

OVERVIEW

- Trademark law governs the use of trademarks by individuals and legal entities to identify their goods or services and to distinguish those goods or services from those sold or provided by others.

What is a service mark?

- A [service mark](#) is a type of trademark which uses words, phrases, symbols or designs to identify and distinguish the source of a service from those of other services.
- For example, the service mark “Legal Aid Society of Sam and Jane County” would distinguish services provided by the legal aid society from others providing similar legal services.

What is trademark infringement?

- A trademark is infringed when some entity other than the owner of the mark another uses the same or similar mark in a way that is likely to cause confusion as to the source or sponsorship of the goods or services involved.
- For example, if another legal services provider used the mark of Legal Aid Society of Sam and Jane County to offer legal services at a cost, the use might be (probably is) an infringement.

TRADEMARK REGISTRATION

What is trademark registration?

- Registration is the process of formally recording your trademark with the United States Patent and Trademark Office (“PTO”).

Is registration of a trademark required?

- No. [Common law trademark rights](#) are established when a mark is used in commerce to identify one’s goods or services. However, common law trademark protection is much more limited than the statutory protections afforded to registered trademarks.

Why should I register a trademark?

- Registering a trademark on the Principal Register of the PTO provides the greatest protection for your trademark.
 - Registration on the **Principal Register** is available for trademarks that are **distinctive**.
- Registration on the Principal Register provides several important benefits including:
 - The public, including other legal service providers, is deemed to have been notified of your ownership of the mark;

- If another entity challenges your use of the trademark, you will be presumed to be the owner of the mark with sole rights to its use, and the challenger will have the burden of proving that you do not have the right to use the mark; and
- If any other legal service organization is using (infringing) your trademark, you may bring a legal action in federal court to stop the infringement.
- If a trademark is not eligible for registration on the Principal Register, for example, if it is **not distinctive** (e.g., it is descriptive), it may be registered on the **Supplemental Register**, which provides some but not all of the protections of marks registered on the Principal Register. Once a mark becomes distinctive, it can be re-registered on the Principal Register.

When can I use the trademark symbols “SM” or ®?

- Any time you claim rights to a mark, you may use the “SM” (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the PTO.
 - Before the trademark is registered by the PTO: Legal Aid Society of Sam and Jane County SM.
- You may use the federal registration symbol “®” only after the PTO registers your mark.
 - After the trademark has been registered by the PTO: Legal Aid Society of Sam and Jane County ®.

THE APPLICATION PROCESS

What does the trademark registration process involve?

- To register a trademark, you must file an application for trademark registration with the PTO. The application may be filed electronically using the PTO Trademark Electronic Application System ([TEAS](http://www.uspto.gov/teas/index.html)), available at <http://www.uspto.gov/teas/index.html>, or by paper application through the PTO.
 - **Please Note:** Paper applications are not processed as quickly as those submitted electronically and have a different fee schedule than electronic applications.

Do I have to have an attorney file the application?

- You do not have to use an attorney to file a trademark application. Through an arrangement with SNAP, a group of law firms informally called the Pro Bono Consortium have agreed to provide advice and assistance to you in completing and filing a trademark application and responding to requests for additional information from the PTO. **The services of the attorneys involved in the Pro Bono Consortium will be provided at no cost to you, however the application filing fees and post-registration maintenance fees and obligations described below will be your responsibility.**

THE APPLICATION – WHAT YOU MUST INCLUDE

Name and type of entity of the Legal Aid Society

- The application must be filed in the name of the Legal Aid Society, which is the owner of the mark.

Address for Correspondence

- You must provide an address where the PTO can send communications concerning the application. If you use the services of our Pro Bono Consortium, communications relating to the application will be sent to your attorney during the application process.

Depiction of the Mark ([The Drawing](#))

- The “Mark” will consist of each Legal Aid Society’s name or logo.
- A drawing may be filed as either
 - A [standard character drawing](#) in which
 - All letters and words in the mark are depicted in Latin characters;
 - All numerals in the mark are depicted in Roman or Arabic numerals;
 - The mark includes only common punctuation marks; and
 - The mark does not include a design element.
 - Note: A standard character drawing must include a statement that the mark presented in standard character format without claim to any particular font style, size or color.
 - A stylized or special form drawing which
 - Includes a design element or logo.
- **Note**: Once the drawing is filed, **A MATERIAL CHANGE TO THE MARK IS NOT ALLOWED.**

Classification of Services

- The Pro Bono Consortium has determined that the appropriate classification for the services you provide is “**International Class 45: Legal Services**,” which includes all legal services rendered by others to meet the needs of individuals, including attorney services.

Basis for Filing

- Applications are based on the current use of the trademark in commerce, or the intent to use the trademark in commerce in the future.
- A “use in commerce” based application must include a sworn statement (declaration) that the trademark is in use in commerce, listing the date of the first use of the mark

anywhere and the date of first use of the mark in commerce, and signed by the Executive Director (or other authorized person) on behalf of the Legal Aid Society.

Specimen

- A specimen is an actual example of how the name of the Legal Aid Society is used in connection with the provision of free, civil legal services to low-income persons.
 - For example, you can submit promotional brochures, newspaper clippings, website screen shots, or fundraising materials displaying the name or logo of the Legal Aid Society and describing the legal services.

Application Filing Fee

- In 2007, Application Filing Fees are \$325 for TEAS Applications and \$375 for Paper Applications.
 - Note: If the application meets the minimum filing requirements and is given a filing date, the application filing fee cannot be refunded.

Signature

- Only persons properly authorized to sign on behalf of the Legal Aid Society may sign the application.
 - For example, the Executive Director of the Legal Aid Society.

REVIEW AND EXAMINATION BY THE PTO

Review of the Application

- Once the PTO determines that the minimum filing requirements are met, your application is forwarded to an Examining Attorney who will determine if the application complies with all applicable rules and statutes and includes all required fees.
 - Note: This may take several months.

Results of the Examination

Deficient or Refused Applications

- If the Examining Attorney determines that the application is deficient or the mark should not be registered, the Examining Attorney will issue an Office Action to you or, if you use the Pro Bono Consortium, to your attorney explaining the substantive reasons for refusal, and any technical or procedural deficiencies in the application.
 - If an Office Action is issued, your response is required within six months of the mailing date, or the application will be declared [abandoned](#).
 - If your response to the Office Action does not overcome all objections, the Examining Attorney will issue a final refusal.
 - You may appeal a final refusal, for an additional fee, to the Trademark Trial and Appeal Board.

- If you use the Pro Bono Consortium, your attorney will prepare the response to the Office Action for you. The attorney may need additional materials from you. You should respond to any requests for additional materials promptly to avoid abandonment of your application.

Approved Applications

- If the Examining Attorney raises no objections to registration, or the all objections raised in the Office Action are overcome, the mark will be approved for publication in the [*Official Gazette*](#).
- After publication, any party who believes that it may be damaged by registration of the mark has 30 days from the date of publication to file an opposition to registration or to request an extension of time to oppose.
- If the mark is published based on use in commerce, and no opposition is filed, the mark will register and a registration certificate will be issued by the PTO about **3-4 months** after the publication date.

MAINTAINING A FEDERAL TRADEMARK

- Between the 5th and 6th years following registration you must file a Declaration of Use with the PTO
 - Cost: \$100 (for each class of services)
- Any time after the 5th year following registration, you may file a Declaration of Incontestability; typically, this optional document is filed with the Declaration of Use.
 - Cost: \$200 (for each class of services)
- Federal trademarks are issued for **10 years** and may be renewed for additional 10-year periods.
 - Renewal Application
 - Between the 9th and 10th years following registration (or renewal).
 - Cost: \$500 (for each class of services)
- If you use the Pro Bono Consortium, your attorney will prepare a package for you when your mark is registered that will include your PTO registration certificate, as well as a schedule of when the Declaration of Use, Declaration of Incontestability and Renewal Application should be filed.
- **Please bear in mind, however, that these post-registration maintenance obligations are the obligations of the Legal Aid Society. The Pro Bono Consortium will not provide any services or assistance in connection with post-registration maintenance obligations and will not be responsible for reminding you of the filing dates.**

More information is available from the Post Registration Division, (571) 272-9500.