

Why choose Federal trademark registration?

In most cases, it is better to register your trademark in the Federal system, through the USPTO, because Federal registration provides far more protection than state registration. State registration only protects your trademark within the state—it cannot prevent someone else from using your mark outside of West Virginia.

Federal registration provides nationwide protection of your mark within specific categories of goods and services. This protection means the right to exclusively use the trademark and prevent other from using it, including recovering any money damages associated with unauthorized use of your trademark.

There are two important limitations for exclusive use for trademarks registered with the USPTO:

First, your trademark registration is limited to the goods and services provided by your business. For example, "Apple" is a registered trademark for technology products and software. They do not exclusively own use of the name "Apple" for shoes, clothing, restaurants, etc.

Second, you may not be able to exclude some people who used the trademark before you. For example, say you want to register the name of your meal delivery service, "Everybody Loves Raisins," with the USPTO. Then, you learn that a bakery in Kentucky has already registered "Everybody Loves Raisins" in their *State* registry, but not Federally. In this scenario, you would still be able to register Everybody Loves Raisins in the Federal system, and you would be able to do business with that mark in every state except for Kentucky. If you wanted to operate in Kentucky, you would have to find a new mark, even if you only use that mark in Kentucky and nowhere else. If you registered Everybody Loves Raisins Federally before the bakery in Kentucky tried to register it in their State system, you can stop them from using it at all. Lastly, if the company in Kentucky called "Everybody Loves Raisins" was not a bakery, but a theatre troupe that teaches acting classes, you might be able to register your mark for the food delivery service to include Kentucky as well. These two industries are so different that the USPTO reviewer might approve both, seeing the possibility of confusion as very low.

Federal registration also allows you to use the ® symbol, indicating you have a registered trademark (State registrations only allow you to use TM or SM marks). Furthermore, once you have a Federal trademark, you can register it with the U.S. Customs and Border Protection Service to prevent infringing or counterfeit products from being imported.

Important Considerations for USPTO Registration.

Not all Trademarks can be registered. The USPTO considers whether two marks are similar, and whether the goods or services attributed to each mark are related. "Likelihood of confusion" is the most common reason that the USPTO refuses an application for registration. For example, if there is already a business called "Jake's Cheeses" that makes and sells artisan cheese, the USPTO will likely refuse to register you a new trademark for your cheese distribution company, "Jacob's Queso." The two marks are just too similar. However, if your company is a furniture store called "Cheesy Jacob's Discount Furniture," then the USPTO *might* approve this trademark, because the goods provided by "Jake's Cheeses" are very different from your discount furniture. The question is really whether consumers would mistakenly believe both marks represent the same source. In this example, consumers are unlikely to think that their couch came from the same company as their cheese.

Similarity can also be visual. If your trademark is a logo, it cannot be too similar to an existing company's logo. For example, Reebok cannot use a logo that looks similar to Nike's famous "swoosh" design, even if they also include their brand name in the logo. Using the same design element is confusing for consumers, so Reebok uses a logo that identifies it as a company *other* than Nike.

In this example, both companies provide the same set of goods (shoes and clothing), so there is a high likelihood of confusion if their marks are too similar. However, when two companies provide totally unrelated goods or services, the visual similarity of their trademarks is less likely to produce confusion. Apple, Inc. uses a simple logo of an apple on all of their technological goods. Another technology-based business can never use an image of an apple on their products without creating a likelihood of confusion by consumers. But a food distribution company could still use an apple in their logo. This is because the food distribution company and the technology giant provide totally unrelated goods and services, and consumers are unlikely to think that the company that made their iPod is the same one delivering bread to their restaurant.

How to register a Federal trademark

The United States Patent and Trademark Office (USPTO) handles Federal trademark registration, which typically costs around \$300 (plus lawyer fees, if you hire a lawyer to help you—more on this later). All of the documents you need, including the application itself is available at <https://www.uspto.gov/trademark> .

You can apply for a Federal trademark based on either "use in commerce" or "intent to use." Applying based on "use in commerce" just means you are already using the mark for your business. Applying based on "intent to use" means that you have not yet started using the trademark, but intend to. When you apply based on "intent to use," you will have to start using the trademark, and will also have to pay an additional fee prior to final registration of the mark.

When you apply based on "**use in commerce**," there are four basic steps in the review:

Step 1. Application filed with USPTO.

Step 2. USPTO reviews application. If all the minimum requirements are met for application, a USPTO examining attorney reviews the application to determine whether you must meet additional requirements. If there are no additional requirements, you can proceed to the next step. If the examining attorney determines that you need to meet additional requirements, the USPTO will issue a letter explaining what those requirements are, and you have six months to submit a response addressing each of the requirements. If you have adequately meet the requirements, then you may proceed to the next step. If there are still requirements to be met, you will receive another letter, and be required to submit another response. If you ever fail to respond in the time allowed, your application is abandoned, and the USPTO keeps your application fees.

Step 3. USPTO publishes mark (usually about another month later). The USPTO publishes your mark in a weekly online publication called the Official Gazette. This allows other parties to see your mark and challenge it as infringing on their own mark or somehow harming their mark. Publication in the Gazette indicates that the USPTO is planning to register the mark, unless there is some opposition. You cannot move beyond this stage until all opposition is resolved.

Step 4. After publication and resolution of any opposition, the USPTO registers the mark.

When you apply based on “**intent to use**,” the first three steps are the same as “use in commerce.” It is at the fourth step where things change:

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Step 2. USPTO reviews application. If all the minimum requirements are met for application, a USPTO examining attorney reviews the application to determine whether you must meet additional requirements. If there are no additional requirements, you can proceed to the next step. If the examining attorney determines that you need to meet additional requirements, the USPTO will issue a letter explaining what those requirements are, and you have six months to submit a response addressing each of the requirements. If you have adequately meet the requirements, then you may proceed to the next step. If there are still requirements to be met, you will receive another letter, and be required to submit another response. If you ever fail to respond in the time allowed, your application is abandoned, and the USPTO keeps your application fees.

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Step 4. Within about two months of publication in the Official Gazette, the USPTO will issue you a “Notice of Allowance.” The Notice of Allowance indicates that you will be able to register your mark after you file a “Statement of Use” that demonstrates your use of the mark. If you are not yet using the mark in commerce, you can also file for an extension. Extensions are granted for six months at a time, and you may be granted up to five extensions total.

Step 5. A USPTO examining attorney reviews your Statement of Use, and determines whether your mark meets requirements for Federal registration. If the examining attorney determines that you need to meet additional requirements, the USPTO will issue a letter explaining what those requirements are, and you have six months to submit a response addressing each of the requirements. If you have adequately meet the requirements, then you may proceed to the next step.

Step 6. The examining attorney approves your Statement of Use, and your mark is registered Federally.

Depending on which application method you use, the strength of your mark, and whether your mark is challenged, the registration process can vary from several months to more than two years. Before beginning the process, you should make sure that your trademark is protectable as a unique trademark, and consider how difficult it will be for you to protect your mark, as well.

Here are some questions to consider before you apply for a Federal trademark:

(1) Who has the right to register the mark? Who owns, and is using the mark? This is who should apply for registration.

(2) Is the mark acceptable? Generally, a trademark will not be registered if it:

- Is immoral, deceptive, or scandalous.
- Disparages or falsely suggests connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.
- Consists of or comprises the flag or coat of arms or other insignia of the United States, any state or municipality, or any foreign nation, or any simulation of these.
- Is the name, signature, or portrait of a living person without written consent of that person.
- Is deceptively misdescriptive.
For example: a company that makes imitation leather cannot register the trademark “True Hide” because it deceives customers into thinking that they make a real leather product.
- Is merely descriptive or geographically descriptive.
For example: a yogurt shop may not be able to obtain trademark protection for the name “Creamy Yogurt,” because that is merely descriptive. Similarly, “West Virginia Landscapers” may be confusing to consumers who cannot differentiate this landscaping company from other landscaping companies in West Virginia. For marks that are merely descriptive or geographically descriptive, a corporation can earn trademark protection once those marks earn “secondary meaning.” If “Creamy Yogurt” advertised extensively and became very well known to consumers as a specific company, it might be able to demonstrate that its name, though merely descriptive, has achieved “secondary meaning” and can be protected by trademark. Achieving secondary meaning is costly and risky, not to mention easily avoided by choosing a stronger mark to begin with.
- Is merely a last name.
- Resembles a mark registered or a mark or trade name used and not abandoned as to cause confusion.
For example: it is unlikely that a computer manufacturer will get trademark protection for the mark “Apple Pie Computers” or for a logo of an apple, since those marks may cause confusion between that company and the existing Apple computers company.

(3) Is the mark available? Before going through the trouble of preparing a filing, you must make sure that the mark does not conflict with an existing mark. The USPTO has a search function called the Trademark Electronic Search System (TESS) available at <http://tmsearch.uspto.gov>. TESS will not include trademarks that are only registered in a state, or that are common law trademarks, though, so you should use several methods to research the availability of your mark. See the next section for more information on trademark searches.

(4) How much is this going to cost? The USPTO maintains a comprehensive spreadsheet of fees at <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#TM%20Process%20Fee>. How much you owe in your initial application and at various stages in the process depends on the specifics of your application. For example, the initial application fee ranges between \$225 and \$400, depending on which filing option you choose. The cheapest option may not be the best choice for you, as each choice comes with a specific set of requirements. You should consult an attorney for clarification on the application fees and best method of application for you.

Conducting a Trademark Search

The USPTO has a free search system called the Trademark Electronic Search System (TESS) available at <http://tmsearch.uspto.gov> (or just search "TESS" on the USPTO.gov website). You can also access the TESS database by visiting the Patent and Trademark Resource Center, located in the Evansdale Library at West Virginia University, in Morgantown.

When a trademark is registered, the USPTO uses certain descriptive words and phrases to log it in the database. You can search TESS using words and phrases that you think describe your own mark, in order to see if similar marks exist.

While TESS will help you find trademarks similar to your own, and help you decrease the likelihood of having your application for registration rejected, it cannot help you locate any "common law" trademarks.* TESS does not search state trademark databases, or business name databases, either.

After making sure that no other mark conflicts with yours, you may proceed to simply fill out the application and submit your payment, then wait.

Do I need a lawyer?

In short, yes. A lawyer can help you decide first whether Federal registration is the right choice for you. A lawyer can also help you perform searches of the databases to make sure there is not a conflicting trademark already in use. Though the search sounds simple, it can be very complicated and technical. The application process can also be complex, and a lawyer can help you perfect your application before you spend money applying. Please contact the Entrepreneurship and Innovation Law Clinic at the WVU College of Law for any questions, or for help applying for a trademark. Librarian Marian Armour-Gemmen at the WVU LaunchLab on the Evansdale campus can also help you conduct a search of both the State and Federal systems.

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* The best way to find similar common law trademarks is just to search the internet and articles that mention or reference marks that might be similar to yours.