

TRADEMARK PROSECUTION IN THE US

What can be registered as a Trademark?

In the US, a trademark may be registered for almost any means used by a business to distinguish its goods or services from those of competitors in the marketplace. Indeed, US trademark registration may be composed of one or more words, a graphic design, a unique form of packaging, colours, sounds, scents and flavours or any combination thereof.

Where are Trademarks Registered?

In the US, trademarks may be registered on a federal register or on the register for an individual state. Trademarks may only be registered on a federal register if they are used in commerce that crosses state and/or international borders. As few Canadian clients are concerned about state registrations, these comments are restricted to the federal registers.

At the federal level, there are two registers available in the US: (1) the Principal Register; and (2) the Supplemental Register. A registration on the Principal Register is preferred where available.

The Supplemental Register is a secondary federal register where descriptive trademarks may be registered that are not yet eligible for registration on the Principal Register. It is intended to reserve rights to such marks where they are already being used, but have not had time to become distinctive of the applicant through extensive use in the market.

Unlike registrations on the Principal Register, a registration on the Supplemental Register is not entitled to any presumption that it is valid, that it identifies the correct owner or that the mark is being used in commerce. On the other hand, a registration on the Supplemental Register does grant the registrant the right to sue for TM infringement in the US, the right to use the ® symbol and will act as a bar to registration of any confusingly similar marks on either the Principal or the Supplemental Register.

After a descriptive mark has been registered for

several years on the Supplemental Register, an application for registration on the Principal Register may be accepted if there is sufficient evidence that the mark, although descriptive, has become distinctive of the applicant through extensive use in the marketplace.

What is the Classification System?

Unlike Canada, the US requires that all the goods and services identified in an application be assigned to one of 45 possible classes. The US requires the payment of a separate application fee for each class of goods and/or services contained in an application.

For instance, a retail sporting goods outlet with its own house brand for products may have a trademark application that covers four classes, namely retail sales services (Class 35), clothing (Class 25), sports equipment (Class 28) and luggage (Class 18).

Four application fees will be required for this single application identifying goods and services which fall into four different classes. The current US application fee is \$325.00US per class.

To avoid paying multiple application fees, many applicants will remove some of the identified classes of goods and/or services that may be considered secondary to their main business activities from their US applications, either before or after filing.

What are the Available Grounds for an Application?

US trademark applications can be filed on the basis of:

- a. actual use of the trademark in the US;
- b. an intention to use the trademark in the US;
- or
- c. a foreign trademark registration or pending application combined with an intention to use the trademark in the US.

Like Canada, the US adheres to an international treaty which regulates the orderly filing of trademark applications in multiple countries. This treaty stipulates that if a trademark application is

filed in any foreign country within six months after the first application is filed for the same mark, the foreign application will be effectively backdated to the filing date of the first application.

Accordingly, trademark applications filed in the US may also claim a priority filing date from a pending Canadian trademark application for the same mark, if filed less than 6 months earlier. This allows the US application to assert priority, for a period of 6 months, over any intervening applications that may have been filed in the US after the filing date for the corresponding Canadian application.

What are Specimens?

Generally speaking, each trademark application filed in the US must be supported by specimens demonstrating proper use of the applied-for mark. At least one specimen must be filed for each class of goods or services identified in the registration.

For trademarks filed on the basis of foreign trademark registration or pending application, this requirement may be satisfied by instead filing a copy of the certificate of registration for the corresponding foreign trademark registration.

Specimens must show the mark as actually used:

- a. on or in connection with *goods*; or
- b. in the sale or advertising of *services*.

Please note that advertising material is generally NOT acceptable as a specimen for *goods*. For instance, advertisements, brochures, price lists, publicity releases, trade directory listings, letterhead, invoices and business cards are not acceptable as specimens for *goods* unless they comprise point-of-sale material. On the other hand, such specimens may be adequate specimens for *services*.

Acceptable specimens for *goods* include copies of tags, labels and packaging. Catalogs and web site pages may also be acceptable specimens for *goods* if they include an offer to accept orders or instructions on how to place an order.

Each specimen should be flat and no larger than 8 ½" x 11". Generally speaking, photocopies, photographs and other reproductions are adequate. If available, digital copies are preferred.

Is Registration Mandatory?

Like Canada, limited rights to a trademark may accrue through use in the marketplace in the US. However, it is highly recommended that trademark applications be filed.

Registration on the Principal Register in the US grants the owner the exclusive right to use the trademark across the US in association with the goods and services listed in the application. In addition to giving notice to the public of your exclusive right to the trademark, a registration is especially helpful in protecting that right when a dispute subsequently arises.

The professionals at Ballagh & Edward LLP are qualified to file applications in the United States.

When do Trademark Registrations Expire?

Like Canada, US trademark registrations may be maintained as long as the trademark remains in use. However, registrations do need to be renewed every ten years in the US.

In addition, for all new trade-mark registrations in the U.S., specimens must be filed between the 5th anniversary and the 6th anniversary to show that the registered mark remains in active use in association with the identified wares and services. If such evidence is not filed, the registration will be deemed to be abandoned.

What are the Steps to Register a Trademark in the US?

1. Formalities

First, your agent files the application with the United States Patent & Trademark Office ("USPTO"), usually via the Internet. If it is in order, complete and includes the filing fee, the application will receive a filing date and an application number from the USPTO. A filing receipt is usually delivered by email to your agent within 60 minutes after filing the application. The application will be entered on the US Trademarks Registry. The application is now described as 'Pending' and moves to step two.

2. Examination & Suspension

A trademark examiner will review the application, usually within 6 months after filing, and determine

if the trademark can be approved for advertisement in the *Official Gazette*. If it cannot be approved as filed, the examiner will issue a report setting out the objections. This report is also known as an “office action”.

Your agent may be able to amend certain aspects of the application so it can be approved. Your agent may also submit arguments responding to any substantive objections to the application. If submitted changes and/or argument are not acceptable, you may elect to abandon the application or it may be refused by the USPTO.

The examiner may also suspend an application when: (a) specimens are not yet available for an application filed on the basis of an intention to use; or (b) the certificate of registration for a corresponding foreign application is not yet available. When an application is suspended, examiners make routine inquiries as to the status of the corresponding foreign application about every six months. Generally, this six-month suspension period may be renewed up to four times (ie. 2 years).

The failure to respond to an examiner's report or suspension inquiry may result in automatic abandonment. When all of the examiner's objections have been overcome, the application is approved and a notice of publication is issued, moving the application to step three.

3. Advertising

The application will be published in an issue of the *Official Gazette* about two months after the notice of publication is issued. The *Official Gazette* is published weekly by the USPTO and is available for review via the Internet. Within one month after advertisement the application can be opposed by someone else and will then be removed from the normal processing cycle until the opposition has been resolved. See step four for what will happen if the application is opposed.

4. Opposition

If the application is opposed after being advertised in the *Official Gazette*, the Trademark Trial and Appeal Board will forward to your agent a copy of the notice of opposition. Should you wish to contest the opposition, your agent will have about one month to serve and file an answer. Both parties will, in turn, have an opportunity to file

affidavit evidence, conduct oral examinations and submit written arguments. If the opposition is withdrawn or is unsuccessful, the application will proceed to registration. See step five.

An opposition is a complex adversarial proceeding. Most proceedings are resolved during the course of the opposition, but a complete opposition may last more than two years and the legal fees incurred cannot be recovered from the opposing party.

5. Registration

If it is not opposed, the application will move to the final stage and a certificate of registration will be forwarded by mail, usually within 3 months after advertisement.

Where Can I Get More Information?

You can get more information by visiting the web sites for:

United States Patent & Trademark Office
www.uspto.gov

Or by contacting:

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