

GUIDE TO TRADEMARKS

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GUIDE TO TRADEMARKS

NOTICE: CHANGES IN THE LAW PERTAINING TO FEDERAL TRADEMARK REGISTRATION TAKE EFFECT ON NOVEMBER 16, 1989. THE INFORMATION CONTAINED HEREIN INCORPORATES THESE CHANGES.

BASIC FACTS ABOUT TRADEMARKS

A TRADEMARK may be a word, symbol, design or combination word and design, a slogan or even a distinctive sound which identifies and distinguishes the goods or services of one party from those of another. Used to identify a service, it can be called a service mark. In general, throughout this pamphlet the term trademark will refer to both trademarks and service marks. Normally, a trademark for goods appears on the product or on its packaging, while a service mark is usually used in advertising to identify the owner's services.

A trademark is different from a copyright or a patent. A copyright gives protection for an artistic or literary work and a patent gives protection for an invention.

Unlike a copyright or patent, trademark rights can last indefinitely if the mark continues to perform a source-indicating function. The term of the Federal trademark registration is 10 years, with 10 year renewal terms. However, between the fifth and sixth year after the date of the registration, the registrant must file an affidavit stating the mark is currently in use in commerce. If no affidavit is filed, the registration will be cancelled.

Trademark fights arise from either (1) use of the mark, or (2) a bona fide intention to use a mark, along with the filing of an application to Federally register that mark on the Principal Register. A Federal trademark registration is not required in order for a trademark to be protected, and a trademark may be used without obtaining a registration.

Before a trademark owner may file an application for a Federal registration, the owner must either (1) use the mark on

goods which are shipped or sold, or services which are rendered, in commerce regulated by Congress (e.g., interstate commerce or commerce between the U.S. and a foreign country), or (2) have a bona fide intention to use the mark in such commerce in relation to specific goods or services.

BENEFITS OF REGISTRATION

WHILE Federal registration is not necessary for trademark certain advantages:

- 1 The filing date of the application is a constructive date of first use of the mark in commerce (this gives registrant nationwide priority as of that date, except as to certain prior users or prior applicants);
- 2 The right to sue in Federal court for trademark infringement;
- 3 Recovery of profits, damages and costs in a Federal court infringement action and the possibility of treble damages and attorneys' fees;
- 4 Constructive notice of a claim of ownership (which eliminates a good faith defense for a party adopting the trademark subsequent to the registrant's date of registration);
- 5 The right to deposit the registration with Customs in order to stop the importation of goods bearing an infringing mark;
- 6 Prima facie evidence of the validity of the registration, registrant's ownership of the mark and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate;
- 7 The possibility of incontestability, in which case the registration constitutes conclusive evidence of the registrant's exclusive right, with certain limited exceptions, to use the registered mark in commerce;
- 8 Limited grounds for attacking a registration once it is five years old;
- 9 Availability of criminal penalties and treble damages in an action for counterfeiting a registered trademark;

10 A basis for filing trademark applications in foreign countries.

NOTICE

ONCE a Federal registration is issued, the registrant may give notice of registration by using the symbol, or the phrase "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." Although registration symbols may not be lawfully used prior to registration, many trademark owners use a TM or SM (if the mark identifies a service) symbol to indicate a claim of ownership, even if no Federal trademark application is pending.

THE REGISTRATION PROCESS

THE Patent and Trademark Office (PTO) is responsible for the Federal registration of trademarks. When an application is filed, it is reviewed to determine if it meets the requirements for receiving a filing date (see page 4). If the filing requirements are not met, the entire mailing, including the fee, is returned to the applicant. If the application meets the filing requirements, it is assigned a serial number, and the applicant is sent a filing receipt.

The first part of the registration process is a determination by the Trademark Examining Attorney as to whether the mark may be registered. An initial determination of registrability, listing any statutory grounds for refusal as well as any procedural informalities in the application, is issued about three months after filing. The applicant must respond to any objections raised within six months, or the application will be considered abandoned. If, after reviewing the applicant's response, the Examining Attorney makes a final refusal of registration, the applicant may appeal to the Trademark Trial and Appeal Board, an administrative tribunal within the PTO.

Once the Examining Attorney approves the mark, the mark will be published in the Trademark Official Gazette, a weekly publication of the PTO. Any other party then has 30 days to oppose the registration of the mark, or request an extension of time to oppose. An opposition is similar to a proceeding in the Federal district 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.

If the mark published based upon its actual use in commerce, a registration will issue approximately 12 weeks from the date the mark was published.

If, instead, the mark published based upon applicant's statement of a bona fide intention to use the mark in commerce, a notice of allowance will issue approximately 12 weeks from the date the mark was published. 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 six-month extension of time to file a statement of use (see forms and instructions at back of booklet). The applicant may request additional extensions of time only as noted in the instructions on the back of the form.

STATUTORY GROUNDS FOR REFUSAL

THE Examining Attorney will refuse registration if the mark or term applied for:

- 1 Does not function as a trademark to identify the goods or services as coming from a particular source; for example, the matter applied for is merely ornamentation;
- 2 Is immoral, deceptive or scandalous;
- 3 May disparage or falsely suggest a connection with persons, institutions, beliefs or national symbols, or bring them into contempt or disrepute;
- 4 Consists of or simulates the flag or coat of arms or other insignia of the United States, or a State or municipality, or any foreign nation;
- 5 Is the name, portrait or signature of a particular living individual, unless he has given written consent; or is the name, signature or portrait of a deceased President of the United States during the life of his widow, unless she has given her consent;
- 6 So resembles a mark already registered in the PTO as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive;

- 7 Is merely descriptive or deceptively misdescriptive of the goods or services;
- 8 Is primarily geographically descriptive or deceptively misdescriptive of the goods or services of the applicant;
- 9 Is primarily merely a surname.

A mark will not be refused registration on the grounds listed in numbers 7, 8 and 9 if the applicant can show that, through use of the mark in commerce, the mark has become distinctive so that it now identifies to the public the applicant's goods or services. Marks which are refused registration on the grounds listed in numbers 1, 7, 8 and 9 may be registrable on the Supplemental Register, which contains terms or designs considered capable of distinguishing the owner's goods or services, but that do not yet do so. A term or design cannot be considered for registration on the Supplemental Register unless it is in use in commerce in relation to all the goods or services identified in the application, and an acceptable allegation of use has been submitted. If a mark is registered on the Supplemental Register, the registrant may bring suit for trademark infringement in the Federal courts, or may use the registration as a basis for filing in some foreign countries. None of the other benefits of Federal registration listed on page 1 apply. An applicant may file an application on the Principal Register and, if appropriate, amend the application to the Supplemental Register for no additional fee.

TRADEMARK SEARCH LIBRARY

A RECORD of all active registrations and pending applications is maintained by the PTO to help determine whether a previously registered mark exists which could prevent the registration of an applicant's mark. (See ground for refusal No. 6, above.) The search library is located near Washington, D.C. at Crystal Plaza 2, 2nd Floor, 2011 Jefferson Davis Highway, Arlington, VA 22022, and is open to the public free of charge Monday through Friday, 8:00 am to 5:30 pm. The PTO cannot advise prospective applicants of the availability of a particular mark prior to the filing of an application. The applicant may hire a private search company or law firm to perform a search if a search is desired before filing an application and the applicant is unable to visit the search library. The PTO cannot recommend any such companies, but the

applicant may wish to consult listings for "Trademark Search Services" in the telephone directories or contact local bar associations for a list of attorneys specializing in trademark law.

WHO MAY FILE AN APPLICATION

THE owners of marks may file and prosecute their own applications for registration, or be represented by an attorney. The Patent and Trademark Office cannot help select an attorney.

FILING REQUIREMENTS

AN application consists of (1) a written application form; (2) a drawing of the mark; (3) the required filing fee; and, only if the application is filed based upon prior use of the mark in commerce, (4) three specimens showing actual use of the mark on or in connection with the goods or services. A separate application must be filed for each mark for which registration is requested.

Following is a description of each of these elements of a complete application. The written application form is the first form of four forms at the back of the booklet and is titled "Trademark/Service Mark Application, Principal Register, with Declaration." [The back page of the form is printed upside down so that it may be affixed to the application file at the top and still be easily read.]

Written Application Form

THE application must be written in English. The enclosed form may be used for either a trademark or service mark application. Additional forms may be photocopied. The following explanation covers each blank, beginning at the top.

Heading. Identify (a) the mark (e.g. "ERGO" or "ERGO and design") and (b) the class number(s) of the goods or services for which registration is sought. Classification is part of the PTO's administrative processing. The International Classification of Goods and Services is used (see inside back cover of this booklet). The class may be left blank if the

appropriate class number is not known.

Applicant. The application must be filed in the name of the owner of the mark. Specify, if an individual, applicant's name and citizenship; if a partnership, the names and citizenship of the general partners and the domicile of the partnership; if a corporation or association, the name under which it is incorporated and the state or foreign nation under the laws of which it is organized. Also indicate the applicant's post office address.

Identification of Goods or Services. State briefly the specific goods or services for which the mark is used or intended to be used and for which registration is sought. Use clear and precise language, for example, "women's clothing namely, blouses and skirts," or "computer programs for use by accountants," or "retail food store services." Note that the identification of goods or services should describe the goods the applicant sells or the services the applicant renders, not the medium in which the mark appears, which is often advertising. "Advertising" in this context identifies a service rendered by advertising agencies. For example, a restaurateur would identify his service as "restaurant services," not "menus, signs, etc." which is the medium through which the mark is communicated.

Basis for Application. The applicant must check at least one of four boxes to specify the basis for filing the application. Usually an application is based upon either (1) prior use of the mark in commerce (the first box), or (2) a bona fide intention to use the mark in commerce (the second box), but not both. If both the first and second boxes are checked, the Patent and Trademark Office will not accept the application and will return it to the applicant without processing.

The last two boxes pertain to applications filed in the United States pursuant to international agreements, based upon applications or registrations in foreign countries. These bases are asserted relatively infrequently. For further information about foreign-based applications, the applicant may call the trademark information number listed in this booklet or contact a private attorney.

If the applicant is using the mark in commerce in relation to all the goods or services listed in the application, check the first box and state each of the following:

-- The date the trademark was first used anywhere in the U.S.

on the goods, or in connection with the services, specified in the application;

- The date the trademark was first used on the specified goods, or in connection with the specified services, sold or shipped (or rendered) in a type of commerce which may be regulated by Congress;
- The type of commerce in which the goods were sold or shipped or services were rendered [for example, "interstate commerce" or "commerce between the United States and (specify foreign country)"]; and
- How the mark is used on the goods, or in connection with the services [for example, "the mark is used on labels which are affixed to the goods," or "the mark is used in advertisements for the services"].

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 the second box. This would include situations where the mark has not been used at all or where the mark has been used on the specified goods or services only within a single state (intrastate commerce).

Execution. The application form must be dated and signed. (See back of form.) The declaration and signature block appear on the back of the form. The Patent and Trademark Office will not accept an unsigned application and will return it to the applicant without processing. By signing the form, the applicant is swearing that all the information in the application is believed to be true. If the applicant is an individual, the individual must execute it; if joint applicants, all must execute; if a partnership, one general partner must execute the application; and if a corporation or association, one officer of the organization must execute the application.

2. Drawing

THE drawing is a representation of the mark as actually used or intended to be used on the goods or services. There are two types; (a) typed drawings and (b) special form drawings. All drawings must be made upon pure white durable nonshiny paper 8 1/2" wide by 11" long. One of the shorter sides of the sheet should be regarded as its top. There must be a margin of at least one inch on the sides and bottom of the paper and at

least one inch between the drawing of the mark and the heading.

The drawing is different than the specimens, which are the actual tags or labels (for goods) or advertisements (for services) which evidence use of the mark in commerce. The drawing is a black and white, or typed, rendition of the mark which is used in printing the mark in the Official Gazette and on the registration certificate. A copy of the drawing is also filed in the paper records of the Trademark Search Library to provide notice of the pending application.

Heading. Across the top of the drawing, beginning one inch from the top edge and not exceeding one third of the sheet, list on separate lines:

- Applicant's name;
- Applicant's post office address;
- The goods or services specified in the application (or typical items of the goods or services if there are many goods or services listed);
- Only in an application based on use in commerce--the date of first use of the mark anywhere in the U.S. and the date of first use of the mark in commerce;
- Only in an application based on a foreign application--the filing date of the foreign application.

Typed drawing. If the mark is only words, or words and numerals, and the applicant does not wish the registration to be issued for a particular depiction of the words and/or numerals, the mark may be typed in capital letters in the center of the page.

Special form drawing. This form must be used if the applicant wishes the registration for the mark to be issued in a particular style, or if the mark contains a design element. The drawing of the mark must be done in black ink, either with an india ink pen or by a process which will give satisfactory reproduction characteristics. Every line and letter, including words, must be black. This applies to all lines, including lines used for shading. Half-tones and gray are not acceptable. All lines must be clean, sharp, and solid, and not be fine or crowded. A photolithographic reproduction, printer's proof or camera ready copy may be used if otherwise suitable. Photographs are not acceptable. Photocopies are acceptable only if they produce an unusually clear and sharp black and white

rendering. The use of white pigment to cover lines is not acceptable.

The preferred size of the drawing of the mark is 2 1/2" x 2 1/2", and in no case may it be larger than 4" x 4". The Patent and Trademark Office will not accept an application with a special form drawing depicted larger than 4" by 4" and will return the application without processing. If the amount of detail in the mark precludes clear reduction to the required 4" x 4" size, such detail should not be shown in the drawing but should be verbally described in the body of the application.

Where color is a feature of a mark, the color or colors may be designated in the drawing by the linings shown in the following chart:

3. Specimens (Examples of Use)

TRADEMARKS may be placed on the goods; on the container for the goods; on displays associated with the goods; on tags or labels attached to the goods; or, if the nature of the goods makes such placement impractical, then on documents associated with the goods or their sale. Service marks may appear in advertisements for the services, or in brochures about the services, or on business cards or stationary used in connection with the services.

For an application based on actual use of the mark in commerce, the applicant must furnish three examples of use, as described in the paragraph above, when the application is filed. The Patent and Trademark Office will not accept an application based on use in commerce without at least one "specimen" and will return it to the applicant without processing.

The three "specimens" may be identical or they may be examples of three different types of uses. The three specimens should be actual labels, tags, containers, displays, etc. for goods; and actual advertisements, brochures, store signs or stationary (if the nature of the services is clear from the letterhead or body of the letter), etc. for services. Specimens may not be larger than 8 1/2" by 11" and must be capable of being arranged flat. Three-dimensional or bulky material is not acceptable. Photographs or other reproductions clearly and legibly showing the mark on the goods, or on displays associated with the goods, may be submitted if the manner of

affixing the mark to the goods, or the nature of the goods, is such that specimens as described above cannot be submitted.

4. Filing Fee

THE fee, effective April 17, 1989, is \$175 for each class of goods or services for which the application is made. (See International Classification of Goods and Services on inside back cover.) At least \$175 must be submitted for the application to be given a filing date. All payments should be made in United States specie, treasury notes, national bank notes, post office money orders, or certified checks. Personal or business checks may be submitted. The Patent and Trademark Office will cancel credit if payment cannot be collected. Money orders and checks should be made payable to the Commissioner of Patents and Trademarks. Money sent by mail to the Patent and Trademark Office will be at the risk of the sender; letters containing cash should be registered. Remittances made from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Application fees are non-refundable.

FURTHER REQUIREMENTS FOR INTENT-TO-USE APPLICANTS

AN applicant who alleges only a bona fide intention to use a mark in commerce must make use of the mark in commerce before a registration will be issued. After use begins, the applicant must submit, along with specimens evidencing use (see page 8) and a fee of \$100 per class of goods or services in the application, either (1) an Amendment to Allege Use or (2) a Statement of Use. The difference between the two filings is the timing of the filing. Copies of each of these forms appear in the back of this booklet behind the application form. See the instructions and information concerning the filing of these forms on the back of each form.

Also in the back of this booklet is a form entitled "Request for Extension of Time under 37 CFR 2.89 to File a Statement of Use, with Declaration." This form is intended for use only when an applicant needs to request an extension of time to file a statement of use. See the instructions and information concerning the use of this form on the back of the form.

FOREIGN APPLICANTS

DOMESTIC REPRESENTATIVE. Applicants not living in the United States must designate by a written document the name and address of some person resident in the United States on whom notices of process in-proceedings affecting the mark may be served. This person will also receive all official communications unless the applicant is represented by an attorney in the United States.

COMMUNICATIONS WITH THE PTO

THE application and all other communications should be addressed to "The Commissioner of Patents and Trademarks, Washington, D.C., 20231." It is preferred that the applicant indicate its telephone number on the application form. Once a serial number is assigned to the application the applicant should refer to this number in all telephone and written communications concerning the application.

ADDITIONAL INFORMATION

The Federal registration of trademarks is governed by the Trademark Act of 1946, 15 U.S.C. See. 1051 et seq.; the Rules, 37 C.F.R. Part 2; and the Trademark Manual of Examining Procedure.

General Trademark or Patent Information:
(703) 557-INFO

Status Information for Particular Trademark Applications:
(703) 557-5249

General Copyright Information:
(202) 479-0700

International schedule of classes of goods and services

Goods

- 1 Chemicals products used in industry, science, photography, agriculture, horticulture, forestry, artificial and synthetic resins; plastics in the form of powders, liquids or pastes, for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs; tanning substances; adhesive substances used in industry.
- 2 Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colouring matters, dyestuffs; mordants; natural resins; metals in foil and powder form for painters and decorators.
- 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- 4 Industrial oils and greases (other than oils and fats and essential oils); lubricants; dust laying and absorbing compositions; fuels (including motor spirit) and illuminants; candles, tapers, night lights and wicks.
- 5 Pharmaceutical, veterinary, and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax, disinfectants; preparations for killing weeds and destroying vermin.
- 6 Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building

materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (nonelectric); locksmiths' work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in nonprecious metal not included in other classes; ores.

- 7 Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators.
- 8 Hand tools and instruments; cutlery, forks, and spoons; side arms.
- 9 Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counterfreed apparatus; talking machines; cash registers; calculating machines; fire extinguishing apparatus.
- 10 Surgical, medical, dental, and veterinary instruments and apparatus (including artificial limbs, eyes and teeth).
- 11 Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes.
- 12 Vehicles; apparatus for locomotion by land, air or water.
- 13 Firearms; ammunition and projectiles; explosive substances; fireworks.
- 14 Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewelry, precious stones, horological and other chronometric instruments.
- 15 Musical instruments (other than talking machines and wireless apparatus).
- 16 Paper and paper articles, cardboard and cardboard articles; printed matter, newspaper and periodicals, books; bookbinding material; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and clichés

(stereotype).

- 17 Gutta percha, india rubber, balata and substitutes, articles made from these substances and not included in other classes; plastics in the form of sheets, blocks and rods, being for in manufacture; materials for packing, stopping or insulating; asbestos, mica and their products; hose pipes (nonmetallic).
- 18 Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- 19 Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; roadmaking materials; asphalt, pitch and bitumen; portable buildings; stone monuments; chimney pots.
- 20 Furniture, mirrors, picture frames; articles (not included in other classes) of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, celluloid, substitutes for all these materials, or of plastics.
- 21 Small domestic utensils and containers (not of precious metals, or coated therewith); combs and sponges; brushes (other than paint brushes); brushmaking materials; instruments and material for cleaning purposes, steel wool; unworked or semi-worked glass (excluding glass used in building); glassware, porcelain and earthenware, not included in other classes.
- 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials (hair, kapok, feathers, seaweed, etc.); raw fibrous textile materials.
- 23 Yarns, threads.
- 24 Tissues (piece goods); bed and table covers; textile articles not included in other classes.
- 25 Clothing, including boots, shoes and slippers.
- 26 Lace and embroidery, ribands and braid; buttons, press buttons, hooks and eyes, pins and needles; artificial flowers.
- 27 Carpets, rugs, mats and matting; linoleums and other

materials for covering existing floors; wall hangings (nontextile).

28 Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.

29 Meats, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.

30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard, pepper, vinegar, sauces, spices; ice.

31 Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.

32 Beer, ale and porter; mineral and aerated waters and other nonalcoholic drinks; syrups and other preparations for making beverages.

33 Wines, spirits and liqueurs.

34 Tobacco, raw or manufactured; smokers' articles; matches.

Services

35 Advertising and business.

36 Insurance and financial.

37 Construction and repair.

38 Communication.

39 Transportation and storage.

40 Material treatment.

41 Education and entertainment.

42 Miscellaneous.

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