

Errata for
Just Wanna Trademark for Makers
#11564

All Versions

Pages 9 and 135:

The tiny URL and QR code for the download was updated. See the attached PDFs for the updated interior pages as well as *The Big Trademark Application List and Weblinks Document* file.

PART III: THE APPLICATION takes you through the application process, step by step.

PART IV: YOUR TRADEMARK looks at what happens once you have your trademark certificate, including how to maintain your trademark; what happens if someone infringes on your trademark; and what others can legally do with your trademark, even without your permission.

Icons Used in This Book

A couple helpful icons are designed to make it easier for you to use this book. When you see these symbols, you'll know what to do.



Lawyer time icon

alerts you that the question or issue at hand may be more complicated than a DIY solution. You are not required to hire an attorney when you encounter something sticky, but we tell you when it may be a wise decision.



Online resources icon

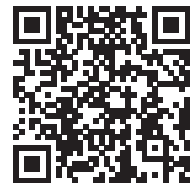
provides additional resources on the Web that may be helpful in understanding a particular topic.

The Big Trademark Application List and Weblinks Document

Finally, we want to introduce you to the Big Trademark Application List (page 135) and the weblinks document. We have compiled the many steps you will follow into a form that you can fill out as you work through this book so you will be ready when it is time to apply for your trademark. We want you to copy, download, and use this list. Don't let the size of the Big List be intimidating. You will learn along the way that many items will not apply to your particular situation, and you'll get to **skip them!** The Big List also allows you to double-check that you are prepared, whether filling out the application or chatting with an attorney.

Weblinks are sometimes long and difficult to type accurately. To make it easier for you to quickly find the page you need we've provided a list of links found in *Just Wanna Trademark for Makers*.

To access the document through the tiny url, type the web address provided into your browser window. To access the document through the QR code, open the camera app on your phone, aim the camera at the QR code, and click the link that pops up on the screen.



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Before you begin working your way through the book, open up this document and keep it handy on your computer. When you find a webpage that you want to visit, scroll down and find the corresponding chapter title. Under each chapter title, you'll find a listing of the direct weblinks for each site discussed in the book. Simply click on the link and avoid lots of extra typing.

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Ready? Let's Dive In!

We are going to take you step-by-step in understanding trademark and preparing the materials for your application. Get a snack. Grab some coffee. And let's do this!

The Big Trademark *Application* List

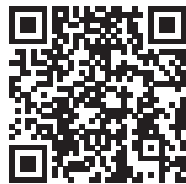
On the next two pages you will find the Big Trademark Application List to help you get ready to file your application. Once you complete the steps, you'll have all of your information ready when it is time to file your application.

Download the Form

You can download the Big Trademark Application List too! Scribble on it. Fill it in. If you find you need to start over or you decide to file a second application, you can print a fresh copy.

To access the forms through the tiny url, type the web address provided into your browser window.

To access the list through the QR code, open the camera app on your phone, aim the camera at the QR code, and click the link that pops up on the screen.



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WORDS OF ADVICE

Do your homework. Try your best. If you get it wrong, the trademark examining attorney will give you an opportunity to fix it. And, if you decide to hire an attorney, the answers from the Big Trademark Application List, and the more extensive downloadable form will help the process, and maybe cut down the cost of your legal bill!

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DOWNLOAD FOR

Just Wanna[®]
Trademark
FOR MAKERS

**A Creative's Legal Guide to
Getting & Using Your Trademark**

Elizabeth Townsend Gard and Sidne K. Gard

 **C&T PUBLISHING**
Another Maker Inspired!

Just Wanna Trademark for Makers Download

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Just Wanna Trademark for Makers *Quick* Links

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PART I: What Is Your Mark?

Step 1: Trademark Basics

USPTO Filing Fees

<https://www.uspto.gov/trademarks/trademark-fee-information>

Pro Bono Programs

<https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>

The USPTO Trademark Assistance Center

<https://www.uspto.gov/learning-and-resources/support-centers/trademark-assistance-center>

Lawyers for the Creative Arts

<https://law-arts.org/>

National VLA Directory

<https://law-arts.org/national-vla-directory>

Pinkbox Doughnuts' Intellectual Property Page

<https://www.pinkboxdoughnuts.com/trademark/>

USPTO's Examples of Typical Application Pitfalls

<https://www.uspto.gov/trademarks/additional-guidance-and-resources/possible-grounds-refusal-mark>

Step 3: Check the Strength of the Mark

VIVIVA's Naming Story

<https://vivivacolors.com/pages/about>

The LEGO Name Origin Story

<https://www.lego.com/en-us/history/articles/b-the-beginning-of-the-lego-group>

USPTO Guidance on Using Names and Likenesses of Living Individuals

<https://www.uspto.gov/trademarks/laws/inquiry-regarding-nameportraitsignature-particular-living-individual-mark>

Jennifer Rothman's Right of Publicity Roadmap

<https://rightofpublicityroadmap.com/>

USPTO Guidance on Geographical Indications

<https://www.uspto.gov/ip-policy/trademark-policy/geographical-indications-gi-protection>

Step 4: Confirm There Are No Disqualifying Statutory Exceptions

Words and Designs Deemed Off-Limits by Statute

<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-Cd1e1.html>

Step 5: International Classes

Official List of WIPO Classes List

<https://www.wipo.int/classifications/nice/nclpub/en/fr/>

Artists and Virtual Currency

<https://fnewsmagazine.com/2022/10/the-artistic-underground-of-nfts/>

How the USPTO is Handling New Technologies

<https://www.uspto.gov/sites/default/files/documents/TM-Newer-Technologies-webinar.pdf>

Trademark ID Manual

<https://idm-tmng.uspto.gov/id-master-list-public.html>

Part II: Check Your Mark

Step 7: Searching the USPTO Trademark Records

Trademark Electronic Search System (TESS)

https://tmsearch.uspto.gov/bin/gate.exe?f=login&p_lang=english&p_d=trmk

The TESS Official Help Page

<https://tmsearch.uspto.gov/webaka/html/help.htm>

Additional Search Tips from the USPTO

<https://www.uspto.gov/sites/default/files/documents/Trademarks-Advanced-Searching-Sept272022.pdf>

Pattern Matching and Other Advanced Search Techniques

<https://www.uspto.gov/trademarks/search/word-andor-design-mark-search-structured#step1>

WIPO Global Brand Database

https://branddb.wipo.int/en/quicksearch?by=brandName&v=&rows=15&sort=score%20desc&start=0&_=1680013191702

Canadian Trademark Database

<https://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>

Design Mark Searches

The Design Code Manual

<https://tess2.uspto.gov/tmdb/dscm/index.htm>

Nontraditional Mark Searches

Color Marks in Design Code Search Manual

https://tess2.uspto.gov/tmdb/dscm/dsc_29.htm

Pinkbox Doughnuts' Intellectual Property Page

<https://www.pinkboxdoughnuts.com/trademark/>

Step 8: Preparing Your Specimen

USPTO Guidance on Specimens

<https://www.uspto.gov/trademarks/laws/specimen-refusal-and-how-overcome-refusal>

Even More on Specimens

<https://www.uspto.gov/about-us/events/trademark-specimens-overview-experienced-filers>



Part III: Your Application

The Application, Step by Step

Trademark Electronic Application System (TEAS)

<https://www.uspto.gov/trademarks/apply>

My USPTO Homepage

<https://my.uspto.gov/>

The USPTO YouTube channel, USPTOvideo

<https://www.youtube.com/@USPTOvideo>

USPTO Video on TEAS Plus Versus TEAS Standard

<https://www.uspto.gov/trademarks/apply/initial-application-forms#Chart%20Application%20requirements>

Foreign-Domiciled Applicants

<https://www.uspto.gov/trademarks/laws/trademark-rule-requires-foreign-applicants-and-registrants-have-us>

USPTO Video on Providing Additional Statements About the Mark

<https://www.uspto.gov/learning-and-resources/uspto-videos/teas-nuts-and-bolts-additional-statements>

Less Common Applications

USPTO Mailing Requirements

<https://tmep.uspto.gov/RDMS/TMEP/print?version=current&href=TMEP-300d1e459.html>

Office Actions

Reviving Abandoned Applications

<https://www.uspto.gov/trademarks/apply/reviving-abandoned-application>

USPTO Guide to Satisfying Disclaimer Requirements

<https://www.uspto.gov/trademarks/laws/how-satisfy-disclaimer-requirement#heading-4>

USPTO Video Guide to Using the Responding to Office Action Online Form

<https://www.youtube.com/watch?v=YO1Qw-L2QNs>

USPTO Tips for Claiming Acquired Distinctiveness

<https://www.uspto.gov/trademarks/laws/how-claim-acquired-distinctiveness-under-section-2f-0>

USPTO Help for Office Actions

<https://www.uspto.gov/trademarks/maintain/responding-office-actions>

More on Letters of Protest

<https://www.uspto.gov/trademarks/trademark-updates-and-announcements/letter-protest-practice-tip>

Filing a State Trademark Application

USPTO Listing of State Trademark Application Systems

<https://www.uspto.gov/trademarks/basics/state-trademark-information-links>

The Illinois Application Form

https://www.ilsos.gov/publications/pdf_publications/tmsm15.pdf

Trademarks Outside the United States

WIPO's Global Brand Database

https://branddb.wipo.int/en/quicksearch?by=brandName&v=&rows=15&sort=score%20desc&start=0&_=1679954180294

Video Tour of WIPO's Global Brand Database

https://www.wipo.int/reference/en/branddb/news/2018/news_0003.html

User's Guide to WIPO's Global Brand Database

<https://branddb.wipo.int/en/help>

Countries Covered by the Madrid Protocol

https://www.wipo.int/wipolex/en/treaties/ShowResults?start_year=ANY&end_year=ANY&search_what=C&code=ALL&treaty_id=8

Canadian Trademark Resources

<https://ised-isde.canada.ca/site/canadian-intellectual-property-office/en/trademarks>

Trademark Filing for Canadians

<https://www.canada.ca/en/services/business/ip.html>

The Madrid Protocol Fee Calculator

<https://madrid.wipo.int/feecalapp/>

TEASi Form for U.S. Applicants

<https://www.uspto.gov/trademarks/apply/trademark-electronic-application-system-teasi-online>



Part IV: Your Trademark: What's Next

Maintaining Your Mark

To File a Letter of Protest

<https://my.uspto.gov>

Your Trademark out in the World

Circuit Tests for the Likelihood of Confusion

<https://www.thebillinglife.com/blog/likelihoodofconfusiontestsbycircuit>

Facebook Notice and Take Down Form

<https://www.facebook.com/help/contact/634636770043106>

Changing or Expanding Your Trademark

The Electronic Trademark Assignment System (ETAS)

<https://etas.uspto.gov/>

Help on Trademark Assignments

<https://etas.uspto.gov/etas/help.html>

Conclusion

Visit Our Website

<https://www.justwannaquilt.com/>

Resources

USPTO Homepage

<https://www.uspto.gov/>

The Trademark Manual of Examining Procedure (TMEP)

<https://tmep.uspto.gov/RDMS/TMEP/current>

Trademark Electronic Search System (TESS)

https://tmsearch.uspto.gov/bin/gate.exe?f=login&p_lang=english&p_d=trmk

Trademark ID Manual of Goods and Services

<https://idm-tmng.uspto.gov/id-master-list-public.html>

Design Search Code Manual

<https://tess2.uspto.gov/tmdb/dscm/index.htm>

Alt Legal

<https://www.altlegal.com/blog/>

Trademarkia

<https://www.trademarkia.com/>

Markify

<https://www.markify.com/>

Clarivate CompuMark Comprehensive Searches

<https://clarivate.com/products/compumark-family/>

Cornell's Legal Information Institute

<https://www.law.cornell.edu/uscode/text/15/1051>

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Just Wanna Quilt

<https://www.justwannaquilt.com/>

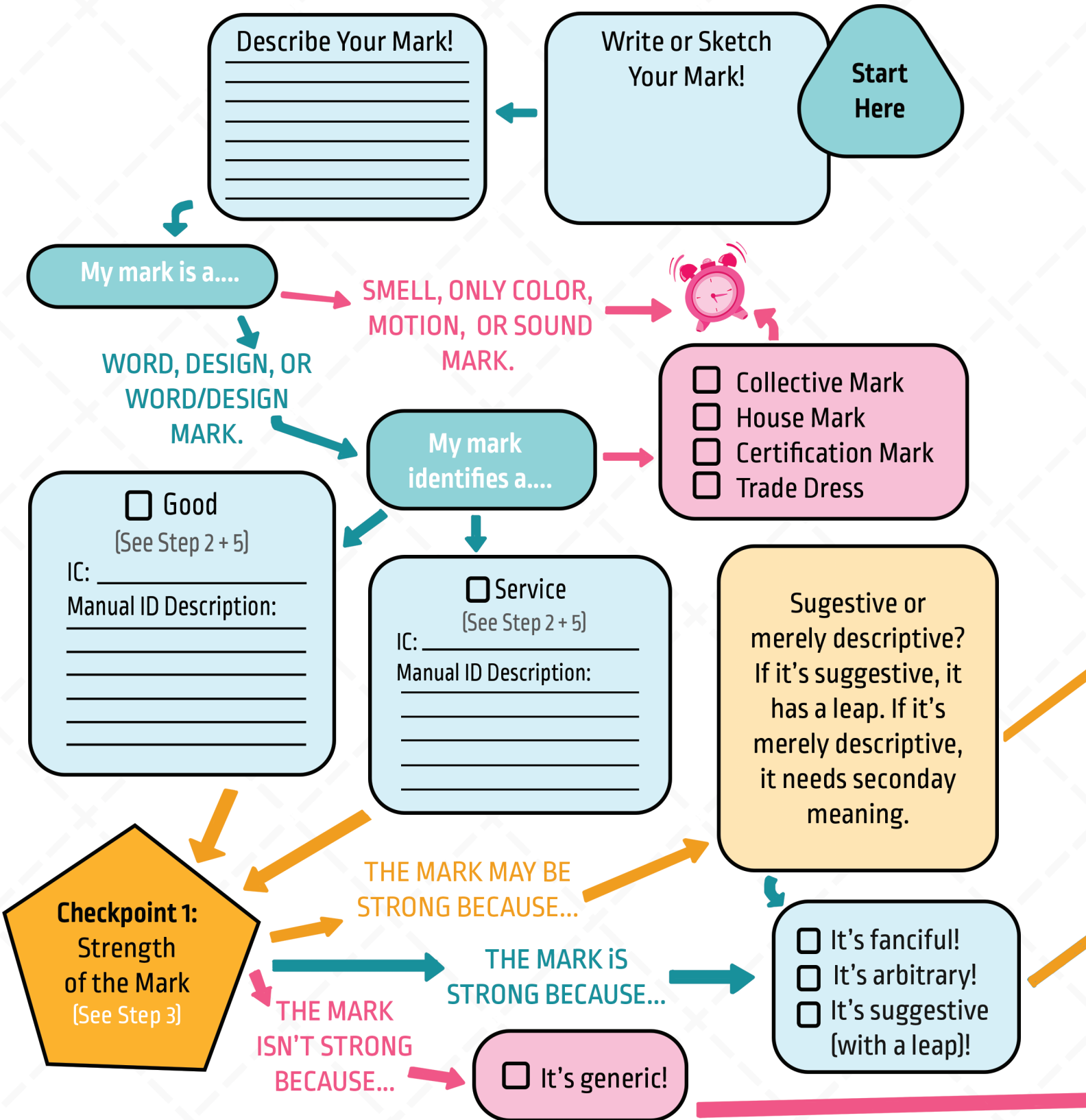
About the Artist

Teddie Bernard

<https://teddiebernard.net/>



The Big *Trademark* Application List



I'm ready to start my application.

I INTEND TO USE THE MARK (SOON).

Specimen Requirements

- Shows actual use in commerce.
- Is likely perceived as a source identifier.
- Mark in the specimen matches the mark in the application.
- If image of website, include url and date of search.
- At least one specimen per class.

Stop and Summarize!

- Word Mark: _____
- Design Mark: Drawing in .jpg format, 300-350 DPI. In color or black/white?

IC: _____

Owner: _____

Preparing the Application
[See Part III]

THE MARK IS IN USE.

The first date my mark was used in commerce was...

What I Found Out!

Secondary Meaning Required

- Geographic Term
- Merely a Surname
- Only Color
- Merely Descriptive

Out-in-the-World Check

- Domain Name
- USPTO TESS Search
- Google Search
- Dictionary Search
- Be Creative

Secondary meaning:
There has been substantially exclusive and continuous use for at least five years?

- Yes
- In Progress

Checkpoint 3:
Can You Use this Mark?
[See Step 5]

Checkpoint 2:
Not Off Limits
[See Step 4]

This word/design is not off Limits by Statute.

Start over with new mark

FALSE

TRUE

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