

From the Desk of

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Overview of the Process for Seeking U.S. Trademark Protection

You have asked the MKG, LLC (“MKG”) to prepare a new trademark application on your behalf for filing in the U.S. Patent and Trademark Office (“USPTO”) seeking federal trademark protection of your proposed mark¹. Accordingly, we take this opportunity to explain to you what you can expect during the preparation, filing and prosecution of your application before the USPTO. Please note that this document is intended to only give you a broad overview of the process for seeking trademark protection in the US and is not to be considered a quotation of costs for your particular situation.

The process involves the preparation of a trademark application seeking federal registration of a proposed mark in one or more classes of goods and/or services as defined by the USPTO. Typically, there are two types of trademark applications: an “in-use” application and an “intent-to-use” application. The “use” application is appropriate when the applicant is currently or has been using the proposed trademark in interstate commerce (e.g., business transactions between entities in two or more states, or between entities in one state and a foreign jurisdiction). The “intent-to-use” application is appropriate when the applicant has a bona fide intention to use the proposed trademark in interstate commerce, but may have not begun such use.

In some cases, we recommend conducting a search prior to adoption, use and/or preparing and filing a trademark application. Generally speaking, MKG offers two types of searches. The first type of search which is performed in our office by our paralegal, is a database search of registered and pending US trademark applications. This search, with our informal opinion regarding registrability, costs a minimum of about \$400.00 USD. The second type of search, prepared by an outside trademark search company, is a database search of registered and pending US trademark applications, state registrations, as well as proprietary databases and other sources identifying common law trademark usages and domain names. The search, with our informal opinion regarding registrability, costs in a range of about \$1,000.00 to \$1,300.00 USD including the searcher’s fee. Upon completion of the search, we prepare the trademark application. The fee for preparing the application including a description of goods and/or services in one class for a mark comprising a block letter drawing is \$600.00 USD. However, should an applicant make repeated changes to the application (i.e., mark, and identification of goods or services) or require additional counseling, the final cost of preparation of the trademark application may increase.

¹ A trademark or service mark (referred to interchangeably as a mark) is a word, symbol, picture, phrase, color or combination thereof used on in connection with goods and/or services to distinguish your goods and/or services from competitors.

Overview of U.S. Trademark Process (continued)

Once the application is prepared, it is filed with the USPTO. The required USPTO filing fee is \$275.00 USD per class. If the trademark is sought to be registered in multiple classes, a \$275.00 USD fee is required by the USPTO for each class. MKG's fee typically remains \$600.00 USD for a multiple class application, unless the application seeks registration in greater than three (3) classes. MKG will provide a specific cost estimate for such multiple class filings.

Once the application is received at the USPTO, it is assigned to an Examining Attorney who then conducts a substantive examination of the application including his/her own search through the USPTO's records of pending and registered trademarks. If the Examining Attorney uncovers applications/registrations relevant to your proposed mark, an Office Action will issue including the Examining Attorney's reasons for initially rejecting the application over uncovered third party applications or registrations. The Examining Attorney may also initially reject the application for alleged informalities including, for example, terms within the description of goods and/or services that the Examining Attorney requires be changed or further clarified. The Examining Attorney may also argue that the mark is not eligible for protection under US Trademark Law for other reasons. We will of course work to minimize these refusals by drafting an application that meets all the USPTO requirements. You should bear in mind that it is not uncommon, and in fact more likely than not, that the Examining Attorney will cite applications/registrations against your application that were not uncovered in any search we performed for you. This is due in part to the fact that what the Examining Attorney finds relevant may be quite different from what was uncovered when the search was made. Furthermore, the documents available to the Examiner may be more comprehensive and complete than those available to the public. Additionally, new trademark applications are filed daily, so it may be possible that a third party's application was filed after our search and before your application was filed with the USPTO.

Upon receipt of an Office Action from the Examining Attorney, MKG will review it and report its receipt to you with our recommendations for a response. Our recommendations will include an estimated cost for responding to the Office Action including a highlight of amendments and/or arguments we believe will overcome the initial refusal. Depending on the extent of the Office Action, the preparation of this letter reporting the Office Action and providing our recommendations can cost anywhere from about \$400.00 to \$500.00 USD (billed at our attorney's hourly rates).

In order to continue with the prosecution of the trademark application, a response must be made to the USPTO's Office Action within a given time frame, which is typically six (6) months, or the application is deemed abandoned. As noted above, an estimated cost for responding to the Office Action will be given with our recommendations for response. Generally speaking, the cost for responding to most USPTO Office Actions is typically about one thousand to one thousand four hundred dollars (\$1,000.00 to \$1,400.00 USD). Depending on the reasons for the initial refusal. An applicant can usually expect one or two Office Actions during the prosecution of the trademark application. However, bear in mind that it is also possible that the application will register without any Office Actions. If we are successful in responding to the Office Action issued by the Examining Attorney, the application is then published for possible opposition by third parties that believe they may be injured if you obtain federal registration of your mark. The timing of the publication and statutory opposition period

Overview of U.S. Trademark Process (continued)

will be reported to you at the appropriate time, with a copy of the Notice of Publication. Our fee for reviewing and reporting the Notice of Publication is approximately \$150.00 USD.

At times, MKG is unable to convince an Examining Attorney that the mark in the trademark application is registrable. In this instance, the applicant can either cease any further prosecution of the application, which would result in its abandonment, or can appeal the continued refusal by the Examining Attorney to the United States Trademark Trial and Appeal Board (“Board”). If an applicant decides to appeal to the Board, a Notice of Appeal must first be filed. The cost for preparing and filing such a Notice of Appeal is approximately \$350.00 USD. Once a Notice of Appeal is filed, an applicant has two (2) months to submit an Appeal Brief to the Board. Appeal Briefs are extensive documents which including arguments refuting the Examining Attorney’s continued refusal on legal and substantive grounds. The cost to prepare a Brief varies depending upon the grounds for refusal. Typically, an Appeal Brief can be prepared at a starting costs of about \$2,500.00 to \$3,500.00 USD. If a favorable decision is handed down from the Board, the application will then pass to Publication. If an unfavorable decision is handed down, the applicant has two options - either allow the application to go abandoned or file an appeal in a U.S. Court.

Once the application is published, a one-month statutory opposition period commences in which potential third parties may object to registration of your mark by filing a Notice of Opposition and beginning an Opposition Proceeding before the Board. Potential opposers include anyone who feels that they would be harmed by the registration of your mark. If this occurs, you must respond to the Notice of Opposition and other action in the Opposition Proceedings otherwise the opposer defeats your application by default. Fees for responding to action in the Opposition Proceeding start at about \$1,200.00 USD and are then billed hourly. However, you should note that an Opposition Proceeding is a formal process conducted before the Board and is similar to a trial of the issues involving the registration of the mark undertaken before the USPTO as compared to a US court of law. MKG has a separate overview document outlining the typical stage of an Opposition Proceeding, and we will be pleased to provide that to you and discuss any questions you may have. As with any adversarial proceeding, costs vary greatly depending upon the matters at issue and if settlement cannot be achieved. Please bear in mind that very few applications receive a Notice of Opposition and that, if received, MKG works to keep costs to a minimum while reaching an amicable resolution for all parties.

After publication, without an Opposition being filed, an “in-use” application is registered and the Certificate of Registration is reviewed from the USPTO. MKG will review the registration, confirm its accuracy and forward the registration to you for safekeeping along with recommendations for proper use of your trademark.

If the trademark application was filed under an “intent-to-use” basis, after Publication the USPTO will issue a Notice of Allowance. The Notice informs an applicant that all substantive examination is completed, that registration was not opposed, and that a registration is ready to be issued once the applicant demonstrates use of the mark in interstate commerce. MKG’s fee for reviewing, confirming the accuracy of and reporting the Notice of Allowance is approximately \$150.00 USD. Once the Notice of Allowance is received, a six-month statutory time period commences in which a Statement of Use must be filed. The Statement of Use is the means by

Overview of U.S. Trademark Process (continued)

which the applicant demonstrates use of the mark in commerce to the USPTO. MKG's fee for preparing and filing the Statement of Use (one class) is \$300.00 USD, and the USPTO fee is \$100.00 USD per class. An applicant may obtain a 6-month extension of time to file a Statement of Use. MKG's fee for preparing and filing the Extension of Time for the Statement of Use (one class) is \$250.00 USD, and the USPTO fee is \$125.00 USD per class. Once the Statement of Use is filed and accepted, the application will pass to registration. Again, we would review, verify the accuracy of and forward the Certificate of Registration to you.

After registration, the USPTO does require certain acts to maintain a US federal trademark registration in force. As long as the mark is continuously used in interstate commerce, a registration can be renewed. Under US Trademark Law, registrations are renewable every ten (10) years by filing a Declaration of Use under Section 8 of the Trademark Act and an Application for Renewal under Section 9 of the Act. MKG's fee for preparing and filing the Sections 8 and 9 Declarations is \$400.00 USD, and the USPTO official filing fee is \$425.00 USD per class. In the first ten-year term, the USPTO requires submission of a statement showing continuous use of the mark in commerce between the fifth and sixth year following registration by filing a Declaration of Use under Section 8 of the Act. At this time, MKG also recommends an applicant file a Declaration under Section 15 of the Trademark Act seeking "incontestability" under US Trademark Law. Accordingly, at this 5th to 6th year post-registration time period, an applicant may file just the Section 8 Declaration, or the combined Sections 8 and 15 Declaration. MKG's fee for preparing and filing the Section 8 Declaration is \$400.00 USD, and the USPTO official filing fee is \$125.00 USD per class. MKG's fee for preparing and filing the combined Sections 8 and 15 Declaration is \$400.00 USD, and the USPTO official filing fee is \$325.00 USD per class. Thereafter, renewals are required at ten year intervals tracked from the date of first registration.

As stated above, this document is intended only to provide a very broad overview of the process for seeking federal trademark protection in the US, as well as to give you, as an applicant, an idea of the representative costs of the process. Please bear in mind that the costs detailed above can vary significantly from application to application depending upon such things as the similarity of your mark to that of third parties in related fields of commerce. Accordingly, please understand that this document is provided merely as guidance to future costs and us not a guaranty of the total costs of successfully registering your mark. Please review this document and should you have any questions or concerns, do not hesitate to contact us, as we are always willing to discuss the particular details unique to your mark, the trademark application and/or your uses.