HOW TO FILE A TRADEMARK
(without paying attorney’s fees)
Background Information
What Kind of Intellectual Property Protection Do I Need?

I. Trade Secrets
   - To protect a company’s secret information regarding products or services
   - This information is not obvious to the consumer, (e.g. the Coca-Cola “secret recipe”). Trade secret law is ideal for companies that do not want to disclose information about a product to the public, as disclosure inadvertently happens in the patent process
   - No formal filing for Trade Secrets; Automatic State law protection

II. Patents
   - To protect a product with unique design or utility
   - Patents are public documents that expire after a certain period, typically 7-10 years
   - Patents must be filed with the USPTO; Federal protection

III. Copyrights
   - To protect the content of creative works (e.g. plays, novels, music)
   - Copyrights are less product orientated, and more about intangible intellectual property
   - Copyright protection is automatic, but in order to sue for infringement, the copyright must be registered with the US Copyright Office

IV. Trademarks / Service Marks
   - To protect marketing aspect of products or services, rather than utility or design
   - The main goal is to protect consumers from confusion in the marketplace (e.g. Rolex)
   - For nationwide protection, trademarks are registered with the USPTO. Unregistered marks have limited protection
Does my company need a Trademark or Service Mark?

- **Trademarks** protect words, names, symbols, sounds, or colors that distinguish goods and services from those manufactured or sold by others and to indicate the source of the goods. *Keyword: Goods*
  - If your name and/or logo appear on the tangible goods that you're selling, you'd be filing for a trademark. (E.g. you are starting a computer hardware company. The name stamped on your products would need a Trademark.)

- **Service Marks** protect a word, name, symbol or device that is to indicate the source of the services and to distinguish them from the services of others. *Keyword: Services*
  - If you're selling services in connection with a name and/or logo, you'd be filing for a service mark. (E.g. you are starting a dry-cleaning company. The name on the side of the vans and your storefront would need a service mark.)

**THE BOTTOM LINE**

It is common to use the term "trademark", even when discussing a service use, because the handling of either is interchangeable by both the USPTO and all 50 Secretary of State offices.
The Basics: USPTO Registration

- For nationwide protection, trademarks must be registered with the United States Patent and Trademark Office (USPTO) for a $225, $275, or $400 filing fee, depending on the selected application process. Initial registration lasts 10 years, and the owner has the option of renewal for each 10 year period thereafter.

- Registration can be completed online at [http://www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html)
Q: What do I get for my $225 filing fee? Why file?

A: Key Reasons to Register your Trademark

- **Money, Money, and More Money.** If you have infringed on someone else's name or mark, you may be ordered to rename your company immediately; give up all profits earned by the use of the unregistered mark; and pay other damages, including punitive damages, fines, and attorneys' fees.

- **Lost Customers.** If you have to change your business name because you later find out that someone else is already using it, you could confuse and lose your customers.

- **Exclusive Use.** Registering your mark gives you the exclusive right to use it within the relevant geographic area.

- **Presumption of Ownership.** Anyone else who uses your registered mark will be presumed to be a willful infringer, and you could be entitled to monetary damages as a result of the infringement.

- **Federal Protection.** Federal registration serves as constructive notice to the rest of the country that you are the owner of the mark, even if you do not yet do business nationally.

- **Liability to Registered Owner.** If you do not register and there happens to be a registered owner of the same or a substantially similar mark, that owner will have an indefinite period of time to find you and sue you for infringement.

- **Printing Costs.** If you don't register and you find out later that another company already has the same or a very similar name, you will have to redo all of your business cards, stationery, advertising, and signs.
Steps to File a Trademark
Step 1: Brainstorm Potential Trademarks or Service Marks

- You should identify at least a few desirable potential marks that are (1) probably strong AND (2) probably unique

### Strengths of Trademarks

1. **Arbitrary / Fanciful**: Words that bear no relationship to good or service
   - High protection!
   - Arbitrary: real world word ("Apple" computers)
   - Fanciful: made-up word ("Google" search engine)

2. **Suggestive**: Suggests, rather than describes, some particular characteristic of goods or services (Ford "Mustang" = ‘fast’ car) = Good protection.

3. **Descriptive**: Identifies a characteristic or quality of an article or service (includes names and places; "Mendelson vineyards") = Poor protection.
   - Must acquire secondary meaning! – i.e. buyers must associate the descriptive mark with its source before the mark is protected.

4. **Generic term**: Names identifying products or services, instead of the origin of the products or services ("Downtown Laundromat"). = No protection!!!
Step 2: Chose potential Marks that are Unlikely to Infringe Existing Marks

- Potential marks would infringe prior marks where the use of the potential mark would “likely cause confusion” of the source of the goods and serves with respect to the prior mark. 15 USC § 1114(1)(a).

- Two marks can create a likelihood of confusion between their owners when the goods and services compete for sales OR when the goods or services are related, but are not competitive. → Compare your potential marks to similar marks you know off-hand.

Factors for identifying infringing marks that are related, but not competitive (AMF Inc. v. Sleekcraft Boats):

1. Strength of prior user’s mark;
2. Proximity of the goods;
3. Similarity of the marks;
4. Evidence of actual confusion;
5. Marketing Channels used;
6. Type of good and degree of care likely to be exercised by the purchaser;
7. New user’s intent on selecting the mark;
8. Likelihood of expansion of the product lines.
Step 3: Preliminary Search for Conflicting Marks

- First, you should ask people about the potential marks and you should search the Internet for confusingly similar marks:
  1. Confidentally ask what other people or focus groups think about the potential marks.
  2. Check to see if the potential marks mean something inappropriate in slang or another language.
  3. Search each proposed mark and variants of those proposed marks using internet search engines such as Google, Bing and Yahoo.
  4. Check for website URLs for each proposed mark and variants of those proposed marks. You can identify the name of the company that owns the URL through the WHOIS database (http://www.networksolutions.com/whois/index.jsp)
  5. Preliminary analysis:

    1. Avoid marks that are similar to businesses that use a confusingly similar mark on similar types of goods and services that will be offered by your business. However, you may be able to negotiate with the other business for using that potential mark.
    2. Never use marks that are similar to famous marks (e.g. Coke, Disney, Nike etc.) even if your business will be offering different goods and services from the famous marks.
Step 4: USPTO Search for Conflicting Marks Before Filing

- Second, You should search the USPTO records on marks that survived the preliminary searching before filing your application to determine if any party is already claiming rights in a particular mark. You may conduct a search online at:
  - Or, just search for “Trademark Electronic Search System (TESS)” within the USPTO website

If you find that someone else has the same mark:

1. Check whether the mark is “LIVE” or “DEAD”.
   - If the mark is DEAD, then proceed with filing your mark
2. Check to see whether the mark is being used for the same class of goods or services as your company (more on this later).
   - If it is registered under a different class, then proceed with filing your mark.
3. If someone else owns a LIVE mark for the same good or service,
   then the next step may be to contact the owner of the mark directly to negotiate (contact information is provided on by the USPTO) OR choose a different name for your product or service.
First, select which Trademark Electronic Application System you want to use. The following chart and video describes the differences between each category.

<table>
<thead>
<tr>
<th>Trademark application forms (select one to start) --- &gt;</th>
<th>TEAS Plus form</th>
<th>TEAS Reduced Fee form</th>
<th>TEAS Regular form</th>
</tr>
</thead>
<tbody>
<tr>
<td>Filing fee per class of goods/services</td>
<td>$225</td>
<td>$275</td>
<td>$400</td>
</tr>
<tr>
<td>E-mail address required for USPTO application-related correspondence?</td>
<td>Yes</td>
<td>Yes</td>
<td>No</td>
</tr>
<tr>
<td>Additional submissions, like responses to Office actions, must be filed online?</td>
<td>Yes</td>
<td>Yes</td>
<td>No</td>
</tr>
<tr>
<td>Goods/services listing must be selected from the USPTO Trademark Identification (ID) Manual?</td>
<td>Yes</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Full Filing fee paid upfront (per class for all classes listed on the application)?</td>
<td>Yes</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Certain statements regarding the mark be provided in the application as filed, if applicable (e.g., translation statement, claim of ownership, color claim and description)?</td>
<td>Yes - see TMEP §819.01</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Additional processing fee if applicant does not satisfy the relevant filing option requirements?</td>
<td>Yes - $125 per class of goods/services</td>
<td>Yes - $125 per class of goods/services</td>
<td>No</td>
</tr>
</tbody>
</table>

For more, watch the USPTO’s video explaining the difference between application forms:

Second, enter the “owner of the mark”. This will likely be your legal entity (e.g., your corporation or LLC). Personal correspondence information will be gathered later in the process.
If you would like to simply register the name, then choose “standard characters” (see next slide)

If you would like to register a logo, then choose “special form” (see slide following the next)
To Register Standard Characters

Trademark/Service Mark Application, Principal Register
Version 4.2

Mark Information

Before the USPTO can register your mark, we must know exactly what the mark is. You may present your mark either as: (1) standard characters, or (2) special form (styled and/or design). In this section of the form, you must present the mark by itself. If you are already using the mark in commerce, do not show here how the mark appears on a specimen (sample of actual use, e.g., a label or advertisement. This will be required in a different part of the form, if appropriate.) Also, you may submit only one mark per application. An application that includes multiple marks may be denied a filing date or refused registration.

When you click on one of the two circles presented below, and follow the specific instructions, the system will automatically create a separate page that displays your mark. Please carefully review this page prior to final submission to the USPTO, to ensure that it accurately identifies your mark. You may not be able to change or correct your mark after filing this application. While minor changes in the mark are sometimes permitted, any material alteration will not be permitted and will result in the examining attorney issuing a refusal on that ground.

WARNING: AFTER SEARCHING THE USPTO DATABASE, EVEN IF YOU THINK THE RESULTS ARE "O.K.," DO NOT ASSUME THAT YOUR MARK CAN BE REGISTERED. AFTER YOU FILE AN APPLICATION, THE USPTO WILL PERFORM ITS OWN SEARCH AND OTHER REVIEW, AND MIGHT REFUSE TO REGISTER YOUR MARK.

* Click the appropriate circle to indicate the Mark type: ○ Standard Characters ○ Special Form (Stylized and/or Design)

Enter the mark here: (Note: The entry can be in capital letters, lower case letters, or a combination thereof. Do not include the™, *, ©, or ® symbols after the mark entry, because they are not part of the actual mark. If using Internet Explorer, the entry cannot exceed 2000 characters; otherwise, you must switch to another browser.)

Preview USPTO-Generated Image

NOTE: For information about mark display in USPTO databases, click here.

☐ Check here if you need to enter an additional statement, e.g., a disclaimer, translation, or claim of ownership. The full range of possible statements will then be displayed. If, upon review of all of the statements, you realize that no statement is needed, you must click on this box to "uncheck" it, and the entire Additional Statement section will be removed.

| Go Back | Continue |
To Register a Special Form (Logo)

Here, attach an image of ONLY the logo.

Here, type the literal words in the logo.
The Application: Part IV
Additional Statement

- This part of the application is to demonstrate to the USPTO the “use in commerce” of the trade or service mark.
- “Use” can be shown by pictures of company products with the trademark, signs, advertisements, etc.

See next slide for screen shot of actual application...
Here, attach proof of the service or trade mark. For example: trademark name on official advertisements, signs, etc. DO NOT JUST PROVIDE AN IMAGE OF THE WORDS/LOGO ONLY. IT MUST BE IN CONTEXT!
Is Your Mark Not Yet “In Commerce”? 

- If your product or service is not yet available to consumers, then you can either:
  - 1) Wait until your trade or service mark is used in commerce; or
  - 2) Specify that the application is for “Intent to Use” and not “Use in Commerce” on the USPTO online application.

- If you choose to file “Intent to Use”, then you MUST file an “Amendment to Allege Use” anytime between the initial filing date and 6 months after the mark is approved by the examiner. This can be filed online via USPTO; simply search for “Amendment to Allege Use” on the online forms page.

  *If this additional amendment is not filed in the given time period, then the mark is declared abandoned. No registration will be granted.*
The Application: Part V
Goods and/or Services Information

Determine the class of goods and/or services for which the mark will be used, and indicate here.
If there are multiple classes, an additional fee will be incurred.

<table>
<thead>
<tr>
<th>Navigation History</th>
<th>Instructions</th>
<th>Add Goods/Services</th>
<th>Remove Checked Class(es)</th>
</tr>
</thead>
</table>

Trademark/Service Mark Application, Principal Register
Version 4.2

**Goods and/or Services Information**

**Instructions:**

**Step 1:** Click on the appropriate button, below, to indicate whether you wish to create your listing of goods/services by (1) taking entries directly from the Manual of Trademark Acceptable Identifications of Goods & Services (IDManual); or (2) entering your own free-text entry. **NOTE:** Option 1 is recommended, to ensure automatic acceptance of the listing in examination; however, if the entry requires customization through the insertion of free-form text, even Option 1 obviously will not ensure that the listing is automatically accepted.

**Step 2:** Click on the "Add Goods/Services" button.

**Step 3:** After creating the complete list of goods and/or services for this application, you will then be able in the next section of the form to designate the filing basis (or bases) appropriate for each listed item.

**NOTE:**

1. If a desired term does not appear in the IDManual, you can request that identification be added, by e-mailing TMIDSUGGEST@uspto.gov; however, since the item would not be added immediately, you would need to use Option 2 (free-text entry). For more information on the process for adding identifications, click [here](#).

2. If you cannot access the IDManual through the "Add Goods/Services" button, try switching to another browser. If after changing browsers you still cannot access the IDManual through the "Add Goods/Services" button, please contact TEAS@uspto.gov.

* Choose ONE method for adding the Goods and/or Services:
  - Searching IDManual
  - Entering Free-form text
What are International Classifications?

- All goods or services are categorized within 45 International Classes
  - Goods are in classes IC 1-34
  - Services are in IC 35-45
- Registration in multiple classes will cost an additional fee
- You will need to identify the class of your service or goods to file your mark - see next slide for complete list.

Examples:

Class 12: Vehicles; apparatus for locomotion by land, air, or water.

Class 43: Services for providing food and drink
# International Trademark Class Numbers and Short Titles

## GOODS

<table>
<thead>
<tr>
<th>Class</th>
<th>Title</th>
</tr>
</thead>
<tbody>
<tr>
<td>001</td>
<td>Chemicals</td>
</tr>
<tr>
<td>002</td>
<td>Paints</td>
</tr>
<tr>
<td>003</td>
<td>Cosmetics and Cleaning Preparations</td>
</tr>
<tr>
<td>004</td>
<td>Lubricants and Fuels</td>
</tr>
<tr>
<td>005</td>
<td>Pharmaceuticals</td>
</tr>
<tr>
<td>006</td>
<td>Metal Goods</td>
</tr>
<tr>
<td>007</td>
<td>Machinery</td>
</tr>
<tr>
<td>008</td>
<td>Hand Tools</td>
</tr>
<tr>
<td>009</td>
<td>Electrical and Scientific Apparatus</td>
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<tr>
<td>010</td>
<td>Medical Apparatus</td>
</tr>
<tr>
<td>011</td>
<td>Environmental Control Apparatus</td>
</tr>
<tr>
<td>012</td>
<td>Vehicles</td>
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<tr>
<td>013</td>
<td>Firearms</td>
</tr>
<tr>
<td>014</td>
<td>Jewelry</td>
</tr>
<tr>
<td>015</td>
<td>Musical Instruments</td>
</tr>
<tr>
<td>016</td>
<td>Paper Goods and Printed Matter</td>
</tr>
<tr>
<td>017</td>
<td>Rubber Goods</td>
</tr>
<tr>
<td>018</td>
<td>Leather Goods</td>
</tr>
<tr>
<td>019</td>
<td>Non-metallic Building Materials</td>
</tr>
<tr>
<td>020</td>
<td>Furniture and Articles Not Otherwise Classified</td>
</tr>
<tr>
<td>021</td>
<td>Housewares and Glass</td>
</tr>
<tr>
<td>022</td>
<td>Cordage and Fibers</td>
</tr>
<tr>
<td>023</td>
<td>Yarns and Threads</td>
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<tr>
<td>024</td>
<td>Fabrics</td>
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<tr>
<td>025</td>
<td>Clothing</td>
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<td>026</td>
<td>Fancy Goods</td>
</tr>
<tr>
<td>027</td>
<td>Floor Coverings</td>
</tr>
<tr>
<td>028</td>
<td>Toys and Sporting Goods</td>
</tr>
<tr>
<td>029</td>
<td>Meats and Processed Foods</td>
</tr>
<tr>
<td>030</td>
<td>Staple Foods</td>
</tr>
<tr>
<td>031</td>
<td>Natural Agricultural Products</td>
</tr>
<tr>
<td>032</td>
<td>Light Beverages</td>
</tr>
<tr>
<td>033</td>
<td>Wines and Spirits</td>
</tr>
<tr>
<td>034</td>
<td>Smokers’ Articles</td>
</tr>
</tbody>
</table>

## SERVICES

<table>
<thead>
<tr>
<th>Class</th>
<th>Title</th>
</tr>
</thead>
<tbody>
<tr>
<td>035</td>
<td>Advertising and Business</td>
</tr>
<tr>
<td>036</td>
<td>Insurance and Financial</td>
</tr>
<tr>
<td>037</td>
<td>Construction and Repair</td>
</tr>
<tr>
<td>038</td>
<td>Communication</td>
</tr>
<tr>
<td>039</td>
<td>Transportation and Storage</td>
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<tr>
<td>040</td>
<td>Material Treatment</td>
</tr>
<tr>
<td>041</td>
<td>Education and Entertainment</td>
</tr>
<tr>
<td>042</td>
<td>Miscellaneous Services</td>
</tr>
</tbody>
</table>

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**Still Unsure?**
Check USPTO.gov for complete and thorough descriptions of each class.
The Application: Part VI
Correspondence Information

- Here, type the address of the individual who will serve as liaison between the corporation and the USPTO.
- If your mark is approved or additional information is needed, this individual will be contacted.
As previously mentioned, filing a trademark application with the USPTO costs $225, plus any additional charges for filing in multiple classes.

Entering payment information is the last step! Congratulations!
Contact Information

- The USPTO will contact you in the next 3-6 months regarding the status of your application.
- If you have any additional questions, please feel free to contact the Practicum:
  - VIA EMAIL:
    - wkell@law.berkeley.edu
  - VIA PHONE:
    - 510-642-4050 – Bill Kell’s Office