

U.S. Legal Forms, Inc.

Multi-state

Patent and Trademark Law Handbook

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A general guide to the laws governing the granting and protection of patents and trademarks in the United States.

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INTRODUCTION

Businesses and individuals undertaking commercial endeavors create and deal with intellectual property rights such as patents and trademarks. For persons and entities engaged in trade, obtaining, maintaining and protecting property rights such as patents and trademarks can give a competitive edge in the market place. Patents grant the holder the exclusive right to an invention such as a mechanical process, composition or design. Trademark rights grant the owner the exclusive right to a company name, logo, package or design. Often patents and trademarks are an integral part of an ongoing business. Too often, unfortunately, they are confused. This handbook explains what patents and trademarks are, details how to apply for and obtain each and how to protect the exclusive national rights granted under each. The handbook explains trademarks and patents separately so as to minimize any confusion between the two.

This is a general handbook, containing guidelines that are applicable in the United States in a similar form to that presented here. You should not however rely on this handbook to make legal decisions, but rather to alert you to the fact that there may be an issue or opportunity, and to give you a starting place from which to discuss your problem with a local expert. **THIS HANDBOOK IS NOT A LEGAL DOCUMENT**, and is not intended as a substitute for seeking legal advice from an attorney or other qualified professional.

Of note is that most states have trademark laws that apply only at the state level and supplement the federal laws outlined in this handbook. Most states have codified law and state court case law. As the state laws differ from state to state and comprise a separate body of law onto themselves, this handbook does not address state law.

We hope this handbook raises your awareness of patent and trademark law as well as rights; and that you find it useful and informative. We begin each section with an explanation of the property right granted and a summary of the types of marks and patents. We then proceed to cover patents and trademarks from beginning to end, including how to apply, the application examination process and protecting the patent/trademark.

OVERVIEW

Federal patent and trademark law consists of federal statutes, federal rules and regulations as well as federal court case law. These laws govern the registration and protection of patents (generally novel inventions, designs and processes) and trademarks (generally names, phrases and logos) at the national level. These laws are supplemented by international laws and conventions that regulate the registration and protection of patents and trademarks between countries and internationally. The United States Patent and Trademark Office (USPTO) is the office that determines whether a logo or name can be registered federally as a trademark and whether a patent can issue for a particular invention.

I. Patents

The granting and protecting of patents is governed specifically by codified federal law, the American Inventors Protection Act of 1999 (AIPA), federal rules and federal court case law. Patents may be obtained for novel and unique products, processes, and functional designs that a business or individual invents. By obtaining a federal patent the holder of the patent obtains a property right that enables him/her to exclude other parties from “making, using, offering for sale, or selling” the invention in the United States or “importing” the invention into the United States.” (See 35 U.S.C. §154). Of note is that the grant of a patent does not entitle the inventor to make, use, offer for sale, or sell, or import the invention “if doing so would violate any law or would infringe the prior rights of others.”

A. Length of Patent

As a general rule, the length of time the patent lasts (referred to as the term of the patent) is 20 years from the date on which the application for the patent was filed in the United States. (See 35 U.S.C. §§154(a), 155 & 156). An exception to this rule is a design patent which lasts for 14 years. (See 35 U.S.C. §173). Of note is that the patent term can be extended or adjusted for delays in the application process (termed prosecution). (See 35 U.S.C. §154(b)). In addition, patent holders can under certain conditions receive patent term extensions (PTE) for utility and plant patents that were filed between 6/8/1995 and 5/28/ 2000. (See 37 C.F.R §1.701). Finally patent holders can, under certain conditions, receive patent term adjustments (PTA) for utility and plant patents that were filed after 5/29/2000. (See 37 C.F.R §§1.702 – 1.705) and (See 35 U.S.C. §154(b)).

Of note is that maintenance fees must be paid to the United States Patent and Trademark Office (USPTO) in order for the term of the patent to last twenty years. Again, the exception to this general rule is a design patent which does not require maintenance fees. Maintenance fees are due at 3 1/2, 7 1/2 and 11 1/2 years from the date the patent is granted. The maintenance fee must be paid at these times if the patent is to be maintained. There is a six month grace period after the due date, during which the patentee will have to pay a surcharge in addition to the maintenance fee. (See 37 C.F.R. §1.362). Failure to pay the current maintenance fee on time may result in expiration of the patent.

B. Types of Patents

There are three types of patents that can be granted.

- Utility Patents are granted to any person who invents or discovers any “new and useful process, machine, manufacture, or compositions of matter, or any new and useful improvement thereof.” (See 35 U.S.C. §102). "Process" refers to technical processes. The term "manufacture" refers to all manufactured articles and the term "Composition of matter" refers to chemical compositions. (See Ibid).
- Design Patents are granted for new, original, and ornamental designs for an article of manufacture. (See 35 U.S.C. §171). Of note is that the design patent protects only the appearance of an article, but not its structural or functional features.
- Plant Patents are issued for the “discovery and asexual reproduction of a distinct and new

variety of plants.” This includes “cultivated sports, mutants, hybrids, and newly found seedlings other than a tuber-propagated plant and a plant found in an uncultivated state.” (See 35 U.S.C. §161).

C. Baseline Requirements for Obtaining a Patent

The applicant for a patent must be the inventor or the inventor’s legal representative (such as a guardian, heir, estate administrator or executor, or lawyer). When an invention is made by two or more persons jointly, they must apply jointly for the patent. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent. If a joint inventor refuses to join in an application for a patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. (See 35 U.S.C. §§116-118). It is important to knowingly designate the true inventor(s) for any willful deception in naming the inventors can lead to an invalidation of any subsequent patent that issues. If the wrong individual is unknowingly listed as the inventor or one of the inventors, the USPTO will permit an amendment of the application to correct the error. (See 35 U.S.C. §116). The inventor does not need to be a United States Citizen to apply for a U.S. Patent.

In order for the USPTO to grant a patent, the invention must meet the following requirements:

- Novel and Non-Obvious. In order for an invention to be patentable it must be novel (i.e. new) and non-obvious. Under federal law, the USPTO will reject a patent as not being novel if “(a) the invention was known or used previously by others in this country, or previously patented or described in a printed publication in this or a foreign country,” or “(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States.” (See 35 U.S.C. §102). This means that even if the inventor published his patent himself in a foreign or U.S. publication, he must apply for a U.S. patent within one year of that publication or his application will be denied as not being novel. The non-obvious requirement means that “a patent may not be obtained even though the invention is not identically disclosed or described in another publication, if the differences between the subject matter sought to be patented and the published patent are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the field of science or “art” that relates to the patent.” (See 35 U.S.C. §103).
- Useful. Under federal patent law, in order to be patentable, the invention must be useful in the sense of purpose as well as in the sense of mechanical functionality. Of note is that pursuant to the Atomic Energy Act of 1954, if the invention is only useful in the “utilization of special nuclear material or atomic energy for atomic weapons“ then a patent will not issue.

Since patents will only be granted to novel, non-obvious and useful inventions that have not been published before, it is better practice for the applicant to conduct a search of patents

before completing an application. While patent attorneys and agents will conduct such a search, applicants can conduct their own searched at the USPTO website, by going to the Patent Search Room in Virginia or by going to a Patent and Trademark Depository Library (PTDL). The USPTO's Official Gazette as well as website has a listing of PTDLs in each state.

D. Applying for a Patent.

An application for a patent must include, at a minimum, the following elements:

- (1) Specification: The specification contains “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” In addition the specification must “set forth the best mode contemplated by the inventor of carrying out his invention” and “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” (See 35 U.S.C. §111). The Specification is the most important part of the application as it contains the claims that will determine the scope of the exclusive rights granted under the patent. The detailed requirements for a properly structured specification can be found in the Code of Federal Rules (See 37 C.F.R. §§1.71-1.77).
- (2) Oath or declaration. Each application must contain an oath or declaration which is a notarized statement to be signed by the inventor or someone acting on his/her behalf. The oath must state: that the applicant believes he/she is the “original and first inventor of the process, machine, manufacture, or composition” for which a patent is being solicited; and state the applicant's country of citizenship. (See 35 U.S.C. §115).
- (3) Drawings.. Applications are to include a drawing if and when necessary. Generally, a drawing should be included if it assists in understanding the subject matter of the invention and the claims that the applicant wants to patent. (See 35 U.S.C. §112). Of note is that the drawings must be very precise and meet the exact requirements for drawings set forth in the USPTO rules and regulations. (See 37 C.F.R. § 1.81 to 1.85).
- (4) Model/specimens. Dependent on the nature of the invention, the USPTO may require that the applicant provide a physical model that exhibit's the several parts of his/her invention. (See 35 U.S.C. §114). When the invention relates to a composition of matter, the USPTO may require the applicant to furnish specimens or ingredients to the USPTO as part of the application process. (See Ibid).
- (5) Filing Fee. Generally, the filing fee for a utility patent is \$300.00, for a plant patent is \$200.00 and the fee for a design patent is \$200.00. For each dependent claim beyond three that is filed or later presented the USPTO charges a fee of \$84.00 per claim. For the filing or later presentation of any claim (dependent or independent) in excess of 20, the USPTO charges an additional \$50.00 fee per claim. (See 37 C.F.R. §1.16). Keep in mind that there are additional fees and surcharges that apply in some circumstances, that most fees are reduced by 50% for small entities and that the amount of fees changes regularly. As a result, the applicant should always contact the USPTO or go to its website to

confirm current filing fee categories and amounts.

If an application does not contain all of the elements listed above, the USPTO will deem the application incomplete or defective. The USPTO will tell the applicant what elements are missing from the application. For the payment of an additional surcharge the applicant can submit those elements needed to complete the application.

E. Examination of the Application

Once a complete application is received by the USPTO, the application will be assigned a filing date and will be assigned to an examiner.

If upon examination of the application, the examiner rejects any claim for a patent or has an objection/requirement, the examiner will notify the applicant of his/her decision stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful to the applicant in judging the propriety of continuing the prosecution of his application (this is termed an Office Action). (See 35 U.S.C. §132). Applicants have from 30 days to six (6) months to reply (the Office Action will specify the time period within which a reply is required). If the applicant does not respond within the specified time limit, the USPTO will consider the application abandoned. (See 35 U.S.C. §133). If the applicant replies to the office action with a decision to persist in his/her claim for a patent, with or without amendment, the application will be reexamined by the examiner. The applicant can amend the application to modify or eliminate claims in response to the Office Action or as required by the examiner. In amending an application in reply to a rejection, the applicant must follow the rules and regulations of the USPTO as they apply to amendments. Details on how to amend applications can be found at 37 C.F.R. §§1.114 to 1.126. Of note, is that the response to the Office Action is not permitted to introduce new matter into the disclosure of the invention. (See 35 U.S.C. §132).

The usual period for reply to an Office action is three months. A shortened time for reply may be extended up to the maximum six-month period. Applicants can extend the period of time within which to reply to an Office Action by filing a petition for an extension of time accompanied by a fee. For procedures on how to file an extension of time request and the requisite fee see 37 C.F.R. §§1.136, 1.137.

Of note is that as a general rule all applications for patents are kept confidential and no information concerning the patent application or invention will be disseminated without the permission of the applicant until 18 months after the date on which the patent application was filed. After 18 months the application is published in its entirety by the USPTO. (See 35 U.S.C. §122). Under certain circumstances and upon the request of the inventor if certain assurances are given the USPTO will not publish a patent application. For more detail on these specific circumstances, refer to 35 U.S.C. §122.

F. Final Rejection or Final Grant of Patents

If the examiner concludes that the invention applied for is not patentable, he or she will send the applicant a final rejection. The applicant may appeal the examiner's final rejection decision to the Board of Patent Appeals and Interferences if it is the second rejection decision

and the applicant has paid an appeal fee. (See 35 U.S.C. §134). Likewise, if the applicant disagrees with the examiner's continued rejection of certain claims contained in the application, the applicant can appeal this decision to the Board of Patent Appeals and Interferences.

Upon an examination of the application and a search conducted for prior patents/art, if the examining attorney determines that the applicant is entitled to a patent under the law, the USPTO will give or mail a written notice of allowance of the application to the applicant. The notice will indicate the amount of the issue fee the applicant must pay within three (3) months of receiving the notice of allowance. Upon payment of the issue fee the patent will issue. If the issue fee is not paid on time the application will be regarded as abandoned by the applicant. (See 35 U.S.C. §151). On the day the patent issues, the USPTO will mail to the applicant the patent grant and open the patent file to the public. The effective date for a granted patent is the date on which a "completed" application was received by the USPTO.

G. Protecting Your Invention/Discovery

Once a patent is issued, the USPTO will have no jurisdiction over infringement actions, enforcement actions. As a result, the patentee must file private claims in federal court to enforce his/her rights.

- **Infringement Action:** Infringement of a patent occurs when a third party, without the permission of the patent holder, makes, uses, offers for sale, or sells any patented invention within the United States or U.S. Territories, or imports into the United States of any patented invention during the term of the patent. (See 35 U.S.C. §271). Additional acts such as importing the components of a patented machine into the country infringe the patentee's rights and are detailed in the federal statute at 35 U.S.C. §271 and §272. If a patent is infringed, the patentee may sue for relief in federal district court. If infringement is proven, the court may award the patentee 1) an injunction to discontinue the infringing acts, 2) damages or other monetary relief if there has been commercial manufacture, use, or sale of infringing products/processes, and 3) attorney fees. (See 35 U.S.C. §271). Of note is that the amount of damages awarded is intended to compensate the patentee for the infringement and in no event will be less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs. Under certain circumstances, the court can triple the amount of damages awarded. (See 35 U.S.C. §284). Of note is that if the U.S. Government infringes a patent, the patent holder can sue the government agency or employee in federal court and recover the same relief (i.e., damages, interest, costs, and attorney fees). (See 35 U.S.C. §296).
- **Reasonable Royalty:** While a person is waiting for their patent to issue, they are still entitled to and can enforce their exclusive right to use their invention as long as the invention has been published by the PTO. Between publication and issuance of the patent the applicant can demand and receive reasonable royalties from any person or entity that makes, uses, offers for sale, or sells in the United States or imports into the United States products made by the patented process; provided the person infringing the patent had actual notice of the patent. (See 35 U.S.C. §154(d)).

H. Other Considerations

- Assigning/Transferring Ownership of Patents. A patent and the exclusive rights granted by the patent can be conveyed, in whole or in part, to a third party. (See 35 U.S.C. §261). By conveyance, the federal law permit's the patent holder to sell, mortgage, assign under condition or assign for a temporary period of time his/her right in and to the patent. Of note is that assignments must be recorded with the USPTO within three months of the assignment, conveyance or mortgage. (See 35 U.S.C. §261).
- Joint Ownership. "In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners." (See 35 U.S.C. §262). Joint ownership arises when the invention is created by more than one person or when the patentee assigns, transfers or conveys a partial interest in the patent to another person or entity. As a result, it is better practice to have a written agreement between joint inventors governing how they will use, license, assign, etc. their portion of the patent.
- Correcting a Defective Patent. Under certain conditions, the patentee can request that the patent be reissued due to defects. Generally, the reissue is made to correct defects (new matter will not be accepted) and will be granted, if at all, after an examiner has reviewed the proposed corrections to the original patent. Of note is that the reissue will not extend the term of the original or reissued patent. (See 35 U.S.C. §251, §252).
- Foreign/International Patent Protection. Patents granted by the USPTO allow the inventor to preclude others from selling or using a similar or identical invention in the United States, its territories and possessions. U.S. patent rights do not, however, extend abroad. The Paris Convention for the Protection of Industrial Property provides that an inventor may, file in other nations who are members of the Paris Convention, NAFTA or WTO a patent application and use the U.S. Patent as the basis for the application, as long as the application is filed within 12 months of the patent grant in the U.S. (and six months in the case of industrial design patents). (See 35 U.S.C. §119). The same right extends to inventors in foreign countries who are member countries of WIPO, NAFTA or the Paris Convention and permits them to file for U.S. patents based on their foreign patent. (See 35 U.S.C. §104). The effect of these treaties is that an application(s) filed abroad will have the same effective date as the U.S. patent thereby permitting the U.S. patentee to have priority internationally beginning on a set date. (See 35 U.S.C. §119). To make filing in member countries a little easier, the Patent Cooperation Treaty provides for, among other things, centralized filing procedures and a standardized application format. (See 37 C.F.R. §1.434).

II. Trademarks.

Trademarks, as the term is generally used, are distinctive names, logos, designs, numbers, symbols, or signs that are used to identify and distinguish the source of a particular product or service. The property right that is represented by and embodied in a trademark is termed goodwill. Goodwill is in general the association in the public mind between the mark, the provider of particular goods and/or services and the quality of the particular goods and/or services sold. Examples of trademarks with Goodwill are Microsoft, NBA, and RCA. Goodwill is created by the actual use of the mark in commerce and advertising of the mark. From this basic principal develops the legal fact that the person or entity that uses a mark in commerce first has the greatest, and at times sole right to use that mark.

Of note is that the more fanciful and arbitrary the mark, the greater the goodwill in the mark and therefore the greater the likelihood that the United States Patent and Trademark Office (“USPTO”) will register the mark. The USPTO generally will not register marks that are descriptive or misdescriptive of the goods/services, geographically descriptive or misdescriptive of the goods/services, a surname or ornamental. There are other grounds on which the USPTO will reject registration and these are set forth in the USPTO’s *Trademark Manual of Examining Procedure* (TMPEP) in Chapter 1200. (See also 15 U.S.C. §1052).

Federal registration of a mark is not required as it does not grant the right to use the mark in commerce nor does it create goodwill in the mark. The owner already has the right to use a mark in commerce and can only create goodwill by using and/or advertising the mark. Federal registration of a mark instead gives the owner in the eyes of the U.S. federal government and courts the presumption that he/she has the sole right to prevent others from using a confusingly similar mark in commerce in any of the 52 U.S. states and U.S. possessions. Federal registration also provides the owner with the right to 1) bring an infringement or dilution action in U.S. federal court, 2) to prevent third parties from importing similar/ the same goods or services into the U.S. under a confusingly similar or counterfeit mark by registering the mark with the U.S. Customs Service, and 3) use the U.S registration as a basis to register the same mark internationally (See 15 U.S.C. §1051). Of note, is that the registration of a mark does not permit the owner to prevent others from making the same goods or from selling the same goods or services under a clearly different mark.

A. Length of Federal Registration

Federal registration of a mark last for ten (10) years. During this ten year period, between fifth and sixth year, the owner must file an Affidavit of Continued Use or Affidavit of Excusable Non Use along with the appropriate fee to maintain the registration. (See 15 U.S.C. §1058). After the ten years has expired, the owner can renew the registration for another ten year period. In this manner the owner can maintain the federal registration indefinitely as long as the owner continues to use the mark in commerce and files Applications for Renewal of the registration along with the appropriate fee every ten years. (See 15 U.S.C. §1059).

B. Types of Marks

In common language the term “trademark” is often over used to describe a range of names, logos symbols and designs (generally termed marks) that the USPTO offers federal

protection for. However, each mark has a different legal name and definition based on the purpose it serves and the nature of the creative work it protects. Following is a summary of the types of marks the USPTO offers federal protection for:

- **Service Mark:** This is a mark (word, name, symbol, or device) used to distinguish the source of the services sold in commerce AND used to distinguish the services offered from the services of others. (See 15 U.S.C. §1127) and (See TMEP §1301).
- **Trademark:** A trademark is a word, name, symbol or device used to indicate the source of the goods and to distinguish them from the goods of others.” (See 15 U.S.C. §1127).
- **Certification Mark:** A certification mark is any “word, name, symbol, device, or any combination” thereof used by the members of a group to “certify the regional origin, mode of manufacture, quality, accuracy, or other characteristics of the goods or services.” In addition, certification marks can be used to certify that “the work or labor on the goods or services was performed by members of a union or other organization.” (See 15 U.S.C. §1127).
- **Collective Mark:** A collective mark is a trademark or service mark that indicate that the origin of goods or services is a member of a certain group (a collective) and that the member has met the group’s quality and service requirements. As collective marks are used by all of the members of the collective, the mark is owned by the collective and not the individual members of the group. (See TMEP §1303). Examples of collectives are unions and franchises.

C. Requirements For Registration of a Mark

Only the person or entity that owns the mark can request federal registration of the mark. The applicant does not have to be a US citizen, however, if you reside outside of the United States, then you must appoint a "domestic representative" to receive correspondence from the USPTO on the applicant’s behalf. (See 37 C.F.R. §2.18).

There are two primary grounds (basis of application) under which a person or entity can apply for federal registration of a mark. The first is actual use of the mark in the normal course of business on goods or in connection with services in commerce between states of the United States and/or between countries (termed “Use in Commerce“). The second is a bona fide intent to use the mark in the normal course of business on goods or in connection with services in commerce between states of the United States and/or between countries (termed “Intent to Use”). If an owner of a mark has already registered a trademark in a foreign country, under certain circumstances the owner can claim the foreign registration as the basis for the U.S. application for federal registration (See 37 C.F.R. §2.18).

Because the owner’s right to use a mark develops by the owner using the mark in commerce, the USPTO will not register a mark that is similar to an existing mark and likely to confuse the consumer as to who or which company is the source of the good or service. As a result, before preparing and submitting a trademark application, it is better practice to conduct a search of existing marks to determine if the applied for mark could or would be considered

confusingly similar to an existing mark. Applicants can conduct searches utilizing 1) the Patent and Trademark Depository libraries, 2) the USPTO website (these searches will not capture pending marks), 3) an intellectual property attorney or 4) a private firm that charges a search fee (firms are listed in the yellow pages as well as on the internet).

D. Applying For Federal Registration of a Mark

In addition to identifying the applicant, the domestic representative if appropriate and listing an address for correspondence, the application for federal registration of a mark at a minimum must include the following:

- **A Drawing of the Mark:** A clear drawing of the mark as it is or will be used in commerce must be included in the application. If the mark consists of only word(s), letter(s), and/or number(s), (i.e., no design or stylization of letters/numbers) the applicant can “type” the mark in all capital letters in the center of the drawing page. If the mark contains a design or stylized numbers/letters then the drawing page should include a black and white image of the mark, no larger than 3.5 inches by 3.5 inches. The stylized drawing must conform to USPTO specifications. For example, the drawing generally cannot contain color and instead can only contain a description of color unless the mark itself is a color. If you want to register a mark in color, you must submit a color drawing. 37 C.F.R. §2.52(b)(1). You must also submit: (1) a color claim naming the colors that are a feature of the mark; and (2) a separate statement describing where the color(s) appear on the mark. The USPTO drawing specifications can be found at 37 C.F.R. §2.52.
- **Goods or Services.** The application must contain a listing of all the goods or services on which or in connection with which the mark is used or will be used. (15 U.S.C. §1112). The listing must contain a detailed description of the goods/services in plain language. Furthermore, “the applicant should designate only the number of classes for which a filing fee is submitted and should limit the [list of] specified goods and services to those within the particular class(es) designated. Thus, if a single filing fee is submitted, the applicant should designate only one class and should limit the goods or services specifically listed] in the identification to items in that class.” (See TMEP §1401.04(b)). The USPTO suggests that applicants use the language from the USPTO’s *Acceptable Identification of Goods and Services Manual* to describe the goods or services.
- **Multiple classes of goods/services.** Since the applicant can only limit the scope and/or narrow the description of goods/services after the application is submitted, it is better practice to be over inclusive rather than under inclusive when it comes to listing the goods or services. The examining attorney will direct the applicant in how to narrow the listing of goods or services if he/she deems it necessary in an e-mail or in an office action that follows. If the goods and/or services listed fall under more than one class, the application should group the goods or services under each corresponding classification. Furthermore, “the class numbers and corresponding goods or services must be listed separately, from the lowest to the highest number.” (See TMEP §801.01(b)).
- **Filing Fee.** The filing fee is determined by the number of classes of goods or services that the application lists under the goods or services identification section. (See TMEP §801.01(b)). For each class of goods or services contained in the application, the filing

fee is \$375.00 for paper filing, or \$275-\$325 for electronic filing and each application must include at a minimum one class of goods or services. Payment can be made by credit card, check (business, personal and certified) or money order, and should be made payable to the Director of the USPTO. In addition, payment can be made through an existing USPTO deposit account. Fee increases are enacted on a regular basis, so the applicant should call the following toll free number to verify the current fee amount - 1-800-PTO-9199.

- Declaration. Applications must include a sworn statement (termed a declaration) stating either that the mark is in use in commerce and the date of first use of the mark (for “Use in Commerce” applications) or that the owner has a bona fide intention to use the mark in commerce (for “Intent to Use“ applications). The USPTO offers a form declaration that can be obtained from the USPTO office in Virginia. Declarations, like the application, must be signed by the applicant or someone authorized to sign on behalf of the applicant (See TMEP §804 et. Seq.).
- Specimens. All applications must contain one specimen of the mark for each class of goods/services listed on the application - an example of how the mark is in fact used on goods or in connection with services. Examples of specimens for goods are hang tags attached to clothing, a picture of the goods with the mark attached to them, or the container for the goods. Examples of specimens for services are business cards with trade name and service, a sign, letterhead stationary, or brochure. (See TMEP §1301.04). Keep in mind that the USPTO will not accept a drawing of the mark as a specimen and will not accept actual items of the goods that are sold. Intent to Use applications require that the applicant submit the specimens once the applicant begins to use the mark. (See 37 C.F.R. §2.59). The USPTO has specific requirements concerning the size of the specimens that will be accepted and has made special provisions for sound marks. (See 37 C.F.R. §2.56).
- Statement of Use. This section applies only to Intent to Use applications. After the application has matured into a registration and the Notice of Allowance has issued, the applicant has six months from the date on which the Notice of Allowance issued within which to make actual use of the mark in commerce and submit a declaration stating that actual use has begun. The declaration is termed a “Statement of Use” and must be accompanied by a filing fee of \$100.00 per class listed and at least one specimen per listed class of goods or services as noted above. (See 37 C.F.R. §2.88). If the applicant is unable to make use of the mark within this six month period, the applicant can file a Request for an Extension of Time to File A Statement of Use along with the \$150.00 per class fee and receive an additional six months within which to use the mark. (See 37 C.F.R. §2.89). In totum the USPTO will grant four extensions of time, but after the 4th extensions or 36 months, the USPTO will not register the mark. (See 15 U.S.C. §1051).

E. Preparing and Submitting the Application

If the application does not contain the minimum elements listed above, the application is termed informal or deficient. The USPTO returns all informal or deficient applications and refunds any fees submitted. So to save time and receive the earliest possible filing date try to assure that the above-noted elements are included in the application.

Applications can be prepared and submitted on line at the USPTO's website or prepared on paper and either hand delivered or mailed to the Commissioner for Trademarks, P.O. Box 1451, Arlington, VA 22313-1451. Upon receipt of applications that contain the minimum elements, the USPTO will assign a filing date to the application, assign a serial number to the application, send the applicant a filing receipt and assign the application to an examining attorney. This process in and of itself may take several months.

F. Examination of the Application

Once the application is assigned to an examining attorney he/she will conduct a search to determine if the mark applied for conflicts with any existing/pending marks and will review the application and make a determination as to whether the application can mature into a federal registration. If the examining attorney finds the mark meets registration requirements noted above, he/she will first publish the mark in the official gazette so that third parties who believe they would be damaged by the registration of the mark can oppose the registration. At the same time the examiner will send the applicant a Notice of Publication. (See 15 U.S.C. §1062). If no one opposes registration of the mark within thirty days of its publication or if any opposition is overcome, the application will mature into a registration and the USPTO will issue a Certificate of Registration to the Applicant or a Notice of Allowance in the case of an Intent to Use Application. (See 15 U.S.C. §1057(a), §1064) and (See 37 C.F.R. §§2.80-81).

If upon completing his/her review of the application, the examining attorney has substantive objections/comments she/he will issue an Office Action that sets forth their objections/comments and explains why she/he refused registration of the mark. The applicant must respond to the office action within six (6) months or the application will be deemed abandoned. In the response, the applicant will have an opportunity to overcome any objections and/or correct any procedural defects in the application. (See 37 C.F.R. §§2.61-63). If the examining attorney determines that only minor changes are required in order for the application to mature into a registration, the applicant will probably have an opportunity to discuss the requested changes and file an amendment so that the registration can issue. (See 37 C.F.R. §2.71). Applicants can file amendments to the application as needed and pursuant to the rule set forth at 37 C.F.R. §2.71 through §2.77.

If the examining attorney determines that despite amendments made/arguments raised, the application cannot mature into a registration, the examining attorney will issue a final rejection. (See 37 C.F.R. §2.64). The applicant can appeal the examining attorney's decision to the USPTO's Trademark Trial and Appeal Board upon payment of the requisite fee, and the Board can reverse or uphold the examining attorney's determination. (See 15 U.S.C. §1070).

G. Protecting Your Mark

Once a mark is registered, the owner can place an "®" symbol next to the mark but only on those goods or in connection with those services listed in the application as approved for registration by the USPTO. If you have not received federal registration or while registration is pending, you can place "TM" (trademark) or "SM" (service mark) next to the mark that

you use in commerce.

- **Infringement Action:** Federal registration of a mark gives the owner the legal presumption that he/she has the sole right to prevent others from using a confusingly similar mark or a counterfeit mark in commerce in any of the 52 U.S. states and U.S. possessions. In addition, the owner can file an action in federal court asking the court to force a third party to discontinue using a mark in commerce (termed an injunction). (See 15 U.S.C. §1051). The owner can, in addition to having the infringing marks destroyed, recover profits and court costs from innocent infringers and win three times the defendant's profits as damages along with costs if the defendant knowingly and willfully infringed the owner's right. (See 15 U.S.C. §1114 and 1117).

- **Dilution Action:** The owner of a famous mark can prevent some one else from registering a similar mark that would lessen the capacity of the famous mark to identify and distinguish goods or services. (See 15 U.S.C. §1127). For example, the owner of the mark Maxim's as used in connection with the restaurant in New York can petition the USPTO not to register the mark Maxims to someone who wants to open a single restaurant in California. To do so the owner must commence a Opposition to Registration proceeding or a Cancellation of Registration proceeding before the Trademark Trial and Appeal Board to preclude or cancel registration of the other mark (See 15 U.S.C. §§1052, 1063 and 1064).
 - o **Domain Names:** As defined by federal statute "the term 'domain name' means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet." (See 15 U.S.C. §1127). To obtain a domain name, a person or entity can apply to a number of companies that assign domain names (Internic, Network Solutions Inc., Etc.). The previous and continuous use in commerce of a trademark as well as the federal registration of a mark does not automatically secure a domain name for the owner. However, the federal registration and prior use of a trademark can prevent another person from obtaining or using a domain name. The owner must demonstrate to the company providing the domain name that the domain name is a significant component of his/her trademark and the company will preclude use of the domain name until the issue of who is entitled to use the domain name is resolved in court or through arbitration.

APPENDIX

USPTO On-line catalogue of general products and services
<http://www.uspto.gov/web/offices/ac/ido/oeip/catalog/index.html>

USPTO telephone numbers listed alphabetically by subject
<http://www.uspto.gov/web/info/index.htm>

Patents

For additional information on the patent process, telephone the USPTO Information Line and Patent Assistance Center at:

Telephone **800-786-9199** (IN USA OR CANADA) or **571-272-1000** for assistance from Customer Service Representatives and/or access to the automated information message system.
TTY: **571-272-9950**

Are there any state government agencies that can help me in developing and marketing of my invention?

A. Yes. In nearly all states there are state planning and development agencies or departments of commerce and industry which seek new product and new process ideas to assist manufacturers and communities in the state. If you do not know the names or addresses of your state organizations you can obtain this information by writing to the governor of your state.

Trademarks

Division

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TrademarkAssistanceCenter@uspto.gov

TRADEMARK TRIAL AND APPEAL BOARD
Phone- (571) 272-8500

This website has been established to provide the public information regarding Internet domain name registration services and will be updated frequently
<http://www.internic.net/>

Trademark Search Companies
Thomson & Thomson
(800) 692-8833
<http://www.thomson-thomson.com>

CCH Corearch, Inc.
(800) 732-7241
<http://www.corsearch.com>

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