

FREQUENTLY ASKED QUESTIONS

1. What should be provided to HSML in order to file an application?

- Applicant's name, address, type of entity, and state (or country) of incorporation
- The exact mark to be filed
- All of goods and/or services
- A specimen for each class [§ 1(a) only]
- Dates of "first use anywhere" and "first use in commerce" for each class [§ 1(a) only]
- Priority document information [§ 44 and § 66]

2. Must a trademark application be filed before using a mark?

No, an Intent to Use (ITU) Application can be filed based only on the "intent to use" the mark in the U.S. Certain requirements must be met before the application can mature to registration, including filing evidence of use.

3. Use-based application v. Intent to Use

In a use-based application, all the goods or services listed must currently be used in U.S. commerce.

In an intent-to-use application, the applicant must have a bona fide intent to use the mark in the U.S. for all the goods or services listed in the application.

4. What goods or services should be included in the application?

For ITU applications, the goods or services which Applicant has a bona fide intent to use the mark in U. S. interstate commerce.

For Use-based applications, the goods or services which are currently offered under Applicant's mark.

5. How does an Applicant find an appropriate identification of goods/services?

The USPTO website posts the Acceptable Identification of Goods and Services Manual at <http://tess2.uspto.gov/netathtml/tidm.html>.

6. Does a search need to be conducted prior to filing the application?

Although typically recommended, a search is not legally required in order to file a trademark application.

7. What does "use in commerce" mean?

The bona fide use of a mark in the U.S. in the ordinary course of trade – not token use.

8. What is the difference between "first use anywhere" and "first use in commerce"?

"First use anywhere" is the date when the goods were first sold or transported or the services first rendered under the mark anywhere in the world.

"First use in commerce" is the date when the goods were first sold or transported, or the services first rendered, under the mark in a type of commerce that may be lawfully regulated by U.S. Congress.

9. What are the bases for filing an application in the U.S.? Can there be multiple bases?

The bases are:

- Use in U.S. Commerce [§ 1(a)]
- Intent-to-Use [§ 1(b)]
- Priority under Paris Convention [§ 44(d)]
- Home Country Registration [§ 44(e)]
- Madrid Protocol [§ 66(a)]

Sections 1(a), 1(b), and 44 can be combined. Section 66(a) can only be claimed by itself.

10. How does the appeal of a Trademark Office refusal work?

Applicant has the ability to appeal an Examining Attorney's refusal beyond the Trademark Trial and Appeal Board if it chooses. The appeal is taken to the United States Court of Appeals for the Federal Circuit.

Alternatively, the Applicant may seek remedy through a civil action in district court.

11. What happens in an opposition?

An Opposition is like a mini-trial but conducted within the administrative parameters of the trademark office and for significantly less cost. Each party has the option to present evidence and arguments. A decision is made by the Trademark Trial and Appeal Board.

Most often, oppositions settle well before the Board reviews the arguments or evidence.