

The Basics

Federal trade mark registrations, which cover all of the United States, are granted by the United States Patent & Trademark Office (USPTO). This sheet briefly explains that system. It is also possible to apply to register a mark in the USA through the Madrid Protocol (International Registration) system if certain conditions apply. Please see our sheet on the Madrid Protocol for details of that system.

Searching

Before using a mark in the USA, as in most countries, it is advisable to conduct appropriate searches for similar marks which are registered, pending or in use. We can help with this process.

Who can apply for registration?

Any natural or legal person can apply for registration.

How do I apply?

Applications are filed at the USPTO and must be filed in English. In order to apply for registration the applicant must have either:

1. actual use - i.e. the mark is already in use in the USA;
2. an intention to use - i.e. there is a bona fide intent to use the mark in the USA; or
3. a home registration or home application - i.e. an application or registration for the same mark in their "country of origin". (If filed on this basis, the applicant must also have an "intention to use" the mark.)

N.B.

- i) Applicants can claim more than one basis for the application but obviously cannot claim both 1 and 2 for the same goods/services.
- ii) "Country of origin" is defined as either a) the country in which the applicant has a bona fide and effective industrial or commercial establishment, b) the applicant's country of domicile or c) where the applicant is a national.
- iii) If based on a home application, the US application must be filed within six months of that home application.

What can be applied for?

Any sign capable of potentially distinguishing goods or services is registrable. This includes the shape of goods, their packaging and colour marks.

One application can claim a number of classes of goods or services, but there is an additional fee for each class claimed. The International (Nice) classification system is used, however the USPTO insists upon the use of very specific terms e.g. "clothing" would not be acceptable: specific items of clothing would have to be listed.

Examination and search

The USPTO examines applications on both absolute and relative grounds.

Absolute Grounds

Examples of marks that would not be acceptable;

- Descriptive marks (unless they have become distinctive through use).
- Shapes which result from the nature of the goods.
- Marks liable to mislead the public as to their nature, quality or geographical origin.
- Marks which are words or logos used in the trade indicate particular goods/services.
- Common surnames.
- Immoral or scandalous marks.

Relative Grounds

- The Office will raise an objection if the mark applied for resembles the mark of another so as to be likely to cause confusion, mistake or deception. It will only search registered marks and pending applications.

Opposition

If the application passes the examination stage it is published in the Official Gazette, at which point it is open to opposition from a third party for 30 days.

Opposition can be filed by any party who feels that they would be damaged by the registration of the mark. For example, opposition may be filed on relative grounds by the owner of prior rights to a similar mark (whether such rights were acquired simply through registration or through use). Alternatively opposition may be filed on absolute grounds, for example if the registration could prevent lawful use of a descriptive term.

Notice of allowance

If no opposition is filed, (or opposition is overcome), the USPTO sends a "Notice of Allowance".

An applicant that filed on the basis of "actual use" will by this time have produced proof of that use and the mark will become registered.

An applicant that filed on the basis of "intent to use" will then have a period of six months, (potentially extensible for up to 30 months), to provide proof of use of the goods and services claimed. Once that proof is provided, the mark becomes registered.

An applicant that filed on the basis of a "home application or registration" need not provide proof of use provided that they provide proof of the registration of the mark in their "home" country. The mark will then become registered.

Renewal

Registered marks fall due for renewal every ten years; at the time of renewal use needs to be proved, or an acceptable reason for non-use given.

Use

Between the fifth and sixth year after the registration issues the proprietor must file a Declaration stating that the mark is in use, or else provide an acceptable reason for non-use.

Non-use of a registered mark for more than three years renders the registration potentially vulnerable to cancellation by a third party.

Once a registered mark has been in continuous use for at least five consecutive years, a proprietor can file a Declaration of Incontestability. This is advisable as (with some exceptions), it can potentially provide:

- i) conclusive evidence of the ownership and exclusive right to this mark.
- ii) immunity from attack on the basis of prior use or descriptiveness.

Note that although the USPTO only makes a formalities check of such claims, it is ultimately the courts that will decide whether or not the mark is incontestable.

Assignment

US trade mark rights can only be assigned with the associated goodwill in the mark.

An assignment is void against a subsequent good faith purchaser of a mark unless the earlier assignee records the assignment at the USPTO.

Common law

As in the UK, trade mark rights can be enforced under common law traditions in the US. Such rights are acquired by the mere use of a mark but are often difficult and costly to enforce and are limited to the geographical area where the mark is used.

We strongly recommend that you seek to register your marks.

State trade marks

Each state in the US has its own trade mark legislation and grants registrations covering just its own state. In general these are mainly of relevance to US trade mark owners having a local interest. However they need to be taken into account when deciding if a mark can be used in a given state.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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