

# Trademarks in a Rush



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American Intellectual Property Law Association



# It is necessary to define a...

Closely partner with trademark counsel, who needs to be aware since the very beginning.



# Implement a strong clearance system



Receive advise on choosing good protectable brands (fanciful, suggestive, arbitrary), avoiding generic, descriptive, common use and/or slang terms



# Trademark Selection and Clearance

## Strongest => Weakest Marks

### 1. Fanciful / Arbitrary

- KODAK for photography supplies
- LAY'S for potato chips
- CHEETOS for snacks
- APPLE for computers



# Trademark Selection and Clearance

## Strongest => Weakest Marks

### 2. Suggestive

- SMARTFOOD for popcorn
- COPPERTONE for suntan oil
- PENGUIN for freezers
- ROACH MOTEL for insect traps



# Trademark Selection and Clearance

## Weakest Marks

### 3. Descriptive

- RICE KRISPIES for Cereal
- Spicy Ranch, Texas BBQ, Lites

### 4. Generic

- Tortilla Chip, Potato Chip, Snack, French Fries, Mani Saladito
- Software for Software

The logo for Rice Krispies, featuring the words "RICE" and "KRISPIES" in a bold, blue, bubbly font with a white outline and a slight shadow effect.

# Marks to Avoid

Merely descriptive of the product or its attributes

- SUNTANOIL - Very hard to register
- PARK´N FLY - Very hard to enforce against others



## Laudatory words

- Best, Super, Preferred, Plus, Gold, Platinum
- World's Favorite Snacks

# Nature of Marks

- Words, slogans, letters, numbers  
LAY´S                      LOVE IT....LIVE IT

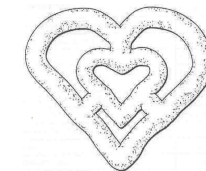
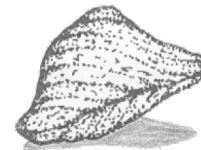


212

- Logos, pictures, symbols, label designs



- Configuration of product



- Color, sounds, scents



# Marketing has come up with a new idea and you are on a RUSH to clear !!



What are your next steps?

Priority countries

Use of local counsel

Purpose of the mark (house mark, slogans, seasonal, limited editions)

# Other factors to consider

*The following factors should be considered in determining when and where to search/file:*

1. Where are sales most likely to occur initially in substantial volume.
2. Where are the next group of countries where sales are most likely to occur.
3. Where owner wants to prevent competition
4. Identify countries with high piracy concerns.

# Trademark Selection and Clearance

## *Most Important Issues:*

1. Inherent registrability ?
2. Does it infringe anyone else's rights?
3. Can we use / register / protect ?

# What resources and tools do you use for a global search project

- Local Counsel (and/or)
- Technology

Trademark search: The new way

TrademarkNow<sup>®</sup> info@onomatics.com Log out Contact us

Home NameCheck™ NameWatch™ Portfolios My account

**NameCheck™**

Chilliefied

Safety level 4

\* Trademark Name \* Product category \* Regions (show coverage)

e.g. apps or pharmaceuticals

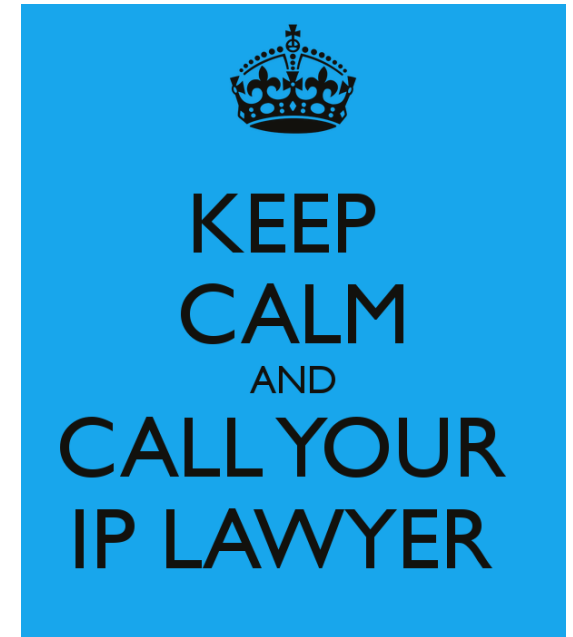
All available

Show instructions Show demo >

Search previous reports

My reports (1,366)  My organization reports (1,644)

Trademark name	Time	Product categories	Regions	Safety level
danio	Tue 2015-05-12	yogurts	European Union	1 <input type="checkbox"/>



# What do you expect from your associates in a search

- Scope of search
- Type of opinion
- Should the search include unregistered rights? Social media?

## What would a perfect search report / opinion look like

# Is the Mark Available?

- Relevant applications or registrations, including owner, goods, application or registration date, and renewal date
- Reasons that could prevent our use/registration: locally famous, but not registered mark; or proposed mark is descriptive/generic
- Chances of obtaining registration of our trademark
- Possible actions against cited trademarks, such as cancellation or nullity actions.
- Suggestions to overcome rejection/oppositions, such as limiting goods, adding a word or design.
- Possibility of reaching a co-existence agreement.
- Can we use even if registration is not possible?
- Can we purchase it?

# Main concerns for Clearance Opinions:

- Ability to USE (%)
  - Trademark Infringement.
  - other basis that may violate 3rd party rights (Unfair Competition/Passing Off, Parasitism, Copyright)
- Only after USE, ability to REGISTER (%)
- If stand alone sub-brand is risky,. Risks associated with pairing with main brands (COLLISIONS vs DORITOS COLLISIONS)
- Brief opinions / Executive Summary
- If searching in several countries, include a Summary Chart
- Always go the extra-mile (internet, translations (including slang); transliterations, etc.

# Technology

- What services do you use?
- How do you search for unregistered rights?
- Will AI and algorithms render the lawyer obsolete?



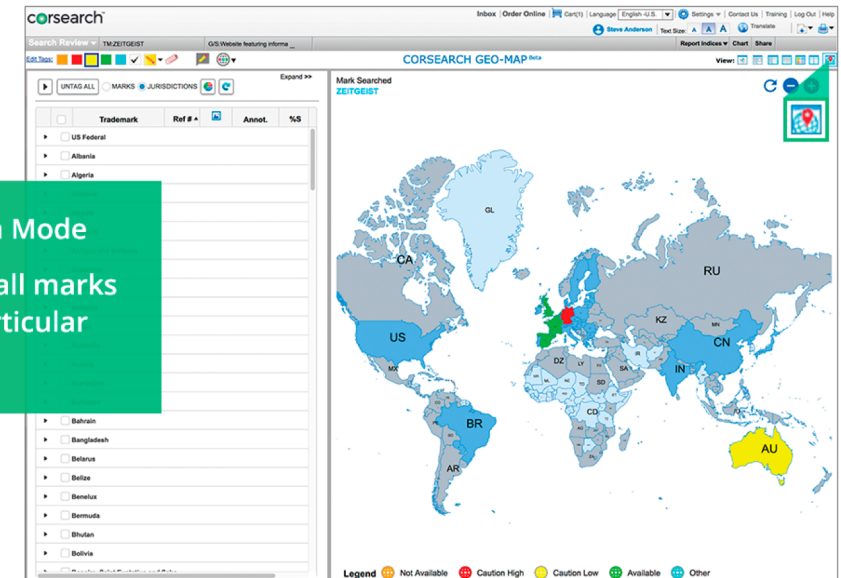
# Human powered options

CompuMark (Clarivate)

Corsearch

SCREENING	CLEARANCE	PROTECTION	
<b>SAEGIS<sup>®</sup> on SERION<sup>®</sup></b>	<b>TM go365<sup>™</sup></b>	<b>Full Availability Search</b>	<b>Watch on SERION<sup>®</sup></b>
Global Online "Knock-Out" Search	Innovative, Cloud-based Clearance Solution	The Gold Standard Trademark Clearance Search	Protection Trusted by the World's Most Valuable Brands
SELF-SERVICE SOLUTIONS		ANALYST SOLUTIONS	

*Shown: Jurisdiction Mode*  
Easily see a list of all marks registered to a particular jurisdiction



# Technology Assisted search options (AI based)

TrademarkNow  
Markify



Markify<sub>beta</sub>

*What?* The world's most accurate comprehensive trademark search. Fast and free.  
*Why?* To help you avoid all confusingly similar marks. [Tell me more](#)

# Common law rights

- What do they mean in the US?
- Why is it so difficult to search in the US?
- Other type of use derived rights?



# Meaning of mark in other languages

Evaluate search for synonyms,  
homonyms, homophones, similar  
sounding words, in all applicable  
languages.

# Examples of meanings gone wrong.



Mondelēz  
International



Irene Rosenfeld, Kraft's CEO speaks during a town hall meeting for all Kraft and Cadbury employees at Kraft Headquarters in Northfield on Friday February 5, 2010. Kraft recently voted to name its new global arm "Mondelez." (William DeShazer/Chicago Tribune)

By **Heidi Stevens**, Tribune Newspapers

MAY 24, 2012

**I**t's not surprising if you find yourself mulling the word Mondelez lately, given its conjuring of everything from "Mon-de-leza Rice" to the Russian term for a sex act.

# Before clearing... ensure meaning is ok in all languages/countries



*CRETA*



# 'Hello, death': Coca-Cola mixes English and Māori on vending machine



Coca-Cola's attempts to combine te reo Māori and English has backfired badly, with the company inadvertently writing "Hello, Death" on a vending machine in [New Zealand](#) stocked full of the drink.

Te reo Māori, the language of New Zealand's indigenous people has been undergoing a revival and big business has taken note.

# EXAMPLES & WAR STORIES





**Applicant's New Logo:**



**Applicant's Existing Registered Logo:**



**Opposer's Registered Logo:**



**Opposer's Logo As Used:**

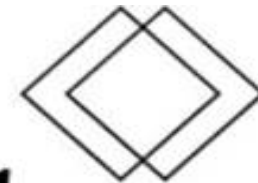
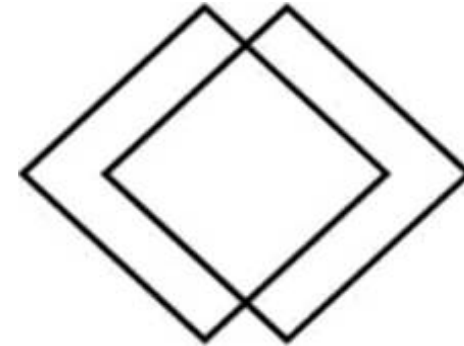


# Marks As Registered:

Applicant's New Logo:



Opposer's Existing Logo:

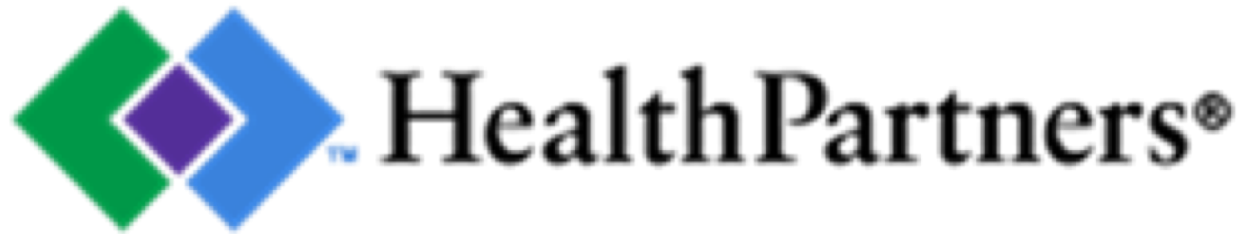


Sam's  
CLUB



# Marks As Used:

Applicant's New Logo:



Opposer's Existing Logo(s):



## Applicant's Marks As Applied For:

- BLIZZARD SPRING WATER
- WHO BUT W.B. MASON'S BLIZZARD SPRING WATER

## Opposer's Registered Marks:

- BLIZZARD



**Applicant's Marks As Used:**



**Opposer's Marks As Used:**





# BLIZZARD™

W.B. Mason's Very Own Spring Water

## Why Spring Water vs. Purified Water?

Purification processes used to create purified water remove natural minerals in the water and alter the taste compared to spring water which naturally comes from the Earth and contains those minerals.



## Why Blizzard™ Water?

- ✓ Refreshing, natural taste at a low price!
- ✓ Real Spring Water bottled from protected local springs
- ✓ Delivered fast, free and where you want it by your driver
- ✓ Exclusively from W.B. Mason!

## BOTTLED WATER

8 oz. and 16.9 oz. bottles

- 24 bottles per case
- Bottles made from plastic
- Made in the USA

CLICK TO SHOP



## WATER COOLER BOTTLES

3 gal. and 5 gal. bottles

- BPA-free bottles
- Non-spill caps can be punctured with a Waterguard Cooler
- Empty bottles are picked up by your W.B. Mason Driver

CLICK TO SHOP





# Blindajes Sebring

📍 Alvaro Obregon, México

Esta empresa está basada en Alvaro Obregon, y se dedica a Vehiculos blindados en existencia, Blindajes de cabinas de tractores, Camiones servicio a vehiculos blindados, Blindajes

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**CHRYSLER**  
  
**SEBRING**



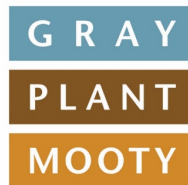


# Questions?

# Thank-you for listening!



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