

## U.S. TRADEMARK REGISTRATION PREP SHEET

Before applying for a registration with U.S. Trademark Office, you should be very comfortable that there is no one else using your proposed mark or a similar mark or if there is another user, that its use is in an unrelated area of commerce and the mark is not well-known. If you need assistance with trademark use research before going through the registration process, you should consider a trademark search by a specialist firm. If you engage us and provide the details of the mark that you wish to register, we can facilitate a search by a third-party search firm such as Clarivate Analytics. If you prefer, you can engage them directly or contact any other trademark search firm that you might know or find on the internet. This link should lead to the Thomson website if you want to review the information they provide about search services:

<http://compumark.thomson.com/do/pid/109>

The U.S. registration application requirements for a simple word service or goods mark are specific and rigidly enforced by the Trademark Examiners. After checking for other use, if you decide to proceed with registration, you will need to assemble the following items for the application:

- (1) Full legal name and address of the owner and if it is a business entity, the type (corporation, partnership, LLC, etc.), state, and date of official organization. NOTE: The owner should be the same as the user of the mark - if the owner is not using the mark but is allowing the use of the mark by someone other than the owner, a license agreement is necessary between the owner and the user.
- (2) The mailing address of the owner if different.
- (3) The trademark that you want to register as it is used by you, including all the words and other elements. If the mark is a design or has design elements such as a symbol, logo or color, a "drawing" of the mark is also required. The drawing *must* be in .JPG format and must consist of the mark *only* without any other words, symbols, pictures, or other matter.
- (4) The date when the trademark was first "used in commerce anywhere," meaning when it was first put on the goods being sold to the public or, in the case of a service mark only, on a brochure or advertisement for the services, and the goods or services were provided or distributed to persons buying the goods or services. For goods, the mark is "in use" when there is an actual sale to an arm's-length buyer. For services, "use" occurs when the mark is displayed prominently with publicity or descriptive material provided to consumers of the services and there is a sale of the services.
- (5) The date when the trademark was first used in "interstate commerce," i.e., a sale of the goods was made out of the state. For services, this date could be when the services were first marketed and sold to customers outside the owner's state of residence by mailing, website, etc. If the applicant company has rendered services outside of the state of residence using the mark, the date of that use would be a date of first use in interstate commerce. **Use in interstate commerce is required before a registration will be issued.**
- (6) A specimen showing the mark as it is used in association with the goods or, for a service mark, as used in promotional materials to describe the services or advertise them to persons purchasing them or considering a purchase. The specimen should be provided as an electronic file in .JPG or .PDF format. The examiners will reject a bare logo or proof containing the word mark on the basis that it does not show the mark as used. The most common specimens for goods are labels or tags that prominently display the mark and are attached to or placed on the goods directly or on the packaging. For service marks, usually the specimens are website pages, brochures or

direct-mail leaflets actually used (no printer's proofs) to advertise the services or letterhead if the mark and relevant services are featured prominently.

(7) Descriptions of all the goods or services with which you are using the mark at this time. The examiners look for specificity and will reject overbroad or inclusive descriptions. Different types of goods and services fall into different trademark "classifications." The Trademark Office filing fees are based on the number of classes involved in the registration so it is less expensive to file in only one class, provided that it will result in sufficient protection. It also saves time and money to use the Trademark Office's database of pre-approved descriptions. You can look at that database on the Trademark Office website or, at your request, I will search it for similar goods and/or services and send you the results that I think most accurately correspond to your descriptions as I understand them.

If you have not started using your mark and you want to try to protect use of it with goods or services that you are not currently selling in interstate commerce, we can file what is called an "intent-to-use" application alleging that you will be using the mark with the described services or goods in the next six months. The six-month period to make a first use of the mark with the described goods or services can be extended if the intent to use is certified as *bona fide* by the applicant and efforts or preparations are being made to use it. There are fees for filing extension requests in the Trademark Office. The application based on intent-to-use will be deemed abandoned if a first use is not made within the period allowed as extended for up to a maximum of five additional 6-month periods by the filing of further affidavits. If the intent-to-use application is of interest to you, we can confer about further details when you have engaged our services.

The initial fee paid to the Trademark Office for filing an electronic application through TEAS may be \$225.00 per class if you provide all of the information above, including the .JPG specimen ready for filing, and use an available description of the goods or services from the database as discussed above. If the application contains a novel description, the fee is \$275.00 per class. The fee can be \$400.00 per class if the application does not meet the Trademark Office standards for these reduced fees. If the filing needs to be made in more than one class, the filing fee is multiplied by the number of classes. Attorney's fees are separate and in addition to the filing fee.

Generally a mark that is a word or words should be registered without special fonts, capitalization, punctuation or appearance. A registration of a simple word in "standard characters" provides protection for more than one appearance and is usually preferred over registration of a special font or a logo. If you want to protect a particular appearance or color or a logo, a separate application is recommended and a drawing of the mark, separate from the specimen discussed above, must also be filed.

After you have engaged us on this project by signing an engagement letter and paying the advance requested in the letter and we have confirmed that there are no conflicts of interest, you can send the above information by e-mail to [jhuntington@eatonpeabody.com](mailto:jhuntington@eatonpeabody.com). We will review the information and contact you about the application within three days.

Please feel free to call us at (207) 622-3747 with any questions. You may also learn more by reviewing the helpful videos and general information for applicants that the U.S. Trademark Office has posted on its website at <http://www.uspto.gov/trademarks/index.jsp>.