


WINTHROP WEINSTINE
 ATTORNEYS AND COUNSELLORS AT LAW

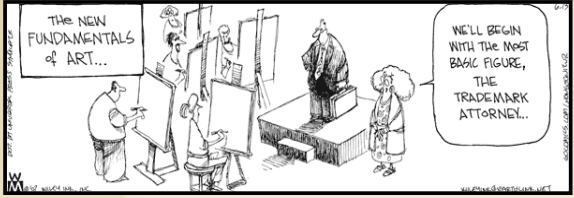
A firm difference.[®]
A flexible approach.

Legal Implications of Branding

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The Need for Early Collaboration Between Marketing and Legal:



So, how do you really feel?

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“Born out of the chasm that can often divide
 legal and marketing types.”
www.DuetsBlog.com

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A Common Marketing Myth

- MYTH:
 - “A brand name is a noun.” “A proper noun that can be used in place of a common word.”
- FACT:
 - Trademark law views a brand as an adjective.
- EXAMPLE:
 - ROLLERBLADE[®] Inline Skates

Source: Al Ries and Laura Ries, “The 22 Immutable Laws of Branding,” pages 5 and 172. Copyright 1998.

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Another Common Marketing Myth

- MYTH:
 - Avoid brand extensions because: “Loss of singularity weakens a brand.”
- FACT:
 - Trademark law rewards brand owners with broader and stronger rights when brands are extended into new categories.
- EXAMPLE:
 - CARIBOU COFFEE[®] Coffee, Ice Cream, Nutrition Bars.

Source: Al Ries and Laura Ries, “The 22 Immutable Laws of Branding,” page 171. Copyright 1998.

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Brands and Trademarks

The Caribou Coffee® Brand



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Brands and Trademarks

What is a Trademark?

- Critical Elements
 - Identifies Goods/Products
 - Distinguishes from Goods/Products of Others
 - Indicates Source of Goods/Products
 - Must Appear on Goods, Attached to Goods, on Containers, or Point-of-Sale Display Materials
- Compare Service Marks

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Brands and Trademarks

How To Create Legal Rights in a Trademark

- Use mark on goods, attached to goods, on containers, or point of sale display materials
- Legal right to exclude extends to the mark owner's geographic area of use and penetration
- Legal right protects against third party uses that create likelihood of confusion among consumers
- Contrast with other forms of intellectual property

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Brands and Trademarks

Likelihood of Confusion Multi-factor Test

- Strength of Mark
- Similarity of Marks (sight, sound, meaning)
- Similarity of Goods/Services
- Channels of Trade
- Actual Confusion
- Intent
- Sophistication of Consumers

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Recognizing Potential Marks

Types of Marks:

- Words
- Symbols
- Combinations of Words and Symbols
- Devices (Non-Traditional Marks)

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Recognizing Potential Marks

Types of Non-Traditional Marks

- Color or Color Combinations
- Product Configurations
- Product Packaging and Containers
- Motions
- Scents
- Tastes
- Retail Environments
- Other Attention-Getting Devices

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Recognizing Potential Marks

Single Color Marks



Post-it
ATAC
Walls That Work
No Matter What

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Datacard® Blue® Card Printer Ribbon Supply Cores



Datacard Group

- Notice is Critical
- "Look For" Ad Copy
- Depict Goods in Color
- Educate Consumers
- Color Combination
- Also Consider Use of "Blue" Word as Trademark

Blue® Cores for use in the Maxsys System

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Recognizing Potential Marks

Sounds

"The mark comprises a sequence of chime-like musical notes which are in the key of C and sound the notes G, B, C, the G being the one just below middle C, and the C being middle C"



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Recognizing Potential Marks

Product Configurations



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Recognizing Potential Marks

Product Containers and Packaging



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Product Configuration or Container?



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Recognizing Potential Marks



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Recognizing Potential Marks

Scent Marks

- Cherry-scented vehicle lubricants
 - Acquired distinctiveness
- Mint-scented medical face masks
 - Inherently distinctive
- Plumeria Blossom-scented yarn
 - Inherently distinctive

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Recognizing Potential Marks

Taste Marks?

- Possible, but none registered yet.
- An Orange Flavor for an oral antidepressant tablet denied.
 - Functional
 - Competitive Need
 - Fails to Function as Mark

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Recognizing Potential Marks

Taste Marks

- What about these?
 - Mint flavored eyeglass tips?
 - Orange flavored ballpoint pen caps?
- Other strategies?

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Recognizing Potential Marks

Retail Environments



Chipotle Mexican Grill Restaurant Interior



Pei Wei Asian Diner Restaurant Interior

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Recognizing Potential Marks

Other Attention-Getting Devices




The mark consists of a formation of light beams resembling the conical framework of a tipi emanating from a circular source of light.

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Recognizing Potential Marks

Implications of Non-Traditional Marks

- Important to avoid limiting creativity in the brands you form – ask whether it makes sense to introduce non-traditional marks
- Important to see potential conflict with third party rights – having a narrow view of trademarks is dangerous during the process of clearing ad copy

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Selecting Strong Marks

Select Strong Trademarks

- Strong Marks Provide a Wider Range of Exclusivity
- Strong Marks are Immediately Protectable
- Distinguish Inherent Strength and Commercial Strength
- Consult Spectrum of Distinctiveness to Determine Inherent Strength

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Selecting Strong Marks

Understand the Spectrum of Distinctiveness

Generic	Descriptive	Suggestive	Arbitrary	Coined Fanciful
Notice (®, SM, TM) CRITICAL		Notice (®, SM, TM) BENEFICIAL		
NO PROTECTION		IMMEDIATE PROTECTION		

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Selecting Strong Marks

The Line Between Suggestive and Descriptive Marks



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Selecting Strong Marks

The Thesaurus is a Copywriter's Friend



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Selecting Strong Marks

Inherently Generic Terms





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Selecting Strong Marks

Victims of Genericide:

- ASPIRIN for analgesic
- ESCALATOR for moving stairs

At Risk?





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Clearing Proposed Trademarks

Why Clear Prospective Trademarks?

- Avoid Disputes with Third Parties
- Avoid Loss of Investment
- Avoid Damage Awards
- Avoid Lost Profit Awards
- Avoid Attorney's Fees Awards
- Pay a Little Now, or Much More Later

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Clearing Proposed Trademarks

Know When to Clear Trademarks

- Before adoption and first use
- Before extending into new product/service lines
- Before licensing to others
- Before modifying/modernizing
- Before extending geographically if no federal registration was obtained
- Before extending use outside U.S.

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Using Trademarks Properly

Use Marks Properly

- Create use guidelines; maintain consistency
- Use notice symbols properly (® ™ SM)
- Use mark as an adjective, not a noun
- Create generic term public will accept
- Don't use mark descriptively in copy
- Never modify to the plural form
- Use marks right or risk losing them!

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Using Trademarks Properly

Brand or Product Category Name?




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Protecting Trademarks

Why Can't a Brand Owner Hide Head in Sand?

- Suffer the consequences of inaction
- Use rights, or risk losing rights

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Clearing Proposed Ads

"Where Else" Litigation

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Clearing Proposed Ads

Lawful Comparative Advertising?

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Clearing Proposed Ads

"Fair Use"?

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Clearing Proposed Ads

"Fair Use"?

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Legal Implications of Branding

Trademark Summary

1. A trademark is a designation of source or origin of a product.
2. In the United States, trademark rights are acquired essentially by use. Registration enhances those rights.
3. The more distinctive a mark, the better the opportunity for legal protection.
4. Trademark searches are generally recommended before commencing use of a trademark whether or not an application is filed for registration.

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Legal Implications of Branding

Trademark Summary

5. The manner in which a trademark is used can significantly affect the scope of protection in the United States.

Generally, marks should be used as an adjective, not as a noun, and be followed by the common descriptive term for the goods or services in connection with which the mark is used.

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Legal Implications of Branding

Trademark Summary

6. The ® symbol cannot be used unless a mark is federally registered in connection with the goods or services with which the mark is used.

The designation "TM" or "SM" may be used in connection with a mark whether or not the mark is federally registered and whether or not an application to register has been filed.

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Legal Implications of Branding

Trademark Summary

7. Use a mark in the form it is registered and for the goods or services specified. Remember that a registration for one class of goods will not necessarily protect the same mark in a different class.
8. Police the use of your trademarks by others, and enforce your rights where necessary.

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Legal Implications of Branding

Trademark Summary

9. The key to trademark infringement is the existence of a likelihood of confusion caused by using a similar mark.
10. In analyzing trademark fair use defenses, each case is unique unto itself and is very fact-specific. Accordingly, relying on such defenses is subject to great risk without legal advice.

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Thank you!



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