



SHEducation

IP Law for Writers

Class 2 of 3:

Trademark and

Contracts

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Reminder/Caveat

- **I am not a lawyer. I do not give legal advice** (though I can share information, including that you might need a lawyer).
- I'm certified in Intellectual Property Management via the University of Maryland.
- I teach IP law in New Media at Bradley (retired, but will teach the course in 2024-2025).
- I'm lead author & co-author of 2 books (in 2 editions) on IP law in New Media.
- **Part One Note: Copyright fee for online registration of a single work IS \$35.00 as noted.**

Trademarks 101

- You may want to establish a trademark to protect your brand and/or work.
- You might encounter trademarks and want to include/use them.
- You do not want to infringe trademarks.
- Fair use might apply, but usually less often than in copyright instances.

A **trademark** is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others.

A **service mark** is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.

- Kodak
- Exxon
- Coca Cola
- Mc Donald' s
- Starbucks
- Walmart
- MTV
- Victoria' s Secret
- Polaroid
- Xerox
- Lego
- Beanie Babies
- Kraft
- Playboy
- Apple
- Dell



Before using a mark, or applying to register one, you should search to see if it's already registered for use

➤ Trademark Searches

- www.uspto.gov
- Private search firms (best to use one)
 - Will pick up “common law” uses
 - Expensive (\$400 - \$500) per mark searched
- <http://tess2.uspto.gov/bin/gate.exe?f=search&state=896lck.1.1>



Trademark Electronic Search System (TESS)

TESS was last updated on Tue Mar 4 04:11:31 EST 2003

- [PTO HOME](#)
- [TRADEMARK](#)
- [TESS HOME](#)
- [STRUCTURED](#)
- [FREE FORM](#)
- [BROWSE DICT](#)
- [BOTTOM](#)
- [HELP](#)

[View Search](#)



[History:](#)

WARNING: AFTER [SEARCHING](#) THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED AT THE USPTO. AFTER YOU FILE AN APPLICATION, THE USPTO MUST DO ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT [REFUSE TO REGISTER](#) YOUR MARK.

- Plural and Singular
- Singular
- Both
- Live
- Dead

Search Term:

Field:

Result Must Contain:

Logout *Please logout when you are done to release system resources allocated for you.*

 Start List At: OR Jump to record: **29 Records(s) found (This page: 1 ~ 29)**

(GOOGLE)[COMB]

Refine Search

Current Search: S2: (GOOGLE)[COMB] docs: 29 occ: 62

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	78049046		OOGLES AND GOOGLES OF STUFF	TARR	DEAD
2	78049049		DUNKERDOO "OOGLES AND GOOGLES OF STUFF"	TARR	DEAD
3	78027659		GOOGLEBERRIES	TARR	DEAD
4	76314811		GOOGLE	TARR	LIVE
5	76314783		GOOGLE	TARR	LIVE
6	76314782		GOOGLE STORE	TARR	LIVE
7	76453281		OOGLES-N-GOOGLES	TARR	LIVE
8	76169077	2603895	GOOGLES	TARR	LIVE
9	76066286		GOOGLEGEAR	TARR	LIVE
10	76043010	2467657	GOOGLES	TARR	LIVE
11	75572905	2554518	GOOGLES	TARR	LIVE
12	75978469		GOOGLE	TARR	LIVE



Google

Word Mark GOOGLE

Goods and Services IC 009. US 021 023 026 036 038. G & S: Computer software for searching, compiling, indexing and organizing information on computer networks; computer hardware, computer software for searching, compiling, indexing, and organizing information within individual workstations, personal computers; computer software for electronic mail and workgroup communications over computer networks; computer software for creating indexes of information, indexes of web sites and indexes of other information resources; mouse pads, calculators. FIRST USE: 20010400. FIRST USE IN COMMERCE: 20001211

IC 011. US 013 021 023 031 034. G & S: Flashlights, lamps. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

IC 012. US 019 021 023 031 035 044. G & S: License plate frames and holders. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

IC 016. US 002 005 022 023 029 037 038 050. G & S: Books, notebooks, pens, greeting cards, stickers, decals. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100

IC 018. US 001 002 003 022 041. G & S: Bags, namely, tote bags, duffle bags, backpacks; luggage tags; umbrellas. FIRST USE: 19990100. FIRST USE IN COMMERCE: 19990100



graphic and audio visual information, by means of global computer information networks. FIRST USE: 19970900. FIRST USE IN COMMERCE: 19970900

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 76314811

Filing Date September 18, 2001

Owner (APPLICANT) Google Inc. CORPORATION CALIFORNIA 2400 Bayshore Parkway Mountain View CALIFORNIA 94043

Attorney of Record Julia Anne Matheson

Description of Mark The first letter "G" is blue; the second letter "O" is red; the third letter "O" is yellow; the fourth letter "G" is blue; the fifth letter "L" is green; and the sixth letter "E" is red.

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

How do I acquire trademark rights?

- From use of the mark **in commerce**
 - Within a particular segment of the economy (as defined by the Trademark office)
 - Within a specified geographic area (as specified by where you do business and/or the area for which you apply)

What is use in commerce?

- **For goods:** the mark must appear on the goods, the container for the goods, or displays associated with the goods, and the goods must be sold or transported in commerce.
- **For services:** the mark must be used or displayed in the sale or advertising of the services, and the services must be rendered in commerce.
- Again, the economic niche(s) and geographic area(s) in question.

Mark Must Be “Distinctive”

Fanciful Arbitrary Suggestive Descriptive Generic y Generic n

Mark Must Be “Distinctive”

- Fanciful (Exxon)
- Arbitrary (Apple)
- Suggestive (Coca-Cola)
- Descriptive (Expert Plumbers)
- Generic yes (Xerox)
 - When a trademark from “above” category falls into “Generic,” there is a risk of loss of rights. Xerox and Kleenex (for example) have to fight hard to protect their marks.
- Generic no (Tissues)

Is registration of a mark required?

No. You can establish rights in a mark based on legitimate use of the mark in commerce.

Why Register?

- constructive notice to the public of the registrant's claim of ownership of the mark;
- a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;

Why Register?

- the ability to bring an action concerning the mark in federal court;
- the use of the U.S registration as a basis to obtain registration in foreign countries; and
- the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

Where to Register?

➤ State Registrations

- Cheaper (Illinois = \$15)
- Statewide protection

➤ Federal Registrations

- The cost to apply for a U.S. trademark is now \$325 per class of goods and services (if you use the electronic filing system). It may be even lower (\$275) if the applicant uses a pre-ordained description of good and services

When can I use the trademark symbols TM and SM?

- Any time you claim rights in a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO.

When can I use the trademark symbol ®?

- You may use the federal registration symbol "®" **only** after the USPTO actually *registers a mark*, and **not** while an application is pending. Also, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration.

What must an application include?

- the name of the applicant;
- a name and address for correspondence;
- a clear drawing of the mark;
- a listing of the goods or services; and
- the filing fee for at least one class of goods or services.

How long does a federal trademark last?

- 10 years
- Renewable for successive 10 year periods
- After 5 years, with proper filings, mark becomes “incontestable”

Trademark Infringement and Dilution

What is a trademark Infringement?

- Senior user owns mark
- Junior user begins to use the same or similar mark on the same or similar goods or services
- **Likelihood of confusion in market**

Who is the law protecting?

➤ Consumers

- The public's right not to be confused

➤ Mark owners

- The right to develop brand awareness
- The right to prevent free-loaders from trading on the mark owner's good will and reputation in the market place

What law applies

➤ Federal Statutes

- The Lanham Act

- [15 U.S.C. §§ 1051 - 1127](#)

➤ State Statutes

- Counterfeit Trademark Act

- 765 ILCS 1049

- <http://www.legis.state.il.us/legislation/ilcs/ch765/ch765act1040.htm>

➤ Judicial Decisions

Infringement Penalties

- Infringers shall be liable in a civil action by the registrant for the remedies hereinafter provided.
 - Injunction
 - Defendant's profits
 - Plaintiff's damages
 - Costs
 - Attorney's fees (if infringement willful)

Likelihood of Confusion Factors

- Similarity of the Marks
- Similarity of the Products
- Area and Manner of Concurrent Use
- Degree of Care Exercised by Consumers
- Strength of Plaintiff' s Mark
- Actual Confusion
- Intent of Defendants

Types of Confusion

- Forward
 - Small Junior trades off of Big Senior User
- Reverse
 - Big Junior saturates market and overwhelms Small Senior User
- Initial Interest
 - Confusion that creates an initial customer interest (e.g. meta-tags, domain names)
- Post-Sale
 - Confusion of someone other than purchaser

Legal Specifications

- The Lanham Act provides the legal framework for Trademark Law.
- The Anticybersquatting Consumer Protection Act (ACPA) adds aspects for online issues.

URLs (domain names) are a Trademark issue

- We will take this up Saturday the 24th as it belongs/goes with other on-line issues.
- For now, let's note that using trademarks inappropriately, online, can involve infringing the marks themselves AND/OR infringing the domain names/URLs of the protected mark owners.

Three Types of Trademark Violations

- **Confusion**
- **Dilution**
- **Tarnishment**
- We have already mentioned/discussed confusion as it is the most basic (and perhaps the most often-confronted) question.

Trademark Dilution

- Lessening of a famous mark to identify and distinguish goods and services
- **Irrespective of:**
 - Competition between owner of mark and other parties; or
 - **Likelihood of confusion, mistake or deception**

Trademark Dilution

- “Blurring” distinctiveness of mark
- “Tarnishing” reputation of mark

Some Contract Considerations

- You can assume that most publishers will want as many rights as they can get.
- Most published work either loses money or makes very little.
 - Publishers hope that your work does A LOT better, but knows that it may not
 - Recovering their costs is a crucial factor.
- To that end, most publishers will probably open the bidding by sending you their boilerplate contract. That document will favor them in every way you can imagine (and some you've probably not thought about).

To what extent do you want to cede your copyright to your publisher?

- Everything, always and forever?
 - Not uncommon for the first publication.
 - Subsequent work might offer “wobble room.”
- Less than the entire suite of rights or for limited terms?
 - Which rights would you retain?
 - Which forms of the work do you want to reserve?
 - For how long?
- Retaining rights means limiting the publisher by modifying their contract. It's a negotiation over what you sign.

Some Rights for Negotiation I

- Translations: Allowing publisher to keep these rights is almost automatic. You probably WANT (overseas marketing)
- Derivative works:
 - Online versions/extended excerpts, audio books, video rendering, stage plays, screenplays, podcasts, sequels, pre-quals, etc.
- Republication:
 - in whole (common as in multiple printing or editions);
 - or in part (anthologize).

Some Rights for Negotiation II

- Right to add co-authors (either as profit participant or as content modifier).
- Avoid accepting “% after costs.”
- Expect them to avoid accepting your partial participation or “final edit/approval” for ceded rights

Some Rights for Negotiation III

Indemnification

- **HUGE RED FLAG RED FLAG** in almost every boilerplate.
- The publisher wants you to promise that you will defend against all infringements claims
 - indemnify them—promise to hold them blameless and cover defense costs.
- I refuse to sign it. I insert language that
 - I've not infringed.
 - That I'll pay defensive costs only after being found, by complete legal process, to have infringed.

You can see what I last taught in the IP in New Media class at BU:

- <http://interactivemedia.bradley.edu/ell/im450/IP450/fall22/im450-01fall2022.html>
- Each class day's lecture is a .pdf, so you can get additional details if wanted.

Q&A

