

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Discussion topics

- Definition of a trademark and the benefits of federal registration
- Filing considerations
- Trademark examination process
- Maintaining your trademark
- Tips and helpful USPTO resources

# What is a trademark?

Any word, slogan, symbol, design, or combination of these that:

- Identifies the source of your goods or services;  
and
- Distinguishes your goods and services from those of another party.

**TM** **®**

# Common-law trademark

- Trademark that is **used** in commerce in connection with specified goods and services, but **not registered**
- Rights are limited to geographic area (based on use in that area)
- Optional symbols: <sup>TM</sup> <sup>SM</sup>
- U.S. is a first-to-use country
  - most countries are first-to-file

# Examples of trademarks

Trademarks can be **WORDS**

STARBUCKS

NIKE

TARGET

Trademarks can be **DESIGNS**

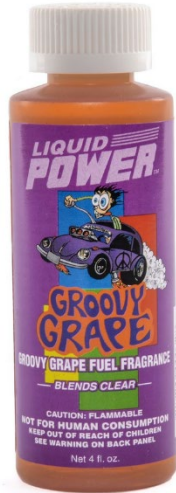


uspto

# Nontraditional marks – colors



# Nontraditional marks – scents



verizon<sup>v</sup>



uspto

# Nontraditional marks – sounds



# Why seek federal registration?



- Legal presumption of ownership and right to use the mark
- Legal right to enforce the mark through legal action in federal court
- Provides public notice because mark is listed in the USPTO database
- Rights are granted throughout the United States and its territories
- Means of preventing importation of infringing products through recordation with U.S. Customs and Border Protection
- Serves as a basis for foreign filing in treaty member countries

# Filing considerations

- Must file application via MyUSPTO.gov account
- Before you file, you should consider:
  - Filing options and fees
  - Identification of goods and services
  - Filing basis
    - Intent to Use
    - Use in Commerce

# MyUSPTO.gov



UNITED STATES  
PATENT AND TRADEMARK OFFICE

[About Us](#) | [Jobs](#) | [Contact Us](#) | [MyUSPTO](#)



## MyUSPTO

MyUSPTO is a single place for you to actively manage your intellectual property portfolio. Track patent applications and grants, check trademark registrations and statuses, and access our services in your personalized USPTO gateway.

I have an account

[Log in with your USPTO.gov account](#)

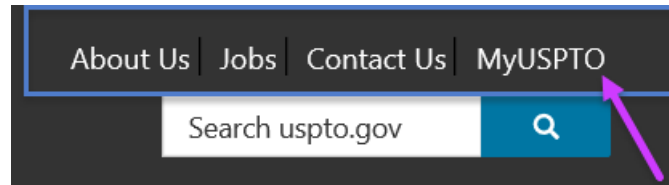
I need an account

[Create a USPTO.gov account](#)



# MyUSPTO.gov

- Create an account by clicking the tab “MyUSPTO.”



- Find assistance on the “frequently asked questions (FAQs)” page of our website at [www.uspto.gov/learning-and-resources/account-faqs](http://www.uspto.gov/learning-and-resources/account-faqs).

# My.USPTO.gov

- Trademark docket
  - Share collections in dockets with other MyUSPTO users
- Trademark form finder widget
  - Widget identifies forms using plain language rather than current form names
  - Includes a search box to search the form names
- Next widget: Trademark Electronic Application System (TEAS) Plus Short Form
  - Initial scope: intent-to-use (ITU) word marks, TEAS Plus fee basis

A screenshot of the 'TRADEMARK FORM FINDER' widget. The title 'TRADEMARK FORM FINDER' is in green at the top left. There are small icons for expand and close at the top right. Below the title is a search bar with the placeholder text 'Search' and a blue search button with a magnifying glass icon. A list of form categories follows, each preceded by a right-pointing chevron: 'File an application', 'Respond to correspondence from the USPTO', 'Respond to a Notice of Allowance', 'Make changes to your application', 'File documents after your mark is registered to maintain or change your registration', 'Change an address', 'Change attorney or domestic representative information', 'File a late response', 'Respond to a Notice of Abandonment', 'File a petition', 'File forms related to the Madrid Protocol', 'File an appeal, opposition, or cancellation with the TTAB', and 'Record an assignment for ownership transfers or changes in name, entity type, or citizenship'. At the bottom of the list is a link that says 'All trademark forms'.



Apple



Google

# USPTO TM Status App

- Available on Apple App Store and Google Play
- Search application and registration numbers
- Notifications of selected status changes
- Reflects updated status changes within minutes
- Share, bookmark, or create notebooks for saving information
- No account necessary



# Filing information

- Choose between two filing options – TEAS Standard and TEAS Plus
- Must file application and all correspondence electronically through TEAS, except in limited circumstances. 37 C.F.R. §§2.21(a), 2.23(a)
- Paper submissions will not be accepted in most cases.
  - Paper submissions will result in additional fees
- Foreign-domiciled applicants must have a U.S.-licensed attorney

# Filing fee options

	TEAS Plus	TEAS Standard
Filing fee per class	\$225	\$275
Email address and correspond by email	✓	✓
File all correspondence electronically	✓	✓
Select goods and services from the Identification Manual	✓	✗
Additional information required in initial filing	✓	✗

# Requirements for a filing date

Application must include the following to receive a filing date (37 CFR §2.21):

- Name of the correct owner of the mark
- Email address and mailing address of owner, and, if different from mailing address, owner's domicile address
- Clear drawing of the mark
- Identification of goods and/or services
- Filing fee (at least one class required)
- If applicant is represented by an attorney, attorney's name, postal address, and email address



# Additional requirements for a TEAS Plus application

- Must include additional information in initial application to be eligible for reduced filing fee
- See 37 C.F.R. §2.22(a) for full list, which includes:
  - Identification of goods and/or services from the ID Manual
  - Filing basis
  - Filing fee for all classes
  - Color claim and description of the mark
  - Translation or transliteration of foreign wording
- We'll charge a processing fee of \$125 per class for any application missing the required information



# Identification of goods and services

Application **must** include a list of goods and/or services that the mark is used with:

- Use the Identification of Goods and Services (ID) Manual found at <https://idm-tmng.uspto.gov> to draft an acceptable identification
- Goods and services divided into 45 classes:
  - 1-34: goods
  - 35-45: services



# Identification of goods and services

- Identification should be “specific, definite, clear, accurate, and concise.” (TMEP §1402.01(a))
- Use common commercial names and specific descriptions:
  - Acceptable: electronic devices, namely, tablet computers  
Unacceptable: electronic devices
  - Acceptable: business administration services  
Unacceptable: business services
- Use the Trademark ID Manual to find sample identifications and guidance on how to write your list of goods and/or services at <https://idm-tmng.uspto.gov/id-master-list-public.html>.

# Filing basis

- **Section 1(a): Use in Commerce**
  - Mark is currently being used to market the goods or services.
  - Mark will proceed to registration without any further filings after it is approved by the examining attorney.
- **Section 1(b): Intent to Use**
  - Mark will be used in the near future (three years) to market the goods or provide the services.
  - Marks filed under 1(b) won't register until a Statement of Use is filed by the applicant to change the status to Section 1(a).

# Trademark examination process

For each filed application an examining attorney will:

1. Review the application.
2. Conduct likelihood of confusion search.
3. Research applicant's mark, goods and services, and issues identified in review of application.
4. Address any procedural or substantive issues identified in an office action, examiner's amendment or priority office action, or via telephone or email.
  - Resolution by phone or email is encouraged if the examining attorney contacts you to make changes to the application.

# Common substantive refusal: Section 2(d) likelihood of confusion

- Two-part test for a likelihood of confusion
- Are the marks similar in:
  - Sound?                      Appearance?
  - Meaning?                      Commercial impression?
  - Similarity in any one of the above is sufficient.
- **Are the goods and/or services legally related?**
  - Consumers will mistakenly believe that the goods and/or services come from the same source.



# Common substantive refusal: Section 2(e)(1) merely descriptive



Strength of a mark determines its registrability and protectability.



Fanciful/arbitrary

Suggestive

Descriptive

Generic



- **Fanciful, arbitrary, and suggestive marks** – Higher probability of registration and easier to protect against third party infringement
- **Descriptive marks** – Often used in the marketplace to describe a characteristic or quality of the product or service
- **Generic marks** – Incapable of serving as a source indicator and not registrable

# Examples of strong marks

## Fanciful

Invented words



## Arbitrary

Actual words but don't convey any association with the goods and/or services

Apple



 BlackBerry

## Suggestive

Suggest a quality or an intended/desired effect of the goods and/or services

**COPPERTONE**

for suntan lotion

**DRI-FOOT**

for deodorant for feet

**EVEREADY** for batteries

uspto

# Other common substantive refusals

- Section 2(e)(4) primarily merely a surname
  - MILLER LAW GROUP is primarily merely a surname for legal services
- Section 2(e)(2) primarily geographically descriptive
  - DENVER WESTERNS for western-style shirts originating in Denver
- Section 2(c) name, portrait, or signature of a living individual or deceased U.S. president without consent
- Section 2(a) false suggestion of a connection; deceptive

# Common procedural requirements

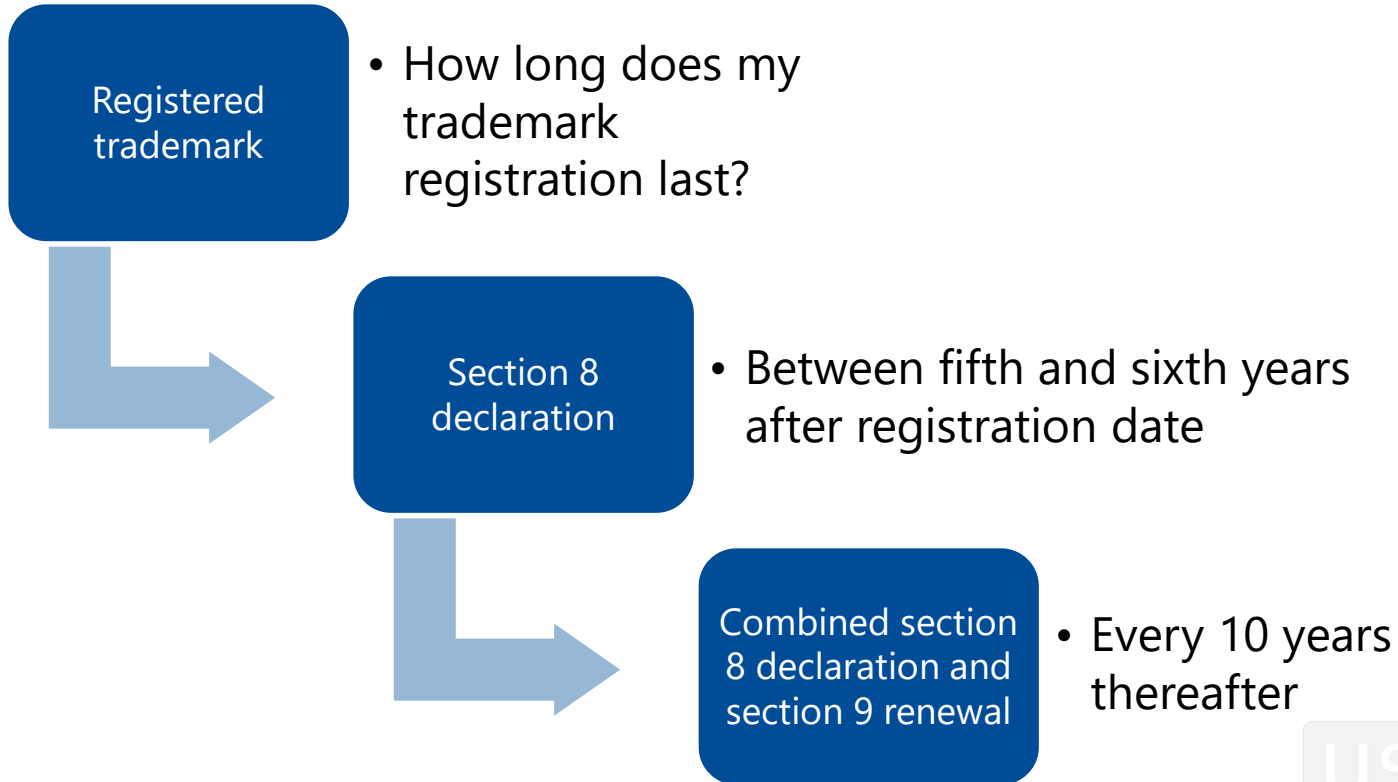
- Drawing issues
  - Mark description, color claim
- Translation and transliteration
- Entity type and citizenship
- Identification
  - Indefinite wording, overly broad language, incorrect class

# During the examination process

Know your deadlines:

- Six months to file a Response to Office Action
- Six months to file an Appeal to the Trademark Trial and Appeal Board (TTAB) following a Final Office Action
  - Applicant may file one or more Requests for Reconsideration prior to appeal and one or more Requests for Remand during appeal.
- The USPTO cannot grant requests to extend deadlines for responding

# Maintaining your trademark



# Trademark filing and response tips

- Consider strength, protectability, and registrability when selecting your mark.
- Research the proposed mark before you file.
- Identify the correct owner of the mark.
- Register for a myUSPTO.gov account.
- Use the ID Manual to draft an acceptable identification of goods and/or services at <https://idm-tmng.uspto.gov/id-master-list-public.html>.
- Respond to communications from the examining attorney.
  - Authorize examiner's amendments where possible.
- Information submitted becomes public record.
  - Avoid sending confidential information.








# Trademark application filing process

For additional help and information:

- Watch the TEAS Nuts and Bolts videos at [www.uspto.gov/trademarks-getting-started/trademark-basics/teas-nuts-and-bolts-videos](http://www.uspto.gov/trademarks-getting-started/trademark-basics/teas-nuts-and-bolts-videos)
- Review our Basic Facts Booklet at [www.uspto.gov/sites/default/files/documents/BasicFacts.pdf](http://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf)
- See our trademark basics videos at [www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos](http://www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos)



# Helpful resources

-  **TESS** - Trademark **E**lectronic **S**earch **S**ystem - Search online for registrations/pending applications.
-  **TEAS** - Trademark **E**lectronic **A**pplication **S**ystem - Apply online and file other forms and responses.
-  **TSDR** - Trademark **S**tatus and **D**ocument **R**etrieval system - Check the status of applications and registrations, and view or download copies of documents in their electronic files.
-  **TMEP** - Trademark **M**anual of **E**xamining **P**rocedure - Research the rules and procedures that govern the examination process.
-  **TMIN** - Trademark **I**nformation **N**etwork videos - View online instructional videos.

# Important contact information

- **For general trademark questions:** call or email the Trademark Assistance Center (TAC) at 800-786-9199 or [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) (M-F, 8:30 a.m. to 8 p.m. ET)
- **For technical difficulties** with the TEAS online forms: email [TEAS@uspto.gov](mailto:TEAS@uspto.gov) (M-F, 8 a.m. to 8 p.m. ET)
- **For general trademark petition questions:** call 571-272-8950 (M-F, 9 a.m. to 5 p.m. ET)



**USPTO resources**

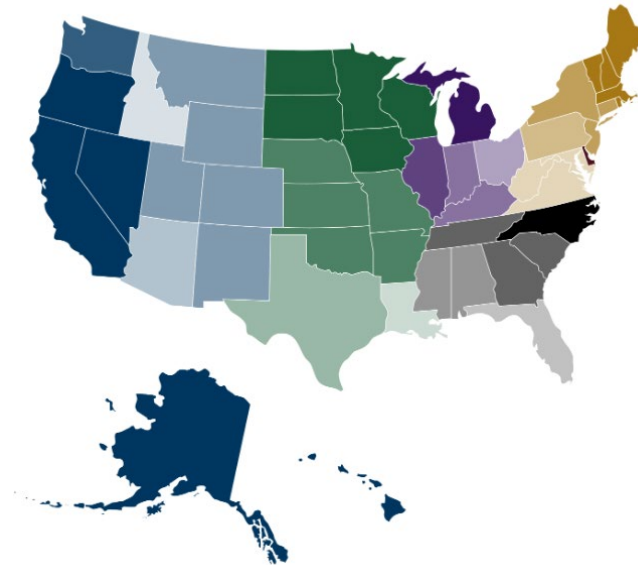
# USPTO Patent Pro Bono Program

Nationwide network that assists financially under-resourced independent inventors and small businesses.

- Coverage in all 50 states achieved and maintained since August 2015
- Program participants must:
  - Have income of 300% below federal poverty guidelines
  - Pay USPTO filing fees and costs
  - Demonstrate knowledge of the patent system
  - Take training course at [www.uspto.gov/video/cbt/certpck/index.htm](http://www.uspto.gov/video/cbt/certpck/index.htm)
  - Have application prescreened to ensure that there is more than an idea



# Pro Bono Program organizations



- |                                      |                                      |                              |
|--------------------------------------|--------------------------------------|------------------------------|
| ■ Washington Pro Bono Patent Network | ■ Gateway Venture Mentoring Service  | ■ New York Tri State Program |
| ■ Idaho Patent Pro Bono              | ■ TALA                               | ■ Delaware Program           |
| ■ CLA                                | ■ The Ella Project                   | ■ FCBA (Mid-Atlantic)        |
| ■ ProBoPat                           | ■ Chicago-Kent Patent Hub            | ■ PA Patent                  |
| ■ Arizona Public Patent Program      | ■ PatentConnect for Hoosiers (IN KY) | ■ NC Leap                    |
| ■ LegalCorps (MN)                    | ■ Ohio Invents                       | ■ Georgia Patents            |
| ■ Pro Bono Patent Project (MI)       | ■ BBVLP Patent Program (MS AL)       | ■ Patent Pro Bono FL         |
|                                      | ■ New England Program                |                              |

# Pro Bono Program for Texas

- TALA Patent Pro Bono Program
  - Located in Austin, Texas
  - Programs designed to help participants apply sound business practices to protect intellectual property, advance careers, and develop income
  - Expanded service to include helping qualified inventors and small businesses to obtain pro bono access to registered patent professionals
  - Contact executive director – Alissa McCain at [centraltexas@talarts.org](mailto:centraltexas@talarts.org)



# Law school clinics

- USPTO's Law School Clinic Certification program allows law students enrolled in a participating law school's clinic program to practice before the USPTO under the guidance of a law school faculty clinic supervisor.
- Students gain experience drafting and filing either patent applications or trademark applications for clients of the law school clinic.



USPTO

# Law School

CLINIC CERTIFICATION PROGRAM



# Law school clinics in Texas

- Baylor Law School
  - [iplawclinic@baylor.edu](mailto:iplawclinic@baylor.edu)
- South Texas School of Law
  - [patent@stcl.edu](mailto:patent@stcl.edu); [trademark@stcl.edu](mailto:trademark@stcl.edu)
- Southern Methodist University Dedman School of Law
  - [patentclinic@smu.edu](mailto:patentclinic@smu.edu); [trademarkclinic@smu.edu](mailto:trademarkclinic@smu.edu)
- Texas A&M Law School
  - [patents@law.tamu.edu](mailto:patents@law.tamu.edu); [trademarks@law.tamu.edu](mailto:trademarks@law.tamu.edu)



# Patent and Trademark Resource Centers (PTRC)

Nationwide network of public, state, and academic libraries that are designated by the USPTO to disseminate patent and trademark information and to support intellectual property needs of the public.

[www.uspto.gov/ptrc](http://www.uspto.gov/ptrc)





# Thank you!

[TexasRegionalOffice@uspto.gov](mailto:TexasRegionalOffice@uspto.gov)

(469) 295-9000

[www.uspto.gov](http://www.uspto.gov)