

TRADEMARK BASICS

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.

Trademarks can also be protected under state law.

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 be issued about 12 weeks later for marks in use in commerce. For applications based on intent to use, a notice of allowance will be issued 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.

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 scandalous or disparaging
- 2) It is an insignia of a governmental entity
- 3) Without consent, it identifies a living individual or a deceased President during the life of his widow.
- 4) It is confusingly similar to a previously- registered mark, or to a mark previously used in the United States by another and not abandoned
- 5) 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 cancelled. It is your responsibility to remember to file the appropriate documents if you want to continue your registration.

Any time you claim rights in a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert others of your claim, regardless of whether you have filed an application with the U.S. Patent & Trademark Office (USPTO). However, you may use the federal registration symbol "®" only after the USPTO actually registers a mark, and not while an application is pending. You can only use the registration symbol with the mark in connection with the goods and/or services listed in the federal trademark registration.

A great deal of information about trademarks is available online. The U.S. Patent and Trademark office (<http://www.uspto.gov/>) provides visitors with the ability to search on line for existing marks, and to check the status of your application. You can even

file an application on line using the Trademark Electronic Application System (TEAS) available at <http://www.uspto.gov/teas/index.html>.