



A QUICK GUIDE TO TRADEMARKS

BRAND



PURPLE FOX LEGAL

HELLO AND WELCOME,

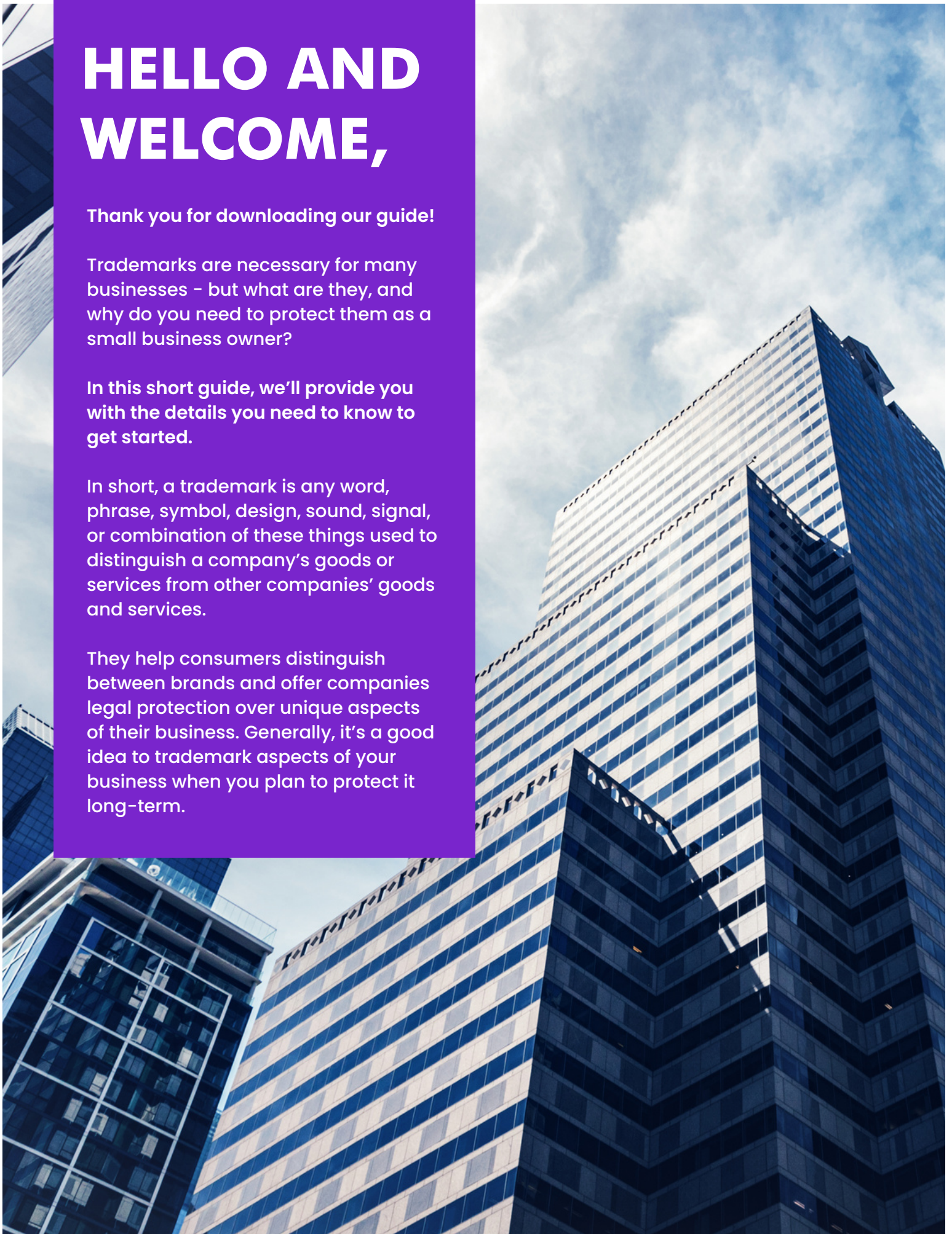
Thank you for downloading our guide!

Trademarks are necessary for many businesses – but what are they, and why do you need to protect them as a small business owner?

In this short guide, we'll provide you with the details you need to know to get started.

In short, a trademark is any word, phrase, symbol, design, sound, signal, or combination of these things used to distinguish a company's goods or services from other companies' goods and services.

They help consumers distinguish between brands and offer companies legal protection over unique aspects of their business. Generally, it's a good idea to trademark aspects of your business when you plan to protect it long-term.



HOW DO YOU REGISTER A TRADEMARK?

The U.S. Patent and Trademark Office (USPTO) governs the federal trademark registration process. From start to finish, the whole process can take up to eighteen months as your application clears through a long list of stages before receiving a trademark registration certificate. In general, most businesses should seek to trademark their name or logo. However, it's not as simple as seeking it, and it is granted.

HOW DO YOU CHOOSE A TRADEMARK FOR YOUR BRAND?

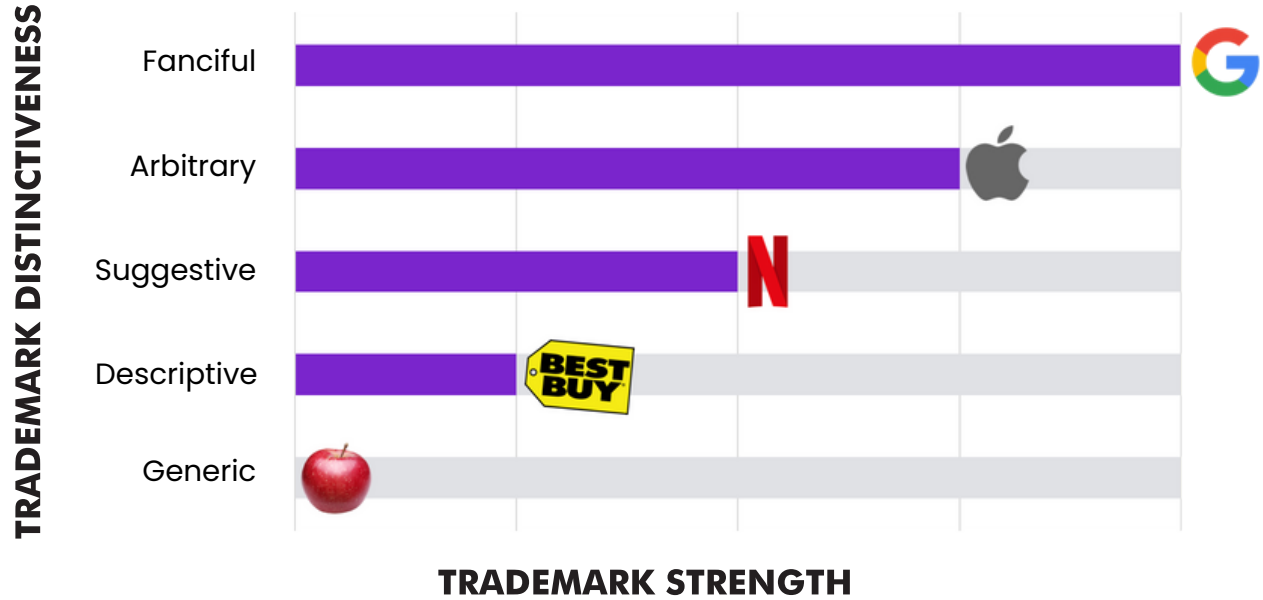
Your trademark application will pass through a range of tests, one of which involves the Abercrombie Trademark Distinctiveness Spectrum. Essentially, the more distinctive your trademark is, the stronger it is and the easier it can be protected under the law. This scale slides from generic to fanciful, with generic marks being incapable of functioning as trademarks and fanciful being the strong type of trademark.

From weakest to strongest, the five categories included in the Trademark Distinctiveness Spectrum are:

- Generic
- Descriptive
- Suggestive
- Arbitrary
- Fanciful



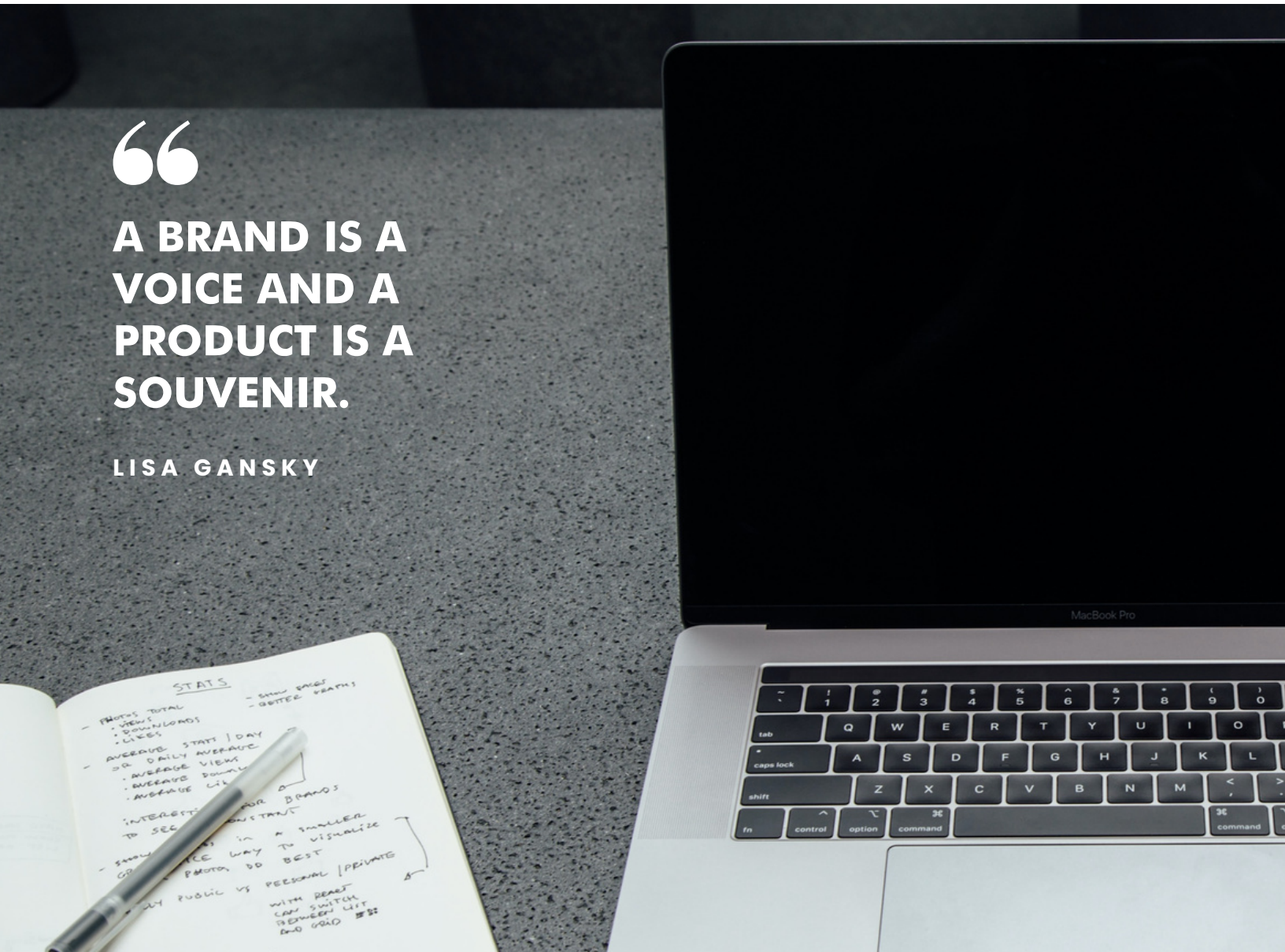
ABERCROMBIE DISTINCTIVENESS SPECTRUM



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A BRAND IS A VOICE AND A PRODUCT IS A SOUVENIR.

LISA GANSKY



THE DISTINCTIVENESS SPECTRUM

Generic

Generic marks are the weakest type of trademark. In fact, they are ineligible for protection simply because they aren't distinctive enough. If you wish to obtain more protection for your word mark, you will need to think of a name that progresses further up the scale.

It's important to note that this doesn't mean your word mark must be abstract or nonsensical. It depends entirely on what your company does and the name you choose to associate with it. For example, calling your company "Apple" and your company sells apple products, that trademark would be deemed generic. However, for Apple, Inc., its trademark is perceived as removed from its products and services and, thus, its trademark is protectable.

Descriptive

Descriptive word marks are ineligible for legal protection, unless they claim a secondary meaning in the minds of consumers over time. In short, a descriptive mark describes a product or service of a company. For example, Best Buy describes to you the value you'll receive in the store. While that may be good for advertising, it doesn't bode well on the spectrum and constitutes a weak trademark that hard to protect effectively.

Suggestive

Suggestive marks are eligible for moderate protection. They are distinguished from descriptive marks in that suggestive marks require some imagination, or an extra thought, for consumers to connect with a brand. Suggestive marks are not particularly strong, but they have a way of connecting an audience to the goods and services they are associated with. For example, Netflix is suggestive as the term "flix" sounds like "flicks" which is a slang term for movies.

Arbitrary

Arbitrary marks are distinctive, offering trademark protection to the companies that use them. Generally, it is a common word that consumers use that is applied in a new or unfamiliar way. Hence, the word isn't new or unique in itself; however, it gains new meaning due to the arbitrary way it's now used. Apple, Inc is a prime example of this.

Fanciful

Fanciful marks are the strongest type of trademarks since they have no meaning or sense in any language. In fact, they have been exclusively made up to be used as a source to signal a particular brand's goods and services.

When used appropriately, these words enter into everyday language. Google is one of the most known and successful fanciful marks. However, fanciful marks are subject to genericide and can become generic if not properly enforced (i.e., Aspirin, Kleenax).

SUBMITTING YOUR APPLICATION

Take your time with the application process. You should carefully complete each part of the application to ensure you're following the correct procedure that will lead to the best results. Hiring an attorney to help you through the process is generally the safest option.

Initially, an attorney will be able to conduct a trademark clearance search which will conclude if your proposed trademark infringes on someone else's trademark. Taking this step will save you significant amounts of time and money down the road.

Once you've concluded that your trademark isn't infringing another brand, you can start drafting your application. Once your draft is complete, you can submit your online application through the Trademark Electronic Application System (TEAS). After submission, an USPTO examining trademark attorney will be assigned to your application. This can take between six and ten months, so you'll need patience.



“ YOUR BRAND IS THE SINGLE MOST IMPORTANT INVESTMENT YOU CAN MAKE IN YOUR BUSINESS. ”

STEVE FORBES

WHAT IS A TRADEMARK EXAMINATION ATTORNEY?

A trademark examination attorney works for the USPTO and reviews submitted trademark applications. The USPTO examination attorney ensures your application complies with all applicable laws, rules, and regulations.

This review period will also include a search for similar or potentially conflicting trademarks that would result in a likelihood of consumer confusion or otherwise potentially infringe on another's rights.

The USPTO examining attorney's review will result in one of three potential outcomes.

The USPTO Examining Attorney may decide:

- 1** Whether your trademark should be registered and allow your application to move to the next step in the process.
- 2** Whether your trademark application needs minor corrections in which they will request you make changes.
- 3** Whether your trademark should not be registered, and you will receive a non-final decision letter, or office action, explaining why your application was denied.

You will be granted a three-month period to respond to the letter through the TEAS online. Your application will be considered abandoned if you do not submit a response during this period.

Once your trademark application has been submitted, it's important to consistently check the status of your trademark application. This ensures you won't miss any deadlines or any other important correspondence that may be important to your application and ability to obtain a trademark registration certificate.



WHAT HAPPENS NEXT?

If the examination attorney allows your application to move to the next stage, your trademark will enter into a thirty-day publishing period in the USPTO's "Official Gazette." This public publication gives notice to anyone who may be harmed by registration of your trademark. During this period, others may object to registration of your trademark if your trademark adversely affects their own.

If you receive no opposition during this time, your application will progress to a stage where you'll receive an official registration certificate. Please note, this may take up to four or more months, so make sure you remain informed of your application's status during this time.

If there is opposition to your mark, you may be required to participate in a hearing before the Trademark Trial and Appeal Board (TTAB), in which there will be a determination as to whether your trademark should be registered.

AFTER RECEIVING YOUR REGISTRATION CERTIFICATE

Once you've received your trademark registration certificate, your work isn't complete. It's up to you to ensure that nobody infringes on your mark and you have a duty to police your mark.

While the USPTO won't register any marks identical to yours, they will not monitor trademark use for violation. That becomes your company's responsibility as the trademark owner. Should you see an infringement, you will be able to contest it in the same way others could have contested yours during the application process - and even into full use.

In the end, it's up to you to keep your trademark protected and enforce possible acts of infringement. Additionally, there are certain documents you should file with the USPTO to ensure your trademark is kept active in the years to come. These documents include:

- Declaration of Use and/or Excusable Nonuse of a Mark
- Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal
- Declaration of Incontestability of a Mark

If you do not file these documents within the correct time frame, your trademark registration could expire or get canceled. Then, you'd have to begin the process all over again.



WHAT IF YOUR BRAND INFRINGES ON ANOTHER'S TRADEMARK?

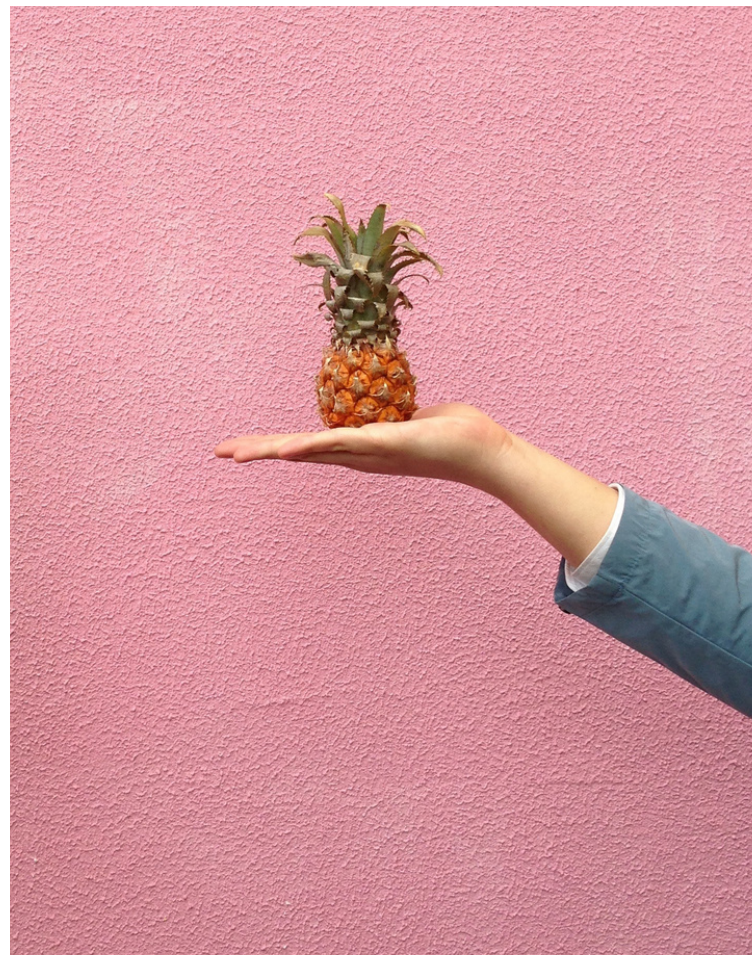
Trademark infringement can be lethal for small businesses. That is why it's most beneficial to conduct a clearance before applying or even using your name or marks. A trademark clearance search is ideally conducted before you even form your business entity.

Once trademark infringement has occurred, the owner can file a lawsuit against you to prevent any continued use and even gain monetary damages. These consequences can bankrupt small businesses, which is why it's better to prevent this type of situation from happening rather than deal with it once the damage is done.

Instead, consulting with an attorney is the best way to protect yourself against trademark issues. Alternatively, you can consult the 13 Du Pont factors.

The 13 Du Pont Factors are frequently used by the USPTO, courts, attorneys, and business owners to help determine the likelihood of consumer confusion for similar trademarks.

In the end, millions of trademarks exist, so navigating them yourself can prove challenging. That doesn't mean you can simply avoid checking, though. When in doubt, consult a trademark attorney, who can protect you against any legal complications you may have been unaware of.



LIKELIHOOD OF CONSUMER CONFUSION ANALYSIS

The 13 Du Pont Analysis helps to identify factors that could cause confusion for consumers when faced with similar trademarks.

- 1 Degree of similarity in appearance, connotation, sound, and strength (conceptual and commercial) between the marks
- 2 Degree of similarity between the nature of the goods and services offered under the marks (or the goods and services listed in the trademark registrations, if applicable)
- 3 Degree of similarity between the trade channels that have been established and are likely to continue
- 4 Consumer purchasing sophistication (impulse buying vs. careful purchasing)
- 5 The prior mark's existing fame and recognition
- 6 The number and nature of similar marks in use on similar goods and services
- 7 The nature and extent of any actual confusion
- 8 The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
- 9 The variety of goods on which a mark is or is not used.
- 10 The market interface that exists between the two marks
- 11 The extent of exclusivity granted to the prior mark
- 12 The extent of any potential consumer confusion
- 13 Any other evidence that consumer confusion between the marks is likely





TRADEMARK LAW IS COMPLEX

With the right knowledge and tools, you can overcome the complexity that surrounds trademark law. It's up to you to avoid some of the most common mistakes business owners make regarding trademark applications. Once you do that, you'll be well on your road to growing your brand.

Before starting your application and also after you've submitted your application, make sure you:

- Do your research to ensure you're not accidentally infringing on someone else's trademark.
- Remember the distinctiveness spectrum. You cannot trademark generic words. So, if you want to get a word mark registered, you need to get a little creative. Generally, arbitrary and fanciful marks are the best choices.
- When you receive correspondence from the USPTO during the trademark application process, you must reply on time. This is even more pressing if there is an issue with your application.
- Take your time with the application. It is easy to make mistakes and you don't want to be forced to restart the process.
- Monitor your trademark at all times. This is equally true after it's been accepted as it's your responsibility to protect your brand's trademarks.



EVERY ENTREPRENEUR NEEDS TO ASK HERSELF TWO THINGS. FIRST, HOW DOES SHE WANT CUSTOMERS TO FEEL WHEN THEY ENCOUNTER HER BRAND? SECOND, HOW CAN SHE MAKE THAT A REALITY?

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