

How to Obtain Trademark Rights

One may obtain trademark rights either by

- actual use of the mark in commerce, under common law, or
- proper registration of the mark with the United States Patent and Trademark Office ("PTO").

Under common law, the trademark owner has exclusive rights to the mark in the geographic area in which it is being used. When a mark is registered with the PTO, the trademark owner gains nationwide trademark rights.

In order to register with the PTO, one must have

- actual use of the mark in interstate commerce, or
- a bona fide intention to use the mark in interstate commerce, or
- a foreign owner's country of origin application filed during the previous 6 months, or its country of origin registration, along with a statement of a bona fide intention to use the mark in U.S. commerce.

The procedure for obtaining registration at the PTO is as follows:

Use-Based Federal Registration Process

1. Application: The application must be prepared and filed along with a drawing of the mark, a fee for the PTO, and specimens showing the mark as actually used in commerce.
2. Filing Receipt: The PTO reviews the application to determine that the filing requirements have been met, then assigns it a serial number and sends the Applicant a receipt. Typically, this process takes about two months.
3. Examination: An Examining attorney reviews the application to determine whether the mark can be registered. If the attorney determines that the mark cannot be registered, the Applicant will receive a letter listing the grounds for refusal. The Applicant has six months from the date of the letter to respond to the refusal. If the Applicant's response does not adequately overcome the objections, the Examining attorney may issue a second refusal. Thereafter, the Applicant can appeal to the Trademark Trial and Appeal Board ("TTAB") of the PTO for final review. Applications can be refused for a number of reasons. For example, the Examining attorney may believe that there is a likelihood of confusion between the Applicant's mark and an existing mark, or the attorney may believe that Applicant's mark is descriptive of a feature of the goods or services.
4. Notice of Publication: If the Examining attorney has no objections to the mark and application, or the Applicant overcomes all objections, the mark is published in the PTO's Official Gazette, a weekly publication. Any party wishing to challenge the published mark has 30 days to respond to the PTO and file an official opposition to registration. Opposition arguments are heard before the TTAB. If no party files an objection to the mark, the application moves to the final stage of the registration process.
5. Issuance of Certificate of Registration: The PTO will register the mark and issue a certificate of registration approximately three months after the conclusion of the opposition period.

Intent-to-use Federal Registration Process

If an Applicant bases the application on an intent to use the mark ("ITU") rather than on actual use of the mark, the registration process follows a slightly different path. After steps (1) through (3) above (filing the application, successfully completing a PTO examination, and waiting through the publication period) are completed, the Application proceeds as follows:

4. Notice of Allowance: The PTO will issue a Notice of Allowance approximately three months after the mark was published in the Official Gazette.
5. File Statement of Use: After the PTO issues a Notice of Allowance, the Applicant has six months to either use the mark in commerce and submit a Statement of Use, or request an extension of time in which to do so. The PTO will grant a maximum of five (5) six-month extensions for any ITU application. If a Statement of Use is not submitted within the allotted time, the application will become abandoned.
6. Acceptance and Issuance of Certificate of Registration: The PTO will inform the Applicant when it has officially approved use of the mark. After the approval, the PTO will issue the registration certificate in approximately eight weeks.