CLEMENZA LAW GROUP

NEW YORK, NY · (212) 365-4875

THE PRIVATE BRIEF · HANDBOOK

The Trademark Owner's Handbook

A name is the first thing most businesses create and the last thing most of them protect. The logo is designed, the domain is bought, the packaging is printed, and somewhere around the launch someone asks whether anyone has checked that the name is free. Often nobody has. Sometimes it is not.

Trademark law is the body of rules that decides who gets to use a name in the marketplace, and it is more forgiving than people fear and stricter than people assume. It rewards the owner who chooses well, checks first, files properly, uses the mark carefully and keeps two dates in a calendar. It punishes guesswork, and it punishes it late, when the name is already load-bearing.

This handbook walks the whole life of a mark in everyday language: what a trademark actually is, how to choose a name you can own, what a clearance search checks, how the application works and what happens when the trademark office writes back, how to use and keep a registration, what to do when someone copies you, how the rules change at the border, and the honest answer to whether you need a lawyer. Read it once now, before the name is on the sign.

clemenzalaw.com/reference/trademark-owner

Chapters

CHAPTER 1

Before you begin: what a trademark actually is

A trademark is anything that tells a buyer where a product or service comes from: a word, a name, a logo, a slogan, occasionally a color, a shape or a sound. Its job is to answer one question in the buyer's mind, "who is this from?", and the law protects it so that buyers are not misled and so that the goodwill you build in a name belongs to you rather than to whoever copies it first.

Three things follow from that job, and each corrects a common misunderstanding. First, trademark rights in the United States come from use, not from a certificate. The moment you sell goods or services under a name, you begin to acquire rights in it in the places you sell. Registration adds a great deal (a nationwide filing date, a public record, the ® symbol, a stronger position in every dispute), but it does not create the right from nothing, and an unregistered business that has used a name for years has rights a register search will never show. Second, a trademark is always tied to particular goods or services. The same word can belong to two different owners in two different markets without conflict, which is why a soap and an ice cream can share a name. Third, a trademark lasts as long as you use it and maintain it. It has no fixed term. It can outlive its founder, or die in six years of neglect.

Two neighbours are often confused with it. Copyright protects original creative work of some substance: the illustration in your logo, the photographs on your website, the music, the code. It does not protect names, titles, short phrases or slogans, because there is not enough in a name to copy. A copyright registration for your logo drawing is a real asset and does nothing to stop a competitor adopting your name. And the certificate you received when you formed your company, or filed a trade name with the county, reserves that name inside one state's business registry. It gives you no nationwide trademark rights and does not stop a business in another state building the same brand. Founders arrive holding that certificate, entirely reasonably, believing the name is theirs. It is not, yet.

The symbols: ™ may be used by anyone on a mark they claim, registered or not. ® may be used only once the mark is federally registered, and only for the goods and services in the registration. Using ® before registration is a false claim the trademark office and courts take seriously.

THE CHECKLIST

- [ ] **Understand that use, not filing, is where rights begin**

  This is why a search cannot stop at the register, why an unregistered business can block you, and why your own first sale under the name is worth dating and recording.

- [ ] Sort your brand assets into trademark, copyright, and neither

The name, the logo as a whole, the slogan, the product names: trademark. The illustration, the photographs, the copy, the music, the code: copyright. The state certificate and the domain registration: neither, though both are worth having. Where one asset does two jobs (a logo with a drawn element), expect to file twice.

> The quiet reverse error: a company registers the trademark, launches, and never secures the copyright in the campaign photography it commissioned, then discovers the photographer owns it because nobody wrote down otherwise.

- [ ] Use ™ freely and ® only after registration

™ signals a claim. ® is a statement of fact about the federal register, and it must be true for the goods it appears on.

- [ ] Start a brand folder today

Dated evidence of the first use of the name and of continuing use: photographs of products, screenshots of the site, invoices, advertising. Every stage of a mark's life asks for this, and it is much easier to keep than to reconstruct.

CHAPTER 2

Choosing a name you can own

Not every name can be a trademark, and among those that can, some are far easier to own than others. The law sorts names along a spectrum, and where your name falls decides most of what follows.

At the strong end are coined words that mean nothing (invented names) and arbitrary words that mean something unrelated to the goods (a fruit for a computer company). They are strong precisely because they describe nothing; nobody else needs them to sell the same thing. Next come suggestive names, which hint at a quality without stating it and require a small leap of imagination. These are registrable and common, and most good brand names live here. Then come descriptive names, which simply say what the product is or does or where it comes from, or are mainly a surname. These are refused registration unless you can show that years of use have taught the public to see the words as your brand rather than as a description, which is expensive to prove and often impossible for a young company. At the far end are generic words, the name of the thing itself, which nobody can own.

Here is the trap, and it catches sophisticated people. The name that sounds best in the meeting is very often descriptive, because it does marketing work: it tells the customer what they are getting. That is exactly the reason the trademark office will refuse it. A name that needs no explanation is a name that is hard to own. A name that needs a sentence of explanation is usually a stronger mark.

A few other rules of the road. A name that is primarily a surname, or that describes a geographic origin, or that is confusingly similar to an existing mark for related goods, will be refused. A mark that includes the name or likeness of a living person requires that person's written consent, which is a formality when the person is you and a real question when it is not. And a name that is free on the federal register but in use by an unregistered business in your field is not free; it is a dispute you have not had yet.

THE CHECKLIST

- [ ] **Place every candidate name on the spectrum before you fall in love with it**

  Coined or arbitrary: strong. Suggestive: good. Descriptive: expect a refusal and years of proof. Generic: not ownable. Be honest about which one you are looking at; the trademark office will be.

  > If the name explains the product, it is doing marketing work, and marketing work is what descriptiveness means. The applicant almost never sees this refusal coming because the name sounded good for exactly the reason it will be refused.

- [ ] **Generate several candidates, not one**

  Clearance eliminates names. A shortlist of five survives the process; a single favorite often does not, and the founder who searched only one name ends up choosing under pressure.

- [ ] **Check the obvious informal sources yourself first**

  A web search, the app stores, social handles, the domain. If a business in your field already uses the name, you have your answer before spending anything.

- [ ] **Avoid surnames, place names and product descriptions unless you have a reason**

  Each is a known refusal ground. There are ways through, but they cost time and evidence, and a young company rarely has either.

- [ ] **Think about where the brand will be in five years**

  A name for a coffee subscription that will one day be on mugs, a café and a cookbook needs to be free in more markets than coffee. The search in the next chapter is only as good as the list of goods and services you bring to it.

CHAPTER 3

The clearance search

A clearance search answers one question: if you spend the next three years building this name, who already has a claim to it? It is the single most valuable step in the whole process, and it is the one most often skipped or done badly, because a free search of the federal database for the exact name returns a clean result that people believe.

There are two kinds. A knockout search is a screen: it reads the federal register for identical and near-identical marks in related categories, checks the obvious web and business-name sources, and tells you whether something plainly blocks the road. It is quick, and it is the right tool for deciding whether to keep thinking about a name at all. A comprehensive search is an investigation: it draws on a commissioned report covering federal filings, state registrations, business-name filings, domain names, and unregistered use found in trade sources and on the open web, and it produces a written opinion on what the risk actually looks like. The two are priced differently and answer different questions, and people routinely buy the cheaper one when the more thorough one was the point.

What the register shows, searched properly: marks that are similar in sound, appearance, meaning or overall impression (not only in spelling); the goods and services each one claims; whether each is live, dead or in a grace period; and whether an owner has a family of related filings that suggests they will defend the space. A single registration is a fact. Six registrations, two oppositions and a portfolio of variants is a posture. What the register cannot show: the restaurant group that has used the name in four states for a decade and never filed anything, and whose unregistered rights can support an opposition, a demand letter, or a request that you rebrand after the packaging is printed. That gap is what the comprehensive search exists to close.

The legal question the search is trying to predict is likelihood of confusion, and two considerations do most of the work. Do the marks feel like the same thing, in sound, look, meaning and impression? And would an ordinary buyer expect the goods or services to come from the same source? T-shirts and hats, yes. Soap and ice cream, no. Which is why a search is never of a name alone but of a name against a list of goods and services, sorted by the trademark office into forty-five classes. A search run against the wrong classes is worse than no search, because it returns a clean answer you will act on.

A search is a risk assessment, not a shield. An examining attorney may cite a registration you considered and discounted; a third party may object on rights no search would surface. What the search buys is a decision made with the facts in front of you, at the stage where changing your mind costs a conversation instead of a rebrand.

THE CHECKLIST

- [ ] Settle the goods and services before anything is searched

What you sell now, what you are likely to sell within a few years, and which adjacent categories a buyer would assume you were connected to. Those three answers set the classes, and the classes set the boundary of the answer.

- [ ] Use a knockout search to eliminate names, and a comprehensive search to clear the one you will build on

The screen is for the shortlist. The investigation is for the finalist, before money is committed.

> A free search of the federal database for the exact name is not clearance. The conflicts that hurt are similar, not identical, and many of them are not on the register at all.

- [ ] Search for sound and meaning, not only spelling

Marks that are spelled differently and sound the same are treated as the same. So are marks that mean the same thing. The trademark office's own examples include names that share no letters and one pronunciation.

- [ ] Read the results for posture as well as presence

A live registration for the exact name in your class is a stop sign. A family of registrations, oppositions and variants is an owner who will fight. A dead registration is a warning that someone once wanted this name and may still be using it.

- [ ] Search before the logo, the domain and the launch, not after

The search is cheap at the naming stage and pointless after the packaging run. Every dollar spent building a name before it is cleared is a dollar that argues for keeping a name you may have to give up.

- [ ] Get the opinion in writing

A written assessment of the risk, with the conflicts found and the reasoning, is what lets you decide with your eyes open and is what a future buyer or investor will ask to see.

CHAPTER 4

Filing the application

Once a name is cleared, the application to the United States Patent and Trademark Office is a set of decisions dressed as a form, and each decision matters for as long as the registration lives.

Who owns the mark. The applicant must be the entity that actually controls the goods or services sold under it. A founder filing in her own name for a brand the company sells, or a company filing for a mark its subsidiary uses, produces a registration that can be attacked as void. Get the owner right the first time.

Use or intent. If you are already selling under the mark, you file on the basis of use and include a specimen: a real example of the mark on the goods or in the advertising of the services (a product label, a website page selling the service). If you are not yet selling, you file on intent to use, which reserves your place in line from the filing date but does not register until you later prove use. That second half has its own filing, its own fee and its own deadlines, with extensions available for a limited time, and applications are abandoned in that gap regularly. Know which branch you are on before you file, because it changes what the whole exercise costs and when.

What the mark is. A standard-character (word) mark protects the words in any font or styling and is usually the more valuable filing. A design mark protects a particular logo. Many brands file both, separately. What the mark covers: the identification of goods and services, drafted as far as possible from the trademark office's pre-approved language, because a description in your own words costs a surcharge and is the most common cause of an avoidable office action. The identification decides the scope of what you own for the life of the registration; too narrow and you have protected less than you sell, too broad and the registration is fragile when the office audits it.

After filing, the sequence is examination (an examining attorney reviews the application and either approves it or sends an office action, covered in the next chapter); publication, a window in which anyone who believes they would be harmed can oppose; and then registration, if you filed on use, or a notice of allowance, if you filed on intent to use, after which the mark registers only when you file your proof of use. Government fees are set per class and change from time to time; a flat-fee engagement should tell you which surcharges to expect before the application goes in, not after.

THE CHECKLIST

- [ ] **File in the name of the entity that controls the brand**

Usually the company, not the founder. If the brand will be licensed or held by a separate entity, decide that structure first and file accordingly.

> If the party named as applicant did not own the mark on the day the application was filed, the application is void from the start, and assigning the mark afterwards does not cure it. That is different from a correct owner whose name was written down wrongly, which the rules do let you fix. This is the mistake that surfaces in diligence years later, when the registration everyone relied on turns out to belong to nobody.

- [ ] **Decide use or intent to use, and understand the second half of intent to use**

Already selling: file on use with a clean specimen. Not yet: file on intent to use, reserve the date, and calendar the proof-of-use deadline and its extensions. The application fee buys a filing date; registration is a separate event.

- [ ] **Draft the identification from the office's pre-approved language wherever it fits**

It avoids a surcharge and an office action. Where your goods or services genuinely are not in the manual (a great many modern services are not), the identification has to be written, and writing it well is where a lawyer earns the fee.

- [ ] **Choose the specimen carefully**

For goods: the mark on the product, its packaging or a point-of-sale page. For services: the mark in advertising or in the rendering of the service. A business card, a mock-up or a press release is not a specimen, and a rejected specimen is a common and avoidable office action.

- [ ] **File the word mark first, the logo second**

A standard-character word mark protects the wording without committing you to one stylized treatment, for the goods and services you registered it for. The logo protects a design that will probably be refreshed in five years. If the budget allows one filing, it is the word mark.

- [ ] **Cover the classes you use and will use soon, not every class imaginable**

Each class costs, and each class you cannot prove use in is a weakness at maintenance and audit. Register what you sell and what is genuinely next.

- [ ] **Calendar every date the day the filing receipt arrives**

The response deadline for any office action, the publication window, the proof-of-use deadline on an intent-to-use filing. The office sends reminders to the address of record and nowhere else.

CHAPTER 5

When the office writes back

An office action is a letter from the examining attorney listing the legal problems with your application. A large share of applications receive at least one, and receiving one is not a verdict. It is the office telling you what stands between the application and registration, and inviting an answer.

The clock is the first thing to read. Most office actions must be answered within three months of the date on the letter. One three-month extension is available, for a government fee, and it must be requested before the response is filed and before the original deadline passes. There is no government fee for the response itself. If nothing is filed, the application is declared abandoned and the process ends; a petition to revive exists for unintentional delay, with its own fee and its own deadline, but it is a rescue, not a plan.

The letters come in kinds. A nonfinal action is the ordinary first letter and lists every issue; you answer all of them. A final action comes only after you have had the chance to respond, and from there the options narrow to a request for reconsideration or an appeal to the office's trademark board. A priority action confirms in writing a conversation with the examining attorney about the problems and how to fix them. An examiner's amendment confirms a change you authorized by phone or email and usually needs no response; it is the good mail. And a suspension notice is not a refusal at all: the application is parked, usually behind an earlier-filed application that would block yours if it registers, and nothing is due except patience.

The distinction that decides the work is procedural versus substantive. Procedural issues are corrections: a required disclaimer of a descriptive word, an amendment to the identification, a substitute specimen, an ownership correction, a translation statement, a consent. They take judgment but not argument. Substantive refusals are arguments, and two dominate. Likelihood of confusion: the examiner has found a registered mark too close to yours for related goods, and answering means analyzing the marks and the goods against the citation and building a record of evidence. Mere descriptiveness: the mark describes what you sell, and the answer is either an argument that it does not, or a showing that years of use have made it distinctive, which means assembling sales, advertising and press from your own records.

A good response on a substantive refusal has three parts: the legal frame (what the examiner has to find and which considerations the refusal actually rests on), the evidence (third-party registrations showing a shared word is weak in your field, dictionary and trade evidence on meaning, proof of separate channels and buyers, or, on descriptiveness, the record of your use), and the amendments. Often the practical move is to narrow the identification so the conflict falls away, or to disclaim wording you were never going to own. Narrowing is not losing. Registering a smaller thing you can defend usually beats arguing for a larger one you cannot. And the first response is the one that counts: arguments not raised and evidence not filed are hard to introduce later, and the board affirms most refusals it sees on appeal.

THE CHECKLIST

- [ ] **Read the deadline first and put it in two calendars**

  Three months from the date on the letter for most applications, with one three-month extension available if you request it before the original deadline and before filing anything. Applications that came in through the Madrid Protocol (Section 66(a)) get six months instead, and no extension. Check which kind yours is, then calendar that date. Missing it ends the application.

- [ ] **Identify whether the letter is procedural, substantive, or a suspension**

  A disclaimer or specimen issue is a correction. A confusion or descriptiveness refusal is an argument that needs evidence. A suspension needs nothing but watching. The letters look alike; the work does not.

  > A suspension notice reads alarmingly and costs nothing. A three-month deadline reads routinely and ends the application if it passes. People react to the tone of the letter and not to its content.

- [ ] **Start gathering evidence the day a substantive refusal arrives**

  Sales figures, advertising spend, press, dates of first use, examples of others using the shared word in your field. Three months is short when the records live in several people's inboxes.

- [ ] **Consider narrowing before arguing**

  If the conflict disappears when the identification is tightened to what you actually sell, that is often the better outcome, and it is cheaper than a contested response.

- [ ] **Treat the first response as the real fight**

  The record is made here. An appeal reviews the record; it rarely rescues one that was thin.

- [ ] If the application has gone abandoned, act quickly

A petition to revive for unintentional delay has its own short window. If it is too late, remember that an abandoned application does not extinguish your rights in the mark (those come from use); it costs you the filing date, and refiling with a better-drafted identification is sometimes the cleaner path.

CHAPTER 6

Using the mark properly

A registration is only as strong as the use behind it, and how you use a mark day to day can strengthen or quietly erode it.

Use it consistently. The mark as registered should be the mark as used: same spelling, same form. Variations creep in through design refreshes and social media, and a registration for one form with use of another invites a challenge at maintenance. Use it as a brand, not as a word. A trademark is an adjective describing a product from a particular source; when it becomes the noun for the product itself, or a verb, it is on the road to becoming generic, which is how several famous marks became ordinary words and stopped being anyone's property. Pair the mark with a generic descriptor (brand-name headphones, not just the brand name) in copy the company controls.

If you let others use the mark (a licensee, a franchisee, a collaborator on a product), you must control the quality of what they sell under it. A license with no quality control is called a naked license, and it can cost you the mark entirely, because a mark that no longer indicates a single source has stopped doing its job. The control does not have to be onerous. It has to be real, written down, and exercised.

Finally, keep proving use to yourself before the office asks you to prove it to them. Twice a year, drop a dated photograph or screenshot of the mark in use on each of the goods and services in the registration into the brand folder. Every maintenance filing and every audit asks for exactly this, and five years is long enough for a company to have quietly stopped selling a third of what its registration lists.

THE CHECKLIST

- [ ] **Use the mark as registered**

  Same words, same form. If the brand is refreshed, consider a new filing for the new form rather than assuming the old registration stretches to cover it.

- [ ] **Use it as a brand, with a generic word beside it**

  In your own copy, the mark modifies a product name rather than replacing it, and it is never a verb. This is how you keep a strong mark from becoming the name of the thing.

- [ ] **Put quality control in every license**

The right to approve samples, standards the licensee must meet, and the right to inspect. Then actually do it, occasionally, and keep a note that you did.

> The friendly, handshake arrangement with a collaborator who sells a product under your name is the one that becomes a naked license. Paper it, even briefly.

- [ ] **Record use twice a year**

Dated evidence for each item in the registration, in the folder. It takes ten minutes and it is what every later filing is built from.

- [ ] **Register with the platforms once registered**

The major marketplaces' brand programs and the social platforms' verification and takedown processes generally ask for a federal registration. It is the single most practical thing a registration unlocks for an online brand.

- [ ] **Keep the office's records current**

Ownership changes when the company merges, converts or sells the brand; the address and email of record when you move. Reminders and audit letters go to the address on file, and a registration whose contact details went stale is one where nobody sees the clock start.

CHAPTER 7

Keeping the registration alive

A federal registration is not a permanent grant. It stays alive only while you keep telling the trademark office, with proof, that the mark is still in use. Two filings do that work, and one optional filing makes the registration considerably stronger.

The first checkpoint falls between the fifth and sixth anniversaries of registration. In that window you file a declaration that the mark is in use on the goods and services listed, with a specimen showing it. A six-month grace period follows the sixth anniversary, for an added fee. Miss the window and the grace period, and the office cancels the registration. There is no appeal to fairness; the rights generally have to be rebuilt from a new application, with a new filing date behind everyone who filed in between.

The second is the renewal, due in the year before each tenth anniversary, and every ten years after that, again with a six-month grace period. The renewal is filed together with another declaration of use, so it proves use and renews at once. There is no limit on renewals; a mark in continuous use can be renewed indefinitely.

The optional filing is the declaration of incontestability, available once the mark has been in continuous use for five years after registration with no adverse decision or pending challenge. Incontestable does not mean unassailable; several grounds of challenge survive it. But it removes the most common ones, and it is the difference between a demand letter that ends a conversation and one that starts an argument. Because its window overlaps the first checkpoint, the two are usually filed together.

Two things about these filings catch people. The declarations are made under oath, and they cover every item in the registration; a company that has stopped selling three of the eleven goods it listed must delete them rather than swear to them. And the office runs an audit program. A registration is eligible when it lists four or more items in at least one class, or two or more in each of at least two classes, and the office picks some at random and directs others where something in the file invites a closer look. The owner is asked to prove use of specific items; items that cannot be proved are deleted for a fee, or the registration is cancelled if nobody responds at all. Confirm the current eligibility criteria and fees on the office's audit page before you rely on them. A registration listing goods you no longer sell is not a bigger registration. It is a fragile one.

THE CHECKLIST

- [ ] **Put two dates in a calendar the business actually looks at**

  The fifth-to-sixth-year window and the year before each tenth anniversary. The office sends a courtesy reminder to the address of record; it is a courtesy, and it is the only one.

  > These are the easiest deadlines in trademark practice to lose, because they arrive years after anyone thought about the mark. A firm that filed the application should be calendaring them for you; ask whether yours does.

- [ ] **Before each filing, audit the registration against what you actually sell**

  Delete what is gone. Swearing to use you cannot prove is the kind of mistake that surfaces in a dispute, when the other side asks for the specimens.

- [ ] **File for incontestability at the first checkpoint if you qualify**

  Five years of continuous use, no adverse decision, no pending challenge. It is the strongest thing a registration can become and it costs one extra filing.

- [ ] **Treat excusable nonuse as the narrow exception it is**

  A mark temporarily out of the market for reasons outside your control, with a stated intention and a plan to resume. Not a shelter for a brand you simply stopped using. If a brand has genuinely gone quiet, resume use before the window or let the registration go and reassess.

- [ ] **Assign the registration when the owner changes**

  A merger, a conversion, a sale of the brand: record it with the office. A registration standing in the name of an entity that no longer exists surfaces at the worst moment, in diligence or in the middle of a dispute.

- [ ] **Keep the specimens coming**

  The twice-yearly habit from the previous chapter is what makes every one of these filings a ten-minute task instead of an archaeology project.

CHAPTER 8

Watching, and what to do when someone copies you

A trademark that nobody watches is a trademark that slowly loses value, because every unchallenged similar use weakens the argument that the mark points to one source. Watching does not have to be expensive. A watch service that reports new applications close to yours, an alert on the name, and a periodic look at the marketplaces and app stores where your customers are, cover most of it.

When you find a conflict, the first question is proportion. Not every similar name is a threat. A business in an unrelated field, in a distant market, using a name that is similar but not the same, may deserve a note in the file and nothing more. A competitor selling related goods under a confusingly similar name is a different matter, and the earlier it is addressed the cheaper the outcome, because rights harden with use on both sides.

The tools, in rough order of escalation. A conversation or a letter, which resolves most disputes when it is measured, specific and leaves the other side a way to comply. A platform takedown, where the copying happens on a marketplace or social network; these processes generally require a registration and are quick when you have one. An opposition, if the conflicting mark is a pending application, filed during its publication window before the office's trademark board; or a cancellation, if it has already registered. A domain-name proceeding under the international dispute rules, where the conflict is a website. And litigation, which is the last resort and is priced accordingly.

The letter you receive deserves a word too. If you are accused of infringing, do not ignore it and do not answer it in anger. Read what is actually claimed, check whether the other side's rights are what they say (a search of the register and of their real use often tells a different story from the letter), calculate what a name change would actually cost you at this stage, and get advice before responding. Many demand letters overstate their rights. Some do not. Knowing which is the whole game.

THE CHECKLIST

- [ ] **Set up a watch**

  A watch service for new filings close to your mark, alerts on the name, and a quarterly look at the marketplaces and platforms where your customers shop.

- [ ] **Judge each conflict on proportion before acting**

  Same or related goods, similar mark, overlapping customers: act early. Unrelated field, distant market, weak similarity: note it and watch. Not every use is a fight worth having, and over-enforcement has costs of its own.

- [ ] **Write demand letters that leave a way out**

  Specific about the mark, the goods and the rights; measured in tone; clear about what would resolve it. Most disputes end at this stage when the letter is reasonable. Letters that threaten everything invite a fight or a public airing.

  > A demand letter can itself become evidence, and an aggressive one sent to a business that turns out to have earlier rights is an embarrassing document. Check their rights before asserting yours.

- [ ] **Use the platforms' processes for online copying**

  Marketplace brand registries and social platforms' takedown procedures are fast and inexpensive once you hold a registration, and they resolve most counterfeit and impersonation problems without a lawyer.

- [ ] **Watch the publication window and oppose when it matters**

  A pending application that conflicts with your mark can be opposed only during its short publication period. This is what the watch service is for.

- [ ] **If you receive a demand letter, read, check, cost, then respond**

  What exactly is claimed; whether their rights are real and earlier than yours; what changing the name would cost you today; and advice before any reply. Silence and anger are the two responses that reliably make it worse.

CHAPTER 9

Beyond the United States

Trademark rights stop at the border. A United States registration gives you nothing in Canada, the European Union, the United Kingdom or China, and in much of the world the rule is not first to use but first to file: the first valid applicant usually takes the mark, whoever used it first somewhere else. Usually, not always. National laws differ, and prior use, a filing made in bad faith, a well-known mark or an opposition can all change the answer in a particular country. This has a practical consequence that surprises brands every year: a distributor, a former partner or a stranger files your name in a country you plan to enter, and you arrive to find your own brand belongs to someone else.

The good news is that the system for filing abroad is more accessible than it sounds. An international treaty arrangement lets a United States applicant or registrant file one application, in English, through the United States office, designating the member countries where protection is wanted, and pay one set of fees. Each designated country then examines the application under its own law, and some will raise objections that need local counsel, but the front end is a single filing rather than dozens.

When to do it is the real question. File in a country before you launch there, before you appoint a distributor there, and before you announce there, because the announcement is what tells the squatter which name to file. If you manufacture in a country, consider filing there even if you will never sell there, so that your own goods are not stopped at that country's border by someone else's registration. And prioritize: the countries where you sell, where you make, and where copying is most likely, rather than everywhere.

THE CHECKLIST

- [ ] **Assume you own nothing outside the United States until you file**

  Rights are territorial, and most countries award them to the first filer. Your years of use at home count for little abroad.

- [ ] **File in a country before you launch, announce or appoint a partner there**

  The announcement is the squatter's cue. The distributor agreement is the moment a partner is tempted to file in their own name. Both come after your filing, not before.

  > The most common international problem is not a stranger. It is a former distributor or manufacturer who registered the brand locally while the relationship was friendly and now owns it.

- [ ] Use the international system to file in several countries at once

  One application through the United States office, in English, designating the countries you choose. Expect some countries to object under their own rules and budget for local counsel where they do.

- [ ] Consider filing where you manufacture, not only where you sell

  A registration held by someone else in the country of manufacture can stop your own goods at the port.

- [ ] Prioritize by market, manufacturing and risk

  A short list of the countries that matter, filed properly, is worth more than a long list filed late.

CHAPTER 10

Do you need a lawyer, and how to use one well

There are two answers, and which one applies depends on where you live. The rule turns on domicile, meaning where you permanently live or, for a company, its principal place of business: not your nationality, and not where you happen to be this month. If you are domiciled outside the United States, the trademark office requires you to be represented by a lawyer licensed here; that is a rule, and there is nothing to weigh. If you are domiciled in the United States, you are not required to have one. The office accepts self-filed applications and always has. So the honest answer for a United States applicant is: sometimes, and here is how to tell.

Filing it yourself is a reasonable choice when most of the following are true. The name is coined or arbitrary, with no meaning in your industry. A careful search finds nothing close on the register or on the open web. Your goods or services are described in the office's pre-approved language in words that actually fit. You are already selling, so you file on use with a clean specimen. One class covers it. And the name is not yet load-bearing: little spent, nothing printed, and changing it next month would be an inconvenience rather than a crisis. That profile is real, it describes a fair number of filings, and the office's own materials will walk you through it.

It stops being a reasonable bet as the variables move. The name says something about the goods, which is the refusal that turns a routine filing into a long argument about acquired distinctiveness. Something close exists, which is answered with analysis and evidence rather than a form. Your services are not in the manual, so the identification must be drafted and decides the scope of what you own for the life of the registration. You are filing on intent to use, with its second half and its deadlines. There are several classes, or a logo and a word mark. Or money is already committed: packaging ordered, a domain bought, a launch booked. At that point the question is no longer whether you can file it yourself. It is what it costs to be wrong.

The office itself is helpful within its limits. It explains its process, publishes guides, runs the searchable database, answers procedural questions, and its examining attorneys will sometimes resolve a small problem by phone. It will not tell you whether your mark is a good idea, whether a conflict is fatal, whether to file on use or intent, how broadly to describe your goods, or what to do about the company in another state using your name. Its employees are not permitted to give legal advice. So the choice is not between a lawyer and guidance; it is between a lawyer and doing your own analysis.

If you do engage one, the point of a search-and-filing engagement is not the filing. Anyone can complete the form. What you are paying for is the half hour in which somebody who has read the register tells you the name is a problem before you commit to it. Expect a flat fee with its edges drawn: what is included (the search, the opinion, the application, docketing through the first office action) and what is not (office action responses, priced by the kind of refusal; proof-of-use filings on an intent-to-use application; oppositions and litigation; international filings; the maintenance filings years later). Expect to be told which government surcharges will apply before filing, not after. And expect the one caveat every honest trademark lawyer gives: registration is never guaranteed. The office decides, and sets its own pace, and no lawyer controls either.

THE CHECKLIST

- [ ] **If you are outside the United States, you need a licensed U.S. lawyer**

  It is a requirement of the trademark office for applicants, registrants and parties to proceedings, not a recommendation.

- [ ] **If you are in the United States, run the self-filing checklist honestly**

  Coined or arbitrary name; nothing close found; goods in the pre-approved language; already selling; one class; name not yet load-bearing. Most true: self-filing is reasonable. Several false: it is not.

- [ ] **Get advice before money is committed to the name, not after**

  The value of the advice is highest at the naming stage and falls with every dollar spent on packaging. The most expensive trademark advice is the kind sought after the launch.

  > The applicant who most needs advice is usually the one who is most sure the name is fine, because the name is descriptive and sounds good for exactly that reason.

- [ ] **Ask for the fee in writing with its edges drawn**

  What the flat fee includes, what an office action response would cost by type, what the proof-of-use and maintenance filings cost, and which government surcharges to expect. Two honest numbers beat one comfortable one.

- [ ] **Ask who will calendar the maintenance deadlines**

  Years from now, the fifth-to-sixth-year window will arrive when nobody is thinking about the mark. Know whether your lawyer tracks it, and keep your own calendar regardless.

- [ ] **Accept that registration is never guaranteed**

  A search reduces risk; it does not remove it. An application can be refused; the office decides. Anyone who promises otherwise is not describing the system.

That is the life of a mark, from the meeting where the name is chosen to the decade in which it is renewed. Almost every trademark problem we see comes from skipping one step: the search that was not run, the owner that was named wrong, the letter that was not answered in three months, the checkpoint nobody calendared. None of the steps is difficult. This handbook exists so that you know what they are before the name is on the sign.

If you have a name in front of you and would like to know whether it can be owned before you build on it, that conversation is where we usually begin.

Clemenza Law Group, New York, NY. (212) 365-4875.

The current edition of this handbook, and the essays behind it, are at clemenzalaw.com/reference/trademark-owner.