

TRADEMARKS

This document is intended to provide an overview of the basics of trademark registration, the steps required to register your trademark, and post-registration requirements. When available, a link to the pertinent section of the United States Patent and Trademark Office website is included. The homepage of the Trademark section of the Office is <http://www.uspto.gov/trademarks/index.jsp>.

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Trademark Basics: <http://www.uspto.gov/trademarks/basics/index.jsp>

Helpful Video: <http://www.youtube.com/watch?v=o4zwq6MEaKw&feature=relmfu>

A trademark is a word, name, symbol or device used by someone to identify their goods and distinguish them from others.

- Service marks are the same as trademarks, except they identify and distinguish a business's services rather than its products.

Getting Started:

Before starting the application process, it is important to have clearly in mind

- (1) the mark you want to register;
- (2) the goods and/or services in connection with which you wish to register the mark; and
- (3) whether you will be filing the application based on actual existing use of the mark or a bona fide intention to use the mark in the future.

Choosing Your Mark:

1. Marks must be distinctive.
 - The marks with the highest level of distinctiveness are those marks deemed *inherently* distinctive. These marks can be arbitrary, fanciful, and/or suggestive. Examples:

- Arbitrary: Blue Diamond Almonds. (Blue Diamonds have no relation to nuts).
 - Fanciful: Exxon, Google. (These marks have no meaning outside the goods or services they are associated with). Fanciful marks can provide the strongest level of protection.
 - Suggestive: Greyhound, Coppertone. (These marks *indirectly* describe the goods or service).
- Marks that are classified as descriptive marks are not protectable unless there is a showing of *secondary meaning*. This can be an expensive hurdle to overcome and therefore these marks should be avoided if possible. Examples:
 - Marks that describe the product or service. “Spicy Chicken Wings”, “Fast Tax Preparation”.
 - Marks that describe the geographic location from which the goods or services emanate. “San Antonio Computer Repair”, “Texas Lawn Care”.
 - Marks that are primarily a person’s surname. “Smith’s bathroom remodeling”.
2. Marks can be a variety of things.
- Marks can be a word, name, symbol, device, or any combination thereof.
 - Marks can also include “trade dress”, as long as it is not a function product or product packaging feature. This is to prevent attempted circumvention of the limits on patents terms by calling functional features trade dress.
3. Representation of your mark. <http://www.uspto.gov/trademarks/basics/mark.jsp>
- Standard Character format for word(s), letter(s), number(s) or any combination. (This provides the most protection because it is not dependent on any design elements, colors, fonts, etc.)
 - Stylized/Design format is used if you want to protect words with a specific design element, and or letter with a particular stylized appearance. You cannot try and register both a standard format and stylized/design as one mark.

Helpful Video: <http://www.youtube.com/watch?v=b8wJ4gVa2yk&feature=relmfu>

Searching Trademarks: <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4005:1e01te.1.1>

Helpful Video: <http://www.youtube.com/watch?v=8iUR5p6q8X0&feature=youtu.be>

Registering a Trademark: <http://www.uspto.gov/trademarks/teas/index.jsp>

A Trademark application must include the name of the applicant (“owner”), a name and address for correspondence, a depiction of the mark (known as the “drawing”), a listing of the goods and services associated with the mark, proper filing fees.

See: <http://www.uspto.gov/trademarks/process/appcontent.jsp>

Ownership:

The owner of the mark is not necessarily the person filling out the application. If the mark owned by a legal entity (LLC, corporation, partnership), then the name of the entity must be used as the owner of the mark.

Helpful Video: <http://www.youtube.com/watch?v=iB8YonpIRjU&feature=relmfu>

Identifying Your Goods and Services:

Identification of Goods and Services Manual (ID Manual):

<http://tess2.uspto.gov/netahtml/tidm.html>

Helpful Video: <http://www.youtube.com/watch?v=zGUPZkE56wk&feature=relmfu>

Goods = Products

Services = Activities

Basis:

Under the basis for filing of either "use in commerce" or "intent to use," prior to registration you must demonstrate that you have **used the mark in commerce**. The types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country. The basic difference between these two filing bases is whether you have started to use the mark on **all the goods/services identified in your application**.

<http://www.uspto.gov/trademarks/basics/Basis.jsp>

Helpful Video: http://www.youtube.com/watch?v=N75TCZeuq_A&feature=relmfu

Section 1

- **1(a)** Use in Commerce: If you have already used your mark in commerce, you may file under the "use in commerce" basis.
- **1(b)** Intent to use in Commerce: If you have not yet used your mark, but intend to use it in the future, you must file under the "intent to use" basis. This means you have a bona fide intent to use the mark in commerce; that is, you have more than just an idea but are less than market ready (for example, having a business plan, creating sample products, or performing other initial business activities). An "intent to use" basis requires filing an additional form and fee prior to registration that are not required if you file under "use in commerce" at the outset.

Specimen:

- Goods: Must show how the mark is used on the good. (label, logo on the good, etc...)
- Services: Can use advertising and marketing materials.

Helpful Video: <http://www.youtube.com/watch?v=-ZCOEE9gKr8&feature=relmfu>

After you file:

<http://www.uspto.gov/trademarks/process/index.jsp>

Helpful Video: <http://www.youtube.com/watch?v=2SP9QPsQV7Y&feature=relmfu>

- Office Actions: This is a response to your application from a Trademark Office Examining Attorney. It is imperative that:
 - (1) The Trademark Office has a current address to send correspondence to the person requesting registration.
 - (2) **All Office Actions are answered by the deadline included in the office action!**
- Statement of Use: The Applicant has six (6) months from the mailing date of the notice of allowance in which to either file a statement of use or file an extension request. If the applicant does not file a statement of use or extension request within six (6) months from the date the notice of allowance issued, the application is abandoned (no longer pending/under consideration for approval). To continue the application process, the applicant must file a petition to revive the application within two (2) months of the abandonment date.
- Follow your application online.

Post-Registration:

Helpful Video: <http://www.youtube.com/watch?v=JUMZOrpOIM4&feature=relmfu>

Keep your registration alive by sending in the proper forms and paying the proper fees.

See: <http://www.uspto.gov/trademarks/process/maintain/prfaq.jsp>

Other Resources:

- Trademark Examination Guides:
http://www.uspto.gov/trademarks/resources/Trademark_Exam_Guides.jsp