

FAQs

What is a Trademark? What is a Servicemark?

A “trademark” is any word, slogan, phrase, logo or a combination of those items that is used to identify the products of one company from the products of other companies. Trademarks represent branding efforts by a company and are incredibly important business asset in that they enable businesses to promote and distinguish the reputation of their products. They also allow business owners to market their products without the fear that a competing product of lesser quality will dilute or diminish the perception of the quality associated with their products’ brands. Trademarks usually appear directly on the product or its packaging, and the USPTO requires that specimen samples of the product(s) featuring the mark be submitted with the application, or at a later date after the application is filed if the products are not yet being sold in commerce.

“Service marks” are basically identical to trademarks but they are used to identify and distinguish services (as opposed to products) in the marketplace. A service mark can also consist of words, slogans, phrases, symbols and designs (and combinations of the foregoing). Service marks appear mostly in advertising for the services, such as a website featuring the mark. For ease of reference, we will refer to both trademarks and service marks as “trademarks”.

What is the Preliminary Direct Hit Search that is included in the Flat Fee Application Price?

We perform a preliminary direct hit search of your proposed mark with the USPTO database (TESS) as part of the flat application fee, to see if your mark is already registered. This direct hit search gives us an indication whether your proposed mark is registered. If we find that your exact mark has been registered, we will send you an email and offer to refund your application fee. Please keep in mind that this preliminary direct hit search is *by no means* a conclusive method for determining whether a trademark is available for use or whether the USPTO will register the mark, as the USPTO uses *many* criteria when evaluating a trademark application. Rather, the preliminary direct hit search we perform for free just lets us know whether your exact proposed mark is registered with the USPTO (or if there is a pending application for registration).

Our preliminary hit search **does not** include any other common law, internet or other database searches—only the USPTO’s federal trademark register. There are several other trademark search sources that would be beneficial to check for your mark, some of which include State trademark registers, telephone books, newspapers, the Internet, and a wide variety of other databases and media sources. If you would like to have the US Trademark Group order a comprehensive common law search, please send us an email to mail@dglegal.com, and we will be glad to arrange for a full search. Comprehensive

searches for availability in the U.S. generally take five (5) business days and costs \$750. Again, this is not mandatory, but is advisable if your budget allows this expenditure. With us, you can be assured that your trademark search will include a comprehensive search including the USPTO, State, Common Law, Internet and Domain Names. This more extensive search is done to see if anyone else is using your mark, but hasn't bothered to file a federal registration. However, you may wish to skip the common law search, and proceed directly with a trademark application based upon our preliminary search and your own search efforts-we will gladly defer to your choice, but just want to make you aware of your options.

The Trademarking Process

The US Trademark Group has attempted to make the Federal Trademark Registration Process as easy as possible for our clients. The following sets forth a general overview of the registration process to give you an idea of what you can expect when using our firm to file your application:

- 1) **Complete our easy online questionnaire, found at USTRademarkGroup.com.**
 - **Email us an image of your name and logo mark to Mail@DGLegal.com**
If your trademark is a stylized design or logo, you will need to send us an image of the mark. If your trademark is currently being used in commerce, we will need a sample showing the mark in use.
 - **We'll conduct a trademark search.**
We conduct a trademark search for possible conflicts with existing marks. If a conflict exists, you can choose to modify your application, proceed as planned, or cancel your application.
 - **We complete and file your application, acting as your attorneys.**
The USPTO will assign a serial number to your registration and we will email you a confirmation.
 - **The USPTO reviews your application.**
About six months after filing, the USPTO will review the application and determine whether the mark may be registered. If the examining attorney determines the mark cannot be registered, he or she will issue an Office Action listing grounds for the refusal, and instructions if you decide to petition against the refusal. The examining attorney may also send you an Office Action if any other corrections on your application are required. You must respond to any Office Actions within six months of the letters mailing date.
 - **The USPTO approves your mark for publication.**
If there are no objections, or if you overcome all objections, the examining attorney will approve the mark for publication in the Official Gazette. The USPTO will send you a Notice of Publication indicating the publication date. In the case of two or more applications for similar marks, the USPTO will publish the application with the earliest effective filing date first.
 - **You Receive a Registration Certificate from the USPTO.**

- a. If your application was based on using your mark in commerce and no opposition was filed, the USPTO will register the mark and issue a registration certificate about 12 weeks after the publication date of the mark.
- b. If the mark was published based on the applicant's statement of intent to use the mark in commerce and no opposition was filed, the USPTO will issue a Notice of Allowance about 12 weeks after the publication date of the mark. You have six months from the date of the Notice of Allowance to either (1) use the mark in commerce and submit a Statement of Use, or (2) request a six-month Extension to File a Statement of Use. If the Statement of Use is filed and approved, the USPTO will then issue the registration certificate.

As with patent applications, trademark applications are reviewed by an examiner at the USPTO and will either be accepted or rejected, but sometimes the examiner will issue an Office Action that requires a response. This may be a challenge to the distinctiveness of the mark, its use, or the class—there are a variety of issues that may be raised in an Office Action. We will be glad to prepare and file all responses to any and all office actions so that your mark will issue. We perform all such work at our discounted hourly rate of \$275, and we would obtain an advance retainer from you in the amount of \$250 to \$1,000, depending on our assessment of the work involved. *Note that discount, non-attorney trademark filing services cannot and will not represent you in an office action.*

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Is registration of my mark required?

No. You can establish rights in a mark based on legitimate use of the mark. However, owning a federal trademark registration on the Principal Register provides several advantages, e.g.,

- constructive notice to the public of the registrant's claim of ownership of the mark;
- a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;
- the ability to bring an action concerning the mark in federal court;
- the use of the U.S registration as a basis to obtain registration in foreign countries; and
- the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

When can I use the trademark symbols TM, SM and ®?

Any time you claim rights in a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO. However, you may use the federal registration symbol "®" **only** after the USPTO actually *registers a mark*, and **not** while an application

is pending. Also, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration.