



Trademark Services



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Tennessee law requires DeSalvo Law Firm PLLC to inform you that this is an advertisement. The Tennessee Commission on Continuing Legal Education and Specialization does not offer certification as a specialist in the area of trademark law.

What are Trademarks and Service Marks?

A trademark is a word, phrase, symbol, or design, or a combination of such elements that identifies and distinguishes goods or services from another party's goods or services. Trademarks identify sources of tangible goods and service marks identify sources of intangible services. The same mark may function as both a trademark and a service mark, depending upon the nature of the goods and services offered.



Trademarks and service marks are often confused with copyrights and patents. Trademarks and service marks protect names, logos, slogans, etc. used to identify goods and services. Copyrights protect original artistic, literary, and other creative works. Patents protect inventions and other utilitarian creations.

Trademark Protection

Trademark law protects consumers from confusing one source of goods or services with those from another source. The mark's owner benefits from trademark law protections against consumer confusion. Trademarks and service marks often are the most valuable assets owned by companies.

Mark Formats

A mark can appear in one of three possible formats: (1) **standard character format** or a "**word mark**"; (2) a **stylized/design** format; or (3) **sound mark**. The standard character format is used to register words, individual or groups of letters, numbers, or combinations of such elements. In a standard character trademark application, the applicant makes no claim to any particular font style, size, color, or design elements. A standard character format generally provides its owner with the broadest rights, preventing other parties from using the same or a confusingly similar mark to identify the same or related goods or services in both standard text and stylized/design format.

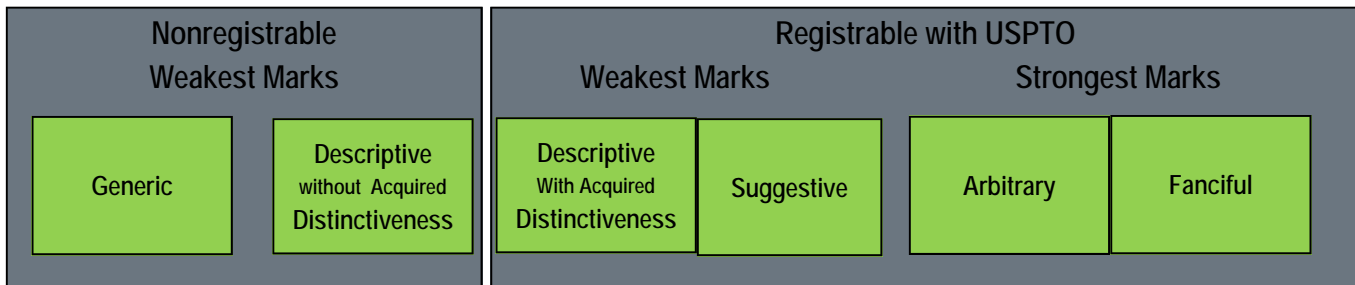
The stylized/design format is appropriate if the trademark applicant desires to register a mark containing a design element and/or words, letters, or numbers having a particular stylized appearance.

A sound mark is comprised of sounds. (Think: the tri-tone sound for "NBC")

The flat fees included later in this guide are for applications for standard character word marks in one class of goods or services. Additional attorney fees apply to applications for stylized/design or sound marks and/or applications identifying more than a single class of goods or services.

What Makes a Good Mark?

A mark may be generic, descriptive, suggestive, arbitrary or fanciful with the strongest mark being fanciful and the weakest being generic. A generic mark such as “Crackers” for crackers will not be afforded protection; however, “Crackers” may be a strong arbitrary mark for a night club. Descriptive marks convey some information about the characteristics of the mark. (e.g., “Light” for a lightweight computer) Suggestive marks suggest a quality or ingredient of the goods or services. (e.g. Coppertone® for sun tan oil) An arbitrary mark is a word typically found in a dictionary that bears no relation to the actual goods or services. (e.g. Apple® for computers) A fanciful mark is an invented word or “coined” words chosen to operate as a trademark. (e.g. Xerox®) Generic marks are not registrable. Descriptive marks may become protectable if they acquire a secondary meaning in the marketplace, i.e., when a consumer associates the word with the product or service. (e.g. Jacuzzi) Suggestive, arbitrary, and fanciful marks are inherently distinctive and need not acquire a secondary meaning to be registrable with the U.S. Patent and Trademark Office (USPTO)



Trademark Registration



Federal Registration of a mark with the USPTO is not mandatory and is not required to convey rights in a particular mark. One obtains rights in a mark based on **actual use of the mark in commerce**. Federal registration provides several advantages, including public notice of the registrant's claim of mark ownership, legal presumption of nationwide ownership, and the exclusive right to use the mark on or in connection with the goods or services specified in the registration.

To qualify for federal registration, a mark must be used in interstate or foreign commerce, not consist of immoral or deceptive matter, not resemble a registered mark, and not be functional. Generic terms can never become marks; however, fanciful, arbitrary, and suggestive marks, as well as descriptive marks with secondary meaning, are registrable with the USPTO. Marks that do not qualify for federal registration may be registrable in the states in which they are used.

Goods and Services Classifications

The USPTO follows the international classification of goods and services, grouping marks by the specific categories of goods or services to which they apply.

Goods and services classifications permit the USPTO Examining Attorney to focus on active federal marks in the relevant classes during the application review process. The application filing fee and certain other expenses vary depending upon the number of classes included in the application. Currently USPTO electronic application fees either are \$275 or \$400 per class of goods or services.

The flat fees referenced in this guide are for applications for standard character word marks in one class of goods or services. Additional attorney fees apply to applications for stylized/design or sound marks and/or applications identifying more than a single class of goods or services.

Clearance & Legal Opinions



Before adopting and/or attempting to register a mark, it is highly advisable to search federal and state trademark registrations, common law rights in unregistered trademarks, and trade names to determine if there are any prior conflicting rights. A proper clearance consists of two steps: (1) the preliminary or “knockout” search and (2) the full clearance search. The **knockout search** is used to identify obvious conflicting marks before spending time and money for a full clearance. For example, if a company

proposes to use the mark COCA-COLA to identify a new beverage, a preliminary search would quickly reveal a number of conflicting COCA-COLA® marks.

The **full trademark search** is more detailed and includes search criteria for identical marks, marks with variant spellings and phonetic equivalents, and similar marks from USPTO and state records. The full search also seeks conflicting common law, Internet uses, and domain name registrations. It is advisable to obtain a full clearance report from a recognized company specializing in comprehensive trademark searches. Before proceeding with the adoption and registration of a mark, it is important to have an attorney review the search report and render a legal opinion as to the proposed mark’s registrability. DeSalvo Law Firm PLLC generally retains Thomson CompuMark for full searches. A full clearance search for a word mark in the U.S. generally costs \$800.00, with additional charges for expedited searches, specialized searches (e.g. alcoholic beverages), design/stylized and composite marks, and searches in territories outside the U.S.

Even the broadest search cannot guarantee the absence of conflicting marks, particularly where others have unregistered common law rights. Broadening the search is particularly important as the Internet has made it possible for the smallest companies to have an international presence and establish worldwide use of a mark.

Application Process

Although the federal trademark application process (known as the **trademark prosecution**) is rarely uniform, the various stages in the trademark prosecution are standard. Generally, a trademark prosecution can take anywhere from a few months to more than a year from the filing of the application to the issuance of, or the refusal to issue, a registration certificate.

After the USPTO receives an application for registration and determines that the application meets the minimum filing requirements, the USPTO issues the application a unique serial number and assigns it to an **Examining Attorney**. This stage generally takes two to four months. Next, the Examining Attorney reviews the application and determines if it complies with trademark statutes and USPTO rules. Then, the Examining Attorney conducts a comprehensive application review including a search for conflicting marks in the USPTO system and a detailed examination of the application.



If the Examining Attorney determines that the mark should not be registered, an Office Action will issue that explains the substantive legal reasons for refusing the registration, and/or any technical or procedural deficiencies in the application. If the application requires only minor corrections, the Examining Attorney may contact the applicant or the applicant's attorney to discuss the necessary correction. If the applicant agrees to the suggested correction, the Examining Attorney can resolve the issue quickly by using an **Examiner's Amendment**.

If the Examining Attorney sends an Office Action, the applicant must respond within six months to avoid the application's abandonment. If the response does not overcome all objections sufficiently, the Examining Attorney will issue a **Final Refusal**. The applicant may appeal the Final Refusal to the **Trademark Trial and Appeal Board**, an administrative tribunal within the USPTO. An appeal requires an additional filing fee and DeSalvo Law Firm PLLC charges standard hourly rates for time spent on appeals.

If the Examining Attorney finds no objections or if the applicant overcomes all objections, the Examining Attorney should approve the mark for publication in the **Official Gazette**, a weekly publication of the USPTO, through which other parties are given an opportunity to object to a mark's registration. Any party who believes it may be damaged by registration of the proposed mark may file within 30 days an opposition to the registration or request an extension of the time to oppose the registration. If no party files an opposition, or if the opposition is unsuccessful, the application will enter the next stage of the trademark prosecution.

If the application is based on actual use (i.e., not merely the intent to use the mark in commerce, discussed below), the USPTO should issue a certificate of registration. Following registration, the mark's owner must file periodic maintenance documents to keep the registration live.

Intent to Use Applications

If a mark is actually being used in commerce, the application will usually contain an **actual use** basis. If the owner is developing the goods or services the mark will identify, the application can be filed based on a bona fide **intent to use** the mark in commerce. For an intent to use based application, after a successful publication stage (discussed above), the USPTO will issue a **Notice of Allowance (“NOA”)**, usually about eight weeks after the publication date. After receiving an NOA, the applicant has six months to (1) actually use the mark in commerce and submit a **Statement of Use** (currently \$100 per class of goods or services) or (2) request a six-month extension of time to file a statement of use (an **“extension request”**) (currently \$125 per class). It is important to understand that a NOA is not the same as a registration. Until an applicant can demonstrate actual use of a mark in commerce, the application process is not complete and the USPTO will not issue a registration certificate.

Because extension requests are granted in six-month increments, a trademark applicant must continue to file extension requests every six months, not to exceed a total of five requests. An intent to use applicant must be able to establish actual use of the mark in commerce no later than 30 months (2.5 years) after receiving an NOA.

Notices

After adopting a particular mark, it is permissible to include a **common law** trademark (i.e., TM) or service mark (i.e., SM) **notice** immediately after the mark, as illustrated in the example graphic below. If the mark’s owner has obtained a federal registration from the USPTO, it is permissible to include a registered symbol (i.e., ®), but not before.

Our attorneys can provide guidance on the proper form and location of trademark and service mark notices.



Vigilance

After registering a trademark, it is important to protect it against infringement and to oppose the registration of any mark that may be confusingly similar to the mark. A vigilance search is an ongoing search of the USPTO records and/or other sources (e.g., domain name registrations) in one or more countries to protect the mark by locating other marks and applications that may present confusion issues. DeSalvo Law Firm PLLC works with its clients to develop cost-effective search strategies. We can have searches performed in over 200 countries, on a worldwide basis, or on a country-by-country basis.

Maintenance

To maintain a federal registration, the mark’s owner must file certain maintenance documents between the fifth and sixth year after registration and before the end of every ten year period after registration. DeSalvo Law Firm PLLC also offers ongoing maintenance services to its clients.

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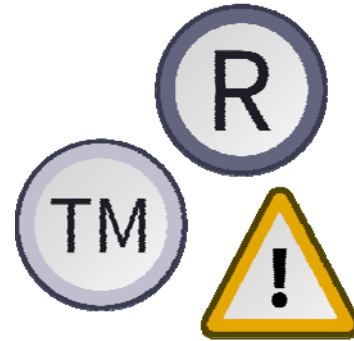
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Trademark Services

DeSalvo Law Firm PLLC offers a variety of trademark services, including:

- Trademark Analysis and Acquisition Advice
- Trademark Use Opinions
- Trademark Federal Registration Opinions
- Trademark Search and Registration: Federal and State
- Trademark Monitoring
- Trademark Renewals
- Trademark Office Actions
- Trademark Opposition Proceedings
- Trademark Appeals
- Trademark Consent and Concurrent Use Agreements
- Trademark Enforcement and Litigation
- Trademark Licensing and Transfer
- Domain Name Registration and Disputes
- Intellectual Property Audits
- Business Formation



Unless included in the following flat rates section, trademark services are charged at our standard hourly rates plus expenses. Hourly rates vary year to year.

Trademark Flat Rates

Effective April 1, 2017

DeSalvo Law Firm PLLC offers the following trademark services at the flat rates indicated:

U.S. Federal Trademark Registration (Word Marks Only^{***})

Includes:

- Basic & Full Trademark Clearance and Opinion Letter
- Electronic Trademark Application*
- Attorneys' fees for application preparation and filing**

**\$1,500 for 1 word mark or
\$2,500 for 2 word marks filed at once**

+

Cost of Clearance Report

+

USPTO application fees (currently \$275 or \$400 per class)

*Additional fees apply if paper application required.

**Standard hourly rates apply to all actions after application filing date.

***Clearing a design/stylized or design-intensive composite mark is more complex than a word mark clearance, requiring the identification and coding of each design element featured in the mark. DeSalvo Law Firm PLLC must review any marks featuring design elements before providing a price for clearance and registration.

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Trademark Flat Rates

Effective April 1, 2017

U.S. Statement of Use Filing or Request for Extension of Proof-of-Use Deadline

\$300
+
USPTO Statement of Use Fee (currently \$100 per class)
+
USPTO Extension Request Fee (currently \$125 per class)

Trademark Post-Registration Maintenance

Maintenance Due Between 5th and 6th Year or Renewal Due Between 9th and 10th Year

\$400
+
Trademark Office Filing Fee
(currently \$325 per class for Section 8 & 15 filings and
\$425 per class for Section 8 & 9 Filings)

State Trademark Registration (No Clearance)

\$500
+
Applicable State Secretary of State Filing Fee

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