INTRODUCTION TO TRADEMARKS

Sheldon Klein
Arent Fox Kintner Plotkin & Kahn, PLLC
INTRODUCTION TO TRADEMARKS

I. WHAT IS A TRADEMARK?

A. Definition and Function

1. In general, trademarks are words, names, symbols, devices, designs, or other distinctive items which serve to identify the source of goods or services and distinguish them from those sold by others. A trademark will not always reveal the name of the source, but if consumers understand that all of the goods or services sold under a particular designation emanate from a single entity, or from others approved by that single entity, then the designation functions as trademark.

2. Trademarks symbolize the good will which a company has established for a product or service, and provide protection for the company's investment in that good will.

3. Trademarks are important advertising tools for their owners.

4. Trademarks aid consumers because they represent consistent quality.

5. Trademarks are exclusive rights; their use by others without permission in connection with similar goods or services is an actionable wrong, i.e., an infringement of the owner's rights.
B. Items which can Serve as Marks
   1. Words - COCA-COLA soda; KODAK film.
   2. Names - FORD automobiles; HOWARD JOHNSON restaurants and hotels; ELAINE'S restaurant; PIERRE CARDIN fashions, perfume, etc.
   3. Symbols - Graphic designs, such as the Nike swoosh, Microsoft's Windows flag symbol; characters, such as Mr. Clean or the Jolly Green Giant.
   4. Combinations of words and designs (i.e., logos) - Ford Motor Company's blue and white oval FORD logo, the PEPSI swirl.
   5. Trade dress, e.g., package designs, product configurations, restaurant decor - Kodak's film packaging; Coca-Cola's classic bottle shape; Taco Cabana and Fuddruckers restaurants.
   6. Sounds - The NBC chimes
   7. Scents - Floral-scented sewing thread

II. TYPES OF MARKS

A. Trademarks
   1. Identify the source of goods.
   2. Must be used on the goods.
      - Exceptions exist where labeling is impractical, e.g., items sold in bulk shipments, such as petroleum products shipped in tanker trucks. There, use of
the mark on documentation accompanying the goods will suffice.

B. Service Marks
1. Identify the source of services.
2. Are used in connection with the offering of services.
3. Are used on advertisements, brochures, letterhead, business cards, signs, etc.
4. Compare with trade names, which identify a company, but are not always used in connection with an offer to provide services.
5. Are particularly useful in franchising, e.g., MCDONALD'S, CENTURY 21.

C. Certification Marks
1. Certification marks identify a product or service as complying with a uniform standard or quality established by the certifying individual or entity. Examples:
   a. UL for electrical consumer products.
   b. GOOD HOUSEKEEPING SEAL OF APPROVAL for household and other consumer products.
   c. AAA for hotels, motels and automobile repair shops.
2. The certifier may not also sell the same goods or services under the same mark.
3. Federal registration may not necessarily be required, but is highly recommended and usually pursued.
D. Collective Marks
   1. Collective marks indicate membership in a union, association, or other organization. There are two types:
   2. Collective trademarks or service marks
      a. Are used by members to identify their goods or services.
      b. Are very similar to certification marks, but there is no statutory bar against use on goods or services by the association itself.
      c. Example: SUNKIST for a cooperative of orange growers and their products.
   3. Collective membership marks
      a. Indicate membership, but are not used by members to identify goods or services.
      b. Can be used on goods or services by the association itself.
      c. Examples: TEAMSTERS and UAW for labor unions; AMERICAN BAR ASSOCIATION for a lawyers' organization

III. SOURCES OF TRADEMARK LAW AND CREATION OF TRADEMARK RIGHTS IN THE UNITED STATES

A. Trademark rights can be acquired via use as a trademark under the common law and Sec. 43(a) of the Lanham Act of 1946, as amended.
   1. Trademark use vs. non-trademark use
a. Trademarks must be used on goods or in connection with services.

b. Trademarks should be prominent, recognizable, and separate from other words.

c. Trademarks are normally used as adjectives, rather than as nouns or verbs. They should not merely describe a product but rather indicate its source.

d. Trademarks should not be used merely as company names, trade names, surnames, first names, or geographic names, although they are sometimes identical to such names.

2. Geographic limitations
   • Common law trademark rights are protected within the area of use as well as a "zone of natural expansion."

3. No federal statutory presumptions
   • Federal rights and remedies under Lanham Act Sections 34, 35, 36, and 43(a) are applicable if the mark is used "in commerce", i.e., in interstate commerce or in commerce between the U.S. and another country.

B. Federal registration after use enhances rights already acquired and provides additional rights.

1. It extends the right of priority nationwide, as of the filing date of the application.

2. It provides other statutory benefits and presumptions (See Section IV, infra).
C. Contingent trademark rights can be acquired prior to use by filing an application to federally register the mark under Section 1(b) of the Lanham Act.

   1. The filing of an application constitutes constructive use and confers a nationwide right of priority.
   2. The applicant must have a bona fide intention to use the mark in commerce.
   3. The application must be followed by use in commerce, unless the registration is based on a valid foreign registration.
   4. Rights cannot be enforced until the mark is registered; except that an application can serve to block registration of a later filed mark, or as a basis for initiating an opposition or cancellation proceeding.
   5. Rights are extinguished if the application does not mature to registration (non-priority common law rights will remain if the mark has been used).

D. Trademark rights (and a registration) can be acquired without use by filing an application based on a foreign application or registration under Section 44 of the Lanham Act.

   1. Section 44 of the Lanham Act implements the Paris Convention trademark treaty.
   2. A foreign applicant can base a U.S. application on a pending application in a foreign country, provided the U.S. application is filed within six months of the filing of the foreign application.
3. The foreign filing date becomes the effective U.S. filing date, rather than the actual, later U.S. filing date.

4. An application can also be based on a foreign registration.

5. In both cases, the application must allege a bona fide intent to use the mark in the U.S., however, no use of the mark in the U.S. is necessary in order for the application to mature into a registration.

E. **Trademark rights can be acquired based on an International Registration pursuant to the Madrid Protocol, under Section 66 of the Lanham Act.**

   1. Beginning on November 2, 2003, a foreign applicant can utilize the Madrid Protocol in the United States if the application is located in a country which is a member of the Protocol.

   2. Under the Protocol, the owner of a foreign application or registration can obtain an International Registration ("I.R.") based on a home country ("basic") application or registration from the International Bureau ("I.B.") of the World Intellectual Property Organization ("WIPO") in Geneva.

   3. The owner of an I.R can then file a request for extension of protection of same mark in the U.S. through the I.B. The I.B. transmits the request to the U.S.P.T.O., which examines the request for extension of protection under Section 66 of the Lanham Act.
4. The Paris Convention provisions regarding the granting of an earlier filing date apply if the extension of protection is sought within six months of the filing date of the basic application in the foreign country.

5. An application under Section 66 must allege a bona fide intent to use the mark in the U.S., however, no use of the mark in the U.S. is necessary in order for the application to mature into a registration.

F. Priority Determination

1. In general, the first to file a federal trademark application in good faith achieves nationwide priority over all except a prior user in its region of use and anticipated region of expansion.

2. A filing based on only an intent to use must be perfected via use and registration to maintain and enforce its priority rights.

3. A filing based on a pending foreign application under the Paris Convention, or under a combination of the Paris Convention and the Madrid Protocol, may achieve a priority date up to six months earlier than the actual U.S. filing date. If the home country or basic application matures into a registration, the applicant does not need to use the mark in the U.S. in order to obtain a registration.

G. Famous marks may be entitled to protection from dilution under federal law.
1. Dilution means the weakening of a trademark's distinctiveness via its use by others, without permission from the trademark owner, even though such use may not be likely to cause confusion as to the source of goods or services.

2. Two basic forms of dilution have been recognized at the federal level:
   a. Dilution by blurring, where a mark identical or very similar to the plaintiff's mark is used on goods or services that are totally unrelated to those sold by the trademark owner, e.g., the use of XEROX for pasta sauce.
   b. Dilution by disparagement, where an identical or very similar mark is used in a context that demeans the plaintiff's mark or product, thus reducing its distinctiveness and value.
   • In dicta in a Supreme Court decision earlier this year, *Moseley v. V Secret Catalogue, Inc.*, 123 S.Ct. 1115 (2003), the Supreme Court questioned whether the Federal Dilution Act, Section 43(c) of the Lanham Act, truly provides for a cause of action for dilution by disparagement.

3. The trademark owner can obtain relief even though there may be no likelihood of confusion (consumers would not really believe that Xerox Corporation sells or endorses the pasta sauce).

4. A mark must be deemed "famous" to qualify for federal dilution protection. Section 43(c) of the Lanham
Act lists criteria that a court may consider to make this determination.

5. Under the holding in the Moseley case, a plaintiff must prove actual dilution of a famous mark, rather than mere likelihood of dilution, in order to prevail.

6. A federal registration is not required for a mark to qualify for protection.

7. Injunctive relief is available; monetary damages can be awarded only if willfulness on the part of the defendant is shown.

8. Dilution of a famous mark cannot be utilized by an examiner in the Patent and Trademark Office as grounds for refusing to register another mark. However, dilution can be used by the owner of the famous mark as a basis for challenging registration of another mark in inter partes (opposition or cancellation) proceedings in the Patent and Trademark Office.

H. Protection under state law

1. State common law provides rights and remedies similar to those available under Section 43(a) of the Lanham Act.

2. State trademark registration is available in all states but not in the District of Columbia.

   a. Usually relatively easy to secure, but with limited benefits, such as the ability to add a state statutory cause of action to an infringement complaint.
b. May prevent rivals from registering to do business in the state under the same name or from appropriating that name as a corporate name or assumed name.

c. Most states require use prior to filing an application, however, some allow intent-to-use applications.

3. State anti-dilution protection is available in 27 states. Usually, trademark registration in the state in not a prerequisite for dilution protection. Most statutes do not explicitly require the plaintiff’s mark to be "famous," and some courts have confirmed this, which may make such states more attractive for plaintiffs. In other states, courts have added the “famous” requirement.

I. Trademark Protection in Foreign Countries

1. This outline pertains mainly to United States trademark law. Trademark rights are territorial in nature. Each country has its own laws and registration regime. In general, while there are many similarities in the laws, obtaining trademark rights in one country will not automatically afford protection of the mark in other countries.

2. In most countries, unlike in the United States, trademark rights are almost solely dependent on registration. Also, a registration can be obtained without using the mark. However, non-use can result in cancellation of a registration in many countries.
3. There is no single international trademark registration system, although treaties exist that provide some uniformity and cross-border benefits. The United States recently joined the Madrid Protocol. Under the Protocol, which will be effective in the United States beginning November 2, 2003, a trademark applicant or registrant in one country may, after receiving an International Registration, designate other member countries to receive an application for extension of protection for the same mark. As of April 1, 2003, 57 countries had joined the Madrid Protocol. The European Union has a single trademark registration system, along with parallel registration systems in each country.

IV. BENEFITS OF FEDERAL REGISTRATION

A. Federal registration confers the benefit of nationwide constructive use and, thus, a right of priority, over all subsequent users or filers, as of the application filing date.

B. Registration is constructive notice of the registrant's rights as of the registration date. It prevents acquisition of common law rights by innocent adoption and use of the same or a similar mark by another.

C. A certificate of registration is, at the least, prima facie evidence and is, sometimes, conclusive evidence of the registrant's right to exclusive use of the mark and the validity of the mark's registration.

D. After 5 years, a registration can become "incontestable," meaning that it cannot be invalidated for
certain reasons, e.g., prior use of a conflicting mark or descriptiveness (but excluding genericness).

E. Registration permits the use of the "®" symbol or other statutory designations of registration, such as "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off."

F. Goods bearing a mark which infringes a registered mark may be excluded from entry into the U.S. by recordation with the U.S. Customs Service.

G. Registration furnishes the basis for foreign registration under the Paris Convention and the Madrid Protocol.

V. STRENGTH OF MARKS: THE SPECTRUM OF DISTINCTIVENESS

The scope of protection afforded to trademarks is directly related to their strength. This varies according to the type of trademark, i.e., how readily a consumer would primarily associate it with the goods or services in connection with which it is used, rather than view it as an indication of a particular source for the goods or services. The types of marks are generally categorized along a "spectrum of distinctiveness," as follows:

A. Coined or Fanciful Marks

These are the strongest types of marks. They are inherently distinctive, and have no meaning other than as trademarks. They do not suggest the product or a quality
associated with the product. Examples: KODAK film; EXXON gasoline.

B. Arbitrary Marks
   Typically, these can be actual words which have meaning, but their meaning does not describe or suggest the product or a quality associated with the product. Examples: PLEDGE furniture polish; MUSHROOMS for shoes.

C. Suggestive Marks
   These marks suggest a quality or characteristic of a product, but don't merely describe it. Some degree of thought is required in order to make the connection of the mark with the product. Examples: SPRINT for long distance telecommunications; SUPER FRESH for supermarkets.

D. Descriptive Marks
   Words which merely describe the goods or services cannot be protected as marks. However, such terms can, over time, acquire distinctiveness as indicia of origin, and then be protected. Examples: WOODWORKER'S SUPPLY for retail sales of woodworking items; PARK 'N FLY for airport parking services.

E. Generic Terms
   These terms are the apt names for goods or services. They can never be appropriated or protected as marks, as
competitors and the public need to be able to use them to refer to the goods or services. Examples: supermarket, escalator.

F. Acquisition of distinctiveness ("secondary meaning") for descriptive marks

1. Descriptive marks which are used substantially exclusively and continuously for five years acquire a presumption of distinctiveness under Section 2(f) of the Lanham Act.

2. Earlier acquisition of distinctiveness is possible via substantial use and advertisement resulting in consumer recognition of the mark as an indication of source.

3. The ability to date the acquisition of distinctiveness can be critical in priority battles.

4. If distinctiveness is only acquired in certain geographic areas, then the trademark rights may be limited to those areas.

VI. SPECIAL TRADEMARK SPECIES

A. Geographic Terms

1. Primarily geographically descriptive terms
   a. can be registered upon acquisition of "secondary meaning," except for appellations of origin for wines, which cannot be registered as trademarks under the GATT Uruguay Round treaty.

2. Deceptively misdescriptive geographic terms
a. cannot be registered even if "secondary meaning" can be shown, under NAFTA.

3. Fair use defense available

B. Surnames
1. Primarily, merely surnames are not trademarks
2. Acquisition of distinctiveness ("secondary meaning") is possible
3. Fair use defense - right to use one's own name -is very limited in the face of a strong surname mark

C. Product Configurations and Trade Dress
1. Can function as trademarks if inherently distinctive or upon a showing of secondary meaning.
2. If the trade dress sought to be protected is the design or configuration of a product itself, such as a line of children’s clothing with unique decorative features, secondary meaning will always have to be shown as a prerequisite for protection. Wal Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000).
3. The design or portion of the trade dress claimed as a trademark must be nonfunctional. If the trade dress is not registered as a trademark, it is the burden of the party claiming trade dress rights to show that it is nonfunctional. See, Trademark Amendments Act of 1999, amending the Lanham Act, Section 43(a).
4. If the trade dress sought to be protected is the design or configuration of the product itself, and the feature
for which protection is being sought was the subject of a utility patent, there will be a strong presumption that the feature is functional and not protectable trade dress. *Traf Fix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

D. **Colors**
   1. Protectable as components of design marks
   2. The color of a product itself is protectable and registrable as a trademark, but a showing of secondary meaning will always be required. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995); *Wal Mart Stores, Inc.*, Id.

E. **Sounds**
   1. Are protectable and registrable.
   2. May be considered inherently distinctive in certain cases.

F. **Scents**
   - Are registrable under a Patent and Trademark Office decision granting registration to a distinctive floral scent of sewing thread.

G. **Internet Domain Names**
   1. Can function as service marks and are registrable if distinctive and are used other than as mere domain names.
2. Are issued by domain name registrars on first come, first served basis.
3. Problems arise because domain name system allows different parties to obtain domain names that are extremely similar.
4. Problems have been exacerbated as the number of generic top level domains (e.g., "com," "org," "net") has expanded to include new domains such as "info," "biz" and "name," and the "us" domain has expanded to commercial use, and other country code top level domains, such as .ca, .uk and .de, have been used commercially or by cybersquatters.

VII. TRADEMARK SEARCHING

A. Purpose of a Trademark Search
1. The primary purpose of a trademark search is to ascertain the availability of a proposed mark. A proper search may disclose references to potentially conflicting marks, and further investigation may be warranted before the proposed mark can be considered available for use and registration.
2. It makes economic sense for a company to conduct a search prior to investing in a new mark which may later turn out to be in conflict with a senior mark.
3. A search will assist in judging the distinctiveness and, hence, scope of protection that may be accorded a mark. If many similar marks for similar goods
exist, the mark will be considered a "weak" mark and will be accorded a narrow scope of protection. If the mark is a word which has been "disclaimed" in registrations, it will likely be difficult to register that word alone as a trademark, although it may be registrable in a distinctive combination.

B. A Duty to Search?

1. Although there may not be a general affirmative legal duty to conduct a search prior to using or applying to register a mark, a search is extremely advisable. The failure to conduct a pre-adoption trademark search can be an intent factor considered by a court in an action for infringement.

2. Some courts have inferred a duty to search in certain circumstances. For example, where a company has a reason to believe that there may be a prior use of a similar mark, there is a duty to investigate further. Also, ignoring the advice of an attorney to broaden a screen search can have adverse consequences.

3. Certainly, attorneys should always advise clients to conduct pre-adoption searches.

C. Searchable Records

1. The United States Trademark Register
   a. Principal and Supplemental Registers
   b. Registrations and pending applications
   c. Cancelled registrations and abandoned applications
d. Searchable online for free at the PTO web site, www.uspto.gov. Private search companies also provide PTO records on CD-ROM and online.

2. State trademark registrations, searchable online.

3. "Common law" sources, e.g., telephone listings, trade directories, company and corporate name registries, Internet domain names, Internet web site search engines, (e.g., Goggle, AltaVista) and a variety of public and private business and product name databases available via private online services and the Internet.

4. There are several private search firms who perform trademark searches for set fees.

D. Limitations of the Search

1. A trademark search is never foolproof, and the limitations should typically be noted in the opinion letter.

2. PTO electronic records typically lag behind actual filings with the Office by several weeks.

3. A mark which seems clear on the day of a search may later be blocked by a subsequent filing of a new application, by a request for extension of protection under the Madrid Protocol, or by a foreign applicant who is entitled to a priority filing date under the Paris Convention.

4. A potentially conflicting application or registration which seems “dead” according to the search report may be revived by the applicant or registrant via a special petition or a grace period filing.
5. Even a so-called “comprehensive” search which includes common law sources can fail to disclose a pertinent use of a similar mark.

E. Information Needed for a Search
   1. Correct spelling of the mark
   2. Accurate depiction of any graphics
   3. Explanation of the meaning of a mark if it is an acronym, surname, geographic indication, in a foreign language, or has any meaning in the applicable industry
   4. Specific listing of the goods or services which will be sold under the mark

F. Analysis of the Search Results
   1. Evaluate “hits” on the basis of likelihood of confusion. Consider similarity of the two marks in appearance, sound and meaning, and the relatedness of the respective goods or services and their channels of trade.
   2. Consider whether the results (e.g., many similar marks, many marks with particular elements disclaimed) indicate that a mark or certain of its elements are generic, merely descriptive or extremely dilute and hence weak.

G. Dealing with Potential Conflicts
   1. Further investigation may indicate mitigating circumstances, such as:
a. The conflicting registration or application is or is about to be canceled or abandoned
b. The mark is not in use at all
c. The mark is entitled to only a very narrow scope of protection due to limited use.

2. Consider steps that may be taken to decrease the similarity between the two marks, such as the use of distinctive packaging, emphasizing the company name ("house mark"), or using a distinctive, stylized logo.

3. Consider an "intent to use" application in the PTO to test the waters, if there is sufficient lead time.

4. It may be advisable to seek a consent from the owner of the prior right.

H. The Risks of Ignoring a Conflict

In a famous case, the infringer was a large company which refused to acknowledge the possible prior rights of a small company. This resulted in the public wrongly assuming that the small company was infringing the large company's right ("reverse confusion"). In the case, Big O Tire Dealers Inc., v. Good Year Tire & Rubber Co., 408 F. Supp 1219 (D. Colorado 1976), a jury awarded $19,000,000 against the infringer (amount reduced on appeal).
VIII. LOSS OF TRADEMARK RIGHTS

A. Abandonment
   1. Abandonment is discontinuance of use with intent not to resume - Lanham Act, Section 45.
   2. "Use" to avoid abandonment must be bona fide in the ordinary course of trade, and not merely to reserve a right in a mark.
   3. Intent not to resume may be inferred from circumstances.
   4. Non-use for three consecutive years is prima facie evidence of abandonment.
   5. Partial abandonment:
      a. limited geographic area
      b. limited goods or services.
   6. Change in nature of goods or services sold under the mark.
   7. Change in nature of format of mark as used.
   8. A temporary suspension of use due to outside causes can constitute a defense to an abandonment claim.

B. Failure to Prosecute Infringers
   1. Failure to prosecute infringers usually evidences a weakness of the mark rather than abandonment; unless the third party use is overwhelming, and no effort is made to prevent it.

23
2. The trademark owner need only pursue one infringer at a time.

3. A reasonable amount of time is usually allowed to negotiate settlements of infringement disputes; this does not constitute abandonment.

C. Licensing Without Adequate Quality Control

D. Genericization of Mark
   1. It can be the consequence of commercial promotion which is too successful.
   2. The mark becomes the common descriptive name for the goods or services, and ceases to function as an indication of source.
   3. Examples
      a. marks which became generic:
         ASPIRIN, CELLOPHANE, ESCALATOR, THERMOS, GOLD CARD, SHUTTLE
      b. marks which have not become generic:
         BEER NUTS, HONEY BAKED HAM, KLEENEX, XEROX, SANKA, TEF/ON, TINKERTOY
   4. Steps must be taken to prevent genericization of famous marks.
   5. A federal registration of a mark which has become generic is subject to cancellation.
   6. The Federal Trade Commission has statutory power to apply for cancellation of generic marks under Lanham Act, Section 14. However, this power is limited by
the authority of Congress to cancel funding for such activities - e.g., the FORMICA case, and has not been exercised in many years.

IX. COMPARISON OF TRADEMARKS,
COPYRIGHTS AND PATENTS

A. Basis of Rights
   1. Trademark rights are a branch of the common law of unfair competition. Rights can be enhanced via registration under the federal Trademark Act of 1946, as amended, also known as the Lanham Act, 15 U.S.C. Secs. 1051 et seq., and state law. The Constitutional basis for federal trademark protection is the Commerce Clause, Article 1, Section 8, Clause 3.
   2. Copyrights and patents, and their corresponding federal statutes, are specifically derived from the Constitution, Article 1, Section 8, Clause 8.

B. Protected Subject Matter
   1. Trademarks - See Section A. 1. above.
   2. Copyrights - Works of creative expression fixed in a tangible medium.
   3. Functional Patents - Functional features of a process, machine, manufactured item or composition of matter.
   4. Design Patents - Ornamental features of manufactured articles.
C. Criteria for Protection
   1. Trademarks - Use in a manner which serves to identify source. Must be distinctive (and, for designs, nonfunctional).
   2. Copyrights - Work must be original, creative, and, for a three-dimensional design, have a form which is not dictated by the article's function, and be separable from the article.
   3. Functional Patents - Invention must be novel, useful, and non-obvious (distinguishable from "prior art").
   4. Design Patents - Item must be novel and non-obvious, and its form may not be dictated by its function.

D. Creation of Rights
   1. Trademarks - Use as a mark. Rights are enhanced by federal or state registration. Contingent nationwide priority rights are obtained by filing an application for federal registration.
   2. Copyrights - Automatic upon creation and fixation of a work in a tangible medium. Rights enhanced via use of copyright notice and federal registration.
   3. Functional and Design Patents - Dependent upon a federal government grant after application and substantive examination.
E. **Duration of Rights**

1. Trademarks - Common law rights endure as long as the mark is in use; federal registration rights are granted for a ten-year renewable term, subject to proof of continued use between the fifth and sixth year following registration and with every renewal application.

2. Copyrights – In general, for works created in or after 1978: life of the author plus 70 years; for works made for hire, the earliest of 95 years from publication or 120 years from creation. Subject to several exceptions and a constitutional challenge before the Supreme Court.

3. Functional Patents - Generally, 20 years from earliest U.S. filing date, but possibly longer for applications filed on or after May 29, 2000, depending on certain circumstances (delays in prosecution by the PTO). If filed before June 8, 1995, 17 years from grant if longer (provided maintenance fees are paid).

4. Design Patents - 14 years from the date of the grant.

F. **Test of Infringement**

1. Trademarks - Likelihood of confusion, mistake or deception

2. Copyrights - Copying of a substantial portion of the protected work. Copying is presumed if it can be shown that the accused infringer has access to the protected work and the two works are substantially similar.
Unauthorized creation of a work derived from the protected work is also infringement.

3. Functional Patents - Making, using or selling anything embodying the claimed subject matter.

4. Design Patents - Substantial similarity in the eyes of the ordinary observer.

**USEFUL REFERENCES**

Statutes and Publications


International Trademark Association, *United States Trademark Law, Rules of Practice, Forms & Federal Statutes*

Bacal, Barnaby, et al., *Trademark Administration* (INTA)
U.S. Patent and Trademark Office, Basic Facts About Trademarks (pamphlet)

McCarthy on Trademarks and Unfair Competition (Clark, Boardman)

Gilson, J., Trademark Protection and Practice (Matthew Bender)

Telephone Numbers

To ascertain status of application or registration:

   TRAM Automated Status Line          (703) 305-8747

For general information:

   PTO Trademark Assistance Center      (703) 308-9000

To order publications:

   Superintendent of Documents

   International Trademark Association (212) 768-9887

   American Intellectual Property       (703) 415-0780
   Law Association

Web Sites

American Intellectual Property Association - www.aipla.org

International Trademark Association - www.inta.org

World Intellectual Property Organization - www.wipo.int

Internet Corporation for Assigned Names and Numbers - www.icann.org

Trademark Search Companies and Databases

CCH CORSEARCH
Customer Service
233 Spring Street
New York, NY 10010
Phone: 800-732-75 or 212-228-4084
Fax: 212-228-5090
http://www.cch-corsearch.com

Thomson and Thomson
500 Victory Road
North Quincy, MA 02171-3145
Toll Free: 800-692-8833
Phone: 617-479-1600
Fax: 617-786-8273
http://www.thomson-thomson.com