



Making Business Happen

Attention: Business Owners

Don't allow your competition to steal your business!

Do you want your competition to steal your customers?

Do you want your competition to steal your business identity?

Do you want your competition to damage your company's reputation?

Do you want your competition to use your company's name or slogan in their advertisements?

Whether you sell a product or provide a service, we can Trademark your Company Name, DBA, Slogan, Brand or Logo at the Federal or State Level. In today's business climate, filing a trademark is a necessity and should be done immediately after incorporating your business or filing your DBA to make sure that you control the exclusivity of your Business Name and Brand. A registered trademark might be your most valuable asset!

TM ® TM © TM

US Federal Trademark Registration Package

\$ 999.00 + Government Fees

There are no hidden charges

Includes Comprehensive Trademark Search of Federal & State Trademarks, Common Law Sources & Top-Level Domain Names with a Legal Review & IP Attorney Opinion Letter

ACT NOW & CALL US TODAY!

- We will not mislead you with false "got you hooked" fees then clobber you with additional charges.
- We will walk you thru the entire trademark process and explain everything you need to know.
- We have successfully filed thousands of trademarks for our clients.
- Our knowledge, honesty and expertise are unmatched.

Allstate Corporate Services Corp
2215 Hendrickson Street, Suite 1
Brooklyn, NY 11234
Tel (800) 906-9220 Fax (800) 906-9880
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Nationwide Corporate Filing & Research Services

Trademark Searches & Filings – Listing of Fees

US Federal Trademark Registration Package: Includes Comprehensive Trademark Search with a Review & IP Attorney Opinion Letter Please add Government Filing Fees of \$325-\$375 per class of goods or services Please add ACS Fee of \$110 per additional class of goods or services in application	\$ 999.00 + Government Fees
Comprehensive Trademark Search with Review & IP Attorney Opinion Letter: Includes search of Federal & State Trademarks, Common Law Sources & Top-Level Domain Names with a Legal Review & IP Attorney Opinion Letter	\$ 760.00
Basic Direct-Hit Trademark Search: Includes search of Federal & State Trademarks	\$ 170.00
<p>Once an application is submitted to the Trademark Office, you will receive a filing receipt from the Trademark Office indicating that the application has been entered into its computer system and the review process will commence. If there are any inquiries, refusals to register or any other additional requests, you will receive an Office Action from the Trademark Office stating the concerns of the Examining Attorney. We are able to respond for additional fees.</p>	
Trademark Monitoring Service: SILVER Annual Package Monitors Federal & State Trademarks Results are emailed monthly	\$ 200.00
Trademark Monitoring Service: GOLD Annual Package Monitors Federal & State Trademarks & Common Law Sources Results are emailed monthly	\$ 400.00
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Note: A listing of our additional services and related fees for all 50 States and Jurisdictions is available upon request. Fees are subject to change without notice. Please confirm pricing prior to ordering any of our services.



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TRADEMARK REGISTRATION

The Three Steps Process

We make registering your trademark simple. Once you complete the order process, we take care of all the time-consuming legal formalities.

The following is our 3 step trademark registration process:

- 1) **Complete the questionnaire and Fax or Email it back to us.**
Complete our short questionnaire which was created by our experienced trademark professionals. If you are unable to answer any of the questions don't worry, simply leave them blank. Fax the completed questionnaire to us at Fax # 800-906-9880 or Email it to info@acs123.com
- 2) **We will confirm your information and then prepare and file your Trademark application.**
We will call you in order to review the information you submitted, answer all your questions and walk you through the entire trademark process. Once everything is confirmed and upon your authorization, we will conduct a Comprehensive Trademark Search and file the trademark application with the U.S. Patent & Trademark Office on your behalf.
- 3) **You receive your documents and final instructions.**
You will receive a copy of the necessary documents and final instructions.

Thank you for choosing [Allstate Corporate Services](#) for your trademark requirements.



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Trademark & Service Mark Registration Order Form

Today's Date _____ My Name & email _____

Your Firm / Name _____

Your Phone # _____ Your Fax # _____

Address for delivery of Filed Documents _____

.....

You would like to register a Trademark at the: _____ **State Level** _____

In order to register a Trademark at the State level, the Mark must be in use locally. List one or more states as requested

_____ **Federal Level** (USPTO: US Patent & Trademark Office)

In order to register a Trademark at the Federal level, the Mark must be in use, or intended to be used, in interstate commerce.

1. Trademark Name and/or Design to be registered:

2. Is this Mark used with a design? Yes No

PLEASE NOTE: If checked "Yes" you will need to submit a black and white (or color) image of your stylized trademark or logo. Please include a copy of the logo with this questionnaire, or send the image via e-mail (.jpg format)

3. What products and/or services is the Mark used with or to be used with?

This is one of the most important parts of the application, so please be very careful. Your description will establish the scope of the trademark registration.

Use clear and concise terms to list the specific goods or services represented by the trademark. Examples include:

- Chocolate candy
- Business consulting for the telecommunications industry
- Computer software for accounting purposes
- Dry cleaning service
- Fishing rods

DO NOT use ambiguous or general terms such as **Computer Services, Food or Clothing etc...** unless you later specify the exact type (for example: **Computer Consulting Services, namely, designing and implementing web sites for others**).



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4. Has the Mark already been used? Yes No

If yes, where is it being used?

PLEASE ALSO NOTE: If you checked "Yes" you will need to submit a specimen that shows your trademark as it is actually used for example, on a packaging label or an advertising brochure. Please include a copy of the specimen with this questionnaire, or send the specimen image via e-mail (in .jpg format).

For services, acceptable specimens include brochures, flyers, advertisements and internet websites. Business cards or stationery are usually not acceptable, unless there is some clear reference to the type of services rendered.

For goods, acceptable specimens include labels, tags, packaging material, instruction manuals and containers which display the trademark. Please note that brochures, catalogs and stationery are generally not acceptable specimens for goods.

5. Where will the Mark be used in the future?

6. If the Mark has not been used as yet, what evidence of bona fide intention to use?

7. In what manner is the Mark used or to be used [i.e. on labels, hangtags, packaging, promotional literature, website presence, etc.]?

8. Are specimens/proof of actual usage available? Yes No

If yes, are specimens/proof attached? Yes No



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9. Information about the Owner/Applicant of the Trademark:

Name _____

Email _____

Tel # _____ Fax # _____

Address _____

10. Is Owner a person? Yes No Citizen of _____
or LLC? _____ Corporation? _____ formed in the State of _____

11. Is the current owner the original Trademark owner, or is there a predecessor in interest?

12. When did owner begin use of the Mark anywhere? [mm/dd/year] _____

13. When did owner begin use of the Mark in interstate commerce? _____

14. Evidence of use can be substantiated by purchase order, bill of lading, delivery or payment?

15. Who will sign the application? Name _____ Title _____

17. Does Applicant own any other registrations for the same Mark? Yes No
Does Applicant own any other Registered Trademarks? Yes No If yes, please list:

Would you like to include any additional statements regarding your trademark application?
(Please note: This is not required)

These statements could be used to describe specific colors, translate foreign words, etc.



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Trademarks Informational Guide

What is a trademark and why are trademarks important?

Trademarks are words, names, symbols, slogans, tag lines, characters and designs. Trademarks can also be colors (e.g., pink insulation), sounds (e.g., lion roar), scents (e.g., scented yarn), product configuration (e.g., shaped bottle), or trade dress (e.g., look/feel of a restaurant). Depending on the nature of the trademark, issues such as distinctiveness and secondary meaning may need to be considered to determine registrability and protectibility.

Trademarks identify goods and services coming from a single source and serve to establish good will with the consumer, enticing that consumer to repurchase the goods or services based upon the name or source of the goods or services. They also distinguish a manufacturer's or merchant's goods or services from those manufactured or sold by others.

As consumers become familiar with particular marks, and the goods or services they represent, marks can acquire a "secondary meaning," as indicators of quality. Thus, established marks help consumers answer the question: "Is this product or service a good one to purchase?" For this reason, the well-known marks of reputable companies are valuable business assets, worthy of nurturing and protection.

The law governing marks essentially is consistent, regardless of the kind of product or service identified, or the nature or appearance of the mark employed. However, marks often are categorized according to the type of identification involved. The most commonly encountered categories are **trademarks**, **service marks**, and **trade dress**. **Trade names** are not marks, although a trademark owner should know something about them.

What is the difference between a trademark and a service mark (TM or SM)?

A trademark is a type of mark. Traditionally, the term, "trademark," described only marks designating products, or "goods" (as opposed to services). Increasingly, however, the word is used to describe any type of mark, not just traditional "trademarks."

A service mark is another type of mark. A service mark is a trademark that is used in the sale or advertising of services (e.g., restaurant services, banking services, etc.). Service marks indicate the source or origin of services (as opposed to goods). However, since the distinction between goods and services is not always clear, the term trademark is often used to encompass service marks as well. For all practical purposes, trademarks and service marks are subject to the same rules of validity, use, protection, and infringement. For purposes of this informational, both are referred to as trademarks.

What is the difference between a trademark and a trade name?

A trademark is used with specific goods or services and identifies the source of those goods or services. A trade name identifies a company and its business.

Because words can be used interchangeably as both a trademark and a trade name, depending on the context of use, close attention to trade names should be given in determining the use of a trademark.

For example:

If used as an adjective: "Get your Allstate Corporate Services trademark search."

It is a trademark.

If used as a noun: "Get your trademark search from Allstate Corporate Services."

It is a trade name.



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Trade names are *not* marks. A trade name is a word, name, term, symbol, or combination of these, used to identify a business and its goodwill. Whereas, a mark identifies the goods or services of a company, a trade name identifies the company itself. Trade names and marks are related. For example, if one business adopts a trade name similar to a mark used by another, the trade name of the first business may impede the effectiveness of the mark used by the second in identifying the source or origin of goods or services. Consumers may come to believe that the first business makes goods, or provides services, sold by the second. For this reason, conflicts can arise between trade names and marks.

Trade names also can function as marks. Many companies use all or part of their business names as marks on their products, or in connection with their services. When a trade name is used by a company in this dual fashion, it becomes even more important that competing companies refrain from using a similar trade name or mark.

What is a Trade Dress?

Trade dress also is a type of mark. "Trade dress" refers to the overall image or impression of a product (the product's "look," and "feel"), and/or the way in which the product is packaged and presented to consumers. Generally, only those elements of a product which are nonfunctional (as opposed to functional elements, such as shrink-wrap, or a plain cardboard box); which have acquired a secondary meaning, and which inform consumers about a product's source, are considered protectable product trade dress.

If I use my trademark without a federal trademark registration, what kind of rights do I have?

Common law rights. The level of protection depends on the jurisdiction involved, and remedies are determined from interpretation of relevant case law(s).

Without a federal trademark registration, your trademark rights may only cover the geographic area in which the trademark is being used.

A problem may occur when the territories of two common law trademark owners with similar trademarks on similar goods overlap. Most often, the owner that first used the trademark in the contested market will prevail and the other owner will be prevented from expanding into the overlapping territory. However, it is important to note that these situations are not categorical—the facts for each circumstance need to be examined to determine the outcome.

What trademark rights do I get with federal trademark registration?

The primary benefit of obtaining a federal trademark registration is that it establishes nationwide protection to registered marks, regardless of the areas in which the mark is actually being used.

What are some other advantages of obtaining federal trademark registration?

- Enables you to use the registration notice "®" and notifies others of your trademark rights.
- Safeguards future opportunities for nationwide expansion.
- Provides access to federal courts.
- Allows for the possibility of greater recovery of damages for infringement.
- An application or registration acts as a deterrent. By placing the mark on the register, you alert others who may want to use your trademark that it is already being used.
- Gives the registrant the ability to stop importation of goods that utilize infringing marks, by depositing a copy of the registration certificate (and subsequent renewal certificates) with U.S. Customs.

What is the difference between the symbols ™ and ®?

No formal filing is necessary to use a ™. It can be used at any time to inform the public that trademark rights are being claimed by the owner. The ®, on the other hand, can only be used if the trademark is federally registered.



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What makes a trademark owner eligible to obtain a federal trademark registration?

Use of a trademark in interstate commerce in direct association with a product or service. Generally, use of the trademark only in advertising does not constitute trademark use for purposes of obtaining a federal trademark registration. Service marks are an exception to this rule, with each situation requiring the appropriate assessments.

What constitutes interstate commerce?

For goods, "Interstate commerce" involves sending the goods across state lines with the mark displayed on the goods or the packaging for the goods. With services, "interstate commerce" involves offering a service to those in another state or rendering a service which affects interstate commerce (e.g. restaurants, gas stations, hotels, etc.).

What if I don't use my mark in more than one state?

You can file a State Trademark registration, which functions as a public record, alerting others to your common law rights within that state. State trademark registrations can also provide certain state statutory rights. State registrations are fairly quick and inexpensive, serving, at the very least, as a deterrent to third parties who may be searching the state databases in an effort to clear a mark for use and/or registration.

If you intend to eventually use your trademark in interstate commerce, you should consult with us about filing a federal trademark application based on intent to use.

Do trademark rights extend from one country to another?

NO. Every country has its own trademark laws. There are over 200 countries with individual trademark laws. While trademark rights are territorial, and many of the basic concepts found in U.S. trademark law hold true in other countries, there are also many differences, including the establishment of trademark rights.

How far do trademark rights extend?

To avoid confusion between trademarks, the courts and the Trademark Office usually look at the relationship of the goods/services in which the mark is used. In other words, with the exception of famous marks (e.g., COCA-COLA, POLAROID, TIFFANY), trademark registration does not give you a total monopoly over every use of a mark. A mark which is similar to another mark may still be registrable if the marks are used in connection with sufficiently different goods or services, and such simultaneous use is not likely to confuse a consumer.

In addition to registrability, the relative strength or weakness of a mark also affects the scope of protection. In other words, is the mark unique enough to distinguish the goods or services of one from the goods/services of another?

What determines the strength of a trademark?

A Mark (such as a word or a logo) can only be considered a trademark or a service mark if it is distinctive. A distinctive device is one that is capable of distinguishing the goods or services upon which it is used from the goods or services of others. A non-distinctive device is one that merely describes or names a characteristic or quality of the goods or services. The distinctiveness of a Mark can generally be categorized into one of five categories which fall along a spectrum of distinctiveness. From most distinctive to least distinctive, these categories are Fanciful/Coined, Arbitrary, Suggestive, Descriptive (including Surnames) and Generic.

Trademarks that are fanciful, arbitrary, or suggestive are considered distinctive enough to function as trademarks. On the other hand, if a Mark is descriptive, the Mark can function as a trademark or service mark only if it has obtained secondary meaning. Generic devices can never be a trademark.

The "strength" of a mark is determined in part by where it falls on this spectrum. Fanciful marks are considered stronger than suggestive marks, and therefore are granted greater protection by the courts.

Trademark strength can be determined by fitting a mark into one of the following categories:



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	<u>Definition</u>	<u>Examples</u>
Fanciful/Coined	No dictionary meaning	CHEX – Cereal, OREO – Cookies
Arbitrary	Words used out of context	OCEAN SPRAY – Juice, CAMEL – Cigarettes
Suggestive	Hints at or suggests the nature or attribute of a product	HAMBURGER HELPER – Dinner Mix SLIM FAST – Meal Replacement Drinks
Descriptive	Describes product, ingredients or attributes	VISION CENTER – Optical Center EXTRA STRENGTH – Aspirin
Generic	Common description, can never be a trademark	Baking soda, telephone

A descriptive term (including surnames) may be capable of becoming a trademark if it is shown that the term is recognized as emanating from a single source or possessing a "secondary meaning." In other words, it is not just an identifier of a thing or person.

Fanciful marks:

Fanciful marks are devices which have been invented for the sole purpose of functioning as a trademark and have no other meaning than acting as a mark. Fanciful marks are considered to be the strongest type of mark. Examples of fanciful marks are:

EXXON
KODAK
XEROX

Arbitrary marks:

An arbitrary mark utilizes a device having a common meaning that has no relation to the goods or services being sold. Examples of arbitrary marks include:

APPLE (for computers)
LOTUS (for software)
SUN (for computers)

Suggestive marks:

Suggestive marks are marks that suggest a quality or characteristic of the goods and services. Despite the fact that suggestive marks are not as strong as fanciful or arbitrary marks, suggestive marks are far more common due to the inherent marketing advantage of tying a mark to the product in a customer's mind. Suggestive marks are often difficult to distinguish from descriptive marks (described below), since both are intended to refer to the goods and services in question. Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination, thought or perception. Putting this distinction into practice clearly is one of the most difficult and disputed areas of trademark law.

The following marks can be considered suggestive:

MICROSOFT (suggestive of software for microcomputers)
NETSCAPE (suggestive of software which allows traversing the "landscape" of the Internet)
SILICON GRAPHICS (suggestive of graphic oriented computers)



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Descriptive marks:

Descriptive marks (or more properly, "merely descriptive marks") are devices which merely describe the services or goods on which the mark is used. If a device is merely descriptive, it is not a mark at all, since it does not serve to identify the source of the goods or services. No trademark rights are granted to merely descriptive marks. Misdescriptive marks are equally weak. As explained in connection with **suggestive marks** above, descriptive marks are often difficult to distinguish from suggestive marks. Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination, thought or perception. Putting this distinction into practice can be very difficult. Merely descriptive marks can be registered federally on the Supplemental Register.

The following imaginary marks could be considered merely descriptive for computer peripherals:

FAST BAUD for modems (describing the quickness of the modem);
104 KEY for computer keyboards (describing the number of keys on a keyboard);
LIGHT for portable computers (describing the computer's weight); and
TUBELESS for computer monitors (even if misdescriptive for a monitor that contains tubes).

However, it is possible for descriptive marks to "become distinctive" by achieving secondary meaning. Secondary meaning indicates that although the mark is on its face descriptive of the goods or services, consumers recognize the mark as having a source indicating function. Once it can be shown that a descriptive term or phrase has achieved this "second meaning" (the first meaning being the generally understood meaning of the term or phrase), a protectable trademark is developed. Secondary meaning can be achieved through long term use, or large amounts of advertising and publicity. The acquisition of secondary meaning is often proven through the use of consumer surveys, that show that consumers recognize the mark as a brand, such as "FORD", as opposed to a descriptive term, such as "reliable".

Examples of marks which might be considered descriptive but have clearly developed secondary meaning include:

SHARP for televisions;
DIGITAL for computers;
WINDOWS for windowing software;
INTERNATIONAL BUSINESS MACHINES for computers and other business machines; and
POWER COMPUTING for computers based on the Power PC chip.

Surnames:

Marks that are primarily surnames (such as "SMITH SHOES" or "RODRIGUEZ COMPUTERS") are treated the same as descriptive marks under U.S. trademark law. As a result, surnames are not given protection as trademark until they achieve secondary meaning through advertising or long use. A trademark is "primarily a surname" if the public would recognize it first as a surname, or if it consists of a surname and other material that is not registrable.

Once a surname achieves secondary meaning, the mark is protectable as a trademark. Others cannot use the mark on confusingly similar goods, even if they have the same name. Thus, Jane McDonald could not open a restaurant called "MCDONALDS", nor could Joel Hyatt open a motel under the name "HYATT MOTEL", since the marks MCDONALDS and HYATT have achieved secondary meaning.

Generic "marks":

Generic "marks" are devices which actually name a product and are incapable of functioning as a trademark. Unlike descriptive marks, generic devices will not become a trademark even if they are advertised so heavily that secondary meaning can be proven in the mind of consumers. The rationale for creating the category of generic marks is that no manufacturer or service provider should be given exclusive right to use words that generically identify a product.

A valid trademark can become generic if the consuming public misuses the mark sufficiently for the mark to become the generic name for the product. The prime examples of former trademarks that became the generic name for a product are



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ASPIRIN and CELLOPHANE. Current trademarks that were once considered to be candidates for becoming generic are XEROX and KLEENEX. XEROX has spent a great deal of advertising money to prevent misuse of its mark. By doing so, XEROX has likely avoiding the loss of its trademark.

The following words and phrases can be considered generic and therefore are incapable of functioning as a trademark:

MODEM
WWW
E-MAIL

There are a lot of fine lines to consider when evaluating the strength of a trademark, especially when determining if a trademark is suggestive, descriptive or generic. Even the best trademark experts will disagree on this very subjective topic. Although analysis and expertise are required to determine trademark strength, there are some general guidelines one can follow.

A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it conveys an immediate idea as to the ingredients, qualities or characteristics of the goods. A term is generic if it has significance to the public as the principal name for something.

Can the Federal or State Trademark Office refuse to register a mark?

Yes. The Office will refuse to register matter if it does not function as a trademark. Not all words, names, symbols or devices function as trademarks. For example, matter which is merely the generic name of the goods on which it is used cannot be registered.

Additionally, Section 2 of the US Trademark Act (15 U.S.C. §1052) contains several of the most common (though not the only) grounds for refusing registration. The grounds for refusal under Section 2 may be summarized as:

the proposed mark consists of or comprises immoral, deceptive, or scandalous matter;

the proposed mark may disparage or falsely suggest a connection with persons (living or dead), institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

the proposed mark consists of or comprises the flag or coat of arms, or other insignia of the United States, or of any State or municipality, or of any foreign nation;

the proposed mark consists of or comprises a name, portrait or signature identifying a particular living individual, except by that individual's written consent; or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow;

the proposed mark so resembles a mark already registered in the Patent and Trademark Office (PTO) that use of the mark on applicant's goods or services are likely to cause confusion, mistake, or deception;

the proposed mark is merely descriptive or deceptively misdescriptive of applicant's goods or services;

the proposed mark is primarily geographically descriptive or deceptively geographically misdescriptive of applicant's goods or services;

the proposed mark is primarily merely a surname; and

matter that, as a whole, is functional.

How can I be sure that someone else isn't already using my proposed trademark on similar goods or services?

By researching your proposed mark and running a comprehensive trademark search. Although there is no guarantee, taking these steps will help you determine if it can be adopted and used without infringing on someone else's rights.

Whether clearing a mark or protecting an existing mark, how is trademark infringement determined?

Infringement occurs when the marks used on two respective goods are likely to cause confusion, mistake or deception with regard to source, affiliation or sponsorship. Because Trademark Law is a way to proactively prevent consumer confusion, actual confusion is not necessary to claim infringement, just the likelihood of confusion.

There may also be the possibility of a dilution action either under Federal law or the laws of several states. As defined by Section 45 of the US Trademark Act, "the term 'dilution' means the lessening of the capacity of a famous mark to identify and



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distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties OR (2) likelihood of confusion, mistake or deception.” Determining whether dilution exists is a very complex aspect of trademark law.

What are some tests for likelihood of confusion?

- Similarity between trademarks in appearance, sound, and/or meaning. (e.g., “RAID” vs. “RAZE” for insecticide or EASY SPRAY vs. EZ SPRAY for window spray or HURRICANE vs. CYCLONE for fencing)
- Similarity between goods/services (e.g., breakfast cereal vs. breakfast bars).
- Marketing environment or channels of trade. Does one user sell exclusively at retail and the other exclusively to commercial buyers?
- Strength of senior trademark. BETTY CROCKER/COKE/MCDONALDS, for instance, are so well known that use of these trademarks even in unrelated areas is likely to be damaging.
- Likelihood of a senior trademark expanding into the product category of a junior trademark. (e.g., women’s apparel vs. women’s shoes)
- Intent of a junior trademark user’s adoption. (e.g., knowingly adopting a trademark to benefit from the reputation of a well-known trademark)
- Buyer sophistication. Are the goods inexpensive and purchased with little thought, or are they expensive and therefore warrant careful consideration with regard to purchasing?

How long does it take for a mark to be registered with the US Trademark Office?

It is difficult to predict how long it will take for an application to mature into a registration, because there are so many factors that can affect the process. When an application is submitted for filing, the USPTO receives it and issues a confirmation of filing that includes the date of receipt and a summary of the submission. This confirmation is evidence of filing should any question arise as to the filing date of the document. However, the total time for an application to be processed may be anywhere from almost a year to several years, depending on the basis for filing, and the legal issues which may arise in the examination of the application. [Current status information on trademark applications and registrations may be obtained by calling Allstate Corporate Services at 1-800-906-9220 and requesting a status check.](#)

How do I know if my trademark application has passed through the examination process?

Examining attorneys and paralegals at the Trademark Office examine both the use-based and ITU (intent-to-use) applications for technical and substantive problems. The attorneys determine factors such as: whether any conflicts exist on the register; if the trademark is merely descriptive; and if the description of goods and the classification are properly set forth.

You will receive a Notice of Publication from the Trademark Office if no issues are found by the examining attorney. However, if there is an issue, you will receive an Office Action from the Trademark Office stating the concerns of the examining attorney. If you would like us to and we are able to respond, our fee to do so is \$225.00. A reply must be made to the examining attorney within six months from the mailing date of the Office Action. The absence of a response will result in the loss of the application. If the response is not satisfactory to the examining attorney, further Office Actions can be issued. Upon a satisfactory response to the examining attorney, the application will be published for opposition. If a satisfactory response to an issue is not achieved, the application may be finally rejected.

What is meant by Published for Opposition?

Printed materials like the Official Gazette inform the public of applications for trademark registration with the United States Patent and Trademark Office (USPTO) and offer third parties an opportunity to stop registration of a published trademark by filing a notice of opposition. This review of trademark application publications is called policing. Many companies use trademark watching services as offered by Allstate Corporate Services to police Official Gazettes and other publications throughout the world. In the U.S. there is a 30-day deadline beyond the publication date to file an opposition or obtain an extension of time to file the opposition.



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Once registered, do trademark rights last forever?

NO. Since Federal trademark rights are based on use, a Registrant must inform the U.S. Trademark Office from time to time through Section 8 Affidavit and renewal filings of its continued use of the mark in order to maintain its registration and eliminate “dead wood” in the Trademark Office.

What is a Section 8 Affidavit of Use?

A Section 8 Affidavit of Use is a verified statement attesting to the continued use of a mark. In other words, the registrant affirms that the trademark is being used in commerce in connection with all or some of the goods and services specified in the original registration.

When does the Section 8 Affidavit of Use need to be filed?

A one-time Section 8 Affidavit has a deadline of the sixth anniversary after the issuance of the registration. This filing can occur at any time after the five-year mark. A Section 8 Affidavit must also be filed ten years from the initial registration date as well as all subsequent ten-year periods throughout the life of the registration. This filing can occur at any time after the nine-year mark, ending at the ten-year mark of each ten-year increment. An example of the trademark being used must accompany the affidavit. Failure to file the Section 8 Affidavit will result in cancellation of the federal registration. The filing fee is currently \$100 per class. A 6-month grace period is granted over the six-year and ten-year deadlines at an additional cost of \$100 per class.

What is a Section 9 renewal?

It is a request for renewal, filed every ten years from the registration date. Remember, if a Section 8 is also not filed, the Section 9 renewal will not be accepted. Therefore, the Section 8 is typically filed along with the Section 9. The filing fee is currently \$400 per class. A six-month grace period is granted over the ten-year deadline at an additional cost of \$100 per class. Failure to file the Section 9 renewal will result in cancellation of the federal registration. The combined Section 8 & 9 renewal filing fee is currently \$500 per class.

Are there any other documents that I am required to file?

NO. However, at any time after the mark has been used continuously for a five-year period, the registrant has the option to file an affidavit of incontestability—referred to as the Section 15 Affidavit. With the Section 15 Affidavit the validity of the registration becomes incontestable, making it immune from most challenges. The filing fee is currently \$200 per class.

Do other documents affecting the Trademark’s title of ownership need to be filed?

Yes. If the transaction is an assignment involving applications or registrations, such a transaction should be made a matter of record in the Trademark Office to avoid complications when subsequent filings with the Trademark Office are made. In other words, disruption in the chain of title will require explanation and a recording of the assignment in order to obtain and/or maintain the registration. As with assignments, if a name change, a merger or state of incorporation has changed the status of the owner, the document should be recorded. This step keeps the chain of title clear.

Allstate Corporate Services can assist in filing any and all documents with the US Federal and/or State Trademark Office. Please contact us for details at 800-906-9220 or email info@AllstateCorporateServices.com

What resources are available for watching (policing) my marks against infringement?

Allstate Corporate Services offers a comprehensive range of trademark and domain name monitoring services that will notify you of potentially confusingly similar trademarks that have been filed and/or published for opposition at the Trademark Office and Web Domain names being registered that may pose a threat or weakness to your trademark. Please contact us for details at 800-906-9220 or email info@AllstateCorporateServices.com



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What is the risk of not policing my marks?

If not done or done too little, your mark can be weakened and its value diminished which can possibly result in a loss of rights.

Why is it important to use trademarks properly?

Misuse of a trademark diminishes its strength. Loss of distinctiveness can result in marks becoming public domain. The term "genericide" is used to reflect that a trademark has become the generic term for the goods or services.

What are the rules of thumb for using a trademark properly?

Trademarks are adjectives—not nouns or verbs. A trademark is not a thing or a kind of thing. It is a brand for a thing.

Example: Make a Polaroid® picture, NOT take a Polaroid.

Suggestions:

- Follow a trademark by its generic name (Kleenex® tissues)
- Place a ™ or ® next to a trademark (Kleenex® tissues)
- Follow a trademark with brand (Kleenex® brand tissues)

DO: "Polaroid® cameras are fun!"

DON'T: "A Polaroid® is fun."

DO: HUNGRY JACK syrup is thick.

DON'T: HUNGRY JACK is a thick syrup.

The proper use of marks is crucial, in any campaign to acquire, register, or maintain them. Proper use preserves a mark's ability to identify the origin of products or services, and increases the mark's potential for "secondary meaning." Proper use minimizes the likelihood that a mark will become generic, or be abandoned, unintentionally, by its rightful owner. Proper use also strengthens trademark registrations, and overcomes defenses raised in trademark litigation. The most compelling point to remember is that trademark rights are *based* upon use. For this reason alone, anyone who cares about her mark, will want to use it properly, and will want others to do so as well.

The following guidelines for proper trademark use apply equally to business documents; correspondence; advertisements; promotional material; displays; packaging; product labels; signs; dictionaries; Web pages, and other media, containing, discussing, or describing, marks. This listing is not exhaustive -- contact a qualified trademark attorney for information tailored to your trademark situation.

Give Notice of Your Trademark Rights

Providing public notice of trademark rights is important, for registered and unregistered marks alike. The failure to display proper notice of registration, or notice of unregistered trademark rights, is a common mistake, yet the easiest to correct and avoid.

The appropriate form of notice to employ, depends on whether the mark is registered with the United States Patent & Trademark Office ("PTO").

Registration Notices:

There are three ways to give notice that a mark is registered with the PTO:

Use the symbol, "®;"

Use the legend, "Registered, U.S. Patent and Trademark Office," or

Use the abbreviation, "Reg. U.S. Pat. & Tm. Off."

Failure to employ one of these notices, each time a federally registered mark is used, may hinder the prosecution of a trademark infringement action, by allowing the wrongdoer to claim "innocent infringement" as a defense. If proper notice is not



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employed, and displayed prominently, the infringer may claim ignorance of trademark rights, and damages available to the trademark owner may be reduced.

In other countries, permissible notice forms differ from those used in the above-examples. Consult qualified trademark counsel for the form appropriate to your target country, *before* preparing labels, advertisements, packaging, or displays with trademark information.

Notices of Rights in Unregistered Marks:

The registered symbol, "®," the legend "Registered, U.S. Patent and Trademark Office," and the abbreviation, "Reg. U.S. Pat. & Tm. Off.," should be used only on, and in connection with, marks registered with the PTO. The use of these notices on unregistered marks is a crime, punishable by fines and/or imprisonment.

Technically, providing notice of rights in unregistered marks is optional, but the prevailing wisdom is that such notice should be employed. Such notice is consistent with the rationale underlying proper trademark use, and enhances a mark's source-identifying function. Notice of rights in an unregistered mark, consists of one of the following notations, usually appearing above, and to the right of, the mark in which rights are asserted: (TM) for an unregistered trademark; and, (SM) or (TM) for an unregistered service mark.

Use Your Mark As An Adjective

Marks are adjectives, and should be used only as such. Marks never should be used as nouns or verbs. Nor should marks be pluralized, or used in the possessive form. Non-adjectival uses of marks, over time, can result in genericness, or a finding of unintentional abandonment -- even when such use emanates from the public, rather than a trademark owner. For this reason, the owners of marks such as *Coke®*, *Kleenex®*, *Xerox®*, and *FedEx®*, expend considerable efforts to educate the public concerning the proper use of marks.

One way to ensure that a mark is used in proper adjectival context, is to follow each use with the generic noun for the product identified. For example, generic terms for the trademarked products and services mentioned in the preceding paragraph, are "soft drink," "facial tissue," "photocopier," and "overnight courier service." Using these terms after the marks, makes them adjectives, rather than nouns. Using the word, "brand," after a mark, and before the generic product name, further guards against non-adjectival use.

Use Your Mark Distinctively

Marks should be used in ways that distinguish them from surrounding text. The use of trademark notices, generic terms, and "brand," in connection with marks, helps differentiate marks from generic terms. However, marks also should be CAPITALIZED, underlined, *italicized*, placed in "quotation marks," or depicted in **boldface** type, whenever they appear in printed or electronic media. The goal is not just to avoid genericness and abandonment, but to create a distinct commercial impression in the minds of consumers regarding a mark, and the products, services, and business it represents.

Combining a logo with a word mark, can enhance, or create, a distinctive commercial impression, and sometimes can distinguish two similar word marks from one another. In some cases, where a relatively descriptive word mark is selected, registration may be obtained by joining a distinctive logo with the common or partially-descriptive term. Such registrations generally do not cover the descriptive portion of the mark, but protect the logo, and the mark viewed as a whole. The strongest marks are those that are distinctive, and those trademark owners use distinctively.



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Affix Your Mark to Goods and Services

Not all product nicknames, business slogans, and broadcast advertising phrases are trademarks and service marks. In order for trademark rights to be created and maintained, a mark must be *affixed* to a specific product, or used in the provision of a particular service. Marks cannot discharge their source-identifying duties, if they cannot be seen on products, or with services.

Trademarks are "affixed" by applying them directly to a product, to containers in which the product is packaged, or to tags or labels attached to the product. Service marks are "affixed" by using them in signs and other advertisements offering the services, and on letterhead and invoices through which the services are provided. As a general rule, a mark is not a mark until it has been *affixed*!

License With Care

Trademark law frowns upon "naked licensing." Fortunately for trademark owners, "naked licensing" is not as fun as it sounds. "Naked licensing" occurs when third-parties are allowed to use a trademark without restriction; when the quality of goods or services provided under a mark by third-parties is not controlled, or when rights in a mark are assigned, in whole or part, without the goodwill of the business symbolized by the mark. Naked licensing severs a mark from its source-identifying function, and thus results in the loss of trademark rights through abandonment.

Authorized third-party uses of a mark should be licensed, and all licensing agreements should be written carefully, signed, and enforced. The agreement must set standards concerning the licensee's use of the mark, and the quality of products or services with which the mark will be used.

Some trademark owners omit these formalities, due to the nature of their relationship with a particular "licensee." A parent company may not see the need to license trademarks to its subsidiary. A business owner may not realize the importance of licensing marks to a nephew, opening a branch of the business in another locale. What each fails to consider is that trademark law is not based upon an owner's right to use a mark in any manner she wishes. Trademark law is designed to protect *consumers* from confusion regarding the source or origin of products and services. If the parent company or franchise owner engages in conduct that makes such confusion likely, trademark rights may be abandoned -- perhaps even to the subsidiary or franchisee! Naked licensing, and other informal licensing arrangements, contribute to such confusion, and are not good for marks.

Examples of Trademarks

A trademark is a device which can take almost any form, as long as it is capable of identifying and distinguishing specific goods or services. The best way to understand the types of devices available is through actual examples. The following examples are divided as follows: [letters and words](#), [logos](#), [pictures](#), [a combination of words and a logo](#), [slogans](#), [colors](#), [product shapes and sounds](#).

Letters and words:

A word or other groupings of letters is the most common type of mark. Examples include:

APPLE
SILICON GRAPHICS
NETSCAPE
IBM
NBC



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Logos:

Logos are probably the next most common form of mark. A logo can be described as a design which becomes a mark when used in close association with the goods or services being marketed. The logo mark does not need to be elaborate; it need only distinguish goods and services sold under the mark from other goods and services. Examples of logo marks are:

McDonald's double arches



NBC's peacock style design



Apple Computer's Apple



Pictures or drawings:

Pictures or drawings of a character or scene are often used as trademarks or service marks.

Apple's Automator



Corning's Pink Panther





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Sun Microcomputer, Inc.'s Duke



MSN's Butterfly



Combination:

Or a trademark might be a combination of letters and a design, such as:



Slogans:

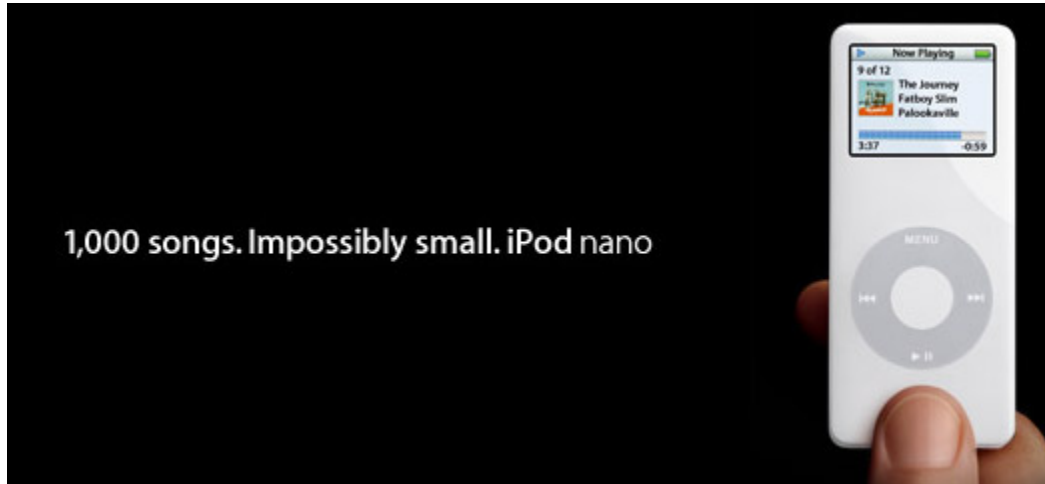
Slogans from advertising campaigns are also used as trademarks. Example slogans which have strong trademark rights attached to them are:





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Color marks:

The color of an item can also function as a trademark. The Supreme Court held in the 1995 case of *Qualitex Co. v. Jacobson Products Co.*, 115 S.Ct. 1300 (1995) that the green-gold color of a dry cleaning press pad can function as a trademark. Before this decision, the argument was often made that color alone could not be considered a trademark, since granting trademark status to colors would soon lead to the depletion of the number of colors available for an object. The Court in *Qualitex* rejected arguments based on this depletion theory, reasoning that alternative colors would usually be available for competitors. In those cases where alternative colors were not available, courts could deny trademark protection in those circumstances where color depletion may actually occur.

In order for a color to be considered a trademark, the owner must show that secondary meaning has been developed for the color. In addition, a color cannot be a trademark if the color is functional in nature. For example, one court has held that the color black serves a functional purpose when used on outboard boat motors, since the color black matches all other boat colors and also makes the motor appear smaller. A second court, however, has stated that it is possible for a color to function as a trademark even if the color contributes to the utilitarian or aesthetic function of a product. A second example of a color mark is the color pink for Owens-Corning's fiberglass insulation.

Product shape:

A product or container shape can also serve a source identifying function and therefore can be an enforceable trademark. A product or container shape may also be subject to a design patent. Historically, trademark protection was not granted to product shapes until the consuming public recognized the shape as indicating the source of the product. In other words, the product shape was required to obtain secondary meaning. However, recent court decisions may mean that an inherently distinctive product shape can be a protectable trademark even before secondary meaning is obtained. Examples of product shapes and configurations that likely enjoy trademark status include:



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The Coca Cola bottle



Apple's iPod



Sound marks:

A sound can also be a trademark or a service mark. The three tone chime of NBC has been registered as a service mark. Sound trademarks recently were in the news when Harley-Davidson announced that it was attempting to register the exhaust sound of a Harley- Davidson motorcycle with the U.S. Patent and Trademark Office (USPTO). Harley-Davidson was reacting to moves by competitors to duplicate the Harley sound in competing motorcycles. Hearings in front of the USPTO have been scheduled to determine whether Harley-Davidson can register the sound.