

THE BENEFITS OF TRADEMARK REGISTRATION

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1. THE BENEFITS OF A TRADEMARK

Trademarks may be registered for either goods or services with both the United States Patent & Trademark Office (<http://www.uspto.gov/>), as well as, each individual state. The benefits of federal trademark registration are as follows:

- a. The right to sue in federal court for trademark infringement;
- b. Recover profits, damages and costs from an infringer, and possibly up to 3x damages and attorney fees;
- c. Gives others constructive notice of your mark;
- d. To stop importation of goods bearing an infringing mark through notice to the Customs;
- e. Right to sue for counterfeiting the mark, and for both civil and criminal penalties;
- f. State registration gives an additional benefit-because it prevents another from registering the same mark with the state.

2. TRADEMARK RIGHTS

Trademark rights arise from either:

- a. Actual use of the mark in commerce, or
- b. A bona fide intention to use a mark in commerce in relation to specific goods or services, along with the filing of an application to federally register that mark.

3. THE REGISTRATION PROCESS

After an online application has been filed (Trademark Electronic Application System (TEAS) available at <http://www.uspto.gov/teas/index.html>) 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. Usually, the examining attorney will issue an action letter informing the applicant that the application has been reviewed and detailing any required actions or requests for response. The applicant must respond to any objections within 6 months or the application will be abandoned.

Once the Examining attorney approves a mark, the USPTO issues a notice of publication. The mark is then published in the Trademark Official Gazette. 30 days are allowed for anyone to object to the registration of the mark. If no opposition is timely filed with the USPTO, the mark will be registered issued about 3 months later. If the mark is 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.

4. **GROUND FOR REFUSING FEDERAL REGISTRATION**

The USPTO may reject registration of any mark for the following reasons:

- a. It is scandalous or disparaging
- b. It is an insignia of a governmental entity
- c. It identifies a living individual or a deceased President during the life of his widow.
- d. It is confusingly similar to an already registered mark, or to a mark previously used in the United States by another and not abandoned
- e. 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.

5. **THE MARK IS NOT REGISTERED FOREVER**

After Registration, it is necessary to continue to use the mark to avoid de facto abandonment of the mark. Registration of the mark must be renewed every 10 years. Between the fifth and sixth year after the date of the registration, the mark holder 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 up to the mark holder to file the appropriate declaration to continue registration of the mark.

6. **PUTTING THE PUBLIC ON NOTICE OF MARK RIGHTS**

Before actual registration, or while the application is pending with the USPTO, a mark

holder may claim rights in the mark by placing a "TM" (trademark) or "SM" (service mark) designation obviously placed near the mark to indicate to all others that there is a claim of registration and that the mark holder has rights to the mark.

After the mark holder receives actual registration of the mark, he/she/it should use the federal registration symbol "®" indicating that the mark is registered. You can only use the registration symbol with the mark in connection with the goods and/or services listed in the federal trademark registration.

The information provided herein is not intended as legal advice and should not be acted upon. If you have additional questions about this subject matter or would like to consult with an attorney about Trademark issues, please call Jennifer J. Hagan or James Hagan at the Hagan Law Firm (650) 322-8498.

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