

TRADEMARK REGISTRATION PROCESS

U.S. Federal Applications

1. In the U.S. (and many other countries), trademark rights derive from use and registration. A prior user of a “confusingly similar” mark will have priority over your proposed mark. The owner of a U.S. registration has priority for the registered mark throughout the U.S. over any later-adopted mark that is likely to cause consumer confusion or to dilute the distinctive value of the prior mark. A prior user may bring suit to enjoin use of the later mark and claim damages and attorneys’ fees. Most practitioners therefore recommend searching before filing an application to register a trademark. A preliminary database trademark scan-type search (or “knock-out” search) is a search of the state and federal trademark registration databases, but only for marks that are identical or nearly so. If the scan discloses direct “hits,” the mark should not be adopted.
2. The industry standard is a full U.S. trademark search which is a comprehensive search state and federal trademark registration databases, as well as industry directories, business names, domain names and other relevant databases.
3. Filing a trademark application and prosecuting the application to registration (for one class of goods or services) costs a minimum average of \$2,000 (US), but charges can vary widely depending on the circumstances. Trademark prosecution takes at least a year if no substantive objection is made by the trademark office and if the mark is not opposed by another party. If there is such an objection, or if the mark is not put into use, the application can take much longer.

California State Applications

1. It is also possible to have a California state trademark registration. You should still search the mark first. Coverage is only for the state of California, and the application cannot be based on intent to use the trademark.
2. It is generally much cheaper (averaging under \$1,000) and faster.

Non-U.S. Applications

1. If you are planning to sell or manufacture in other countries, or if your mark’s reputation may extend to other countries, it is wise to consider searching and registering your trademark in those countries.
2. Costs and timing vary dramatically based on the countries of interest. We can prepare estimates once we have more information.

Information Required

Trademark Application.

1. Complete name and contact information (including state of incorporation or organization if the applicant is a corporation or LLC);

2. The identity of the mark to be protected and any meaning it might have in the trade or as applied to the goods or services (if it is a design mark, we will need a jpeg of the mark, *without* any TM symbol or other wording on it);
3. A very specific description of the products or services to which the mark is applied (or to be applied if intent to use), including the field of use and the type of consumer; NOTE: if the mark is based on use, it must be in use on *all* the goods and services covered by the application.
4. Federal applications only: Will the application be based on use or intent to use?
5. If the application is to be based on use, the date of first use (usually the date of first sale of products bearing the mark or the date of first advertisement bearing the mark [provided the services have been rendered], if the mark is for services), and two "specimens" showing use of the mark on the goods/services (tags, labels for goods; advertisements for services).

Process

These are the common steps to registration:

1. File application;
2. Trademark Office (TMO) sends an "office action" listing requirements to be met and possible objections (3-6 mos.);
3. Applicant responds (within 6 mos.);
4. #2 and #3 are sometimes repeated;
5. Assuming the TMO is now satisfied, about 3 months after the last response, the TMO will publish the mark in a periodical called the Official Gazette which is on its website; others have 30 days (which can be extended up to 120 days) to oppose registration;
6. If no opposition is filed, the application typically proceeds to registration about 3 months later. If the application is based on intent to use, however, instead of the registration, a Notice of Allowance issues and the applicant has up to 3 years to file evidence of use, after which the registration issues. During this period, the applicant must ask for additional time and pay a fee every 6 months.
7. A declaration of continued use must be filed between years 5 and 6 after registration.
8. A renewal application must be filed in the 9th year after registration, and every 10 years thereafter, to keep the registration in force.

Supplemental v. Principal Register

Registration on the *Principal Register* provides the ability to stop importation of infringing products. Registration on the Principal Register also provides the possibility of achieving incontestability of the registration after five years continuous use. Incontestability makes certain of the presumptions below not rebuttable, subject to certain defects and defenses. A Principal Register registration provides the following evidentiary presumptions:

- Validity of mark and its registration;
- Ownership;
- Nationwide rights;
- Priority;
- That the mark is actually in use nationwide;
- That the infringer had notice of the registration; and
- Presumption of the truth of the facts stated in the registration (e.g. first use date).

Registration on the *Supplemental Register* does not afford all the benefits of registration on the Principal Register, and you must be using the mark on *all* the goods and services in the application to amend to the Supplemental Register. It is possible after several years of use to reapply for a registration on the Principal Register. Registration on the Supplemental Register does provide the following advantages:

- The registrant may use the registration symbol ®;
- The registration is protected against registration of a confusingly similar mark under Trademark Act Section 2(d);
- The registrant may bring suit for infringement in federal court; and
- The registration may serve as the basis for a filing in a foreign country under the Paris Convention and other international agreements, although this is no guarantee that any such application will be accepted by the foreign country.

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