

Protecting Your Brand Name in the Growing World Economy

for



Presented by
Edward F. Perlman, Esq.

October 25, 2007

Wolf Greenfield

600 Atlantic Avenue

Boston, Massachusetts 02210

617.646.8000 fax 617.646.8646

wolfgreenfield.com

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Agenda

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- **What is a trademark or brand?**
 - Selecting a legally strong one
- **What is trademark infringement?**
 - How to avoid it
- **What is trademark dilution?**
 - Does it help or hurt you?
- **Where should your brand be protected?**

A Trademark or Service Mark is a...

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- **Word**
- **Name**
- **Symbol**
- **Design**
- **Slogan**
- **Word/design combination**
- **Distinctive sound**
- **Color**
- **Product shape**
- **Scent**

...which identifies and distinguishes goods or services of one manufacturer or service provider from those of another

Examples



that was easy.™

Why Trademarks are Important

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- **Valuable corporate asset**
 - **Used to gain commercial advantage over competitors**
- **Represent quality and provide consumer recognition**
- **Help to maintain reputation among customers and competitors**
- **Represent “Brand Promise”**

Trademark Selection

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- **When selecting a mark, consider:**
 - **Brand promise**
 - What is it and does it promise to distinguish your business from your competitors?
 - **Easily remembered and pronounced**
 - **Foreign equivalents**
 - **Distinctiveness of mark (“selection scale”)**
 - **Is mark legally available for adoption?**

Trademark Selection *(cont)*

FANCIFUL

marks consist of “coined” words—previously unknown

Clorox[®]
Polaroid[®]

Kodak[®]
Xerox[®]

ARBITRARY

marks comprise words, symbols, pictures, etc. in common use but which, when used with the goods or services neither suggest or describe any ingredient, quality, or characteristic of goods or services

- **Ivory[®]** (soap)
- **Apple[®]** (computers)

Trademark Selection *(cont)*

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SUGGESTIVE

marks require imagination, thought and perception to reach a conclusion as to the nature of the goods

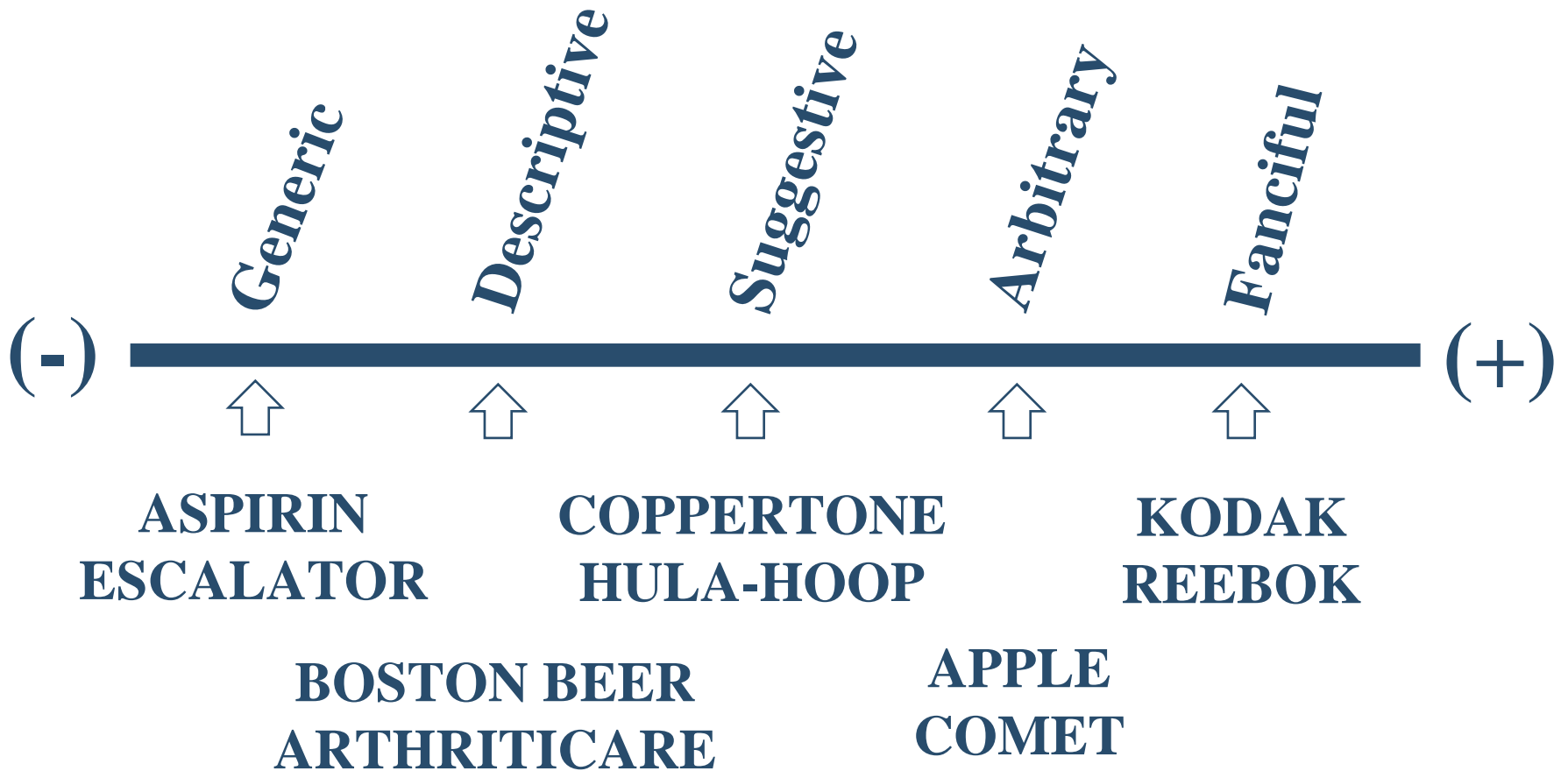
- **360^o™** (athletic footwear)
- **At a Glance™** (calendars)
- **Citi Bank™** (bank)

DESCRIPTIVE

marks are descriptive of the intended purpose, function or use of the goods, the size of the goods, the class of users, etc.

- **Micro™** (wheel weight)
- **Big & Tall™** (men's clothes)
- **Apple Raisin Crisp™** (cereal)

Trademark Selection *(cont)*



Trademark Infringement

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Two Categories

- 1. Intentionally trying to confuse buyers as to the source of the goods**
 - Counterfeits – A false mark that is identical with or substantially indistinguishable from the genuine mark
- 2. Unintentionally cause consumers to be confused as to the source of the goods**
 - “likelihood of confusion” test

Test of Trademark Infringement

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- Whether use is “likely to cause confusion or to cause mistake or to deceive” (15 U.S.C. 1114)
- **Probability**, not possibility of confusion, mistake, or deception

Test of Trademark Infringement *(cont)*

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- **13 DuPont Factors**

- *In Re E.I. DuPont de Nemours & Co.* 476F.2d 1357 (e.c.P.A. 1973)

- Sound, means, and appearance
 - Similarity of goods
 - Similarity of channels of trade
 - Conditions of purchase—impulse vs. sophisticated purchaser
 - Fame of prior mark
 - Similar marks—crowded field
 - Actual confusion?

Confusingly Similar Marks

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mattress

Beauty-Rest v. **Beauty Sleep**

nuts

Beer Nuts v. **Brew Nuts**

wine

Blue Nun v. **Blue Angel**

raincoats

London Fog v. **Smog**

furniture wax

Pledge v. **Promise**

fabric softener/liquid detergent

Rain Barrel v. **Rain Fresh**

Not Confusingly Similar Marks

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after sun lotion

After Tan

v.

Apres Sun

nuts

Beer Nuts

v.

Schnaps

detergent

Dawn

v.

Day Light

restaurant

Hard Rock Café

v.

Country Rock Cafe

cleaning product/services

Mr. Clean

v.

Masterful Kleen

What If...

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- **You own a famous mark and someone uses it for very different goods in very different channels of trade**
 - **No likelihood of confusion**
 - **NO TRADEMARK INFRINGEMENT!!**
 - **What can you do?**

Trademark Dilution

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- **OLD standard:**
 - *Cause dilution of distinctive quality of famous mark*
- **NEW standard:**
 - *Likely to cause dilution by blurring or tarnishment of famous mark, regardless of:*
 - Actual or likely confusion
 - Competition
 - Economic injury

Dilution by Blurring

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- **Association due to similarity between mark or trade name and famous mark that impairs distinctiveness of famous mark**
 - Degree of similarity
 - Degree of distinctiveness
 - Exclusivity of use
 - Degree of recognition
 - Intent of defendant to create association
 - Any actual association

Dilution by Tarnishment

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- **Association due to similarity between mark or trade name and famous mark that harms reputation or famous mark**
 - **Ex: On May 31, 2007, the automaker Lexus SUED LexusCash.com (adult website)**

Must be Famous

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- **“Widely recognized by general consuming public as designation of source of goods or services of mark’s owner”**
 - Advertising
 - Sales
 - Actual recognition
 - Federal registration

Must be Distinctive

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- **Inherent or acquired distinctiveness**
- **No descriptive and surname marks**

Exclusions Based on Free Speech

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- **Fair use**
 - **Comparative advertisements**
 - **Identifying and parodying, criticizing, or commenting upon owner of famous mark or its goods/services**
- **News reporting and news commentary**
- **Noncommercial use of mark**

Relief Available

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- **Injunctive relief**
- **Damages – if two requirements met:**
 - **Use after TDRA's enactment (Oct. 6, 2006)**
 - **Willfulness**
 - Trading on recognition (for blurring)
 - Harming reputation (for tarnishment)
- **Valid registration is complete bar to dilution claim**

Foreign Trademarks

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- **First-to-File countries**
- **Use not required in all countries**
- **Registration = rights in many countries**
- **10 year renewals**
- **Hot Countries**
 - **Canada**
 - **Europe**
 - **China!!**

International Filing Issues

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- **Where to file?**
 - **Manufacturing countries**
 - **Competitor countries**
 - **Present markets**
 - **Future markets**

International Filing Issues *(cont)*

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- **When to file?**
 - **Anytime**
 - The sooner, the better!
 - **Typically within six months of U.S. Trademark Filing**
 - Paris Convention

Conclusion

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- **Select a strong mark**
- **Avoid confusion with other marks**
- **Famous mark = broader rights**
- **Obtain foreign rights**

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