



## Trademarks: What they are and why they're important

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### Definitions

Trade and service marks have both technical and practical meanings.

#### Trademarks

Technically, a trademark is any word, phrase, image, symbol, or design (or any combination of these elements) that distinguishes the products of one manufacturer from the products of others in the marketplace. Trademarks are often described as identifying the source of products in the minds of consumers.

#### Service Marks

Service marks operate in similar fashion, distinguishing one provider of services from another, and identifying the source of particular services in the minds of consumers. Throughout this discussion, the term "trademark" will refer to both trade and service marks unless otherwise noted.

#### Copyrights and Patents

Although trademarks are a type of "intellectual property," they should not be confused with copyrights and patents. Copyrights protect particular expressions of ideas, with titles, names, short phrases, slogans, familiar symbols, and designs specifically excluded. Patents protect original inventions that have utility, feature unique designs, or consist of new plant varieties.

#### Trade Names

Nor should trademarks be confused with trade names. A trade name is the full legal name of your company - Azure Pleasure Cruises, Inc., or Five Figs, LLC. It appears on letterhead, contracts, mailing lists, and the like. Although it identifies the name of your company, it does not act as a mark unless you use the entire company name as a mark. Most companies do not. McDonalds, Inc. uses the mark "McDonalds." International Business Machines, Inc. uses the mark "IBM" and so on.

In practice, trademarks are far more than sterile legal concepts - they operate as an ambassador for your company's vision and values in the marketplace, forming the foundation of powerful brands. If cultivated properly, trademarks can become extremely valuable assets.

#### Acquisition

In the United States, **trademark rights** are acquired primarily through use. A trademark is "used" when it is affixed to, or used in close connection, with product or product packaging.

### **Example:**

Tempton, Inc., a manufacturer of specialty fruit drinks, uses its mark "Five Figs," on individual drink packages and jar labels, and on shipping boxes and crates.

A **service mark** is used when it appears on materials, such as advertisements and promotional literature, that describe the nature of the services.

### **Example:**

Azure Pleasure Cruises places its mark "Azure Pleasure" on brochures describing its various Caribbean and Arctic cruise services.

Trademark rights can also be acquired before use, by filing an "Intent to Use" application with the United States Patent and Trademark Office ("USPTO"). As explained in more detail below, the Intent to Use application (or "ITU") allows you to acquire a date of use based on an intent to use the mark, so long as that intent is in good faith, and you ultimately do use the mark.

## **Benefits of Federal Registration**

Using a mark without registering it - known as a "common law" mark - does give you certain rights, including the right to prevent later use of confusingly similar marks in geographic areas where you conduct business.

Federal registration with the USPTO, however, can give you far greater rights.

- 1) Exclusive, nationwide rights to your mark - even if you operate only in a specific geographic area.
- 2) The right to place the ® symbol after your mark.
- 3) Putting other parties, including competitors and other who might wish to use the same or a similar mark, on notice that you own the mark.
- 4) The right, after five years of continuous use, to make your rights to the mark incontestable - meaning that it can no longer be challenged by parties claiming prior rights to a confusingly similar mark.
- 5) In a lawsuit:
  - a) A presumption that you are the valid owner of the mark (a legal concept meaning, in most cases, that you won't have to prove that you own the mark; the court will presume, on the basis of the registration, that it is true.
  - b) The right to recover triple damages from any party found to have infringed your mark, plus attorney fees.

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## Names that can and cannot be trademarked

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The naming effort involves so many business and creative factors - does the name sound good? does it communicate our company's vision? - that it's easy to lose sight of the legal criteria that can determine whether your name achieves trademark status.

The USPTO has a series of rules governing the types of names that can and cannot be trademarked. These rules can be very hard to apply. They are highly subjective, and it is often difficult to articulate why a name falls into one category rather than another. As a result, you should use these rules as general guidelines only.

Click on a term in the table below for more details.

| Type of term                                                                                                                                                                | Trademarkable?                                                                                      | Examples                                                                                                                     |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------|
| 1) <u>Generic</u>                                                                                                                                                           | No                                                                                                  | "California Vineyards" for a winery located in California                                                                    |
| 2) <u>Merely descriptive</u>                                                                                                                                                | No (unless you can prove that customers associate the term with your specific products or services) | "Breadspred" for jellies and jams                                                                                            |
| 3) <u>Suggestive</u>                                                                                                                                                        | Yes                                                                                                 | "Coppertone" for tanning products                                                                                            |
| 4) <u>Arbitrary</u>                                                                                                                                                         | Yes                                                                                                 | "Penguin" for books                                                                                                          |
| 5) <u>Fanciful or coined</u>                                                                                                                                                | Yes                                                                                                 | "Exxon"                                                                                                                      |
| 6) <u>Geographically descriptive</u>                                                                                                                                        | No (unless you can prove that customers associate term with your specific products or services)     | "California Pizza Kitchen"                                                                                                   |
| 7) <u>Surname</u>                                                                                                                                                           | No (unless you can prove that customers associate term with your specific products or services)     | "Peterson's Plumbing"                                                                                                        |
| 8) <u>Deceptive</u>                                                                                                                                                         | No                                                                                                  | "Organik" for clothing made from non-organic cotton                                                                          |
| 9) <u>Miscellaneous</u> (immoral or scandalous, disparaging, suggestion of false connection, national flags and symbols, likeness of living persons or deceased presidents) | No                                                                                                  | "Bo Ball" for a sports ball suggests false connection with Bo Jackson.<br>"Red Cross" may only be used by American Red Cross |

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## Names that can and cannot be trademarked: Generic terms

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## What are they?

Generic terms name a type of product or service rather than a specific product from a specific manufacturer (or a specific service of a particular provider).

## Examples:

- "California Vineyards" for a winery located in California.
- "Video Buyer's Guide" for a magazine.
- "Web Communications" for consulting in the area of Internet communications.
- "Cable Ty" for ties used to bind cables.
- "Carryout Cafe" for a cafe offering take-out food.
- "Replica Gaslights" for replicas of historical gaslight fixtures.

## Can they be trademarked?

No. Generic terms can never be trademarked, no matter how well known a particular name might be. If it were otherwise, the terms would be unavailable for use by competitors to describe their own goods and services.

An existing, distinctive, mark can become generic through use. Escalator, Thermos, Aspirin, Trampoline, and Kerosene all began their lives as distinctive, unique marks, but lost their trademark status through generic use by consumers - using the term to describe a category or type of goods rather than the specific goods themselves.



## Names that can and cannot be trademarked: Merely descriptive names

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## What are they?

"Merely descriptive" terms immediately, and with some specificity, describe a feature, function, use, purpose, ingredient, or characteristic of goods or services. Although the line between this type of mark and a generic mark is a fine one, there is a difference. Generic marks name the product itself; its type, or category. Merely descriptive marks hone in to describe a feature or use of the product rather than the product itself.

## Examples:

- ▶ "Breadspred" as a mark for jellies and jams is merely descriptive because a characteristic of jellies and jams is that they can be spread on bread.
- ▶ "Mouseklip" is merely descriptive of clips used to hold a mouse cord in position on a desk.
- ▶ "Lasergraft" is merely descriptive of surgical hair transplantation services because a feature of the service is the use of lasers to graft hair.
- ▶ "Featherlite" as a mark for gloves is merely descriptive because minimal weight was a characteristic of the gloves' lining.
- ▶ "Net Entertainment" is merely descriptive of magazines covering interactive entertainment on the Internet (or "net").

## Can they be trademarked?

Generally no. A merely descriptive name cannot be registered as a federal trademark unless its owner can demonstrate that, due to long use in the market or extensive publicity and advertising, consumers have

come to associate the term with the owner as the source of particular goods or services rather than the goods or services themselves. This change in consumer perception is known as "acquired distinctiveness" or "secondary meaning," and can be extremely difficult to prove, with the burden growing as the descriptiveness of the mark increases. Acquired distinctiveness is frequently demonstrated through use of customer surveys and evidence of spending on advertising and publicity.

Although each case is decided on its own facts, several general rules hold true:

- ▶ Even if a term has several different meanings, it remains "merely descriptive" so long as one of its meanings is descriptive of the goods at issue.

Example: "Web Graphics" for a company specializing in Internet graphics is merely descriptive, despite the fact that the phrase also describes graphics resembling or inspired by a spider's web.

- ▶ A term does not need to describe all qualities or features of a product to be merely descriptive - describing one prominent feature or characteristic is enough.

Example: "Limo Care" is merely descriptive of automotive repair services, even though applicant repairs more than limousines.

- ▶ Images can be merely descriptive if they depict an important feature or characteristic of the goods.

Example: a visual depiction of a scuba tank is merely descriptive of underwater diving tour services.

- ▶ Superlative or laudatory terms used to attribute excellence to a product or service - "best," "super," and "exquisite" are examples - are nearly always merely descriptive, and do not make an otherwise descriptive mark distinctive.
- ▶ Creative misspellings do not make a descriptive term distinctive. Example: "C-Thru" is equally as descriptive of transparent rulers as "see through," the words it misspells.
- ▶ A descriptive term remains descriptive even if expressed in a foreign language.

Example: "Caffe Sorbetto," a mark used for the ingredients of mocha and coffee flavored soft drinks, is merely descriptive because its Italian terms mean "coffee sorbet."

- ▶ Otherwise descriptive components can be combined to form distinctive marks if done in an inventive or unexpected manner.

Example: "Sugar & Spice" is not merely descriptive of bakery products, despite the fact that each term individually describes ingredients of baked goods, because the phrase "sugar & spice" is part of a familiar nursery rhyme. That element of creative invention is enough to prevent the mark from being merely descriptive.

Determining whether a mark is merely descriptive is an extremely difficult and highly fact-specific task. Marks that seem descriptive may in fact be suggestive, and vice versa. Unless you are absolutely certain that your mark is merely descriptive, do not abandon hope. The trademark examiner assigned to your case may decide that the mark is suggestive, or, if the examiner decides against you, a good attorney may

prevail with a similar argument. See "[Post-application events and issues](#)" for more information.

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### What are they?

Rather than providing an immediate description of a product's use or features, suggestive marks evoke and suggest positive associations for, or attributes of, the product. As a result, some degree of thought or imagination is required to comprehend the nature of the goods or services.

### Examples:

- ▶ "Coppertone" for tanning products.
- ▶ "Greyhound" for bus services.
- ▶ "Mustang" for automobiles.
- ▶ "Esprit" for clothing.
- ▶ "Passion" for perfume.

### Can they be trademarked?

Yes. Suggestive marks are considered inherently distinctive, and can thus be registered without a showing of acquired distinctiveness.

As mentioned earlier, the line between merely descriptive and suggestive marks is a fine, and hotly contested, one. If there is any doubt whether a mark is merely descriptive or suggestive, the USPTO decides in favor of the applicant. Therefore, do not discount a mark that seems to be merely descriptive unless it is obviously so. You may ultimately succeed in registering it.

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## What are they?

Arbitrary marks are common words used in unexpected and completely non-descriptive ways.

## Examples:

- ▶ "Camel" for cigarettes
- ▶ "Apple" for computers
- ▶ "Sun" for computers
- ▶ "Penguin" for books (Note: "penguin" would be suggestive if applied to refrigerators)
- ▶ "Arrow" for shirts
- ▶ "Amazon" for Internet book and product sales

## Can they be trademarked?

Yes. Like suggestive marks, arbitrary marks are inherently distinctive, and require no demonstration of acquired distinctiveness to achieve registration. More importantly, arbitrary marks are considered very strong by the courts, and are entitled to a greater scope of protection against infringement and likelihood of confusion than suggestive marks.

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## What are they?

Fanciful terms are invented words whose only purpose is to identify particular goods or services.

## Examples:

- ▶ "Exxon"
- ▶ "Kodak"

## Can they be trademarked?

Yes. Fanciful marks share the advantages of arbitrary marks: they require no showing of acquired distinctiveness to be registered, are extremely strong, and are entitled to a significant scope of protection against infringement.

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### What are they?

A term whose primary meaning describes the geographic source of your products or services. The geographic meaning must be the primary sense of the word, e.g., California, Alabama, or Albany. Words such as Mobile, with secondary geographic meanings, do not violate this rule.

### Examples:

- ▶ "California Pizza Kitchen"
- ▶ "Texas Steakhouse & Saloon"
- ▶ "The Nashville Network"
- ▶ "Nantucket Nectars"

### Can they be trademarked?

No, unless you are able to demonstrate acquired distinctiveness.

If a mark contains a primarily geographic term but the product or service does not originate from that place, it cannot be registered under any circumstances. This type of mark carries the ungainly title of "primarily geographically deceptively misdescriptive."

### Examples:

- ▶ "Durango" for tobacco not produced in Durango, Mexico.
- ▶ "New England" for baked goods not produced in New England.
- ▶ "California Mix" for mixed nuts not originated or produced in California.

## Exceptions to the rule:

- ▶ Geographic locations that have no possible commercial connection to the products or services, or are so remote or obscure that consumers are not apt to associate them with commerce.

Examples: "South Pole" for fruits and vegetables; "Tapatio (a region in Mexico)" for hot sauce; "Vittel (a region in France)" for cosmetics.

- ▶ Geographic terms that are used to describe a particular style or type.

Examples: Swiss Cheese, and Philadelphia Cheese Steak.

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### What are they?

Terms whose **primary** use is as a surname.

### Examples:

- ▶ Peterson's
- ▶ Knowles'
- ▶ Moore's

### Can they be registered?

No, not without a showing of acquired distinctiveness. The prime example is McDonald's for fast food restaurant services. If the term's primary meaning is not as a surname - Hunt, Bird, Tailor, Major - registration can be attained without evidence of acquired distinctiveness.



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## What are they?

Terms that falsely describe product or service characteristics and are material to a consumer's buying decision.

## Examples:

- "Lovee Lamb" for seat covers not made of lambskin.
- "Organik" for clothing made from non-organic cotton.
- "Silkease" for clothing not made from silk.
- "Cedar Ridge" for siding not made from cedar.
- "Blanc de Chine" for new porcelain lamps and figurines, where the term "blanc de Chine" designates antique porcelain from a particular historical period, and the products named are not from this period.

## Can they be trademarked?

No, never, regardless of whether acquired distinctiveness is shown.

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### What are they?

#### *A) Immoral or Scandalous Terms*

### What are they?

Terms that have immoral or scandalous meanings or connotations.

### Can they be trademarked?

No, even with a showing of acquired distinctiveness. The USPTO is not prudish, however. Marks that are in bad taste can be registered. The following marks were allowed:

- "Friggin" for refrigerator magnets
- "Bad Frog" for beer, where graphic depicted a frog "flipping the bird."
- "Big Pecker Brand" for t-shirts, where graphic depicted a large bird.

#### *B) Deceptively Misdescriptive Terms*

### What are they?

If a mark both misdescribes a product or service and consumers are apt to believe the misdescription, then the mark is deceptively misdescriptive.

### Examples:

- "Cameo" for jewelry not featuring cameos.

### Can they be trademarked?

No, unless the owner can demonstrate acquired distinctiveness. If the product feature or characteristic that is misdescribed is material to a consumer's buying decision, then the mark becomes deceptive and can never be registered, regardless of whether it acquires distinctiveness. See Deceptive Terms.

### ***C) Terms that Disparage, Falsely Suggest a Connection with, or Bring a Person, Institution, Belief or National Symbol into Contempt or Disrepute***

#### **What are they?**

Not surprisingly, this category includes terms that disparage, falsely suggest a connection with, or bring a person, institution, belief, or national symbol into contempt or disrepute.

#### **Examples**

- ▶ Graphic mark with "X" superimposed over a hammer and sickle would bring national symbol of USSR into disrepute.
- ▶ Graphic mark depicting a greyhound-like dog defecating would bring Greyhound's similar mark into disrepute
- ▶ "U.S. Aqua" for drinking water falsely suggests a connection with the U.S. Government. (As evidence of how fact-specific these cases can be, the PTO decided in a separate case that "U.S. Health Club" could be registered)
- ▶ "Bo Ball" for an oblong leather ball falsely suggests a connection with Bo Jackson
- ▶ "Westpoint" for shotguns falsely suggests a connection with the U.S. Military Academy.

#### **Can they be trademarked?**

No, never.

### ***D) Terms consisting of or containing Flags, Coats of Arms, or Other Sovereign Insignia***

#### **What are they?**

As the title indicates, this category includes marks that consist of or contain a flag, coat or arms, or other insignia of the United States, or a state, municipality, or foreign country.

#### **Can they be trademarked?**

No, never.

### ***E) Terms and Images Protected by Statute***

#### **What are they?**

Certain terms and graphic images are reserved by statute to the U.S. government and cannot be used by others.

#### **Examples:**

- ▶ The greek red cross insignia, which only the American Red Cross may use.
- ▶ Name of agencies, such as the FBI and CIA.

### **Can they be trademarked?**

No, never.

### ***F) Marks containing the Name, Portrait, or Signature of a Living Individual or Deceased U.S. President***

What are they?

Marks that contain the name, portrait, or signature of a particular living individual, or of a deceased United States President during the lifetime of his widow.

### **Examples**

- ▶ "Prince Charles" for meat products.
- ▶ "Eisenhower" for greeting cards.

### **Can they be registered?**

No, unless consent is given by the individual or the president's widow.

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### ► Post-Application Events and Issues

Your trademark application has been submitted. What happens now? Post-application events can be divided into several time periods:

- A) [USPTO Review](#) - The Patent and Trademark Office reviews your application for mistakes and conflicts with existing marks.
- B) [Approval and Registration](#) - The PTO approves your application.
  - 1) Intent to Use
  - 2) Actual Use
- C) [Post-Registration](#) - Steps necessary to keep your mark active.

### A) PTO Review

- For about a month, nothing will happen - your application will sit at the USPTO awaiting entry into the system. Once entered, your application's status can be tracked, and you will be able to keep tabs on its progress from your account page. In addition, the USPTO will send you updates and notices of actions via postal mail.
- Next, your application will be assigned to an Examiner who will review it for the following:
  - technical compliance - e.g., whether all of the fields are properly filled out; and
  - substantive problems - e.g., whether it is merely descriptive or confusingly similar to an existing mark.

The Examiner's review can take up to six months (although they often complete it sooner).

- An Examiner may make several types of comments about your application:

### Technical Comments

These comments pertain to the form of your application, and can often be corrected through a telephone discussion with the Examiner.

## 1) Missing or Inaccurate Information

If you've left any fields blank in your application - an email address, fax number, or country of citizenship - the Examiner will want them to be completed before the application is fully processed.

## 2) International Class

- a) **Incorrect Class** -- If the Examiner believes that you've selected an incorrect class for your goods or services, he or she will suggest a different one.
- b) **Multiple Classes** - If your description of goods and services falls into more than one class, the Examiner will ask you either to:
  - i) Limit your goods and services to one class by amending your description; or
  - ii) Pay the additional fees necessary to register the mark in more than one class.

## 3) Indefinite Description of Goods and Services

If an Examiner finds that your description of goods and service is not specific enough, he or she will typically suggest an alternative description. You can resolve any problems of this type by discussing the issue with the Examiner on the telephone.

## 4) Specimens

- a) The Examiner will also let you know if the mark reflected in your specimen doesn't match the mark described in the application.

### **Example:**

"Ace Shoelaces" is the mark described in your application, but the specimen you include as proof of actual use contains the mark "Ace's Shoelace."

What do you do? It depends on where the mistake was made. If your specimen was incorrect, submit a new specimen with a mark that matches your application. If your specimen uses the mark correctly, amend the application to match the specimen. You may amend the mark itself so long as you don't change the essence or commercial impression of the mark - known as a "material alteration."

### **Examples:**

Changing "NY Jewelry Outlet" to "New York Jewelry Outlet" was not a material alteration.

Adding a house mark "Pierce" to "Chik'n-Bake" to form "Pierce's Chik'n-Bake" was a material alteration.

- b) The Examiner may find that the specimen of use you submitted fails to show use on the goods or services described in your application.

**Example:**

You claim use of the mark "Big Bad Chicken Little" for casual clothing (products) and retail clothing sales (services) but your specimen only shows use of the mark on a t-shirt. In this case, to satisfy the Examiner you will have to submit an additional specimen showing use of the mark to advertise or promote your retail clothing services.

**5) Prior Registrations**

If you have existing trademark registrations, the Examiner will ask you to disclose these in your application, thereby establishing that you are the common owner of the marks and avoiding any chance that one of your own marks will be raised as confusingly similar to the mark in your application.

**Substantive Rejections**

There are two major types of substantive rejections:

**1) Likelihood of Confusion**

The Examiner may find that your mark is likely to be confused with an existing mark or application. If so, the Examiner will refuse to register your mark.

Because the issue of whether one mark is confusingly similar to another is very complex, we strongly recommend that you obtain an attorney's assistance in responding to this type of rejection.

**2) Merely Descriptive**

The Examiner may also find that your mark is merely descriptive of the goods or services set forth in your application.

We also recommend that you obtain an attorney's assistance in responding to this type of rejection.

**B) Approval and Registration**

- ▶ Once all objections to your application have been resolved, it will be published for opposition in the USPTO's Official Gazette. For a period of 30 days, it will be subject to opposition by any party with a claim that registration of the mark would damage them.
- ▶ If anyone does oppose your application - typically because they believe it is confusingly similar to their own mark - we recommend, once again, that you seek the assistance of an attorney. Opposition proceedings are conducted like litigation and really do require an attorney's expertise.

**1) Intent to Use**

- ▶ If no one opposes your ITU application - or if an opposition is resolved in your favor - the Examiner will issue, and send you by post, a Notice of Allowance. This means that your mark is ready for registration, and will obtain full registration once you submit proof of actual use.

How do you submit proof of use? One of two ways:

#### **a) Amendment to Allege Use**

As noted above, it can take over six months for your application to be approved for publication. If, during this time, you actually begin using your mark, you can submit proof of this use by filing an Amendment to Allege Use. Note: To comply with USPTO rules, the amendment can only be filed on or before the day the Examiner approves the mark for publication. Once the mark is published, and until the Examiner issues a Notice of Allowance, no allegations of use are permitted - a black-out period applies. This black-out period can be lengthy, particularly if your application is opposed. Before filing your proof of use, check the status of your mark from your Account Page to ensure that the black-out period is not in effect.

#### **b) Statement of Use**

Once a Notice of Allowance has issued for your mark, the black-out period is lifted and you can submit proof of use by filing a Statement of Use. You must submit a Statement of Use within six months of the Notice of Allowance or obtain an extension. Extensions are available in six-month increments. Each extension after the first requires a showing of good cause - a specific description of your ongoing efforts to use the mark. A general statement that efforts are ongoing is not sufficient.

You may not receive more than five six-month extensions. At the very latest, use must be shown no more than 36 months after the Notice of Allowance is issued.

### **2) Actual Use**

- ▶ If no one opposes your Actual Use application, the Examiner will issue a Certificate of Registration - congratulations, your mark is now registered! Follow the steps in the next section to ensure that it stays active.

## **C) Post-Registration**

### **1) Formal Requirements**

Registration is not the end of the story. You must make periodic filings to maintain your mark's registration. If you fail to make these filings on time, your mark will be at risk of cancellation. Note: Your Account Page keeps track of these submission deadlines, letting you know when and what you need to file.

#### **a) Section 8 & 15 Affidavits**

A "Section 8" affidavit lets the USPTO know that you are still using your mark, and must be filed at the following times:

On or between the fifth and sixth year following your mark's registration; and

On or between the ninth and tenth year following registration; and

Each ten year anniversary thereafter.

A "Section 15" affidavit attests that you have been using the mark continuously for five consecutive years, and requests that the USPTO make the mark "incontestable." The label is less than accurate. Although your mark doesn't actually become "incontestable," it does become more powerful and more resistant to attack.

The Section 15 affidavit can be filed any time on or between the fifth and sixth anniversary of continuous use of the mark.

Since this date often coincides with the first Section 8 filing, the two filings are often combined as a single filing.

Note: Even if you haven't used the mark continuously, and thus are not able to file a Section 15 affidavit right away, you will still need to timely file a Section 8 Affidavit to ensure your mark's continued registration.

## **b) Section 9**

Every ten years you must renew your mark's registration. A Section 9 statement accomplishes this task. It is often combined with the Section 8 affidavits as a single filing.

## **2) Practical Requirements**

In addition to the foregoing formal requirements, remember the following:

- a) *Use your mark.* Continuing use is critical to maintain your trademark rights.
- b) Once registered, use the "®" symbol. Doing so increases your chances of recovering money damages should it become necessary to sue another party for infringement.
- c) Be vigilant. Protect your mark by acting when necessary to stop infringers.

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