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**Trademarks**

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**Module I – Registration Basics**

**Activities**

1. Which government entity handles federal Trademark registrations?
   1. Answer – USPTO
2. How many federal registers are available?
   1. Answer – 2; Principal & Supplemental
3. Is there are difference between the Principal and supplemental registers?
   1. Answer – Yes; the Principal Register requires a trademark to meet additional requirements, and trademarks on the Principal register obtain greater protections.
4. Two types of legal protections or advantages that a trademark eligible for the Principal Register may receive, but that is not granted to a trademark only eligible for the Supplemental Register include:
   1. Source - 15 U.S.C. § 1094.
   2. Answer (choose any two)
      1. § 1051(b) – application for bona fide intent to use
      2. § 1057(b) – registration certificate as prima facie evidence of ownership
      3. § 1057(c) – application to register mark as constructive use and priority against subsequent applications and users
      4. § 1072 – registration as constructive notice of claim of ownership
      5. § 1124 – importation of goods bearing infringing marks or names forbidden; correlates to 15 USC 1096.
5. What types of trademarks cannot be registered on either the Principal or Supplemental Registers?
   1. Sources - 15 U.S.C. §§ 1052; 1091(a).
   2. Answer – (choose any one or more)
      1. Immoral, deceptive or scandalous matter;
      2. A mark that is or contains the flag of the United States, any State or any foreign nation;
      3. Marks that are or contain the name, portrait or signature of a particular living individual, unless consent received;
      4. A mark that is likely to cause confusion because it so resembles a mark already registered or previously used in the United States and not abandoned.
6. How many goods or services must you classify as being used in connection with the mark you seek to register?
   1. Source - TMEP §805.
   2. Answer – All of the goods on which you wish to use the mark and/or all services that will be offered under the trademark.
7. True or False? The classification of the goods or services on a trademark application is the same as the descriptive identification of those goods or services?
   1. Source – TMEP §1402.01(a)
   2. Answer – False: the classification of goods and services is simply a number that corresponds to the category in which the goods or services fall and is determined by the International Schedule of Classes of Goods and Services. Acceptable descriptive identifications of the same goods and services are specific, definite, clear, accurate and concise descriptions of goods or services and *may* come from the Acceptable Identification of Goods and Services Manual. Both the Schedule and Manual may be found on the USPTO website: uspto.gov.
8. How do you classify the goods or services that you want to list on your trademark application?
   1. Source – TMEP §1401.02
   2. Answer – You must look-up in the latest version of the International Schedule of Classes of Goods and Services the appropriate type of good or service that you wish to classify and locate the corresponding classification number.
9. Which is important to remember about the relationship between the Supplemental and Principle Registers?
   1. Source - 15 U.S.C. §1095.
   2. Answer – Registration on the Supplemental Register does not prevent future application to the Principle Register, nor is registration on the Supplemental Register an admission that a trademark does not meet the distinctiveness requirement for the Principle Register.
10. If you are not comfortable with selecting the classification or acceptable description of your goods and services, who should you speak with?
    1. Source – common professional caveat
    2. Answer – a licensed attorney with whom you have a client-attorney relationship

**Module II – Registration Process and Requirements**

**Activities**

1. True or False? The trademark registration process is a long and arduous journey through the bureaucracy of the United States Patent and Trademark Office?
   1. Answer – False: the length and difficulty of a trademark registration depends on many factors.
2. What are key requirements needed to complete an application?
   1. Source – TMEP 818
   2. Answer
      1. A clear drawing of the mark
      2. A verified signature
      3. A written application (may be completed online)
      4. Filing fee for each class of goods and services listed in the application
3. What is a Specimen?
   1. Source - 1613.12(a)
   2. Answer - a depiction of how the trademark as shown in its trademark application has been used on or in connection with the goods or services in the classifications listed in the application.
4. If you have already started using the trademark to sell or offer for sale goods or services across state boundaries, i.e., in commerce, what else must you supply in your initial application?
   1. Source – TMEP 818; 1613.12(a)
   2. Answer – One specimen for each class of goods and services listed in the application.
5. What are USPTO Office Actions?
   1. Source – TMEP §705
   2. Answer – Office Actions are a letter or email (if authorized) communicated by an attorney who examines a trademark application to notify an applicant of registration refusal, of any need to change the application, or any changes the examining attorney made.
6. What is a Final Action?
   1. Source – TMEP 714.04
   2. Answer – an applicant’s final opportunity to respond to issues an Examining Attorney has raised with an application. A Final Action occurs when an Examining Attorney has notified an applicant of all issues in the application that must be resolved to attain registration, and the applicant has had the opportunity to respond to each issue.
7. What factors may contribute to the amount of time it takes for the USPTO to determine if an application is eligible for registration?
   1. Source – TMEP 711.01; 714.03
   2. Answer – the initial completeness and accuracy of the application and the number of office actions the USPTO sends to an applicant to clarify aspects of the application. An applicant typically receives six months to respond to an Office Action, but encourages Examining Attorneys to conduct efficient and thorough examinations such that two Office Actions are sufficient to determine eligibility.
8. Besides deciding whether to apply for the Principle or Supplemental Register, what other vital decision must an applicant make?
   1. Source – TMEP 801.01(a)
   2. Answer – whether the application is a single or multiple-class application.
9. Given the importance of single and multiple-classification applications, what can be one of the most prominent costs of a trademark registration?
   1. Source – TMEP 810.01
   2. Answer – filing fees; an applicant must pay a fee for each classification of goods or services listed in the application. The fee schedule is on the USPTO website: uspto.gov.