

# Trade Marks in the United States



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## Introduction

Trade mark rights in the United States arise from use of a trade mark, not registration. However, a registration acts as a public record of your trade mark, and places other possible users of the same or confusingly similar marks that you already holds rights in the trade mark throughout all fifty states. Whilst registration is not mandatory in the United States, registration is highly recommended; proving the existence of unregistered rights in your trade mark is difficult, very expensive, and at best, can show rights only in those States where you can show you have actively used the trade mark.

Therefore, a trade mark registration for a business, brand or product name, a logo, slogan or other trade mark provides a business with the most effective and least expensive way to prove trade mark rights in the United States.

Registration acts as prima facie proof of the Proprietor's entitlement to the trade mark. If a third party believes that it has a better right to a trade mark than the registered owner, the third party will have to apply to the United States Trademark Trial and Appeal Board ("TTAB") to have the registration cancelled, which can be a long and expensive procedure, with a number of procedural and evidential hurdles to overcome.

The indicia of federal registration, ®, indicates to the world at large that the trade mark has achieved registration and accordingly, the trade mark will be protected under the United States Lanham Act of 1946. If a trade mark has not been registered, use of the ® marking constitutes false marking and can jeopardize enforcement of trade mark rights.

Importantly, registration for a trade mark can be sought for a trade mark before the mark is used, provided that there is an actual intention to use the trade mark. An application can mature to a registration once proof of use has been accepted with the United States Trademark Office ("USPTO"). It is also possible to obtain a trade mark registration in the United States based upon trade mark rights that have already been recognised in foreign countries that hold trade mark treaties and alliances with the United States.

An action for trade mark infringement can be brought without proof that the trade mark owner has suffered any damages.

Filing an application results in the details of the trade mark being captured on the database at the USPTO. Most businesses when assessing whether to adopt a new trade mark conduct trade mark searches to ensure that no trade mark complications are likely to arise. Consequently, it is likely that any third parties which might otherwise unwittingly make use of the trade mark will be alerted to the trade mark owner's prior rights.

Unlike other forms of intellectual property protection, registered trade mark protection can last indefinitely provided renewal fees are paid.

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## Should I conduct a search?

As a matter of course, well-advised businesses conduct a number of searches before adopting

a new trade mark in the United States ("Mark"). The purpose of a trade mark search is to ensure that there are no identical or similar trade marks already in use in the United States, or on the trade mark registers of the USPTO (the Federal Register) or any of the fifty States (the individual state registers) covering identical or similar goods or services to those of the Mark ("Earlier Marks"). If there are, the owner of any such Earlier Mark may be able to bring a lawsuit for trade mark infringement. Searches should also be conducted for company names, domain names and in journals and trade directories in the relevant business sector.

If the trade mark search identifies a risk, then an assessment needs to be made as to whether such risk constitutes a serious commercial threat. If so, an alternative trade mark may need to be developed and the search procedure repeated.

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## What can be registered as a trade mark?

Under the United States Lanham Act of 1946, a trade mark is any sign capable of being represented graphically which is capable of distinguishing the goods or services of its owner from the goods or services of another. This not only covers words, but also logos, 3D shapes, sounds, colours, images, moving images and smells.

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## Where should I register a trade mark?

As intellectual property rights are territorial in nature, it will be necessary to conduct searches and file applications in each country of interest. However, there are various international arrangements that can simplify this procedure. These include the European Union trade mark system where a single application that covers the entire EU and "International Registrations" under the Madrid Protocol. Also, if an application is filed, for example in the United States or in the United Kingdom, then you will have a period of 6 months to assess whether to file applications in other countries. If you do so, then the second application is permitted the claim the same effective filing date as the first application.



## What is the process?

In order to obtain a United States Trade Mark registration, an application has to be filed with the USPTO.

Alternatively, an application can be made for an International registration including a request that the trade mark rights be honored in the United States.

For trade mark purposes, goods and services are sub-divided into 45 "Classes". When an application is made for a trade mark, the Applicant must identify the goods and services on which the Applicant is using, or intends to use, the trade mark. The higher the number of classes applied for, the greater the scope of protection afforded by registration. It should, however, be borne in mind that as there is an additional fee for each class, the cost of applying for the trade mark registration increases commensurately with the number of classes. Also, designating a greater number of classes increases the likelihood of encountering problems with Earlier Marks.

Once the application has been filed with the USPTO, the application is assigned an application number and filing date. The application date can be of particular importance because for certain applications, the filing date is considered to be the "first use" date of the trade mark in the United States, once the trade mark is registered.

The USPTO will then examine the application, and if any issues arise, will issue an Office Action refusing the registration on specific grounds. There are a number of grounds upon which the USPTO will provisionally refuse an application. The principal grounds encountered are:

- conflicts with other registered trade marks
- that the trade mark is not considered distinctive or is merely descriptive of the goods and/or services to be provided under the trade mark
- that the descriptions of the goods or services must be modified from European practice to conform with United States practice and format.

If the USPTO does not refuse the application, or if all issues are overcome, then the trade mark will be published in the United States Trademark

Office Official Gazette. Once published, third parties have an opportunity to oppose the application. If no oppositions are filed, or if any such opposition is overcome, then the trade mark will proceed to registration. If required, proof of use will need to be filed prior to the mark being registered.

## How long does the process take?

If there are no grounds for refusal of an application, registration can be achieved within a little over six months in the United States. If objections are raised then it commonly takes 12 months or longer. Registration can also be delayed if the trade mark is not yet in use in the United States, or if applications based upon foreign rights must wait until the foreign trade mark rights are registered. Whilst the process can be lengthy, the important date is often the date on which the application was made, not when registration is obtained.

## How long does a registration last?

A United States registration has a ten year term. However, a registration can be cancelled after its sixth year if the trade mark owner has not filed proof that it is using the trade mark in the United States. Thereafter, the registration may be easily maintained for additional ten year terms so long as the trade mark continues to be used in the United States and renewal fees are paid.

## International Dimension

Intellectual property rights are jurisdictional in nature and a United States registration will not protect the trade mark outside the United States. Should you require trade mark protection outside the United States, we can provide those services either directly or through our network of international contacts.

## What is the cost?

The official fee for filing a United States Trade Mark Application is \$275-\$325 per class, depending upon the description of the goods and services. Our fees are available on request.

There will be additional legal costs incurred after filing although these will largely depend on the grounds of any rejections received from the USPTO or third parties.

If you would like further information or costs on United Kingdom or European Union trade marks then please ask for a copy of our information sheet.

### For further information on this subject please contact:

#### Dominic Farnsworth

Partner

T + 44 (0) 20 7074 8088

[dominic.farnsworth@lewissilkin.com](mailto:dominic.farnsworth@lewissilkin.com)

#### Steven Jennings

Trade Mark Counsel

T + 44 (0) 20 7074 8203

[steven.jennings@lewissilkin.com](mailto:steven.jennings@lewissilkin.com)

