Trademark Registration



The Q and A of Intellectual Property

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1 What Is a Trademark?

A trademark is anything that designates the source of goods or services. A trademark can be a word mark, a logo, a slogan, or even a sound. Under U.S. law, trademark rights are based on use of the mark in commerce. Although trademarks can be registered with the U.S. Patent and Trademark Office ("USPTO"), trademark ownership is based on the date of first use rather than the date of registration. The exception to this rule is that a federal trademark registration cannot be challenged on the basis of priority of use more than five years after the date of registration. Trademarks may also be registered on a state level, but a federal trademark registration constitutes ownership of the mark in all 50 states.

2 What Are the Benefits of a Federal Trademark Registration?

There are several significant advantages to a federal trademark registration. In addition to the benefits noted above, a federal trademark registration permits you to use the registered trademark symbol (®). It also gives you the right to sue for up to $2 million dollars in statutory damages for willful infringement. Alternately, you may elect to pursue treble damages for willful infringement. Trademark owners who prevail in an infringement action may also recover their attorneys' fees in an exceptional case.

3 How Does the Trademark Registration Process Work?

Every federal trademark application undergoes an examination process at the USPTO. First, the application is reviewed by a trademark examining attorney to determine whether there is a likelihood of confusion with any other marks that are in the USPTO database (that is, any pending applications or issued registrations). If so, then the examining attorney will issue an Office Action refusing registration on the basis of likelihood of confusion. Registration may also be refused on other grounds, such as descriptiveness or insufficient proof of use, or the examiner may require clarification of the description of goods/services. Although a federal trademark application may be filed on an intent-to-use basis, proof of use must be filed with the USPTO before the registration will issue.

Once the examination process is completed, if all grounds for refusal have been overcome, the application is then published in the *Official Gazette* (a USPTO publication) for a 30-day opposition period. During this time, anyone who is using the same or similar mark may oppose registration of your mark on the basis of likelihood of confusion. Although oppositions may also be brought on the basis of fraud, genericness, etc., likelihood of confusion is by far the most common basis for a trademark opposition.

If no oppositions are filed during the publication period, then the trademark office will issue a Certificate of Registration (if proof of use was submitted at the time of filing) or a Notice of Allowance (if the application was filed on an intent-to-use basis). The applicant then has six months in which to file the Statement of Use. A total of five six-months extensions may be obtained upon payment of the requisite fees. Once the registration issues, it must be renewed at five years, four years, and then every ten years thereafter.

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4 How Do I Prove Trademark Infringement?

Trademark infringement is based on the likelihood of confusion test, which takes into consideration the degree of similarity of the marks and the relatedness of the goods and/or services at issue. The more similar the marks, the less related the goods/services need to be in order to support a finding of likelihood of confusion. For example, if the two marks at issue are both REDWING, and the goods are footwear and semiconductors, there would not be any likelihood of confusion because the goods are completely unrelated. On the other hand, if one party wanted to use REDWITH for real estate brokerage, and another party wanted to use REDWING for property management, there would be a likelihood of confusion because the services are related, and the marks are similar. The first part of a mark is usually, but not always, considered to be the "dominant" part of the mark. The likelihood of confusion test is used by courts to determine liability for trademark infringement, and it is also used by the U.S. Patent and Trademark Office to determine whether a mark is registrable.

5 Can I Protect My Trademark Internationally?

Yes. Trademarks can be registered internationally via the Madrid Protocol, which is an international treaty that governs the registration of marks on an international basis. In order to use the Madrid Protocol registration process, a U.S. trademark owner must first have a U.S. trademark application or registration. The Madrid Protocol application must be filed within six months of the U.S. filing date in order to claim priority back to the U.S. filing date. A Madrid Protocol application may be filed at any time, but if it is filed after this six-month window, then the priority date in foreign countries is the date on which the Madrid Protocol application is filed, not the date on which the U.S. application was filed. This matters because most foreign countries are first-to-file jurisdictions, unlike the U.S., which (like Canada) is a first-to-use jurisdiction.



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