

Branding and Trademarks

HOW TO ROUND UP YOUR
COMPETITION AND KEEP YOUR
HERD OF CUSTOMERS ON THE
RANCH

BY CLARK & BELLAMY, P.C.



Brian Bellamy
ClarkandBellamy.com

CONTENTS

How to round up your competition and keep your herd of customers on the ranch	1
by Clark & Bellamy, P.C.	1
Should you DEVELOP a brand?	3
Creating a brand is an important step to creating a business identity	3
How to develop a brand?	3
What is a trademark?.....	4
A Trademark Can be a Word, Phrase, Symbol, Design or Combination Thereof	4
Using trademark symbols	4
Do I Need to Register My Trademark?	5
So the short answer is YES. You should register your trademark.	6
How to choose a good trademark.....	6
STRONGEST: Fanciful Marks	6
Very strong: arbitrary marks	6
Strong: Suggestive Marks	7
Weak: Descriptive Marks	7
PROHIBITED: GENERIC MARKS	7
How to register a trademark	8
Search before USING OR REGISTERING a trademark for your brand	8
How to file a trademark application electronically	9
How to check the status of your filed trademark application	14

SHOULD YOU DEVELOP A BRAND?

Creating a brand is an important step to creating a business identity

Here are several reasons why you should consider creating a brand for your web-based business:

- 1) a brand identifies who you are to the customer and helps develop a long-term relationship
- 2) a brand provides a source of connection and loyalty for your customer
- 3) a brand builds trust and value for the company, as customers are willing to forsake the best deal to do business with a trusted brand



Consider the value of brands in your life and think about how you can create that same type of value in the eyes of your customers. For example, do you have a favorite brand such as Starbucks or Coca-Cola. Even though the products of these brands are much more expensive than competing generic or off-brands, we are often willing to pay more and buy more because of our trust or emotional bond with that brand. So, next time you buy an expensive cup of coffee, think about how you can create a brand relationship with your customer.

HOW TO DEVELOP A BRAND?

First, to create an effective brand, you must first define your brand according to your VPP (Valuable Pre-selling Proposition). Second, define your brand according to your target audience. You should develop your brand in a way that will appeal to the interests of your audience. If you are selling juggling equipment for instance, you would not want to develop a brand that is formal and stiff. Instead, you would want your brand to convey fun, while still being authoritative.

Once you have defined your brand, you should consider how to promote and build brand recognition. Consider using your brand in all of your marketing communications including your website, email, newsletters, business cards, customer service interactions, product packaging, ebook covers, and anything that helps to establish your reputation and connect with your audience.

As you determine your brand and begin to develop it, consider making it stand out even more by adding a trademark or service mark to your brand.

WHAT IS A TRADEMARK?

A trademark is different than a brand in that your brand represents much more than just a mark. Overall, your brand may be very similar to a competitor's. You may even choose to model the personality of your brand after another successful company. Nevertheless, you will want to distinguish your brand to avoid confusion and differentiate yourself in the marketplace. This is where a trademark can be important as a potentially very important part (but only a part) of your overall branding strategy.

A Trademark Can be a Word, Phrase, Symbol, Design or Combination Thereof

A trademark by definition identifies a source of products or services and distinguishes the source from another. Thus, a trademark can become a vital intellectual property asset of the business, as it is what consumers will use to identify your products and services amongst the crowd, return for more, and spread your brand to others.

USING TRADEMARK SYMBOLS

The various designation symbols used for trademarks are used to alert the public of your claim to a mark. When you do not have a federally registered mark, but you do want to protect a trademark to distinguish yourself, then you should use the TM or SM symbols. In the example of DEERCON, the mark became registered and may now use the ® symbol. However, until then, the product was marketed using the TM symbol as shown.



- ✓ Use the TM symbol is used for marks that relate to products (also known as goods).
- ✓ Use the SM symbol is used for marks that are used only in connection with services.

- ✓ Use the ® symbol when you have a trademark registered with the United States Patent and Trademark Office – use only in connection with the goods/services listed in the registration.

DO I NEED TO REGISTER MY TRADEMARK?

The screenshot shows the USPTO Trademarks Home page. At the top, there is a search bar and a navigation menu. The 'Trademarks' section is highlighted. Below the navigation, there is a 'Trademarks Home' section with a welcome message and a list of links for various trademark services. The 'Mission' section is also visible, stating the USPTO's mission to apply the statute in the examination and registration of trademarks.

You do not have to register a trademark with the government to establish your rights. In fact, you can use a mark in commerce on the local, state or national level and develop some rights to a trademark within your geographic region of business.

HOWEVER, REGISTRATION OF A TRADEMARK ON A NATION'S OFFICIAL REGISTER DOES CONFER MANY BENEFITS. IN THE UNITED STATES THESE BENEFITS INCLUDE THE FOLLOWING:

- ✓ Registration provides constructive notice to the public and listing in the U.S. Patent and Trademark Office database. This reason alone is sufficient for registration, as it will deter many from choosing a confusing name and causing future conflicts. Without registration, it is much more difficult for others to identify your trademark among the masses of other businesses.
- ✓ Registration with the USPTO provides you with a legal presumption of ownership because the trademark has been evaluated and approved by a trademark examining attorney.
- ✓ Registration prevents you from encountering geographic restrictions to your state or locale by establishing your right to use the mark nationwide with the connected goods/services.
- ✓ Registration gives you greater ability to sue for infringement in federal court.
- ✓ Registration entitles you to use of the U.S. federal registration to obtain registration and protection in foreign countries.

- ✓ Registration gives you the ability to use U.S. customs to prevent importation of infringing goods from overseas.
- ✓ Registration enhances your potential for recovery of punitive damages and attorney fees if your mark is infringed and you must litigate.
- ✓ Registration makes it possible for your trademark to become incontestable as a valid registered federal trademark after five years.
- ✓ Registration of a trademark enhances domain name protection for website owners because of additional enforcement tools provided by domain registrars. In other words, you are better able to prevent others from cyber-squatting with respect to your trademark or using your reputation and trademark in a domain name to market competing products.
- ✓ Registration of a trademark gives you greater possible protection by search engines from other companies using your trademark for advertising.

SO THE SHORT ANSWER IS YES. YOU SHOULD REGISTER YOUR TRADEMARK.

HOW TO CHOOSE A GOOD TRADEMARK

To choose a good trademark, you need to understand the different categories of marks as classified by U.S. law. The five types of marks are: fanciful, arbitrary, suggestive, descriptive, and generic. These are listed in order of best to worst.

STRONGEST: FANCIFUL *MARKS*

Fanciful marks consist of one or more made up words. Examples of fanciful marks include Exxon, Kodak, and Xerox. These marks are strongest because they have no meaning at all outside of the related product or service. Thus, when a consumer uses a fanciful mark to identify the source of a product or service, there is no opportunity for confusion.

VERY STRONG: ARBITRARY *MARKS*

Arbitrary marks consist of real words that have nothing to do with the product or service. Examples of arbitrary marks include Apple (computers), Amazon (books), and Google (internet search). These marks are very strong because they have no meaning with respect to the product or service. Therefore, when the consumer connects an arbitrary mark to identify of a source of a product or service, there is little opportunity for confusion within the scope of commerce in which the mark is used.

STRONG: SUGGESTIVE MARKS

Suggestive marks consist of real words that have little to do with the product or service other than to suggest a quality of the company's products or services that people would look for. Examples of suggestive marks include Citibank, Playboy, and Greyhound. Consider how Greyhound has the suggestion of speed, which connotes a positive attribute of this bus service. These suggestive marks are strong because they do not use words that normally describe the product or service. Therefore, the consumer is able to make a strong connection between the mark and the product or service. Suggestive marks are popular because they often are believed to help establish a positive association between the public mind and a quality of the company.

WEAK: DESCRIPTIVE MARKS

Descriptive marks are weak because they merely describe some portion of the goods and services being sold. It is commonly more difficult to get a descriptive mark registered with the U.S. Patent and Trademark Office. Descriptive trademarks must acquire secondary meaning to have strong protection, which requires 5 years or more of use and advertising. Secondary meaning pertains to the association of the public with the particular goods or services of the mark's owner.

In some ways it is easier to market using a descriptive mark because these marks describe the product or service. But, bear in mind the difference between marketing with a trademark versus secondary meaning, wherein the consumer recognizes the source of those goods and services being marketed.

Descriptive marks are usually less valuable and afforded less protection because of the many related trademarks that already exist with similar appearance or sound. Examples of descriptive service marks include: VISION CENTER, WELLNESS VISION, and VISION REJUVENATION.

PROHIBITED: GENERIC MARKS

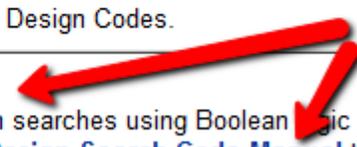
Generic marks are incapable of being trademarks by law. While generic words are good for domain names, they cannot function as a trademark. The term generic trademark refers to common names that the relevant purchasing public understands primarily as describing the genus [category] of goods or services being sold. Examples of such generic words would include the word COMPUTER for identifying the source of a computers or computer services, or the word book for identifying a business selling books.

If you want your domain name to be legally protectable as a trademark, do not use generic terms. Instead, the domain name must be inherently distinctive by using one of the other categories of trademarks listed above. One good strategy to consider is combining a generic domain name with a trademark used on the website as part of your brand.

SEARCH BEFORE USING OR REGISTERING A TRADEMARK FOR YOUR BRAND

Start your trademark search at the top by using the database of federally registered marks maintained by the U.S. Patent and Trademark Office. Find the database at www.uspto.gov and use the advanced search features to broaden your search and find any mark that might be considered confusing and similar to your choice of marks.

Select A Search Option	
▶ Basic Word Mark Search (New User)	This option cannot be used to search design marks.
▶ Word and/or Design Mark Search (Structured)	This option is used to search word and/or design marks. NOTE: You must first use the Design Search Code Manual to look up the relevant Design Codes.
▶ Word and/or Design Mark Search (Free Form)	This option allows you to construct word and/or design searches using Boolean logic and multiple search fields. NOTE: You must first use the Design Search Code Manual to look up the relevant Design Codes.



Doing a comprehensive and informative search is not easy and will take some development and honing of your search skills. Use the online help at the Trademark Office to understand how to use the different fields and search techniques. Use design codes to search for stylized marks or marks that include graphical features.

Before investing too much money in a trademark, you should consider hiring a professional. You might consider our services at www.clarkandbellamy.com or www.trademarkapplicationhq.com. The law concerning likelihood of confusion between trademarks is very complex and has many nuances that entire treatises are written about. At the very least, understand how a trademark can infringe on another mark by being confusingly similar, not just identical. Famous marks are given even broader protection than other trademarks.

While researching your proposed trademark selection, [it is also wise to search state registrations, trade names, and common law marks using state databases, brand databases, and search engines](#). Prior use of a mark in commerce does establish rights even without registration; therefore someone can oppose registration of your mark, or later seek cancellation of your mark, even if they do not have a registered mark.

Ultimately, you will want to choose a mark that is not going to infringe or dilute another trademark, which can lead to problems down the road. Besides being asked to stop using your mark by someone else, you will be investing in building a brand. Your brand becomes more valuable overtime, and the last thing you want to do is have to start over with the development of brand recognition and loyalty. The recent acquisition of SKYPE®

by MICROSOFT® for over \$8 billion is a good example of brand value, considering the MICROSOFT® already has technology like that owned by SKYPE® and did not need the company for its technology.

Frankly, very few lay people properly understand how to assess their trademark search results. Usually, when things work out well for a lay person filing for registration of a mark pro se, it is a result of some degree of luck. Take your time to study this topic of trademark search thoroughly, or else consider hiring a professional to conduct the search and let an attorney give you an opinion on the results, especially if you plan to invest much time and money prior to federal registration of your chose trademark.

Following is an example of how to file a U.S. trademark application electronically using the internet if you want to Do It Yourself (DIY).

HOW TO FILE A TRADEMARK APPLICATION ELECTRONICALLY

First, go to www.uspto.gov.

If you are ready to file your trademark application, click on item #3 [File Forms Online](#).

The image shows a screenshot of the USPTO website's main navigation area, divided into three columns. The 'Patents' column lists various services like 'Patents Process', 'Search', 'View Fee Schedule', 'File Online', 'Check Status', 'Maintain/Pay Fees', 'Appeal', 'Assignments', 'Electronic Business Center', 'Patent Prosecution Highway', and 'Ombudsman Pilot Program'. The 'Trademarks' column lists 'Trademark Basics: Start Here', 'Search Marks', 'File Forms Online' (highlighted with a red arrow), 'Check Status', 'View and/or Order Documents', 'Maintain/Renew a Registration', 'View Fee Schedule', 'Trademark Trial and Appeal Board', 'Assignments', 'Madrid Protocol', and 'Trademark User Feedback'. The 'IP Law & Policy' column lists 'IP Policy and Enforcement', 'Training and Education', 'Office of the General Counsel', 'Interested in Copyrights?', 'Protecting Intellectual Property', and 'Rulemaking'. Each column has a 'More about' link at the bottom.

Patents	Trademarks	IP Law & Policy
<ul style="list-style-type: none">1 Patents Process Visit the Patents Process page2 Search Search patent databases3 View Fee Schedule Check on the current fees and information related to the patent process4 File Online Apply for a patent using the Electronic Filing System (EFS-Web)5 Check Status Check the status via the Patent Application Information Retrieval (PAIR) system6 Maintain/Pay Fees Pay your maintenance fees7 Appeal Learn the appeal process via the Board of Patent Appeals and Interferences (BPAI)8 Assignments Visit the Assignments Homepage9 Electronic Business Center Get web application links & help via the Electronic Business Center (EBC)10 Patent Prosecution Highway11 Ombudsman Pilot Program <p>» More about Patents</p>	<ul style="list-style-type: none">1 Trademark Basics: Start Here View How-To Videos; FAQs; Basic Facts Booklet; Processing Timelines; ID Manual; TMEP2 Search Marks Search pending and registered marks (EPCAS)3 File Forms Online File application and other documents online (TEAS)4 Check Status Check the status of an application or registration (TARR)5 View and/or Order Documents View and download application and registration records (TDR) and/or order certified copies6 Maintain/Renew a Registration File documents to keep a registration active7 View Fee Schedule Check the current trademark fees and other fee-related information8 Trademark Trial and Appeal Board Visit TTAB Home Page9 Assignments Visit Assignments Home Page10 Madrid Protocol11 Trademark User Feedback <p>» More about Trademarks</p>	<ul style="list-style-type: none">1 IP Policy and Enforcement USPTO leads efforts to develop and strengthen both domestic and international IP protection2 Training and Education The Global IP Academy (GIPA) offers IP related programs around the world3 Office of the General Counsel General Counsel, Office of the Solicitor, Office of General Law, Office of Enrollment and Discipline4 Interested in Copyrights? The USPTO advises the Administration on copyright protection and policy5 Protecting Intellectual Property Strategy Targeting Organized Piracy (STOP!) helps businesses protect their IP at home and abroad6 Rulemaking The USPTO continues to propose new initiatives to make its operations more efficient <p>» More about IP Law & Policy</p>

On the next page, click on [Initial Application Form](#).

Trademark Electronic Application System (TEAS)

WARNINGS

LEGAL PROCEEDING: Filing a trademark application requires you to satisfy many legal requirements within strict time deadlines, all based on [Eastern Standard Time](#).

ALL DATA PUBLIC: All trademark information you submit in the electronic forms will become public record and will be viewable by the public in the USPTO's on-line databases and through search engines and other trademark databases, including your phone number, e-mail address, and street address. Also, to maintain confidentiality of banking or credit card information, **only** enter payment information in the secure portion of the site after validating your form. For any trademark information that may be subject to copyright protection, by submitting it to the USPTO, the applicant is representing that the applicant has the authority to grant, and is granting, the USPTO permission to make the information available in its on-line database and in copies of the application or registration record.

UPLOAD SCHEDULE: Most filings made through TEAS are uploaded into the USPTO's Trademark Document Retrieval (TDR) system within 4-5 calendar days. If that amount of time has passed and your filing is still not appearing, please e-mail TDR@uspto.gov.

Scroll over category headings to view list of all forms within a specific category or click top heading of "FORMS," below, to access index. Click category heading to access page to select specific form.

[FORMS](#)

1. [INITIAL APPLICATION FORM](#)

To apply for a trademark/servicemark, or other type of mark

BEFORE FILING (GENERAL INFORMATION): First-time filers should go to "[Trademark Basics: Start Here](#)" before opening the application form, to review important information such as how-to videos, processing timelines, and FAQs.

BEFORE FILING (SPECIFIC CONSIDERATIONS FOR ELECTRONIC SUBMISSIONS AND COMMUNICATIONS): Review information focusing on [electronic matters](#).

2. [RESPONSE FORMS](#)

To respond to: a Law Office examining attorney letter (an "Office action") (a non-final or final action, including a suspension inquiry/letter of suspension or a request to submit a "substitute form" where the wrong form type was initially filed); an Intent-to-Use Unit (ITU) Office action; a Post-Registration Division Office action; a Petitions Office letter

Now, you are almost ready to start filling in your information for the application. But first, you must decide what trademark application form you are going to use. The selection depends on whether you plan to select the listing of goods and/or services for your application directly from the USPTO's [Acceptable Identification of Goods and Services Manual](#).

You may list more than one identification of goods or services. But, if you list goods or services that fall into more than one international class, then you will be required to pay additional filing fees. There is a filing fee

with the USPTO for every class that you include in your application. Most applications are limited to one or two classes of goods. I have selected an identification of services that happens to fall into class 35.

I prefer the TEAS Plus form in most cases because the filing fees are \$50 less. Plus, by selecting my goods and services from the USPTO's manual, I am reassured that the USPTO is going to accept my identification of goods.

TEAS Plus Form

This form has a lower filing fee of \$275 per class of goods and/or services, but has **stricter** requirements, than the TEAS form. Select this option **ONLY** if you agree to:

- file a "complete" application. Almost all fields in this form are mandatory;
- select the listing of goods and/or services for this application directly from the USPTO's [Acceptable Identification of Goods and Services Manual](#). While certain listings permit "[customization](#)," total "free-text" entries for identifications cannot be made; **NOTE:** You should confirm that your identification(s) appear in the Manual by using the link, *above*, **BEFORE** entering the TEAS Plus form. If the term(s) does not appear, you may request that an identification be added by e-mailing TMIDSUGGEST@uspto.gov; however, you could not file immediately. For more information on this process, click [here](#).
- pay the fees for **all** classes at the time of filing;
- file certain later communications regarding the application, such as a Response to an Office action, through TEAS; and
- receive all communications concerning the application by e-mail during the pendency of the application.

NOTE: If you use TEAS Plus, you must pay an additional fee of \$50 per class if at any time during the examination of the application the USPTO determines that (1) the application did not meet the TEAS Plus requirements as of the filing date; (2) you file a paper form after the initial application when a TEAS form exists for that purpose (*e.g.*, a Response to an Office action); and/or (3) you refuse to receive correspondence from the USPTO by e-mail during the pendency of the application.

TEAS Form

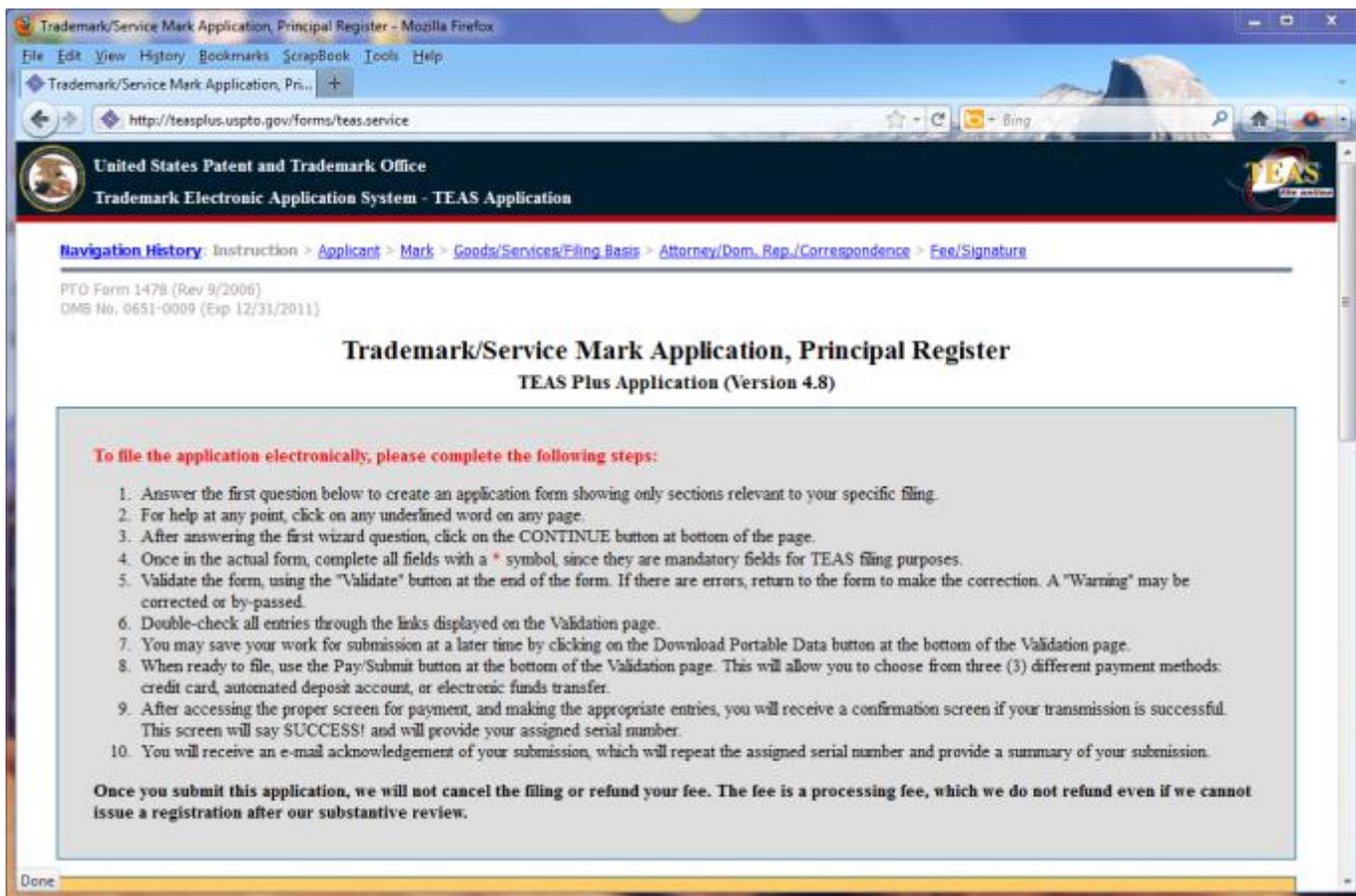
Select this option, having a filing fee of \$325 per class of goods and/or services, if you cannot satisfy the TEAS Plus requirements, as outlined above.

Once you select your form preference, you are ready to start filling in the application.

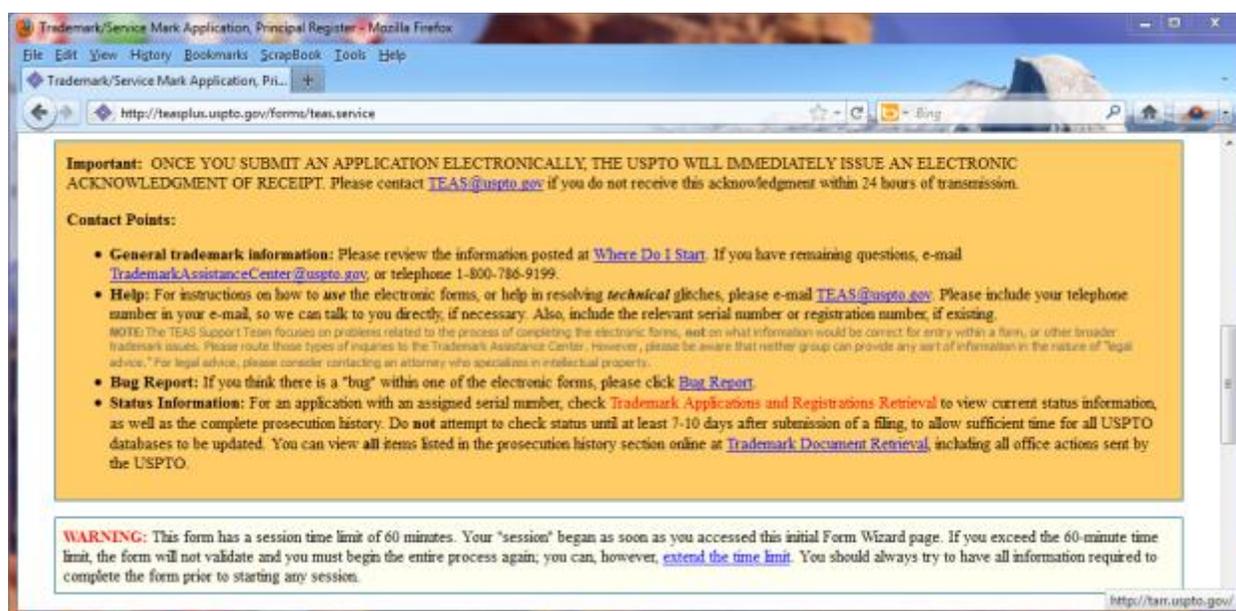
In this example, I have chosen the TEAS Plus form. The main difference is that if you choose the regular TEAS form, you will have to fill in a custom description of your goods and services. The USPTO will require the description of goods and services to be limited to one class of goods or services, or will require an additional fee during prosecution of the application if you choose more than one class.

This is a good place to stop and think about your primary business. What exactly do you sell and what products or services will you use your trademark with. Narrow this down before your proceed so that you are prepared to define your product within the application. Because of the expense of filing in more than one class, you may want to focus on your most important product or service for now.

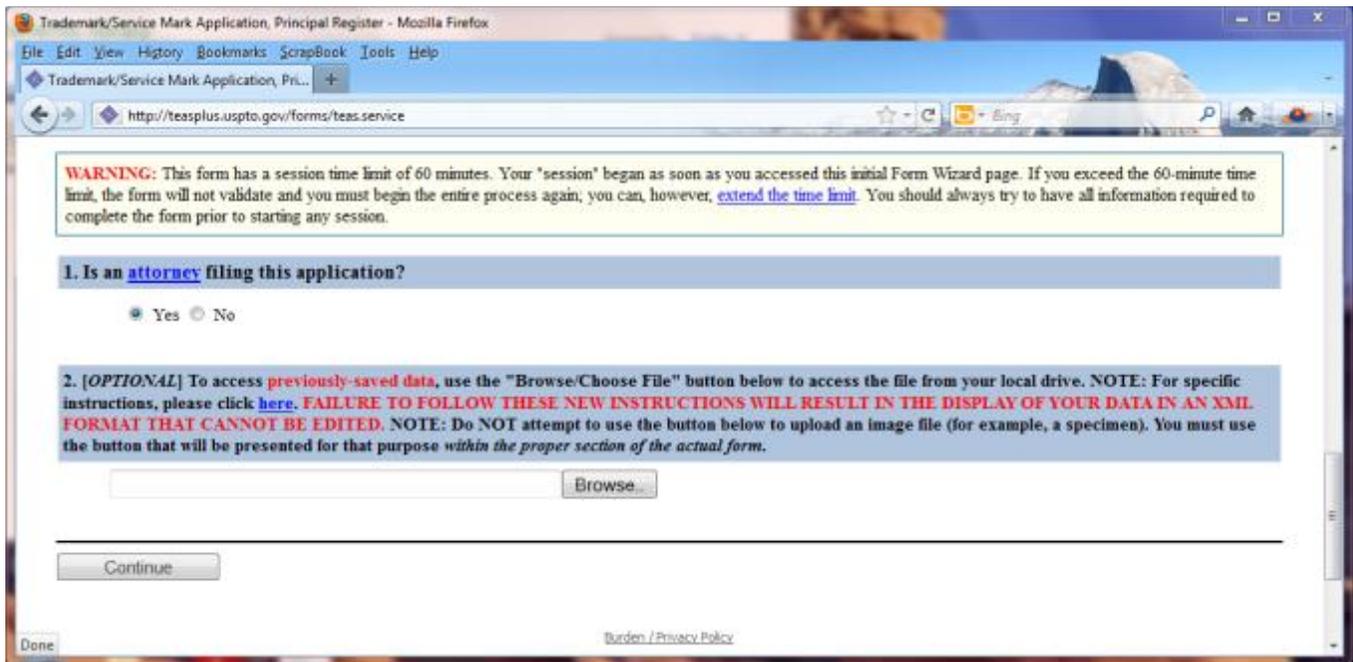
Read the instructions provided by the USPTO application on the application screens to get an overview of the process and to avoid mistakes.



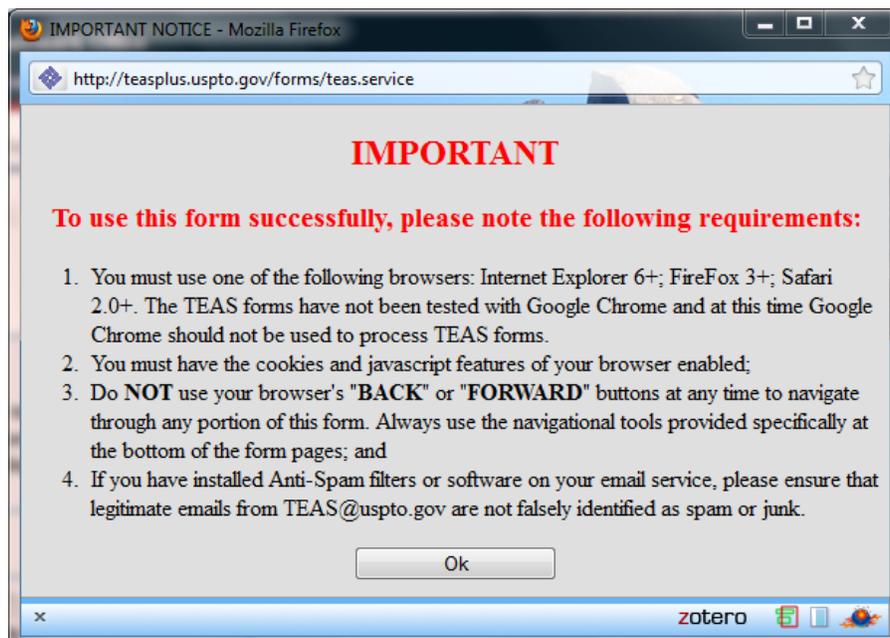
This opening screen of the trademark application form gives you a variety of helpful information if you are completely new to the process. First of all, there is an overview of the steps that you will go through in completing the form. I recommend printing this page for future reference. The instructions on this page tell you how to get help from the Trademark Office and how to check the status of your filed application. Also, note that you have a 60 minute limit for completing the application form.



Ready, set, go. If you are filing your trademark application by yourself, select “No” for #1 with regard to the question “Is an attorney filing this application?” Usually, question #2 will be left blank, but you will have the opportunity to save your form and come back to it later if desired. Question #2 is where you would load up your previously saved form.



Click the CONTINUE button to go on to the next screen, which will pop up a warning message. Verify that you meet the requirements for your internet browser and security features. Click the OK button when you are ready to proceed.



HOW TO CHECK THE STATUS OF YOUR FILED TRADEMARK APPLICATION

Once you have filled in all of the application requirements, verified your data, and submitted your application, you will receive an official US Patent and Trademark Officer filing receipt that will include your application serial number. You can use this Serial number to check the status of your filed application.

Monitor your application every 3–4 months by checking the status in the USPTO TARR system, which stands for Trademark Applications and Registrations Retrieval. The website address for TARR is

<http://tarr.uspto.gov/>.

You are given 6 months to reply to most Trademark Office actions. If you are checking your status every 3–4 months, you should never have to worry about missing a deadline. Don't wait until 6 months to check because you want to allow yourself time to write a good response or consult an attorney if needed.

Good luck with your own trademark filing, and call me if you need any legal help with your own U.S. Federal Trademark Application. My office number is (229) 228–5400.

<p>Brian Bellamy Registered Patent Attorney Clark & Bellamy, P.C. P.O. Box 1997 Thomasville, GA 31799 United States Ph. (229) 228–5400</p>	<p>BIO – Brian Bellamy is a registered patent attorney with over 17 years experience. He specializes in patent and trademark prosecution for invention protection, brand development and protection of creative expressions. Brian is experienced in advising clients in development of intellectual property strategy and advising new businesses on formation of corporations and business structures and drafting contracts and licenses. www.clarkandbellamy.com</p>
--	--