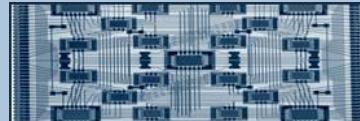


Intellectual Property Basics

TRADEMARKS

LawReviewCLE
March 22, 2012

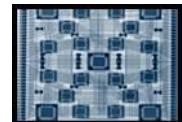
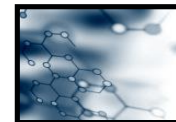
Speaker:
Salumeh R. Loesch





Trademarks

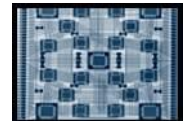
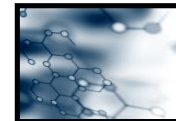
- ❖ Portland Vodka
- ❖ Nike Vodka
- ❖ Jim's Vodka





Strength of Mark

- ❖ Generic – Weakest
- ❖ Descriptive
- ❖ Suggestive
- ❖ Arbitrary – Strongest





Determine Whether The Name Is Already Being Used

❖ PTO's website



<http://tess2.uspto.gov/trademarks/index.jsp>

❖ Internet search

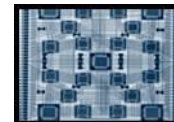
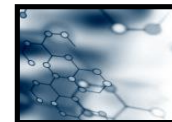


❖ Thomson-Reuters search



THOMSON REUTERS

<http://trademarks.thomsonreuters.com/searching/full-searches>





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Trademarks Home

What is a trademark or service mark?

A trademark is a brand name. A trademark or service mark includes any word, name, symbol, device, or any combination used or intended to be used to identify and distinguish the goods/services of one seller or provider from those of others, and to indicate the source of the goods/services. Although federal registration of a mark is not mandatory, it has several advantages, including notice to the public of the registrant's claim of ownership of the mark, legal presumption of ownership nationwide, and exclusive right to use the mark on or in connection with the goods/services listed in the registration.

WARNING: NON-USPTO SOLICITATIONS THAT MAY RESEMBLE OFFICIAL USPTO COMMUNICATIONS: Be aware that private companies **not** associated with the USPTO often use trademark application and registration information from the USPTO's databases to mail or e-mail trademark-related solicitations.

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TRADEMARK BASICS

View How-To Videos, FAQs, the Basic Facts Booklet, processing timelines and the ID Manual.

Tools

TESS

search trademarks

Search pending and registered marks using the [Trademark Electronic Search System \(TESS\)](#).

TEAS

file trademarks online

File applications and other documents online using the [Trademark Electronic Application System \(TEAS\)](#).

TSDR

check status & view documents

Check the status of an application and view and download application and registration records using [Trademark Status and Document Retrieval \(TSDR\)](#) (combining TARR and TDR).

ASSIGN

assignments

Transfer (assign) ownership of a mark to another entity or change the owner name and search the [assignments database](#).

TTAB

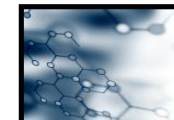
trademark trial & appeal board

Visit the [Trademark Trial and Appeal Board \(TTAB\)](#) online.

DASHBOARD


Visit the [Trademark Dashboard](#) for Trademark Operation performance measurements.


Search pending and registered marks using the Trademark Electronic Search System (TESS).





Structured Search

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Welcome to the **Trademark Electronic Search System (TESS)**. This search engine allows you to search the USPTO's database of registered trademarks and prior pending applications to find marks that may prevent registration due to a **likelihood of confusion** refusal.

WARNING: Before conducting your search, you must understand the following: (1) what the database includes; (2) how to construct a complete search; and (3) how to interpret the search results. Click [TESS TIPS](#) for detailed information on these and other important search topics.

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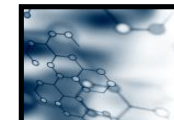
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- ▶ [Basic Word Mark Search \(New User\)](#)
This option cannot be used to search design marks.
- ▶ [Word and/or Design Mark Search \(Structured\)](#)
This option is used to search word and/or design marks.
NOTE: You must first use the [Design Search Code Manual](#) to look up the relevant Design Codes.
- ▶ [Word and/or Design Mark Search \(Free Form\)](#)
This option allows you to construct word and/or design searches using Boolean logic and multiple search fields.
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This option browses all fields in the database unless you limit to a particular field. Results are returned in a dictionary-style (alphabetic) format.
- ▶ [Search OG Publication Date or Registration Date \(Search OG\)](#)
This option searches the Official Gazette for marks published or registered on a particular date.

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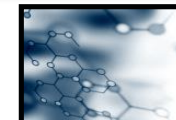
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Search Term: Field: Operator

Search Term: Field:

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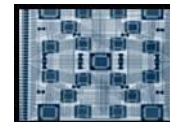
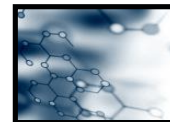
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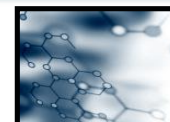
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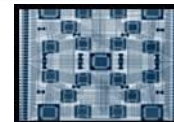
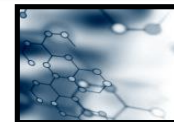
List At: OR to record: **4 Records(s) found (This page: 1 ~ 4)**

Refine Search

Current Search: S1: **(Jim)[BI] and (Liquor)[GS]** docs: 4 occ: 12


	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	76458682	2773356	JIM BEAM	TARR	LIVE
2	74256899	1753005	DIAMOND JIM'S	TARR	LIVE
3	74256898	1749052	JIM'S	TARR	LIVE
4	73716564	1555941	JIM BEAM	TARR	DEAD

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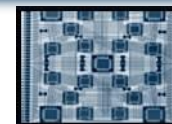
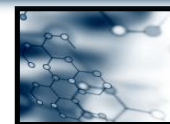
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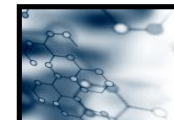
Refine Search

Current Search: S1: [\(Jim\)\[B\]](#) and [\(033\)\[C\]](#) docs: 35 occ: 85

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	85528420		DIAMOND JIM WHISKEY	TARR	LIVE
2	85249810	4068642	JIM BEAM BEAM FORMULA B A STANDARD SINCE 1795 DEVIL'S CUT 90 PROOF KENTUCKY STRAIGHT BOURBON WHISKEY	TARR	LIVE
3	85166500		JIM BEAM, BEAM FORMULA, B, A STANDARD SINCE 1795, DEVIL'S CUT, 90 PROOF, KENTUCKY STRAIGHT BOURBON WHISKEY, AS BOURBON AGES, THE ANGEL'S SHARE IS LOST TO EVAPORATION., THE DEVIL'S CUT IS TRAPPED IN THE BARREL WOOD-UNTIL NOW., JIM BEAM DEVIL'S CUT IS A DISTINCTLY BOLD BOURBON, WITH RICH FLAVOR UNLOCKED FROM DEEP INSIDE THE BARREL.	TARR	DEAD
4	85071531		TRADER JIM	TARR	DEAD
5	78653575	3100633	JIM JIM	TARR	LIVE
6	77715687	3798400	RED STAG BY JIM BEAM	TARR	LIVE
7	77345174	3584292	JIM BALL VINEYARDS	TARR	LIVE
8	77257970		JIMSLIM	TARR	DEAD
9	76022553	2628902	JIMTOWN	TARR	LIVE
10	76513554	2824820	JIM BEAM BLACK	TARR	LIVE
11	76458682	2773356	JIM BEAM	TARR	LIVE
12	76310039	2639099	THE WORLD'S FINEST BOURBON JIM BEAM BLACK SOUR MASH KENTUCKY STRAIGHT BOURBON WHISKEY AGED 8 YEARS 86 PROOF BEAM FORMULA B A STANDARD SINCE 1795	TARR	LIVE
13	76184128	2665418	JIM BEAM THE WORLD'S FINEST BOURBON KENTUCKY STRAIGHT BOURBON WHISKEY DISTILLED AND BOTTLED BY JAMES B. BEAM DISTILLING CO. BEAM CLERMONT FRANKFORT, KENTUCKY USA	TARR	LIVE
14	75307682		JIM BEAM ROADHOUSE	TARR	DEAD
15	75239036	2436072	JIM BEAM KENTUCKY ROADHOUSE	TARR	DEAD
16	75169941	2103211	JIM PORTER	TARR	LIVE
17	74694469	1973075	JIM BEAM CLASSIC COCKTAILS	TARR	DEAD
18	74676951	1985392	JIM BEAM CELEBRATE 200 YEARS OF PERFECTION BEAM FORMULA A STANDARD SINCE 1795 B	TARR	DEAD

19	74652787	1973715	JIM BEAM 1795 1995 BEAM FORMULA A STANDARD SINCE 1795 200TH ANNIVERSARY	TARR	DEAD
20	74422842		SPLASHERS FROM JIM BEAM	TARR	DEAD
21	74422824		JIM BEAM SUN SPLASHES	TARR	DEAD
22	74422823		JIM BEAM SPLASHERS	TARR	DEAD
23	74422822		SUN SPLASHES FROM JIM BEAM	TARR	DEAD
24	74328123	1849549	JIM BEAM: THE NEW AMERICAN FRONTIER	TARR	DEAD
25	74314072		JIM BEAM BASIC DREAM TEAM 78 58 29 62 83 45 93 52 61 15 49 AMERICAN BASIC B	TARR	DEAD
26	74285777	1752807	JIM BEAM AND COLA	TARR	DEAD
27	74237135		JIM BEAM'S LEXINGTON	TARR	DEAD
28	74237126	1854280	JIM BEAM AMERICAN B BASIC	TARR	DEAD
29	74201897	1722289	JIM BEAM	TARR	LIVE
30	74159157	1749559	JIM BEAM BARREL-BONDED	TARR	DEAD
31	73353669		JIM GRANT	TARR	DEAD
32	71596150	0544365	JIM BEAM	TARR	LIVE
33	72161284	0758535	JIM DANT	TARR	DEAD
34	72141922	0756197	DIAMOND JIM'S	TARR	DEAD
35	71669146	0607406	OLD JIM GORE	TARR	DEAD

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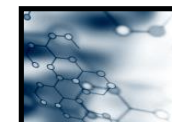




Sample Registration For JIM BEAM BLACK

Typed Drawing

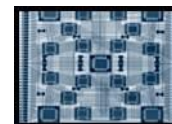
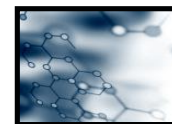
Word Mark	JIM BEAM BLACK
Goods and Services	IC 033. US 047 049. G & S: ALCOHOLIC BEVERAGES, NAMELY, WHISKEY. FIRST USE: 19920100. FIRST USE IN COMMERCE: 19920100
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76513554
Filing Date	May 12, 2003
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	December 30, 2003
Registration Number	2824820
Registration Date	March 23, 2004
Owner	(REGISTRANT) JIM BEAM BRANDS CO. CORPORATION DELAWARE 510 Lake Cook Road Deerfield ILLINOIS 60015
Attorney of Record	Lynn A. Sullivan
Prior Registrations	0544365;2639099;2773356
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Other Data	The name "JIM BEAM" does not identify a living individual.
Live/Dead Indicator	LIVE





Problems Along The Way

- ❖ Cease & Desist Letter
- ❖ TTAB:
 - ◆ Opposition to Application
 - ◆ Cancellation Proceeding
- ❖ Litigation

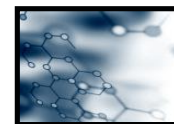




Likelihood Of Confusion

TTAB's likelihood of confusion test (*DuPont* factors):

- (1) **The similarity of marks**
- (2) **The similarity and nature of the goods or services**
- (3) **Channels of trade**
- (4) **Class of customers**
- (5) **Fame of prior mark**
- (6) Similar marks in use on similar goods
- (7) **Actual confusion**
- (8) Concurrent use without evidence of actual confusion
- (9) Variety of goods on which a mark is or is not used (house mark, "family" mark, product mark)
- (10) Applicant and the owner of a prior mark (consent, agreements, assignments, laches)
- (11) Applicant's right to exclude others from use of its mark on its goods
- (12) Potential confusion, i. e., whether *de minimis* or substantial
- (13) Any other established fact probative of the effect of use

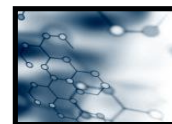




Likelihood Of Confusion

9th Circuit's likelihood of confusion test (*Sleekcraft* factors):

- ❖ Strength of the mark
- ❖ Proximity of the goods
- ❖ Similarity of the marks
- ❖ Evidence of actual confusion
- ❖ Marketing channels used
- ❖ Type of goods and the degree of care likely to be exercised by the purchaser
- ❖ Defendant's intent in selecting the mark
- ❖ Likelihood of expansion of the product lines

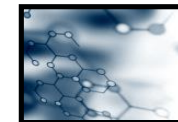




Dilution

To prove dilution, a trademark owner (“Plaintiff”) must show:

- ❖ It owns a famous mark that is distinctive
- ❖ The defendant is using a mark in commerce that dilutes the plaintiff’s distinctive mark
- ❖ The plaintiff’s mark became famous before the defendant began using its mark
- ❖ The defendant’s use of the mark is likely to cause dilution by blurring or by tarnishment





QUESTIONS?



Salumeh R. Loesch

salumeh.loesch@klarquist.com

Klarquist Sparkman, LLP

