Trademarks @
Evansdale Library

Evansdale Library at WVU is the only U.S. Patent and Trademark Resource Center in the state of West Virginia.

Provide reference assistance throughout the state.

Trademark ®™ SM

- A word, name, symbol, or device that is used in trade with goods to indicate the source of goods and to distinguish them from the goods of others.
- A service mark is the same as the trademark except that it identifies and distinguishes the source of service rather than a product.

Videos
http://www.uspto.gov/trademarks/process/TMIN.jsp
Topics include
1. "Introduction to the USPTO and Trademark Basics"
2. "Before You File"
3. "Searching"
4. "Applicant Information"
5. "Drawing Issues"
6. "Goods and Services"
7. "Filing Basis Information"
8. "Specimen"
9. "After You File"
10. "Statement of Use"
17. "Counterfeit Goods: What’s the Harm?"

Accessing Trademarks Online
http://www.uspto.gov

Quick Links
Searching U.S. Trademarks September 2017

**TEAS : (Trademark Electronic Application System): Online Filing**

- [Link to TEAS](http://www.uspto.gov/trademarks-getting-started/trademark-basics/teas-nuts-and-bolts-videos)

**TEAS Nuts and Bolts Videos**

- [Link to Nuts and Bolts Videos](http://www.uspto.gov/trademarks-getting-started/trademark-basics/teas-nuts-and-bolts-videos)

**TSDR Trademark Status Database**

- [Link to TSDR](http://tsdr.uspto.gov/)

**Specimens**

- [Link to Specimens](http://tsdr.uspto.gov/)

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Marian G. Armour-Gemmen
Checklist for Specimens

- Is the mark legible on the specimens?
- Does the mark on the specimens match the mark shown on the drawing?
- Do the specimens reflect the goods or services listed in ID?
- Are the specimens an acceptable type? Examples for goods: the goods themselves, packaging, labels, tags, displays associated with the goods.
- Examples for services: advertising, brochures, signs.

http://www.uspto.gov/trademarks/law/ornamental.jsp

Two Registers

- Principal Register
- Supplemental Register

It allows for registration of certain marks that are not eligible for registration on the Principal Register, but are capable of distinguishing an applicant’s goods or services.
- Can use registration symbol
- Marks registered on the Supplemental Register receive protection from conflicting marks and other protections
- excluded from receiving the advantages of certain sections of the Trademark Act of 1946. The excluded sections are listed in 15 U.S.C. §1094.

Getting Started with Trademarks

Components of a Trademark

- Type of Good or Service sold under the proposed Trademark
- Symbol, or word or phrase used
Trademark Manual of Examining Procedure (TMEP)
http://tess2.uspto.gov/tmdb/tmep/

- Review Chapter 1400 for the appropriate class scope notes in order to confirm the terms and classes you have chosen.
- For example, Class 8 (Hand Tools) includes cutlery but not surgical knives, which are in Class 10 (Medical Apparatus), or fencing weapons, which are found in Class 28 (Toys and Sporting Goods).

https://tmidm.uspto.gov/id-master-list-public.html

Additional Search Tips

Coordinated Class Table
- Searches related Goods using the CC command with 3 digit number
- Automatically includes related International Classes in the search results when the primary International Class is searched.
- For example, a search for the International Class 007 utilizing the Coordinated Class index includes results containing any of the following International Class designations: 007, 008, 011, 012, 035, 037, 040, 042, A, B, 200.
- See “Help” when searching TESS.

What makes up a mark?

- Word
- Phrase
- Packaging
- Design
- Symbol
- Color, Sound, Smell

Likelihood of Confusion

Courts have objected to the following marks when used with identical or similar products

- Seycos Seiko® (for watches)
- Cleo Cola Coca Cola®
- S.O. Esso® (petroleum products)
- Toro Rojo Red Bull® (beverages)
- Oral-Angle Oral-B® (toothbrushes)

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Likelihood of Confusion Analysis

“Would customers be likely to mistakenly believe that the foods (or services) come from the same company?”

If “yes” the TM examining attorney will refuse the application

Trademarks compared as to SAM
- Sound Appearance and Meaning

Goods/Services compared to SUM
- Similar in Nature, Use and Marketing
Design Code Manual

Design Code Manual

Design Code Manual

Design Code Manual Tips

Top Search Mistake

Other Common Mistakes

#1 Assuming that you only have to search for **exact spelling** of trademark.

- If there is a registered U.S. trademark of application that is **not spelled exactly the same** but is **similar in Sound, Appearance, or Meaning** and is for related good/services the application will be rejected.

  - Reason: consumers would be confused.

- Include every element of the design.
  - So a bear with balloons would be both
    03.01.14 Bear & 21.01.13 Toy balloons.
  - Image List, just displays images.

- Thinking that the mark will be issued if it is not in the USPTO database.
- Believing that a “dead” trademark record necessarily means that the trademark is available for use by others.
- Forgetting that there are state and common law trademarks that do not appear in the USPTO database.
Trademark Electronic Search System (TESS)

Search Tips:
- Main Truncation tools: * and $
- * can used in front and behind
  - Often search in [bi,ti]
- Hyphens seen as spaces

Additional Search Tips

Using Free Form Advanced Search

Search Techniques

Quotation Marks—Exact Phrase:
“Happy Camper”
  -Retrieves HAPPY CAMPER and BE A HAPPY CAMPER
  -But not CAMPUER HAPPY or HAPPY AS A CAMPER

Boolean Set Operators: And, Or, Not

Additional Search Tips

Fields of BI and TI are often searched.

The Basic Index field contains the word mark and pseudo mark information indexed for optimal searching efficiency.

The search *DOG*[BI] will retrieve marks that have the word segment DOG anywhere in the word mark or pseudo mark.

Alternatively, the search *DOG*[BI, TI] will retrieve the word segment DOG occurring anywhere in the word mark, pseudo mark or translation.

Additional Search Tips: Applying Search Principles

Search Component Parts of individual terms
  - HAPPY CAMPER: *hap*[bi,ti] AND *camp*[bi,ti]
  - WORK AT HOME: *work*[bi,ti] AND *hom*[bi,ti]
  - DUGOUT: *dug*[bi,ti] AND *out*[bi,ti]

Pattern Matching—substituting for class of characters

V All vowels—A, E, I, O, U, Y
    PEN p[vn][bi,ti]
D All decimal digits 0-9
    200(d) [bi,ti] would retrieve years 2000-2009

Additional Search Tips: Applying Search Principles

Number range of characters:

\{v2\} exactly two vowels
\{v:2\} one or two vowels
\{v0:2\} zero, one, or two vowels

So, sl\{v2\}p [bi,ti] retrieves SLEEP, SLEEP, SLEEP

but not SLAP, SLIP, SLEEP
1) Consider this search: 
   "trac"[bi,ti]
Which mark will this search not retrieve?
   a) Track
   b) Attractive
   c) Tractor
   d) Trakshon

2) Consider this search:
   sno$ball[bi,ti]
Which mark will this search not retrieve?
   a) snowball
   b) snoball
   c) Sno ball
   d) Sno-balls

Questions?
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