

TRADEMARKING AND LICENSING FOR TRANSIT PROVIDERS

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INTRODUCTION

Transit officials need to understand the basics of trademark protection and how to create revenue by licensing intellectual property holdings. Prevention of misappropriation and loss of control over an agency's trademarks is something of immediate interest to the transit industry. An article in the *Washington Post* publication, *Express*, June 7, 2004, illustrates the trademark issues faced by the Texas Department of Transportation when it neglected to register its anti-litter slogan "DON'T MESS WITH TEXAS." It became apparent that the department had missed an opportunity to earn revenue on the licensing of the slogan when unrelated parties began to print it on T-shirts, caps, and other souvenir items. Several years later, the department obtained a registration with the United States Patent and Trademark Office (USPTO or Trademark Office) and began to protect its slogan by sending the infringers "cease and desist" letters that warned of litigation if they did not stop the unauthorized use of the slogan.

By perfecting its rights by filing for, and later obtaining, a federal trademark registration and by defending against misuse by third parties, the Texas Department of Transportation created the foundation for a revenue asset stream.

The purpose of this report is to guide the intellectual property novice through the process of protecting trademark assets. The report begins with an overview of the statutory and regulatory framework that allows for trademark ownership. This is followed by instructions on how to prepare, file, and prosecute a trademark application at the federal level. This includes details for electronic filing, references to forms, examples of verbiage, and information on government fees. Also presented are overviews regarding post-registration concerns and registering trademarks at the state level. Details on current USPTO policy and procedures along with practical advice are interspersed throughout the report. For completeness, shorter sections explain the Trademark Trial and Appeal Board (TTAB), Trademark Office organization, and international (Madrid Protocol) filings. An entire section explains licensing of trademark assets and relevant provisions to include in a licensing agreement. The report concludes with an appendix of online resources.

INTELLECTUAL PROPERTY IN GENERAL

There are four different types of intellectual property: patents, copyrights, trademarks, and trade secrets. The idea of encouraging technological progress is included in the U.S. Constitution. Article I, Section 8, reads in part, "The Congress shall have Power...to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Both patent and copyright laws stem from this clause, while trade secret protection arises from the right of businesses to protect confidential information and is state regulated.

Trademark law arises from the government's authority to regulate commerce among the states and with foreign nations. In the U.S. Constitution, Article I, Section 3, the "Commerce Clause" grants authority for regulating commerce and reads in part, "To regulate Commerce with foreign nations and among the several States..." Federal jurisdiction over trademarks only applies to marks used in interstate commerce. The reason why many states also register trademarks is to have jurisdiction over intra-state commerce.

A trademark can be any word, name, symbol, or device, or combination of these, used or intended to be used, in commerce. Trademarks indicate the source of goods or services.¹ A service mark similarly can be any word, name, symbol, or device, or any combination of these that are used or intended to be used in commerce. Trademark² registrations are indefinitely renewable and in essence may last forever, as long as the trademark is continually in use to identify goods in commerce.

Trademarks have three very important functions: to protect the trademark owner's efforts to associate the trademark with goodwill and reputation, to protect consumers from confusion as to the source of goods that they purchase, and to indicate that all goods sold under the same mark have the same level of quality. Trademarks do not need to be just words. They can be anything that identifies source. For example,

1. Letters, such as VTA,³

¹ The term "goods" will encompass both goods and services.

² The term "trademark" or "mark" will encompass both trademarks and service marks.

³ U.S. Reg. No. 2168418. Registrant: Santa Clara Valley Transportation Authority. Services: transportation of passen-

2. Numbers, such as 123 TRANSIT;
3. Slogans, such as DO THE RIDE THING!;⁴

4. Designs, such as



5. Color, such as the pink color of Owens Corning's insulation;
6. Product shape or product container shapes, such as a bus ticket shaped like a bus;
7. Building appearances, such as the shape of a Pizza Hut roof;
8. Sounds, such as the chimes used by NBC for broadcasting; and
9. Fragrance, such as the smell of plumeria blossom for thread.

LANHAM ACT

The Lanham Act⁵ provides the legal framework for seeking a federal registration for a trademark at the USPTO and describes the penalties for trademark infringement. The *Trademark Manual of Examining Procedure* (TMEP), used by both USPTO application examiners and private trademark practitioners, is the most comprehensive guidance for preparing, prosecuting, and maintaining a trademark application or registration at the USPTO. It is an invaluable source for responding to "Office Actions" or official correspondence from the USPTO. It is available and searchable online at <http://www.uspto.gov/web/offices/tac/tmep/>.

SPECTRUM OF MARKS

Marks are either inherently distinctive or non-inherently distinctive. Inherently distinctive marks are marks that are fanciful or coined, arbitrary or suggestive. Non-inherently distinctive marks include descriptive marks, generic terms, name marks, and geographic marks.

Fanciful or coined marks are terms that have no meaning but to function as a trademark and indicate origin of goods. Examples include marks like PEPSI for soda pop, EXXON for gas station services, and KODAK for cameras. Arbitrary marks are terms that are common words but are not related to the goods. For example, APPLE for computers and PUMA for shoes. Suggestive marks suggest a quality, feature, or characteristic of the goods, but require imagination or an additional step in logic to determine what the mark conveys about the goods. An example is EVEREADY for batteries.

gers and their incidental baggage by bus, van, rail, and other multi-passenger ground vehicles.

⁴ U.S. Reg. No. 2338108. Registrant: Des Moines Metropolitan Transit Authority. Services: transportation of passengers by bus.

⁵ Pub. L. No. 79-489, 60 Stat. 427 (1946) (current version at 15 U.S.C. § 1051 (2005)).

Descriptive marks are terms that identify a purpose, function, characteristic, or feature of the goods. For instance, the mark SAN DIEGO TRANSIT⁶ is descriptive for transit services because the mark immediately describes the location and the services. Descriptive terms are registrable if the applicant can show that the term has acquired distinctiveness, meaning that consumers recognize the mark as identifying a single source. The more descriptive the term, the greater the evidence the applicant must proffer to show acquired distinctiveness.

Generic terms are basically the very name of the goods and cannot ever acquire distinctiveness and function as trademarks and are therefore unregistrable. For example, SHOE for selling shoes. Generic terms must remain in the public domain because they tell the consumer what the goods are and cannot indicate source. For example, GAS STATION for gasoline stations or MOTOR OIL for motor oil would never be allowed. If a registered trademark is not properly policed, it can become generic and is therefore no longer protectable under the Lanham Act. For instance, ASPIRIN was once a registered trademark, but now has become the generic name for a certain type of painkiller. Similarly, SUPERGLUE was a registered mark but has now become generic for a certain type of glue.

TYPES OF MARKS

Marks at the Trademark Office fall into three different categories. First, trademarks, as discussed above, can be words, letters, designs, combinations of words or letters, color, product shape, sounds, etc., and indicate that the goods come from a particular source.

Second, trademarks can be collective marks, used by the members of a cooperative, an association, or other collective groups to indicate that particular goods come from a member of the applicant's organization or that the user of the mark is a member of the applicant's organization, such as the mark INTERNATIONAL BROTHERHOOD OF TEAMSTERS for the transportation, maintenance, and handling labor union.⁷

Third, trademarks can also be certification marks used by persons other than an owner to certify:

1. Regional or other origin of the goods or services;
2. Material, mode of manufacture, quality, accuracy, or other characteristics of the goods or services;
3. That the work or labor on the goods or services was performed by members of a union or other organization.

The purpose of certification marks is to inform purchasers that the goods of a person possess certain characteristics or meet certain qualifications or standards established by another person. The message conveyed

⁶ U.S. Reg. No. 2180474. Registrant: San Diego Metropolitan Transit Development Board. Services: transportation of passengers by means of bus.

⁷ U.S. Reg. No. 1994996.

by a certification mark is that the goods have been examined, tested, inspected, or in some way approved based upon methods determined by the certifier or owner. For example, the mark TEAMSTERS I.B. OF T.C.W. & H. OF A. UNION SERVICE⁸ for brewery products, dairy products, and a wide variety of novelty items, which is used by manufacturers to indicate that a product was produced by members of the Teamsters Union.

PROTECTING TRADEMARKS BEFORE OBTAINING FEDERAL REGISTRATION

Overview of Common-Law Rights

It is helpful to view trademark rights as a collection of rights along a continuum that are accumulated by a series of actions creating goodwill or reputation associated with a mark. Common-law rights arise from use of a trademark as an indication of source and are defendable without approval from an outside authority if the holder of the trademark uses it and protects it in a valid manner. Using a trademark in a valid manner generally means using it as a way to “brand” goods in commerce, indicating that the goods originate from a particular source. Using a trademark in a valid manner in practice should include asserting one’s rights in a mark by giving notice to the public. Notice to the public can include such things as superscripting a “TM” or “SM” after the information one claims as a trademark or service mark. Another way to give notice of one’s proprietary interest in a trademark is notice statements. Similar to copyright notices, they are statements placed in an obvious place and plainly stating that the information indicated is property of the owner and is their intellectual property. In addition, making a proprietary claim to a trademark can include calling upon infringers when their existence is revealed. Making proprietary claims to the mark builds goodwill or a reputation that is associated with the mark, bolstering the rights of the owner and moving him or her further along the continuum.

Common-law rights normally extend only to the actual geographical area where the mark is used, such as within state boundaries or across a region. Continuing to use the mark within the geographic boundaries is not affected by confusingly similar marks outside of the territory unless those marks are U.S. registrations or were used in the geographic territory first. The situation can become complicated if the owner of a trademark wishes to expand his or her market into another geographic area. At this point, the trademark owner must conduct a common-law search to ascertain whether there exists a prior owner of the mark within that new territory. Knowingly using a mark of another is willful infringement and is cause for action by the owner of the mark with superior rights. The most common method of putting others on notice outside of the

initial territory regarding use and intent is by filing a U.S. trademark application.

PREPARING A U.S. TRADEMARK APPLICATION

Benefits to Filing for U.S. Trademark Protection

Giving the public notice of one’s proprietary interest in a trademark to achieve a greater scope of protection can take several forms, but the most comprehensive and legally binding way (within the U.S. market) is to file for federal trademark protection with the USPTO. The benefits of filing a trademark application include giving public notice as to the source and origin of a good or service, establishing one’s superior interest in a trademark, and gaining presumptions of law and fact in federal court. In fact, if the trademark is not in use in commerce at the time of filing the application, filing the application can actually substitute for use in order to give public notice because under U.S. law, an intent to use a trademark is all that is needed to file. Again, merely having intent to use a trademark in commerce and filing a federal application on that basis will help to move the owner further along the continuum.

INFORMATION REQUIRED

Prior to filing a federal trademark application, it is important to gather documentation that proves the applicant or the mark itself meets specific requirements for filing. A substantiation file should include items that will help to verify the claims made in the application about the mark, such as an invoice evidencing a first sale in interstate or foreign commerce, information concerning the inception of the mark, minutes from a meeting, or advertisements, etc. This information should support the date of first use and the date of first use in commerce because both must be verifiable.

TMEP Section 202 reiterates the provisions of 37 C.F.R. § 2.21, setting out the minimum requirements in an application for the applicant to receive a filing date with the USPTO. They are

- The name of the applicant,
- A name and address for correspondence,
- A clear drawing of the mark,
- A listing of the goods or services, and
- The filing fee for at least one class of goods or services.

If an application does not meet these basic requirements, the USPTO returns the application to the applicant or the applicant’s attorney. The fee is then lost and the applicant must re-file.

SEARCHES

USPTO Database Searches

Searches are normally conducted when the owner of a trademark wants to begin the process for filing a fed-

⁸ U.S. Reg. No. 1286640.

eral application. Generally, the search helps ascertain the chances for viability through the examination process and beyond. A properly completed search will identify whether any confusingly similar marks exist that could pose a bar to registration at the USPTO or preclude use in the marketplace. A search can also make a trademark owner aware of potential problems such as the existence of another entity that is misappropriating the mark or unfortunately, in some cases, an owner of a confusingly similar mark with superior rights. There are many variations on what to include in a search; however, the knock out search is one of the most expedient. The knock out search helps eliminate the possibility that there are confusingly similar marks in the current USPTO database. Usually, without considering any other source of information except the USPTO database, the researcher attempts to replicate a plausible search that a USPTO examiner would conduct when he or she examines the application. This type of search is the most cost-effective for revealing pending or registered marks that may prove to be an obstacle to registration. A knock out search is not comprehensive because of its limited source of information.

Comprehensive Searches/Hiring a Search Firm

Outsourcing the trademark search to a trademark search firm does offer an opportunity to perform a more comprehensive search. Search firms offer a variety of search tools and options. These options can include searches of the current USPTO database, state and corporate trademark records, the World Wide Web, international databases, and other sources of information such as phone listings and business-vetting databases to determine whether there is a trademark that could be confusingly similar to the trademark being searched. An outsourced, comprehensive search can be much more costly and may take longer than a knock out search of the online database. Please note that if a comprehensive search does not turn up any problematic marks, there is still no guarantee that the trademark in question will pass scrutiny under examination. It does, however, increase the chances that a confusingly similar trademark does not exist in the marketplace. In some cases, a comprehensive search can actually be more cost-effective in the end if the mark will have a wide scope of exposure in the marketplace or if potential exists within the industry for infringement.

An entire industry exists to perform confusingly similar trademark searches. The options and costs vary, and spending a minimum of \$500 for a basic search and report is common. Analysis of the report and advice on whether to proceed to file for a trademark usually costs extra, regardless of the type of search conducted.

SPECIMENS

Specimens demonstrate that the applicant properly uses the trademark in commerce and on or in connection with the particular goods. The applicant declares that the specimens submitted were in use for the goods

at the time of filing the application. TMEP Chapter 904 addresses specimens and reads in part, “An application for registration under §1(a) of the Trademark Act must include one specimen showing use of the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.”

The Lanham Act requires that a trademark be used on “goods in trade” as opposed to merely used on “goods.” TMEP Chapter 1202.06 defines “goods in trade” as

having “utility to others as the type of product named in the application.” Therefore, goods that are ancillary to one’s business are not “goods in trade” and do not prove proper use of a trademark in commerce. The most common example is the use of letterhead and business cards. Unless a business is in the business of producing or selling business cards, business cards are not “goods in trade” and are therefore not proper specimens to demonstrate use of the trademark in commerce.

Acceptable specimens for goods according to TMEP Chapter 904.04 include such items as “a label, tag, or container for the goods, or a display associated with the goods. [cite deleted]. A photocopy or other reproduction of a specimen of the mark as actually used on or in connection with the goods is acceptable.”

This section addresses at length the various scenarios that may arise when submitting specimens and is a valuable reference if specimen questions arise.

TMEP Chapter 904.06(a) discusses catalog displays as valid specimens for goods in trade. The decision in *Lands’ End Inc. v. Manbeck*⁹ requires examining attorneys to accept a catalog as a specimen as a display associated with goods in trade, when,

(1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods, (e.g., a phone number, mailing address, or e-mail address). Any form of advertising that satisfies these criteria should be construed as a display associated with the goods. It is not necessary that the specimen list the price of the goods.

Acceptable specimens for services normally consist of advertisements, displays, or signage. TMEP Chapter 1301, “Service Marks,” reiterates Section 45 of the Trademark Act, defining a service mark as

any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks not-

⁹ 797 F. Supp. 511, 24 U.S.P.Q.2d (BNA) 1314 (E.D. Va. 1992).

withstanding that they, or the programs, may advertise the goods of the sponsor.

The best example of a specimen that shows use of a service mark is an advertisement in which the mark is used in close proximity to a description of the particular services provided. Currently, Web sites are a common example of a proper specimen when they display the respective trademark and indicate the services within close proximity to it. A more traditional example is a newspaper advertisement.

An issue concerning the submission of proper specimens needing clarification is whether a design in the center of a T-shirt, hat, or bumper sticker, for instance, can function as a trademark. In the case of a logo design trademark placed on a T-shirt, the mark only functions as a trademark if it indicates source and consumers do not view it as being just decorative. Placing the same design on the label of the T-shirt or in a location on the T-shirt that is common for branding, such as on the pocket or left hand shoulder, would then make it an acceptable specimen. Owners of decorative logos that do not function as valid trademarks can normally find protection for their design under copyright law.

The USPTO currently prefers digital depictions of specimens. The rules governing electronic submissions of specimens are found at TMEP Section 904.02, entitled, "Electronically Filed Specimens." Details about how to file applications electronically are covered in depth later in this report.

INTENT-TO-USE AND USE-BASED APPLICATIONS

Intent-to-Use Applications

TMEP Chapter 1100 addresses Intent-to-Use (ITU) Applications. An ITU application finds its basis solely on a bona fide intent to use the mark in commerce. The applicant avers an intent to use the mark in commerce as opposed to swearing to actual use. The information needed to file an ITU is similar to that of a use-based application except that there is no need to submit dates of first use, first use in commerce, or specimens. Furthermore, the applicant signs a sworn statement attesting to an intent to use the mark, as opposed to verifying its use in commerce. An ITU application is subject to the same initial procedural examinations as a use-based application, in that the basic requirements to secure a filing date must be met to obtain a Serial Number. Once these items are verified, the application continues onward to be examined by an examining attorney for legal sufficiency. Examination of an ITU application is the same for a use-based application. If the ITU application is cleared by the examiner, it will then move to the next step, which is publication. However, it cannot mature to a registration until there is use.

Additional Procedural Filings for ITU Applications

The applicant files an Amendment to Allege Use (AAU) when there is use of the trademark before publication. In this instance, the applicant files an amend-

ment to the existing application averring use in interstate commerce and offering proof in the form of specimens. A signed declarative statement supporting the dates asserted and that the specimens are valid is required. If the AAU is accepted, the application then converts to a use-based application. After passing examination, the application then moves to publication, where it is published as a use-based application.

When the applicant uses the mark after publication, he or she must file a Statement of Use (SOU) instead of an AAU. Once an application makes it through the publication without an opposition or other problem, the USPTO then issues a Notice of Allowance. This notifies the applicant that he or she must submit an SOU along with a valid specimen within 6 months or risk abandonment of the trademark application. The USPTO will grant extensions to file the SOU for a fee if needed.

Use-Based Applications

The information required to file a use-based application is identical to that of an ITU; however, in the case of a use-based application, the date of first use, the date of first use in commerce, and a specimen must accompany the initial filing of the application. Proof of the date of first use in commerce must evidence that a sale of the goods took place in interstate commerce using the trademark. The most common way to prove the date of first use in commerce is a copy of an invoice or other business transaction document. Evidence supporting the dates of use is not required to be filed with the application because the declarative statement swears that such dates are true.

Declarative Statements

TMEP Chapter 804.01(b) addresses declarative statements. Declarative statements are averments that must accompany the application. The signer avers that the information within the application is true and correct to his or her knowledge and can be legally relied upon. The declaration statement is placed at the very end of the application and warns the applicant that willful false statements are punishable by law. When filing electronically, the declaration statement is automatically placed at the end of the application and just above the signature line.

The standard declaration reads,

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or

in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

AUTHORIZED SIGNATURE

An acceptable signature for a federal application is defined in 37 C.F.R. § 2.33(a) as “a person properly authorized to sign on behalf of an applicant.” TMEP Chapter 804.04 clearly states that examiners are not required to question the authority of the person who signs the application unless there is an inconsistency between the signature and other information or if there is any other indication that the information is inaccurate. The signature on the application is “fresh” and acceptable for a period of 1 year from the date of signing.

POWER OF ATTORNEY AND APPOINTING A DOMESTIC REPRESENTATIVE

TMEP Chapter 600 covers the requirements and information concerning the attorney of record and the domestic representative for receiving official correspondence. A U.S. trademark application may be filed pro se, or by a nonlawyer on behalf of themselves. If the applicant is represented by an attorney, there must be a Power of Attorney granting authority to this person to act on the applicant’s behalf.

Appointment of a domestic representative is required when the applicant is a foreign entity. TMEP Chapter 600, Section 604, addresses the detailed requirements in this instance.

DRAWING PAGE

TMEP Chapter 800, Section 807, details the requirements for submitting a drawing or depiction of the mark. The drawing page will normally depict the mark in isolation and provide only the bare minimum identifying information. The drawing page does not include statements, signatures, or any other aspect of the application. The drawing page should only include identifying information such as the name of the applicant, the International Classes filed for, whether the application is a use-based or ITU application, and, if a use-based application, the dates of first use in commerce.

Proprietary markings of TM or SM, and obviously ®, are not necessary because they are not part of the mark and can cause delay if present. TMEP Section 807.01(b) sets out the size requirements for a paper-filed drawing page. It requires that the drawing be between 2.5 in. (6.1 cm) and 4 in. (10.3 cm) high and/or wide. Electronically filed applications have the drawing page automatically generated during the online filing process. For worded marks, the filer simply types the word or words into a box on the electronic application. Trademarks with graphic elements are uploaded. The USPTO Web site provides instructions regarding the size re-

quirement for electronically filed applications so that a drawing page will automatically be generated. Currently, the requirements are the following:

All black-and-white jpg images and color jpg images should be scanned at no less than 300 dots per inch and no more than 350 dots per inch, and within the pixel range suggested by the USPTO, namely, a length and width of no less than 250 pixels and no more than 944 pixels; *e.g.*, a valid pixel dimension is 640 X 480 pixels.¹⁰

USPTO FEES

Calculate the application fees for filing an application by multiplying the number of International Classes (ICs) by the filing fee. Effective January 31, 2005, trademark fees are \$325 per international class if filing electronically using the Trademark Electronic Application System (TEAS) and \$375 per international class if submitting a paper application. Payment options for filing an application or amendments and affidavits include a check or money order, cashier’s check, credit card, or USPTO deposit account. In the case of electronic filings, only a credit card, a USPTO deposit account, or an electronic bank transfer are accepted. Filing electronically is the most convenient and cost-effective method currently available to file an application or other documents because the required fees can be easily processed, and confirmation can be nearly instantaneously emailed to the filer.

FEDERAL PROSECUTION

Examination Process Overview

Once an applicant files an application, it is scanned into an electronic database that is accessible online at the USPTO Web site. The USPTO mails or emails a filing receipt that confirms the date of filing and reports the assigned serial number. Closely examine the filing receipt for typos and inaccurate information. Mistakes and misspellings in the applicant’s name, address, etc., are common and can result in incorrect information on the registration certificate. Therefore, correct any mistakes immediately if possible. After the initial review, the application is assigned to a trademark examining attorney, or examiner.

The Search

One of the first things that an examiner does is to search the Federal Register to determine if there are any marks similar to the mark she is currently examining (known in Trademark Office parlance as “2(d) cites” or simply “cites”). This search is a very comprehensive search and is performed using internal software called “X-search.” The examiner has extensive training in X-search, and the search will undoubtedly find cites that the average trademark applicant will not find by way of a search of the online USPTO Trademark

¹⁰ Found at <http://teas.uspto.gov/V2.0/bas250/teahelp.htm>.

Electronic Search System (TESS). This is why there is a very strong disclaimer on the Web site which states, "Warning: after searching the USPTO database, even if you think the results are "o.k.," do not assume that your mark can be registered at the USPTO. After you file an application, the USPTO must do its own search and other review, and might refuse to register your mark."

SUBSTANTIVE REFUSALS

After the search, the examiner will review the mark to see if it falls into any of the categories of marks that are not allowed on the Register. Lanham Act Section 1052, subsections 2(a) through 2(f), covers substantive refusals. The first refusal, 2(a), states in part, "No trademark...shall be refused registration on the Principal Register...unless it...consists of or comprises immoral, deceptive or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols or bring them into contempt or disrepute."

There are four types of marks that are refused based on Section 2(a):

1. Scandalous or immoral marks;
2. Deceptive marks;
3. Marks that suggest a false connection with living or dead persons, institutions, beliefs, or national symbols; and
4. Marks that are disparaging of living or dead persons, institutions, beliefs, or national symbols, or that bring them into contempt or disrepute.

The test to determine if an applicant's mark is scandalous or immoral is whether the mark is shocking to the senses or gives offense to the conscience or moral feelings of a substantial composite of the public. Marks are often refused if they offend religious, ethical, political, or patriotic beliefs, or if they identify sexual activities or describe bodily functions as being scandalous or immoral. For instance, the mark BULLSH*T for handbags, purses, belts, and wallets was refused under 2(a) because it was deemed vulgar. However, WEEKEND SEX for magazines was registrable.

Section 2(a) also covers deceptive marks. The test to identify deceptive marks consists of three parts. First, the marks must misdescribe the applicant's goods or services. Second, the misdescription must be plausible and likely for consumers to believe it is true, and third, the misdescription must materially affect the consumer's decision to purchase. Marks refused under this subsection often misdescribe the applicant's goods with regard to material content or some other significant feature of the mark. For example, COTTON COMFORT for underwear that is made of polyester or PRO'S TITANIUM SHAFT for golf clubs that do not contain titanium.

Section 2(a) also refers to marks that make a false connection to something or someone. The test to identify a false connection also consists of three parts. First,

the mark is the same or a close approximation of the name or identity of a person, institution, belief, or national symbol and would be recognized as such. Second, there is no connection between the person, institution, belief, or national symbol and the goods of the applicant. Third, the fame or reputation of the person, institution, belief, or national symbol is such that a connection is presumed. For example, GATESWARE for computer software would be refused registration under this subsection, unless consent from Bill Gates was evidenced in the application.

The test to identify marks that are disparaging or bring a person, institution, belief, or national symbol into disrepute or contempt has two prongs. The first question is whether the mark refers to a person, institution, belief, or national symbol. The second question is whether the mark would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. For instance, CRAZY HORSE for alcoholic beverages was refused under Section 2(a) because it was deemed offensive to American Indians.¹¹

The next refusal, addressed in Section 2(b), states in part, "No trademark...shall be refused registration on the Principal Register...unless it consists of or comprises the flag or coat of arms or other insignia of the United States or of any State or municipality, or of any foreign nation, or any simulation thereof."

Actual flags, coats of arms, or insignias or close simulations of these are unregistrable. Designs that suggest a prohibited symbol or that are so stylized as to mirror it are registrable. Therefore, a mark consisting of the U.S. flag is refused registration, but a stylized version of the U.S. flag would be allowed to register.

The next refusal involves obtaining consent before using the name, picture, or signature of a living individual or dead president. Section 2(c) states in part,

No trademark...shall be refused registration on the Principal Register...unless it consists of a mark which...consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent or the name, signature or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Consent is required if the mark includes full name, surname, given name, pseudonym, stage name, nickname, title, or portrait or any combination of these that would identify a particular living individual. For instance, the mark MARIO ANDRETTI for high perform-

¹¹ The seminal 2(a) cases include *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 U.S.P.Q.2d (BNA) 1923 (Fed. Cir. 1988); *In re Budge Mfg. Co., Inc.*, 857 F.2d 773, 8 U.S.P.Q.2d (BNA) 1259 (Fed. Cir. 1988); *In re Perry Mfg. Co.*, 12 U.S.P.Q.2d 1751 (TTAB 1989); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635 (TTAB 1988); and *University of Notre Dame de Luc v. J.C. Gourmet Food Imports Co., Inc.*, 217 U.S.P.Q. (BNA) 505 (Fed. Cir. 1983).

ance auto tires would be refused under this subsection unless Mr. Andretti consented to the use of his name.

The most common refusal made by examining attorneys is a Section 2(d) refusal. Section 2(d) states in part,

No trademark...shall be refused registration on the Principal Register...unless it consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office...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.

The standard is whether there is a likelihood of confusion between the marks. This involves a two-part analysis. First, are the marks similar, and second, are the goods related? To determine whether the marks are similar, the examiner will consider the sound, appearance, and meaning of the marks. To determine if the goods are related, the examiner will consider factors such as whether the goods are used together or if they are sold together, displayed together, or advertised with the same marketing methods or within the same channels of trade.

The major case in this area is *In re E. I. du Pont de Nemours & Co.*¹² During the examination period, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. The following factors are usually the most relevant:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- The similarity or dissimilarity of established, likely-to-continue trade channels;
- The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
- The number and nature of similar marks in use on similar goods; and
- A valid consent agreement between the applicant and the owner of the previously registered mark.

Furthermore, *doubt must be resolved in favor of the registrant*. It is important to remember that the test is likelihood of confusion, not actual confusion or the possibility of confusion. Important cases include *In re Great Lakes Canning, Inc.* (227 U.S.P.Q. 483 TTAB 1985), in which the mark CAYNA for soft drinks was held likely to be confused with the mark CANA for canned and frozen fruit and vegetable juices because they sound similar and the goods are related; *Weiss Assoc. Inc. v. HRL Assoc.*, 14 U.S.P.Q.2d 1840, in which the mark TMM was held confusingly similar to the mark TMS,

because of similarity in appearance of the marks and because they are both for computer software; *In re Nationwide Indus. Inc.*, 6 U.S.P.Q.2d 1882 TTAB 1988, in which the mark RUST BUSTER for rust-penetrating spray lubricant was held likely to be confused with BUST RUST for penetrating oil since the marks are essentially transpositions of each other and the goods are related; and *Gastown Inc. of Delaware v. Gas City, Ltd.*, 187 U.S.P.Q. 760 (TTAB 1975), in which the mark GAS CITY was held likely to be confused with GASTOWN, both for gasoline, because the marks are similar in meaning and the goods are identical.

After 2(d) refusals, the most common refusals issued are descriptive refusals. Section 2(e)(1) states in part, “No trademark...shall be refused registration on the Principal Register...unless it consists of a mark which when used on or in connection with the goods of the applicant is merely descriptive or deceptively mis-descriptive of them.”

If the mark merely describes an aspect of the applicant’s goods, it cannot be registered on the Principal Register. The aspect described can be any ingredient, characteristic, function, quality, feature, purpose, or use of the applicant’s goods. In addition, laudatory terms, which extol the quality or excellence of the applicant’s goods, are descriptive, such as AMERICA’S FINEST TRANSIT.¹³

One way to think about this refusal is that words that describe a feature, characteristic, etc., of a good are probably needed by others in the industry to describe and promote their goods too. This prohibition exists so that no one supplier has an exclusive right to use such words. For instance, consider the imaginary trademarks, KWICK TRIP TRAIN for a new “bullet” train line, YOUR GAS BUS for buses fueled by natural gas, or PAPER TOKEN for fare cards. If only a portion of a mark is found descriptive or generic, then the examiner will require a “disclaimer” of the descriptive portion of the mark and allow the mark as a whole to continue through the process.¹⁴

Sections 2(e)(2) and 2(e)(3) discuss geographic descriptiveness and read in part,

No trademark...shall be refused registration on the Principal Register...unless it consists of a mark which...

(2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them or

¹³ Example based upon the case *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USP2 1056 (Fed. Cir. 1999), in which the Federal Circuit affirmed the TTAB’s refusal to register the mark BEST BEER IN AMERICA.

¹⁴ The seminal 2(e)(1) cases include *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 189 U.S.P.Q. (BNA) 759 (2d Cir. 1976); *In re Shutts*, 217 U.S.P.Q. (BNA) 36 (TTAB 1983); *In re Cryomedical Sciences, Inc.*, 32 U.S.P.Q.2d (BNA) 1277 (TTAB 1994); *In re Conus Communications Co.*, 23 U.S.P.Q.2d (BNA) 1717 (TTAB 1992) and *In re Ox-Yoke Originals, Inc.*, 222 U.S.P.Q. (BNA) 352 (TTAB 1983).

¹² 476 F.2d 1357, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973).

(3) when used on or in connection with goods of the applicant is primarily geographically deceptively misdescriptive of them.

The test for determining whether a mark is primarily geographically descriptive under Section 2(e)(2) is:

1. The primary significance of the mark must be geographic;
2. The applicant's goods or service must originate in the geographical place identified in the mark; and
3. A goods/place or services/place association must be shown to exist, so that the public is likely to believe that the goods or services do originate in the place identified in the mark.

Examples of marks that may be considered geographically descriptive include WASHINGTON STATE TRANSIT AGENCY for a transit agency within the State of Washington or WINDY CITY TRANSIT for bus services located in Chicago.¹⁵

Similarly, the test for determining whether a mark is primarily geographically misdescriptive under Section 2(e)(3) is:

1. The primary significance of the mark must be geographic;
2. The applicant's goods or service *do not* originate in the geographical place identified in the mark; and
3. A goods and place or services and place association must be shown to exist, so that the public is likely to believe that the goods or services do originate in the place identified in the mark.

For example, the mark PARADISE ISLAND AIRLINES for airline services and the mark LONDON & EDINBURGH INSURANCE for insurance services are geographically descriptive. The mark NEW ENGLAND for freshly baked bread and rolls not produced in New England is geographically misdescriptive. Other imaginary examples are IN A NEW YORK MINUTE purporting to be the fastest of trains in Iowa City or WE CAN HELP YOU CROSS EVEN THE GRAND CANYON for para-transit in San Francisco.¹⁶

The last descriptive refusal is Section 2(e)(4), which states in part, "No trademark...shall be refused regis-

tration on the Principal Register...unless it consists of a mark which...is primarily merely a surname."

If there is an additional element to the mark that is registrable, the mark is not considered primarily merely a surname and is not subject to a 2(e)(4) refusal. In general, if the surname is combined with a distinctive design or stylization that can "carry the mark," it is not primarily merely a surname. For example, a mark is not primarily a surname if it has a nonsurname meaning or double meaning, such as the surname WOLF. A mark is not primarily a surname if it has a meaning as a given name, such as TAYLOR. Similarly, a mark is not primarily a surname if it is a given name and a surname together, such as SARA JOHNSON, or it is combined with a capable non-generic term, such as ABSOLUTELY JOHNSON.

Additional elements to a proposed surname mark that will not help it overcome a rejection as primarily merely a surname include elements such as:

- Courtesy titles, such as MRS. JOHNSON;
- Preceding initials, such as S. M. JOHNSON;
- Plurals or possessives, such as JOHNSONS or JOHNSON'S;
- A nondistinctive design, such as a simple border around the name JOHNSON;
- Incapable generic terms, such as JOHNSON SHOES; or
- Informational material, such as JOHNSON COMPANY.

ACQUIRED DISTINCTIVENESS AND THE SUPPLEMENTAL REGISTER

When the examiner determines that the entire mark is descriptive under any of the subsections of 2(e) and the applicant or their attorney's arguments have not been persuasive in changing the examiner's mind, the applicant can still obtain a registration by amending to what is called the Supplemental Register or by claiming Section 2(f) Acquired Distinctiveness.

The Supplemental Register is an alternative register to the Principal Register. Trademark applications for marks that are capable of distinguishing an applicant's goods, but that do not qualify for inclusion on the Principal Register, may seek registration on the Supplemental Register. Because registration on the Principal Register is superior to registration on the Supplemental Register, marks eligible for inclusion on the Principal Register cannot be included on the Supplemental Register. A mark must be in use before the application is eligible for inclusion on the Supplemental Register; therefore, if the application is an ITU application, an AAU must be submitted and approved before the mark is registered.

There are some differences between the Principal and Supplemental Registers; for instance, the Principal Register gives prima facie evidence of:

1. Validity of the registration

¹⁵ The seminal 2(e)(2) and 2(e)(3) cases include *In re Wine Society of America, Inc.*, 12 U.S.P.Q.2d (BNA) 1139 (TTAB 1989); *In re John Harvey & Sons, Ltd.*, 32 U.S.P.Q.2d (BNA) 1451 (TTAB 1994); *In re Nantucket Allserve, Inc.*, 28 USP2d 1144 (TTAB 1144); *In re Loew's Theatres, Inc.*, 226 U.S.P.Q. (BNA) 865 (Fed. Cir. 1985); and *Fred Hayman Beverly Hills, Inc., v. Jacques Bernier, Inc.*, 38 U.S.P.Q.2d (BNA) 1691 (TTAB 1996).

¹⁶ The seminal 2(e)(4) cases include *In re Benthin Mgmt. GmbH*, 37 U.S.P.Q.2d (BNA) 1332 (TTAB 1995); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 U.S.P.Q. (BNA) 652 (Fed. Cir. 1985); and *In re Garan, Inc.*, 3 U.S.P.Q.2d (BNA) 1537 (TTAB 1987).

2. Registrant's ownership
3. Exclusive right to use the mark in commerce
4. Incontestability after 5 years
5. Constructive notice of registrant's claim of ownership
6. Nationwide rights in the mark
7. Right to bring suit in federal court regardless of diversity
8. Statutory remedies
9. Ability to prevent importation of goods bearing an infringing trademark by depositing the registration with U.S. Customs.

While the Supplemental Register does not offer these presumptions, it does offer:

1. Use of the registration symbol
2. Use of the mark as a bar to registration of confusingly similar marks
3. Registration abroad based on U.S. rights
4. Right to bring suit in federal court.

Instead of amending to the Supplemental Register, if the applicant can show that the mark has acquired distinctiveness, the mark may register on the Principal Register with a notation that the registration is based on acquired distinctiveness under Section 2(f). The three types of evidence deemed acceptable to establish acquired distinctiveness are:

1. A claim of ownership of prior registration(s) on the Principal Register for the same mark for related goods or services;
2. A verified statement that the mark has become distinctive of the applicant's goods or services because of the substantially exclusive and continuous use in commerce by the applicant for 5 years before the date on which the claim of distinctiveness is made; and
3. Actual evidence of acquired distinctiveness such as evidence of advertising expenditures and/or consumer surveys and statements.

For example, in U.S. Reg. No. 1647685 for SAN DIEGO TROLLEY for "public rail transit services," the mark is geographically descriptive. However, the registrant was able to prove the mark had acquired distinctiveness and was allowed to register the mark on the Principal Register under Section 2(f).

DISCLAIMERS

If only a portion of a mark is descriptive, as opposed to the entire mark, the examining attorney will require a disclaimer of the descriptive portion. A disclaimer makes it clear that the applicant is not claiming exclusivity for the descriptive portion of the mark apart from the composite mark as a whole. A disclaimer does not remove the disclaimed matter from the mark. For example, the Utah Transit Authority has a federal registration

for the mark UTA BUS¹⁷ for "mass transit for the general public." They were required to make the following statement for the record, which is printed on the registration certificate: "No claim is made to the exclusive right to use BUS apart from the mark as shown." Clearly, the term BUS is descriptive with regard to these services and a disclaimer makes it clear that the term BUS is available for everyone in the industry to use. Generally, it is best not to disclaim material in the initial application, but rather wait until the examiner requires it.

Geographically descriptive terms typically require a disclaimer. For example, in U.S. Reg. No. 2288372 for HOUSTON TRANSTAR for "traffic management consulting services and traffic management services," the registrant was required to disclaim HOUSTON. Similarly, in U.S. Reg. No. 2459353 for NJ TRANSIT for "plastic train and bus pass holders," the registrant was required to disclaim NJ.

Geographically misdescriptive terms cannot be disclaimed, and marks containing them cannot be registered.

SECTION 1, 2, AND 45—DOES NOT FUNCTION AS A MARK

Not everything that an applicant adopts or uses with the intent of it functioning as a mark rises to the level of a protectable trademark. The proposed mark must be used in such a way on the specimens of record that it identifies the applicant's goods or services and distinguishes them from the goods or services of others. If the proposed mark does not do this, the examining attorney will issue a Section 1, 2, and 45 refusal, stating that the material does not function as a mark. Examples of elements that fit into this category are:

1. Background designs such as common geometrical shapes and borders;
2. Informational matter such as LOCATIONS IN PHILADELPHIA AND NEW YORK;
3. Model or series numbers and grade designations such as X2300;
4. Titles of single works such as THE SHINING;
5. Trade names, such as if the specimen uses the term ABC Transit, only with an address such as ABC Transit, Iowa City, IA 50701, and does not advertise what services the company provides in connection with the term ABC Transit;
6. Names of artists and authors such as STEPHEN KING; and
7. Telephone numbers such as 1-800-555-METRO.

Section 1, 2, and 45 cover two additional areas. First, if the proposed mark is merely a decorative feature of the goods, the examining attorney will state that the mark is ornamental and does not function as a mark. This is a common refusal when the specimen is a T-

¹⁷ U.S. Reg. No. 2321567.

shirt with the trademark prominently emblazoned on the front of it. The examining attorney will argue that the material is decorative and not an indicator of source. The applicant will have to show that the mark is not merely decorative by proving it has acquired distinctiveness or meaning as a trademark or that the applicant has a collateral use of the mark on other goods and therefore consumers would view the mark on a T-shirt as a mark and not merely a decoration. For instance, the NIKE® symbol on the front of a T-shirt with nothing more would be considered by consumers as indicating the source for the goods without further inspection of the label.

Second, if the proposed mark is a three-dimensional shape placed directly on the goods or itself is packaging for the goods, such as the shape of a perfume bottle, the examining attorney will find that the mark is a configuration and does not function as a mark. To register such a mark, the applicant will have to prove either that the design feature is nonfunctional and serves no utilitarian purpose or that the design feature is inherently distinctive or has acquired distinctiveness.

IDENTIFICATION OF GOODS AND SERVICES AND CLASSIFICATION

The applicant must specify the goods or services in connection with which the mark is used or the goods and services that the mark will be used on. The identification must be specific enough so that the examining attorney can determine whether there is a likelihood of confusion with another mark under Section 2(d) and provide proper notice to third parties as to the specific scope of the applicant's rights. The identification must also be specific in its description under the Nice Agreement Concerning International Classification of Goods and Services for the Purposes of the Registration of Marks.¹⁸ Under this agreement, there are 34 different classes of goods and 11 different classes of services. The decision as to what International Class goods or services are classified is purely an administrative matter that is within the sole discretion of the USPTO. The International Classes for Goods are:

- Class 001: Chemicals
- Class 002: Paints
- Class 003: Cosmetics and cleaning preparations
- Class 004: Lubricants and fuels
- Class 005: Pharmaceuticals
- Class 006: Metal goods
- Class 007: Machinery
- Class 008: Hand tools
- Class 009: Electrical and scientific apparatus
- Class 010: Medical apparatus
- Class 011: Environmental control apparatus
- Class 012: Vehicles
- Class 013: Firearms
- Class 014: Jewelry
- Class 015: Musical instruments

- Class 016: Paper goods and printed matter
- Class 017: Rubber goods
- Class 018: Leather goods
- Class 019: Non-metallic building materials
- Class 020: Furniture and articles not otherwise classified
- Class 021: Housewares and glass
- Class 022: Cordage and fibers
- Class 023: Yarns and threads
- Class 024: Fabrics
- Class 025: Clothing
- Class 026: Fancy goods
- Class 027: Floor coverings
- Class 028: Toys and sporting goods
- Class 029: Meats and processed foods
- Class 030: Staple foods
- Class 031: Natural agricultural products
- Class 032: Light beverages
- Class 033: Wines and spirits
- Class 034: Smokers' articles

The International Classes for Services are:

- Class 035: Advertising and business
- Class 036: Insurance and financial
- Class 037: Building construction and repair
- Class 038: Telecommunications
- Class 039: Transportation and storage
- Class 040: Treatment of materials
- Class 041: Education and entertainment
- Class 042: Computer, scientific, and legal
- Class 043: Hotels and restaurants
- Class 044: Medical, beauty, and agricultural
- Class 045: Personal services

The Trademark Office has an electronic, searchable database called the Acceptable Identification of Goods and Services Manual (I.D. Manual) available on its Web site. If an applicant uses an identification previously approved and included in the I.D. Manual, it will be acceptable to include in their own application. The I.D. Manual, however, is not exhaustive; it is merely a useful tool to help an applicant formulate an acceptable identification. Trademark Examination Note 98/1 provides further guidance on this matter. The Examination Note states,

When assessing whether an identification of goods or services is acceptable, the following concepts should be considered: 1. Clarity: Would a non-expert in the field of trademarks or in the field of the applicant's goods or services understand what the item or the activity is? 2. Classification: Is there language in the ID that makes classification difficult or ambiguous; are the goods or services clearly in a single class? 3. Scope: Is the scope of protection that would be provided by a registration clear? That is, does the language of the ID adequately define the parameters of the goods or services in the application? If an ID satisfactorily accomplishes these needs for clarity, classification and scope, it should be accepted even if the language proposed by the applicant doesn't appear in the ID Manual.

¹⁸ TMEP § 1401.02(c).

It is important to recognize the restriction on phrasing the identification in an application because while the identification may be amended to clarify or limit the scope, additions and widening of the scope are prohibited. To reiterate, the applicant may not amend to include any goods or services that are not within the scope of the original identification or the identifications as amended at any point during prosecution of the application.

For example, suppose the applicant files an application with an identification that reads: “clothing, namely, shirts, pants, and socks.” While the application is still pending, the applicant decides he or she wants to also use the mark on baseball caps and key chains and tries to add these items to the application. This will not be allowed. First, key chains are in a different class than clothing items and therefore certainly cannot be added. Second, even though a baseball cap is considered an item of clothing and would fit in the same class as shirts, pants, and socks, it is considered to widen the scope of the original identification and cannot be added.

Conversely, if the applicant files an application with an identification of “clothing, namely, shirts, pants, hats, skirts, T-shirts, shoes, socks, and jackets,” and then decides to stop using the mark on skirts, the term “skirts” can simply be deleted anytime while the application is pending.

This example illustrates an important lesson when crafting identifications. It is prudent to be over inclusive and broad in the beginning. The applicant can always delete items and clarify the scope of broad categories, but nothing can ever be added.

DIVIDING AN APPLICATION

It is permissible to file an application with several classes, some of which the mark is already being used on and some which the applicant intends to use the mark on sometime in the future. For example, the applicant could already be using the mark on various items of clothing, which are in Class 025, and intend to use the mark on jewelry, which is in Class 014, in the near future. In essence, the application is both a use-based application and an ITU application.

If this type of application is approved for publication and is not opposed, it will be sent to the ITU section of the Trademark Office and will not receive a registration certificate until the applicant has shown that the mark is being used on all goods and/or services. The problem with this method is that it lengthens the time it takes for the applicant to receive a registration certificate for the class in which he already has use. To avoid this problem, the applicant may divide the application. All this requires is a written request and (currently) a \$100 fee per class for each class that will be moved into essentially another file. The file is physically divided into two separate file jackets that are tagged, with one as the “parent” and one as the “child.” In this example, the applicant can divide the application and put the clothing class in another application. This child application

will then be ready to receive a registration certificate. The jewelry class will stay in the original parent application and remain pending until the applicant shows proper use.

The disadvantage to this method is that dividing an application requires another fee, more paperwork, and slows the entire process down. To ensure the quickest registration possible, it is a better policy to file multiple applications, each containing one class. In this example, the applicant should have filed two applications, one as a use-based application with the clothing items and one as an ITU application with the jewelry items.

TYPES OF OFFICE ACTIONS

After the examining attorney performs the search and examination, she will approve the application for publication if the application is not subject to any of the refusals discussed above or any informational requirements. If there are substantive refusals or requests for information, the examiner will issue a written first Office Action. A first Office Action can either be a standard Office Action, a Priority Office Action, or an Examiner’s Amendment.

A standard first Office Action will lay out any applicable substantive refusals and state any technical requirements that the applicant has not fulfilled. The applicant then has 6 months from the mailing date of the Office Action to argue against the refusals and fulfill the requirements, or the application will become abandoned. The examiner will issue a Priority Action if there are no substantive refusals, but there are technical requirements that the applicant must respond to, such as a clearer drawing of the mark. Again, the applicant has 6 months to respond to such an action, or the application will become abandoned. A Priority Action implies that the examiner will respond quickly to a response, so the sooner the applicant responds, the sooner the mark can be approved. If the only problem with an application is a minor technical requirement, the examiner may call the applicant and ask for authority to amend the application herself to fulfill the requirement. For instance, the examiner may simply need to insert a disclaimer or correct a misspelling. If the applicant agrees, the examiner will issue an Examiner’s Amendment. No response is necessary to an Examiner’s Amendment, and once the amendment is made, the application is approved for publication.

After the applicant has responded to a standard first Office Action, if the examiner feels that a substantive refusal is still required or that the technical requirement has not been fully addressed, she will issue a Final Office Action. If the Final Action only maintains a technical requirement, the applicant has 6 months from the mailing date of the Final Action to comply with all outstanding requirements or the application becomes abandoned. If the Final Action maintains substantive refusals, the applicant has 6 months to file an appeal with the TTAB or the application becomes abandoned.

RESPONDING TO OFFICE ACTIONS

The deadline for responding to an examiner's Office Action is 6 months from the mailing date of the Office Action. For example, a response to an Office Action dated August 31 is due on the following February 28 (or 29 if it is a leap year). A response to an Office Action dated February 28 is due on August 28 and not the last day of August. If a response or fee is due on a Saturday, a Sunday, or a federal holiday within the District of Columbia, the response or fee is considered timely if it is received on the following day that is not a Saturday, Sunday, or a federal holiday within the District of Columbia. See TMEP Chapter 300, Section 308, for further information and for a list of federal holidays observed in the District of Columbia.

A response or correspondence is timely filed even if it is received after the deadline if it was deposited with the United States Postal Service as first class mail or transmitted to the office by fax before the expiration of the deadline, and it is accompanied by a signed certificate attesting to the date of mailing or transmission. In addition, correspondence can be submitted electronically and even though the office should receive such correspondence almost immediately, it is still a good idea to include a certification of transmission. Even if the office loses the fax or paper, the postal service loses the correspondence, or the office does not receive the electronic correspondence due to technical glitches, etc., the office will consider the correspondence timely filed if the applicant can show that a proper certificate of mailing or transmission was included.

For example, if the applicant wishes to mail in the response, the following language or certificate should be included at the conclusion of the response:

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to
Commissioner for Trademarks
P.O. Box 1451, Alexandria, VA 22313-1451, on the date shown below:

(Typed or Printed Name of Person Signing Certificate)

(Signature)

(Date)

Similarly, if the applicant wishes to respond by electronic mail, at the end of the response this certificate should be included:

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office on the date shown below.

(Typed or Printed Name of Person Signing Certificate)

(Signature)

(Date)

If the applicant is even 1 day late in responding, the USPTO will not accept the response and the application is automatically abandoned. A Notice of Abandonment is sent to the applicant. If the applicant wishes to revive the application, a Petition to Revive must be filed. The petition must include the appropriate petition fee, a statement signed by someone with firsthand knowledge that the delay in filing the response on or before the due date was unintentional, and, unless the applicant alleges that he or she did not receive the Office Action, the applicant's response to the Office Action. The response should be on a separate paper from the petition. The petition must be filed within 2 months of receiving the Notice of Abandonment.

APPEALING A FINAL REFUSAL

If the examiner issues a final refusal based on substantive issues, the only option an applicant has is to appeal the refusal to the TTAB. Filing a Notice of Appeal and paying an appeal fee within 6 months of the mailing date of the final refusal initiates an appeal. If the applicant does not file a Notice of Appeal in a timely fashion, the application is abandoned. If the abandonment was unintentional, the applicant may file a Petition to Revive as described above. Once the Notice of Appeal is filed, the applicant must file an appeal brief within 60 days. The examiner is then allowed time to respond with a written appeal brief.

The standard of review for the TTAB is the clear error standard. This means that the TTAB will only overturn a decision by an examiner if the decision was a clear error of law or fact that if not corrected will result in a registration or rejection in violation of the Trademark Act. Hence, one could draw the conclusion that it is difficult to get an examiner's position overturned. The general rule under the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), Section 1207, for submission of additional evidence on appeal is that no additional evidence is allowed. TTAB makes its decisions based upon the file wrapper (the application, submitted documents, and Office Actions); briefs submitted by the parties; and in some cases, oral or telephonic arguments. Only under special circumstances is additional evidence allowed.

APPROVAL FOR PUBLICATION AND REGISTRATION

After the examination of an application is complete and the examining attorney determines that the mark is entitled to registration on the Principal Register, the mark is published in the *Official Gazette of the United States Patent and Trademark Office*. Marks that are registrable on the Supplemental Register are already registered when published in the *Official Gazette* because they cannot be opposed (but are subject to cancellation).

During the 30-day opposition period, any person who believes that they would be damaged by the registration of a mark (for instance if they believe that the mark being published is confusingly similar to their mark) on the Principal Register may oppose its registration by filing a Notice of Opposition with the TTAB and paying the required fee within 30 days after the date of publication.

The most recent five issues of the *Official Gazette* are available in electronic form on the USPTO Web site. The printed (paper) publication is available from the Superintendent of Documents, U.S. Government Printing Office (GPO), as an annual subscription or as single copies. Information on how to obtain the paper publication is available at <http://www.uspto.gov/web/offices/ac/ido/oeip/catalog/products/tmprod-1.htm>.

If the mark is unopposed, it proceeds to registration as a purely clerical function. The Publication and Issue Section prints and issues the registration certificates. The registration certificate includes the owner's name and address, the mark, the goods and/or services, and the international class(es). A registration jacket cover is placed over the certificate, and it is embossed with the official seal of the Director of the Office. Once the USPTO confers the registration certificate and it is received by the applicant, now registrant, the registration symbol (®) should be used beside the mark.

POST-REGISTRATION CONCERNS

Once a trademark is registered, the registrant must carefully file the required declaration and affidavits with fees throughout the lifetime of the mark in order to maintain the registration status. It is theoretically possible to maintain a trademark registration into perpetuity.

The first declaration affidavit required by the Lanham Act is the Section 8 Affidavit. The owner of the mark must file the Section 8 Affidavit between the 5th and 6th year anniversary date of the registration of the mark. Thereafter, the owner of the mark must file a Section 8 Affidavit within the year before the end of every 10-year period after the date of registration. The Section 8 Affidavit must include a sworn statement attesting to the continued use or excusable nonuse of the mark and a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under Section 2.161(f)(2) of the Lanham Act.

If the affidavit is filed online, follow the instructions for filing specimens online; otherwise, the specimen must meet the following requirements:

- (1) Show the mark as actually used on, in connection with the goods, or in the sale or advertising of the services. A photocopy or other reproduction of the specimen showing the mark as actually used is acceptable. However, a photocopy that merely reproduces the registration certificate is not a proper specimen; and,
- (2) Be flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the file wrapper.¹⁹

If the registrant is not using the mark, it is subject to cancellation unless the registrant can show excusable nonuse. Examples of excusable nonuse include a trade embargo or other circumstances beyond the owner's control. The sale of a business that temporarily results in nonuse of the mark may also be excusable nonuse. However, things like decreased demand for the product sold under the mark, resulting in its discontinuance for a period, are not excusable.

A Section 15 Affidavit of Incontestability is a procedure by which the exclusive right to use a registered mark in commerce in connection with specified goods is declared incontestable. A properly filed affidavit is conclusive evidence of the validity of the registered mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce subject to certain defenses and exceptions. A Section 15 Affidavit is available only for marks on the Principal Register and should be filed 5 years after the registration is granted. In many cases, registrants or their attorneys will file the Section 8 Affidavit and the Section 15 Affidavit at the same time during the 5th year after the date of registration.

Monitoring Registered Marks

Once a mark is registered, the trademark owner, now the registrant, should monitor, or pay someone to monitor, the *Official Gazette*. This will help to guard against newly filed marks that may be confusingly similar. If the registrant finds any similar marks, the registrant must initiate an opposition proceeding in order to properly defend his or her ownership in their mark (presumed to be the superior mark). It is vital to defend the interests in a trademark in order to maintain full rights in it. Please see below for a discussion of opposition proceedings. Monitoring should be done frequently, on a weekly or biweekly basis. Although registrants can monitor their marks themselves via the paper copies or online, it is advisable to hire a trademark-monitoring firm that conducts weekly inspections and issues regular reports of its search of the *Official Gazette*.

¹⁹ Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (15 U.S.C. § 1114 (2005)).

Cease and Desist Letters

One of the responsibilities of a registrant is to police the use of his or her mark. If a third party is using the same mark or a confusingly similar mark on related goods, the registrant has a duty to warn the third party infringer to stop. The registrant should send a cease and desist letter (C and D letter). This type of warning is appropriate to send in any instance where the owner of a trademark believes his or her trademark is in danger of being misappropriated to his or her detriment or in cases where the trademark owner simply must stake a proprietary claim against any confusingly similar trademarks.

C and D letters consist of several elements, including evidence of superior rights; warning of impending lawsuit in federal court; and specific instances of infringement, such as dates, places, or even customers. The letter can also include a Certificate of Compliance, which is in essence an affidavit for the infringer's signature averring to complete certain tasks, such as transferring a domain name, recalling all infringing goods, or placing a statement of non-affiliation on a Web site. If the registrant does not police use of his or her mark, the mark may be subject to a cancellation proceeding.

Consent Agreements

Consent agreements allow for use of a trademark by an individual or entity other than that of the owner. Normally, consent agreements exist in cases where the infringement (willful or otherwise) of a trademark by another is discovered. Rather than sue, the owner with the superior rights may agree to allow the owner with inferior rights to continue actively using their trademark. Usually, these agreements do not require royalty fees, nor does the owner exert quality control over third party uses of the mark, as in the case of licenses or franchise arrangements. In essence, the consent agreement functions as an agreement not to sue based upon an acknowledgement of the rights held by the superior owner.

BRIEF OVERVIEW OF FEDERAL TRADEMARK LITIGATION CONCERNS

The district and territorial courts of the United States have original jurisdiction and the U.S. courts of appeals have appellate jurisdiction of all actions that arise under the Lanham Act, regardless of the amount in controversy or the diversity or lack of diversity of the citizenship of the parties. Under the Lanham Act, if a trademark owner thinks a person is engaged in infringing activity, the owner can institute a civil action. Infringing activity is defined as:

Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which

such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.²⁰

Remedies include profits gained by the infringer due to the use of the trademark owner's mark; damages and costs incurred by the trademark owner due to the infringing activity; attorneys' fees; treble damages; and statutory damages. Maybe most importantly, the Lanham Act provides for the equitable remedy of injunctive relief. Many trademark holders find that injunctive relief is one of the most important remedies provided by the statute because it prevents the infringer from making, selling, advertising, promoting, distributing, or importing the infringing goods until the case is adjudicated.

STATE TRADEMARK REGISTRATION

Based on efforts of the International Trademark Association (INTA), formerly the United States Trademark Association (USTA), the Model State Trademark Bill was revised in the 1990s to reflect the Lanham Act more closely at the state level. It calls for enforceable and significant protections in local jurisdictions. At the time of its introduction, only a few states had trademark statutes that allowed for key items such as the standardization of a formal application process, anti-dilution protections, and allowing causes of action for trademark infringement in state court.

Many states updated their methods for handling trademarks within state boundaries. Because most states continue to regulate trademarks as part of their responsibility for regulating commerce, the laws can vary and differ in many respects from jurisdiction to jurisdiction. Filing at the state level, along with filing a U.S. federal application, can bolster the rights held in the trademark, again moving the owner further along the continuum of rights because of the requirements for use in commerce and the potential for an interstate sale to meet the requirements to file at the federal level. Filing at the state level can also preclude infringements where many occur—between local competitors. Please see the Appendix for a complete listing of state government-sponsored Web sites regarding trademarks.

²⁰ Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (15 U.S.C. § 1114 (2005)).

TRADEMARK TRIAL AND APPEAL BOARD²¹

The Trademark Trial and Appeal Board (TTAB) is an administrative judicial body located in the Trademark Office empowered to address the issues involved with the right to register a trademark with the USPTO. The TTAB does not have the authority to determine other trademark issues such as the right to use, trademark infringement, or unfair competition.

There are four types of inter partes proceedings that the TTAB may hear: oppositions, cancellations, interferences, and concurrent use proceedings. Oppositions are proceedings in which the plaintiff tries to prevent the mark from being registered on the Principal Register. As described earlier, the plaintiff must believe that he or she would be damaged by the registration of a mark. The plaintiff must file an opposition within the period allocated after the mark is first published in the *Official Gazette*.

Cancellations are proceedings in which the plaintiff seeks to cancel an existing registration. The plaintiff must be a person who believes that he or she would be damaged by the registration of a mark. Interferences are proceedings in which the TTAB determines which, if any, of the owners of conflicting applications is entitled to registration. This type of proceeding is initiated by petition to the director. The plaintiff must show extraordinary circumstances, namely, that the plaintiff would be unduly prejudiced without the interference. Concurrent use proceedings determine if one or more applicants are entitled to a registration with conditions and limitations set by the TTAB. Usually a concurrent registration is restricted as to geography. The USPTO Web site contains a mechanism for filing opposition and cancellation proceedings online and includes a searchable database of closed and pending matters before the TTAB. The only type of ex parte proceeding that the TTAB may hold a hearing to adjudicate an appeal from is a final refusal issued by an examining attorney. Appeals from final refusals are discussed in the Federal Prosecution section.

The TTAB is currently composed of 11 judges who normally sit in panels of 3, and 16 interlocutory attorneys. The interlocutory attorneys decide upon non-dispositive motions in all cases. All communications are conducted in writing, unless a party requests an oral hearing. Regardless of whether there is an oral hearing, TTAB bases its decisions exclusively on the written record.

Currently, decisions in ex parte proceedings, including decisions on oppositions and cancellations, are rendered approximately 24 weeks after all briefs have been submitted or after a hearing, if one is held. Final decisions of the TTAB are available online on the USPTO

Web site and can act as a valuable indicator of how the Trademark Office is interpreting the Lanham Act.

Decisions of the TTAB may be appealed directly to the U.S. Court of Appeals for the Federal Circuit or to any federal district court.

TRADEMARK OFFICE ORGANIZATION/PENDENCY

Divisions Within Trademark Office

See the USPTO Web page at <http://www.uspto.gov/teas/contactUs.htm>, which lists the ways in which to contact USPTO personnel. The Trademark Assistance Center, reachable at 1-800-786-9199 or by email at TrademarkAssistanceCenter@uspto.gov, gives assistance of a general nature and transfers callers to other USPTO contacts. Technical questions can be emailed to TEAS@uspto.gov. For questions concerning ITU applications, contact the ITU branch at 571-272-9550 or email branch personnel at TMITU@uspto.gov. In order to ask questions regarding the status of an application or to speak to an Examiner for which the direct phone number is unavailable, dial 571-272-9____, with the last three numbers corresponding to the law office in which the application is stored or examined. The following chart, which can be found in its entirety at <http://www.uspto.gov/teas/contactUs.htm>, may come in handy when you know which section to contact.

²¹ The TTAB follows the procedures and guidelines set forth in the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), which can be found in its entirety on the USPTO Web site at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp>.

OFFICE OF THE ADMINISTRATOR FOR EXAMINATION	571-272-9100	
OFFICE OF THE COMMISSIONER FOR TRADEMARKS	571-272-8900	
OFFICE OF PROGRAM CONTROL	571-272-7200	
OFFICE OF TRADEMARK SERVICES	571-272-9401	
PETITIONS OFFICE	571-272-8950	TMPetitions@uspto.gov
POST REGISTRATION	571-272-9500	TMPostRegistration@uspto.gov
PRE-EXAMINATION	571-272-9401	TrademarkAssistanceCenter@uspto.gov
PUBLICATION AND ISSUE	571-272-9401	TrademarkAssistanceCenter@uspto.gov
TRADEMARKS ASSISTANCE CENTER	571-272-9250	TrademarkAssistanceCenter@uspto.gov

Statistics on Pendency Through the Process of Obtaining a Registration

Although the USPTO has a goal of examining newly filed cases within 3 months of their filing date, currently it is taking 6½ months to receive a first Office Action from an examining attorney. Once an application is approved for publication, it takes approximately 3–4 months for the application to be published in the Official Gazette. Once the application has been published and a Notice of Allowance has been mailed, it takes 3–4 months to receive a registration certificate in the mail. *Please note that these statistics fluctuate.*

ELECTRONIC FILING

To file a trademark application electronically, visit the home page of the USPTO Web site, located at www.uspto.gov. See the word “TRADEMARKS” placed on the left-hand side of the screen in large bolded font. It is a hotlink leading to an entire Web site with information concerning trademarks only. Underneath “TRADEMARKS,” the choices “File,” “Status,” and “Search” are located. Clicking on “File” will direct the user to the “Trademark Electronic Application System” or “TEAS” Web site at <http://www.uspto.gov/teas/index.html>. Along the right-hand column are the different choices of document types one might file. Choose “Apply for a new mark.” The first battery of questions creates a basic template depending on the type of application. These categories are “Use,” “Intent-to-Use,” or “Foreign-based filings.” In most cases, the first choice, “Trademark/Service Mark Application, Principal Register,”²² is used. Other possible choices include “Certification Mark Application, Principal Register”²³ or “Collective Mem-

bership Mark Application, Principal Register.”²⁴ To determine whether these other choices are appropriate, refer to their descriptions elsewhere in this report or consult an intellectual property attorney. After clicking on the appropriate choice, the user must answer another battery of questions, which include all of the particulars needed to file the application. These questions include identifying the proper International Class of goods or services associated with the trademark; whether color or specialized font or texture (stripes, fading color, etc.) are features of the mark; and a description of the goods or services. The entire process of completing the online application can take a mere few minutes; however, incorrect information can stall an application and could lead to a rejection over a simple matter.

TMEP Section 804.05, Signature of Electronically Transmitted Applications, addresses how to enter an electronic signature directly into the application in TEAS and reads in part,

The applicant enters a “symbol” that the applicant has adopted as a signature. The Office will accept *any* combination of letters, numbers, spaces and/or punctuation marks as a valid signature if it is placed between two forward slash (“/”) symbols. 37 C.F.R. §§ 1.4(d)(1)(iii) and 2.33(d). Examples of acceptable signatures for TEAS applications include */john doel*, */drll*, and */544-4925/*.

While the choice of saving the completed application and forwarding it to the applicant for signature is available, it is obviously a time-saver to have a Power of Attorney signed beforehand so that the filer can sign on behalf of the applicant. In some instances, when a member of the applicant’s legal department completes the application, the Power of Attorney may be inferred.

²² Found at <http://teas.uspto.gov/V2.0/bas250/>.

²³ Found at <http://teas.uspto.gov/servlet/V2.0/gov.uspto.teas200.newapp.common.servlets.ControllerServlet?action>

[selection=0&formnumber=2.](#)

²⁴ Found at <http://teas.uspto.gov/servlet/V2.0/gov.uspto.teas200.newapp.common.servlets.ControllerServlet?action=selection=0&formnumber=1.>

In any case, the filer “signs” the document by using any combination of letters, numbers, or symbols between two slash marks, such as “/Joann Smith/.” Next, the date that the applicant gave the representative permission to sign on his or her behalf is filled in. This may be the date of the Power of Attorney, or in the case where Power of Attorney is inferred, the dates are identical to the filing date.

Next, review the application before submitting it. Viewing the application in both HTML and Text formats will allow for added assurance. A quick glance at the attached specimens (if any) to ensure that the relevant material is properly uploaded is also a good idea. Next, validate the form by pressing “Validate” and then “Submit.” Validation will run a check of the document to ensure that all necessary items are completed.

The payment page then appears, presenting several options for paying the fees due. The two most common methods of payment are using a USPTO deposit account or a major credit card. Holding a deposit account with the USPTO is normally convenient only for parties that regularly file a large number of trademarks because there are requirements, such as minimum balances, that can be burdensome to occasional filers. Wire and check transfers can be time-consuming and costly as well. Obviously, using a major credit card is the quickest and most convenient means to pay the fees. The instructions for submitting payment are very straightforward and do not require detailed instruction.

Items Required to File Documents Online

The items required to file documents online are identical to those items necessary to file in person or by mail or fax. These include the name, address, citizenship, or state of incorporation of the applicant or applicants as the case may be. It also includes a Power of Attorney or a procedure for obtaining a primary electronic signature from the applicant. If using a credit card for payment, the card must be “in-hand” because it is necessary to input the three-digit security code found on the back of the card. Knowing the number of classes and if possible the proper identification or description of them, including what International Class they fall under, will save time during the initial review. The item that can create the most inconvenience for even the most experienced attorney is uploading the specimens in proper size and format. Specimens should consist of digital photographs of the products with the trademark clearly visible on the labeling, scans of Web pages, or a scanned picture of the primary document in the case of the most common specimens, product labels and advertising. Specimens that are uploaded to the TEAS Web site during the filing process must be in “.jpg” format and

should be scanned at no less than 300 dots per inch and no more than 350 dots per inch, and within the pixel range suggested by the USPTO, namely, a length and width of no less than 250 pixels and no more than 944 pixels; e.g., a valid pixel dimension is 640 X 480 pixels.

The TEAS Web site has a mechanism for checking and converting specimens if needed.

MADRID PROTOCOL

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) is an international treaty that enables a trademark owner to obtain registration in any of the countries that are signatories to the treaty by filing a single, international application. The International Bureau of the World Intellectual Property Organization (WIPO), located in Geneva, Switzerland, oversees the process for Madrid Protocol filings. There are currently 61 countries that are signatories to the Madrid Protocol. A list of the countries is on the WIPO Web site: www.wipo.int/portal/index.html.en.

A U.S. trademark owner with a pending or registered mark with the USPTO, called either a Basic Application or a Basic Registration, respectively, who is also a national of the U.S. or has a domicile in or a real industrial or commercial establishment in the U.S. can submit an international application through the USPTO. The biggest advantage to the Madrid Protocol is that it provides a very efficient way to file one application, using one language (either English or French), while paying one fee for the objective of obtaining multinational registration. Filing an application in this manner can initially save money because there is no need to translate documents or hire local counsel in all the designated countries until, or if, Office Actions are issued by offices in the individual countries.

There are some disadvantages to filing a Madrid Protocol Application. For example, the USPTO requires more specific identifications than some other Protocol countries. American filers find that because the strictness of the U.S. application process requires more narrow identifications, these limitations carry over into the designated countries on the Madrid application, resulting in more narrow protection in those countries. For instance, an acceptable identification for U.S. originating applications would state, “Clothing, namely, T-shirts, caps, socks,” whereas in many other countries the broad identification of “Clothing” is perfectly acceptable. In addition, while U.S. law allows for registration on the Supplemental Register, a registration on the Supplemental Register cannot serve as the basis for an international registration. Most importantly, if during the first 5 years the application pending in the home country does not result in a registration on the Principal Register, or is cancelled, then the international registration and all corresponding foreign designations are abandoned automatically.

ASSIGNMENTS

In general, an Assignment is an outright transfer of all rights associated with a trademark. Since trademarks represent the goodwill associated with their owner, a Deed of Assignment needs to include a provision transferring the goodwill that the trademark symbolizes. A trademark sold without an explicit transfer of the goodwill may be found invalid and possibly lead to loss of rights in the mark.

Negotiating an assignment is similar to negotiating any other contract and can transfer ownership to either a pending application or a registered trademark. Considering that many factors, including the expense and resources that went into creating, marketing, or defending the trademark, can affect the value of the mark, the worth of a trademark is that which the two parties agree its worth is or will be. While transferring a pending application is common, the filing of a trademark application with the sole intent to sell the mark may be “brokering,” and this activity is illegal. In essence, the applicant files the application and avers either that the trademark is already in use or that the applicant swears to have a bona fide intent to use the mark.

Required Terms Within a “Deed of Assignment”

A Deed of Assignment should include a statement about transferring the “goodwill”; otherwise the Assignment could be considered a license by default. The parties should always specify the goods and any limitation concerning which goods can use the mark. Recording the transfer of rights in the trademark with the USPTO is necessary for completion. The USPTO will update the information in the original file to reflect the new owner. The parties can file the recordal form online. The form is self-explanatory and is easily completed. There is a fee for recording Assignments and Licenses with the USPTO. See the Recordation section for more information.

LICENSES

General Overview of Licenses²⁵

The owner of a trademark may employ various legal options to benefit not only from his or her own use, but also from the use by a third party. Depending upon the nature of the situation, the trademark owner grants rights to another party by granting an assignment, a consent agreement, a franchise agreement, or a license. An overview of trademark licensing follows.

A trademark license is a grant of permission from a trademark owner (“licensor”) to a third party (“licensee”) to use the trademark in accordance with specified terms and conditions. A license agreement can be oral or written; however, to meet the requirements of the Lanham Act, it may be prudent to have all terms of the agreement in writing. The key issue relevant to licensing a trademark is the issue of quality control over the licensee’s use of the mark. Courts interpret the Lanham Act as requiring a trademark owner to control the quality of the goods manufactured or sold under the mark, even when such goods are made and sold by a third-party licensee. As Judge Posner stated in a Seventh Circuit decision:

The owner of a trademark has a duty to ensure consistency of the trademarked good or service...The purpose of a trademark, after all, is to identify a good or service to the consumer, and identity implies consistency and a correlative duty to make sure that the good or service really is of consistent quality....²⁶

Thus, the issue of quality control stems from the notion that trademarks serve not only to identify the *source* of goods, but also to indicate a *level of quality* associated with the goods.²⁷ The trademark owner’s ability to maintain a consistent level of quality is most significant because a trademark owner’s failure to exercise adequate, consistent quality control over a licensee’s use of a mark can lead to unwanted consequences. When a licensor does not adequately control the use of its trademark by a third party, this is “uncontrolled” or “naked licensing.” The Second Circuit noted in *Dawn Donut Co. v. Hart’s Food Stores, Inc.*,²⁸ that uncontrolled licensing may constitute an abandonment of the licensor’s mark. When a license agreement is silent as to quality control requirements, the courts may find that it is void or has, de facto, become a naked license, contributing to a loss of rights and possibly abandonment or cancellation. The Lanham Act Section 45(2) reads in part, “A mark shall be deemed to be “abandoned”... (2) When in the course of conduct of the owner...causes the mark...to otherwise lose its significance as a mark.”

Dawn Donut further interprets this section of the Lanham Act to mean uncontrolled licensing may cause the trademark to lose its meaning and thus deceive the public.²⁹ Other court decisions have evolved to find the loss of rights in a trademark based upon not only a finding of improper control, but also upon a finding of no control whatsoever, which is in essence a void license.³⁰ Inadequate control in the case where the licensor is unable to prevent a licensee’s continued unauthorized use of the mark may also result in a finding of a void license.³¹

While the courts vary on the issue of adequate control, there does appear to be agreement about what prudent quality control may include. It may include: 1) clearly defined quality standards or requirements; 2) regular site inspections of the licensee’s facilities, to include reporting and in some cases recordkeeping of the findings; and 3) the review of licensee’s products or

²⁶ *Gorenstein Enters., Inc. v. Quality Care-USA, Inc.*, 874 F.2d 431, 10 U.S.P.Q.2d (BNA) 1762, 1764 (7th Cir. 1989).

²⁷ See generally MCCARTHY ON TRADEMARKS 3:10.

²⁸ *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 121 U.S.P.Q. (BNA) 430 (2d Cir. 1959).

²⁹ *Id.* (stating that the licensor of a trademark must be compelled to take reasonable measures to prevent misuses of his trademark so as to prevent deception on the public).

³⁰ See *Yamamoto & Co. (America), Inc. v. Victor United, Inc.*, 219 U.S.P.Q. (BNA) 968 (Cent. Dist. Cal. 1982).

³¹ *Stanfield v. Osborne Indus.*, 52 F.3d 867, 34 U.S.P.Q.2d (BNA) 1456 (10th Cir. 1995), *cert. denied*, 516 U.S. 920, 133 L. Ed. 2d 217, 116 S. Ct. 314 (U.S.) 1995.

²⁵ This section was written in consultation with Elizabeth Seltzer of Driscoll and Seltzer, PLLC, Alexandria, Virginia.

marketing materials. The extent of quality control that a trademark owner should exercise over a licensee's use of its mark may depend upon the nature of the goods or services. For example, the degree and nature of control appropriate for manufacturing T-shirts may differ from the degree of control needed to oversee the manufacturing of highly sophisticated medical devices. The purpose of specifying the amount of quality control is to avoid deception of the public.

Licensing arrangements commonly happen between related parties. Section 45 of the Lanham Act defines *related company* as "any person whose use of the mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used."

Emphasis is on *actual* control over the nature and quality of goods to insure that the use of the trademark continues to inure to the benefit of the trademark owner, and that the public has assurances that the quality and goodwill associated with the goods remains intact. The Lanham Act, Section 5 reads,

Where a registered mark or mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration...[i]f first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.

To maintain rights or to prove continued use in a trademark, the owner may claim use by a related party as long as proper, actual control over the mark is present. Thus, the fact that entities are related by legal constructs is not in and of itself sufficient to support "related party" use within the meaning of the Lanham Act.³² The key is whether the trademark owner exerts actual control over quality in relation to a subsidiary's use of a mark.³³ Related company status can also be difficult to find among subsidiary corporations serving as subsidiaries of the same common parent corporation. The TTAB has held that such corporations fail to have the quality control that traditionally exists in relationships between parent and subsidiary corporations. The USPTO no longer requires proof of exerted control over trademark use by related companies, but again, the best practice is to have quality control measures between related (and non-related) entities encapsulated within a written agreement. Quality control provisions within a license agreement may include:

- Requiring "full and complete compliance" with patent, trademark, and copyright laws of the United States;
- Requiring that all of the goods produced under the licensed trademark be of a high quality and in conformity with a sample approved by the licensor;

³² TPEM § 1201.01.

³³ *May Dep't Stores Co. v. Prince*, 200 U.S.P.Q. (BNA) 803 (TTAB 1978).

- Requiring that if the quality of the goods falls below the quality previously approved by the licensor, the licensee shall use its best efforts to restore such quality within a set period of time, for instance within 30 days, otherwise the licensor retains the right to terminate the agreement;
- Requiring that the licensee provide a given number of samples that meet a certain level of quality or cover a certain scope of the licensee's use of the mark; and
- Requiring the provision of promotional and advertising materials to be associated with the licensed products.

Royalties are payments made to the licensor by the licensee for the privilege of using the mark. They are typically a set figure or a figure based upon a percentage of sales. Courts have held that licensors are not required to receive royalty payments in order to fulfill the requirements for a valid license agreement.³⁴ Royalty payments are referred to in the license agreement in a manner that is unique to each situation; however, common language addressing royalties may include:

- Requiring, for example, royalties based on licensee's net sales of the goods;
- Payment terms that require calculation on a quarterly basis and royalties made payable no later than a certain number of days;
- Requiring the submission of a royalty statement, which identifies the goods sold under the mark such as the stock number, item, units sold, description, quantity shipped, gross invoice, amount billed customers minus discounts, allowances, returns, and reportable sales for the goods;
- Requiring the payment of a Guaranteed Minimum Royalty;
- Addressing how the issue of outstanding royalties will be calculated upon the expiration or termination of the license agreement and when they would be due and whether payments are to be accelerated; and
- Addressing whether royalties will continue to be due even in the event of expiration or termination, as long as the licensee continues to manufacture, sell, or otherwise market the goods.

A licensing agreement may be either exclusive or non-exclusive in nature. Exclusivity may be for a licensee to use a mark in connection with a restricted set of goods or within a restricted geographic territory. Non-exclusivity is addressed in cases where the licensee is one of many secondary users. For instance, the Coca-Cola Company licenses the right to use its trademarks

³⁴ *University Book Store v. University of Wis. Bd. of Regents*, 33 U.S.P.Q.2d (BNA) 1385, 1396 (TTAB 1994) (finding an implied license between University and local bookstores given the existence of acceptable quality maintenance on the part of the bookstores, despite the informal and royalty-free nature of the license agreement).

to several bottlers worldwide. Clauses on exclusivity or non-exclusivity may include:

- Language professing the licensee as the holder of an exclusive, possibly, worldwide license to use the trademark(s) in connection with the goods and
- Language professing that the licensee holds a non-exclusive license to use the trademark(s) in connection with the goods.

The issue of assignability may arise depending on how restrictive an exclusivity clause is drafted. In many cases, the licensor wants to maintain adequate, consistent quality control over the licensee's use and allowing for an assignment of the license may not allow adequate control to continue. Clauses restricting the licensee from assigning the license may include stating simply that the license granted is personal to the licensee and shall not be assigned to another. Exceptions may be carved out regarding the outright sale of the licensee (if a business) to another entity or with the express consent of the licensor.

The trademark owner may want to contemplate language in a licensing agreement that clearly reserves the right to bring infringement suits in defense of its marks. In addition, the owner may contemplate language that requires the licensee to notify the licensor of unauthorized third-party use of the mark. Right to Defend provisions may be placed with indemnity clauses and include:

- Requiring the licensee to defend and indemnify the licensor, its officers, directors, agents, and employees, against all costs, expenses, and losses, including reasonable attorneys' fees and costs incurred through claims of third parties against licensor based on the manufacture or sale of the goods. These provisions may also include indemnity regarding product liability.

Other important provisions that are commonly included within license agreements are:

- Requiring the licensee to obtain, and maintain at its own cost, product liability insurance naming the licensor as an additional named insured in order to protect both parties from claims, demands, and causes of action arising out of any defects or failures of the goods. The licensor can require a specific amount of insurance coverage, taking into consideration the nature of the goods and the situation in which the licensee plans to manufacture or sell them;
- Requiring the licensee to recognize the value of the goodwill associated with the marks and the acknowledgement that any future goodwill is solely for the benefit of the licensor; and
- Requiring the licensee to acknowledge that the licensor alone holds exclusive rights in the mark and that the licensee will not at any time during or after the term of the agreement dispute or contest the licensor's exclusive right and title to the marks.

Finally, a licensor may include a caveat that no representation or warranty with respect to the validity of its trademarks or other intellectual property is promised.

The above points to include within a license agreement are not exhaustive and are provided in this report solely for information purposes and do not constitute legal advice to the reader.

Recordation

The USPTO should receive documentation verifying all assignments, licenses, and security interests in pending or registered marks. Recordation is in essence a request to the Director of Trademarks. The request must include a USPTO Recordal Cover Sheet, the appropriate fee, and one of the following documents: 1) a copy of the original document; 2) a copy of an extract from the document evidencing the effect on title; or 3) a statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title to the mark.³⁵

UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

Overview

The management of the Internet was originally the responsibility of the U.S. Government through the executive agency Internet Assigned Numbers Authority (IANA). IANA was responsible for a myriad of tasks, including the assignment of top-level domain names (TLDs). After that time, the Internet Corporation for Assigned Names and Numbers (ICANN) was formed to continue these functions in a multinational, grassroots, and independent manner. ICANN is responsible for several functions related to the management and operation of the Internet, but at its most basic level, is responsible for delegating which organizations and companies may register domain names. In addition, its responsibilities include the development of a dispute resolution system to help the domain name system run smoothly throughout the world. The Uniform Domain Name Dispute Resolution Policy (UDRP) is used widely by domain name registrars and is agreed to by domain name registrants (individuals, businesses, associations, etc.) via service agreements and the like.³⁶ Its appeal is broad-based and thus, ICANN is a key role player in resolving over 5,000 disputes worldwide.³⁷ A full copy of the UDRP is found at www.icann.org along with its updates and implementation guidance.

How to File a Complaint or Enforce a Ruling

To file a complaint under the UDRP, the complainant must meet three applicable requirements for requesting

³⁵ 37 C.F.R. § 3.25.

³⁶ The Uniform Domain Name Dispute Resolution Policy was enacted on August 26, 1999.

³⁷ www.icann.org.

a mandatory proceeding. These elements must exist before the complaint is filed. The three requirements, approved by ICANN on October 24, 1999, as set out in the *Rules for Uniform Domain Name Dispute Resolution Policy*, are 1) the defendant is alleged to hold a domain name that is identical or confusingly similar to a trademark or service mark in which the complainant has rights, 2) the defendant has no rights or legitimate interests with respect to the domain name, and 3) the domain name has been registered and is being used in bad faith.

In order to file a complaint, one must contact an Approved Dispute Resolution Service Provider (ADRSP). The WIPO is the ADRSP for intellectual property disputes. WIPO provides specific guidance, documents, and resources for filing a complaint and requesting arbitration or mediation in a matter. The forms are available online, and a complaint or response to a complaint can be filed online. Currently, the WIPO charges between \$1500 and \$4000 for arbitration services, depending on how many panelists are requested to preside over the matter.

The main drawback to filing a complaint under UDRP is the fact that panelists are not bound by precedent. The system is relatively new, and consistency can be an issue. In February 2005, WIPO addressed the issue of consistency by compiling a report that traverses all disputes adjudicated by WIPO. In an effort to build consensus among panelists with regard to major points of law, a searchable database now exists to shed light on decision trends. Another costly drawback to filing with WIPO instead of a domestic forum, for example, is that the lack of a response by the defendant is not cause for an automatic default ruling. Hence, the time factor involved in either waiting for a response or pursuing an alternative remedy elsewhere can be costly and possibly avoided altogether if the original complaint had been filed elsewhere.

It appears clear that the advantages outweigh the disadvantages, and the WIPO Web site itself enumerates some of the advantages. They include a recognized and enforceable decision³⁸ by an independent, internationally respected organization; an online docketing and document submission system that is available worldwide; and independence from precedent. Furthermore, the foundation of arbitration, which is party-driven, is reinforced by allowing the parties to agree on their panelists, the language for resolution, and other factors not available within a traditional courtroom setting. Finally, for U.S. trademark and domain-name owners, the publicity of winning a dispute not only helps establish reputation and goodwill in the U.S., but also helps to put foreign squatters or infringers on notice.

³⁸ The United States is a party to the United Nations Convention for the Recognition and Enforcement of Foreign Arbitral Awards of 1958, known as the New York Convention.

USPTO's Guidance Regarding Domain Names

On September 29, 1999, the USPTO issued Examination Guide Number 299 concerning trademarks composed, in part or whole, of domain names in order to clear up confusion about whether material submitted for registration, such as ABC with a TLD such as ".com" can be registered. In this example, ABC is a second-level domain (address) and ".com" is a top-level domain. The USPTO handles the subject of trademarks that include either second- or top-level domains in trademark applications in the same manner it handles other marks that include informational material. Because the TLD merely indicates an Internet address, it is considered informational and is not an indication of source for the goods or services in question. Second-level domains submitted for registration that include a TLD must "rise to the level of a trademark" by offering the consuming public a way to identify the source or origin for the goods or services independently of the TLD. Due to the creation of second-level domains in order to facilitate locating a specific Internet address, material submitted in an application that is used as a second-level domain must indicate the source and will be subject to any of the applicable refusals stated in the Lanham Act.

Generally, the addition of a TLD does not give the trademark more strength, but is superfluous information in the eyes of the examiner, and is disregarded during the examination process. The examiner then focuses on the second-level domain portion of the proposed mark and determines whether it functions as an indicator of source by itself. The lesson learned is that when applying for a trademark registration for a mark that is used primarily as a domain name, it is imperative to ensure its use as an indication of origin for the goods or services in question and not merely rely upon a TLD for uniqueness.

PRACTICE TIPS

General Tips to Protect Trademarks

- A trademark should be used as an adjective to indicate that the product or service comes from a particular source. A proper trademark is not a noun or a verb and should not be used in either plural or possessive forms.
- The common generic name of the product or service should follow the trademark. For example, EXXON gasoline stations.
- A trademark should be distinguishable from the rest of the text. For example, if the text is in lower case, the trademark can be initial-capped or in all caps. A trademark can also be distinguished by using a different type style or a different color.
- A trademark should be designated as a trademark by using the symbols TM or SM or the registration symbol ® next to the mark.
- In addition, the first time the mark is used in the text, the source of the mark should be indicated in a footnote.

- A registrant must police third-party use of any confusingly similar marks, both by monitoring the *Official Gazette* and sending C and D letters when necessary.

Making the Application Process Less Cumbersome

- The scope of the identification cannot be broadened once the application is filed. Therefore, it is better to err on the side of over inclusion of items because they can be deleted during prosecution.
- If the trademark contains descriptive or generic terms, do not disclaim them until the examiner requires the disclaimer in a first Office Action.
- Make sure the trademark is accurately typed or displayed in the application as filed. Correcting typos may not be allowed if the correction would materially alter the mark.

Paperless Filing

- Scan all specimens into electronic form, including Web site examples, by printing off the appropriate page(s) and then scanning and attaching them. There is an opportunity to describe what is being submitted within the application form in case it is not readily apparent by the scanned copy.
- If a copy of a Web site page is submitted, give the Web address along with the description so that if the scan is unreadable, the examiner may view the appropriate Web page.
- Garnering a Power of Attorney before filing the application in order to sign the application on behalf of the applicant is the most efficient means by which to sign an electronic application. One way to obtain the proper information is to “cut and paste” the standard Power of Attorney verbiage from the USPTO Web site into a word processing document saved and labeled for the applicant to sign. In the case of in-house legal counsel, either the legal counsel has direct knowledge of the use of or intent to use the mark or Power of Attorney is inferred, and he or she can sign without additional documents on file.
- Reporting to the client is especially easy via email because the USPTO sends out nearly simultaneous confirmations via email. The confirmation email, which includes the assigned Serial Number, replaces the traditional paper “filing receipt” normally issued.
- The applicant or legal counsel can check the status of the application via Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/> after 45 days.

Prosecuting Trademark Applications

- Always use a Certificate of Mailing or Transmission on every document that is filed with the USPTO. It will prevent the possibility that the application may become abandoned and save the time and expense of having to revive it.
- Respond to an examiner’s Priority Action as quickly as you can. The faster you respond, the faster your mark will be approved for publication.

- If an examiner calls you to discuss the application or to complete an Examiner’s Amendment, respond as quickly as possible. Examiners are on a rigid production system and must act upon a certain number of cases every day. Therefore, if an examiner takes the time to contact you via phone, it is a good indication that the application is about to be approved for publication.
- When responding to a refusal in an Office Action, make sure to include as much evidence as possible. Remember, the examiner and the TTAB decide based on paper evidence in the record.

APPENDIX

I. BIBLIOGRAPHY OF RELEVANT SOURCES REGARDING TRADEMARK LAW

- McCarthy, J. Thomas. *On Trademarks and Unfair Competition*. 4th ed., 2004.
- Gilson, Jerome. *Trademark Protection and Practice*. 1994.

II. WEBLIOGRAPHY OF USEFUL WEB SITES AND LINKS REGARDING TRADEMARK LAW

PLEASE NOTE: The links below were current at the time of writing, and there is no guarantee that the information included herein is still valid. The links and information below are provided for informational purposes only.

Useful Links: General

- USPTO, Home page: <http://www.uspto.gov>
- USPTO, Trademark Filings: <http://www.uspto.gov/teas/index.html>
- USPTO, Office Contact List: <http://www.uspto.gov/teas/contactUs.htm>
- World Intellectual Property Organization (WIPO), Home Page: <http://www.wipo.int/portal/index.html.en>
- Internet Corporation for Assigned Names and Numbers (ICANN), Home Page: <http://www.icann.org>

State Trademark Law Web Links by Jurisdiction:

Alabama

Please see: <http://www.sos.state.al.us/business/land.htm>

Alaska

Please see: <http://www.dced.state.ak.us/bsc/tmark.htm>

Arizona

Please see: <http://www.cc.state.az.us/corp/starpas/index.htm>

Arkansas

Please see: <http://www.sos.arkansas.gov/corps/trademk/>

California

Please see: <http://www.ss.ca.gov/business/ts/ts.htm>

Colorado

Please see: http://www.sos.state.co.us/pubs/business/faq_business.htm#Q33

Connecticut

Please see: <http://www.sots.ct.gov/CommercialRecording/crdforms.html#TradeandServiceMark>

Delaware

Please see: <http://www.delcode.state.de.us/title6/c033/index.htm>

Florida

Please see: <http://www.sunbiz.org/corpweb/inquiry/coritmo.html>

Georgia

Please see: <http://www.sos.state.ga.us/corporations/trademarks.htm>

Hawaii

Please see: <http://www.hawaii.gov/dcca/quicklinks/bac/pct>

Idaho

Please see: <http://www.idsos.state.id.us/corp/corindex.htm> regarding “assumed business names.”

Illinois

Please see: http://www.cyberdriveillinois.com/departments/business_services/publications_and_forms/trademrk.html

Indiana

Please see: <http://www.in.gov/sos/business/trademarks.html>

Iowa

Please see: http://www.sos.state.ia.us/corp/corp_search.asp

Kansas

Please see: <http://www.kssos.org/search.asp?SeartType-2>

Kentucky

Please see: <http://sos.ky.gov/business/trademarks/>

Louisiana

Please see: <http://www.sec.state.la.us/comm/cforms/f-309.pdf> regarding “tradenames.”

Maine

Please see: <http://www.maine.gov/sos/cec/corp/tradenam.htm> and www.Maine.gov/sos/cec/corp regarding “assumed names.”

Maryland

Please see: <http://www.sos.state.md.us/Registrations/Trademarks/Trademarks.htm>

Massachusetts

Please see: <http://www.sec.state.ma.us/cor/corpweb/cortmsm/tmsmfrm.htm>

Michigan

Please see: http://www.michigan.gov/documents/8306_34468_7.pdf

Minnesota

Please see: <http://www.sos.state.mn.us/business/forms.html>

Mississippi

Please see: <http://www.sos.state.ms.us/forms/forms.asp?TextOnly=NO>

Missouri

Please see: <http://sos.state.mo.us/business/commissions/trademark.asp>

Montana

Please see: <http://www.sos.state.mt.us/css/BSB/Contents.asp>

Nebraska

Please see: <http://www.sos.state.ne.us/admin/about/contact.html>

Nevada

Please see: http://secretaryofstate.biz/comm_rec/trademk/index.htm

New Hampshire

Please see: <http://www.sos.nh.gov/corporate/trademarkleader.htm>

New Jersey

Please see: http://www.state.nj.us/treasury/revenue/dcr/geninfo/fees_pd.html#tmsm-fee

New Mexico

Please see: <http://www.sos.state.nm.us/TradeFAQ.htm>

New York

Please see: <http://dos.state.ny.us/corp/miscfae.html>

North Carolina

Please see: <http://www.secretary.state.nc.us/trademrk/>

North Dakota

Please see: <http://www.nd.gov/sos/businessserv/registrations/trademark.html>

Ohio

Please see: <http://www.sos.state.oh.us/sos/businessservices/trade.aspx>

Oklahoma

Please see: <http://www.sooneraccess.state.ok.us/home/home-tm.asp>

Oregon

Please see: <http://www.filinginoregon.com/online.htm> about searching trade names.

Pennsylvania

Please see: <http://www.dos.state.pa.us/corps/cwp/view.asp?a=1093&q=431231>

Rhode Island

Please see: <http://www.sec.state.ri.us/corps/trademark/trademark.html>

South Carolina

Please see: <http://www.scsos.com/forms.htm#Trademarks>

South Dakota

Please see: <http://www.sdsos.gov/trademarks/>

Tennessee

Please see: http://www.state.tn.us/sos/bus_svc/trademarks.htm

Utah

Please see: <http://trademark.utah.gov/>

Vermont

Please see: <http://www.sec.state.vt.us/corps/tmkhome.htm>

Virginia

Please see: <http://www.state.va.us/scc/division/srf/webpages/regtrademark.htm>

Washington

Please see: http://www.secstate.wa.gov/corps/registration_forms.aspx

West Virginia

Please see: <http://www.wvsos.com/business/trademark/main.htm>

Wisconsin

Please see: <http://www.wisconsin.gov/state/byb/education.html#tpc>

Wyoming

Please see: <http://soswy.state.wy.us/corporat/tm.htm>

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