

# Trademarks and Service Marks

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President



# Trademarks (and Service Marks)

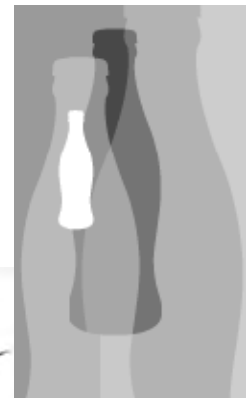


## Federal Law:

- ❑ Mainly Lanham Act, 15 U.S. Code § 1051 et. seq.
  - ❑ Also state statutes (e.g., New Mass. G.L. c. 110H) and common law
  - ❑ If going global, consider relevant foreign laws

## Subject Matter:

- ❑ Words, phrases, designs, shapes, sounds, and even smells and colors, used to identify one's goods/services and distinguish them from the goods/services of others
  - ❑ Similar protection for trade names and trade dress
  - ❑ Domain names may or may not be trademarks



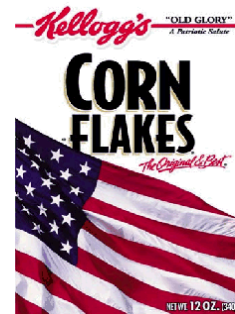
# Trademarks

## Exclusions:

- ❑ Cannot protect generic terms, geographic or other descriptive terms that lack “secondary meaning,” or mere surnames
- ❑ Also impossible or difficult to protect or register immoral or scandalous matter or U.S. flag

## Owner:

- ❑ First person to use or register as mark for this good/service



# What Do These Have in Common?



# Trademarks

## Scope of Protection:

- ❑ Right to prevent others from using confusingly similar mark for related goods/services in territory where priority established
  - ❑ Needn't be related for famous marks – *dilution* (blurring or tarnishment) is separate claim
  - ❑ Federal registration protects throughout U.S.

## Term:

- ❑ Indefinite, until abandoned or generic
- ❑ Federal registration lasts 10 years, but can be renewed indefinitely
  - ❑ *Cream of Wheat* – 1899
  - ❑ *Samson* – 1884

**SAMSON**



**CREAM  
OF  
WHEAT**

## Some Lost Trademarks

- ❑ Aspirin Bayer AG
- ❑ Cellophane E.I duPont de Nemours
- ❑ Escalator Otis Elevator Company
- ❑ Heroin **?** Bayer AG
- ❑ Kerosene Abraham Gesner
- ❑ Phillips-head screw Henry F. Phillips
- ❑ Thermos Thermos GmbH
- ❑ Yo-yo Duncan Yo-Yo Company
- ❑ Zipper B.F. Goodrich



# Trademarks

## Filings:

- ☐ Optional, but available at Federal (USPTO) and state levels

## Cost:

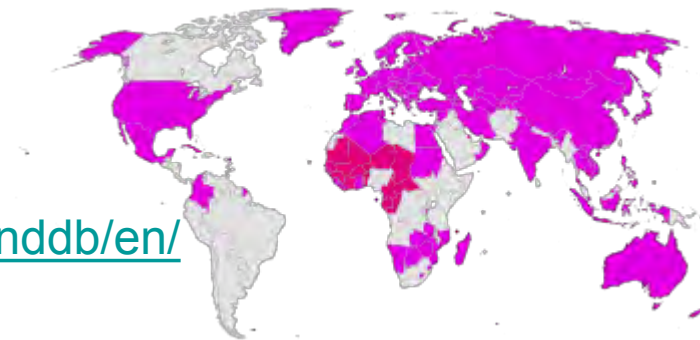
- ☐ Moderate
- ☐ \$275 (e-filing) or \$375 (paper) federal filing fee (per mark per class)

## Notices:

- ☐ Federal Registration: ® or “Reg. U.S. Pat. & Tm. Off.”
- ☐ Otherwise: ™ for trademark and ℠ for service mark

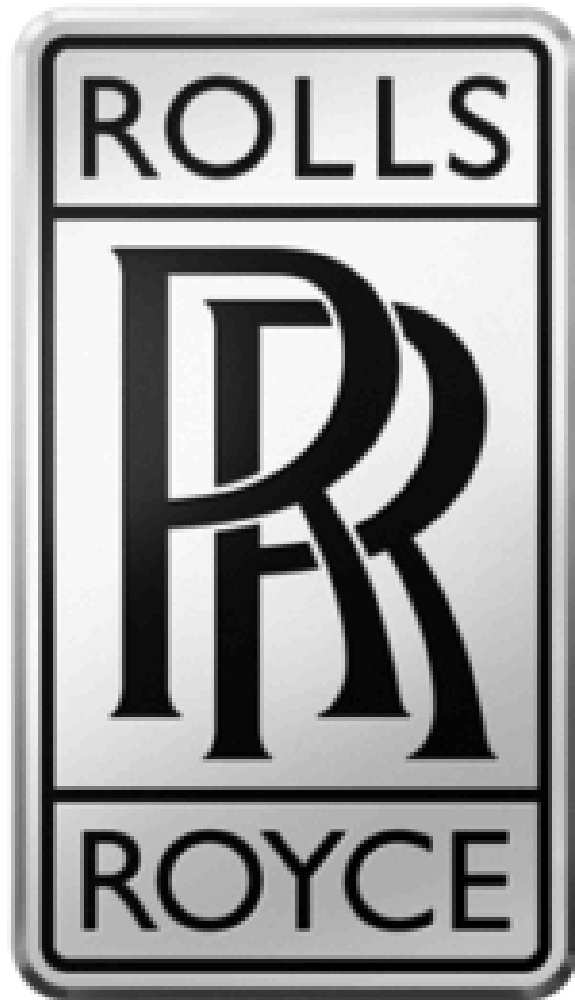
# International Trademark Registration

- ❑ Madrid Protocol
  - ❑ Apply for international protection based on a single application in a contracting state
- ❑ Administered by WIPO
  - ❑ 104 members
  - ❑ Search capability: <https://www.wipo.int/branddb/en/>
- ❑ Cost:
  - ❑ Basic fee: Swfr653 (903 for color)
  - ❑ Fee per country Swfr100-1,000 for 1-3 classes
    - ❑ Extra for additional classes

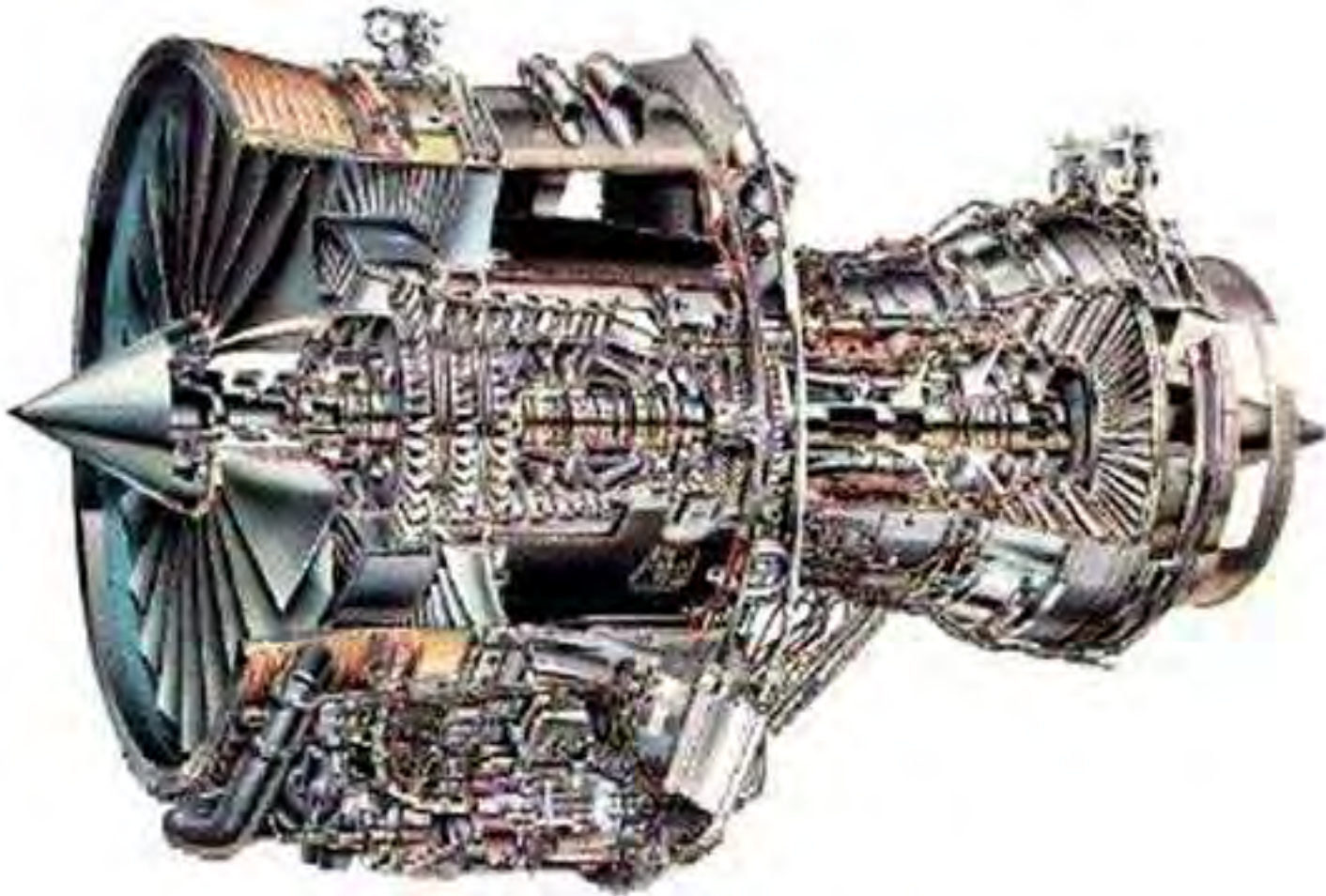




## Case Study



# RB211



## Selected as the Launch Engine for the Lockheed TriStar



## Decided to Use a Novel Composite Fiber for the Fan Blades



## Failed the Chicken Bullet Test

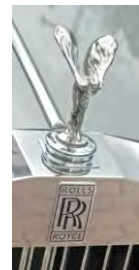
- ❑ Had to go to titanium back-up design
- ❑ Development cost doubled
- ❑ Unit production cost exceeded contractual sales price
- ❑ Rolls-Royce went into Receivership
  - ❑ Nationalized in 1971
  - ❑ New company formed – Rolls Royce plc, owned by Government
    - ❑ Car company spun off, Rolls Royce Motors, 1973
    - ❑ Also owned rights to the Bentley
  - ❑ Rolls Royce plc privatized in 1987





# The Car Story

- ❑ Rolls Royce Motors bought by Vickers in 1980
- ❑ Sold in 1998
  - ❑ BMW bid £340 million
  - ❑ Volkswagen bid £430 million
  - ❑ Won
- ❑ Turned out the trademarks were owned by Rolls Royce plc
  - ❑ Rolls Royce Motors only had a license to use for cars
  - ❑ Rolls Royce plc had the right to approve any transfer
    - ❑ Refused to allow transfer to Volkswagen
- ❑ Volkswagen found they'd only bought the mascot and radiator shape
  - ❑ Ooops!
  - ❑ Who did the due diligence?
- ❑ Rolls Royce plc decided to license the name to BMW
  - ❑ £40 million



# The Outcome

- ❑ Rolls Royce Motors changed its name to Bentley Motors
  - ❑ *Real politic!*
  - ❑ Allowed to make Rolls Royce cars till 12/31/2002
  - ❑ After that, limited to Bentleys
- ❑ BMW launched Rolls Royce cars January 1, 2003

