

# Federal Registration of Trademarks to Protect Intellectual Property

Advantages over common law trademark rights include instant nationwide protection, effective notice to competitors, and ease of assigning, licensing, and defending

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Unlike with patents, there are common law legal protections with trademarks whether or not a mark is registered with the Trademark Office. In the United States, common law trademark rights automatically take effect upon actual use of the trademark in association with particular goods or services in commerce. As such, the question often arises, “*why bother federally registering trademarks if common law rights already exist through actual use?*” Common law trademark rights occur under state law. Therefore, such protections are only in place in the specific states in which the mark is commercially used in association with the goods or services. In states where there is no commercial use, there are no legal protections (and therefore competitors in those states are free to use the same or similar mark on the same or similar goods). In contrast, if a federal trademark registration is obtained, legal protections are automatically created across the entire United States, whether or not the mark is actively in use in each and every state.

## U.S. Trademark Requirements

Commercial use of a trademark requires actual sales or transactions of goods or services with consumers in arm’s length transactions in interstate commerce in a manner that demonstrates the trademark in conjunction with the goods or services. Mere advertisement of a product or service does not qualify as commercial use in the U.S. To be eligible for federal trademark registration in the U.S., the commercial use must be in interstate commerce, meaning the sale or transaction must be with a consumer from a different state than where the business and the goods or services originate. If sales or transactions with consumers are only in the same state as the business and source of goods, then pursuing a state trademark registration should be considered, instead of a federal trademark registration. Sales or transactions internationally, outside of the U.S., also qualify the mark for federal trademark registration.

## Types of U.S. Trademark Applications and Application Process

In the U.S., there are two forms of trademark registration applications. An intent-to-use trademark application can be filed before there is actual commercial use of the mark; whereas an in-use application (or regular trademark application) requires actual commercial use such as a sale or transaction across state lines before applying for registration. An in-use application includes a description of the trademark, a description of the goods or services associated with the mark for which registration and rights are sought, and evidence of use of the mark with the goods or services in a specimen evidencing use. The application goes through an examination process with the Trademark Office, where the trademark examiner reviews the application and compares it with other registered marks to assess whether there are any owners of senior trademark rights for the same or similar mark on the same or similar goods or services. If there are no senior rights owned by others for confusingly similar marks, then the registration continues on to publication for opposition and then to registration if no opposition is filed by a third party claiming senior rights.

The intent-to-use application allows for the same examination process (i.e., trademark prosecution) to receive an indication from the Trademark Office as to whether the mark is registerable or not based on certain filing criteria and whether it is confusingly similar to other federally registered marks, while deferring the requirement for evidence of actual use until the end of the process instead of the beginning. If the application is allowed (deemed registerable), evidence of actual commercial use must be provided. If such evidence in the form of a specimen evidencing use cannot be provided, then extensions of time to file such specimen are available for an additional fee. Each extension of time lasts six months, and the applicant can apply and pay for a maximum of five extensions, for a total of 2 ½ years from the indication of registerability. There must be good cause for taking an extension of time. This can be achieved with an applicant's statement of ongoing efforts to make such use, including activities such as product or service research or development, market research, steps to acquire distributors, steps to obtain required governmental approval, or similar specified activity.

To file an intent-to-use application, the applicant must have a bona fide intent to use the mark. As such, it is important to preserve any evidence of bona fide intent, such as evidence of any preparations made toward using the mark. Evidence of preparations can include registrations of domain names, work done toward designing and using marketing materials or product packaging, product development or research, etc. A benefit of the intent-to-use application process is that it provides a constructive date of first use of the mark as of the filing date of the application, which can enable the applicant to temporarily reserve an earlier priority date than they may otherwise be eligible for based on actual use later.

#### **Advantages of Federal Trademark Registration**

Federal registration is the recommended way to proceed, instead of merely relying on common law trademark rights. Registration provides instant protection across the entire country in which the registration is obtained. Additionally, it is a much more effective way of notifying competitors as to the existence of trademark rights because registered trademarks are published and available in the trademark databases, whereas there is no universal public database for common law trademarks. Registrations for trademarks are also more easily assigned and licensed, and the current assignee owners can be searched and located in the trademark databases. Trademark registrations also provide the presumption that the trademark is valid if challenged (placing the burden on the challenger to show that it is not valid). Many businesses and products have substantial portions or even all of their value in the form of their brand (e.g., where there is no patentable technology). Such businesses should definitely obtain federal trademark registrations to protect this valuable intellectual property.

For more information about registration of trademarks, please contact [Sean Detweiler](#).