

The Trademark Registration Process in the United States

In the United States, trademark rights are “common law” in nature, meaning that some trademark rights are acquired simply by selling goods and services designated by a particular mark in the U.S. However, there are significant benefits to registering trademarks with the U.S. Patent and Trademark Office (PTO). Following is a summary of the benefits of and process for filing for trademark registration in the U.S.

Benefits of Registering Trademarks

A federal trademark registration conveys the following benefits:

- 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 ®;
- Listing in the United States Patent and Trademark Office's online databases;
- The ability to maintain the trademark registration for as long as the mark is in use; and
- The ability for the registration to obtain an “incontestable” status after five years of registration, which significantly restricts the grounds on which others can challenge registration.

Use-Based Federal Registration Process

A trademark application can be filed based on either (1) actual use of the mark in interstate commerce, or (2) a bona fide intention to use the mark in interstate commerce. The application/registration process involves the following steps:

1. Application: The application is prepared and filed along with a drawing of the mark, the PTO filing fee, and specimens showing the mark as actually used in commerce if it is in use.
2. Filing Receipt: The PTO reviews the application to determine that the filing requirements have been met, then assigns it a serial number and sends the Applicant a receipt. For applications filed electronically, a receipt is typically issued within 24 hours.
3. Examination: An Examining Attorney reviews the application to determine whether the mark can be registered. If the Examining Attorney determines that the mark cannot be registered, the Applicant will receive a letter listing the grounds for refusal. The Applicant has six months from the date of the letter to respond to the refusal.

If the Applicant's response does not adequately overcome the objections, the Examining attorney may issue a second refusal. Thereafter, the Applicant can appeal to the Trademark Trial and Appeal Board ("TTAB") of the PTO for final review. Applications can be refused for a number of reasons. For example, the Examining attorney may believe that there is a likelihood of confusion between the Applicant's mark and an existing mark, or the attorney may believe that Applicant's mark is descriptive of a feature of the goods or services.

4. **Notice of Publication:** If the Examining Attorney has no objections to the mark and application, or the Applicant overcomes all objections, the mark is published in the PTO's Official Gazette, a weekly publication. Any party wishing to challenge the published mark on the basis that registration of the mark will be harmful to them, has 30 days to respond to the PTO and file an official opposition to registration. Opposition arguments are heard before the TTAB. If no party files an objection to the mark, the application moves to the final stage of the registration process.
5. **Issuance of Certificate of Registration:** The PTO will register the mark and issue a certificate of registration approximately three months after the conclusion of the opposition period.

Intent to Use Federal Registration Process

For applications based on an intent to use the mark ("ITU") rather than on actual use of the mark, the registration process follows a slightly different path. After steps (1) through (3) above (filing the application, successfully completing a PTO examination, and waiting through the publication period) are completed, the application proceeds as follows:

1. **Notice of Allowance:** The PTO will issue a Notice of Allowance approximately three months after the mark was published in the Official Gazette.
2. **File Statement of Use:** After the PTO issues a Notice of Allowance, the Applicant has six months to either show use of the mark in commerce and submit a Statement of Use, or request an extension of time in which to do so. The PTO will grant a maximum of five (5) six-month extensions for any ITU application. If a Statement of Use is not submitted within the allotted time, the application will become abandoned.
3. **Acceptance and Issuance of Certificate of Registration:** The PTO will inform the Applicant when it has officially approved use of the mark. After the approval, the PTO will issue the registration certificate in approximately eight weeks.

On average, it usually takes between six months and a year for a use-based application to proceed to registration, and about one to two years for an intent-to-use application to proceed to registration.

Trademark Application Fees

The cost to file a trademark application depends on the numbers of "Classes" of goods and services covered by the application. A list of the 45 Classes of goods/services can be found [here](#). The PTO currently charges \$275-\$375 per Class of goods and services covered in an application.

Trademark Clearance

Before filing a trademark application and/or commencing use of a mark, we strongly recommend that clients obtain a trademark search and opinion, confirming that the mark is available for the proposed goods/services, and does not infringe the rights of any third party.

Please contact Sterne Kessler if you would like assistance with clearing and protecting your trademarks.

Maintaining Trademark Rights

Unlike copyrights and patents, trademark rights can last indefinitely, provided that the trademark owner continues to use the mark in commerce as an identifier of the source of goods or services. The term of a federal registration is 10 years, with unlimited renewal terms of 10 years. In addition, the PTO requires trademark owners to file a declaration of use between the 5th and 6th year of the initial registration. Both the renewals and the declaration require evidence that the mark is still in use. If either the renewals or the declaration are not filed in a timely manner, the trademark registration ultimately will be declared expired.

For more information, please visit www.skgf.com/trademark or contact:

Monica Riva Talley, Director
mtalley@skgf.com

Tracy-Gene G. Durkin, Director
tdurkin@skgf.com

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