

Trademarks: Lessons and Landmines

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Introduction

- I'm not an attorney / not an expert - I just own a U.S meadery which owns several Federally registered trademarks
- My company's trademarks, fictional trademarks & real world trademarks for illustrative purposes
- I'm not making recommendations regarding any specific product / entity
- Real responses redacted
- Most important advice of the day: Consult an attorney

How I Got Interested in Trademarks

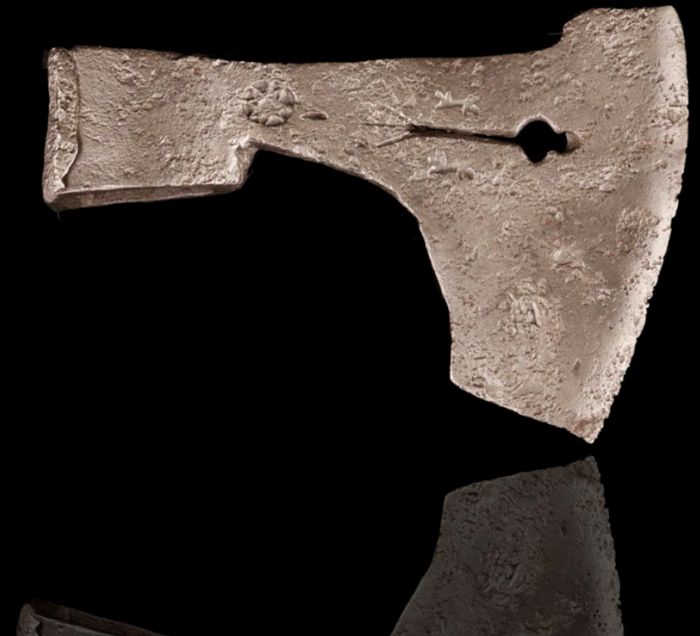
- I'm going pro! Meads in competitions!
- "...know you are getting ready to start a commercial meadery, saw you entered [MEAD NAME] in a competition and need to let you know we have [MEAD NAME] on the market"
- Friend who owned meadery - received notice of alleged infringement
- Re-brand: signs, labels, business cards, website, etc.
- No litigation but related expenses = \$\$\$ thousands
- Everything I thought I knew about trademarks was wrong

Plan of attack

- What is a trademark
- What use is a trademark
- What makes a strong trademark
- Trademark Examples (all registered with USPTO, trad and non-trad)
- How to get / how to lose a trademark
- Common law vs Registered trademarks
- Federal Trademark Registration
- Infringement
- Atheling's Approach
- USPTO Resources

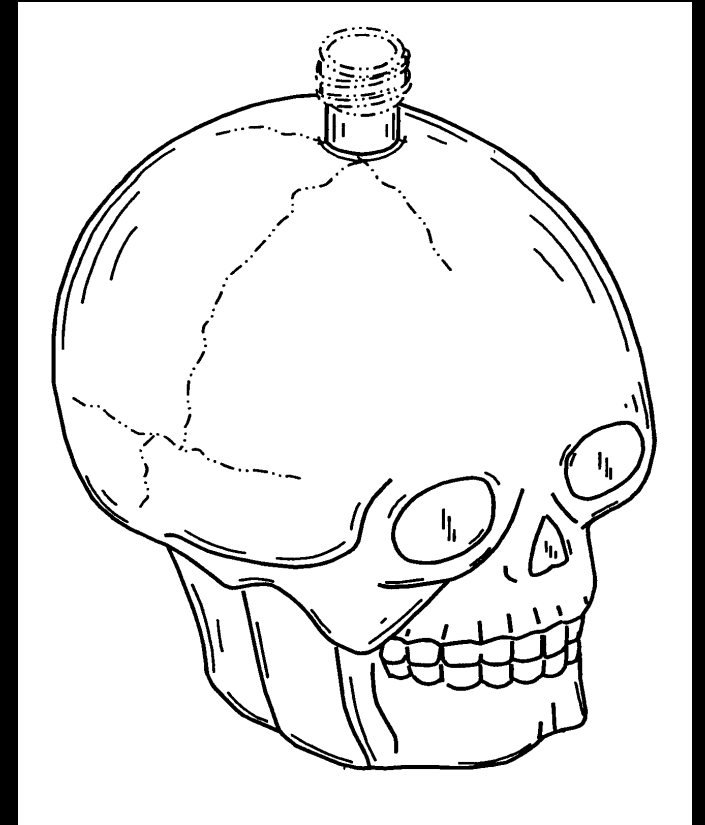
What is a trademark?

- Any word, phrase, symbol, design, device or a combination thereof
- Identifies and distinguishes the source or affiliation of goods or services - distinguishes from competitors.
- Prevents consumer confusion (usually key issue)



What is a Trademark?

- A noun, not a verb
- A type of intellectual property (Intangible asset)
- Has value, can be bought, sold or licensed
- Copyright(©): Protects original creative works.
- Patents: Grant ownership to rights of an invention
- Trade secrets: must be secret, valuable, reasonable effort to maintain secrecy



What Use is a Trademark?

- EXCLUSIVE right to use the mark in trade
 - Others cannot use confusingly similar mark in commerce
 - Does not convey exclusivity outside of category / related categories
 - Delta Airlines / Delta Faucets
 - Does not limit use in ordinary speech
 - Does not limit fair use - descriptive / nominative
 - Geographically limited

What makes a Strong trademark

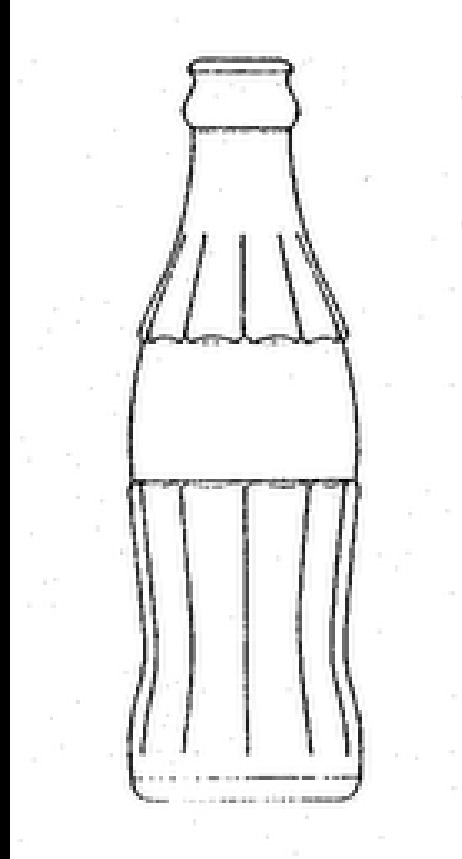
- Fanciful = otherwise meaningless words, coined terms, portmanteaus
 - Relity Meadery, Accura
- Arbitrary = words, names unrelated to product
 - Vacuum Cleaner Meadery, Amazon
- Suggestive = words related to product - imagination required
 - Bees' Treasure Meadery, Rite Aid
- Descriptive = words related to product - no imagination required / geographic ID
 - Roanoke Red Pymment, American Airlines
- Generic = can never be a trademark
 - Honey Wine Mead, Bicycle Shop
 - Doctrine of foreign Equivalents

Trademark Examples (traditional)

- A word or words
 - Atheling, Under Armour
- A phrase or motto
 - "Just do it", "Do the Dew"
- An image or graphic design



Trademark Examples



Trademark Examples

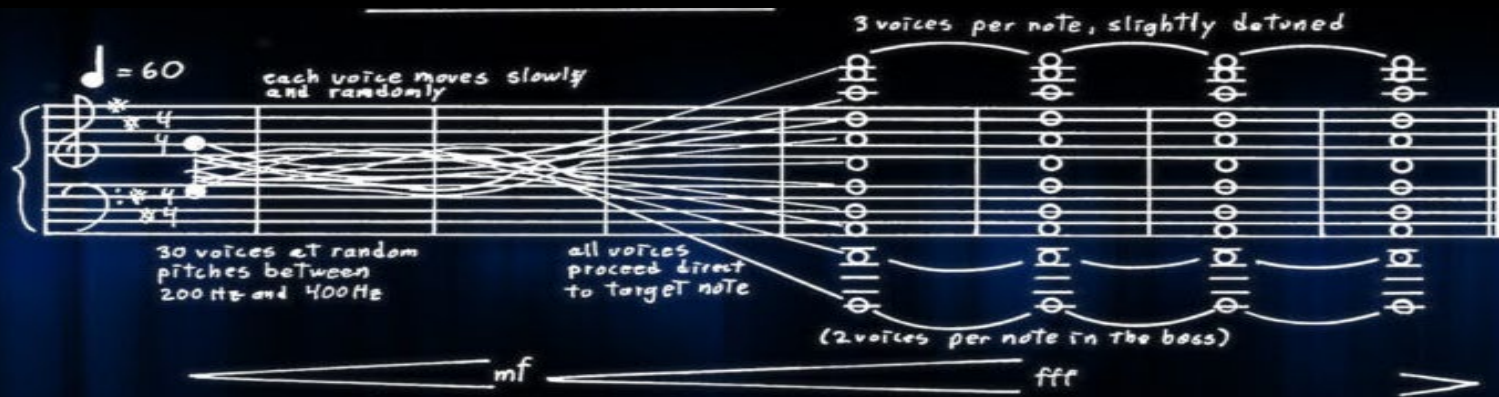
- A color?



#644117
PULLMAN BROWN

Trademark Examples

- A Sound



Trademark Examples

- A texture?
- "The mark consists of a velvet textured covering on the surface of a bottle of wine" - American Wholesale Wine & Spirits, Inc.

Trademark Examples

- A smell?
- A sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough.



How to get a trademark

- Must be distinctive / distinguishable
- Created through use in commerce in connection with goods / services
- Must be used continuously and substantially enough that consumers create a connection between the mark source of the mark

How (not) to get a trademark

- Incorporating a business
- Getting a TTB / state permit / COLA
- Setting up a website / Registering an internet domain
- Announcing a plan to use a mark in trade
- Entering mead in contests under expected commercial name
- Printing up t-shirts

How to Lose a Trademark

- Non-use / Abandonment (May still have common law rights)
- Uncontrolled licensing
- Failure to enforce (not enforcing every single infringement does not cause loss of rights)
- Improper Assignment
- Genericide (zipper, escalator, thermos, trampoline)
- Loss isn't automatic

Common Law vs Registered

- Unregistered (Common Law)
 - Rights based on state law / prior court decisions
 - No official starting date / may be difficult to defend
 - No centralized database/ registry
 - Rights limited to geographic area of use + "reasonable expansion"
- State Registered
 - Rights based on state law – vary by state
 - Official filing date
 - Searchable state registry
 - Rights limited to state of registration

TM

Federal Trademark Registration

- Strongest protection
- Based on Federal law (Congresses' power to regulate interstate commerce)
 - Lanham Act 1946, Trademark Modernization Act of 2020
- Rights in all of US and US territories
- Intent to use / official filing date
- Easier to defend / Presumption of ownership / validity
- More consequences for infringement
- Searchable USPTO Primary & Supplemental Register
- Block imports + basis for international filing
- Common law mark can be isolated by a federally registered mark



Federal Trademark Registration

- Slow (months)
- Has cost
- Complex – Each application goes through a vetting process by real experts / attorneys at the USPTO
- File for continued use + incontestability (if able) after 5 years, then continued use every 10 years
- Requires use in interstate commerce

Infringement

- "...unauthorized use of a trademark...on or in connection with goods and / or services in a manner that is likely to cause confusion, deception, or mistake about the source of the goods and / or services."



Infringement

- Marks convey a similar general meaning / produce same mental reaction
- Consumers would mistakenly believe goods from same source / related
- Similarity in sound, spelling or appearance may be sufficient

Infringement

- What are related products?
- Yogurt and cereal
- "Insignia" wine v "Alec Bradley Star Insignia" cigars.
 - goods need not be similar or competitive “...circumstances surrounding their marketing...would give rise to the mistaken belief that goods emanate from the same source.”

Infringement

- Think McMead
- Likelihood of confusion not required
- Dilution = Damages a FAMOUS mark
 - Tarnishment- reputation harmed through association with similar mark
 - Blurring – identity impaired by association with another similar mark

Infringement

- Be prepared to monitor / defend your businesses' trademarks
- Monitor yourself / pay your attorney / company to monitor
- You will spend real \$ to do this.

Infringement

- You may get contacted stating that you have infringed a trademark
- Even if it's friendly, it's very serious
- Assume sender's attorney has reviewed and sender feels they have a strong position
- Will usually contain some standard elements
 - Business information of sender
 - Name / contact information of sender
 - What is potentially infringing
 - Sender's trademark information
 - A request that you stop the infringing activity and respond affirmatively
 - Window of time to respond

Infringement

Dear [MEADERY],

My name is [NAME], and I own [MEADERY] in [CITY, STATE]. I'm writing to you today because I noticed [TRADEMARK ISSUE].

My meadery owns a federal trademark registration for [TRADEMARK] in connection with mead, which gives us the exclusive right to use that name in connection with mead in the United States. The registration number is [REGISTRATION NUMBER], and we applied to register the mark on [DATE]. I'm concerned that if [TRADEMARK ISSUE] consumers will mistakenly believe that your mead was produced by [MEADERY].

I suspect that you might not have been aware of my meadery's trademark rights, and wanted to reach out to you directly to let you know. Please respond within the next 30 days and confirm that you will stop using [TRADEMARK] in connection with mead.

I hope that by reaching out early, it minimizes the costs associated with rebranding. Should you have any questions or need to discuss this further, you can reach me best by [CONTACT INFORMATION].

Thank you,

[NAME], [MEADERY]

Infringement

We are counsel for [COMPANY]. [COMPANY] owns a federal trademark registration for [NAME]. Reg. No. [NUMBER]. As you will recall, [COMPANY OWNER] requested that you stop using the mark [TRADEMARK]. Your continued use of this mark constitutes intentional trademark infringement. Accordingly, please stop all use of the mark [TRADEMARK], and all confusingly similar marks, in connection with the sale, advertising, and promotion of your goods or services. We look forward to your favorable response by [DATE]. Otherwise, we will be forced to commence litigation against you without further notice.

Infringement

- Plan your response
- Be professional, emotional response will not make the issue go away
 - "I don't think there will be any consumer confusion."
 - "I don't see how anybody could confuse the two products..."

Infringement

- If you suspect infringement
 - Make sure you have a strong position
 - Consider a friendly personal contact first
 - Have limits in mind ahead of time – what will you negotiate on?
 - Remain professional at all times
- There's always a C/B involved in enforcing trademark rights

Infringement

- Many times, infringement can be resolved quickly and amicably
- Other times will not be so amicable
- You will be the bad guy in someone's story

Infringement

- "We incorporated before your trademark date so we have rights to [NAME]"
- Accused of lying "just to mess with us."
- "We'll be changing our mead's name to [NAME] but you'll see more people trying to use your trademarked name."
- "There is also a Meadery called [NAME] Meadery. You guys need to do a better job of defending your trademark."
- "You don't have TM by [NAME] so it doesn't count as a trademark"
- "No one has seen your meads on the liquor store shelves around these parts"
- "The mead community is a small one and it is better to support each other than tear each other down."
- "Our labels look different from yours"
- "We know you have [NAME] on the market so we added extra words to make ours distinctive"
- "There are multiple uses of [NAME] on the market currently. It does not seem that you are defending your trademark as well as the law specifies" (sent pictures of my product)

Atheling's Approach

- Name: Federally Registered Trademark
- Logo: Federally Registered trademark
 - Also Federally registered copyright
- Every mead that goes out retail / wholesale: Federally Registered Trademark
 - Also labels Federally registered copyright
- Every mead that is on tap at the meadery: Generic Name
 - Ex: Wildflower honey with blackberry, clover honey mead
- Monitor and defend trademarks, friendly letter first



Conclusion

- Your business has trademarks
- Trademarks distinguish your business and brands
- Trademarks are intellectual property with value
- Trademarks have associated right to exclusive use
- Trademark registration may or may not be worthwhile or possible
- Trademark mis-steps can be stressful and expensive

Resources

- www.uspto.gov/trademarksearch
- www.uspto.gov/trademarks

Questions?

