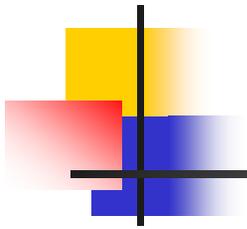


The U.S. Patent and Trademark Office

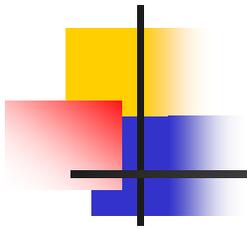
Overview of Trademarks

- Cynthia Henderson
- Attorney-Advisor
- Office of Intellectual Property Policy and Enforcement
- (571) 272-9300
- Cynthia.henderson@uspto.gov



Topics

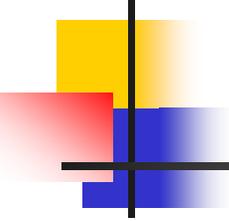
- International Standards of Protection under TRIPS
- Introduction to Trademark Protection in the United States
- Procedures to Obtaining a U.S. Federal Trademark Registration
- Examination Issues (most common refusals)
- Madrid Protocol



Article 15, TRIPS

- Any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.

Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs shall be eligible for registration as trademarks."

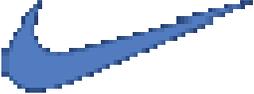


Definition of a Trademark

- Any word, name, symbol or device (or any combination thereof) used to identify and distinguish goods or services and to indicate their source



Types of Trademarks

- Word Marks KODAK
- Design Marks 
- Composite Marks containing both words and design



Unusual Trademarks

- Shape: Bottle shape for soda pop
- Color: Pink color for insulation
- Sound: Three chimes sound for television broadcasting services
- Scent: Plumeria flower blossom scent for sewing thread
- Motion: Flying pegasus for movie studios



Types of Trademark Protection in the U.S.

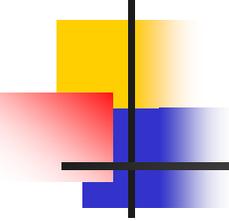


- Common Law
 - protection derived from use
- State Registration
 - registered with one or more U.S. states
- Federal Registration
 - registered in the United States Patent and Trademark Office

Statutory Authority

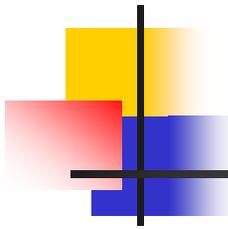
- The Federal Trademark Registration Act of 1946, known as the Lanham Act (or Trademark Act) provides the statutory framework for federal examination and registration of trademarks





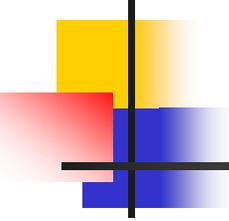
Federal Registration of a Trademark

- Provides notice to others of marks in use in commerce in the U.S.
- Provides access to the federal courts
- Provides prima-facie evidence of ownership
- Provides access to anti-counterfeiting statutes
- Permits enforcement of rights
- Provides a basis for foreign filing



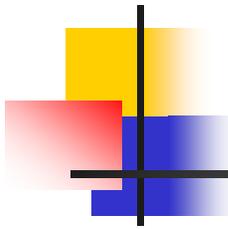
Registration May be Applied To:

- trademark associated with goods or products
- service mark associated with the delivery of services
- certification mark associated by the characteristics of someone's goods or services
- collective mark indicated by membership in an organization



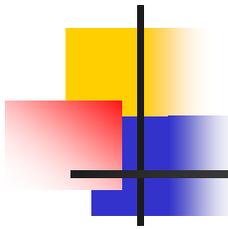
Applications May be Filed Based on:

- Existing use of the mark in commerce
- Intention to use the mark in commerce
- Foreign application or registration



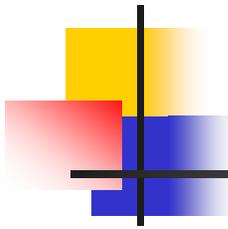
Principal Trademark Office Functions:

- Maintain the federal register of trademarks
- Perform initial processing and preliminary examination of applications for registration
- Examine trademark applications under the law
- Publish and Issue trademark registrations
- Provide search and information resources to provide notice of trademarks in use
- Provide policy support, propose and implement new rules, provide employee training, interpret and apply trademark law, practice and procedure



Trademark Application filings

- 2006 = 354,775 applications were filed at the USPTO
- 9.7% Increase from 2005
- 147,118 trademark registrations issued, 188,899 classes



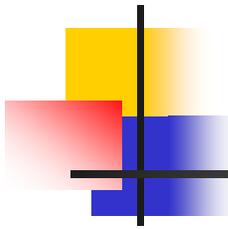
Trademark Pendency Rates

- Examination = **4.8 months** after filing (average pendency)
- Trademark Final Action Pendency = **18 months** after filing

Trademark Office Mission

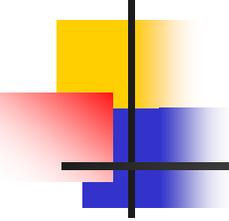
- Our mission is to register trademarks
 - The Trademark Act provides that “*no trademark shall be refused registration on the Principal Register unless...*”





Examination Process at USPTO

1. File Application.
2. Examination by Examining Attorney – Allowed, Amended, or Refused.
3. If Allowed, Notice of Allowance and publication in the *Official Gazette*.
4. If Refused, appeal to the Trademark Trial and Appeal Board.
5. If Refusal is affirmed:
 - Appeal to U.S. District Court *de novo*; or
 - Appeal to Federal Circuit on administrative record.



Examination Process at USPTO

6. The Office of the Solicitor defends Director of USPTO in ex parte appeals of TTAB decisions.
7. After publication, Opposition period. Both parties (Opposer and Applicant) have right to appeal the TTAB decision.
8. If no Opposition, Registration issues.
9. Cancellation proceeding available to cancel a registration. Both parties have right to appeal TTAB decision. In general, USPTO not involved in inter partes appeals of TTAB decision.

POST-REGISTRATION REQUIREMENTS

Requirements in the First Ten Years

First Filing: A Declaration of Continued Use or Excusable Nonuse, filed between the 5th and 6th years after the registration date.

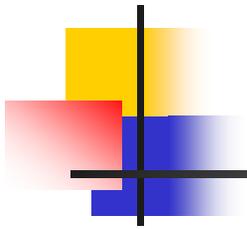
Second Filing: A Combined Declaration of Continued Use or Excusable Nonuse and an Application for Renewal*, filed between the 9th and 10th years after the registration date.

*For Registrations under §66(a), only a Declaration of Use is required. Renewal must be made at the International Bureau, under Article 7 of the Madrid Protocol.

Most Common Grounds for Refusal

- Likelihood of Confusion
- Lack of Distinctiveness





Article 15, TRIPS

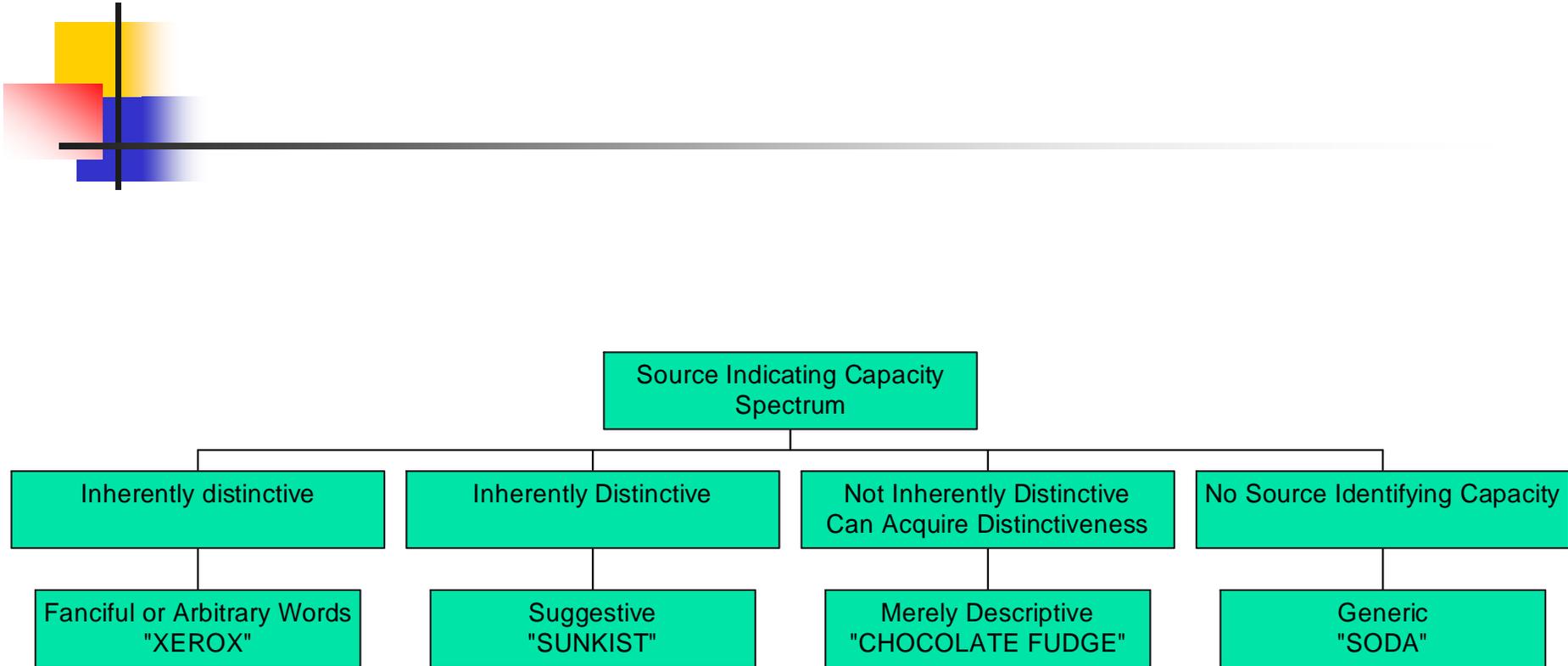
- “Any sign, or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.”

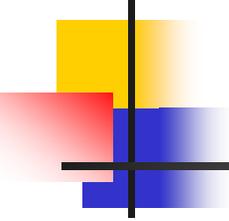
U.S.: Section 2(e)(1) of the Lanham Act

“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register . . . unless it . . . consists of a mark which, when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them. . . .”



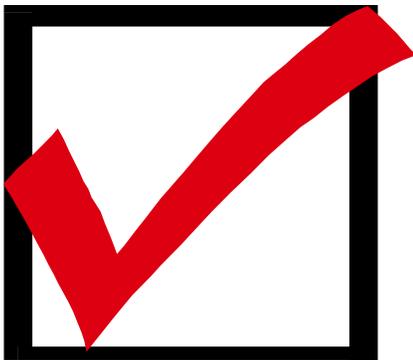
Capable of Distinguishing Goods or Services?

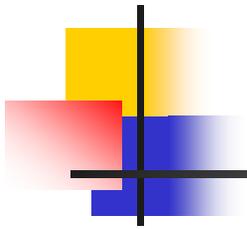




The Merely Descriptive Test

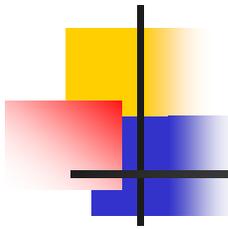
- A proposed mark is merely descriptive if it describes any significant aspect of the goods/services
 - Purpose
 - Characteristic
 - Quality
 - Use/Users
 - Ingredient
 - Function
 - Feature





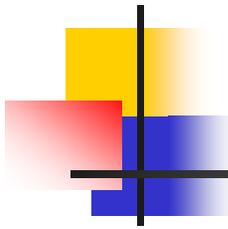
TRIPS Article 16

- “The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods and services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.”



U.S.: Section 2(d) of the Lanham Act

“No trademark . . . shall be refused registration . . . unless it . . . so resembles a mark registered in the Patent and Trademark Office . . . *as to be likely, when used on or in connection with the goods [or services] of the applicant to cause confusion, or to cause mistake, or to deceive . . .*”



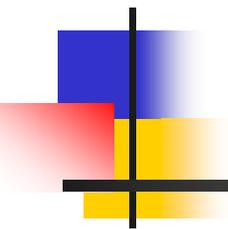
2-part Test for Likelihood of Confusion

COMPARE THE MARKS

- Identical Marks
- Similar Marks
 - Sound
 - Appearance
 - Meaning

COMPARE THE GOODS/SERVICES

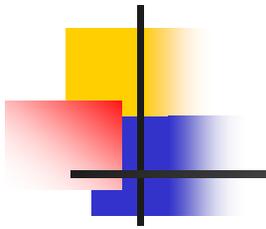
- Identical Goods/Services
- Relatedness of Goods/Services
 - Similar types
 - Use of the goods/services together
 - Channels of Trade/Marketing



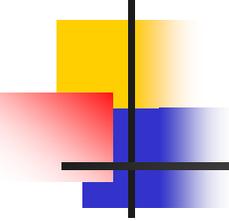
The Madrid Protocol:

A "One-Stop" filing system

The Madrid Protocol: What is it?



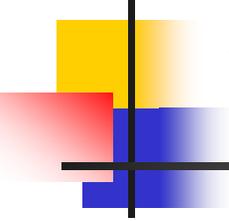
- The Madrid Protocol is an International Trademark Filing Treaty.
- The Protocol was adopted in 1989 and began operating as an international filing system in 1996.
- The US joined on November 2, 2003.
- As of July 2007, the Protocol currently has 73 member countries—called Contracting Parties.



What does it do?

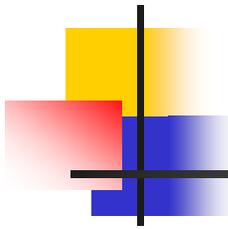
The Madrid Protocol permits a trademark owner in a Contracting member-state to:

- Potentially file a single application, in English, French or Spanish, and seek registration in any or all of the Contracting Parties to the Protocol.
- There is no need to file individual applications in each of those 73 countries.



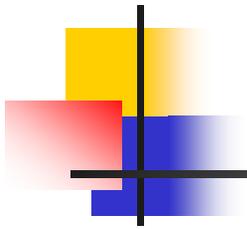
What does it do?

- After rights are granted in any of those Contracting Parties
 - Assignments for any or all of the rights in any or all of the contracting parties can be effected by filing a single document with WIPO
 - Renewal of all rights can be effected by the payment of a single fee at WIPO



Foreign Trademark Owners

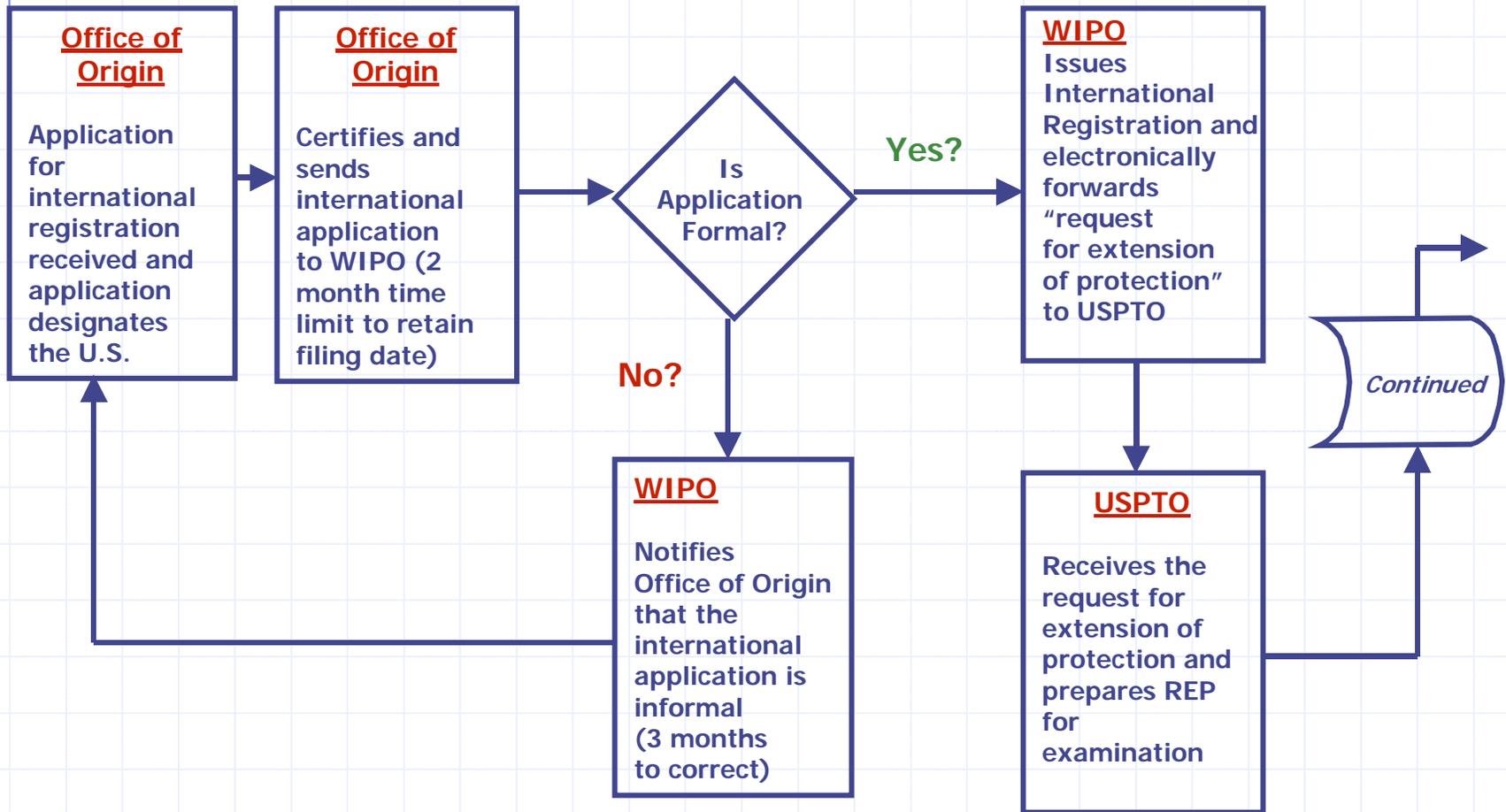
How **you** can use the Madrid Protocol to
Obtain Protection in the United States



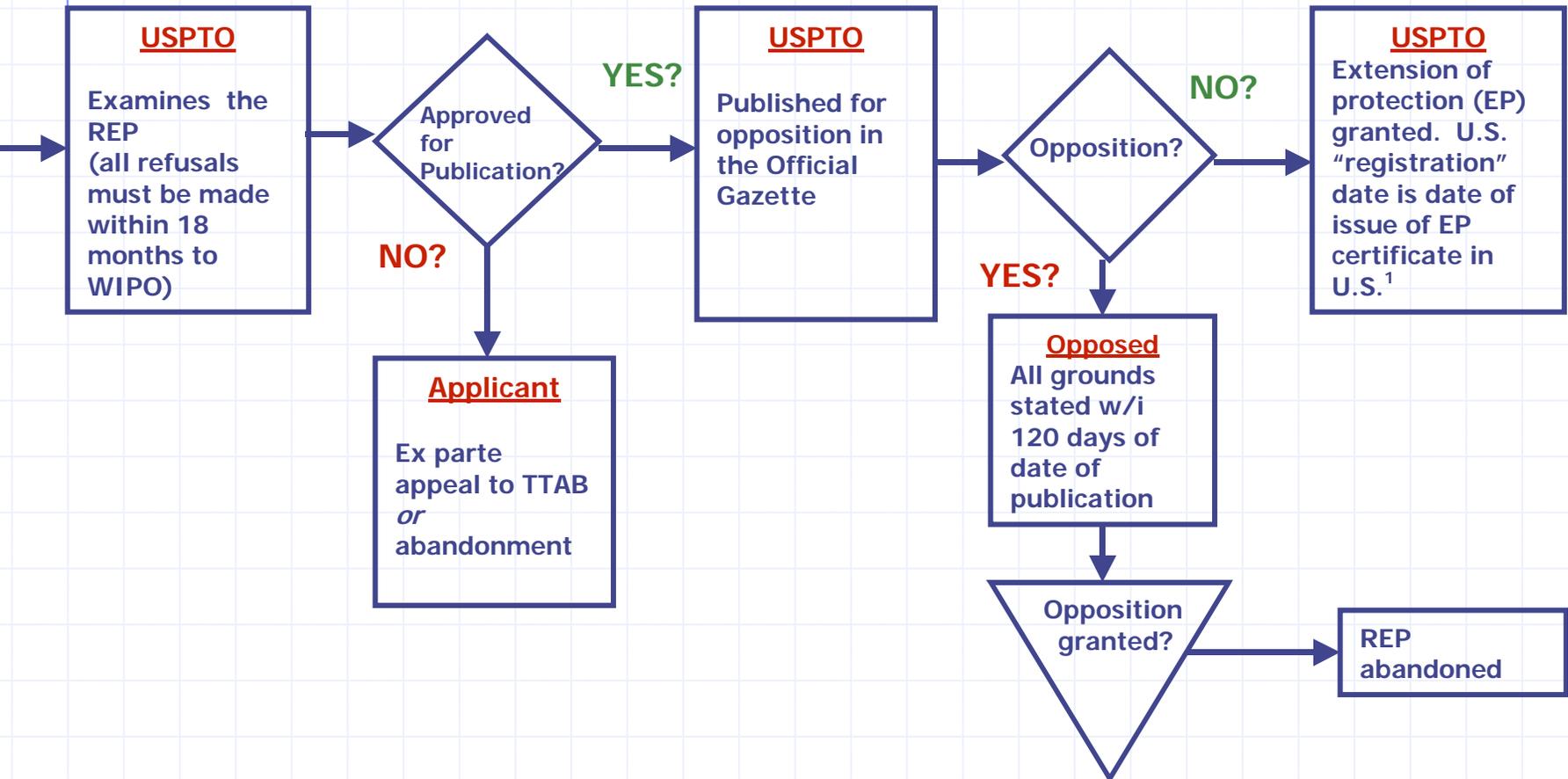
Requests for Extension of Protection (REPs)

- The owner of an international registration may request “extension” of its international registration to the United States
- The International Bureau of WIPO will send requests for extension of protection (REPs) to the USPTO

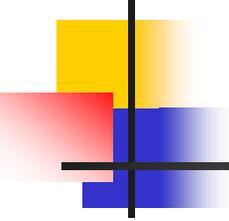
Process: Foreign Applicant Seeking Protection through the Protocol in the U.S.



Process: Foreign Applicant Seeking Protection through the Protocol in the U.S.

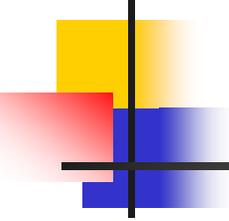


1. Protocol registration date is either: (a) date of international registration, or, (b) date of extension request.



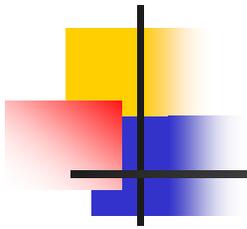
Myth about Madrid Protocol

- Adverse impact on local trademark practitioners –
 - Local trademark practitioners believe that they will lose business if foreign applicants stop using the national trademark systems for filing applications



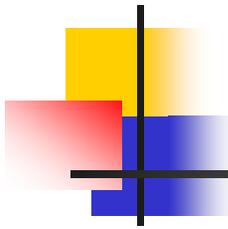
Madrid Protocol Benefits:

- **In reality**, local trademark owners will need advice on filing their international applications.
- **Concerning** incoming REPs, if the national office refuses the REP filed by an owner in another Madrid Member, local counsel in the domestic market will be needed to handle the prosecution before the national office.



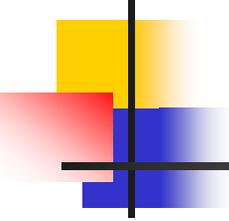
Benefits of Madrid Protocol

- In short, under the Protocol, the workload for local counsel on incoming REPs shifts away from filing trademark applications to later in the prosecution process.
- If more countries were to adopt the Protocol, more trademark applications would be filed worldwide and the workload for local counsel worldwide would increase as trade expands.



Benefit of Madrid Protocol

- Offers trademark owners a simple, time saving and cost effective way to seek registration in a large number of countries, by allowing trademark applicants streamlined access to protection in each other's jurisdictions, thus facilitating trade in those goods and services bearing such marks.



Electronic Access to Trademark Information

TEAS – electronic filing

File applications for registration, intent to use and post registration electronically; respond to office actions – pay on-line

TDR – Access all pending and most registered files

includes full file contents and examiner actions

TARR – Registered and pending trademarks

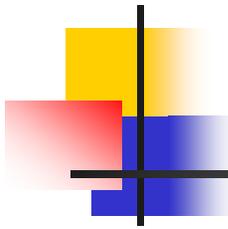
status of over 1.3 million Trademarks

TESS – Search marks and application/registration information

more than 2 million marks active/non-active

Official Gazette – Weekly issue of marks published for opposition, registered and renewed

most current 5 weeks available on-line



Apply “On-Line”

- Trademark application form is available on-line (Trademark Electronic Application System or TEAS)
- Three ways to pay: credit card, automated deposit account or electronic funds transfer.
- Forms may be printed & mailed

Trademark Electronic Application System *file online*



The United States Patent and Trademark Office (USPTO) is pleased to present TEAS - the Trademark Electronic Application System. TEAS allows you to fill out a form, check it for completeness, and then submit the form directly to the USPTO over the internet, making an official filing on-line.

Scheduled Outage Notice

Due to a system upgrade TEAS forms will be unavailable from 08:00 a.m. to 10:00 a.m. on Saturday, Feb. 26, 2005. During this scheduled outage period, we cannot guarantee site resources or completion of online activities. We apologize for any inconvenience this may cause.

NOTE: New Filers are encouraged to review [Where Do I Start](#) information before beginning the application process.

Up-Coming Enhancements

- Trademark Document Retrieval. *New 01/26/2005*
- Response form for Section 66(a) filings. *New 01/31/2005*
- Fee Change Notice. *New 12/28/2004*
- Expanded Image File Types. *Updated 01/05/2005*

Important Notices

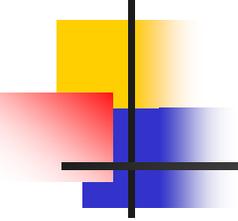
- Paper Filings. *Updated 11/02/2004*
- Form Session Time Limit.
- Ensuring Receipt of All Information.
- Keeping Data When "Backing Up" in Forms.
- Eastern Time Controls Filing Date.

Forms

Click here for [TEAS TECHNICAL INFORMATION](#), [TEAS TUTORIAL](#) (step-by-step instructions for filing your application directly over the Internet), and [ELECTRONIC FILING TIPS](#) *New*.
Click below to access the correct form:

Trademarks

- [Apply for a NEW mark](#)
- [File a PRE-registration Form](#)
 - File Preliminary Amendment
 - File Extension of time or Allegation of Use/Statement of Use
 - File form after receiving your Notice of Allowance (NOA)
 - File Request to Delete Section 1(b) basis, Intent to Use *New*
- [File a POST-registration form or Renew an Existing Registered Mark](#)
- [Response to Office Action Form](#)
- [Change of Address Forms](#) *New*
- [Express Abandonment Form](#) *New*



Thank you!
