

# TRADEMARKS: A CLINICAL HANDBOOK

MICHAEL A. RANSOM, KARI L. HENDEL, & MATTHEW G.  
SIPF\*

## TABLE OF CONTENTS

Introduction.....	148
Trademark Basics.....	148
The Initial Client Interview.....	154
Performing a Search.....	157
Filing the Application.....	160
Following Up.....	163
Office Actions .....	163
Publication for Opposition, Registration, and Maintenance.....	164
Conclusion .....	165
Checklist.....	167

---

\* Michael A. Ransom, Kari L. Hendel, and Matthew G. Sipf each graduated from the University of Tennessee College of Law in May 2016. The authors worked together in the Business Law Clinic at the College of Law assisting clients with various transactional matters including prosecuting trademarks. Additionally, Mr. Ransom and Ms. Hendel were students in the first Trademark Clinic offered by the College of Law as part of the USPTO Pilot Program. All are licensed to practice in Tennessee.

## INTRODUCTION

Welcome to the world of trademarks and thank you for taking time to peruse this handbook! Trademarks are a fascinating part of both the modern legal and business worlds, so it is a great idea to know something about them before finding yourself on the wrong side of a cease and desist letter or, even worse, losing a valuable business or product name to another party. This handbook is intended to be used in conjunction with the United States Patent and Trademark Office's Pilot Program, which allows students at participating law schools to prosecute trademarks for real clients. It is not the authors' intention that this handbook replace clinical instruction, doctrinal courses in intellectual property, or other educational courses in trademark law. In fact, it is strongly recommended that students take advantage of all relevant educational resources and treat this handbook merely as a guide to assist with the process of learning how to file trademarks. Before starting, you may want to review the United States Patent and Trademark Office ("USPTO") website at [www.USPTO.gov](http://www.USPTO.gov) and familiarize yourself with the site and the resources available there. Remember that this is a learning process, so take advantage of every opportunity to expand your knowledge and understanding of all things trademark-related. Good luck!

### I. TRADEMARK BASICS

#### *A. The Trademark Process*

The process of filing a trademark is relatively straightforward. As you will see later on in this handbook, the attorney does most of the work in a trademark application before actually filing anything with the USPTO. Before filing, the client can display the "TM" symbol in conjunction with his or her mark, which serves as notice to the public that he or she is claiming the exclusive right to that particular mark. Once the attorney has done all of this work, he or she files an application with the USPTO, which then has up to six months to review the application and determine whether it will publish the mark. If the mark is published and no other party opposes the mark, the USPTO will register the mark on the Principle Register and the client can start using the "®" symbol on his or her trademark. Once again, this is all covered

later in the handbook, but it is advisable to have some idea of the process before reading further.

B. *What is a Trademark?*

Now that you have a very basic idea of what the trademark process entails, the most logical next step is to define what a trademark is. The Lanham Act, which represents the majority of codified trademark law in the United States, states that:

“[t]he term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>1</sup>

This relatively simple statute has been the source of much contention over the years as to what Congress intended a trademark to include. Courts occasionally have clarified this language and held that anything capable of identifying the source of a good or service is capable of being a trademark, including “a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread).”<sup>2</sup> The key here is that the trademark identifies the source of a good or service because, at a fundamental level, trademarks are intended to protect those words or images that identify the quality of a good or service.<sup>3</sup> To illustrate, imagine a world where we allowed both Apple and a knock-off competitor to market and sell cellular phones under the name

---

<sup>1</sup> 15 U.S.C. § 1127 (2012).

<sup>2</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (citing Registration No. 696,147 (Apr. 12, 1960); Registration Nos. 523, 616 (Apr. 4, 1950) and 916, 522 (July 13, 1971); *In re Clarke*, 17 U.S.P.Q.2d 1238, 1240 (T.T.A.B. 1990)).

<sup>3</sup> *See* 15 U.S.C. § 1127 (2012).

“iPhone.” Consumers would walk into their cellular provider expecting to receive a high quality device and would leave not knowing whether they purchased the real thing or the knock-off. By limiting the iPhone brand to just Apple, consumers can rest assured that they receive a product on par with the quality expected from Apple.

*C. Can Any Word or Symbol Actually be a Trademark?*

As you saw from the trademark definition above, almost anything can technically be a trademark. Now, just because almost anything can serve as a trademark, that does not mean that every word or symbol necessarily will be “trademarkable.” There are several factors to consider including:

1. The Strength of the Mark;
2. Use of the Mark in Commerce; and
3. Competing Marks (aka Likelihood of Confusion)

All of these factors will be examined individually to provide the best overview of how each affects the trademark application process.

1. The Strength of the Mark

In the world of trademarks, there is a spectrum of five “designations” into which all potential trademarks fall. This spectrum includes Coined, Arbitrary, Suggestive, Descriptive, and Generic marks, with different degrees of “trademarkability” attached to each category.<sup>4</sup> Trademarks must be distinctive in order to be registered by the USPTO, and this spectrum provides guidance for both the attorney filing a trademark application and USPTO examiners to determine the distinctiveness of a mark. The more distinctive a mark is the more protection it is afforded.<sup>5</sup>

Coined marks have the strongest level of trademark protection because they are essentially a new word or image created by the owner to

---

<sup>4</sup> *Trademarks vs. Generic Terms*, INT’L TRADEMARK ASS’N, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarksvsGenericTermsFactSheet.aspx> (last visited Sept. 12, 2016).

<sup>5</sup> *Id.*

identify his or her good or service.<sup>6</sup> Put another way, the word or phrase used to identify the source of the good or service did not exist prior to being applied to those goods or services. As a result, coined marks are inherently distinctive, which gives them the highest level of trademark protection, and they are the easiest to trademark.<sup>7</sup> A classic example of a coined mark is “Xerox,” which did not exist as a word until it was created and used to identify a certain brand of photocopy machines.<sup>8</sup>

Arbitrary marks are the next strongest marks, and represent words that already exist, but that are applied to a good or service not otherwise associated with that word.<sup>9</sup> A good way to think of arbitrary marks is to determine what the word refers to, and then look at how it is being used by the trademark applicant. If the applicant is using the word differently from the ordinary meaning that is attached to the word, then the mark is likely arbitrary. For example, the word “Apple” is generally understood to mean a piece of fruit. But there is also a technology company that began using the name and symbol of an apple as an identifier for the computers it manufactured.<sup>10</sup> This arbitrary use of a name is given a high degree of “trademarkability” as a result of the consumer being able to quickly associate the name with the source of the good or service. Another example of an arbitrary mark is the name “Jaguar” for a brand of luxury cars.

Suggestive marks are perhaps the trickiest of all because they are difficult to distinguish from descriptive marks. A suggestive mark suggests the source of the good or service, but requires the consumer to

---

<sup>6</sup> *Types of Trademarks*, INTELLECTUAL PROPERTY LAW GROUP, LLP, [http://www.iplg.com/resources/articles/trademark\\_types.html](http://www.iplg.com/resources/articles/trademark_types.html) (last visited Sept. 12, 2016).

<sup>7</sup> *Id.*

<sup>8</sup> *See id.*

<sup>9</sup> *Trademarks vs. Generic Terms*, INT’L TRADEMARK ASS’N, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarksvsGenericTermsFactSheet.aspx> (last visited Sept. 12, 2016).

<sup>10</sup> *See id.*

create the final association between the mark and the source. Suggestive marks are given less trademark protection because marks that partially describe the good or service are poor indicators of the source of those goods or services.<sup>11</sup> In fact, it is often difficult, even for seasoned attorneys, to differentiate between suggestive and descriptive marks. As a result, marks sometimes fail USPTO examination for registration even if they are technically suggestive. Some of the easiest examples of registered marks that are suggestive are “Microsoft” for computer software and “Netflix” for internet streamed movies and shows.

Descriptive marks are not usually “trademarkable” because they merely describe the good or service rather than identify the source of those goods or services, undercutting the fundamental purpose of trademarks.<sup>12</sup> Good examples of descriptive marks that would likely fail to attain registration include “E-Trade” for electronic stock trading software and “Chapstick” for a lip balm stick that treats chapped lips. These marks merely describe the good or service being offered rather than identify the source. In some cases, it is possible for a descriptive mark to be registered if the owner can show that the mark has acquired distinctiveness through use. However, this is often a costly process that does not guarantee registration. As a result, it is probably best to caution a client against filing a descriptive mark.

Generic marks are the final category of trademarks and are never “trademarkable” because they are, well, generic.<sup>13</sup> A generic mark is something that refers to an entire class of goods or services rather than identifying the specific good or service.<sup>14</sup> A classic example of a generic trademark is “Aspirin,” which is commonly referred to when referencing an over-the-counter pain-killer rather than a specific brand of medicine made from acetylsalicylic acid.<sup>15</sup> Companies often patrol their trademarks heavily to make sure that their brand name is not becoming

---

<sup>11</sup> See 15 U.S.C. § 1127 (2012).

<sup>12</sup> See *Trademarks vs. Generic Terms*, INT’L TRADEMARK ASS’N, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarksvsGenericTermsFactSheet.aspx> (last visited Sept. 12, 2016).

<sup>13</sup> See *id.*

<sup>14</sup> *Id.*

<sup>15</sup> See *id.*

generic because people are using the name to refer to an entire class of goods.<sup>16</sup> For example, Google’s trademark could potentially become generic as many people simply refer to an online search engine as “Google” or the act of running an online search as “Googling.”

## 2. Use of the Mark in Commerce

In addition to being a distinctive mark that identifies the source of a good or service, trademark law requires that a mark be in use in commerce at the time of filing, or that the applicant intend to use the mark in commerce within six months of the time an application is made for trademark registration.<sup>17</sup> “Use in commerce” is a somewhat ambiguous phrase that raises questions in the mind of the average applicant. Thankfully, the USPTO provides some clarification by stating that commerce means, “all commerce that the U.S. Congress may lawfully regulate; for example, interstate commerce or commerce between the U.S. and another country.”<sup>18</sup> Use in commerce must be “bona fide use of the mark in the ordinary course of trade, and not use simply made to reserve rights in the mark.”<sup>19</sup> Generally, use in commerce for goods is met when the mark appears on the goods, the container holding the goods, or on a display associated with the goods.<sup>20</sup> If the mark is representing a service, it “must be used or displayed in the sale or advertising of the services, and the services must be rendered in commerce.”<sup>21</sup> When applying to trademark a mark currently in use in commerce, the applicant must provide a sworn statement asserting the first date that the mark was ever used and the

---

<sup>16</sup> *See id.*

<sup>17</sup> *Intent to Use (ITU) Forms*, U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/filing-online/intent-use-itu-forms> (last visited Aug. 14, 2015).

<sup>18</sup> *Glossary*, U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/main/glossary/> (last visited Aug. 14, 2016).

<sup>19</sup> *Id.*

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

first time it was used in commerce. The USPTO does, however, allow registration of a mark not yet in use in commerce if an “Intent to Use Application” is filed, an additional fee is paid, and the mark is used within six months of the date of filing.

### 3. Competing Marks

Finally, in order for a trademark to be registered by the USPTO, a mark cannot be substantially likely to cause consumer confusion.<sup>22</sup> As previously mentioned, trademark protection stems from a need to protect the owner of a mark from having other, lesser quality goods or services passed off as the same as those identified by the mark. This trademark protection is as much for the good of the mark owner as it is for the consumers that would otherwise purchase a good or engage a service provider with the belief that they are getting a higher quality service or good than they are actually receiving.

This is not to say that there cannot be a mark registered in one class under one name and another with a similar name in a different class. This part of the USPTO system is simply intended to prevent confusion and if no confusion exists, there is no issue. Keep in mind, however, that just because you do not find a registered mark does not mean that there is no potential conflict. The United States recognizes some protections for common law trademarks. Lawsuits stemming from common law trademarks arise when there are other parties already using a mark in commerce, but have not registered a that mark with the USPTO. While it is unlikely to be an issue outside of large, well-known marks, it is always good to research any potential common law marks and let your client know about potential issues or anticipated legal actions down the road. One of the best ways to research common law trademarks is through a detailed internet search.

## II. THE INITIAL CLIENT INTERVIEW

Now that you know a little bit about trademarks, it is time to meet with your client. The first time you meet with your client, either in person, via skype, or on the phone, you are gathering information while

---

<sup>22</sup> *Protecting Your Trademark*, U.S. PATENT AND TRADEMARK OFFICE, 3, <http://www.uspto.gov/sites/default/files/BasicFacts.pdf> (last visited Sept. 12, 2016).

also giving your client some assurance that you know what you are doing. Thus, it is important to ask the right questions and anticipate what questions your client will ask so that you can respond with confidence.

Arguably, the most important part of the initial client interview is finding out who your client is. This critical step is often overlooked by students, but is vitally important from an ethical and practical standpoint. After all, you cannot advise an individual client that he or she should claim ownership of a trademark and is able to license it to a corporation for a fee if that corporation is actually your client. That is a conflict of interest and violates the rules of professional conduct.<sup>23</sup> Know who your client is before proceeding, and keep that person or entity's best interest in mind throughout the clinical process.

After establishing the identity of your client, you should try to figure out what it is that the client does. Do they sell cinnamon scented pet grooming products? Do they have a treehouse cleaning service? Do they currently sell their products at the local farmer's market, or is it just an idea that they want to make a reality? Does the client's next door neighbor also sell products under the same name? These questions go back to the purpose of a trademark, which is to protect the source of a good or service, while also hitting some of the USPTO requirements early in the process. You need to understand the client's business before you can help him or her decide if the source of a good or service equals a registrable trademark, so ask questions that will give you the information you need to move forward.

Likewise, it is important for you to figure out what exactly the client wants to trademark. Do they want to protect the name of their business? Do they want to trademark a stylized logo? Do they want to claim a specific color as part of their trademark? These are all questions that are important to ask because they affect the trademark application filing process as discussed later on.

---

<sup>23</sup> See MODEL RULES OF PROF'L CONDUCT r. 1.7 (1983).

Once you have an idea of what the client does, you should explain the trademark process to him or her. Keep in mind, however, that your client is likely new to this process and may not be familiar with the concepts or terminology common to trademark registrations. In other words, keep it simple. Let them know that they need to have a unique mark that is either currently in use or will be in use within six months of filing the application. Furthermore, let them know that the cost will differ based on the type of application you file and whether or not the mark is in use.<sup>24</sup> The costs associated with filing are also detailed later in this handbook, but as of 2016, the range in cost is \$225.00 - \$325.00 per USPTO classification.<sup>25</sup>

You should also ask some questions that provide additional information you will need to file the trademark application later. Specifically, you should ask your client the first date he or she ever used the mark, and also the first date he or she used the mark in commerce. Both of these dates are crucial in the trademark registration process because it can establish priority based on use. Often, the client will not know the answer to these questions and will have to get the information to you later. You have time for them to do so, which is why you are asking questions now.

At this point, it is probably not a good idea to offer your client an opinion as to whether you think the mark will be accepted for registration because you likely have not performed a search for conflicting marks and thus have not done your due diligence. In fact, as a practical matter, it is always a good rule to be cautious when offering your client any kind of opinion as you can never guarantee an outcome and can avoid losing the client's trust if the case ends differently than you promised it would. You can and should, however, reassure the client that you know what is going on, will begin working on their case shortly, and will keep them informed. Often you are dealing with the client's hard-earned business reputation, so making them feel comfortable with the process and their attorney is important.

---

<sup>24</sup> See *Filing Online*, U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/filing-online> (last visited Sept. 12, 2016).

<sup>25</sup> *Id.*

### III. PERFORMING A SEARCH AND DETERMINING A FILING CLASS

#### *A. Performing a Search*

Once you have met with your client, it is time to start searching for conflicting marks. As you already know, this is one of the most critical parts of filing a trademark because the USPTO will not register a mark if it is likely to cause consumer confusion with another registered mark.<sup>26</sup> To facilitate this process for both practitioners and trademark examiners, the USPTO maintains a database called the Trademark Electronic Search System or, as it is commonly known, TESS.<sup>27</sup> This database contains every trademark application that has been filed with the USPTO, which makes it the logical starting point for a search of potentially conflicting trademarks.

The process of running a search on TESS is a bit archaic and the interface feels a bit rough for a system that receives a high volume of traffic. However, attorneys must work with what they are given, so learning how to navigate the TESS system is necessary to ensure thorough coverage of registered trademarks. When you arrive at the site, several search options are presented including “Basic Word Mark Search;” “Word and/or Design Mark Search (Structured);” and “Word and/or Design Mark Search (Free Form).”<sup>28</sup> Each has its pros and cons depending on what you are looking for.

For an initial trademark search, it is probably best to use the Basic Word Mark Search function. This search will retrieve all marks that are similar or identical to your search query. This is important because it will give you an idea of any potentially conflicting marks. The Structured Search function will allow you to narrow the parameters of

---

<sup>26</sup> *Protecting Your Trademark*, U.S. PATENT AND TRADEMARK OFFICE, 3, <http://www.uspto.gov/sites/default/files/BasicFacts.pdf> (last visited Sept. 12, 2016).

<sup>27</sup> The TESS database can be accessed at <http://tess2.uspto.gov/>.

<sup>28</sup> See *Trademark Electronic Search System*, U.S. PATENT AND TRADEMARK OFFICE, <http://tess2.uspto.gov/> (last visited Sept. 12, 2016).

your search by things like international trademark class or attorney of record. This search is helpful if you are looking for specific marks and already know the search parameters. The Free Form search function allows you to create a free form search using various codes and keywords. This is a somewhat complicated procedure that is likely beyond the scope of a clinical program.

As part of your due diligence, you also want to perform a search of the internet for other similar marks. This is important because, even though you looked through the TESS system for registered marks, there could be other similar marks out there that are not registered. While these unregistered marks will not prevent the USPTO from approving your client's mark for publication, it could become an issue if the owner of the other mark decides to assert a claim against the validity of your client's mark once it has been published. Knowing the existence of these marks will allow you to plan appropriately and give your client the best advice possible.

#### *B. Determining a Filing Class*

Up to this point you may have been confused by various references to "Class" or "Classification" that have appeared throughout the previous sections of this handbook. To clarify and explain, classifications are a big part of a trademark application because they define the parameters of the good or service that is attached to the mark you are attempting to register. Put more simply, not all goods and services are the same, so the USPTO created a list of 45 International Classifications into which all goods or services fit.<sup>29</sup> This prevents a company that sells welding tools and a company that offers a dog walking service from competing with each other for a registration when they clearly have nothing in common. There is occasionally some overlap between classes, but generally your client's goods or services will fit easily into a particular class.

This is where you come in as the attorney. Part of your job is to help the client understand what he or she is trademarking. If he or she

---

<sup>29</sup> *List of Goods and Services in Class Order*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, <http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20160101/taxonomy/> (last visited Sept. 12, 2016).

manufactures a good, then it is technically possible to trademark both the manufacturing service and the good that is manufactured.<sup>30</sup> However, these two things would fall into two separate classes. The USPTO allows for filing multiple classes in the same application, but requires a separate fee for each class. In other words, it can get expensive for your client if they trademark every possible class. Discuss these costs so that the client can make an informed decision.

The other task you have as the attorney is making the determination as to what class is appropriate for the client's good or service. This is something of a judgement call and will depend largely on your understanding of the client's mark. For example, if your client has a line of designer jeans and you are filing to protect the brand name as it relates to the goods (rather than the service of making the jeans), you would decide to file in International Class 25 which covers clothing.<sup>31</sup> If you have any questions about the class, it may be worth your while to talk with your client and explain the issue as you see it. You can often save time and energy by seeking clarification when you need it.

Once you have completed all of your searches and determined the proper class, you are at the "point of no return." Everything you do from this juncture forward will be based on your belief that the client's mark is or is not conflicting with any other marks and fits into a particular classification. You will either move forward with filing the application, or you will tell your client that his or her mark is likely not registrable and it is best to not proceed with the application process. This is a big decision and one that you must make and live with. This type of judgement call is likely new territory for many law students and is a great introduction to the decision-making you will have to exercise in practice. So, carefully consider everything you know about the mark, consult with your clinic supervisor and your client if need be, and decide how you will proceed.

---

<sup>30</sup> *See id.*

<sup>31</sup> *See id.*

#### IV. FILING THE APPLICATION

If you survived the previous step and decided to move forward, you are now at the point in the semester where you prepare to file the trademark application. A trademark application may be filed by mail, hand delivery, or online through the Trademark Electronic Application System (“TEAS”).<sup>32</sup> The USPTO prefers all applications to be completed through TEAS.

Applications filed through TEAS are required to provide:

1. the owner of the mark and its entity type;
2. contact information;
3. the standard character mark, stylized/design mark, or sound file; and
4. additional statements including:
  - a. disclaimers, translations, consents, and miscellaneous statements;
  - b. the filing class and goods/services offered;
  - c. description and PDF or JPEG attachment of the specimen;
  - d. date of first use of mark anywhere and in commerce; and
  - e. all filing fees.

There are three options for filing a trademark application through TEAS:

1. TEAS Plus Form. In order to use this form, you must meet the filing requirements specified on the USPTO website, file certain submissions electronically, and authorize email communications. The filing fee for this form is \$225 per class of goods/services.

---

<sup>32</sup> *Filing Online*, U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/filing-online> (last visited Sept. 12, 2016).

2. TEAS Reduced Fee Form. In order to use this form, you must meet the filing requirements specified on the USPTO website, file certain submissions electronically, and authorize email communications. The filing fee for this form is \$275 per class of goods/services.
3. TEAS Regular Form. The filing fee for this form is \$325 per class of goods/services. On the form you must include the name of the applicant, a name and address for correspondence, a clear drawing of the mark, and a listing of the goods/services.<sup>33</sup>

Before you file, it may be a good idea to familiarize yourself with the Trademark Manual of Examining Procedure (“TMEP”) as it is the go-to source for the examiners when they review your application.<sup>34</sup> If you have a particular issue or are unclear about what the USPTO will require for your client’s mark, search through the TMEP to see if you can find a way to circumvent the issue before it is raised by the examiner. After all, your job is to avoid any potential time-consuming problems for your client and anticipate your best defense.

Now that you are ready to file, decide which application you will file and then proceed through the steps outlined in the application. The application is fairly straightforward and self-explanatory. However, there are one or two places that some additional information may be helpful.

First, know the difference between a drawing and a specimen. A drawing is simply the word or symbol that you are attempting to register.<sup>35</sup> For a standard character mark, the drawing will simply consist of typed black letters against a plain white backdrop.<sup>36</sup> For a stylized mark, you will upload an image showing the mark you are

---

<sup>33</sup> *Id.*

<sup>34</sup> The TMEP is available online at <https://mpep.uspto.gov/RDMS/TMEP/current>.

<sup>35</sup> *Protecting Your Trademark*, U.S. PATENT AND TRADEMARK OFFICE, 16, <http://www.uspto.gov/sites/default/files/BasicFacts.pdf> (last visited Sept. 12, 2016).

<sup>36</sup> *See id.* at 17.

attempting to register.<sup>37</sup> If you are filing a stylized mark, make sure that your image conforms with the USPTO size requirements outlined in the application. Nothing is worse than your clinic supervisor receiving an email stating that your image file for the mark was rejected due to size issues.

Another required element of the application is that it must include a specimen of the mark, which is an image that shows the mark in use in commerce.<sup>38</sup> This can be a screenshot of a website showing the client's business name, or it can be a picture of a T-Shirt with your client's logo on the price tag. Remember that the point of a specimen is to show use in commerce so make sure that your specimen includes some showing that the good or service is actually available to consumers. If necessary, review the USPTO website for all guidelines relating to specimen.<sup>39</sup>

One crucial step in the filing process that many students overlook is including your school code in the Attorney of Record area. Your supervisor should have this code as well as an example of how to add it to the application. Failure to include this code will cause the USPTO to route your applications to a different set of examiners which takes longer and will frustrate and upset the examiners. Most of the examiners are very helpful and easy to work with, so return the favor by not making their lives harder.

When completing your application, have your supervisor review everything to make sure you have not overlooked anything. The supervisor is the primary attorney listed on the application and is responsible for your work. As a result, they will need to verify that everything has been done correctly. After completing the application and paying the appropriate fees, a link will be provided to save a copy of

---

<sup>37</sup> *Id.*

<sup>38</sup> *Id.* at 21.

<sup>39</sup> "Specimen" Refusal and How to Overcome This Refusal, U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademark/laws-regulations/specimen-refusal-and-how-overcome-refusal> (last visited Aug. 14, 2016).

the filing receipt. Make sure to save this document, keep a copy in your records, and email a copy to your client.

## V. FOLLOWING UP

Once the trademark application has been filed, the USPTO assigns a serial number to the application. You can use this number to check the status of the trademark by going to the Trademark Status & Document Retrieval (“TSDR”) and entering the number in the search box.<sup>40</sup> The application and all related documents, communications, and updates will be posted to this site. A good rule of thumb is to check the status of the mark once a week. By periodically checking the status of the mark, you will be able to adequately inform your client and clinic supervisor of any developments or issues that arise. Keeping your clients up to date is an important aspect of both your clinical experience and real world practice, so it is a good time to develop the habit. In the past, the time to receive a response from the USPTO has ranged from 30 days to three months. Your wait generally ends when one of two things happens: 1) Your mark is approved for publication, or 2) You receive an office action. What each of these things means for you moving forward is discussed below.

## VI. OFFICE ACTIONS

Office actions are letters, usually issued by the examining agent, notifying the applicant of any deficiencies in the application or problems with the mark itself, and refusing registration.<sup>41</sup> The office action may come in many forms including: A Letter of Suspension; a request for a substitute application, certification, or collective mark; an Intent-to-Use office action; or a Post-Registration office action. The office action is simply a letter that lays out the examining agent’s rationale for rejection, along with any case law or statutes that the examiner relied on when

---

<sup>40</sup> TSDR can be accessed at <http://tsdr.uspto.gov/>.

<sup>41</sup> See *Protecting Your Trademark*, U.S. PATENT AND TRADEMARK OFFICE, 25, <http://www.uspto.gov/sites/default/files/BasicFacts.pdf> (last visited Sept. 12, 2016).

making his or her decision.<sup>42</sup> Responses to an office action must be filed within six months after the mailing date of the office action, or your application will be abandoned.<sup>43</sup>

Upon receipt of an office action, your first step should be to discuss the issues raised by the examiner with your clinic supervisor. Often the issue is a simple one that can be fixed by calling the examiner and requesting an examiner's amendment to your application. In fact, it is often a good idea to call the agent and discuss any questions with them. The USPTO agents that work with the Pilot Program do so specifically because they want to help students learn the trademark process. As a result, they are often very helpful and provide good insight into your application and the practice of filing trademark applications. This does not mean you should call the examining agent with no idea of what you need. The examiners have limits on what information they can give you, so ask specific questions and do not push them if they say they cannot answer your question. Most importantly, remember to be respectful and conscious of the examiner's time.

If the office action requires that you file a response, such as adding a disclaimer or amending goods/services, you will need to prepare a response that will be sent in accordance with the instructions set forth in the office action. This process is completed online and is generally quick and simple. If you are able to resolve the issue in this manner, the examining agent will then move forward with publishing the mark for opposition.

## VII. PUBLICATION FOR OPPOSITION, REGISTRATION, AND MAINTENANCE

If there are no objections raised to the trademark application, or all objections are overcome, then the examining attorney will publish the mark in the USPTO Official Gazette.<sup>44</sup><sup>45</sup> Publication of the mark is

---

<sup>42</sup> *See id.*

<sup>43</sup> *Id.*

<sup>44</sup> 15 U.S.C. § 1062 (2012).

<sup>45</sup> The Official Gazette is posted at <https://www.uspto.gov/learning-and-resources/official-gazette>.

used to give notice to any party who believes that he or she may be harmed by the registration of the mark. Any party wishing to contest registration has up to 30 days after publication to object to the registration.<sup>46</sup> An objection may result in a proceeding held before the Trademark Trial and Appeals Board (“TTAB”).<sup>47</sup>

If no opposition is raised or filed during the 30-day period, then the USPTO will register the mark and issue a certificate of registration.<sup>48</sup> After registration, the owner must continue to pay periodic fees and file proof of use to keep the registration active. Specifically, between the fifth and sixth years after the trademark is registered, the registrant must file a Declaration of Use, asserting that the trademark is in use in commerce.<sup>49</sup> Subsequently, the owner of the trademark must file a Declaration of Use between the ninth and tenth year after registration and between every ninth and tenth year after that.<sup>50</sup> After five years, the owner of the mark may also file for incontestability,<sup>51</sup> which provides an additional layer of protection for his or her trademark.

## VIII. CONCLUSION

So, now you know everything you need to know in order to successfully prosecute a trademark with the USPTO, right? As much as you would like to believe so, this is probably not an accurate

---

<sup>46</sup> 15 U.S.C. § 1063 (2012).

<sup>47</sup> *Protecting Your Trademark*, U.S. PATENT AND TRADEMARK OFFICE, 25, <http://www.uspto.gov/sites/default/files/BasicFacts.pdf> (last visited Sept. 12, 2016).

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 31.

<sup>50</sup> 15 U.S.C. § 1058 (2012).

<sup>51</sup> “An ‘incontestable’ registration is conclusive evidence of the following: (1) validity of the registered mark, (2) the registration of the mark, (3) the owner's ownership of the mark; and (4) the owner's exclusive right to use the mark with the goods/services.” *TEAS*, U.S. PATENT AND TRADEMARK OFFICE, <http://teas.uspto.gov/postreg/view/S71N15/WIZHELP.htm> (last visited Aug. 14, 2016).

statement. As outlined in the introduction, this handbook is not a substitute for any other method of instruction when it comes to such a technical area of the law. However, it is the hope of the authors that through this handbook, you are a little more confident in your ability to navigate the sometimes daunting task of handling real trademarks for real clients. In the appendix, you will find a checklist that you can use to quickly review the important steps outlined in this guide. Take advantage of all the resources at your disposal and most importantly, enjoy your time in clinic. Once again, good luck!

## APPENDIX

### CHECKLIST

#### A. Meet with the Client:

1. Determine who your client is and who owns the mark.
2. Determine exactly what it is that your client wants to trademark.

#### B. Review the Mark:

1. How strong is the mark?
2. Is the mark being used in commerce?
3. Are there competing marks that are likely to confuse consumers?

#### C. Search for Existing Trademarks:

1. Are there any similar marks on TESS?
2. Are there any similar marks that are not registered?

#### D. File the Trademark Application:

1. Owner of the mark
2. Specimen of the mark (pdf or jpeg)
3. Class or classes of filing
4. First date of use ever
5. First date of use in commerce
6. Credit card for payment of filing fee

#### E. Monitor the Status of the Trademark Application at <http://tsdr.uspto.gov/>