**Topic:** Trademark

**Module I:** Registration Basics

**Information:**

The United States Patent and Trademark Office (“USPTO”) handles both patent and trademark registrations. This section will introduce aspects of trademark registration. If you are looking for more information about patents, *click here* for the Patent Tutorial*.*

There are two federal registers available for trademarks: 1) the Principal Register and 2) the Supplemental Register. The Principal Register offers greater protections for a trademark compared to the Supplemental Register, but requires a trademark to meet additional requirements, ultimately making it more difficult to obtain. There are several 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. 15 U.S.C. § 1094. These legal protections include:

* Application for bona fide intent to use ­­– § 1051(b);
* Registration certificate as prima facie evidence of ownership – § 1057(b);
* Application to register mark as constructive use and priority against subsequent applications and users – § 1057(c);
* Registration as constructive notice of claim of ownership – § 1072;
* Importation of goods bearing infringing marks or names forbidden; correlates to 15 U.S.C. 1096 – § 1124.

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. See 15 U.S.C. §1095.

Importantly, not all trademarks can be registered. According to 15 U.S.C. §§ 1052; 1091(a), the following types of trademarks cannot be registered on either the Principal or Supplemental Registers:

* Immoral, deceptive or scandalous matter;
* A mark that is or contains the flag of the United States, any State or any foreign nation;
* Marks that are or contain the name, portrait or signature of a particular living individual, unless consent received;
* 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.
  1. When registering a trademark, you must classify all of the different goods and services being used in connection with the mark you seek to register. For example, if you wanted to register a trademark for a brewing company and later decided to use that same trademark on t-shirts or other clothing, you would need to register two different types of classifications for the same mark. See TMEP §1401.02 to 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.

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. In addition to classification of goods and services in connection with the trademark you want to register, you also need to provide acceptable descriptive identifications of the same goods and services. These descriptive identifications 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: <http://www.uspto.gov>.

**Activity 1 (MC):**

Where can you register a trademark?

1. The United States Copyright Office
2. The United States Patent Office
3. The United States Patent and Trademark Office (CORRECT)
4. The United States Trademark Registrar’s Office

**Activity 2 (Yes/No):**

There is only one type of federal register for trademarks.

a. Yes.

b. No. (CORRECT)

HAVE FOLLOWING TEXT APPEAR AFTER QUESTION HAS BEEN ANSWERED: There are two types of federal registers for trademarks: Principal and Supplemental.

**Activity 3 (Yes/No):**

Is there a difference between the Principal and Supplemental registers?

a. Yes.

b. No.

HAVE FOLLOWING TEXT APPEAR AFTER QUESTION HAS BEEN ANSWERED: Principle Registration is more difficult to obtain than Supplemental Registration but offers more protection for a trademark.

**Activity 4 (MC):**

What legal advantage does a trademark with Principal Registration have over Supplemental Registration?

1. The Registration Certificate can be used as prima facie evidence of ownership of the trademark.
2. The Registration can be considered constructive notice of claim of ownership of the trademark.
3. The Registration Application is evidence of constructive use of a trademark and can show priority against subsequent applications and users.
4. All of the above. (CORRECT)

HAVE FOLLOWING TEXT APPEAR AFTER QUESTION HAS BEEN ANSWERED: Other advantages of the Principal Registration over Supplemental Registration include the following: The Principal application represents a bona fide intent to use the trademark and importation of goods bearing infringing marks or names are forbidden.

**Activity 5 (MC):**

Which of the following trademark description is not forbidden on the Principal or Supplemental Registers?

1. A trademark containing a swear word.
2. A trademark with the United States Flag in a circle.
3. A trademark that contains a picture your neighbor’s face (with their permission). (CORRECT)
4. A trademark that looks identical to a Nike Swoosh.

**Activity 6 (Yes/No):**

You designed a trademark for your new company that sells a type of software. You decide to also promote your brand by selling sweatshirts with the same logo on them. Should you only register your trademark under the software classification?

1. Yes. Software is your main product and is the only goods/services that you need to classify when registering your trademark.
2. No. If you want to fully protect your trademark, you need to classify all the goods and services being used in connection with your trademark at the time of registration. (CORRECT)

**Activity 7 (Yes/No):**

Is the classification of the goods or services on a trademark application the same as the descriptive identification of those goods or services?

1. Yes. The classification is the same as the descriptive identification.
2. No. 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. (CORRECT)

**Activity 8 (MC):**

If you are not comfortable with selecting the classification or acceptable description of your goods and services, who should you speak with?

a. Your best friend.

b. A licensed attorney with whom you have a client-attorney relationship. (CORRECT)

c. Another business professional in your field.

d. The artist who designed your trademark.

END OF FIRST QUIZ

**Module II –** Registration Process and Requirements

**Information:**

The length of time and difficulty required to complete the trademark registration process through the United States Patent and Trademark Office depends on many factors.

The TMEP 818 list several components required to complete a trademark application such as:

* A clear drawing of the mark
* A verified signature
* A written application form (which can be completed online)
* Payment of a filing fee for each class of goods and services listed in the application.

Trademark Registration Terms:

A “Specimen” is 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. See TMEP 818; 1613.12(a).

USPTO “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.

USPTO “Final Action” is 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.

Application to Registration Timeline

Several factors may contribute to the amount of time it takes for the USPTO to determine if an application is eligible for registration. 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. See TMEP 711.01; 714.03.

Other Trademark Application Considerations

In addition to deciding whether to apply for the Principle or Supplemental Register, an applicant must also decide whether the application is a single or multiple-class application. This is an important decision when applying for a trademark because multiple-class applications are much more expensive than single-class applications. See TMEP 801.01(a) and TMEP 810.01. The filing fee schedule for the various classifications is available on the USPTO website: <http://www.uspto.gov>.

**Activity 1 (Yes/no):**

Is the trademark registration process a long and arduous journey through the bureaucracy of the United States Patent and Trademark Office?

a. Yes. The process goes on for a set amount of years.

b. No. The length and difficulty of a trademark registration depends on many factors. (CORRECT)

**Activity 2 (MC):**

What is a key requirement needed to complete a trademark application?

a. A clear drawing of the mark.

b. A verified signature and an application fee for all the goods and services listed in the application.

c. A complete, written application (which may be completed online).

d. All of the above. (CORRECT)

**Activity 3 (MC):**

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. One specimen for each class of goods and services listed in the application. (CORRECT)

b. Only the specimen for one class of goods and services that is used most frequently.

c. You don’t need to supply anything extra if you have been using the trademark across state boundaries.

d. You are ineligible for a trademark once you start selling goods or services across state boundaries.