

UNITED STATES
PATENT AND TRADEMARK OFFICE



Trademark basics boot camp: Registration process overview

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Trademark basics boot camp

- Reminders:
 - This session is being recorded.
 - The slides will be emailed after the presentation.
 - Captioning is available.
 - Post your questions to the Q&A box.

Discussion topics

- Trademark basics
- Application workflow and timeline
- Post-registration workflow overview
- How to find help

Discussion topic

Trademark basics



Trademark basics (cont'd)

- Trademark
 - Identifies the source of goods and services.
 - Distinguishes them from the goods and services of another party.
 - Provides legal protection for a brand.



Trademark basics (cont'd 2)

- Remember:
 - You are not “buying” a trademark.
 - Not every trademark is registrable.
 - Filing fees are not refundable.

Discussion topic

Application workflow and timeline

Application workflow and timeline

(cont'd)





Application workflow and timeline

(cont'd 2)

- Applicant conducts clearance search.
 - USPTO database
 - Federally applied-for and registered trademarks
 - www.uspto.gov/SearchTrademarks
 - The internet
 - Option for searching for common law use



Application





Application workflow and timeline

(cont'd 3)

- Applicant files new trademark application.
 - Trademark Center
 - Guided user interface
 - Drafts that automatically save every 60 seconds
 - Application costs that update as you go
 - Prompts to complete commonly omitted information



Application

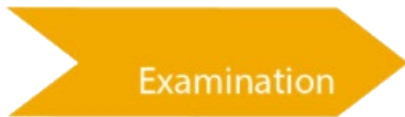




Application workflow and timeline

(cont'd 4)

- USPTO issues filing receipt.
 - Prepares application for review.

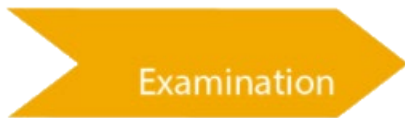




Application workflow and timeline

(cont'd 5)

- Examining attorney reviews application.
 - Occurs about 6-7 months after application filed.
 - Takes action within 7 days of beginning review.

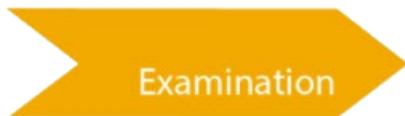




Application workflow and timeline

(cont'd 6)

- Applicant responds to office action.
 - Typically required within 3 months of issuance of office action
 - One 3-month extension available per office action

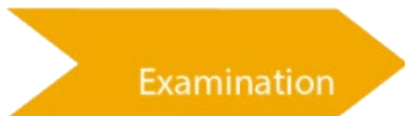




Application workflow and timeline

(cont'd 7)

- Examining attorney reviews response.
 - Takes action within 28 days of receipt.

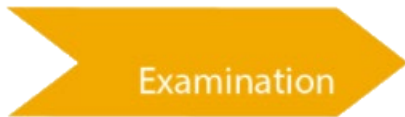




Application workflow and timeline

(cont'd 8)

- Applicant responds to final office action.
 - Options:
 - Submit request for reconsideration.
 - Appeal to Trademark Trial and Appeal Board (TTAB).
 - Submit request for reconsideration and file appeal.

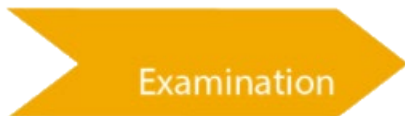




Application workflow and timeline

(cont'd 9)

- Applicant responds to final office action.
 - Typically required within 3 months of issuance of office action
 - One 3-month extension available per office action

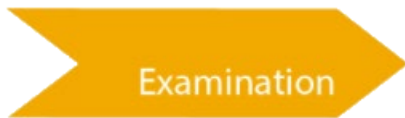




Application workflow and timeline

(cont'd 10)

- Examining attorney reviews request for reconsideration.
 - Takes action within 28 days of receipt.

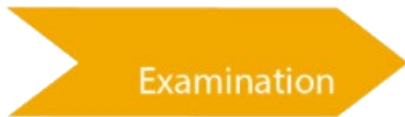




Application workflow and timeline

(cont'd 11)

- Option: TTAB decides appeal.
 - Typically renders decision in about 10 months.





Application workflow and timeline

(cont'd 12)

- Examining attorney approves application for publication.
 - Occurs at any point in the review process.





Application workflow and timeline

(cont'd 13)

- USPTO publishes application.
 - Trademark appears in Official Gazette.
 - Begins 30-day opposition period.





Application workflow and timeline

(cont'd 14)

- USPTO moves application forward.
 - If application based on use in commerce:
 - Issues registration certificate.
 - If application based on intent-to-use:
 - Issues Notice of Allowance (NOA).

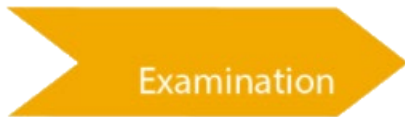




Application workflow and timeline

(cont'd 15)

- Applicant files Statement of Use (SOU).
 - Required within 6 months of issuance of NOA
 - Option:
 - May file an extension request, if trademark is not yet in use in commerce.

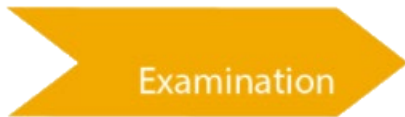




Application workflow and timeline

(cont'd 16)

- Option: Applicant files extension request.
 - Required within 6 months of issuance of NOA
 - Allowed to file up to 5 requests
 - SOU due by end of last extension request period

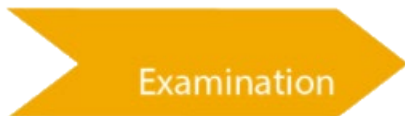




Application workflow and timeline

(cont'd 17)

- Examining attorney reviews SOU.
 - Takes action within 28 days of receipt.





Application workflow and timeline

(cont'd 18)

- USPTO issues registration certificate.





Application workflow and timeline

(cont'd 19)

- Reminders
 - Check your application regularly for deadlines.
 - If you miss a deadline, examining attorney will abandon your application.



Application workflow and timeline

(cont'd 20)

- Abandoned application
 - Ends USPTO's review of application.
 - Option:
 - File a "Petition to revive."

Application workflow and timeline

(cont'd 21)

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Section 1(a) timeline

Application based on use of your trademark in commerce

Place your mouse over the steps for more information.

```
graph TD; A[1. Application filed] -- "See current wait times" --> B[2. USPTO reviews application]; B -- "About 1 month" --> C[3a. USPTO approves and publishes trademark]; B -- "OR" --> D[3b. USPTO issues letter (office action)]; C -- "About 3 months" --> E[4a. You submit timely]; D -- "Within 3 months" --> F[4b. You do not respond]; E -- "OR" --> F;
```



Knowledge check #1

Does submitting an application guarantee federal registration of your trademark?

Yes

No



Knowledge check #2

If the USPTO refuses to register your trademark, does that mean your trademark can never be registered?

Yes

No





Knowledge check #3

Does publication of your trademark mean that it is registered?

Yes

No

Discussion topic

Post-registration process overview



Post-registration requirements

- Required filings
 - Section 8 declaration of use
 - Due between 5th and 6th years after registration
 - Combined Section 8 declaration of use and Section 9 application for renewal
 - Due between 9th and 10th years after registration
 - Then due every 10 years thereafter



Post-registration requirements (cont'd)

- Optional filing
 - Section 15 claim of incontestability
 - May be filed after five years of continuous use.



Post-registration process overview

- Post-registration audit program
 - Allows cancellation of registrations.
 - Allows deletion of goods and services from other registrations.

Post-registration process overview

(cont'd)

Trademark basics boot camp: Keeping your registration alive

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Knowledge check #4

If your trademark registers, does federal registration last forever?

Yes

No

Discussion topic

How to find help

Caution: scam alert

- Beware of scams.
 - www.uspto.gov/TMFraud
- Beware of non-attorney filing firms.
 - www.uspto.gov/trademarks/protect/filing-firms
- Beware of misleading notices and offers.
 - www.uspto.gov/TrademarkSolicitations



USPTO resources

- Website
 - www.uspto.gov
- Trademark videos
 - www.uspto.gov/TMvideos
- Trademark basics registration toolkit
 - www.uspto.gov/TrademarkBasicsToolkit



USPTO resources (cont'd)

- IP Identifier
 - <https://ipidentifier.uspto.gov>
- Free services and resources
 - www.uspto.gov/FreeServices
- USPTO virtual assistant
 - www.uspto.gov/trademarks/basics





USPTO resources (cont'd 2)

- Trademark Assistance Center
 - Main support center for all trademark customers
 - Phone: 1-800-786-9199 (press 1)
 - Email: TrademarkAssistanceCenter@uspto.gov

USPTO resources (cont'd 3)

- The USPTO does not:
 - Provide legal advice.
 - Enforce legal rights.
 - Recommend specific private attorneys.



Legal resources

- Remember:
 - The best resource is an experienced trademark attorney.
 - Most trademark filing companies can only provide limited services.



Questions?



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