



Protecting Your Association's Trademarks

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What is a trademark/service mark?



- ❖ A word, slogan, phrase, logo or design that is used by an association to identify its product or service.
- ❖ Most association marks are service marks, not trademarks.

Difference between Copyrights, Trademarks and Patents

Trademarks – Protect names, logos, phrases.
(Registered with USPTO)



Copyrights – Protect original works of authorship, such as publications, music, movies, computer programs, etc. (Registered at the US Copyright Office)

Patents – Protect inventions and ideas.



How do you gain ownership in a trademark?

- ❖ Do NOT need to register mark
- ❖ Ownership established by actual use
- ❖ In most cases, entity that first used the mark will be given priority
- ❖ Must be used continuously



So why register your trademarks?

- ❖ Provides formal notice “to the world” that you are using the mark
- ❖ Prima facie evidence of validity of the mark – presumption that you own the mark
- ❖ Can use the ® symbol
- ❖ Can sue in federal court, and possibility of increased damages
- ❖ “Incontestability”
- ❖ Ultimately, much easier to protect a registered trademark

What marks should be registered?

- ❖ Name
- ❖ Acronym
- ❖ Logo
- ❖ Slogan
- ❖ Association magazine or other publication
- ❖ Tradeshow name



Types of trademarks



- ❖ Trademark – Promotes a product (Kleenex, Xerox, M&M, Honda)
- ❖ Servicemark – Promotes a service (JiffyLube)
- ❖ Membership mark – mark used to show representation in an organization (AAA member) (Used by members or chapters, owned by association)
- ❖ Certification mark – certifies that the person meets certain standards (used by certificants, owned by association)

Registration Process



- ❖ Can be registered by state or federal government
- ❖ Unless a regional association, recommend federal registration (USPTO)

Use of trademark symbols

❖ ®

❖ TM

❖ sm



Pre-Registration – Trademark Search

- ❖ Cost around \$700
- ❖ Checks USPTO and state sites, domain names, internet searches, to search for conflicting marks.
- ❖ Much better to research mark before spending time and effort to create goodwill and brand recognition.



Non-Registerable Marks

- ❖ Descriptive – name immediately conveys services of company (problem for associations)
- ❖ Generic – Tires Tires Tires/ Hotels.com
- ❖ “Suggestive Marks” are OK - “Farmacy” “Masters”

Acquired Distinctiveness

- ❖ After a period of time (usually 5 years) the mark acquires a secondary meaning.
- ❖ A descriptive mark may then become registerable.



UNITED STATES PATENT
AND
TRADEMARK OFFICE

Application – 2 types of filings:

- ❖ In Use – applicant has already started using the mark in commerce
- ❖ Intent to Use – applicant has a bona fide intent to use the mark in commerce
- ❖ No mark will be registered until it is being used in U.S. commerce



Application Information

- ❖ Online Application
- ❖ \$325.00 filing fees
- ❖ Need basic information: name, address, contacts, date of incorporation, date first used mark in commerce
- ❖ Need specimen of how the mark used in commerce (Website printouts, publications, advertisements, etc.)

Type of Service

- ❖ Marks are registered in international classes
- ❖ Need to be very careful to properly identify services or mark won't register
- ❖ Frequently, associations use mark for "association services"



Registration Process

- ❖ After application is filed, it is reviewed by Trademark Examiner
- ❖ May need to respond to Office Action(s)
- ❖ Once approved, published for opposition
- ❖ If no one opposes, mark is then registered
- ❖ Once registered, can start using the “®” sign



Timing/Costs



- ❖ Fees - \$325, more if intent to use application
- ❖ Timing – Between 1-2 years to register



Post-Registration Requirements

- ❖ Between 5th and 6th year after filing – File Section 8 and 15 filings
Statement of Use and Incontestability
- ❖ Between 9th and 10th year after filing – Section 8 and 9 filings
Statement of Use and Renewal
- ❖ Failure to file will result in cancellation



Infringement

- ❖ Need to protect the mark, or may be considered abandoned.
- ❖ Mark will become diluted.
- ❖ Need to do so immediately, delay in asserting claim could hurt you.

How to determine if mark is infringing

- ❖ Exact same mark
- ❖ Confusingly similar
- ❖ Likelihood of confusion



Factors in determining the likelihood of confusion:

- ❖ similarity of mark
- ❖ actual confusion
- ❖ proximity of products or services
- ❖ sophistication of audience

Cease and Desist Letter



- ❖ Letter to infringer, telling them to immediately cease and desist using the mark.
- ❖ Sent certified mail.
- ❖ Usually more effective if it comes from an attorney.
- ❖ Remember to protect membership and certification marks as well.

Legal Action



- ❖ File legal action in federal/state court
- ❖ Expensive, but does make people take notice



Foreign Infringers

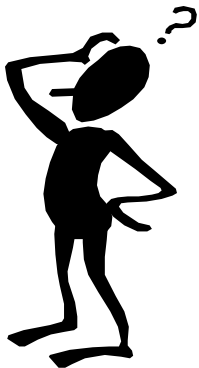
- ❖ If they are using the mark in the US, can get them to cease and desist.
- ❖ If using in their country, and association does not do business in that country, not much you can do.
- ❖ Careful of notices received from companies stating that your mark is going to be registered in another country.

Foreign Marks



- ❖ Need to register your mark in the US first.
- ❖ US trademark the basis for foreign trademarks.
- ❖ File marks through USPTO with World Intellectual Property Organization (WIPO).
- ❖ Can file in several countries with one application.

Questions?



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