

The quest for the glorious[®]

By Ian Berkowitz
SPECIAL ADVERTISING
Part Three of a
Three-Part series

The previous articles in this series on Trademarks, Servicemarks and Tradenames addressed the purpose, reason, and definitions of Trademarks, Servicemarks and Tradenames. In examining the purpose of obtaining Trademark protection, I stated that if you have any desire to possess any Intellectual Property for your business you must obtain the maximum protection, which is to file a federal application with the U.S. Patent and Trademark Office. Simply put, no protection equals no ownership of the Intellectual Property no matter how long you have been using the mark. However, before you even file your application and seek protection I would highly recommend conducting a comprehensive search with the U.S. Patent and Trademark Office to make sure your mark is not similar to anything that is already protected.

As the world has embraced the use of technology so too has the U.S. Patent and Trademark Office provided an electronic platform to register and obtain protection for your Intellectual Property. The system known as the Trademark Electronic Search System, known as "TESS", is the portal used to search the U.S. Patent and Trademark Office database, to determine whether a confusingly similar mark is already registered, or whether a pending application for a confusingly similar mark has been filed, for related goods and/or services.

Check your mark

When developing your mark it would be extremely beneficial to run your names, marks and ideas through the system in order to nix your choices of marks that have already been taken. You surely don't want to develop a logo, name or mark only to find out that someone else has developed it before you. Another word of caution is not to assume that it is available just because it is not listed. Some registrations may not be on the system or may be in the processing stage. Unfortunately, the system does not operate in "real time".

Once you have reviewed the system and checked out TESS for any same or similar marks then

you must make a determination of whether or not your mark can withstand the scrutiny.

Is there anything similar and if so can you responsibly articulate the differences so that the U.S. Patent and Trademark Examining Attorney will grant your registration. The next step is to check out any potential conflicts on the Trademark Application and Registration and Retrieval system, commonly referred to as "TARR". TARR will give you information about any applications and registrations that might create a potential conflict obstacle for you to obtain protec

Again look at the results and with a very detailed eye determine whether or not you are good to go or you need to modify your mark to avoid trouble.

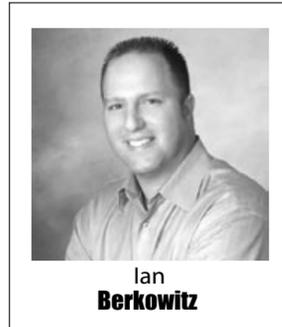
Online application

If you believe that you are ready then navigate back to "TEAS" which stands for the Trademark Electronic Application System. TEAS is an online system which allows you to fill out a form, check it for completeness, and then submit the form directly to the U.S. Patent and Trademark Office over the internet, making an official filing on-line. The system itself is very user friendly and will prompt you through the process especially if you choose to file using the online wizard.

Once you begin a new registration, you will be requested to answer questions such as listing information about you, the filer, and the mark's owner.

You also need to identify the class of the mark, which is a numerical description of the goods and/or services that the mark represents. A trademark application is incomplete without a statement identifying the goods and/or services with which the mark is used or will be used. The U.S. Patent and Trademark Office's website has a link if you are running into problems identifying a class for you to use for registration. Beware that the identification must be specific enough to identify the nature of the mark and its use.

You will also need a JPEG of the mark and if you are already using it in commerce then you will need to attach a JPEG of it in use. There are specific size requirements for the size of the JPEG so make sure



to follow that requirement. As you move forward with the additional information be careful not to make any input errors. As you get to the end you will sign the application electronically and then proceed to validate the form. At this point it will highlight any errors for you and give you the opportunity to go back and make corrections. Payments are made by credit cards and at the present time the registration fee is \$325 per mark/per class.

Proof of filing

Once done make sure that you print out your application and receipt so that you have some proof of your filing. You will also get an email confirming receipt of your application and issuing you a registration number.

Afterwards, you simply just sit and wait for the U.S. Patent and Trademark Office to contact you which is usually within six months of filing your application. Once you are contacted the process will start via email with an Examining Attorney assigned to your application regarding your ability to obtain protection. If you are fortunate you may get the green light on the first try. If not you might have to heed the comments from the Examining Attorney, make some noted changes and respond accordingly.

Overall the process is not complex but if you don't feel confident in your ability to evaluate existing marks and their affect on your ability to register your mark, then seek professional advice. If you are looking to register multiple marks beware that it can be quite costly if you make mistakes or find out that your marks are not eligible for registration. The best advice is to complete all of your research and review before you begin the process so you can ensure a trouble free registration.