

BASIC FACTS ABOUT REGISTERING A TRADEMARK

What is a Trademark?

A TRADEMARK is either a word, phrase, symbol or design, or combination of words, phrases, symbols or designs, which identifies and distinguishes the source of the goods or services of one party from those of others. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. In this pamphlet, the terms "trademark" and "mark" are used to refer to both trademarks and service marks whether they are word marks or other types of marks. Normally, a mark for goods appears on the product or on its packaging, while a service mark appears in advertising for the services.

Establishing Trademark Rights

Trademark rights arise from either (1) actual use of the mark, or (2) the filing of a proper application to register a mark in the Patent and Trademark Office (PTO) stating that the applicant has a bona fide intention to use the mark in commerce regulated by the U.S. Congress. (See below, under "Types of Applications," for a discussion of what is meant by the terms commerce and use in commerce.) **Federal registration is not required to establish rights in a mark, nor is it required to begin use of a mark.** However, federal registration can secure benefits beyond the rights acquired by merely using a mark. For example, the owner of a federal registration is presumed to be the owner of the mark for the goods and services specified in the registration, and to be entitled to use the mark nationwide.

Unlike copyrights or patents, trademark rights can last indefinitely if the owner continues to use the mark to identify its goods or services. The term of a federal trademark registration is 10 years, with 10-year renewal terms. However, between the fifth and sixth year after the date of initial registration, the registrant must file an affidavit setting forth certain information to keep the registration alive. If no affidavit is filed, the registration is canceled.

Unregistered, or Common Law, Trademarks

The term "common law" indicates that the trademark rights that are developed through use are not governed by statute. Instead, common law trademark rights have been developed under a judicially created scheme of rights governed by state law.

Common law trademark rights are limited to the geographic area in which the mark is used. Thus, if a baseball bat is sold under the name BLASTER in California only, the trademark rights to that name exist only in California. If another baseball bat manufacturer begins to market a different bat in New York under the same name (assuming they had no knowledge of the California company), then there would be no trademark infringement. However, if the New York company attempted to sell their baseball bat, they would discover that the California company's common law rights to the mark would prevent them from entering the California market. The question of which company was entitled to use the mark in other states would depend on who used it first in that state.

Since no registration is required in order to establish common law rights to a trademark, it can be difficult to discover whether anyone has trademark rights in a particular mark.

Benefits of Federal Registration

There are numerous advantages to securing federal registration of a trademark. Perhaps the most important advantage is that federally registered trademarks are national in scope, regardless of the actual geographic use made of the mark. This national scope contrasts greatly with the limited geographic range of common law trademarks.

Additional substantive benefits received through federal registration include:

- The ability to recover profits, damages and costs for infringement, including the possibility of receiving treble damages in certain circumstances;
- The ability to recover attorneys fees in infringement actions;
- The incontestable status that a mark can achieve after five years of registration, which serves to eliminate most arguments that the registrant does not have the exclusive right to utilize the mark;
- The right to use the ® symbol in connection with the mark, which may deter potential infringers;

- Increased ease of discovery by those doing trademark searches, which helps to prevent the adoption of confusingly similar marks by third parties;
- The right to sue for infringement in federal courts; and
- The ability to have the customs service block the importation of goods bearing an infringing mark.
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Federal registration also makes it easier to prove an allegation of trademark infringement by providing prima facie evidence of trademark ownership and use. The registration can also be used as evidence that the mark does indeed function as a mark and is not confusingly similar to other registered marks.

Types of Applications for Federal Registration

An applicant may apply for federal registration in three principal ways. (1) An applicant who has already commenced using a mark in commerce may file based on that use (a "use" application). (2) An applicant who has not yet used the mark may apply based on a bona fide intention to use the mark in commerce (an "intent-to-use" application). (3) Additionally, under certain international agreements, an applicant from outside the United States may file in the United States based on an application or registration in another country.

For the purpose of obtaining federal registration, commerce means all commerce which may lawfully be regulated by the U.S. Congress, for example, interstate commerce or commerce between the U.S. and another country. The use in commerce must be a bona fide use in the ordinary course of trade, and not made merely to reserve a right in a mark. Use of a mark in promotion or advertising before the product or service is actually provided under the mark on a normal commercial scale does not qualify as use in commerce. Use of a mark in purely local commerce within a state does not qualify as "use in commerce." If an applicant files based on a bona fide intention to use in commerce, the applicant will have to use the mark in commerce and submit an allegation of use to the PTO before the PTO will register the mark.

A United States registration provides protection only in the United States and its territories. If the owner of a mark wishes to protect a mark in other countries, the owner must seek protection in each country separately under the relevant laws.

Who May File an Application?

The application must be filed in the name of the owner of the mark; usually an individual, corporation or partnership. The owner of a mark controls the nature and quality of the goods or services identified by the mark.

Foreign Applicants

Applicants not living in the United States must designate in writing the name and address of a domestic representative -- a person residing in the United States "upon whom notices of process may be served for proceedings affecting the mark." The applicant may do so by submitting a statement that the named person at the address indicated is appointed as the applicant's domestic representative under §1(e) of the Trademark Act. The applicant must sign this statement. This person will receive all communications from the PTO unless the applicant is represented by an attorney in the United States.

Searches for Conflicting Marks

An applicant is not required to conduct a search for conflicting marks prior to applying with the PTO. However, some people find it useful. In evaluating an application, an examining attorney conducts a search and notifies the applicant if a conflicting mark is found. The application fee, which covers processing and search costs, will not be refunded even if a conflict is found and the mark cannot be registered.

To determine whether there is a conflict between two marks, the PTO determines whether there would be likelihood of confusion, that is, whether relevant consumers would be likely to associate the goods or services of one party with those of the other party as a result of the use of the marks at issue by both parties. The principal factors to be considered in reaching this decision are the similarity of the marks and the commercial relationship between the goods and services identified by the marks. To find a conflict, the marks need not be identical, and the goods and services do not have to be the same.

The PTO does not conduct searches for the public to determine if a conflicting mark is registered, or is the subject of a pending application, except as noted above when acting

on an application. However, there are a variety of ways to get this same type of information, including private search firms that can determine whether there are conflicting marks.

Specific Classes Of Goods Or Services

Trademarks can only be registered in specific categories of goods or services. You should only seek trade mark registration for those categories of goods and/or services in which you are using, or realistically intend to use, your mark.

It is important that the statement of goods and services on your application be properly drafted as on the one hand, if too narrow, it will limit the protection provided by the registered trademark, and on the other, if worded too broadly, it may make your application or registration vulnerable to attack, for example on the basis of “non-use” of the mark.

Use of the "TM," "SM" and "®" Symbols

Anyone who claims rights in a mark may use the TM (trademark) or SM (service mark) designation with the mark to alert the public to the claim. It is not necessary to have a registration, or even a pending application, to use these designations. The claim may or may not be valid. The registration symbol, ®, may only be used when the mark is registered in the PTO. It is improper to use this symbol at any point before the registration issues.

THE REGISTRATION PROCESS

Filing Date - Filing Receipt

The PTO is responsible for the federal registration of trademarks. When an application is received, the PTO reviews it to determine if it meets the minimum requirements for receiving a filing date. If the application meets the filing requirements, the PTO assigns it a serial number and sends the applicant a receipt about **two months after filing**. If the minimum requirements are not met, the entire mailing, including the filing fee, is returned to the applicant.

Examination

About four months after filing, an examining attorney at the PTO reviews the application and determines whether the mark may be registered. If the examining attorney determines that the mark cannot be registered, the examining attorney will issue a letter listing any grounds for refusal and any corrections required in the application. The examining attorney may also contact the applicant by telephone if only minor corrections are required. The applicant must respond to any objections within six months of the mailing date of the letter, or the application will be abandoned. If the applicant's response does not overcome all objections, the examining attorney will issue a final refusal. The applicant may then appeal to the Trademark Trial and Appeal Board, an administrative tribunal within the PTO.

A common ground for refusal is likelihood of confusion between the applicant's mark and a registered mark. Marks which are merely descriptive in relation to the applicant's goods or services, or a feature of the goods or services, may also be refused. Marks consisting of geographic terms or surnames may also be refused. Marks may be refused for other reasons as well.

Publication for Opposition

If there are no objections, or if the applicant overcomes all objections, the examining attorney will approve the mark for publication in the Official Gazette, a weekly publication of the PTO. The PTO will send a NOTICE OF PUBLICATION to the applicant indicating the date of publication. In the case of two or more applications for similar marks, the PTO will publish the application with the earliest effective filing date first. Any party who believes it may be damaged by the registration of the mark has 30 days from the date of publication to file an opposition to registration. An opposition is similar to a formal proceeding in the federal courts, but is held before the Trademark Trial and Appeal Board. If no opposition is filed, the application enters the next stage of the registration process.

Issuance of Certificate of Registration or Notice of Allowance

If the application was based upon the actual use of the mark in commerce prior to approval for publication, the PTO will register the mark and issue a registration certificate about 12 weeks after the date the mark was published, if no opposition was

filed.

If, instead, the mark was published based upon the applicant's statement of having a bona fide intention to use the mark in commerce, the PTO will issue a NOTICE OF ALLOWANCE about 12 weeks after the date the mark was published, again provided no opposition was filed. The applicant then has six months from the date of the NOTICE OF ALLOWANCE to either (1) use the mark in commerce and submit a STATEMENT OF USE, or (2) request a six-month EXTENSION OF TIME TO FILE A STATEMENT OF USE. The applicant may request additional extensions of time. If the STATEMENT OF USE is filed and approved, the PTO will then issue the registration certificate.

Specimen of Trademark Use

For trademarks currently being used at the time of the application, the applicant must submit a "speciment" demonstrating that the mark is being used in commerce. For trademark applications filed for an "intent to use" the mark, specimens must be filed in order to obtain a registration certificate.

The specimens must be actual samples of how the mark is being used in commerce.

If the mark is used on **goods**, examples of acceptable specimens are tags or labels which are attached to the goods, containers for the goods, displays associated with the goods, or photographs of the goods showing use of the mark on the goods themselves. Photographs or other acceptable reproductions that show the mark on the goods, or packaging for the goods, must be furnished. Invoices, announcements, order forms, bills of lading, leaflets, brochures, catalogs, publicity releases, letterhead, and business cards generally are not acceptable specimens for goods.

If the mark is used for **services**, examples of acceptable specimens are signs, brochures about the services, advertisements for the services, business cards or stationery showing the mark in connection with the services, or photographs which show the mark either as it is used in the rendering or advertising of the services. In the case of a service mark, the specimens must either show the mark and include some clear reference to the type of services rendered under the mark in some form of advertising, or show the mark as it is used in the rendering of the service, for example on a store front or the side of a delivery or service truck.