International Intellectual Property

Trademark Law
What is a Trademark?

• The United States Trademark Act of 1964 ("The Lanham Act"):  
  – Section 45 of the Trademark Act, 15 U.S.C. §1127: a trademark is “any word, name, symbol or device, or any combination thereof ... used by a person...” to distinguish the goods or services from that of another.
Spectrum of Trademarks

<table>
<thead>
<tr>
<th>Inherently Distinctive</th>
<th>Not Inherently Distinctive</th>
</tr>
</thead>
<tbody>
<tr>
<td>Fanciful</td>
<td>Generic</td>
</tr>
<tr>
<td>Arbitary</td>
<td>(Sec. Meaning)</td>
</tr>
<tr>
<td>Suggestive</td>
<td>Non-traditional</td>
</tr>
<tr>
<td>Descriptive</td>
<td>TM (color, smell,</td>
</tr>
<tr>
<td></td>
<td>trade dress, etc.)</td>
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</tbody>
</table>

SSHTALT SALT SALT SALT SALT SALT
Trade Dress

• Should trade dress be inherently distinctive?
Other Distinctions

• “Trademark” v. “Service Mark”
  – Trademark = Goods
  – Service Mark = Services

• Trademark v. Trade Name
  – Trademark = “source-identifier”
    • ABC the television corp v. ABC for entertainment services
  – Trade Name = company name
    • ABC, Inc. v. ABC, Co.

• Trademark v. Trade Dress
  – Trademark = word, symbol, or device
  – Trade Dress = distinctive product packaging
Other Distinctions

• Trademarks v. Collective Marks (Lanham Act §45, 15 USC §1127)

  Used by the members of a cooperative, association, or other group to designate membership within that group.
Collective Marks

- Member of the Florists' Transworld Delivery Association
- Member of Certified Public Accountants
Other Distinctions

• Trademarks v. Certification Marks (Lanham Act§45, 15 USC §1127)

- Used to certify **regional** or other origin, material, mode of manufacture, quality, accuracy or other characteristics of a business’ goods or services, or that the work or labor on the goods or services was performed by members of a specific group.

- Standards commonly certified are:
  * quality
  * content
  * method of manufacture
  * geographic origin
Certification marks

- Product is made of pure wool
- Product produced according to Fairtrade political standards.
- Electrical product passed safety standards.
Non-Traditional Marks
Fragrance Marks

Racing Car Lubricants:
- Cherry
- Grape
- Root Beer, etc.

Metal Cutting Fluid: Bubble Gum

Toothbrushes: Strawberry

Yarn: Plumeria
Color Trademarks

Brown
Orange
Green and Gold
Sound Trademarks

Chimes

Sweet Georgia Brown

MGM Lion Roar
Trademarks?

• Foreign Descriptive Terms
  – “foreign equivalents doctrine”
• Acronyms
• Prefixes
• Personal Names
  – Limited protection
Registration Process
Registration process

Pre-Filing  Filing (Review)  Post-Registration

Search  O.A./R  Approved  Cancellation
File  Published  Approved  Registered  Incontestability
/(Opposition)  
File Internationally
File with U.S. Customs
**Principal Register**

- Use of registration symbol ®.
- Sue for infringement.
- Use as a basis for obtaining registration in foreign countries.
- Cite registrations as a bar to the registration.
- Registration shows up in trademark searches.
  - Prima facie evidence of validity.
  - Ability to file with U.S. Customs.
  - Ability to use ITU process.
  - Can become Incontestable.

**Supplemental Register**

- Use of registration symbol ®.
- Sue for infringement.
- Use as a basis for obtaining registration in foreign countries.
- Cite registrations as a bar to the registration.
- Registration shows up in trademark searches.
Registration process

Pre-Filing  Filing (Review)

Search  O.A./R  Published /(Opposition)

Approved  Registered

Post-Registration

Cancellation

Incontestability

File Internationally

File with U.S. Customs
An International Trademark

• Trademark laws are territorial in nature.

• Conflicts with used-based v. first-to-file-based countries
International Treaties

• Paris Convention (Harmonization Treaty)
  – National Treatment
  – Right of Priority
    • Once an application is filed in a Contracting State, an owner may apply for registration in any of the other Contracting States
    • Must apply within 6 months of filing
    • Relation back doctrine: treated as if filed on the same day as the home application
International Treaties

• Paris Convention (Harmonization Treaty)
  – Common Rules
    • Registration in home country does not guarantee registration in other Contracting States
    • Lack of registration in home country is not a basis for denying registration in other Contracting States
    • Each Contracting States agrees to deny registration of marks:
      – If mark is well-known (and not filed by the owner)
      – Bears the state emblem of any Contract State
Vanity Fair Mills v. T. Eaton Co.
Vanity Fair Mills v. T. Eaton Co.

- Does US have jurisdiction over a foreign entity that is using a foreign trademark solely in its home country, although the foreign entity’s country is a member of the Paris Convention?
  - Holding: No. Foreign laws confer no privilege in the US, and simply being a citizens / entity of a Member State does not automatically grant one rights in the other Member States
Registration process

Pre-Filing  Filing (Review)

Search  O.A./R  Published /(Opposition)
File  Approved  Registered

Post-Registration

Cancellation

File Internationally
File with U.S. Customs
Incontestability
Basis for refusal

- Lack of distinctiveness
- Functional (think patents)
- Not in use (never used/abandoned)
- Not first to file (priority)
- Surname Marks
- Scandalous Marks
- Disparaging Marks
- Geographic Marks
Geographic Marks

Primarily Geographically Descriptive

If the goods come from that place:
(1) Is the mark recognized as the name of a geographic area?
(2) Do consumers associate the product with that area?

P.G. Deceptively Descriptive

If the goods do not:
(1) Is the mark recognized as the name of a geographic area?
(2) Would consumers believe the product comes from that area?
Geographical Marks v. Certification Marks

• The US does not recognize geographic marks
  – Matter may be “disclaimed” in an application
  – E.g. NEW YORK MYSTIC PIZZA

• Certification: Used to certify that a mark comes from a particular region (etc)
  – Idaho Potatoes
  – Wisconsin Cheese
  – Florida Oranges
Registration process

Pre-Filing  Filing (Review)

Search  O.A./R  Published /(Opposition)

File  Approved  Registered

Post-Registration

Cancellation  Incontestability

File Internationally

File with U.S. Customs
Inter Partes Proceedings

- **Opposition**
  - “*any person* who believes he or she would be damaged by the registration of a mark...” 15 USC §1063.

- **Cancellation**
Registration process

Pre-Filing  Filing (Review)

Search  O.A./R  Approved (USE)

File  Published  Registered
/(Opposition)

Post-Registration

Cancellation

Incontestability

File Internationally
File with U.S. Customs
Mother’s Restaurants Inc. v. Mother’s Other Kitchen, Inc., 218 USPQ 1046 (TTAB 1983)
Mother’s Restaurants Inc. v. Mother’s Other Kitchen, Inc., 218 USPQ 1046 (TTAB 1983)

• What is “use in commerce”?
  – Where a mark is used exclusively for services offered outside the US, a use in commerce cannot be established solely by advertising to US consumers.
    • Compare with “offer for sale” principle in US

• Attack on the validity of a registration pleaded by an opposer will not be hard unless a counterclaim or separate petition is filed
Mother’s Restaurants Inc. v. Mother’s Other Kitchen, Inc., 218 USPQ 1046 (TTAB 1983)

- Where a mark is used exclusively for services offered outside the US, a use in commerce cannot be established solely by advertising to US consumers.

Prior use and advertising of a mark in connection with goods or services marketed in a foreign country (whether said advertising occurs inside or outside the United States) creates no priority rights in said mark in the United States as against one who, in good faith, has adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner’s first use of the mark on goods or services sold and/or offered in the United States. …
Registered Aug. 27, 2013
Int. Cl.: 25

FOR: SHAPEWEAR, NAMELY FOUNDATION GARMENTS WORN AROUND THE MIDSECTION OR THIGHS TO KEEP THE STOMACH IN AND CREATE A SLIMMING EFFECT; EXCLUDING SOCKS, HOISERY, ATHLETIC/TECHNICAL PERFORMANCE APPAREL FOR SPORTS, NAMELY, JACKETS, PANTS, SHIRTS, SWEATERS, AND UNDERGARMENTS, IN THE NATURE OF BASE LAYERS AND UNDERBREACHES, ALL FOR HORSEBACK RIDERS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 8-18-2012; IN COMMERCE 8-18-2012.

THE MARK CONSISTS OF FIGURE OF A WOMAN OVER THE STYLIZED WORD "FITZ".

SER. NO. 85-744,363, FILED 10-3-2012.

STEVEN PEREZ, EXAMINING ATTORNEY
Registration process

Pre-Filing  Filing (Review)  Post-Registration

Search  O.A./R  Approved (USE)

File  Published /(Opposition)  Registered

File Internationally

File with U.S. Customs

Cancellation  Incontestability
Filing with the U.S. Customs and Borders Protection

• Mark must be registered in U.S. on the Principal Register
• Assists CBP in its efforts to prevent the importation of infringing goods
• Counterfeit Marks Process
  – Detention of goods
  – Notice to importer and Discloser mark owner
  – Exportation or Destruction of goods
• https://iprr.cbp.gov/
Inter Partes Proceedings

• Opposition

• Cancellation
  – “any person who believes he or she would be damaged by the registration of a mark...” 15 USC §1064.
Defense to incontestability

– Defendant:
  • Fair use
  • Adopted in good faith and used before registration of senior mark
  • Junior mark was registered before registration of senior mark

– Equitable principles (Laches, estoppel, acquiescence)
Defense to incontestability

– Senior mark should be canceled (even after incontestable status):
  • Registration was obtained fraudulently
  • Mark is abandoned
  • Mark is being used to misrepresent source of g/s
  • Mark is functional
  • Mark is being used to violate antitrust laws
Registration process

Pre-Filing
- Search
- File

Filing (Review)
- O.A./R
- Published
  /(Opposition)

Post-Registration
- Approved
  (USE)
- Registered
- Incontestability

File Internationally
File with U.S. Customs
International Treaties

• Madrid Agreement = “Harmonization Treaty”
  – Sets National Treatment standards
  – U.S. is NOT a member

• Madrid Protocol = “Filing Treaty”
  – A/K/A “The Madrid Union”
  – WIPO: “a one stop shop solution for registering trademarks worldwide”
  – File one application, one fee, in one language, with one centralized maintenance system
  – 97 Member countries; U.S. became a member in 2003
International Treaties

• Paris Convention
• Madrid Agreement and Madrid Protocol
• TRIPS (Uruguay Round Agreements)
  • Establishes the WTO Agreement
  • Established the TRIPS Council to monitor and enforcement obligations under the Agreement
  • Measures adopted in favor of least-developed nations
International Treaties

• Paris Convention
• Madrid Agreement and Madrid Protocol
• TRIPS (Uruguay Round Agreements)
  • Re Trademarks
    – Defines subject matter
    – Exclusive rights
    – Famous marks enjoy additional protection
    – Term of protection (duration)
International Treaties

• Paris Convention
• Madrid Agreement and Madrid Protocol
• TRIPS (Uruguay Round Agreements)
  • Re Trademarks
  • Re Geographical Indications
    – Prevent the use of any indication which misleads the consumer as to the origin of goods
    – Prevent unfair competition
    – Higher level of protection for wines and spirits
TRIPS Agreement: Art. 22-24

• Geographical Indication is not required to have the same name of a geographical place, but it must be an indication of that place
  – Bourbon (whiskey)
  – Champagne (sparkling wine)
  – Swiss (cheese)
<table>
<thead>
<tr>
<th></th>
<th>US Law</th>
<th>TRIPS</th>
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<tbody>
<tr>
<td><strong>Subject Matter</strong></td>
<td>“…any device…”</td>
<td>“any sign or combination of sign”</td>
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<tr>
<td></td>
<td>Does not expressly include color, but the PTO does allow for protection</td>
<td>Expressly includes “colour”</td>
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<tr>
<td><strong>Other Marks</strong></td>
<td>Protection of collective and certification marks, including those with a geographical term</td>
<td>Geographical Indications</td>
</tr>
<tr>
<td><strong>Non-registerable Marks</strong></td>
<td>Geographic, Geographically Misdescriptve</td>
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<tr>
<td>Post Registration Requirements</td>
<td>US Law</td>
<td>TRIPS</td>
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<td>Between the 5/6 year must file an 8 and 15 Affidavit (mark becomes incontestable); then on the 10th anniversary and every 10 years thereafter</td>
<td>Each term for renewal of registration shall be for no less than every 7 years</td>
</tr>
<tr>
<td>Standard for registration</td>
<td>Mark must be used in commerce before registration is granted (compare with ITU app)</td>
<td>Mark may “published” immediately after registration</td>
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Next Class

• Don’t forget Group Exercise Presentation!!!