

What is a trademark or service mark?

- Generally speaking, 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.
- A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than goods.

Should I register my mark?

Federal registration of your trademark is not required. You can establish rights in a trademark based on use of the mark in commerce, without a registration. However, owning a federal trademark registration on the Principal Register provides a number of advantages, such as:

- 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;
- Public notice of your claim of ownership of the mark;
- Listing in the USPTO online databases;
- The ability to record the U.S. registration with the U.S. Customs and Border Protection Service to prevent importation of infringing foreign goods;
- The right to use the federal registration symbol “®”;
- The ability to bring an action concerning the mark in federal court; and
- The use of the U.S. registration as a basis to obtain registration in foreign countries.

What do I need to file a federal trademark application?

- Name of the trademark owner (the “Applicant”)
- Name and address for correspondence
- Depiction of the mark (the “Drawing”)
- Description of goods/services used in connection with the mark
- Application filing fee (currently \$325 for electronic filing, per class)
- Basis for filing (use in commerce or intent to use)
- Specimen showing use of the mark (only for use-based applications)

What happens after I file a federal trademark application?

The trademark application is assigned an examining attorney who will review your application approximately 3 months after it is filed. The overall registration process may take up to one year, or longer, depending upon several factors.

General process

- A. Examining Attorney review. The examining attorney will review your application and determine whether federal law permits your registration. The examining attorney will examine the written application, the drawing, and any specimen, to ensure they satisfy all of the federal legal requirements. 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 action.
- B. Publication. If no refusals or additional requirements are identified, or if all identified issues have been resolved, the examining attorney will approve the mark for publication in the Official Gazette (OG), a weekly online publication of the USPTO.
- C. Opposition period. 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 it is held before the Trademark Trial and Appeal Board, a USPTO administrative tribunal.
- D. Allowance/Issuance.
 - (1) After the 30-day window, if you filed a “use-in-commerce” application, the USPTO will generally issue a registration certificate about 11 weeks after publication.
 - (2) If you filed an “intent-to-use” application, you will now be required to submit a Statement of Use showing that you are now using the mark. This must be filed within 6 months of the USPTO requirement (the deadline can be extended for up to 3 years).

Maintaining your Federal Trademark Registration

To maintain your trademark registration, you must file your first maintenance document between the 5th and 6th year after the registration date. After this first maintenance filing, you must renew your trademark registration every 10 years to keep it in force. For each of these filings, you need to pay a renewal fee and submit proof that you continue to use the trademark.

Marking and Proper Trademark Usage

When can I use the “TM” designation?

- You can use the “TM” designation any time you claim rights to use a trademark, regardless of whether you have filed an application with the U.S. Patent and Trademark Office.

When can I use the “®” designation?

- You can only use the “circle R” designation after you have obtained a federal trademark registration.

In order to maintain your trademark rights, the following guidelines can be useful when using your trademark:

- ❖ Always use the mark as an adjective, not as a noun or verb.
 - Example: “BAND-AID® Brand Adhesive Bandages have covered and protected cuts and scrapes for millions of people over 90 years” (example taken from Johnson & Johnson Website)
- ❖ Distinguish the trademark from surrounding text, for example, using bold, italics, colored font, capitalization, or other stylized font.
- ❖ Use the mark in a consistent way (do not change the appearance of the mark).

Additional resources

- USPTO website at www.uspto.gov/trademarks
- Trademark Assistance Center (TAC) TrademarkAssistanceCenter@uspto.gov
- International Trademark Association (INTA) trademark basics www.inta.org/TrademarkBasics/FactSheets

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