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IMPORTANT TRADEMARK INFORMATION

Please read carefully

You have recently asked this law firm to file a federal trademark or service mark application. To ensure that you understand the basic operation of the trademark laws, this fact sheet has been prepared.

CREATION OF TRADEMARK RIGHTS

Trademark rights arise from either 1) use of the mark, or 2) a bona fide intention to use a mark, along with the filing of an application to federally register that mark.

Therefore, before a trademark owner may file an application for a federal registration, the owner must either 1) use the mark on goods which are shipping or sold, or services which are rendered in interstate commerce (or commerce between the U.S. and a foreign country), or 2) have a bona fide intention to use the mark in such commerce in relation to specific goods or services.

THE REGISTRATION PROCESS

When an application has been filed, an Examining Attorney in the Patent and Trademark Office will review the application and decide whether the mark may be registered. An initial determination is issued about 3 months after filing. The applicant must respond to any objections within 6 months or the application will be deemed abandoned.

Once the Examining attorney approves a mark, the mark is published in the Trademark Official Gazette. 30 days are allowed for anyone to object to your registration. If no opposition is filed, the registration will issue about 12 weeks later for marks in use in commerce. For applications based on intent to use, a notice of allowance will issue about 12 weeks after publication. The applicant then has 6 months to either use the mark in commerce or request a 6 month extension of time to file a statement of use.

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BENEFITS OF REGISTRATION

The benefits of federal registration include the following:

- 1) The right to sue in federal court for trademark infringement;
- 2) Recover profits, damages and costs from an infringer, and possibly up to 3x damages and attorney fees;
- 3) Gives others constructive notice of your mark;
- 4) Allows the use of the federal registration, R in a circle, with the mark;
- 5) Deposit copies of the registration with the Customs Service to stop importation of goods bearing an infringing mark;
- 6) Sue for counterfeiting the mark, and to both civil and criminal penalties;
- 7) File corresponding application in many foreign countries.

State registration gives one important additional benefit-it prevents another from registering the same mark with the state.

GROUND FOR REFUSING FEDERAL REGISTRATION

- 1) It is an insignia of a governmental entity
- 2) Without consent, it identifies a living individual or a deceased President during the life of his widow.
- 3) It is confusingly similar to a previously- registered mark, or to a mark previously used in the United States by another and not abandoned
- 4) It is merely descriptive or deceptively misdescriptive of the goods or services, or is primarily a surname, and is not distinctive of such goods or services.

MAINTENANCE OF THE MARK

Remember continued use of the mark is necessary to avoid abandonment of the mark. **Registrations must be renewed every 10 years. Moreover, between the fifth and sixth year after the date of the registration, you must file an affidavit stating the mark is currently in use in commerce.** If no affidavit is filed, the registration will be canceled. It is your responsibility to remember to file the appropriate documents if you want to continue your registration. Please Mark you calendar!