT COUNTRY

WIPO ISSUES SINGLE INTERNATIONAL REGISTRATION FOR ALL COUNTRIES ALLOWING MADRID APPLICATION