

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Trademark basics boot camp: Registration process overview

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UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Discussion topics

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

Discussion topics

# **Trademark basics**



# Trademark basics

A trademark is any word, symbol, design, or combination of those that:

- Identifies the source of goods

and

- Distinguishes them from the goods of another party



# Trademark basics

- **Trademark**
  - Indicates the source of goods or products.
- **Service mark**
  - Indicates the source of services.



# Trademark basics

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

Discussion topics

# **Application workflow and timeline**





# Application workflow and timeline

- Applicant conducts clearance search.
  - USPTO database
    - TESS (Trademark Electronic Search System)
    - [www.uspto.gov/SearchTrademarks](http://www.uspto.gov/SearchTrademarks)
  - The internet
    - Option for searching for common law use

# Application workflow and timeline

- Applicant files new trademark application.
  - Trademark Electronic Application System (TEAS)
  - [www.uspto.gov/TEAS](http://www.uspto.gov/TEAS)



# Application workflow and timeline

- USPTO readies application for review.
  - Occurs 1-2 weeks after application filed.
  - Issues filing receipt.



# Application workflow and timeline

- Examining attorney reviews application.
  - Occurs 3-4 months after application filed.
  - Takes action within 7 days of beginning review.



# Application workflow and timeline

- Applicant responds to office action.
  - Typically required within 6 months of issuance of office action



# Application workflow and timeline

- Examining attorney reviews response.
  - Takes action within 21 days of receipt.



# Application workflow and timeline

- Applicant responds to final office action.
  - Typically required within 6 months of issuance of office action
  - Response called a “request for reconsideration”
  - Option:
    - May also appeal final decision to the Trademark Trial and Appeal Board (TTAB).



# Application workflow and timeline

- Examining attorney reviews request for reconsideration.
  - Takes action within 21 days of receipt.





# Application workflow and timeline

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



# Application workflow and timeline

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



# Application workflow and timeline

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





# Application workflow and timeline

- 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

- 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

- 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

- Examining attorney reviews SOU.
  - Takes action within 21 days of receipt.



# Application workflow and timeline

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

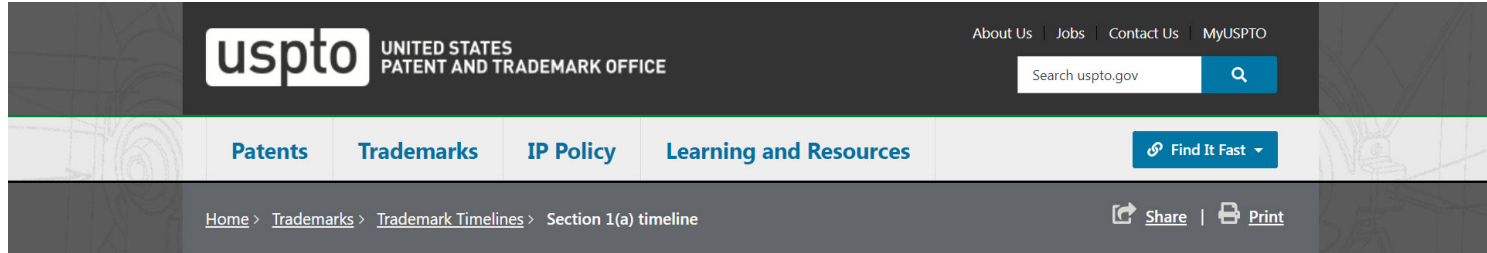




# Application workflow and timeline

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

# Application workflow and timeline



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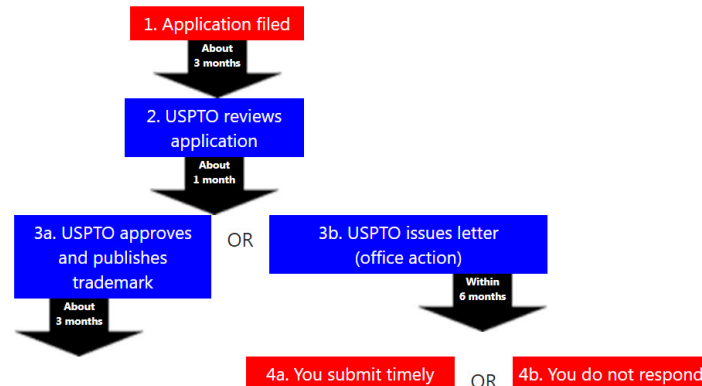
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## Section 1(a) timeline

### Application based on use of your trademark in commerce

Place your mouse over the steps for more information.



Discussion topics

# **Post-registration process overview**



# Post-registration requirements

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





# Post-registration requirements

- 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

## Trademark basics boot camp: Keeping your registration alive

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Discussion topics

# How to find help





# USPTO resources

- Website
  - [www.uspto.gov](http://www.uspto.gov)
- “Basic Facts About Trademarks” booklet
  - [www.uspto.gov/TrademarkBasicsPDF](http://www.uspto.gov/TrademarkBasicsPDF)
- Trademark videos
  - [www.uspto.gov/TMvideos](http://www.uspto.gov/TMvideos)





# USPTO resources

- Law School Clinic Certification Program
  - [www.uspto.gov/LawSchoolClinic](http://www.uspto.gov/LawSchoolClinic)



# USPTO resources

- Trademark Assistance Center
  - Phone: 1-800-786-9199
  - Email: [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)
  - Web: [www.uspto.gov/TrademarkAssistance](http://www.uspto.gov/TrademarkAssistance)



# USPTO resources

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



# Legal resources

- Remember:
  - Best resource might be an experienced trademark attorney.
  - Best resource might not be a trademark filing company.



# Legal resources

- Free or reduced-price legal services
  - American Bar Association
    - [https://www.americanbar.org/groups/legal\\_services/flh-home/](https://www.americanbar.org/groups/legal_services/flh-home/)
  - International Trademark Association
    - <https://www.inta.org/resources/pro-bono-clearinghouse/>



# Other resources

- Advice and business consulting
  - Patent and Trademark Resource Centers (PTRCs)
    - [www.uspto.gov/PTRC](http://www.uspto.gov/PTRC)
  - Small Business Development Centers (SBDCs)
    - <https://americassbdc.org/>

**Questions?**



