

NOVEMBER 2019



TRADEMARKS

When Inmar adopts distinctive trademarks, uses them consistently, and takes steps to ensure consumers view them as source-identifiers, we can build strong brands. Trademarks are, at their core, indicators of source and must be “distinctive” to be protectable.

A product name, brand, slogan or design can begin to function as an Inmar trademark as soon as it is used as a source-indicator with a particular product or service of Inmar. Because all trademark rights in the United States — whether federally registered or common law — are based on use, it is important that use of a mark be consistent.

Trademark registration does come with associated time and cost elements. Due to the importance of trademark registration and process, Inmar has created a formal process and the Inmar Trademark Team.

Use of any trademark without approval from Inmar Trademark Team via the process described in this document is strictly prohibited.

01

Complete product
naming process

02

Decide to register

03

Proceed with Legal
to register

04

Follow marking/usage
best practices

05

Manage portfolio
according to standards

06

Alert Legal with
enforcement concerns

01

Product Marketing identifies there is a new product introduction or a product with no current registration.

02

Product Marketing determines name and provides several naming options. This process will follow the Branding Guidelines set forth in Q1, 2018.

[Click here to link to Branding guidelines SOP.](#)

03

Once approved for use by Inmar Trademark Team (see Appendix), a trademark may be used immediately and the (™) symbol should be used in all collateral. This symbol serves as notice that Inmar is claiming trademark rights in the trademark.

01

Determine if the product name is one we want to register as a trademark in one or more countries.

The decision to apply to register a trademark in a country typically hinges on several considerations:

- We will be inclined to register a trademark if we plan to use it for the foreseeable future with public facing products or services or if we will be investing in marketing collateral.
- We will be less inclined to register a trademark if we plan to use it for a short period of time, in a minimal way or only for internal communications.
- Inmar Trademark Team will determine whether and where to pursue registration.

02

Understand the benefits of registration.

03

Evaluate timing and cost expectations.



Although unregistered trademarks receive some protection the law, federal trademark registration provides significant substantive and procedural rights.

Registration provides a number of benefits, including:

- Grants the right to use the registered trademark symbol: ®
- Grants the right to file a trademark infringement lawsuit in federal court and to obtain monetary remedies
- Acts as a bar to the registration of another confusingly similar mark
- May serve as the basis for an international trademark application

Registering a trademark is neither free nor fast.

If the application is filed based on claimed use of a mark and there are no significant issues encountered during the examination or opposition process, it will take **nine to twelve months** to obtain a trademark registration in the U.S.*

\$1,800 The typical cost for obtaining a registration for a trademark in the U.S. is around **\$1,800**, assuming no search is conducted prior to filing, no significant issues are encountered during the registration process, and the mark is registered in only one class of goods and services.

\$300 Adding additional classes costs approximately \$300 in PTO fees per class.

\$2,000 Adding additional countries will also increase costs. Adding Canada will typically add another \$2,000

If the application is filed based on claimed intent to use the mark in the future, and there are no significant issues encountered during the examination or opposition process, it will take about nine to twelve months to obtain a notice of allowance. A notice of allowance means once you are able to demonstrate use of the mark in commerce (and you have three years to do so), a registration will issue.

*It can easily take longer, however, if there are issues encountered along the way. And it is possible, of course, that a registration may never be granted by the US Patent and Trademark Office (PTO).

01

Legal needs complete information prior to proceeding with registration:

- Description of goods and services
- List of places where you want to sell the product (e.g., U.S. vs Canada vs both, Europe, Mexico, etc.)
- Decision maker(s)
- Stakeholders
- Someone that understands and can explain the product and its uses

Requestor will fill out [Google Form](#) housed on the Product Marketing Site. Form is reviewed by Corporate Marketing for completeness and then evaluated by Legal.

02

Once reviewed and agreement is gained to move forward, Inmar Legal will proceed with appropriate filings and communicate with requestor and Inmar Trademark Team on registration progress throughout the process.

DO

- Choose strong brands and ensure that the brand chosen is registrable as a trademark – words that have no meaning outside of the trademark itself (e.g. INMAR, KODAK, XEROX) are best and words that are merely descriptive of the goods or services cannot usually be registered.
- Ensure that you carefully consider the goods and services that you wish your trademark to cover. Once the mark is registered, it can be challenging to expand the range of goods and services.
- Use trademarks as adjectives. For example, TREK bicycle.
- Use appropriate notations (®, SM, TM) whenever possible. If in doubt, use TM.
- Use all capitals, italics, different fonts or at least initial caps whenever possible to distinguish a trademark from other text in advertising material.
- Use trademarks consistently.
- Use trademarks EXACTLY as registered.

DON'T

- Use trademarks as nouns.
- Use trademarks as verbs.
- Use the "®" notation on any trademark that is not federally registered.
- Use a trademark in a possessive form, unless the trademark itself is possessive.
- Pluralize a trademark. Instead, the common noun should be pluralized. For example, two TREK bicycles rather than two TREKS.

As a team of cross-functional decision-makers, the Inmar Trademark Team will evaluate assets we have on our books on a regular basis and with foresight.

THE TEAM WILL REVIEW:

- Are we using right now?
- Are we going to use the marks in the future?
- Are the description of goods and services matching the way we use the product?
- Are we registering in other countries outside of US?
- From a strategic point of view, identify what are the most valuable Inmar products to protect?

When appropriate, a member of the **Inmar Trademark Team** should be given visibility into acquisitions when trademark assets are going to come over as part of the deal.

THE PURPOSE IS TO:

- Identify which marks we want to pull over during the acquisition.
- Look at marks to be pulled over, as well as description of goods and services, to ensure they are aligned with how we are going to market the service.
- Understand the costs associated with taking over marks, including costs related to maintenance, assignment, and cleaning up registrations.

Once trademarks are registered, Inmar should protect those brands. Proactive enforcement will require a focused effort on the part of Inmar as well as a commitment of funds.

- **Currently**, we know about third parties using or planning to use our brands in two ways:
 - First, if another company files to register with the USPTO a mark that is confusingly similar, Inmar's outside counsel will alert us. We can then decide whether to oppose the third-parties' registration, which will cost money.
 - Second, when Inmar associates notice marks that they believe are confusingly similar to our brands. We investigate those as needed.
- **Desired State** - move away from ad hoc towards intentional. This takes time and money. We propose coming up with some solutions with different price points for consideration by leadership.

LEGAL

Jon Pierce
Jessica Morris

**CORPORATE
& CONSUMER
MARKETING**

Holly Pavlika
Robin Small

Inmar Trademark Team will meet quarterly to review outstanding items and identify any changes needed to process. Inmar Trademark Team will also be notified when new submissions are requested for evaluation.

“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 a word, phrase, symbol, and/or design that identifies and distinguishes the source of a service rather than goods. Some examples include: brand names, slogans, and logos. The term "trademark" is often used in a general sense to refer to both trademarks and service marks.

Unlike patents and copyrights, trademarks do not expire after a set term of years. Trademark rights come from actual “use.”

Therefore, a trademark can last forever - so long as you continue to use the mark in commerce to indicate the source of goods and services. A trademark registration can also last forever - so long as you file specific documents and pay fees at regular intervals.

Registration is not mandatory.

You can establish “common law” rights for a mark based solely on use of the mark in commerce, without a registration. However, federal registration of a trademark with the USPTO has several advantages, including a notice to the public of the registrant's claim of ownership of the mark, a legal presumption of ownership nationwide, and the exclusive right to use the mark on or in connection with the goods or services set forth in the registration.”¹

U.S. federal registration can be on one of two registers — the Principal Register and the Supplemental Register. The Supplemental Register is for registration of potential marks that are capable of distinguishing the applicant's goods or services but are not inherently distinctive and have not yet acquired a "secondary meaning" in the mind of the public as a source identifier. Consequently, until a merely descriptive mark "acquires distinctiveness," it can only be registered on the Supplemental Register. A mark cannot be registered on either register unless the mark is used in commerce. In most cases, use in commerce requires interstate use or use between the United States and a foreign country. Stated another way, purely intrastate use generally will not qualify a mark for federal registration.

Registration on either register provides a number of benefits, including: (i) it grants the right to use the registered trademark symbol: ®, (ii) it grants the right to file a trademark infringement lawsuit in federal court and to obtain monetary remedies, (iii) it acts as a bar to the registration of another confusingly similar mark, and (iv) it may serve as the basis for an international trademark application.

Registration on the Principal Register provides additional benefits, including: (i) a statutory presumption that (a) the mark is valid, (b) the registrant is the owner of the mark, and (c) the registrant has the exclusive right to use the registered mark; (ii) the registration is proof that the mark has acquired secondary meaning; (iii) the registration serves as constructive notice of a claim of ownership, eliminating any justification or defense of good faith adoption and use made by a third party after the registration date; (iv) the registrant is entitled to nationwide priority based on the filing date; and (v) the registration becomes incontestable after five years on the Principal Register, creating conclusive evidence of the registrant's exclusive right to use the mark, subject to certain statutory defenses.



JON PIERCE

jon.pierce@inmar.com
inmar.com

HOLLY PAVLIKA

holly.pavlika@inmar.com
inmar.com

THANK YOU!

