



You Should Trademark That!

Not so fast.

With the emergence of on-line companies advertising discounted trademark registration services, one could easily be misled into believing that securing a trademark registration has been relegated to nothing more than a ministerial act; that with the insouciant wave of the hand, a trademark registration will instantaneously appear at your door step.

Nothing could be further from the truth. And if you are going to take one thing from this article, let it be this -- do not take a cavalier approach to developing, protecting, and maintaining what will undoubtedly become one of your business's most valued assets.

Securing a trademark registration is an art, not a science. It requires both careful attention to detail, and a com-



prehensive understanding of the rules and regulations that govern trademark prosecution. The purpose of this article is to provide an overview of the basic phases of the trademark prosecution process: the clearance phase, the application phase, the examination phase, and the post-registration maintenance phase.

Phase 1: The Clearance Search

The viability of a trademark begins with a quality clearance search. A clearance search is the process by which a potential trademark is vetted by a trained professional to ensure that the potential trademark is not already registered, or in use, by a third-party operating in the

same market. Surprisingly, many trademark applicants bypass this critical phase and proceed with a trademark application without commissioning a proper clearance search. This is a mistake. Why expend the time, and money, developing a trademark which a third party may already have priority rights to?

There are two basic types of clearance searches -- a "knockout" search and a "comprehensive" search. A "knockout" search is a simple, cost-effective method of identifying any obvious conflicts with respect to a potential trademark. A "knockout" search involves an analysis of the United States Patent and Trademark Office ("USPTO") database to determine whether a third-party has applied for, or registered, the potential trademark.

A "comprehensive" search is more thorough. Not only does it involve an analysis of the USPTO database, but this search also undertakes a review of state trademark registrations, business databases, domain name registries, and the

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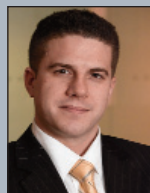
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web. Unlike a “knockout” search which can usually be conducted by counsel, retention of a search firm is often necessary to conduct a “comprehensive” search.

Once the clearance search is complete, the trademark applicant should consult with counsel to ascertain whether any potential obstacles to registration exist. Additionally, the trademark applicant can decide with counsel whether an opinion letter should be prepared analyzing the results of the clearance search. An opinion letter may assess any number of issues including, but not limited to, whether the potential trademark may be registered with the USPTO.

Assuming that the potential trademark successfully passes through the clearance phase, the next step is the preparation of a federal trademark application.

Phase 2: The Application

A federal trademark application can be prepared, and filed, at a discounted rate directly through the USPTO’s “Trademark Electronic Application System.” All trademark applications require some basic information. Although additional detailed information will be required to prepare a complete trademark application, the following are examples of some of the categories of information that must be disclosed in a trademark application: (1) an identification of the individual or entity that will own the trademark application; (2) disclosure of the potential trademark; (3) a description of the goods or services upon which the trademark will be, or is, used; (4) the statutory basis upon which the application is being filed; (5) the name of the representative responsible for filing the application; and (6) a signed verification from an individual authorized by the owner.

1. Ownership: A trademark application must identify the owner of the application. An individual or legal entity can own a trademark application. For example, a natural person, corporation, limited liability partnership, joint venture, trust, or estate may be identified as the owner of a trademark application. In addition, the application must also contain the owner’s contact information. Note that all ownership information will become public upon the filing of a trademark application.

2. Disclosure of Mark: There are three types of trademarks, a standard character trademark, a stylized design trademark, and a non-visual trademark. The two most common trademarks are the standard character trademark and the stylized design trademark. A standard character trademark consists of words, letters, or numbers which do not contain any particular design element. Unlike a standard character trademark, a stylized design trademark consists of stylized words, letters, or numbers, and a particular design element. Although uncommon, a non-visual trademark can take the form, for example, of a unique sound recording (i.e. a sound clip that is associated with the trademark applicant). The type of trademark, and an appropriate description thereof, must be disclosed in the trademark application.

3. Goods and Services Classification: The application must also state the specific goods and/or services upon which the trademark is, or will be, used. The Manual of Trademark Acceptable Identifications of Goods & Services (publicly available on the USPTO website) should be consulted as a starting point in determining appropriate goods or services classifications for the trademark. To expedite the registration process, the applicant should only use classifications that are appropriately tailored to the goods or services upon which the trademark is, or will be, used. During the ex-

amination process, an applicant may be asked to limit the scope of the goods and services classifications, but can never expand the scope of the goods or services classifications once the application is filed with the USPTO. Note that a mark which is used solely in connection with services (as opposed to goods) is properly referred to as a “service mark.”

4. Filing Basis: The trademark application must provide the statutory basis upon which the application is filed. The two most common statutory bases are sections (a) and (b) of 15 U.S.C. § 1051. Section (a) is appropriate if the applicant is currently using the trademark in commerce in connection with the goods or services identified in the application at the time of filing. And section (b) is appropriate if the applicant maintains a bona fide intent to use the trademark in commerce in connection with the goods or services identified in the application at the time of filing. Additional provisions exist for the filing of U.S. trademark applications based upon foreign trademark applications or registrations. Importantly, filing bases are assigned on a class by class basis. Thus, a trademark application which seeks protection in two distinct classifications may be based on both section (a) and section (b) if the applicant is currently using the trademark in one class and has a bona fide intent to use the trademark in the other class. Note that if a section (a) basis is selected, the applicant must submit adequate specimens with the application that demonstrate use of the trademark on the goods or services stated in the application and provide the dates of first use.

5. Representative Information: If the applicant retains counsel to assist in the prosecution of the trademark application, that attorney’s information (including the attorney’s name, address, and law firm affiliation) must be disclosed in the application. The trademark application permits the applicant to

appoint multiple attorneys to assist in the filing and prosecution of the trademark. In addition, if the trademark applicant is a non-U.S. individual or entity, the applicant can authorize a domestic representative (which can be the attorney of record) to act on the applicant's behalf. If an attorney is not retained, the applicant will be listed as the correspondent of record. If an attorney is retained, the USPTO will correspond with the appointed attorney.

6. Verification: In accordance with 18 U.S.C. § 1001, the contents of the trademark application must be verified. A trademark application can be verified by an authorized attorney or an individual with appropriate authority to bind the trademark applicant.

Once the trademark application is complete, the application must be filed with the USPTO and, at that time, the appropriate filing fees paid. Once filed, the USPTO will assign the trademark application a serial number. The assigned serial number should be promptly recorded as the USPTO will require this number for all correspondence with the USPTO concerning the trademark application.

Phase 3: Examination

A trademark applicant is not entitled to a federal trademark registration upon the filing of a trademark application. Instead, the filing of an application is simply the first step in what could take several years before a formal trademark registration will issue. As outlined below, any number of issues can arise prior to the issuance of a trademark registration which will require careful review, analysis, and consideration.

Once filed, it will take several months before a USPTO examining attorney reviews the trademark application. Upon completion of that preliminary review, the examining attorney will likely contact the applicant's representa-

tion to address any issues or objections relating to the application. One of the more common forms of communications from the USPTO examining attorney is an "office action." There are several reasons why the examining attorney may issue an office action. For example, the examining attorney may:

- request that the applicant issue a disclaimer with respect to certain of the subject matter of the trademark;
- request that the applicant clarify the goods or services classifications set forth in the application;
- in the case of a section (a) filing, object to the specimens of use submitted with the trademark application;
- object to the proposed trademark on the basis that it is merely descriptive of the goods or services set forth in the application;
- object to the proposed trademark on the basis that there is a likelihood of confusion with an existing trademark application or registration; or
- object to the proposed trademark on the basis that it is primarily merely a surname.

The above is not an exhaustive list of the issues which may be raised in an office action. The office action will state the time that an applicant has to respond to the issues raised in the office action, which, generally speaking, is six months from the date of the issuance of the office action. If a response is not timely filed, the USPTO will deem the application abandoned and a trademark regis-

tration will not issue. Importantly, a carefully crafted response to an office action will save significant amounts of time and money in the continued prosecution of the application. If the examining attorney does not agree with the arguments presented in a response to a final office action, appeals are available before the Trademark Trial and Appeal Board.

Once the examining attorney completes the preliminary assessment of the trademark application - - and all issues raised by the examining attorney are completely addressed - - the trademark application will be published for opposition in the USPTO Trademark Official Gazette. The Trademark Official Gazette is the USPTO's official journal, published weekly, and contains a complete listing of all trademarks which have recently been published for opposition. Note that if the applicant commences use of the trademark prior to the trademark being approved for publication, the trademark application should be amended to reflect such usage.

Once published, any person who believes that he, she, or it will be damaged by registration of the mark has thirty days to either file an opposition proceeding to oppose the trademark application or request an extension of time to file such proceeding. An opposition proceeding is similar to a proceeding in a federal court (that is, it involves pleadings, discovery, motion practice, and a trial period), but is held before the Trademark Trial and Appeal Board. Trademark opposition proceedings are serious matters and counsel, if not already appointed, should be retained to ensure



that the applicant's interests are properly protected.

If the application is not opposed (and no third-party extends their time to oppose the application), the next step in the prosecution process differs depending upon the filing basis cited in the application. In the U.S. system, a formal trademark registration cannot issue until the applicant adequately demonstrates to the satisfaction of the USPTO that the trademark is currently used in commerce. Thus, if the applicant cited section (a) (that is, the trademark was "in use" at the time the application was filed), a formal trademark registration should issue after the conclusion of the publication period. Recall that in a section (a) application, the applicant must include specimens that demonstrate use of the trademark in commerce and that the examining attorney will review such specimens prior to publication.

However, if the application was filed under section (b) (that is, the applicant has a "bona fide intent to use" the trademark in commerce at the time the application was filed), upon conclusion of the publication period, the USPTO will issue a "Notice of Allowance." Once a Notice of Allowance issues, the applicant has an initial six month term to adequately demonstrate that the trademark is being used in commerce. If the applicant is not using the trademark in commerce during that initial six month term, the applicant can request an additional six months. Notably, an applicant is entitled to a maximum of five such extensions.

Once the applicant begins using the trademark in commerce, the applicant, at this point, can file a "Statement of Use." A "Statement of Use" is the filing by which the trademark applicant: (1) verifies the current use of the mark in commerce; (2) provides the dates that the trademark was first used in commerce; and (3) submits specimens that

depict the usage of the trademark in commerce. Once that submission is approved by the USPTO, a formal trademark registration should issue.

Phase 4: Post-Registration Maintenance

Once issued, a trademark registration must be properly maintained or the registration will be cancelled by the USPTO. To that end, certain filings (outlined below) must be made within the appropriate time frames to ensure that the registration is not cancelled. Although there are "grace periods" in which belated maintenance filings can be made, best practices require that all renewal filings be made prior to the expiration of the time periods prescribed by statute.

1. Section 8 Declaration

Under Section 8 of the Lanham Act (15 U.S.C. § 1058), the trademark registrant is required to file a declaration with the USPTO confirming that the trademark is in continued use in commerce in connection with the registered goods or services. This filing, a declaration by the trademark owner under Section 8, must be made at the following times: (1) between the 5th and 6th year after the issuance of the registration; and (2) within one year of the end of every ten-year period after the issuance of the registration (that is, between the 9th and 10th years post registration, between the 19th and 20th years post registration, etc.). A statutory filing fee must be submitted along with a specimen demonstrating the continued use of the trademark in commerce.

2. Section 15 Declaration

This is an optional (but highly recommended) post-registration filing available under Section 15 of the Lanham Act (15 U.S.C. § 1065). This filing provides the trademark registrant with the opportunity to have the trademark

declared "incontestable." This filing can be made after the expiration of any five year period of continuous use of the trademark in commerce post registration. Often times this coincides with the filing of the initial Section 8 declaration (outlined above). Thus, the USPTO offers a combined Section 8/15 filing that, if appropriate, can be made. Assuming that the registrant can make the representations required in a Section 15 declaration, the avenues by which a third-party can later challenge the validity of the trademark become extremely circumscribed.

3. Section 9 Declaration

Under Section 9 of the Lanham Act (15 U.S.C. § 1059), the trademark registrant is also required to file a renewal declaration with the USPTO which serves to renew the trademark registration. The declaration may be filed within one year before the end of every ten-year period after the issuance of the registration (that is, between the 9th and 10th year post registration, between the 19th and 20th years post registration, etc.). Because this coincides with the filing of the second Section 8 declaration (and all future Section 8 declarations), the USPTO offers a combined Section 8/9 filing that, if appropriate, can be made. Once the appropriate filing fee is paid and the Section 9 filing is accepted, the trademark registration is renewed for an additional ten year period.

Final Thoughts...

Trademark prosecution is an involved process and it is difficult, if not impossible, to properly address all of the nuances involved with successfully navigating a trademark application through the registration process in one article. However, we trust that you found the foregoing information insightful to the extent that it seeks to capture, in an abbreviated nature, the major phases of the life of a trademark application.

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