

# Insights

## Trademarks for Business Owners: 4 (More) Things Every Trademark Owner Should Know

July 12, 2020

By: Robert J. Goode

### Your Trademark and the United States Patent and Trademark Office ("USPTO")

#### 1. Do I have to register my trademark with the USPTO to protect my trademark?

No, registration is not necessary for protection, but it does provide additional protection over an unregistered mark. **1** Anyone who uses a trademark in the U.S. will enjoy trademark protection under the "common law" (judge-made law) and/or state law if they are the first (senior) user of the mark. **2** Use of the mark to sell goods or services on a continual basis gives the senior user the right to prevent others from using the same mark to sell similar goods or services in the same geographic territory. **3**

Another option is to register your trademark with the state(s) in which you do business under the mark. This is relatively inexpensive and provides you with state-wide protection for the mark, which may be a larger geographic area than you might have enjoyed with an unregistered mark. **4**

Finally, a federal trademark registration with the USPTO provides nation-wide notice of your ownership of the trademark **5** and allows you to prevent junior users of the same mark from selling the same or similar goods and services in the same geographic territories as you, plus you have the option to expand nationally and push out any junior users who are doing business in other geographic locations. **6**

#### 2. How long does it take to register a trademark with the USPTO?

The timing depends on a number of factors, including whether you file a traditional "use-in-commerce" application or an "intent-to-use" application (discussed in a later article), and whether the USPTO initially refuses registration for one or more reasons. **7** If there are no issues, a "use-in-commerce" trademark application usually takes around seven to twelve months to register. **8** If the application is initially refused, the time to register your mark could extend by months or even years. **9**

The timing for "intent-to-use" applications is similar to that of "use-in-commerce" applications; however, a Statement of Use must be filed within six months of allowance. If the applicant is not ready to use the trademark within that time, then up to five separate six-month extensions can be obtained to provide the applicant up to an additional 2 1/2 years to use the mark in interstate commerce. **10**

#### 3. How long does a trademark registration last?

A trademark registration can last forever if the owner of the mark continues to use the mark and makes the required maintenance filings. **11** For a state trademark registration, the relevant state's statutes will dictate how often a trademark owner must file renewal filings. In Indiana, renewals must be filed every five years to keep the registration active. **12** For federal registrations, a Declaration of Use of the mark must be filed between the fifth- and

sixth-year anniversaries of the registration date of the mark, and renewal filings must be made every ten years from the registration date.<sup>13</sup> Subject to certain exceptions, once a trademark owner stops using a trademark for at least three years, abandonment is presumed.<sup>14</sup>

#### **4. When I register a trademark with the USPTO, does that mean that I can prevent everyone else from using that mark?**

Not necessarily. A federal trademark registration provides nation-wide notice of your ownership of that mark in conjunction with the goods and/or services listed in the registration.<sup>15</sup> It allows you to stop any junior users of the mark from using it to sell the same, similar, or related goods and/or services as are listed in your registration in the same geographic location(s) as you.<sup>16</sup> It also gives you the power to push out junior users of the mark selling the same, similar, or related goods and services in a geographic location in which you begin selling after your trademark has registered.<sup>17</sup> If, on the other hand, another company started using the same mark on the same, similar, or related goods or services as you before you filed your trademark application, then the other company would be a senior user in its geographic location even though it did not register the mark.<sup>18</sup> As long as that senior user does business under the mark on a continual basis, then that senior user can prevent you from entering the senior user's geographic market despite your trademark registration.<sup>19</sup>

However, you cannot usually stop another party from using the mark with unrelated goods or services as there will not be a likelihood of consumers becoming confused as to the source of your and the other party's unrelated goods and/or services.<sup>20</sup>

[1] See, e.g., I.C. § 24-2-1-15; 15 U.S.C. § 1057; 15 U.S.C. § 1065; 15 U.S.C. § 1111; 15 U.S.C. §§ 1114-1117; 15 U.S.C. § 1121; 15 U.S.C. § 1125; 15 U.S.C. § 1141a; and 19 C.F.R. § 133.3 *et seq.*

[2] See, e.g., I.C. § 24-2-1-15.

[3] *Id.*; see also McCarthy on Trademarks, § 16:1.

[4] See, e.g., I.C. § 24-2-1-0.5; I.C. § 24-2-1-2(11); I.C. § 24-2-1-3(6); I.C. § 24-2-1-15; and McCarthy on Trademarks, §§ 16:1 and 26:1 *et seq.*

[5] 15 U.S.C. § 1072.

[6] See 15 U.S.C. § 1057 and *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959).

[7] *See, e.g.*, <https://www.uspto.gov/trademark/trademark-timelines/section-1a-timeline-application-based-use-commerce>, and <https://www.uspto.gov/trademark/trademark-timelines/section-1b-timeline-application-based-intent-use>.

[8] *See* <https://www.uspto.gov/trademark/trademark-timelines/section-1a-timeline-application-based-use-commerce>.

[9] *See, e.g.*, <https://www.uspto.gov/trademark/trademark-timelines/section-1a-timeline-application-based-use-commerce>, and <https://www.uspto.gov/trademark/trademark-timelines/section-1b-timeline-application-based-intent-use>.

[10] *See* <https://www.uspto.gov/trademark/trademark-timelines/section-1b-timeline-application-based-intent-use>.

[11] *See, e.g.*, 15 U.S.C. § 1058(a)(2).

[12] *See, e.g.*, I.C. § 24-2-1-6.

[13] 15 U.S.C. § 1058.

[14] 15 U.S.C. § 1127.

[15] *See* 15 U.S.C. § 1072(b)

[16] *See id.*

[17] *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959).

[18] See McCarthy on Trademarks, §§ 26:1 *et seq.*

[19] See *Id.*

[20] See 15 U.S.C. § 1057(b) (“A certificate of registration of a mark ... shall be prima facie evidence of ... the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate . . .”).