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The Trademark Application Process from an Intellectual Property Attorney's Perspective.

Please read this BEFORE you come in for your consultation. You will get quite a bit more from the initial consultation if you educate yourself on this material.

Our prices and options. We file trademark applications with two possible pricing places. First, under the "Start to Finish" program, we will prepare and file a trademark application, handle all filing receipts, Office Actions, and other USPTO correspondence for a flat fee, which will take you from filing the application to have an application allowed and delivered to you, or to a Final Rejection. Second, we can prepare and file the application for a lower initial flat fee, and will charge a combination of flat fees and hourly billing for various responses.

What can be trademarked? To quote from the USPTO webpage: "A **trademark** is a word, phrase, symbol, and/or design that identifies and distinguishes the source of the goods of one party from those of others. A **service mark** is a word, phrase, symbol, and/or design that identifies and distinguishes the source of a service rather than goods. The term "trademark" is often used to refer to both trademarks and service marks." The most common trademarks are on the name of a company ("Xerox", "Nike", "Microsoft"), a product ("Big Mac", "iPod"), a slogan ("Over 99 Billion served", or a symbol (the Apple Computer logo, the Golden Arches of McDonalds, the Nike "swoosh"). Other, more unusual trademarks have included certain colors, scents and fragrances.

Do you have to register a trademark? No, but it is great defense as it gives public notice of your claim to the trademark, a legal presumption that you own the trademark across the US, and the exclusive right to that trademark on the goods or services found on your registration. A trademark, like the rest of intellectual property, is the opposite of life insurance. With life insurance you are betting on yourself to die; with intellectual property, you are betting on yourself to succeed in business.

What makes for a strong trademark? Will you pick a name that is likely to result in a strong, inexpensive trademark or would you prefer to spend a ton of money on an application that will result in a weak (if any) trademark? The best names to trademark are "fanciful", that is, they have no relation to the goods or services being sold. For example, a "Kodak" had no relationship to cameras or film before the Kodak Company began using. Same for "Reebok" and "Nike" for shoes. Arbitrary names are another good choice; an arbitrary name is a common, known word used to describe goods or services that are not commonly associated with that name. Two good examples of arbitrary trademarks are "Apple" for computers and "Puma" for shoes. Fanciful and arbitrary marks are often inexpensive to trademark (so long as no one else has trademarked it in your category or a similar category), and result in strong trademarks.

Moving down the spectrum from “cheap and strong” to “expensive and weak” are suggestive marks. A suggestive mark does not exactly describe the characteristic of the goods or services, but, with a little imagination on the part of the consumer, clearly understands what the mark implies. “Greyhound” as the name of a bus company implies fast buses, “Citibank” implies financial services in a city, and “FedEx” implies express mail services across the federation of states.

Below suggestive marks, the client is usually looking at expensive costs and the strong likelihood that he/she will get either no trademark, or a very weak trademark. The two main types of trademark applications that fall into this category are Descriptive and Generic names. Descriptive marks merely describe the good or services and usually end up on the Supplemental Register. A descriptive name might be Trusty Bank for a bank, or Strong Skis for a brand of skis. Generic names merely describe a category of goods, and cannot be registered. Examples of generic names might be “Carlsbad Bank” for a bank located in Carlsbad, or “Snow Skis” for a brand of snow skis.

Trademark Search? We recommend that a trademark search be performed prior to filing. Knowing what other trademarks are out there prior to filing is a good way to determine your strategy in trademarking your business identity. You can try it yourself, or hire an outside company to do it (we generally do trademark searches for $575/class of goods/name).

“In use” or “intend to use”? There are two ways a trademark application can be filed: in use (where you are already using the name on the goods or services in commerce) and intent to use (where you are not already using the name in commerce). Which way should you go? First of all, be honest. If you are not using the name in commerce, better to file under intended use, then convert to “in use” once you start using the name in commerce. If you are already using the name in commerce, file under “in use”. This is something that an attorney can help guide you through.

When to file for Trademark protection. When should you be thinking about trademarking a name? This should be one of your initial considerations when starting a company or starting to work on an invention. The safest approach is to have a trademark search done and if it appears that there is a reasonable chance you can trademark the name, file under “intent to use” before you start making any products or providing any services under that name. This way, if you wait a few months (usually less than 6 months), the USPTO will give you an indication of whether it will approve the mark before you use it in commerce, then you just have to survive the opposition period (described in more detail below) to receive a registered trademark. This way, if you remain “intend to use” and wait to receive the trademark before using the mark in commerce, you minimize your chances of being sued for trademark infringement.

The trademark application process. Once the trademark application is filed, it usually is examined 4 or 5 months later. The application is then either allowed or initially rejected. If it is allowed, it has to pass through the Opposition Period, which is a 30-day

period of official publication during which any person or company who feels that the issuance of your application will damage their business can file an "opposition". Defending an opposition can be expensive, but in our experience this rarely happens. Assuming that your application is not opposed, if you filed "in use" the next step is the USPTO printing your trademark registration and mailing it out. If you filed "intend to use", the next step is that you have 6 months to file a statement of use which says that you are officially using the mark in commerce, at which point the USPTO will print your registration and mail it out. If you are not using the mark in commerce before 6 months expires, you can pay USPTO to "extend" the time period during which you can file the statement of use, but we do not recommend this.

Additional Charges after the Initial Filing (Applicable only to client who select the "Step by Step" approach as opposed to the "Start to Finish" approach. Once the USPTO receives a trademark application, there are several communications regarding their initial review of an application and the designation of a serial number, and then some basic search information. Our basic flat fees for handling these matters are described above. Please note that it is important that we review these initial notifications from the USPTO. We will review the incoming correspondence, notify you, and respond if needed. This firm's time in reviewing, notifying you, and acting upon these notifications will be charged to you on flat fee basis of $150/email or letter from the Trademark Office. Should your trademark be "allowed" as is, these review fees will be very low – usually $300 at the most. In any event, you should anticipate additional costs after the initial filing of your trademark application, even if there are no problems with your application

Responding to Office Actions. If a trademark application is rejected, it is usually over a risk of "consumer confusion"; the examiner is saying that allowing your trademark to coexist with the one (or ones) cited in the Office Action would pose an unreasonable risk of confusing consumers as to whose goods or services they were buying. Responding to an Office Action can take anywhere from one hour to several hours, depending on the complexity of the rejection and the closeness of the other trademarks cited.

It is important to note that the initial preparation and filing fee DOES NOT cover responses to Office Actions, as we cannot estimate in advance how much this will cost. Normally we argue against a trademark rejection by picking which of the "DuPont factors" favor our position. Of the DuPont factors, normally Factor 1 is the most important. The similarity between the name we are trying to protect and the cited trademarks in terms of their visual appearance, sound, number or words, number of syllables, and general overall connotation are all important factors.

Moving beyond Factor 1, we usually find that the channels of trade are often the second most important factor, with impulse purchase and any actual confusion also usually fitting into our responses.

Once the response is sent, the examiner sometimes grants the application; sometimes there is another rejection which necessitates another response. If there is a Final Rejection issued, we can appeal the rejection, but this can become costly.

Maintenance Fees. Once a trademark is issued, there are periodic Maintenance Fees due. The first fee is due between the 5th and 6th year after the trademark issues. There are two "renewal" options. First, you can do a simple renewal, which costs, including our fees, a few hundred dollars. Second, you can renewal and request a "Declaration of Incontestability", which makes your trademark much less open to later challenges by your competition and any other party who files a Petition to Cancel. This second option runs around $500 more than a simple renewal, mostly due to the extra USPTO fees required.

Renewal Options. In terms of docketing and paying the maintenance fees, there are two options. First, you can take over the trademark yourself, and remember to pay the fees and pay them yourself. Second, you can pay us to docket the case, remind you of maintenance fees, and pay the fees for you. Either way is fine with us, but you need to let us know whether you want us to keep the case and either put down a retainer or agree to pay by credit card for our fees. If you retain us to handle the maintenance fees, it is also your responsibility to keep us notified of any change of address or email. If we are not able to reach you, we cannot file any renewals on your behalf. Unless we state in writing that we are taking over responsibility for docketing and reminding you of upcoming maintenance fees, it is your responsibility.

Foreign Trademarks. A trademark only protects your mark in the country in which the trademark is granted, so if you want protection on the name outside of the US, you need to file for trademark protection outside of the US. Filing for trademark protection in foreign countries can get expensive depending on the desired country(ies). When we do foreign filing, we usually use the Madrid Protocol system. If you are interested in foreign filing, we will send you a foreign filing estimate upon request.