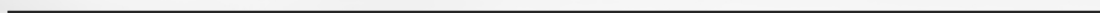


GUIDE FOR REGISTERING A TRADEMARK



BASIC FACTS ABOUT REGISTERING A TRADEMARK IN USA

What Is a Trademark?

A **TRADEMARK** is either a word, phrase, symbol or design, or combination of words, phrases, symbols or designs, which identifies and distinguishes the source of the goods or services of one party from those of others. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. Throughout this booklet the terms “trademark” and “mark” are used to refer to both trademarks and service marks whether they are word marks or other types of marks. Normally, a mark for goods appears on the product or on its packaging, while a service mark appears in advertising for the services.

A trademark is different from a copyright or a patent. A copyright protects an original artistic or literary work; a patent protects an invention. For copyright information call the Library of Congress at (202) 7073000.

Establishing Trademark Rights

Trademark rights arise from either (1) actual use of the mark, or (2) the filing of a proper application to register a mark in the Patent and Trademark Office (PTO) stating that the applicant has a bona fide intention to use the mark in commerce regulated by the U.S. Congress. (See below, under “Types of Applications,” for a discussion of what is meant by the terms commerce and use in commerce.) Federal registration is not required to establish rights in a mark, nor is it required to begin use of a mark. However, federal registration can secure benefits beyond the rights acquired by merely using a mark. For example, the owner of a federal registration is presumed to be the owner of the mark for the goods and services specified in the registration, and to be entitled to use the mark nationwide.

There are two related but distinct types of rights in a mark: the right to register and the right to use. Generally, the first party who either uses a mark in commerce or files an application in the PTO has the ultimate right to register that mark. The PTO’s authority is limited to determining the right to register. The right to use a mark can be more complicated to determine. This is particularly true when two parties have begun use of the same or similar marks without knowledge of one another and neither has a federal registration. Only a court can render a decision about the right to use, such as issuing an injunction or awarding damages for infringement. It should be noted that a federal registration can provide significant advantages to a party involved in a court proceeding. The PTO cannot provide advice concerning rights in a mark. Only a private attorney can provide such advice.

Unlike copyrights or patents, trademark rights can last indefinitely if the owner continues to use the mark to identify its goods or services. The term of a federal trademark registration is 10 years, with 10-year renewal terms. However, between the fifth and sixth year after the date of initial registration, the registrant must file an affidavit setting forth certain information to keep the registration alive. If no affidavit is filed, the registration is cancelled.

Types of Applications for Federal Registration

An applicant may apply for federal registration in three principal ways. (1) An applicant who has already commenced using a mark in commerce may file based on that use (a “use” application). (2) An applicant who has not yet used the mark may apply based on a bona fide intention to use the mark in commerce (an “intent to use” application). For the purpose of obtaining federal registration, commerce means all commerce which may lawfully be regulated by the U.S. Congress, for example, interstate commerce or commerce between the U.S. and another country. The use in commerce must be a bona fide use in the ordinary course of trade, and not made merely to reserve a right in a mark. Use of a mark in promotion or advertising before the product or service is actually provided under the mark on a normal commercial scale does not qualify as use in commerce. Use of a mark in purely local commerce within a state does not qualify as “use in commerce.” If an applicant files based on a bona fide intention to use in commerce, the applicant will

have to use the mark in commerce and submit an allegation of use to the PTO before the PTO will register the mark (See page 12). (3) Additionally, under certain international agreements, an applicant from outside the United States may file in the United States based on an application or registration in another country. For information regarding applications based on international agreements please call the information number provided on page 4.

A United States registration provides protection only in the United States and its territories. If the owner of a mark wishes to protect a mark in other countries, the owner must seek protection in each country separately under the relevant laws. The PTO cannot provide information or advice concerning protection in other countries. Interested parties may inquire directly in the relevant country or its U.S. offices or through an attorney.

Who May File an Application?

The application must be filed in the name of the owner of the mark; usually an individual, corporation or partnership. The owner of a mark controls the nature and quality of the goods or services identified by the mark. See below in the line by line instructions for information about who must sign the application and other papers.

The owner may submit and prosecute its own application for registration, or may be represented by an attorney. The PTO cannot help select an attorney.

Foreign Applicants

Applicants not living in the United States must designate in writing the name and address of a domestic representative – a person residing in the United States “upon whom notices of process may be served for proceedings affecting the mark.” The applicant may do so by submitting a statement that the named person at the address indicated is appointed as the applicant’s domestic representative under §1(e) of the Trademark Act. The applicant must sign this statement. This person will receive all communications from the PTO unless the applicant is represented by an attorney in the United States.

Searches for Conflicting Marks

An applicant is not required to conduct a search for conflicting marks prior to applying with the PTO. However, some people find it useful. In evaluating an application, an examining attorney conducts a search and notifies the applicant if a conflicting mark is found. The application fee, which covers processing and search costs, will not be refunded even if a conflict is found and the mark cannot be registered.

To determine whether there is a conflict between two marks, the PTO determines whether there would be a likelihood of confusion, that is, whether relevant consumers would be likely to associate the goods or services of one party with those of the other party as a result of the use of the marks at issue by both parties. The principal factors to be considered in reaching this decision are the similarity of the marks and the commercial relationship between the goods and services identified by the marks. To find a conflict, the marks need not be identical, and the goods and services do not have to be the same.

The PTO does not conduct searches for the public to determine if a conflicting mark is registered, or is the subject of a pending application, except as noted above when acting on an application. However, there are a variety of ways to get this same type of information. First, by performing a search in the PTO public search library. The search library is located on the second floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia 22202. Second, by visiting a patent and trademark depository library (at locations listed on pages 14 and 15). These libraries have CDROMS containing the trademark database of registered and pending marks. Finally, either a private trademark search company, or an attorney who deals with trademark law, can provide trademark registration information. The

PTO cannot provide advice about possible conflicts between marks.

Laws & Rules Governing Federal Registration

The federal registration of trademarks is governed by the Trademark Act of 1946, as amended, 15 U.S.C. §1051 et seq.; the Trademark Rules, 37 C.F.R. Part 2; and the Trademark Manual of Examining Procedure (2d ed. 1993).

Other Types of Applications

In addition to trademarks and service marks, the Trademark Act provides for federal registration of other types of marks, such as certification marks, collective trademarks and service marks, and collective membership marks. These types of marks are relatively rare. For forms and information regarding the registration of these marks, please call the appropriate trademark information number indicated below.

Where to Send the Application and Correspondence

The application and all other correspondence should be addressed to “The Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 222023513.” The initial application should be directed to “Box NEW APP / FEE.” An AMENDMENT TO ALLEGE USE should be directed to “Attn. AAU.” A STATEMENT OF USE or REQUEST FOR AN EXTENSION OF TIME TO FILE A STATEMENT OF USE should be directed to “Box ITU / FEE.” (See page 5 for an explanation of these terms.)

The applicant should indicate its telephone number on the application form. Once a serial number is assigned to the application, the applicant should refer to the serial number in all written and telephone communications concerning the application.

It is advisable to submit a stamped, self-addressed postcard with the application specifically listing each item in the mailing, that is, the written application, the drawing, the fee, and the specimens (if appropriate). The PTO will stamp the filing date and serial number of the application on the postcard to acknowledge receipt. This will help the applicant if any item is later lost or if the applicant wishes to inquire about the application. The PTO will send a separate official notification of the filing date and serial number for every application about two months after receipt.

Use of the “TM,” “SM” and “®” Symbols

Anyone who claims rights in a mark may use the TM (trademark) or SM (service mark) designation with the mark to alert the public to the claim. It is not necessary to have a registration, or even a pending application, to use these designations. The claim may or may not be valid. The registration symbol, ®, may only be used when the mark is registered in the PTO. It is improper to use this symbol at any point before the registration issues. Please omit all symbols from the mark in the drawing you submit with your application; the symbols are not considered part of the mark.

Information Numbers

General Trademark or Patent Information

Automated (Recorded) General Trademark or Patent Information

Automated Line for Status Information on Trademark Applications

(Additional status information is available at (703) 3089400)

Assignment & Certification Branch (Assignments, Changes of Name, and Certified Copies of Applications and Registrations)

Trademark Assistance Center

Information Regarding Renewals [Sec. 9], Affidavits of Use [Sec. 8], Incontestability [Sec. 15], or Correcting a Mistake on a Registration

Information Regarding Applications Based on International Agreements or for Certification, Collective, or Collective Membership Marks

Trademark Trial and Appeal Board

Assistant Commissioner for Trademarks

THE REGISTRATION PROCESS

Filing Date Filing Receipt The PTO is responsible for the federal registration of trademarks. When an application is received, the PTO reviews it to determine if it meets the minimum requirements for receiving a filing date. If the application meets the filing requirements, the PTO assigns it a serial number and sends the applicant a receipt about two months after filing. If the minimum requirements are not met, the entire mailing, including the filing fee, is returned to the applicant.

Examination

About four months after filing, an examining attorney at the PTO reviews the application and determines whether the mark may be registered. If the examining attorney determines that the mark cannot be registered, the examining attorney will issue a letter listing any grounds for refusal and any corrections required in the application. The examining attorney may also contact the applicant by telephone if only minor corrections are required. The applicant must respond to any objections within six months of the mailing date of the letter, or the application will be abandoned. If the applicant's response does not overcome all objections, the examining attorney will issue a final refusal. The applicant may then appeal to the Trademark Trial and Appeal Board, an administrative tribunal within the PTO.

A common ground for refusal is likelihood of confusion between the applicant's mark and a registered mark. This ground is discussed on pages 2 and 3. Marks which are merely descriptive in relation to the applicant's goods or services, or a feature of the goods or services, may also be refused. Marks consisting of geographic terms or surnames may also be refused. Marks may be refused for other reasons as well.

Publication for Opposition

If there are no objections, or if the applicant overcomes all objections, the examining attorney will approve the mark for publication in the Official Gazette, a weekly publication of the PTO. The PTO will send a NOTICE OF PUBLICATION to the applicant indicating the date of publication.

In the case of two or more applications for similar marks, the PTO will publish the application with the earliest effective filing date first. Any party who believes it may be damaged by the registration of the mark has 30 days from the

date of publication to file an opposition to registration. An opposition is similar to a formal proceeding in the federal courts, but is held before the Trademark Trial and Appeal Board. If no opposition is filed, the application enters the next stage of the registration process.

Issuance of Certificate of Registration or Notice of Allowance

If the application was based upon the actual use of the mark in commerce prior to approval for publication, the PTO will register the mark and issue a registration certificate about 12 weeks after the date the mark was published, if no opposition was filed. If, instead, the mark was published based upon the applicant's statement of having a bona fide intention to use the mark in commerce, the PTO will issue a NOTICE OF ALLOWANCE about 12 weeks after the date the mark was published, again provided no opposition was filed. The applicant then has six months from the date of the NOTICE OF ALLOWANCE to either (1) use the mark in commerce and submit a STATEMENT OF USE, or (2) request a sixmonth EXTENSION OF TIME TO FILE A STATEMENT OF USE (see forms and instructions in this booklet). The applicant may request additional extensions of time only as noted in the instructions on the back of the extension form. If the STATEMENT OF USE is filed and approved, the PTO will then issue the registration certificate.

FILING REQUIREMENTS

WARNING: BEFORE COMPLETING AN APPLICATION, READ THE INSTRUCTIONS CAREFULLY AND STUDY THE EXAMPLES PROVIDED. ERRORS OR OMISSIONS MAY RESULT IN THE DENIAL OF A FILING DATE AND THE RETURN OF APPLICATION PAPERS, OR THE DENIAL OF REGISTRATION AND FORFEITURE OF THE FILING FEE.

To receive a filing date, the applicant must provide all of the following:

1. A **written application** form;
2. A **drawing** of the mark on a separate piece of paper;
3. The required filing **fee** (see page 11 for fee information); and
4. If the application is filed based upon prior use of the mark in commerce, **three specimens** for each class of goods or services. The specimens must show actual use of the mark with the goods or services. The specimens may be identical or they may be examples of three different uses showing the same mark.

1. WRITTEN APPLICATION FORM [PTO FORM 1478]

The application must be in English. A separate application must be filed for each mark the applicant wishes to register. Likewise, if the applicant wishes to register more than one version of the same mark, a separate application must be filed for each version. PTO Form 1478 included in the back of this booklet may be used for either a trademark or service mark application. It may be photocopied for your convenience. See the examples of completed applications on pages 16 and 17 with references to the following linebyline instructions.

LINEBYLINE INSTRUCTIONS FOR FILLING OUT PTO FORM 1478, ENTITLED "TRADEMARK/SERVICE MARK APPLICATION, PRINCIPAL REGISTER, WITH DECLARATION"

Space 1 - The Mark

Indicate the mark (for example, "THEORYTEC" or "PINSTRIPES AND DESIGN"). This should agree with the mark shown on the drawing page. If there is a discrepancy between the mark described in the written application and

the mark displayed in the drawing, the drawing controls.

Space 2 - Classification

It is not necessary to fill in this box. The PTO will determine the proper International Classification based upon the identification of the goods and services in the application. However, if the applicant knows the International Class number(s) for the goods and services, the applicant may place the number(s) in this box. The International Classes are listed inside of the back cover of this booklet. If the PTO determines that the goods and services listed are in more than one class, the PTO will notify the applicant during examination of the application, and the applicant will have the opportunity to pay the fees for any additional classes or to limit the goods and services to one or more classes.

Space 3 - The Owner of the Mark

The name of the owner of the mark must be entered in this box. The application must be filed in the name of the owner of the mark or the application will be void, and the applicant will forfeit the filing fee. The owner of the mark is the party who controls the nature and quality of the goods sold, or services rendered, under the mark. The owner may be an individual, a partnership, a corporation, or an association or similar firm. If the applicant is a corporation, the applicant's name is the name under which it is incorporated. If the applicant is a partnership, the applicant's name is the name under which it is organized.

Space 4 - The Owner's Address

Enter the applicant's business address. If the applicant is an individual, enter either the applicant's business or home address.

Space 5 - Entity Type and Citizenship/Domicile

The applicant must check the box which indicates the type of entity applying. In addition, in the blank following the box, the applicant must specify the following information: Space 5(a) for an individual, the applicant's national citizenship; Space 5(b) for a partnership, the names and national citizenship of the general partners and the state where the partnership is organized (if a U.S. partnership) or country (if a foreign partnership); Space 5(c) for a corporation, the state of incorporation (if a U.S. corporation), or country (if a foreign corporation); or Space 5(d) for another type of entity, specify the nature of the entity and the state where it is organized (if in the U.S.) or country where it is organized (if a foreign entity).

Space 6 - Identification of the Goods and/or Services

In this blank the applicant must state the specific goods and services for which registration is sought and with which the applicant has actually used the mark in commerce, or in the case of an "intent to use" application, has a bona fide intention to use the mark in commerce. Use clear and concise terms specifying the actual goods and services by their common commercial names. A mark can only be registered for specific goods and services. The goods and services listed will establish the scope of the applicant's rights in the relevant mark.

The goods and services listed must be the applicant's actual "goods in trade" or the actual services the applicant renders for the benefit of others. Use language that would be readily understandable to the general public. For example, if the applicant uses or intends to use the mark to identify "candy," "word processors," "baseballs and baseball bats," "travel magazines," "dry cleaning services" or "restaurant services" the identification should clearly and concisely list each such item. If the applicant uses indefinite terms, such as "accessories," "components," "devices," "equipment," "food," "materials," "parts," "systems," "products," or the like, then those words must be followed by the word "namely" and the goods or services listed by their common commercial name(s). Note that the terms used in the classification listing on the inside of the back cover of this booklet are generally too broad. Do not use these terms by themselves.

The applicant must be very careful when identifying the goods and services. Because the filing of an application establishes certain presumptions of rights as of the filing date, the application may not **be amended later to add**

any products or services not within the scope of the identification. For example, the identification of “clothing” could be amended to “shirts and jackets,” which narrows the scope, but could not be amended to “retail clothing store services,” which would change the scope. Similarly, “physical therapy services” could not be changed to “medical services” because this would broaden the scope of the identification. Also, if the identification includes a trade channel limitation, deleting that limitation would broaden the scope of the identification.

The **identification of goods and services** must not describe **the mode** of use of the mark, such as on labels, stationery, menus, signs, containers or in advertising. There is another place on the application, called the “method of use clause,” for this kind of information. (See information under Space 7a, fourth blank, described on the next page.) For example, in the identification of goods and services, the term “advertising” usually is intended to identify a service rendered by advertising agencies. Moreover, “labels,” “menus,” “signs” and “containers” are specific goods. If the applicant identifies these goods or services by mistake, the applicant may not amend the identification to the actual goods or services of the applicant. Thus, if the identification indicates “menus,” it could not be amended to “restaurant services.” Similarly, if the goods are identified as “containers or labels for jam,” the identification could not be amended to “jam.”

NOTE: If nothing appears in this blank, or if the identification does not identify any recognizable goods or services, the application will be denied a filing date and returned to the applicant. For example, if the applicant specifies the mark itself or wording such as “[YOUR COMPANY NAME],” “corporate name,” or “company logo,” and nothing else, the application will be denied a filing date and returned to the applicant. If the applicant identifies the goods and services too broadly as, for example, “advertising and business,” “miscellaneous,” “miscellaneous goods and services,” or just “products,” or “services,” the application will also be denied a filing date and returned to the applicant.

Space 7 Basis for Filing

The applicant must check at least one of the four boxes to specify a basis for filing the application. The applicant should also fill in all blanks which follow the checked box(es). Usually an application is based upon either (1) use of the mark in commerce (the first box), or (2) a bona fide intention to use the mark in commerce (the second box). **You may not check both the first and second box. If both the first and second boxes are checked, the PTO will not accept the application and will return it.** If an applicant wishes to apply to register a mark, for certain goods and services for which it is already using the mark in commerce, and also for other goods and services based on future use, separate applications must be filed to separate the relevant goods and services from each other.

Space 7(a)

If the applicant is using the mark in commerce in relation to all of the goods and services listed in the application, check this first box and fill in the blanks.

In the **first blank** specify the date the trademark was first used to identify the goods and services in a type of commerce which may be regulated by Congress.

In the **second blank** specify the type of commerce, specifically a type of commerce which may be regulated by Congress, in which the goods were sold or shipped, or the services were rendered. (See page 2 for a discussion of the meaning of “use in commerce.”) For example, indicate “interstate commerce” (commerce between two or more states) or commerce between the United States and a specific foreign country, for example, “commerce between the U.S. and Canada.”

In the **third blank** specify the date that the mark was first used anywhere to identify the goods or services specified in the application. This date will be the same as the date of first use in commerce unless the applicant made some use, for example, within a single state, before the first use in commerce.

In the **fourth blank** specify how the mark is placed on the goods or used with the services. This is referred to as the “method of use clause,” and should not be confused with the identification of the goods and services described under Space 6. For example, in relation to goods, state “the mark is used on labels affixed to the goods,” or “the mark is used on containers for the goods,” whichever is accurate. In relation to services, state “the mark is used in advertisements for the services.”

Space 7(b)

If the applicant has a bona fide intention to use the mark in commerce in relation to the goods or services specified in the application, check this second box and fill in the blank. The applicant should check this box if the mark has not been used at all or if the mark has been used on the specified goods or services only within a single state.

In the blank, state how the mark is intended to be placed on the goods or used with the services. For example, for goods, state “the mark will be used on labels affixed to the goods,” or “the mark will be used on containers for the goods,” whichever is accurate. For services, state “the mark will be used in advertisements for the services.”

Spaces 7(c) and (d)

These spaces are usually used only by applicants from foreign countries who are filing in the United States under international agreements. These applications are less common. For further information about treaty-based applications, call the trademark information number listed in this booklet on page 4, or contact a private attorney.

Space 8 - Verification and Signature

The applicant must verify the truth and accuracy of the information in the application and must sign the application. The declaration in Space 8, on the back of the form, is for this purpose. If the application is not signed, the application will not be granted a filing date and will be returned to the applicant. If the application is not signed by an appropriate person, the application will be found void and the filing fee will be forfeited. Therefore, it is important that the proper person sign the application.

Who should sign?

- If the applicant is an **individual**, that **individual** must sign.
- If the applicant is a **partnership**, a **general partner** must sign.
- If the applicant is a **corporation, association or similar organization**, an **officer** of the corporation, association or organization must sign. An officer is a person who holds an office established in the articles of incorporation or the bylaws. **Officers may not delegate this authority to non officers.**
- If the applicants are **joint applicants**, all joint applicants must sign.

The person who signs the application must indicate the date signed, provide a telephone number to be used if it is necessary to contact the applicant, and clearly print or type their name and position.

2. THE DRAWING PAGE

Every application must include a single drawing page. If there is no drawing page, the application will be denied a filing date and returned to the applicant. The PTO uses the drawing to file the mark in the PTO search records and to print the mark in the Official Gazette and on the registration.

The drawing must be on pure white, durable, nonshiny paper that is 8½ (21.59 cm) inches wide by 11 (27.94 cm)

inches long. There must be at least a one inch (2.54 cm) margin on the sides, top and bottom of the page, and at least one inch between the heading and the display of the mark.

At the top of the drawing there must be a **heading**, listing on separate lines, the applicant's complete name, address, the goods and services specified in the application, and in applications based on use in commerce, the date of first use of the mark and the date of first use of the mark in commerce. This heading should be typewritten. If the drawing is in special form, the heading should include a description of the essential elements of the mark.

The **drawing of the mark** should appear at the center of the page. The drawing of the mark may be **typewritten**, as shown on page 19, or it may be in **special form**, as shown on page 18.

If the mark includes words, numbers or letters, the applicant can usually elect to submit either a typewritten or a special form drawing. To register a mark consisting of only words, letters or numbers, without indicating any particular style or design, provide a typewritten drawing. In a typewritten drawing the mark must be typed entirely in CAPITAL LETTERS, even if the mark, as used, includes lowercase letters. Use a standard typewriter or type of the same size and style as that on a standard typewriter.

To indicate color, use the color linings shown below. The appropriate lining should appear in the area where the relevant color would appear. If the drawing is lined for color, insert a statement in the written application to indicate so, for example, "The mark is lined for the colors red and green." A plain black and white drawing is acceptable even if the mark is used in color. Most drawings do not indicate specific colors.

Be careful in preparing the drawing. While it may be possible to make some minor changes, the rules prohibit any material change to the drawing of the mark after filing.

To register a word mark in the form in which it is actually used or intended to be used in commerce, or any mark including a design, submit a **special-form** drawing. In a special form drawing, the mark must not be larger than 4 inches by 4 inches (10.16 cm by 10.16 cm). If the drawing of the mark is larger than 4 inches by 4 inches, the application will be denied a filing date and returned to the applicant. In addition, the drawing must appear only in black and white, with every line and letter black and clear. No color or gray is allowed. Do not combine typed matter and special form in the same drawing.

The drawing in special form must be a substantially exact representation of the mark as it appears on the specimens. The applicant may apply to register any portion of a mark consisting of more than one element, provided the mark displayed in the drawing creates a separate impression apart from other elements it appears with on the specimens. For example, generally it is possible to register a word mark by itself even though the specimen shows the word mark used in combination with a design or as part of a logo. Do not include non trademark matter in the drawing, such as informational matter which may appear on a label. In the end, the applicant must decide exactly what to register and in what form. The PTO considers the drawing controlling in determining exactly what mark the application covers.

3. FEES

Filing Fee

The **application filing fee is \$245.00 for each class** of goods or services listed. (See the International Classification of Goods and Services listed on the inside of the back cover.) **At least \$245.00 must accompany the application, or the application will be denied a filing date and all the papers returned to the applicant.** Fee increases, when necessary, usually take effect on October 1 of any given year. Please call the general information number listed on page 4 for up to date fee information if filing after September 1995. The PTO receives no taxpayer funds. The PTO's

operations are supported entirely from fees paid by applicants and registrants.

Additional Fees Related to Intent To Use Applications

In addition to the application filing fee, applicants filing based on a bona fide intention to use a mark in commerce must submit a fee of **\$100.00** for **each class** of goods or services in the application when filing any of the following:

- an AMENDMENT TO ALLEGE USE
- a STATEMENT OF USE
- a REQUEST FOR AN EXTENSION OF TIME TO FILE A STATEMENT OF USE

Form of Payment

All payments must be made in United States currency, by check, post office money order or certified check. Personal or business checks may be submitted. Make checks and money orders payable to: **The Assistant Commissioner for Trademarks.**

NOTE: FEES ARE NOT REFUNDABLE.

4. SPECIMENS

The following information is designed to provide guidance regarding the specimens required to show use of the mark in commerce.

When to File the Specimens

If the applicant has already used the mark in commerce and files based on this use in commerce, then the applicant must submit three specimens per class showing use of the mark in commerce with the application. If, instead, the application is based on a bona fide intention to use mark in commerce, the applicant must submit three specimens per class at the time the applicant files either an AMENDMENT TO ALLEGE USE or a STATEMENT OF USE.

What to File as a Specimen

The specimens must be actual samples of how the mark is being used in commerce. **The specimens may be identical or they may be examples of three different uses showing the same mark.**

If the mark is used on goods, examples of acceptable specimens are tags or labels which are attached to the goods, containers for the goods, displays associated with the goods, or photographs of the goods showing use of the mark on the goods themselves. If it is impractical to send an actual specimen because of its size, photographs or other acceptable reproductions that show the mark on the goods, or packaging for the goods, must be furnished. Invoices, announcements, order forms, bills of lading, leaflets, brochures, catalogs, publicity releases, letterhead, and business cards generally are not acceptable specimens for goods.

If the mark is used for **services**, examples of acceptable specimens are signs, brochures about the services, advertisements for the services, business cards or stationery showing the mark in connection with the services, or photographs which show the mark either as it is used in the rendering or advertising of the services. In the case of a service mark, the specimens must either show the mark and include some clear reference to the type of services rendered

under the mark in some form of advertising, or show the mark as it is used in the rendering of the service, for example on a store front or the side of a delivery or service truck.

Specimens may not be larger than 8½ inches by 11 inches (21.59 cm by 27.94 cm) and must be flat. See pages 18 through 22 for samples of some different types of specimens. Smaller specimens, such as labels, may be stapled to a sheet of paper and labeled “SPECIMENS.” A separate sheet can be used for each class.

ADDITIONAL REQUIREMENTS FOR INTENT-TO-USE APPLICATIONS

An applicant who files its application based on having a bona fide intention to use a mark in commerce must make use of the mark in commerce before the mark can register. After use in commerce begins, the applicant must submit:

1. three specimens evidencing use as discussed above;
2. a fee of **\$100.00** per class of goods or services in the application; and
3. either (1) an AMENDMENT TO ALLEGE USE if the application has not yet been approved for publication (use PTO Form 1579) or (2) a STATEMENT OF USE if the mark has been published and the PTO has issued a NOTICE OF ALLOWANCE (use PTO Form 1580).

If the applicant will not make use of the mark in commerce within six months of the NOTICE OF ALLOWANCE, **the applicant must file** a REQUEST FOR AN EXTENSION OF TIME TO FILE A STATEMENT OF USE, or the application is abandoned. (Use PTO Form 1581, which is intended only for this purpose.)

See the instructions and information on the back of the forms. The previous information about specimens, identifications of goods and services and dates of use is also relevant to filing an AMENDMENT TO ALLEGE USE or STATEMENT OF USE. Follow the instructions on these forms carefully. Failure to file the necessary papers in proper form within the time provided may result in abandonment of the application.

PATENT AND TRADEMARK OFFICE SERVICES

Trademark Assistance Center

In order to provide improved service to trademark applicants, registrants, and the general public, the Patent and Trademark Office has implemented a pilot program called the “Trademark Assistance Center.” The Center provides general information about the trademark registration process and responds to inquiries pertaining to the status of specific trademark applications and registrations. The location of the Center is 2900 Crystal Drive, Room 4B10, Arlington, Virginia 22202-3513. Assistance may be obtained in person or by dialing (703) 308-9000, Monday through Friday, 8:30 a.m. 5:00 p.m. eastern time, except holidays. Please note that personal assistance concerning trademark as well as patent matters will continue to be available at (703) 308-HELP and recorded information will continue to be available at (703) 557-INFO. Also, automated information about the status of trademark applications and registrations will continue to be available at (703) 305-8747.

Patent and Trademark Depository Libraries

Patent and Trademark Depository Libraries (PTDLs) receive patent and trademark information in various formats from the U.S. Patent and Trademark Office. Many PTDLs have on file all trademarks published since 1872. All PTDLs have the trademark sections of the Official Gazette of the U.S. Patent and Trademark Office. Trademark search systems on CDROM format are available at all PTDLs to increase utilization of and enhance access to the information found

in trademarks. It is through the CDROM systemsthat preliminary trademark searches can be conducted through the numerically arranged collections.

All information is available for use by the public free of charge. Facilities for making paper copies of trademark information are generally provided for a fee.

Trademark Checklist

- Step 1: Develop a Trademark
- Step 2: Determine Your Eligibility
- Step 3: Do a Trademark Search
- Step 4: Understand Your Legal Options
- Step 5: Compile a Trademark Application
- Step 6: Respond to Office Actions
- Step 7: Use Your Trademark
- Step 8: Defend Your Trademark
- Step 9: Maintain Your Trademark



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*Interested in learning more about obtaining a trademark for your business or nonprofit organization? **Let's Talk!***



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