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INTELLECTUAL PROPERTY ATTORNEYS

Trademark Process FAQs

The Trademark Process

This booklet provides useful basic information and answers to frequently asked questions regarding the trademark process and can serve as a good foundation for further discussions with an intellectual property attorney.

The following materials are adapted from the United States Patent and Trademark Office (USPTO) and provide a general guide to the trademark process. This booklet is not intended to provide legal advice. Trademark laws and regulations are complex and subject to change. Please consult an intellectual property attorney for counsel regarding your specific intellectual property matters.

Frequently Asked Questions About The Trademark Process

1 What is a trademark?

A trademark is a word, phrase, symbol or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others.

2 What is a service mark?

A service mark is a word, phrase, symbol or design, or a combination thereof, that identifies and distinguishes the source of a service rather than goods. The term “trademark” is often used to refer to both trademarks and service marks.

3 Who may file an application for a trademark?

Only the owner of the trademark may file an application for registration. The owner controls the use of the mark, and controls the nature and quality of the goods to which it is affixed, or the services for which it is used. The owner may be an individual, corporation, partnership, LLC, or other type of legal entity.

4 Must I register my trademark?

No. You can establish rights in a mark based on use of the mark in commerce, without a registration. However, owning a federal trademark registration on the Principal Register provides several important benefits.

5 What are the benefits of federal trademark registration?

Owning a federal trademark registration on the Principal Register provides several advantages, including:

- Public notice of your claim of ownership of the mark;
- A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in federal court;
- The use of the U.S. registration as a basis to obtain registration in foreign countries;
- The ability to record the U.S. registration with the U.S. Customs and Border Protection (CBP) Service to prevent importation of infringing foreign goods;
- The right to use the federal registration symbol ® and
- Listing in the United States Patent and Trademark Office's online databases.

6 Should I conduct a search for similar trademarks before filing an application?

It is advisable to conduct a search before filing your application. You may search the USPTO's Trademark Electronic Search System (TESS) database, available through www.uspto.gov, free of charge before filing, or you may wish to hire an attorney to perform the search and assess the results for you. Alternatively, you can search the database at a Patent and Trademark Depository Library (PTDL).

The USPTO cannot search your mark for you prior to filing. After filing, the USPTO will conduct a search and will refuse to register your mark if there is another registered or pending mark similar to yours.

7 How long will it take for my mark to register?

The total time for an application to be processed may be anywhere from almost a year to several years, depending on the basis for filing and the legal issues that may arise in the examination of the application.

Trademark Application and Post-Registration Process Timelines are available at http://www.uspto.gov/trademarks/process/tm_timeline.jsp.

8 How long does a trademark registration last?

The registration is valid as long as you timely file all post registration maintenance documents. You must file a “Declaration of Use under Section 8” between the fifth and sixth year following registration. In addition, you must file a combined “Declaration of Use and Application for Renewal under Sections 8 and 9” between the ninth and tenth year after registration, and every 10 years thereafter.

9 Is registration guaranteed and can I get a refund of money paid?

Registration is not guaranteed and only money paid when not required may be refunded. A legal and procedural review of the application is performed by the USPTO, which may deny registration of the mark. If no refusals are identified or if all identified issues have been resolved, the USPTO approves the mark for publication in the *Official Gazette (OG)*, a weekly online publication. After publication in the *OG*, there is a 30-day period in which the public may object to the registration of the mark by filing an opposition, which is similar to a court proceeding, but is held before the Trademark Trial and Appeal Board, a USPTO administrative tribunal.

Examination Of Applications In The USPTO

1 Legal and Procedural Review of the Application

Approximately 3 months from the date your application is filed, the application is assigned to an examining attorney to determine whether federal law permits registration. The examining attorney will examine the written application, the drawing, and any specimen. Federal registration of trademarks is governed by the Trademark Act of 1946, 15 U.S.C. §1051 *et seq.*, and the *Trademark Rules of Practice*, 37 C.F.R. Part 2.

The examining attorney may issue a letter (Office action) explaining any reasons for refusing registration or other requirements. If you receive an Office action, you must submit a response **within 6 months** of the issue date of the Office action. Your filing fee will NOT be refunded if the application is refused registration.

The most common reason for refusing registration is a likelihood of confusion with the mark in a registration or prior application. The examining attorney will search the USPTO database to determine whether there are any marks that are likely to cause confusion with your mark. The principal factors considered by the examining attorney in determining whether there would be a likelihood of confusion are the following:

- The similarity of the marks; and
- The commercial relationship (e.g., channels of trade or class of purchasers) between the goods/services listed in the application and those listed in the registration or pending application.

To find a conflict, the marks do not have to be identical and the goods/services do not have to be the same. It may be enough that the marks are similar and the goods/services are related.

Registration may also be refused if the mark is:

- Descriptive for the goods/services;
- A geographic term;
- A surname; and/or
- Ornamental as applied to the goods.

Examination Of Applications In The USPTO (cont.)

2 Publication for Opposition

If no refusals or additional requirements are identified or if all identified issues have been resolved, the examining attorney approves the mark for publication in the *Official Gazette (OG)*, a weekly online publication. The USPTO will send you a Notice of Publication stating the publication date.

After publication in the *OG*, there is a 30-day period in which the public may object to the registration of the mark by filing an opposition. An opposition is similar to a court proceeding, but is held before the Trademark Trial and Appeal Board, a USPTO administrative tribunal. A third party who is considering filing an opposition may first file a request for an extension of time to file the opposition, which could delay further action on your application.