

Intellectual Property Seminar Level Two: TRADEMARKS

WHAT IS IT? HOW DOES IT WORK? WHAT IS INFRINGEMENT?



Gary Con XIV—24Mar22

Hibbs Law, LLC

Genna Hibbs & Emily Mosnick



- ▲ Intellectual Property boutique firm **founded in 2013**
- ▲ **Bar Admissions:** Illinois, US Northern District IL, US Patents & Trade Office
- ▲ **Focus Areas:** Patents, Trademarks, Copyrights, Unfair Competition, Trade Secrets, Infringement Enforcement/Litigation, Licensing, Entity Formation, Regulatory Compliance, and Business Transactions.
- ▲ **Clientele:** Small business, medium corporations, individuals
- ▲ **Expertise**
 - ▲ **Genna:** Biotechnology, Genetics, Small Business, Government,
 - ▲ **Emily:** Regulatory, International Law, Trademark, Copyright, Privacy
- ▲ **Gaming Experience:**
 - ▲ **Genna:** TTRPG, MTG, WH40K, FPS
 - ▲ **Emily:** Browser-based RPG games
- ▲ Substantial dedication to **pro bono** legal services (20-30% of time)



Legal Disclaimer



- ▲ **Nothing** in this presentation is meant to imply or suggest that an attorney-client relationship is created through this presentation or related communications.
- ▲ After a private initial client meeting, a signed **letter of engagement** would be the official step to create that relationship with Hibbs Law, LLC
- ▲ Legal analysis is largely fact-based and involves a full examination of all details and factors. **General rules** presented, or questions asked and answered, are posed as hypotheticals, and should not be relied on as legal advice. The most common answer to a ‘simple’ legal question is: “It depends.”



ROADMAP

- ▶ 1. What is a Trademark?
- ▶ 2. How do Trademark rights work?
- ▶ 3. What is Trademark infringement?



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1. What is a Trademark?

- ▶ Trademark common law origins and statutory policy basis in CONSUMER PROTECTION
 - ▶ Brand loyalty
 - ▶ Expected quality
- ▶ Trademark is the goodwill identifier that the public associates with YOU as the source of origin of your product/service.
 - ▶ Rights are based on USE, IN COMMERCE
 - ▶ Source of origin ≠ goods/services
- ▶ Balance trademark rights with 1st Amendment Free Speech (FAIR USE: Nominative and Descriptive) and Functionality.

Many things can be a protectable trademark, not just words and logos.

Colors

Sounds

Smells

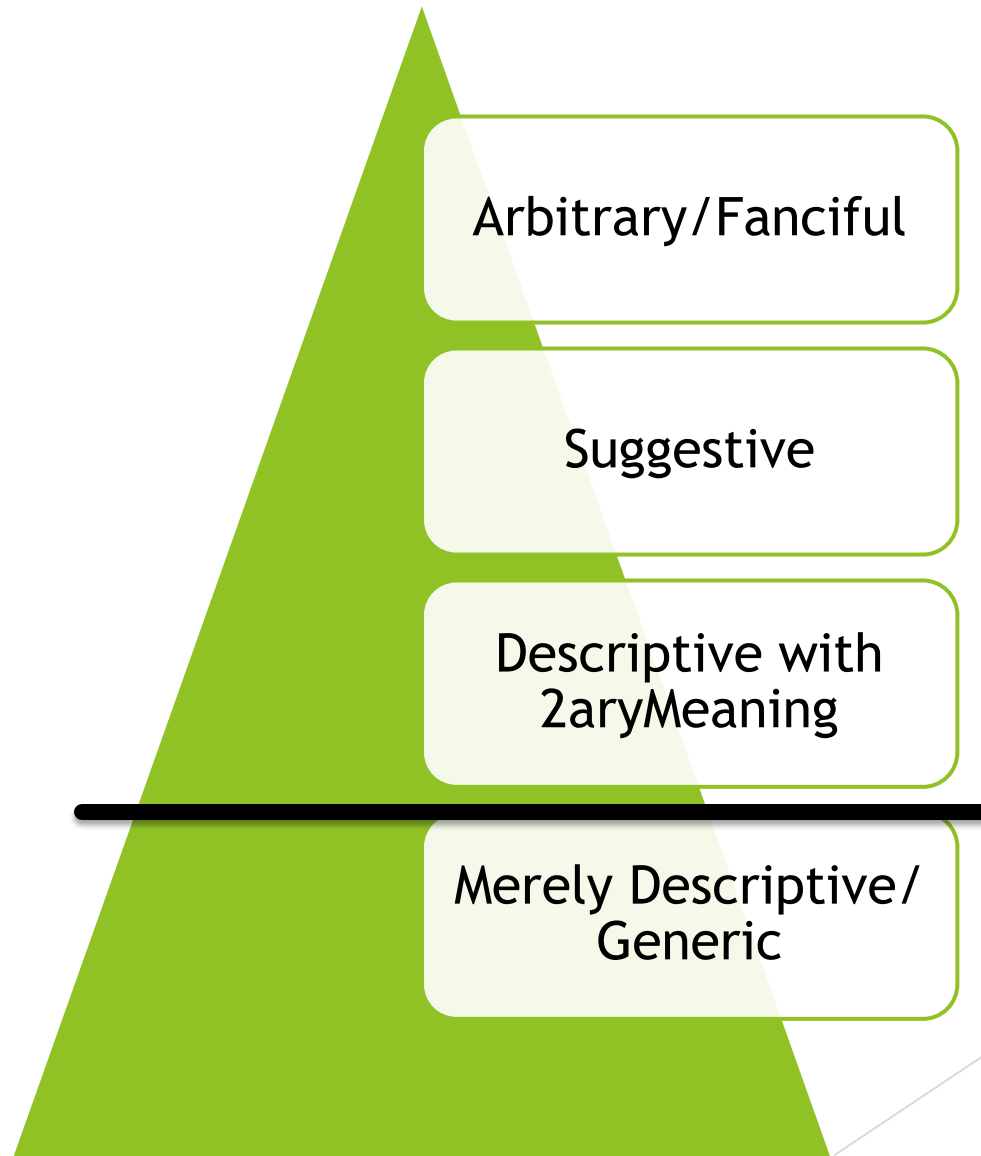
Interior
decorating

Package
design

A Trademark's strength is based on time, market, and **DISTINCTIVENESS**

Important for choosing your brand/trademark.

Secondary Meaning: primary source in public's mind; time and market strength factors can bolster a descriptive mark into protectability; presumed after 5yrs (incontestability)



ARBITRARY or FANCIFUL



SUGGESTIVE

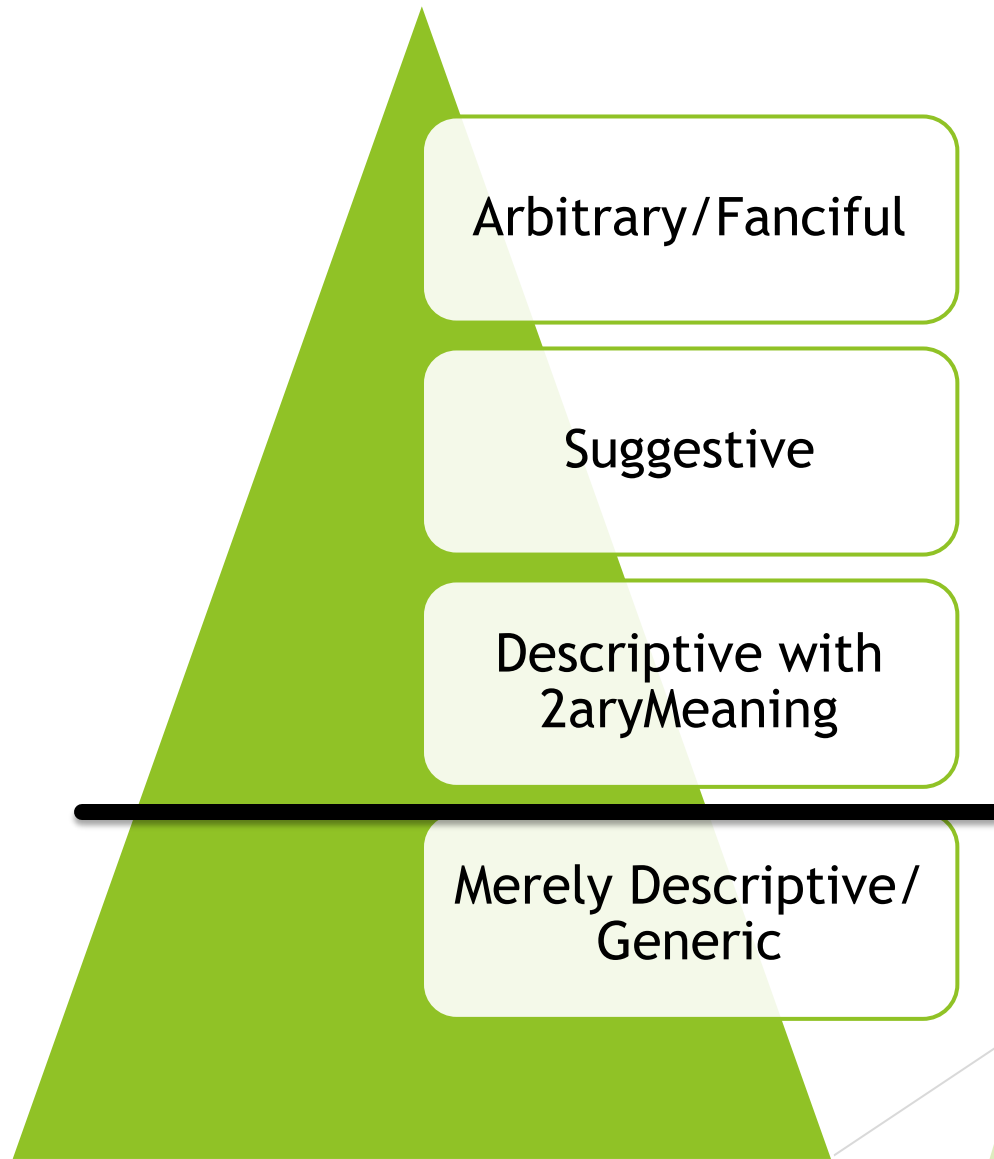


DESCRIPTIVE



Descriptive Marks Require Secondary Meaning:

primary source in public's mind; time and market strength factors can bolster a descriptive mark into protectability; presumed after 5yrs of use.



GENERIC

A Great New Escalator

AT A NEW LOW PRICE!



WIDE ENOUGH for adult and child—or traveler and baggage. The new Escalator carries 5000 people an hour comfortably. It is designed for any vertical rise up to 111 feet.

It's big in capacity throughout

HERE NOW—the first Escalator designed especially for the medium-sized and smaller building. The result of many years' research, this new Escalator has all the time-tested features of earlier models, plus a wealth of post-war design features... it is truly the last word in Escalator design.

Capable of carrying 5000 people an hour, it handles more persons per dollar investment than any other moving stairway. Wide enough to comfortably carry an adult and child on one step, it is the ideal size for most stores, stations, plants, banks and other public buildings. Yet for all its spaciousness, it requires less space and structural work than narrower moving stairways.

Best of all there has been no compromise with quality. In eye-appeal, in safety, in the inherent ruggedness that makes for long life and low upkeep, it is the equal of any Escalator we ever built. And remember, only Otis makes Escalators.

NEW FREE BULLETIN B-700T tells the whole story. Write for your copy to Otis Elevator Company, 260 Eleventh Avenue, New York 1, N. Y.

SAFETY FEATURES include narrow-gage metal treads, semi-circular extended nosing, continuous slip-proof rubber hand rails... the world's safest transportation.



A LIFETIME OF BEAUTY. The modern Escalator's graceful lines and gleaming aluminum balustrade combine to give buildings the New Look in level-to-level travel.

"Escalator" is a U. S. Patent Office registered trademark of the Otis Elevator Company. Only Otis makes Escalators.



OTIS ELEVATOR COMPANY

Offices in All Principal Cities

THERMOS

DRY ICE

A Trademark's strength is based on time, market, and DISTINCTIVENESS.



1st Amendment,
Free Speech.
Competitors ought to be allowed to describe their own goods/services and to distinguish from the competition clearly.



Arbitrary/Fanciful

Suggestive

Descriptive with secondary meaning

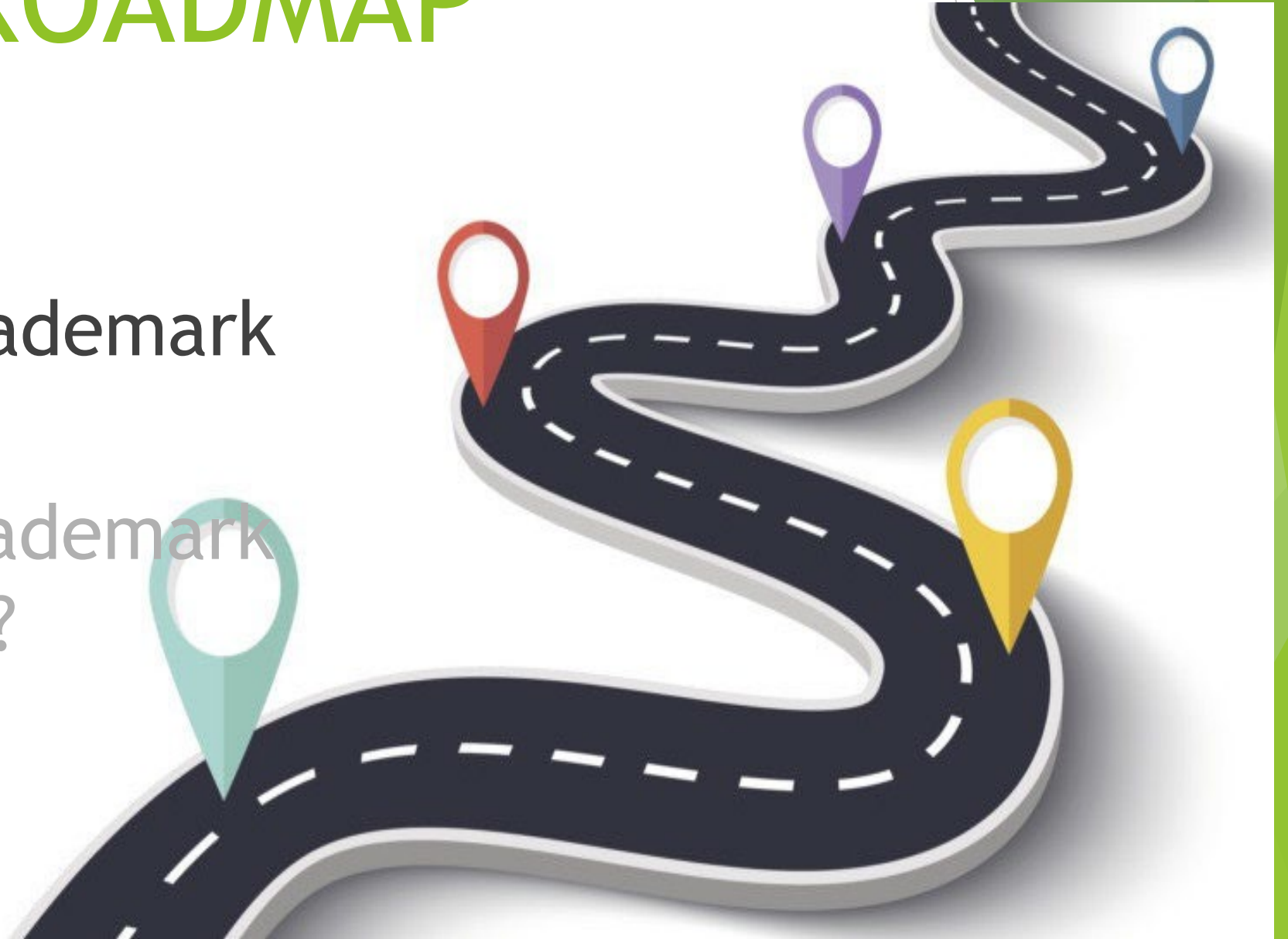
Merely descriptive/generic



DRY ICE

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2. How do trademark rights work?

Common Law @ court,
§43(a)

- ▶ Starts when you begin to use your mark,
- ▶ Limited to your geographic area and reasonable expansion (gets fuzzy with internet).
- ▶ Use™ to identify common law TMs.

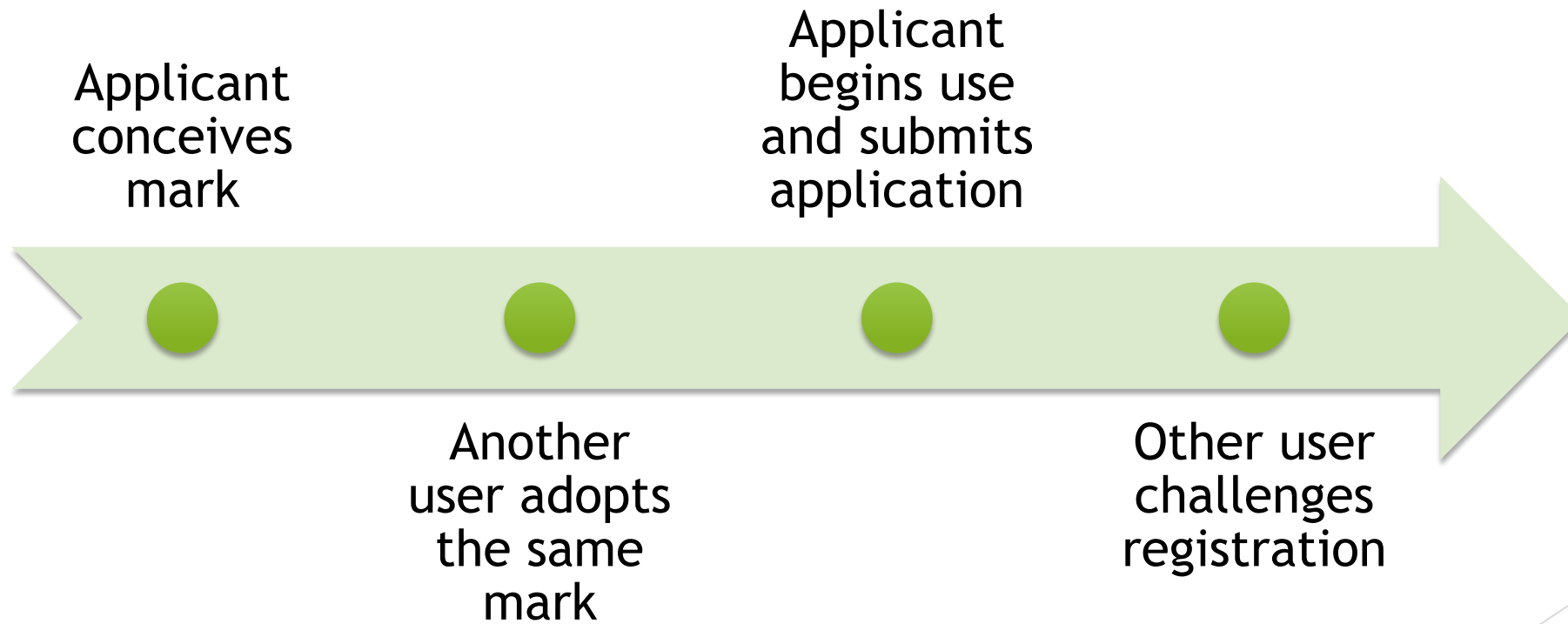
Federal registration @ USPTO,
§1(a)/§1(b)

- ▶ Once registered, provides nation-wide protection from the filing date against all junior users.
- ▶ USPTO registration can be extended internationally (1yr priority deadline for filing date).
- ▶ Use ® to identify registered TMs.

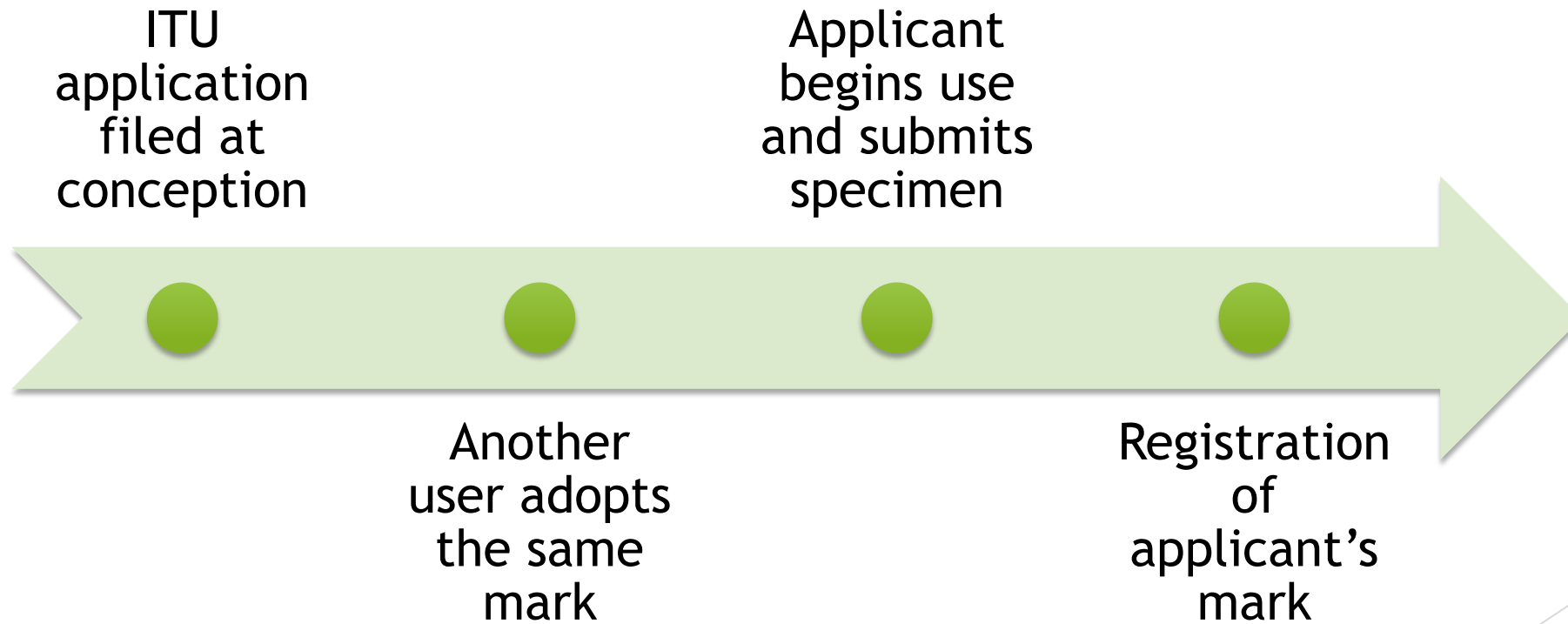
USPTO Registration, general overview

Before

Priority: Junior and Senior users, §1(a)



Priority: Junior and Senior users, §1(b)



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3. What is Infringement?

- ▶ Likelihood of Confusion: is there a likelihood that a potential consumer would be confused as to the source of origin?

3. What is Infringement?

- ▶ LoC Factors Analysis:
 - ▶ Similarity of marks
 - ▶ Similarity of goods/services
 - ▶ Sophistication of consumers
 - ▶ Strength of mark
 - ▶ Length and market of use
 - ▶ Willfulness to infringe by junior user
 - ▶ Actual confusion

Infringing or Non-infringing?

Mrs. Fields[®]

Marshall Field's

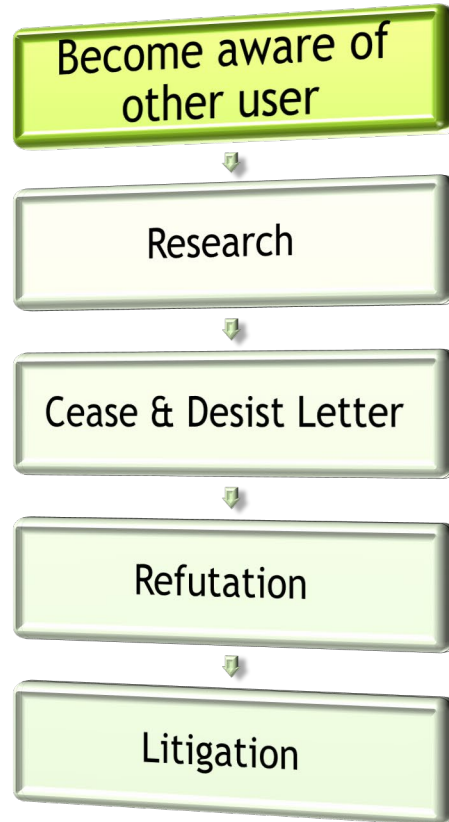
Non-infringing! Goods and services
too dissimilar.

Mrs. Fields[®]

Marshall Field's

The Enforcement Process:

Full-Tilt



Small Steps



Other side



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QUESTIONS?



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