

Trademark Basis

- Every trademark application must have a legal basis for filing. The filing bases under federal trademark law are: Section 1(a) Use; Section 1(b) Intent-to-Use; Section 44(d) Foreign application; Section 44(e) Foreign registration; and Section 66(a) Madrid Protocol.
- If your trademark registers, additional legal requirements, fees, and deadlines must be met to maintain your registration and keep your trademark registered.

Section 1(a) Timeline: Application based on use in commerce

1. Application filed: The filed application is assigned a serial number. This number should always be referenced when communicating with the USPTO. The applicant can check the status of any application throughout the entire process by entering the application serial number at <http://tsdr.uspto.gov/> or by calling the trademark status line at 571-272-5400. It takes approximately three months go to step 2.
2. USPTO reviews application: If the minimum filing requirements are met, the application is assigned to an examining attorney. The examining attorney conducts a review of the application to determine whether federal law permits registration. Filing fee(s) will not be refunded, even if the application is later refused registration on legal grounds. It takes approximately one month go to step 3a or step 3b.
3. USPTO publishes mark: If no refusals or additional requirements are identified, the examining attorney approves the mark for publication in the Official Gazette (OG). The OG, a weekly online publication, gives notice to the public that the USPTO plans to issue a registration. Approximately one month after approval, the mark will publish in the OG for a 30-day opposition period. Any party who believes it would be harmed by the registration may file an objection (opposition) within that 30-day period with the Trademark Trial and Appeal Board. No further action is taken until the opposition is resolved. It takes approximately three months go to step 8.

USPTO issues letter (Office action): If refusals or requirements must still be satisfied, the examining attorney assigned to the application issues a letter (Office action) stating the refusals/requirements. Within 6 months of the issuance date of the Office action, the applicant must submit a response that addresses each refusal and requirement. Within six months, the application moves to step 4a or step 4b.

4. Applicant timely responds: In order to avoid abandonment of the application, the applicant must submit a timely response addressing each refusal and/or requirement

stated in the Office action. The examining attorney will review the submitted response to determine if all refusals and/or requirements have been satisfied. It takes approximately one to two months go to step 5a or step 5b.

Applicant does not respond and application abandons: If the applicant does not respond within six months from the date the Office action was issued, the application is abandoned. The term “abandoned” means that the application process has ended and the trademark will not register. Filing fees are NOT refunded when applications abandon. Abandoned applications are “dead,” since they are no longer pending or under consideration for approval. To continue the application process, the applicant must file a petition to revive the application within two months of the abandonment date. If more than two months after the abandonment date, the petition will be denied as untimely and the applicant must file a new application with the appropriate fee(s).

5. USPTO publishes mark: If the applicant's response overcomes the refusals and/or satisfies all requirements, the examining attorney approves the mark for publication in the Official Gazette (OG). The OG, a weekly online publication, gives notice to the public that the USPTO plans to issue a registration. Approximately one month after approval, the mark will publish in the OG for a 30-day opposition period. Any party who believes it would be harmed by the registration may file an objection (opposition) within that 30-day period with the Trademark Trial and Appeal Board. No further action is taken until the opposition is resolved. It takes approximately three months go to step 8.

USPTO issues final letter (Office action): If the applicant's response fails to overcome the refusals and/or satisfy the outstanding requirements, the examining attorney will issue a “Final” refusal letter (Office action). The Office action makes “final” any remaining refusals or requirements. An applicant may respond to a final office action by a) overcoming the refusals and complying with the requirements or b) appealing to the Trademark Trial and Appeal Board. Within six months, the application moves to step 6a or step 6b.

6. Applicant timely responds and/or files appeal: To avoid abandonment of the application, the applicant must submit a timely response addressing each refusal and/or requirement stated in the “Final” refusal letter (Office action). Alternatively, or in addition to the response, the applicant may also submit a Notice of Appeal to the Trademark Trial and Appeal Board (TTAB). The examining attorney will review the submitted response to determine if all refusals and/or requirements have been satisfied. If the applicant's response fails to overcome the refusals and/or satisfy the outstanding requirements, the application will be abandoned unless the applicant has filed a Notice of Appeal, in which case the application is forwarded to the TTAB. The term “abandoned” means that the

application process has ended and the trademark will not register. Filing fees are not refunded when applications abandon. Abandoned applications are “dead,” since they are no longer pending or under consideration for approval. It takes approximately one to two months go to step 7a or step 7b.

Applicant does not respond and application abandons: If the applicant does not respond within six months from the date the Office action was issued and the applicant has not filed a Notice of Appeal to the Trademark Trial and Appeal Board, the application is abandoned. The term “abandoned” means that the application process has ended and trademark will not register. Filing fees are not refunded when applications abandon. Abandoned applications are “dead,” since they are no longer pending or under consideration for approval. To continue the application process, the applicant must file a petition to revive the application within two months of the abandonment date, with the appropriate fee. If more than two months after the abandonment date, the petition will be denied as untimely and the applicant must file a new application with the appropriate fee(s).

7. USPTO publishes mark: If the applicant's response overcomes the refusals and/or satisfies all requirements of the “Final” refusal letter (Office action), the examining attorney approves the mark for publication in the Official Gazette (OG). The OG, a weekly online publication, gives notice to public that USPTO plans to issue a registration. Approximately one month after approval, the mark will publish in the OG for a 30-day opposition period. Any party who believes it would be harmed by the registration may file an objection (opposition) within that 30-day period with the Trademark Trial and Appeal Board. No further action is taken until the opposition is resolved. It takes approximately three months go to step 8.

Applicant's appeal sent to TTAB: If the applicant's response does not overcome the refusals and/or satisfy all of the requirements and the applicant has filed a Notice of Appeal with the Trademark Trial and Appeal Board (TTAB), the appeal will be forwarded to the TTAB. Information about the TTAB can be found at www.uspto.gov.

8. Mark registers: Within approximately three months after the mark published in the Official Gazette, if no opposition was filed, then the USPTO issues a registration. If an opposition was filed but it was unsuccessful, the registration issues when the Trademark Trial and Appeal Board dismisses the opposition. After a registration issues, to keep the registration “alive” the registrant must file specific maintenance documents. Between five to six years, go to step 9; every 10 years, go to step 10.

9. Registration owner files Section 8 declaration: Before the end of the six-year period after the registration date, or within the six-month grace period after the expiration of the sixth year, the registration owner must file a Declaration of Use or Excusable Nonuse under Section 8. Failure to file this declaration will result in the cancellation of the registration.

10. Registration owner files Section 8 declaration/Section 9 renewal: Within one year before the end of every 10-year period after the registration date, or within the six-month grace period thereafter, the registration owner must file a Combined Declaration of Use or Excusable Nonuse/Application for Renewal under Sections 8 & 9. Failure to make these required filings will result in cancellation and/or expiration of the registration.