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# Aligning Brand Use with Trademark Rights

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The screenshot shows the Practical Law website homepage. At the top, there is a navigation bar with "US" and "Change country" on the left, and "Login" on the right. The main header features the "Practical Law" logo, "A THOMSON REUTERS LEGAL SOLUTION", and navigation links for "Practice Areas", "Resources", "International", and "My Practical Law". A search bar is located below the header, with "SEARCH IN All US" and a search icon. A blue banner below the search bar reads "New to Practical Law? We offer lawyers a better place to start." and includes a "Sign Up for a Free Trial" button and a link for "Already a subscriber? Login". The main content area features a testimonial from Eric Lee, a Practical Law Intellectual Property & Technology expert, with a "Read more" button. Below this is a "Browse our Content" section with a grid of practice areas: Antitrust, Arbitration: International, Bankruptcy, Capital Markets & Securities, Commercial, Corporate and M&A, Employee Benefits & Executive Compensation, Finance, Intellectual Property & Technology, Labor & Employment, Litigation: Federal, Real Estate, and Tax. To the right of the testimonial is a "What Are You Working On?" section with a "Get Started Now" button. Below that is a "Testimonials" section featuring a quote from Alan Berkeley, Partner at K&L Gates LLP, with a "View More" button.

# The Problem: Misalignment

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## Business

- Branding and marketing decisions often involve:
  - New, creative approaches
  - Uncertainty about what is protectable
  - Speedy implementation
  - Single efficient approach globally vs. localized markets

## Legal

- Trademark counsel must be concerned about:
  - Consistent, long-term use
  - Knowing what is protectable
  - Careful consideration of risk and cost
  - Territorial differences in trademark laws

# Advantages of Protecting Brand Through Trademarks

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## Business

- Enhances Product Recognition/ Reputation
- Builds Brand Equity
- Helps Build Brand Loyalty
- Helps With Product Positioning
- Aids in Introduction of New Products

## Legal

- Valuable Assets
- Geographic Scope
- Legal Presumption of Exclusive Ownership
- Enhanced Remedies for Infringement
- Prevent Importation
- Renewable / Incontestability

## What is a Trademark

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- A trademark is a word, phrase, symbol, and/or design 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 goods.

# Associated Trademark Costs

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- Creation / Selection
- Clearance
- Registration process, which vary depending on the countries and the categories of products
- Monitoring and enforcement
- Rebranding

## Is Registration of Trade Name Sufficient?

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- Misconception: many people believe that by registering their business and its trade name at the business registry and/or a domain name, this name would also be automatically protected as a trademark.
- Companies may use a specific trademark to identify all their products, a particular range of products or one specific type of product. Some companies may also use their trade name, or a part of it, as a trademark. They should, in that case, register it as a trademark.

# Establishing Rights in a Trademark

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- Trademarks are territorial with different requirements in different countries.
- Some countries examine and refuse applications on absolute grounds only, while others also consider relative grounds.
- In some countries, particularly those with legal systems based on common law, using a mark can establish common law rights.
- In others, the first registrant of a mark acquires exclusive rights.
- Unlike the United States, most countries do not require a mark to be used before it is registered.
- Registration of a mark in one language does not always prevent others from adoption of mark in another language.



# Protectable Elements

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- Name, Word or Phrase
- Slogan or Tagline
- Graphic/Logo (still or animated)
- Color
- 3-dimensional shape & Trade dress
- Scent
- Sound
- Collective Marks
- Certification Marks

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**SVB** >

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# Where and How Trademarks are Used

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- On products, packaging, labeling
- On invoices
- On marketing materials, brochures, flyers, business cards, billboards, tradeshow signage, promotional merchandise
- Online
  - In domain names
  - On website(s)
  - As keywords for searching and other advertising
  - In social media (static and dynamic content)

# Selecting a Trademark

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- Check that mark meets all the legal requirements for registration.
- Conduct a clearance search to make sure that it is not identical or confusingly similar to existing trademarks.
- Make sure the trademark is easy to read, write, spell and remember and is suitable to all types of advertising media.
- Make sure the mark does not have any undesired connotations in your own language or in any of the languages of potential export markets.
- Check that the corresponding domain name and social media usernames/pages are available for registration.

# Spectrum of Distinctiveness

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<b>Generic</b>	<b>Descriptive</b>	<b>Suggestive</b>	<b>Arbitrary</b>	<b>Fanciful</b>
A common term that fails to distinguish one product source from another	Words that describe the nature, quality or contents of a product	A word or phrase that hints at product attribute	A common word used in an unrelated context	Wholly invented sign, symbol, word, or phrase
Not protectable	Protectable ONLY with secondary meaning	Generally protectable	Almost always protectable	Most protectable



Less distinctive



More distinctive

# Use Requirements

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- Use as a prerequisite to U.S. registration
  - Goods (Classes 1-34)
    - On product or packaging, labels, tags
    - On point-of-sale display associated with goods
    - Peculiar examples of goods and appropriate specimens
  - Services (Classes 35-45)
    - On advertising or marketing materials
    - In course of providing the services
- Use after registration
  - Maintenance and renewal
  - Non-use cancellation
  - Non-Trademark Use

# Acceptable Specimens of Use in the USPTO

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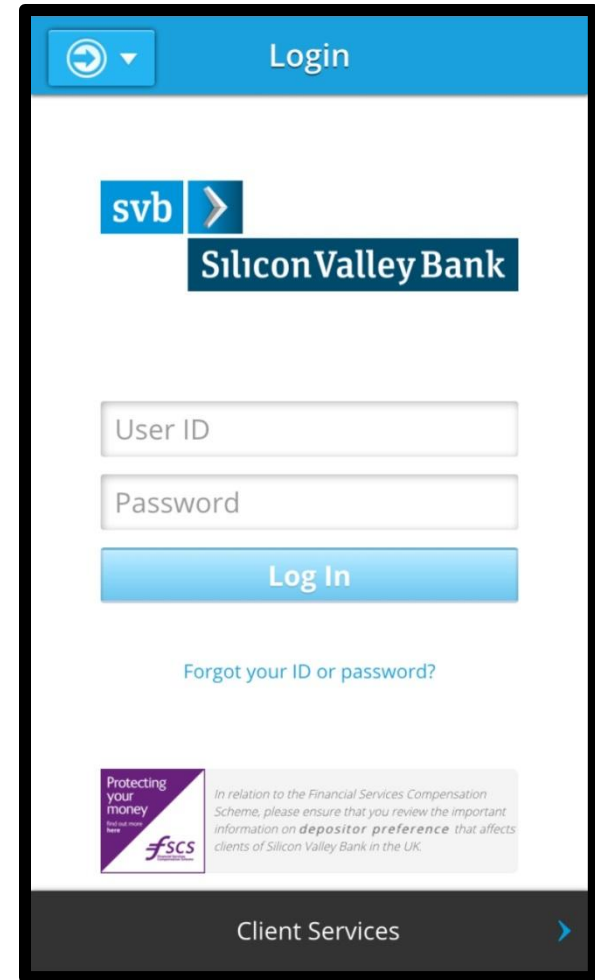
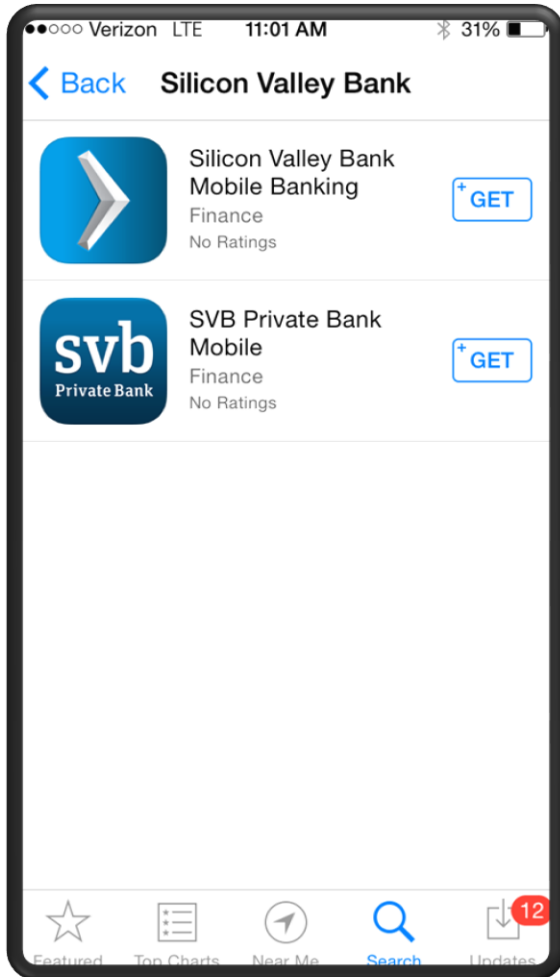
### Events

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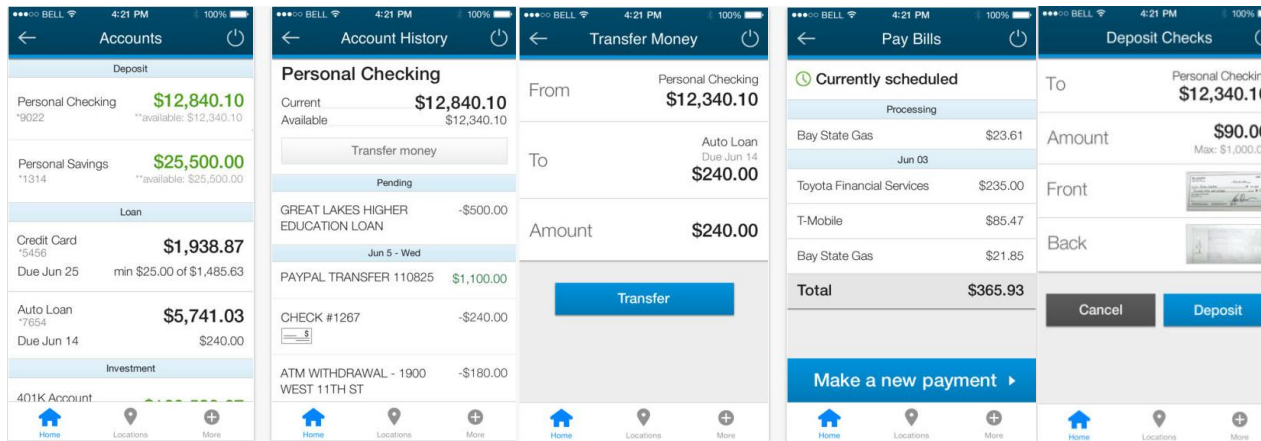
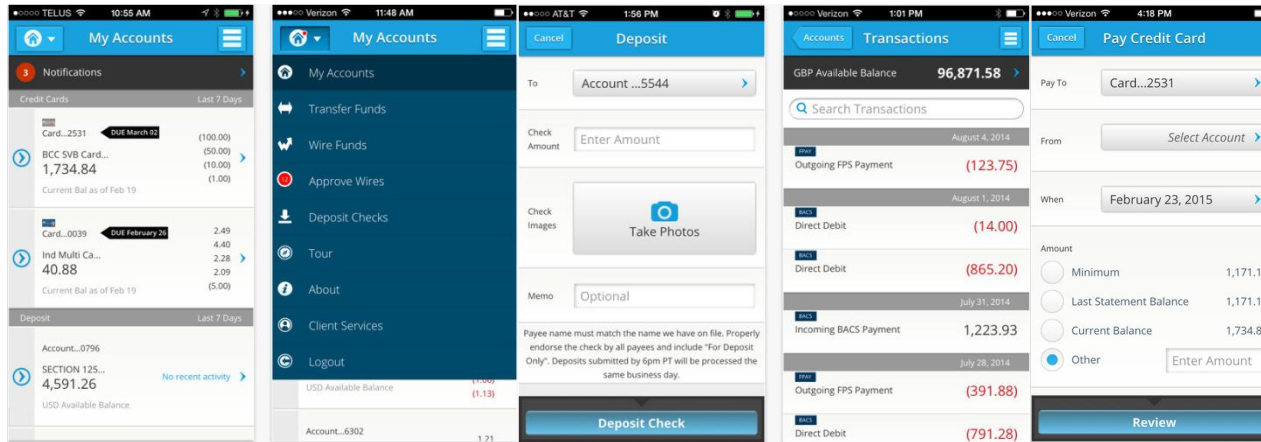
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# Acceptable Specimens of Use in the USPTO



# Unacceptable Specimens of Use for Mobile App in the US





## Preventing Dilution and Genericide

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- Use the trademark exactly as registered; Avoid variations.
- Proper grammar usage.
  - Adjective, not noun or verb; Non-possessive; Singular, not plural
- Use the product's generic name with the trademark.
- Make the trademark stand out from surrounding text.
- Object to others' misuse.
  - Employees, competitors, consumers, public, licensees

# Ensuring Proper Use: Branding Guidelines

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- Provide specific instructions regarding permissible and impermissible use of the trademarks.
- Provide a dynamic list of the marks, jurisdictions, goods/services, and statuses.
- Describe the elements of the brand.



- House mark, Tagline
- Graphic logo and images, icons
- Color palette, fonts, alignment and position

# Ensuring Proper Use: Branding Guidelines

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- Show examples of what NOT to do
  - Recoloring or changing opacity
  - Repositioning or angling
  - Resizing or distorting
  - Adding type or graphics elements
  - Framing
- Significance of violation of these guidelines



# Ensuring Proper Use

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- Quality Control in Licensing
  - It is important that the licensor create a mechanism to exercise control over the quality of the goods or services provided under the licensor's mark.
  - Standards and specifications.
  - How much quality control is necessary? The level of control often depends on the types of goods or services at issue.
  - Some countries require licenses to be recorded.
- Employment & Social Media Policies
  - Employees should exercise reasonable and professional judgment when posting material or communicating with others using social media, and keep in mind that even personal postings through social media may be viewed by clients and reflect on the company.
  - Create Code of Conduct.
  - Enforce network security and confidential information.

# Public Notice: Marking & Attribution

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- Notice advising the public, consumers and competitors, of the status and ownership of the mark.
- ®, Reg., TM and SM
  - ® and Reg. indicate that the mark is registered in one or more countries
  - TM and SM usage reflects the owner's intent to claim trademark rights in the mark
- “Marca Registrada” or “MR” in some countries where Spanish is the dominant language.
- “Marque Déposée,” “Marque de Commerce,” or their abbreviations, “MD” and “MC,” in some countries where French is the dominant language.
- Consequences of non-marking
- Multi-national trademarks

## Placement of Symbols

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- No specific U.S. requirements exist as to the precise use of the ® symbol as to placement, e.g., whether used in a subscript or superscript manner.
- The most common location for the symbol is to the right of the mark, at the top or bottom (required in China).
- The symbol should be immediately adjacent to the mark.
- If you place the symbol where most people expect to find it, you increase the chances that the public and competitors will understand your intent to assert your claim to the mark.

## Placement of Symbols

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- Many countries also recognize the use of the ® symbol to indicate a registered mark.
- A number of countries consider use of the symbol to be illegal if the mark has not been registered within that country.
  - False or misleading marking with the ® symbol on international packaging can result in unfair competition claims, fines, imprisonment and other liability.
  - In certain jurisdictions, it is a criminal offence to falsely indicate a trademark or part of a trademark is registered or certain goods or services are protected by a registered trademark when they are not (Germany, India, Japan and Korea).

## Placement of Symbols

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- Therefore, all goods/services and promotion materials shipped to or used in a foreign country, should use the TM symbol rather than the ® if the mark is not registered in that country.
- Generally, the trademark symbols should be used on all materials that will be seen by the public, including websites, brochures, newsletters, advertisements, reports, etc.
- Use of a symbol once per document or per page is generally sufficient.



# Symbol Placement



- What would be the correct marking in United States for



# Symbol Placement

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- What happens with trademark  
Make next happen now.<sup>TM</sup>  
?

- What would be the correct marking in China for



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# What is the Proper Marking?

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# Attribution Statements

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- Sometimes in addition or alternatively to marking.
- Examples
  - MAKE NEXT HAPPEN NOW is a trademark of SVB Financial Group
  - SVB is a *registered* trademark of SVB Financial Group
  - SVB is a *registered* trademark of SVB Financial Group *in the United States, European Union, Israel, and China.*
  - SVB, SILICON VALLEY BANK, and the Chevron logo are *registered* trademarks of SVB Financial Group *in the United States and elsewhere.*

# Record-Keeping

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- Trademark Portfolio
  - Which trademarks
  - Which goods and services
  - Which countries
  - Ownership and address changes
  - Status
- Collection / Retention of use evidence (Brochures, catalogs, publicity releases, etc.)

## Loss of Rights

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- Failure to renew
- Non-use/Cancellation
- Invalidation
- Misuse
- Failure to police
- Naked Licensing
- Genericide

## Combined Elements & Joint Owners

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- When two become one – registrants jointly “represent a single source”.
- While joint ownership of trademarks is possible, it is somewhat unusual in that joint ownership is counter to the fundamental purpose of a trademark, which is to serve as a designation of origin from a single entity or person.
- Different from trademark licensing, there is no control or limitations between owners.
- What happens to the rights in the trademark in the event that the agreement between the joint owners comes to an end?

## Joint Venture Trademarks

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- The JV is its own entity, separate and apart from the parties' other business/brand interests.
- Commercial considerations in the JV vs. IP rights.
- Who owns the JV trademark that comprises both registered trademarks from each party?
- What happens if the JV agreement comes to an end?
  - Rights in the respective brand names would still exist?
- What happens if ownership and control of the JV changes?



# The Solution: Collaboration & Communication.....

## Business

- Approach legal early on in the creative process
- Keep developments confidential
- Meet regularly
- Keep accurate records

## Legal

- Avoid a “nay-sayer” culture
- Suggest ways to achieve business goal with lower risk
- Characterize risks in terms of real potential consequences, costs and future efforts

# The Solution: Collaboration & Communication

## Business

- Notify legal if third parties are involved in the creative process
- Request legal for trademark clearance

## Legal

- Ensure that creations can be protected and do not infringe other brands or other intellectual property rights
- Insist on confidentiality and provide confidentiality agreements
- Provide regular education

## The Solution (Continued)

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- Jointly develop processes & strategies
  - If the brand is supposed to distinguish your company's offerings over competitors', avoid merely describing and invest in education of consumers.
  - If the term is supposed to help consumers understand what they will get, avoid claiming it as property.

## How Does In-House Counsel Coordinate?

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- Be engaged as early in the process as possible
- Establish a coordinated approach that defines roles
- Put together strategies
  - Trademark Registration
  - Domain Name Registration
  - Enforcement
- Regular communication



# Questions

# Relevant Practical Law Resources Available With a *Free Trial* to Practical Law

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- Trademark Use and Protection Training: Presentation Materials
- Practice Note, Brand Protection: Business Briefing
- Brand Protection Toolkit
- Standard Document, Trademark Use and Protection Guidelines (Internal Distribution)
- Practice Note, Trademark Portfolio Development and Management
- Practice Note, Acquiring Trademark Rights and Registrations
- Practice Note, Loss of Trademark Rights
- Practice Note, Trademark Infringement and Dilution Claims, Remedies and Defenses

# About the Speakers

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**Erica Kitaev**, Senior Legal Editor, *Practical Law Intellectual Property & Technology*

Erica Gann Kitaev, CIPP joined Practical Law from BakerHostetler LLP, where she was a partner with a focus on privacy and data security. She is a co-author of West Academic Publishing's *Privacy Law in a Nutshell, Second Edition*, and she taught privacy law as an adjunct professor at the University of Denver's Sturm College of Law. She was also an associate at Vorys, Sater, Seymour, & Pease LLP.

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Matthew Asbell assists clients in clearing, obtaining, enforcing, and defending trademark rights in the United States and throughout the world. He also provides advice on patents, copyrights, domain names, and other related areas. Matthew is an active speaker and lecturer and is a frequent moderator and panelist at ABA, INTA, and other conferences. He is currently an adjunct professor of law at Fordham University.

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Chester Te is responsible for a wide variety subject matter at Silicon Valley Bank, including enterprise-wide litigation, human resources, vendor management, marketing, intellectual property, security and fraud. Prior to joining SVB, Chester worked in financial services at Wells Fargo and Smith Barney, was a commercial litigator at Carter, Ledyard & Milburn in New York City, and clerked for United States District Judge Alvin W. Thompson (D. Conn). Chester currently serves as the Co-Chair of the National Asian-Pacific American Bar Association's Diversity Committee, and is a board member of the Silicon Valley Campaign for Legal Services. He is a past President of the Asian Pacific American Bar Association of Silicon Valley, and continues to serve on its board.