



Trademark That Thursdays

Definitions by Neena

Definitions You Need to Know:

Trademark:

remember it identifies the source of goods and must be distinctive

- **Word Mark:** words that you want protected (not stylized)
- **Sound Mark:** distinctive noises associated with your brand
- **Smell Mark:** distinctive smell associated with your brand
- **Design Mark:** logo or trade dress

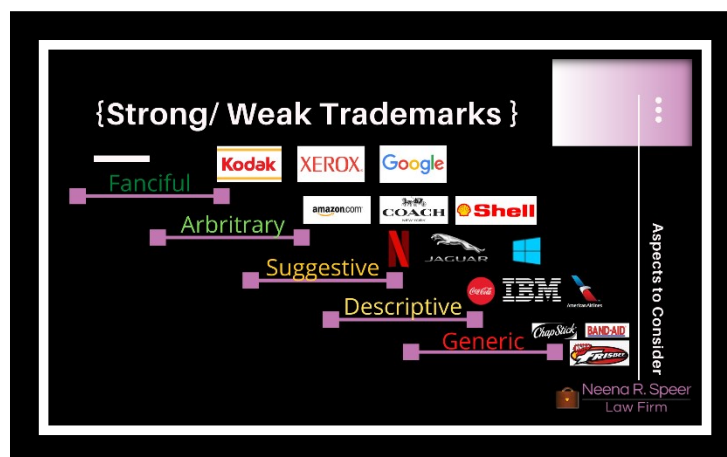
Specimen:

This is a screenshot, a video, a MP3, marketing materials and other items proving you use it commerce

Mark:

How you can recognize your symbol word or phrase in the market (words on a website, logos on shipping packaging)

- **Strength of the Mark**



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Office Action:

Hurdles that are common are 2(d) refusals which is a refusal if you have a previously registered trademark that conflicts with your client's mark. These can be overwhelming, and it is important to approach these with caution.

™ vs. ® vs. ©:

- ™ stands for unregistered trademark that is in the process of being applied for or to scare away copycats
- ® stands for registered trademark in the USPTO database
- © stands for a registered copyright that can be protected from unauthorized copying in the market (fixed creative works of authorship)

1A Applications:

Purpose:

For clients with goods and services that are already in use that they are trying to protect to make distinctive

Process:

Purple means an ideal path

File → USPTO Reviews App → Published for Opposition OR Non-Final Office Action → Notice of Allowance Permitted OR Respond to Office Action → USPTO Registers Trademark Or Final Office Action Issued → Section 8 Filing → Section 8 and Section 10 Filing

1B Applications:

Purpose:

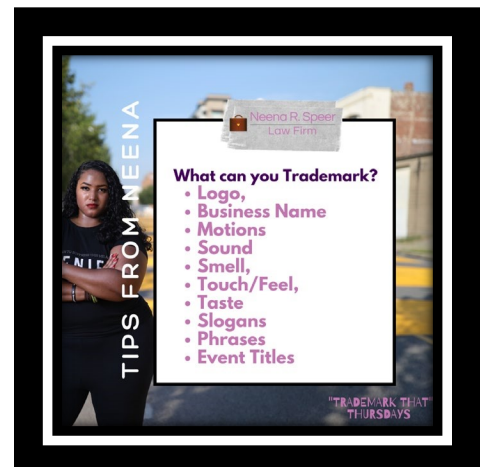
For clients with goods and services they intend to use in the next few months that they are trying to protect to make distinctive

Process:

Purple means an ideal path

File → USPTO Reviews App → Published for Opposition OR Non-Final Office Action → Notice of Allowance Permitted OR Respond to Office Action → Statement of Use (SOU) Filing and Specimen Must Be Submitted (extra filing fee) → USPTO Approves your SOU OR USPTO Rejects Your SOU → USPTO Registers Trademark Or Final Office Action Issued → Section 8 Filing → Section 8 and Section 10 Filing

What can you Trademark?





Lack of Black IP Lawyers

“Law firm demographics, shows that 1.8 percent of IP attorneys are African American “¹

Black Men in IP Missing Example Testimonials²

Cooley’s Joseph Drayton (quotes)

- Benefited from a black role model
- Saw a prominent lawyer who looked like him which contributed to his vision of success
- We must invest in and bet on black IP attorneys, good things tend to happen

Kasowitz’s Jonathan Waldrop (quotes)

- Lucky enough to land in places where people saw something in me, and I was willing to receive it
- Tech industry is “uneven” when it comes to openness to minority lawyers
- If they don’t open the pool to see what’s out there, they don’t know what they’re missing

Black Women in IP Missing Example Testimonial³

Jeanne Gills, Foley & Lardner(quotes)

- General Counsel states don’t know any qualified black patent attorneys
- We must provide mentors and advocates for young attorneys
- It is terrible black women make up less than 1% of the equity partners in law firms
- We’re still being judged, feared, devalued
- Imagine playing Monopoly with no starting money and no property but everyone else is much more ahead

¹ J. Shontavia Johnson, Tonya M. Evans, and Yolanda M. King, *Diversifying Intellectual Property Law: Why Women of Color Remain “Invisible” and How to Provide More Seats at the Table*, LANDSLIDE, VOL. 10, NO. 4, MARCH/APRIL 2018 (Last viewed November 11, 2020 at 7:00 AM), https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2017-18/march-april/diversifying-intellectual-property-law/

² Scott Graham, *“Take That On”: Black Patent Attorneys Say It’s Time They Are Recognized*, LAW.COM (June 12, 2018 at 5:58 PM), <https://www.law.com/therecorder/2020/06/12/take-that-on-black-patent-attorneys-say-its-time-they-are-recognized/>

³ *Id.*