

The Five Phases of the Trademark Registration Process

Phase 1 - Trademark Selection and Search

This phase often requires the most work. A strong trademark is unique, distinct, and consumers understand that goods or services provided under that mark have a consistent quality. Not every name can be a trademark. There are exceptions, but generally trademark law prohibits registering generic and highly descriptive terms, and words that are recognized as last names. Generic terms can never be registered as trademarks. Last names can only be registered by proving that they have acquired a recognized “secondary meaning” as a trademark.

Likewise, marks that simply describe the product, a feature of the product, or the geographic place where it comes can only be registered as trademarks if you can prove they have achieved trademark status. An example is Rugs-Direct.com. <http://www.rugs-direct.com/> The Trademark Office initially refused the application saying the mark is too descriptive, but we were

able to prove the term had acquired a “secondary meaning” and the public recognized it as a trademark.

Sometimes a fanciful logo can be registered even if the words used in the logo are not registerable. One strategy to try to build protection for a highly descriptive name is to first register a logo, then after five years apply to register the words alone.

Assuming the mark meets these minimum criteria, the next step is to conduct a search to see if there are conflicting applications or registrations. The U.S. Patent and Trademark Office website provides the ability to search its database for free:

http://www.uspto.gov/ebc/index_tm.html. If the proposed mark survives this

search, then in most cases I recommend using a search company to get a comprehensive search of both registered and unregistered uses. No search is bullet proof, but it’s usually best to find out about similar marks as early as possible.

Phase 2 – Drafting and Filing the Trademark Application

To draft the application we need to identify: 1) the owner of the mark; 2) whether the mark is presently in use (a “use based” application) or if there is just an intent to use the mark in the future (an “intent to use” application); 3) the goods/services provided in connection with the mark; 4) the Trademark Office classifications for those goods/services; 5) for use based applications we also need to know the date the mark was first used locally, and in interstate commerce; and 6) for use based applications we need samples of use showing how the mark is currently being used.

With this information I will draft the application and send it to the Applicant to be reviewed and signed. When the signed application is returned to me along with the required filing fees and samples of use I file it electronically on the Trademark Office’s website.



The Five Phases of the Trademark Registration Process

Phase 3 - Response

Most applications elicit some type of response from the Trademark Office Examining Attorney. Sometimes they only cite procedural requirements (like changing the way the goods are described), and sometimes they reject an application for substantive reasons (for example the term is too descriptive, is understood to be a last name, or is too close to an existing registration or application.) The applicant has six months to respond to an Office Action. Sometimes the matter is resolved in a phone call or in one written exchange; sometimes the Examining Attorney refuses to budge and the only alternative is to appeal. Appeals are only taken after careful consideration. They are expensive, and the Trademark Trial and Appeal Board upholds about 80% of decisions that are appealed.

Phase 4 - Publication

If the application is approved by the Examining Attorney, it is then published for a thirty day public comment period. The public can either file a Notice of Opposition, which is a fancy name for a lawsuit filed with the Trademark Trial and Appeal Board claiming the application should be denied, or a request for more time to file the lawsuit. The Trademark Trial and Appeal Board follows essentially the same rules and procedures as Federal courts.

If no public comments are filed then use-based applications are sent to the printing office and the Trademark Office will issue a registration certificate about 3 or 4 months after the public comment period ended. For intent-to-use applications the Trademark Office issues a Notice of Allowance.

Phase 5 – Proof of Use for Intent-to-Use Applications

For intent-to-use applications the Notice of Allowance date is critical. The applicant must file proof that it is using the same mark listed in the application in interstate commerce in connection with the goods/services listed in the application before the Trademark Office will issue a registration certificate. The applicant must file this proof within 3 years of the Notice of Allowance date, BUT there are deadlines every 6 months when the applicant has to pay a filing fee and either file proof that the mark is being used, or request an additional six month extension.

Ian D. Titley
804-364-0405
idt@schroderfidlow.com
www.schroderfidlow.com
1901 E. Franklin St. #107
Richmond, VA 23223

