

Saving Costs in the U.S. Trademark Registration Process

Description

Because of the complexities of the U.S. trademark registration system, many trademark owners from other countries, and their counsel, are reluctant to file national or international applications in the United States. One of the reasons often given is the higher cost of obtaining trademark protection in the United States due to the statutory requirements and the formalities that must be observed. It is frequently overlooked, however, that a U.S. trademark registration covers a largely monolingual (English), highly sophisticated market of over 310 million people.

There are opportunities for international applicants and their counsel to save money and time in the United States registration process. Broad descriptions of goods and services can be more narrowly tailored to the usual names of products and services to avoid objections by the United States Patent and Trademark Office (USPTO) and third parties. In addition, documentary evidence of the applicant's intent and capability to use the mark in the United States can be obtained and preserved early in the application process to avoid possible loss of registration rights later. Each of these opportunities is discussed further below.

Draft the Identification of Goods and Services Narrowly

Very often the identification of goods and services used in the applicant's country of origin is drafted very broadly, in effect, to claim the class rather than the goods in order to obtain as broad a scope of protection as possible. Listings of goods and services in multiple classes, extending for several pages, are not uncommon. When an application to register the mark is then filed in the United States, either based on the registration in the country of origin under the Paris Convention, or by extension of the International Registration under the Madrid Protocol, very often the applicant is greeted with a lengthy Office Action from the USPTO, requiring a number of amendments to the identification of goods and services. At this point, in order to avoid abandonment of the application, the applicant will be required either to file the response itself, or to engage the services of a U.S. attorney to prepare and file the response.

If at all possible, the identification of goods and services should be amended before filing the US application. The USPTO has a narrower standard than that used in many countries, and requires the listing of goods and services to use definite terms, and not overly broad language. These terms can be found in the USPTO's "Acceptable Identification of Goods and Services Manual," which is available online [here](#). The identifications in the ID Manual generally are accepted in the examination process without objection. Thus, the applicant, either with the assistance of its own attorney or with a US trademark attorney, can select the most appropriate terms for the applicant's goods and services at the outset and avoid the expense of having to respond later to a lengthy Office Action regarding the identification of goods and services.

Even if the application has already been filed, the applicant is permitted to amend the application voluntarily prior to the time the application is examined. There is generally a 2-4 month period between the time the application is filed and when it is examined. Filing a voluntary amendment to narrow the identification of goods and services during this time can also avoid the expense of having to respond later to a lengthy Office Action.

Preserve Evidence of the Applicant's Intent and Ability to Use the Mark

When filing an application to register a mark that has not been used yet in the United States, the applicant may file its application based on a "bona fide intent to use" the mark in the United States, based on its application or registration in its country of origin, or based on an extension of an international registration under the Madrid Protocol. In each instance, the applicant must sign a declaration that it has a "bona fide intent to use" the mark in the United States in commerce. Applicants unfamiliar with the United States registration process also run into

difficulties when their “bona fide intent to use” the mark is challenged in an opposition or cancellation proceeding.

These documents can include business plans, marketing materials, documents regarding product development, or any other materials corroborating the applicant’s intent to use the mark in the United States. Collecting these documents during the application process ensures that the documents will be available later if needed. If few or no documents exist, the applicant and its attorney also have an opportunity to prepare documents contemporaneously that evidence the applicant’s “bona fide intent to use” the mark. Gathering and preserving these documents also could be the difference between ending an opposition or cancellation proceeding early with minimal cost, or engaging in a long, protracted and expensive proceeding.

Although the trademark registration process in the United States can sometimes be complex, it need not be expensive. Two ways to reduce costs are: (i) to draft the identification of goods and services more narrowly than is typically the practice in other countries, making sure it states the goods or services in common commercial terms, and (ii) to gather and retain contemporaneous documentation supporting the applicant’s claim that it has an “intent to use” the mark in the United States. There also are other ways that experienced U.S. trademark attorneys can assist clients in reducing the costs of the application and registration process.

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