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## TRADEMARK OVERVIEW

### WHAT IS A TRADEMARK OR SERVICE MARK?

A **trademark** is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others. A **service mark** is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product. Throughout this informational summary, the terms "trademark" and "mark" refer to both trademarks and service marks.

### WHAT IS THE DIFFERENCE BETWEEN A TRADEMARK, COPYRIGHT AND PATENT?

A **trademark** protects words, phrases, symbols, or designs identifying the source of the goods or services of one party and distinguishing them from those of others. **Copyright**, by contrast, protects original works of authorship, but does not protect ideas, concepts, systems, or methods of doing something. You may express your ideas in writing or drawings and claim copyright in your description, but be aware that copyright will not protect the idea itself as revealed in your written or artistic work. However, a **patent** may be used to protect the underlying invention, idea, or method.

### WHY TRADEMARK?

Federal trademark registration provides several important advantages:

- It prevents others from using the same or similar trademark in connection with the same or similar goods or services.
- It gives you the right to bring a legal action concerning infringement of your mark in a United States Federal Court.
- The trademark provides constructive notice to the public of your claim of ownership of the mark. This means that a claim of "innocent infringement" will not be entertained by the court if you have obtained federal registration for your trademark.
- It provides you with the ability to file the trademark registration with the U.S. Customs Service to prevent importation of infringing foreign goods.



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- The United States trademark registration may be used as a basis to obtain registration in foreign countries, namely through the **Madrid Protocols**.
- Federal registration of your trademark will be used as a legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration.

### WHEN CAN I USE THE TRADEMARK SYMBOLS TM, SM AND ®?

Any time you claim rights in a mark, you may use the "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO. However, you may use the federal registration symbol "®" **only** after the USPTO actually *registers a mark*, and **not** while an application is pending. Also, you may use the registration symbol with the mark only on or in connection with the goods and/or services listed in the federal trademark registration.

### WHEN CAN I REGISTER A TRADEMARK?

Most U.S. applicants base their application on their *current use* of the mark *in commerce*, or their *intent to use* their mark in commerce in the future.

**Current Use:** If you have already started using the mark in commerce, you may file based on that use. A "use" based application must include a sworn statement (usually in the form of a declaration) that the mark is in use in commerce, listing the date of first use of the mark anywhere and the date of first use of the mark in commerce. The application must include a specimen showing use of the mark in commerce (the Client Intake form explains the specimen in more detail).

**Intent to Use:** If you have not yet used the mark, but plan to do so in the future, you may file based on a good faith or bona fide intention to use the mark in commerce. *You do not have to use the mark before you file your application.* Also, while your mark is pending as "intent to Use," you still receive protection if other marks are filed later that conflict with yours. An "intent to use" application must include a sworn statement (usually in the form of a declaration) that you have a bona fide intention to use the mark in commerce.

### THE LANTERN LEGAL PROCESSING METHOD:

- 1) We will send you an intake sheet which you will fill out and send back to us. The intake sheet will provide us with basic information about you/you company, the product or service, and indicate whether you are currently using your proposed trademark or whether you plan to use it in the future. The intake sheet will also indicate the type of Trademark Availability Search you would like us to conduct on your behalf. Conducting the Availability Search prior to filing a trademark application is important as it will save you time and money if your proposed mark infringes on an already registered trademark.
- 2) We offer two search packages: (1) The basic Patent and Trademark Office (PTO) search which includes a search of all federally registered trademarks that potentially conflict



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with your proposed mark; or (2) a comprehensive availability search which includes PTO search as well as a search of all 50 U.S. state databases, Canadian Trademark Registry, voluminous business directories, domain name registries and directories, and numerous Internet search engines.

- 3) We analyze the Availability Search results and provide you with a results report together with our recommendation as to whether you are safe to move forward with your proposed trademark. (See our Trademark Flowchart, which generally accompanies this summary, for more information about our process).

### WHAT HAPPENS AFTER WE FILE A TRADEMARK APPLICATION?

After the USPTO determines that you have met the minimum filing requirements, the application is forwarded to an examining attorney. This may take a number of months. The examining attorney reviews the application to determine whether it complies with all applicable rules and statutes and includes all required fees. A complete examination includes a search for conflicting marks, and an examination of the written application, the drawing, and any specimen.

If the examining attorney decides that a mark should not be registered, the examining attorney will issue a letter (**Office Action**) explaining any substantive reasons for refusal, and any technical or procedural deficiencies in the application. If only minor corrections are required, the examining attorney may contact us by telephone or e-mail. If your proposed mark is refused for any "substantive" reason that would require an Office Action response on our part, we will consult you and respond accordingly. Because Office Action responses vary in the amount of legal research and analysis needed to effectively draft a response, the fee is on an hourly basis. Note also, that while we are always here to help, you are not required to use our services simply because we filed on your behalf and remain as "Attorney of Record" until your mark is registered.

### PUBLICATION FOR OPPOSITION

If the examining attorney raises no objections to registration, or if the applicant overcomes all objections, the examining attorney will approve the mark for publication in the *Official Gazette*, a weekly publication of the USPTO.

The USPTO will send a NOTICE OF PUBLICATION to the applicant stating the date of publication. Any party who believes it may be damaged by registration of your mark has thirty (30) days from the publication date to file either an opposition to registration or a request to extend the time to oppose.

An opposition is similar to a proceeding in a federal court, but is held before the Trademark Trial and Appeal Board, a USPTO administrative tribunal. If no opposition is filed or if the opposition is unsuccessful, the application enters the next stage of the registration process. A **Certificate of Registration** will issue for applications based on use, which indicates the



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completion of your registration process and allows you to begin using the "®" symbol. If your filing was based on your intent to use the trademark in the future, a **Notice of Allowance** will be issued and you will have six months to submit proof of your use of the mark (the six month period may be extended every six months for up to four (4) years). There is a USPTO fee to file each extension.



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