

FARALLON LAW GROUP NEWSLETTER

(MARCH, 2011)

USPTO Trademark Applications

➤ **What is a Trademark/Service mark?** A trademark (or “mark”) is a word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others. A servicemark is a trademark for services. A trademark typically protects brand names and logos used on goods and services. This is different from copyright which protects an original artistic or literary work, and patents which protect inventions.

➤ **Is Registration of your Mark Required?**
No. You can establish rights in a mark based only on actual use of the mark in commerce. However, owning a federal trademark registration provides several advantages, including:

- Public notice of your claim of ownership of the mark;
- A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in federal court; and,
- The use of the US registration as a basis to obtain registration in foreign countries.

➤ **Can You File A Trademark Application Before You Start Using the Trademark?** Yes. You can file an Intent-to-Use application stating that you have a bona fide intent to use the trademark in the future. Application filing fees are typically \$325.

➤ **What Happens After You File A Trademark Application With the USPTO?**
Approximately 3 months from the date your application is filed with the US Patent and Trademark Office, the application is assigned to an examining attorney to determine whether federal law permits registration. The examining attorney will examine the written application, the drawing, and specimen. The examining attorney will often issue a letter (an “Office Action”) requiring further action or explanation for the application to proceed or

explaining any reasons for refusing registration. If you receive an Office Action, you must submit a response within 6 months of the issue date of the Office Action.

If no refusals or additional requirements are identified, the examining attorney approves the mark for “publication” which commences a 30-day period in which an opposition to the registration of the mark may be filed. If no opposition is filed or you successfully overcome an opposition, the USPTO will issue a registration certificate within about 3 months after publication, if the application is based upon the actual use of the mark in commerce (or on a foreign or international registration). If you filed an Intent to Use application, the USPTO will issue a Notice of Allowance (NOA). A NOA indicates that your mark has been allowed, but you must submit a “Statement of Use” confirming you are actually using the mark in commerce before a registration is granted. Protection will be afforded to your mark from the date of filing your application.

➤ **The Most Common Reason an Examiner Refuses Registration.** The most common reason is that there exists a “likelihood of confusion” with the mark in an existing registration or application. The principal factors considered are:

- The similarity of the marks; and,
- The commercial relationship between the goods/services listed in the application and those listed in the prior registration or application.

The marks do not have to be identical and the goods/services do not have to be the same in order for an examiner to determine that a likelihood of confusion exists. It may be enough that the marks are similar and the goods/services are related.

Please feel free to contact Boris Lieberman or Mario Kashou at 415-255-2450 if you have questions about trademarks and trademark applications/registrations.

This Newsletter is intended as a general guide to law issues and developments. It does not contain a general legal analysis or constitute a legal opinion of Farallon Law Group LLP or any member of the firm on the legal issues described. It is recommended that readers not rely on this general guide in structuring individual transactions but that professional advice be sought in connection with individual transactions.