Chapter 1  Trademarks

1.01 What Is a Trademark?

1.02 Functions of a Trademark
   1.02(A) Indicator of Source
   1.02(B) Guarantor of Quality
   1.02(C) Means of Consumer Protection
   1.02(D) Advertising and Promotion Tool
   1.02(E) Symbol of Goodwill
   1.02(F) Property Right

1.03 Other Types of Marks
   1.03(A) House Marks
   1.03(B) Family of Marks
   1.03(C) Trade Dress
   1.03(D) Collective Marks
   1.03(E) Certification Marks
   1.03(F) Corporate Names

1.04 What Can Be a Trademark?
   1.04(A) Word Marks
      1.04(A)(1) Words
      1.04(A)(2) Letters and Numbers
      1.04(A)(3) Derivative Marks
      1.04(A)(4) Multiproduct Marks
      1.04(A)(5) Grade and Style Marks
      1.04(A)(6) Ingredient Marks
   1.04(B) Design Marks
      1.04(B)(1) Logos
      1.04(B)(2) Appearance
   1.04(C) Product Packaging
   1.04(D) Product Configuration
   1.04(E) Color
   1.04(F) Sound
   1.04(G) Scent

1.05 Strength of Mark
   1.05(A) Fanciful or Coined Marks
   1.05(B) Arbitrary Marks
Trademark Administration

1.05(C) Suggestive Marks
1.05(D) Descriptive Marks
1.05(E) Generic Words

1.06 Registrability and Protectibility
1.06(A) Immoral, Scandalous or Deceptive Matter
1.06(B) Matter That Disparages, Falsely Suggests a Connection with or Brings into Contempt or Disrepute
1.06(C) Geographical Indications
1.06(D) Flags, Coats of Arms or Other Insignia
1.06(E) Name, Portrait or Signature of Living Individuals or Deceased U.S. Presidents
1.06(F) Merely Descriptive or Deceptively Misdescriptive Marks
1.06(G) Primarily Geographically Descriptive or Geographically Deceptively Misdescriptive Marks
1.06(H) Words That Are Primarily Merely Surnames
1.06(I) Primarily or Aesthetically Functional Configurations or Designs
1.06(J) Decorative or Ornamental Configurations or Designs

1.07 Trademarks Compared to Other Intellectual Property
1.07(A) Trademark vs. Utility Patent
1.07(B) Trademark vs. Design Patent
1.07(C) Trademark vs. Copyright
1.07(D) Trademark vs. Trade Name
1.07(E) Trademark vs. Fictitious Name
1.07(F) Trademark vs. Domain Name

Chapter 2 U.S. Trademark Laws

2.01 Lanham Act
2.02 Trademark Law Revision Act
2.03 TRIPS Agreement
2.04 Federal Trademark Dilution Act
2.05 Trademark Law Treaty Implementation Act
2.06 Anticybersquatting Consumer Protection Act
2.07 State Trademark Laws; Model Trademark Act
2.08 Common Law
### Chapter 3  Selection and Clearance of a Mark

#### 3.01  Selection
- 3.01(A) Process and Methods
- 3.01(B) Creating a Mark
- 3.01(C) Selection Committee
- 3.01(D) Naming Companies
- 3.01(E) Guidelines and Other Materials

#### 3.02  Searching and Clearance
- 3.02(A) U.S. Searching
  - 3.02(A)(1) Preliminary Search
    - 3.02(A)(1)(a) Searching Resources
      - 3.02(A)(1)(a)(i) Federal Registrations and Pending Applications
      - 3.02(A)(1)(a)(ii) State Registrations
      - 3.02(A)(1)(a)(iii) Common Law
      - 3.02(A)(1)(a)(iv) Domain Names
  - 3.02(A)(2) Full Availability Search
    - 3.02(A)(2)(a) Searching Services
      - 3.02(A)(2)(a)(i) Federal Registrations
      - 3.02(A)(2)(a)(ii) State Registrations
      - 3.02(A)(2)(a)(iii) Common Law
      - 3.02(A)(2)(a)(iv) Domain Names
- 3.02(B) International Searching
  - 3.02(B)(1) Searching Resources
    - 3.02(B)(1)(a) Internet Databases
    - 3.02(B)(1)(b) Fee-Based Databases
    - 3.02(B)(1)(c) Searching Services
    - 3.02(B)(1)(d) Local Agents
- 3.02(C) Searching Techniques
- 3.02(D) Limitations of Searching Methods
- 3.02(E) Reviewing Search Results
  - 3.02(E)(1) Descriptiveness
  - 3.02(E)(2) Likelihood of Confusion
  - 3.02(E)(3) Dilution
Trademark Administration

3.02(F) Use Investigations
   3.02(F)(1) Internet Searching
   3.02(F)(2) Agents
3.02(G) Resolving Conflicts
3.02(H) Reporting Search Results
3.02(I) Follow-Up Search

3.03 Checklist: Paralegal/Administrator Functions—Trademark Selection and Clearance

Exhibit 3-1 Proposed Mark Information Request Form
Exhibit 3-2 Memo on Preliminary Search
Exhibit 3-3 Printout from USPTO Database
Exhibit 3-4 Printout of SAEGIS Search of Federal Registrations
Exhibit 3-5 Printout of SAEGIS Search of State Registrations
Exhibit 3-6 Full Availability Search Order Form
Exhibit 3-7 Full Availability Search Online Order Form
Exhibit 3-8 Email Confirmation of Full Availability Search Order
Exhibit 3-9 Search Opinion Memo

Chapter 4 Protecting a Mark

4.01 Basis for U.S. Trademark Protection
   4.01(A) Use
      4.01(A)(1) Priority
      4.01(A)(2) Geographic Extent
      4.01(A)(3) Innocence
   4.01(B) Common-Law Protection—Use of \textsuperscript{TM} or \textsuperscript{SM} Symbol
   4.01(C) Federal Protection
      4.01(C)(1) Benefits of Federal Registration
      4.01(C)(2) Principal Register
      4.01(C)(3) Supplemental Register
      4.01(C)(4) Bases for Filing an Application
         4.01(C)(4)(a) Actual Use
         4.01(C)(4)(b) Intent to Use
         4.01(C)(4)(c) Foreign Application
         4.01(C)(4)(d) Foreign Registration
         4.01(C)(4)(e) Extension of Protection
   4.01(D) State Protection

4.02 Federal Registration
   4.02(A) Applications
4.02(A)(1) Due Diligence and the Application Process
4.02(A)(2) Checklist: Paralegal/ Administrator Functions— Pre-Application
4.02(A)(3) Checklist: Paralegal/ Administrator Functions— State and Federal Registration Applications
4.02(A)(4) Preparation of Application
  4.02(A)(4)(a) Reference Sources
  4.02(A)(4)(b) Elements of Application
  4.02(A)(4)(c) Applicant
  4.02(A)(4)(d) Form of Mark
  4.02(A)(4)(e) Drawing
  4.02(A)(4)(f) Classification
    4.02(A)(4)(f)(i) Goods
    4.02(A)(4)(f)(ii) Services
  4.02(A)(4)(g) Identification of Goods and Services
  4.02(A)(4)(h) Dates of First Use
  4.02(A)(4)(i) Specimens of Use
  4.02(A)(4)(j) Execution of the Application
  4.02(A)(4)(k) Verification
4.02(A)(5) Filing
  4.02(A)(5)(a) Electronic vs. Paper Filing
  4.02(A)(5)(b) Application on Paper
  4.02(A)(5)(c) Application in Electronic Format via TEAS
    4.02(A)(5)(c)(i) Signature Requirements
    4.02(A)(5)(c)(ii) Payment of Fees
    4.02(A)(5)(c)(iii) Errors Made on Electronic Applications
  4.02(A)(5)(d) Responding to Office Actions Electronically
4.02(A)(6) Checklist: Paralegal Administrator Functions— Federal Registration Applications
4.02(B) Docketing and Timelines
  4.02(B)(1) Due Diligence
  4.02(B)(2) Docketing Generally
    4.02(B)(2)(a) Manual Docketing System
    4.02(B)(2)(b) Computerized Docketing System
4.03 Prosecution of a U.S. Application
  4.03(A) Procedural Refusals
    4.03(A)(1) Identification of Goods and Services
    4.03(A)(2) International Class
4.03(A)(3) Description of Mark
4.03(A)(4) Disclaimer
4.03(A)(5) Specimens of Use
4.03(A)(6) Other Procedural Refusals
4.03(B) Substantive Refusals
  4.03(B)(1) Not a Mark
  4.03(B)(2) Descriptive/Misdescriptive
  4.03(B)(3) Surname
  4.03(B)(4) Likelihood of Confusion
  4.03(B)(5) Other, Less-Common Refusals
4.03(C) Correspondence with USPTO
  4.03(C)(1) Methods
    4.03(C)(1)(a) Electronic
    4.03(C)(1)(b) U.S. Postal Service, Commercial Delivery Service and Facsimile
  4.03(C)(2) Certificates of Mailing
  4.03(C)(3) Acknowledgments, Postcards and Receipts
4.03(D) Final Refusals and Appeals
4.03(E) Petitions to Director of USPTO
4.03(F) Publication
4.03(G) Opposition Proceeding
  4.03(G)(1) Opposition Period
  4.03(G)(2) Extensions of Time
4.03(H) Special Issues for Intent-to-Use Applications
  4.03(H)(1) Bona Fide Intention to Use
  4.03(H)(2) Amendment to Alleged Use
  4.03(H)(3) Notice of Allowance
  4.03(H)(4) Allegation of Use
  4.03(H)(5) Extensions of Time
  4.03(H)(6) Dividing Applications
4.03(I) Deadlines for Response; Docketing
  4.03(I)(1) Responses to Office Actions
  4.03(I)(2) Responses to Final Actions
  4.03(I)(3) Appeals
  4.03(I)(4) Publication Docketing
  4.03(I)(5) Deadlines to Oppose
  4.03(I)(6) Registration Docketing
  4.03(I)(7) Intent-to-Use Docketing
4.04 Post-registration Filings for U.S. Registrations
  4.04(A) Continuous Use
  4.04(B) Section 8 Affidavit of Continued Use
    4.04(B)(1) Deadlines
4.04(B)(2) Requirements
4.04(B)(3) Use
4.04(B)(4) Changes to Mark
4.04(B)(5) Specimens
4.04(B)(6) Acknowledgment of Receipt and Acceptance
4.04(C) Section 15 Affidavit of Incontestability
   4.04(C)(1) Deadlines
   4.04(C)(2) Requirements
   4.04(C)(3) Exclusive Use
   4.04(C)(4) Acknowledgment of Receipt and Acceptance
4.04(D) Sections 8 and 9 Affidavit of Continued Use and Application for Renewal
   4.04(D)(1) Deadlines
   4.04(D)(2) Requirements
   4.04(D)(3) Use
   4.04(D)(4) Specimens
   4.04(D)(5) Changes to Mark
   4.04(D)(6) Acknowledgment of Receipt and Acceptance
4.04(E) Checklist: Paralegal Administrator Functions—Federal Registrations—Affidavits
4.04(F) Checklist: Paralegal Administrator Functions—Federal Registrations—Renewals
4.05 Obtaining a State Registration
   4.05(A) Application
   4.05(B) Prosecution
      4.05(B)(1) Renewal of State Registrations
      4.05(B)(2) Cancellation of State Registrations
   4.05(C) Docketing
   4.05(D) Checklist: Paralegal Administrator Functions—State Registration Applications
4.06 Registration of Trade Names
Exhibit 4-1 Trademark Recordation Application Template
Exhibit 4-2 Trademark Fact Gathering Sheet
Exhibit 4-3 Letter to USPTO Transmitting Response to Office Action
Exhibit 4-4 TEAS Home Page
Exhibit 4-5 TEAS Tutorial
Exhibit 4-6 TEAS Application Form Wizard
Exhibit 4-7 Sample Electronic Use-Based Application
Exhibit 4-8 Sample Electronic Intent-to-Use Application
Exhibit 4-9 Information Available Through TEAS “HELP” Function
Chapter 5 Trademark Administration and Maintenance

5.01 Introduction

5.02 Recordkeeping and Docketing
   5.02(A) Importance; Definitions
   5.02(B) Benefits
   5.02(C) Filing Systems
      5.02(C)(1) Types of Systems
      5.02(C)(2) Organization of Files Within System
   5.02(D) Computer System
   5.02(E) Docketing Deadlines

5.03 Client Communications
   5.03(A) Client List
   5.03(B) Requests for Information or Documentation

5.04 Registration Maintenance
   5.04(A) Use Files
   5.04(B) Renewals and Other Maintenance Deadlines
   5.04(C) Tracking Agreements: Licenses, Limitations, Coexistence and Consents
5.04(D) Keeping Current on Political Events Affecting Trademark Practice

5.05 Proper Use
5.05(A) Identification and Marking in the United States
5.05(B) General Guidelines
5.05(C) Tools
  5.05(C)(1) Proper Use Manual
  5.05(C)(2) Brochures or Graphic Standards Manuals
  5.05(C)(3) Proper Use Advertising
  5.05(C)(4) Seminars and Training

5.06 Trademark Policing
5.06(A) Purpose
5.06(B) Techniques
  5.06(B)(1) Internal Policing
  5.06(B)(2) External Policing
    5.06(B)(2)(a) Trade Directories
    5.06(B)(2)(b) Watching Services
    5.06(B)(2)(c) Clipping Services
    5.06(B)(2)(d) USPTO Official Gazette
    5.06(B)(2)(e) Internet

Exhibit 5-1 Trademark Database Technical Features
Exhibit 5-2 Trademark Database Fields
Exhibit 5-3 Sample Letter to Client Requesting Use Documentation
Exhibit 5-4 Sample Letter Requesting Correct Trademark Usage

Chapter 6 Trademarks in Business Transactions

6.01 Assignments and Other Transfers of Ownership
  6.01(A) U.S. Requirements
    6.01(A)(1) Certain Assignments to Be in Writing
    6.01(A)(2) Signature of Assignor
    6.01(A)(3) Notarization
  6.01(B) U.S. Recordal
    6.01(B)(1) Procedure
    6.01(B)(2) Effect
  6.01(C) Checklists
    6.01(C)(1) Assignor
    6.01(C)(2) Assignee

6.02 Licenses
  6.02(A) In Writing
6.02(B) Quality Control
6.02(C) Restrictions on Use
6.02(D) Checklists
   6.02(D)(1) Licensor
   6.02(D)(2) Licensee

6.03 Security Interests

6.04 Acquisitions Due Diligence
   6.04(A) Due Diligence Checklist

Chapter 7 International Trademark Protection

7.01 General Principles
   7.01(A) Prior Use
   7.01(B) Territoriality of Trademark Rights
   7.01(C) Acquisition of Trademark Rights

7.02 Priority
   7.02(A) Paris Convention
   7.02(B) Madrid System
   7.02(C) Regional Systems
      7.02(C)(1) Benelux
      7.02(C)(2) European Union: Community Trade Marks and Community Designs

7.03 International Filing
   7.03(A) Filing Strategies and Costs
      7.03(A)(1) Justification for Filing
      7.03(A)(2) Preparing a Filing Program
         7.03(A)(2)(a) Filing Jurisdiction
         7.03(A)(2)(b) Domain Name Selection and Protection
         7.03(A)(2)(c) Costs
   7.03(B) Use of Agents
   7.03(C) Legalization
   7.03(D) Apostille
   7.03(E) Translation Issues
   7.03(F) Cultural and Transliteration Issues
   7.03(G) Boycotts and Embargoes
   7.03(H) Searching
      7.03(H)(1) Evaluating the Need to Search
      7.03(H)(2) Reliability of a Search
      7.03(H)(3) Searching Services
7.03(H)(4) Interpretation of Search Results
7.03(H)(5) Checklist: Searching
7.03(I) Forms
7.03(J) Powers of Attorney
7.03(K) Assignments and Recordals
   7.03(K)(1) Assignment
   7.03(K)(2) Merger and Change of Name
   7.03(K)(3) Justification for Recordal
7.03(L) Other Considerations in Filing
   7.03(L)(1) Identification of the Proper Applicant
   7.03(L)(2) Form of the Mark
   7.03(L)(3) Specification of Goods or Services; Classification
   7.03(L)(4) Electrotypes and Prints
   7.03(L)(5) Further Considerations
7.03(M) Checklist: Non-U.S. Filing
7.03(N) Dealing with Prior Marks
   7.03(N)(1) Prosecution
   7.03(N)(2) Opposition
   7.03(N)(3) Arguments
   7.03(N)(4) Consents
   7.03(N)(5) Counterdeclarations
   7.03(N)(6) Coexistence Agreements
   7.03(N)(7) Cancellation of Prior Registration
   7.03(N)(8) Acquisition of Prior Rights
   7.03(N)(9) Notice Condition
   7.03(N)(10) Hearings and Interviews
   7.03(N)(11) Time Frame
7.03(O) Loss of Rights
   7.03(O)(1) Nonuse
   7.03(O)(2) Evidence of Use: Quality or Quantity
   7.03(O)(3) Legitimate Excuse

7.04 International Trademark Maintenance
7.04(A) Marking
7.04(B) Renewals
   7.04(B)(1) Amendment of Registration
   7.04(B)(2) Reregistration Versus Renewal
   7.04(B)(3) Special Actions
   7.04(B)(4) Checklist: Renewal
7.04(C) Recordkeeping
   7.04(C)(1) Records
   7.04(C)(2) Files
   7.04(C)(3) Bills and Billing
Chapter 7  Trademark Administration

7.04(C)(4) Docket for Correspondence
7.04(C)(5) Setting Priorities
7.04(C)(6) Checklist: Recordkeeping
7.04(D) Enforcement
7.04(D)(1) Policing
    7.04(D)(1)(a) Watching Services
    7.04(D)(1)(b) Surveillance by Owner
    7.04(D)(1)(c) Investigations
7.04(D)(2) Oppositions
    7.04(D)(2)(a) Terms
       7.04(D)(2)(a)(i) Grounds for Opposition
       7.04(D)(2)(a)(ii) Chances of Success in Opposition
    7.04(D)(2)(b) Negotiations
    7.04(D)(2)(c) Coexistence Agreement
    7.04(D)(2)(d) Cancellation Actions
7.04(D)(3) Infringement, Passing-Off and Unfair Competition Actions
    7.04(D)(3)(a) Whom Does the Trademark Owner Sue?
    7.04(D)(3)(b) Grounds and Defenses
    7.04(D)(3)(c) Laches and Deadlines
    7.04(D)(3)(d) Preliminary Injunction
    7.04(D)(3)(e) Trial
    7.04(D)(3)(f) Settlement
    7.04(D)(3)(g) Extralegal Remedies
7.04(E) Gray Market Goods
7.04(F) Customs

7.05 International Trademark and Service Mark Licenses
    7.05(A) Common-Law Licensing
    7.05(B) Recordal at the Trademark Office
    7.05(C) Cancellation of License
    7.05(D) Recordal with Other Government Bureaus
    7.05(E) Trade Name Agreement

Exhibit 7-1  Sample Filing Instructions Form

Chapter 8  Litigation

8.01 General
    8.01(A) ADR and Negotiation
    8.01(B) Litigation Process
8.01(B)(1) The Courts
  8.01(B)(1)(a) Federal Courts
    8.01(B)(1)(a)(i) District Courts
    8.01(B)(1)(a)(ii) Courts of Appeals
    8.01(B)(1)(a)(iii) Supreme Court
  8.01(B)(1)(b) State Courts
  8.01(B)(2) Jurisdiction
  8.01(B)(3) Selection of Forum and Venue
  8.01(B)(4) Filing the Complaint
  8.01(B)(5) Filing the Answer
  8.01(B)(6) Discovery Practice
  8.01(B)(7) Motion Practice
  8.01(B)(8) Trial

8.01(C) Litigation Notebook
  8.01(C)(1) Print Materials
  8.01(C)(2) Electronic Materials

8.01(D) Preliminary Investigation
  8.01(D)(1) Compiling Basic Facts
  8.01(D)(2) Federal Registrations and File Histories
  8.01(D)(3) Trademark Searches
  8.01(D)(4) Advertising Use
  8.01(D)(5) Packaging
  8.01(D)(6) Financial Reports
  8.01(D)(7) Development of Evidence
  8.01(D)(8) Survey Evidence
  8.01(D)(9) Consumer Evidence
  8.01(D)(10) Checklist: Paralegal/Administrator Functions—Organization and Preliminary Investigation

8.01(E) Legal Research
  8.01(E)(1) Determining Jurisdiction
  8.01(E)(2) Determining Venue
  8.01(E)(3) Performing Case Law Searches
  8.01(E)(4) Checklist: Paralegal/Administrator Functions—Legal Research

8.01(F) Filing Suit
  8.01(F)(1) Preliminaries: Local Counsel and Local Rules
  8.01(F)(2) Complaint
  8.01(F)(3) Answer
  8.01(F)(4) Checklist: Paralegal/Administrator Functions—Filing Suit

8.01(G) Discovery
8.01(G)(1) Confidentiality and Discovery of Confidential Business Information
8.01(G)(2) Attorney-Client Privilege
8.01(G)(3) Attorney Work Product
8.01(G)(4) Interrogatories
8.01(G)(5) Receipt of Interrogatories
8.01(G)(6) Production of Documents
8.01(G)(7) Receipt of Request for Documents
8.01(G)(8) Serving Requests for Admission
8.01(G)(9) Responding to Receipts of Requests for Admission
8.01(G)(10) Proof of Service of Discovery Responses; Filing
8.01(G)(11) Depositions
  8.01(G)(11)(a) Receipt of Notice of Deposition
  8.01(G)(11)(b) Document Control
8.01(G)(12) Checklist: Paralegal/ Administrator Functions—Discovery

8.01(H) Motion Practice
  8.01(H)(1) Temporary Restraining Order
  8.01(H)(2) Summary Judgment
  8.01(H)(3) Motion in Limine
  8.01(H)(4) Checklist: Paralegal/ Administrator Functions—Motion Practice

8.01(I) Trial Preparation
  8.01(I)(1) Cataloging Evidence
  8.01(I)(2) Cataloging Case Law
  8.01(I)(3) Listing Witnesses
  8.01(I)(4) Listing Weaknesses
  8.01(I)(5) Pretrial Order
  8.01(I)(6) Checklist: Paralegal/ Administrator Functions—Trial Preparation

8.02 Inter Partes Proceedings in the U.S. Trademark Office
  8.02(A) Introduction
  8.02(B) Procedural Rules
    8.02(B)(1) Federal Rules of Civil Procedure
    8.02(B)(2) Suspension of Application
    8.02(B)(3) Service
    8.02(B)(4) Discovery Phase
      8.02(B)(4)(a) Evidence
      8.02(B)(4)(b) Notice of Reliance
      8.02(B)(4)(c) Discovery
        8.02(B)(4)(c)(i) Interrogatories
8.02(B)(4)(c)(ii) Requests for Production
8.02(B)(4)(c)(iii) Depositions
8.02(B)(4)(c)(iv) Protective Orders
8.02(B)(4)(c)(v) Motion to Compel
8.02(B)(4)(c)(vi) Testimony

8.02(B)(5) Motions
8.02(B)(6) Trial Briefs
8.02(B)(7) Oral Argument
8.02(B)(8) Remand
8.02(B)(9) Involuntary Dismissal
8.02(B)(10) Abandonment

8.02(C) Oppositions
  8.02(C)(1) Extensions of Time
  8.02(C)(2) Notice of Opposition

8.02(D) Petition to Cancel
8.02(E) Concurrent Use
8.02(F) Interference

8.03 Infringement Litigation
  8.03(A) Likelihood of Confusion
    8.03(B) Defenses
      8.03(B)(1) Introduction
        8.03(B)(1)(a) Checklist: Paralegal/ Administrator Functions—Likelihood-of-Confusion Defense
      8.03(B)(2) Genericness
        8.03(B)(2)(a) Checklist: Paralegal/ Administrator Functions—Genericness Defense
      8.03(B)(3) Descriptiveness
        8.03(B)(3)(a) Checklist: Paralegal/ Administrator Functions—Descriptiveness Defense
      8.03(B)(4) Fair Use
        8.03(B)(4)(a) Checklist: Paralegal/ Administrator Functions—Fair Use Defense
      8.03(B)(5) Laches
        8.03(B)(5)(a) Checklist: Paralegal/ Administrator Functions—Laches Defense
      8.03(B)(6) Estoppel
    8.03(C) Remedies
      8.03(C)(1) Temporary Restraining Order
      8.03(C)(2) Preliminary Injunction
8.03(C)(3) Permanent Injunction
  8.03(C)(3)(a) Checklist: Paralegal/ Administrator Functions—Permanent Injunction

8.03(C)(4) Damages
8.03(C)(5) Accounting of Infringer’s Profits
8.03(C)(6) Punitive Damages

8.04 Antidilution Litigation
  8.04(A) Federal Antidilution Actions
    8.04(A)(1) Defenses
      8.04(A)(1)(a) Lack of Distinctiveness
      8.04(A)(1)(b) Lack of Fame
      8.04(A)(1)(c) Prior Use
      8.04(A)(1)(d) Fair Use
    8.04(A)(2) Dilution Remedies
      8.04(A)(2)(a) The Primary Remedy: Injunction
      8.04(A)(2)(b) Damages Where Dilution Is Proved Willful

  8.04(A)(3) Checklist: Paralegal/ Administrator Functions—Antidilution Actions

8.05 Cybersquatting and Other Internet-Related Infringements
  8.05(A) Jurisdiction
  8.05(B) Remedies
  8.05(C) UDRP Proceedings
    8.05(C)(1) Jurisdiction
    8.05(C)(2) Remedies
  8.05(D) Checklist: Paralegal/ Administrator Functions—Cybersquatting and Other Internet-Related Infringements

Exhibit 8-1 Litigation Notebook Outline
Exhibit 8-2 Complaint
Exhibit 8-3 Answer
Exhibit 8-4 First Set of Interrogatories
Exhibit 8-5 Request for Production of Documents
Exhibit 8-6 Request for Admission

Chapter 9 Ethics

9.01 USPTO Code of Professional Responsibility
  9.01(A) Canon 1
  9.01(B) Canon 2
  9.01(C) Canon 3
9.01(D) Canon 4
9.01(E) Canon 5
9.01(F) Canon 6
9.01(G) Canon 7
9.01(H) Canon 8
9.01(I) Canon 9

9.02 Unauthorized Practice of Law
9.03 Confidentiality
9.04 Conflicts of Interest
Exhibit 9-1 Sample Conflict of Interest Check Form

Chapter 10 Resources

10.01 Third Party Resources
   10.01(A) U.S. Patent and Trademark Office (USPTO)
   10.01(B) Trademark Research and Monitoring Services
      10.01(B)(1) SAEGIS
      10.01(B)(2) CCH CORSEARCH
      10.01(B)(3) Other Databases
   10.01(C) LexisNexis
   10.01(D) Westlaw
   10.01(E) Dialog
   10.01(F) International Trademark Databases
   10.01(G) Internet
   10.01(H) International Agents
   10.01(I) Investigators

10.02 Useful Addresses
   10.02(A) USPTO
   10.02(B) WIPO
   10.02(C) OHIM
   10.02(D) U.S. State Secretary of State Offices

10.03 Obtaining Documents
   10.03(A) What Is Available to the Public
   10.03(B) Obtaining Copies
   10.03(C) Legalization