U.S. TRADEMARK REGISTRATION

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BENEFITS OF FEDERAL REGISTRATION

Owning a federal trademark registration on the Principal Register provides several advantages, including:

- Constructive notice to the public of the registrant's claim of ownership of the mark, Lanham Act § 22 (15 U.S.C. § 1072);
- A legal presumption of the validity of the registered mark, the registrant's ownership of the mark and the registrant's exclusive right to use the mark in commerce nationwide on or in connection with the goods and/or services listed in the registration, Lanham Act §§ 7 and 33(a) (15 U.S.C. §§ 1057 and 1115(a));
- The ability to bring an action concerning the mark in federal court for trademark infringement or counterfeiting, and recover lost profits, damages (possibly even treble damages or heightened statutory damages), attorneys' fees and costs, Lanham Act §§ 32 and 35 (15 U.S.C. §§ 1114 and 1117);
- The right to use the U.S. registration as a basis to obtain registration in foreign countries, Lanham Act § 60, *et seq.* (15 U.S.C. § 1141, *et seq.*);
- The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods, *see* Lanham Act § 42 (15 U.S.C. § 1124);
- Incontestability status of the registration after five years of continuous use, serving as conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce, Lanham Act §§ 15 and 33(b) (15 U.S.C. §§ 1065 and 1115(b)) ; and
- Use of the federal registration symbol "®" to inform others of the mark's registered status, Lanham Act § 29 (15 U.S.C. § 1111).

If a mark is not capable of registration on the Principal Register (e.g. it is merely descriptive of the goods/services or is merely a surname), it may still be registrable on the Supplemental Register as long as the mark is in use and is capable of distinguishing the applicant's goods or services, i.e. not generic. (Lanham Act § 23, 15 U.S.C. § 1091). While not as beneficial to the trademark owner as a registration on the Principal Register, the Supplemental Register does offer certain benefits.

- Allows registration of merely descriptive marks that are capable of identifying a source;
- Registrant may use federal registration symbol;
- Mark is protected under Trademark Act Section 2(d) – Likelihood of confusion;
- Registrant may base a registration in a foreign country on a U.S. registration on the Supplemental Register;
- Registrant may bring a separate count for trademark infringement under Section 32 in federal court;

Unlike registration on the Principal Register, a registration on the Supplemental Register does not provide:

- The presumptions under Sections 7(b) and (c), e.g., validity of ownership, exclusive right to use, and constructive use;
- Incontestability after 5 years of use;
- Posting of trademark registrations with Customs to prevent imports of infringing goods.

STEPS INVOLVED IN THE APPLICATION PROCESS

How to File

An applicant may file via paper, or by means of the TEAS (the Trademark Electronic Application System) on-line filing system. Currently, the fees for trademark applications are as follows:

(1) $275 per class for a TEAS Plus application that meets the requirements of 37 C.F.R. §§ 2.22 and 2.23**;**[1]
(2) $325 per class for an application filed electronically using the Trademark Electronic Application System (TEAS); or
(3) $375 per class for an application filed on paper.

In order to receive a filing date, the applicant must include the following information in the application (see 37 C.F.R. § 2.21(a)):

(1) the name of the applicant;
(2) a name and address for correspondence;
(3) a clear image of the mark;
(4) a listing of the goods or services; and
(5) the filing fee for at least one class of goods or services.

Use-based Applications

The power of the federal government to register marks comes from the commerce clause of the Constitution. Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "commerce" as "all commerce which may lawfully be regulated by Congress." Section 45 defines "use in commerce" as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark."[2] Types of commerce include interstate, territorial, and between the United States and a foreign country.

[1] These requirements include providing an e-mail address for correspondence, complying with all requirements for asserting a basis for filing, correctly classifying and identifying the goods/services using the Office's *Acceptable Identification of Goods and Services Manual*, and agreeing to communicate with the Office electronically.
[2] "Token use," or use made solely to reserve rights in a mark, is not allowed.

In an application based on use in commerce under 15 U.S.C. §1051(a), the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application on or before the filing date of the application. The application must include a verified statement that the mark is in use in commerce.

When asserting use of a mark in commerce, an applicant must specify the following:

- The date of first use anywhere (this maybe the same as or earlier than the first use in commerce date);
- The date of first use in commerce lawfully regulated by Congress; and
- An acceptable specimen showing use of the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.

Intent-to-Use (ITU) Applications

- Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), provides that an applicant may file an application based on a "bona fide intention" to use a mark in commerce.
- If the applicant has not yet commenced use of the mark in commerce, the ITU process affords considerable benefits.

    - Pursuant to Section 7 of the Trademark Act, the filing date of an application on the Principal Register is a constructive date of first use of the mark in commerce, provided the application matures into a registration. Thus, filing affords the applicant nationwide priority over others, with the exception of parties who had used the mark before the applicant's filing date, parties who had filed before the applicant, or parties who are entitled to an earlier priority filing date based upon the filing of a foreign application under Section 44(d) of the Trademark Act.

Other Filing Bases

Section 44 of the Trademark Act, 15 U.S.C. §1126, allows a party to file two types of applications: (1) United States applications relying on foreign applications to secure a priority filing date in the United States under §44(d);[3] and (2) United States applications relying on ownership of foreign registrations as a basis for registration in the United States under §44(e).[4] It is important to keep in mind that while §44(d) provides a basis for filing and a priority filing date, it does not provide a basis for publication or registration.

[3] An application filed in the United States under §44(d) will be treated as if it were filed in the United States on the same date as the filing in the foreign country. However, the applicant must file a claim of priority within six months of the filing date of the first-filed foreign application.

[4] The applicant under Section 44(e) must be the owner of a valid registration in the applicant's country of origin.

Examination of the Application

The initial examination by the USPTO includes (1) a search for conflicting marks; and (2) an examination of the written application, the drawing and any specimen(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid.

During the examination process, if the Examining Attorney finds a problem, i.e. refusal or requirement based on one of the above or any other ground, he/she will take one of the following actions:

- Examiner's Amendment – this will only be issued if there are no substantive refusals and the Examining Attorney has already contacted the applicant or the applicant's attorney who has agreed to the procedural amendment (e.g. disclaimer or ID change). No response is necessary unless there is a discrepancy between the applicant's or attorney's communication on the one hand, and the Examining Attorney's amendment on the other.
- Priority Office Action – this is similar to an Examiner's Amendment, except that no agreement was reached as to the procedural matter(s). A response is due within six months.[5]
- Office Action – when a substantive refusal or complex procedural issues exist, a formal letter is mailed to the applicant. A response is due within six months.
- Suspension Letter – this occurs primarily when a prior pending application is cited by the Examining Attorney, and the mark may potentially cause a likelihood of confusion with applicant's mark if registered. If no other issues exist, the application will be suspended pending abandonment or registration of the prior pending application.
- Final Office Action – after the applicant has responded to an initial Office Action with arguments in favor of registration, if the Examining Attorney maintains the refusal(s) and/or requirement(s) to registration, he/she will issue a Final Office Action. The applicant has six months from the mailing date of the Final Office Action to file a Request for Reconsideration and/or a Notice of Appeal with the TTAB.

The most common substantive refusals are:

- Section 2(d) Likelihood of Confusion Refusal
- Section 2(e)(1) Merely Descriptive Refusal
- Sections 2(e)(2) and 2(e)(3) Geographically Descriptive and Geographically Deceptively Misdescriptive Refusals
- Section 2(e)(4) Surname Refusals

[5] If an applicant responds within two months of the mailing date of the priority action, the examining attorney will expedite examination of the response.

The most common technical requirements are:

- Section 6(a) Disclaimer Requirements
- Amendment to Identification of Goods and/or Services
- Substitute Specimen Requirement

Publication

Once application for registration on the Principal Register has been accepted by the Examining Attorney, it will be approved for publication in the Official Gazette.[6] The thirty-day opposition period commences on the date of publication. If no party files a Notice of Opposition or Request for Extension of Time to Oppose within the thirty-day opposition period, the application will proceed through the registration process as follows.

- An ITU application will receive a Notice of Allowance (usually within 2-3 months after the close of the opposition period).
- A use-based application will proceed to registration within a few months time.

Allowance

Once an ITU application receives a Notice of Allowance, the applicant has six months in which to file a Statement of Use ("SOU") indicating that the mark is in use in commerce, claiming dates of first use, and including a specimen of use. The applicant has three years from the issuance of the Notice of Allowance to file an acceptable SOU. During the initial six-month period after allowance, the applicant must either file the SOU or request an extension to file.[7] An applicant may file a total of five requests for extension of time (in six-month increments). The second and subsequent extensions require a showing of good cause. The showing of good cause must include a statement of the applicant's ongoing efforts to make use of the mark in commerce on or in connection with each of the goods/services covered by the extension request.[8]

After the Office accepts a Statement of Use, the applicant will usually receive a Notice of Acceptance within three to four months. A certificate of registration should normally issue within three months thereafter.

[6] This publication is available to the public, and any party who believes it may be harmed by the issuance of a registration may file an opposition proceeding.

[7] Currently, the fee for filing a Statement of Use is $100 per class of goods and services, and the fee for each extension request is $150 per class.

[8] Efforts to use the mark in commerce may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain required governmental approval, or other similar activities.

PROPER USE OF REGISTRATION SYMBOL

The owner of a mark registered in the United States Patent and Trademark Office should give notice that the mark is registered by displaying with the mark the words "Registered in United States Patent and Trademark Office," the abbreviation "Reg. U.S. Pat. & Tm. Off.," or the letter R enclosed within a circle, i.e. ®. 15 U.S.C. §1111.

The registration symbol should be used only on or in connection with the goods or services that are listed in the registration. Furthermore, the federal registration symbol may not be used with marks that are not actually registered in the United States Patent and Trademark Office (this includes marks that are registered in various states, but not federally). Therefore, before a mark is registered and while an application is pending, its owner should use the superscript TM (for trademarks) or SM (for service marks) with the mark to put the public on notice that it considers the particular word or design a proprietary mark.

POST-REGISTRATION FILINGS

Affidavit of Use

An Affidavit of Use under 15 U.S.C. §1058 ("Section 8") must be filed between the fifth and sixth years of registration. This filing proves that the mark is still being used in commerce. A six-month grace period for filing the Section 8 exists as long as the required fee is paid.[9]

Affidavit of Incontestability

If the mark is registered on the Principal Register, the registrant may also file a Section 15 Affidavit of Incontestability, 15 U.S.C. §1065.[10] The registrant must declare in the affidavit that the mark has been in continuous use in commerce, on or in connection with the goods or services covered by the registration, for a period of five years after the date of registration. Although a Section 15 affidavit is an optional filing, incontestability status provides the registrant with a powerful advantage should it need to bring suit for infringement, namely, conclusive evidence of the validity of the registered mark and its registration, of the registrant's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce.[11]

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[9] Currently, the fee for filing a Section 8 Affidavit is $100 per class, and the fee for filing within the six-month grace period is also $100 per class.

[10] The fee for filing a Section 15 affidavit is currently $200 per class. Since the time for filing a Section 15 usually coincides with the time for filing a Section 8, most registrants file a Combined Affidavit of Use and Incontestability.

[11] Section 14 of the Trademark Act, 15 U.S.C. §1064, limits the grounds that a third party can raise in a petition to cancel a mark registered on the Principal Register when the petition is filed more than five years from the date of registration or publication under §12(c). This limitation of grounds does *not* depend on the filing of a §15 affidavit.

Renewal

Registrations issue for ten-year terms. Within one year before the expiration of the registration, the registrant must file a Renewal application claiming that the mark is still in use for some or all of the goods or services listed in the registration.[12] Otherwise, the registration will expire.

As long as the registrant continues to use the mark in commerce and properly maintains the registration with the requisite filings, the registration can last indefinitely.

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[12] As with the Section 8, a Section 9 Renewal may be filed within the six-month grace period. The filing fee for a renewal application is $400 per class, with a $100 surcharge for filing within the grace period.