

Trademark Applications: Drafting the Application

A Lexis Practice Advisor® Practice Note by Peter S. Sloane and Michelle J. Levin, Leason Ellis LLP



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This practice note provides guidance on drafting and filing U.S. trademark applications. Topics covered include the types of application forms available (TEAS Regular, TEAS Reduced Fee, TEAS Plus), who may file the application, the form of the applied-for mark (standard character, stylized or design mark, sound or color mark), the identification of goods/services, the filing basis (use in commerce, intent-to-use, country of origin registration, priority of a foreign application), designation of domestic representatives, and the required declaration.

Most applicants seek to register their marks on the Principal Register, which provides greater protection than the Supplemental Register. For more information on the differences between the two Registers, see [Principal vs. Supplemental Register](#). For a checklist detailing the necessary steps for filing a trademark application, see [Trademark Application Checklist](#). For guidance on the examination process that follows the filing of an application, see [Trademark Examination Process](#).

Note that effective August 2019, all foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented by an attorney licensed to practice law in the United States in all trademark matters. This includes the initial application. Additionally, effective December 21, 2019, all trademark submissions (including applications and documents concerning applications) must be filed electronically, with limited exceptions. See [Changes to the Trademark Rules of Practice to Mandate Electronic Filing](#), 84 FR 52363 (Oct. 2, 2019).

Application Forms

Effective December 21, 2019, the U.S. Patent and Trademark Office (USPTO) will require trademark applications to be electronically filed through the USPTO's [Trademark Electronic Application System](#) (TEAS), with limited exceptions. The relevant forms are listed under "Initial Application Forms" and include:

- TEAS Regular (will no longer exist in October 2019)
- TEAS Reduced Fee (TEAS RF, to be renamed TEAS Standard in October 2019)
- TEAS Plus

Currently, to obtain a filing date, a TEAS Regular application must include the name of the applicant, a name and address for correspondence, a clear drawing of the mark, a listing of the goods/services, and a filing fee. The filing fee for a TEAS Regular application is \$400 per class of goods and/or services.

If the applicant can satisfy the TEAS Regular requirements, the USPTO offers a reduced fee (\$275 per class of goods and/or services) if the applicant files a TEAS RF application.

The applicant must agree to file the application and related submissions electronically and authorize e-mail communication with the USPTO. (Once the rule changes take effect in October 2019, this will become the default filing option and be renamed TEAS Standard. The filing fee will remain at \$275 per class.)

If the applicant can satisfy the TEAS RF requirements, the USPTO offers an even lower filing fee (\$225 per class of goods and/or services) if the applicant files a TEAS Plus application. The applicant must agree to file a “complete” application (where almost all fields are mandatory) and to use the Acceptable Identification of Goods and Services Manual (ID Manual) to specify goods and/or services. This form is a good choice where the application is simple and the goods and/or services are short. (This filing option will remain the same when the rule changes take effect.)

For more on the ID Manual and specification requirements, see Identification of Goods/Services and Classification below.

Identity of Applicant

Applications should be filed in the name of the trademark owner, which is usually the person or entity using or intending to use the mark. Generally speaking, absent agreement to the contrary, agents, distributors, and licensees should not be designated as the applicant, as they are not usually the owners of the mark. For example, if the client is the U.S. distributor of a foreign manufacturer, you should ask whether the client has written permission to apply to register the mark in its own name or whether the foreign manufacturer should be listed as the owner.

If the applicant is an individual, identify the applicant’s:

- Name
- Domicile address
- Country of citizenship
- Email address (effective Dec. 21, 2019)

If the applicant is an entity, identify the entity’s:

- Name
- Principal place of business
- Entity type (e.g., corporation, limited liability company, partnership)
- Jurisdiction of organization (usually state or nation)
- Email address (effective Dec. 21, 2019)
- The names and citizenship of general partners (if applicant is a domestic partnership)

- The names and citizenship of the active members of the joint venture (if applicant is a domestic joint venture)
- The state of organization and the name and citizenship of the sole proprietor (if applicant is a sole proprietorship)

Whether or not to file in the name of an individual or an entity is often a matter of corporate and tax law rather than trademark law.

For companies and organizations in the United States, it is usually a good idea to check the online records of the relevant Secretary of State before filing to make sure that the applicant exists and is active (an application may be void if the wrong party is identified). Most all Secretaries of State have user-friendly websites that make searching for entities and their status quick and easy.

Form of Applied-for Mark

One of the most important decisions to make when filing a trademark application is the form of the applied-for mark, as the protection afforded the resulting registration depends greatly on the chosen form. The mark can consist of:

- Standard characters (i.e., typed form or block letters)
- Stylized letters
- A design
- A sound or color

Trade dress (i.e., product configuration or packaging) falls under the design mark designation. For a more detailed discussion on trade dress, see [Trade Dress Fundamentals](#).

A standard character mark can be displayed in capital letters, lower case letters, numbers, or a combination thereof. Standard character marks are afforded the broadest protection; the words, letters, and/or numbers of such marks are protected in any stylized font or as part of any design.

Given this level of protection, an applicant should apply to register a mark in stylized form or as part of a design only if the stylization or design is an important component of the mark. For example, The Coca-Cola Company protects its mark COCA-COLA in its well-known script font because the stylization is an important part of the brand.

Another issue to consider is whether a stylization or design will change down the road. This is relevant because to maintain the registration obtained, the registrant will need to prove use of the mark in substantially the same form between the fifth and sixth year after registration (and every ten years from the date of registration). Thus, if the font or design is likely to change, it may be prudent to file for the mark in

standard characters. (For more on maintenance obligations, see [Trademark Registrations: Maintenance and Renewal](#).)

Where the mark is shown in stylized letters or as a design, you must submit the proposed mark in a .jpg file, and if such a mark includes a word, letter, or number, you must enter the “literal” element of the mark (i.e., the actual wording, lettering, or numbering). For design marks, you must also submit a description of the significant features of the mark. For example, Nike may describe the NIKE and Swoosh Design as follows: “the mark consists of the term NIKE above a wing design.”

Applicants for design marks must also consider whether to file the applied-for mark in color or in black and white. The protection of a color mark is limited to the color(s) identified in the application, whereas a black and white mark protects use of the mark in any color. Thus, applicants should file in color only if color is an important feature of the mark. If the applicant claims color, you must:

- Submit a color image of the drawing in .jpg format
- Identify the color(s) by their generic names
- Indicate where the color(s) appear in the mark

Otherwise, the image submitted must be a clear black-and-white drawing.

Note that an applicant may wish to file more than one application to cover a mark in different forms. For example, Nike, Inc. owns registrations for the mark NIKE, NIKE with the famous Swoosh design, and the Swoosh design on its own. This approach provides protection for each separate element and provides the owner with greater flexibility to change its design in the future without fear of losing all registered rights.

Additional Statements

Once the mark is identified, it is possible to enter additional statements regarding the mark such as:

- A disclaimer of descriptive elements
- Translation of foreign words
- Ownership of a prior registration

For example, if an applicant is applying to register the mark ZENITH PRINTERS for computer printers, it should offer to disclaim exclusive rights to the word “printers” apart from the overall mark. Or if the mark refers to the name of someone now deceased, the applicant should indicate that the mark does not identify any living individual.

While an applicant is not required to enter any statements at the time of filing, including such a statement (if applicable) may help to avoid an unnecessary Office Action during examination.

Identification of Goods/ Services and Classification

The application must identify the goods and services offered or intended to be offered under the mark. An applicant may wish to identify the goods or services broadly for two main reasons:

- To increase the scope of protection of the mark
- The USPTO does not allow amendments that broaden the original identification of goods and services (only amendments that narrow or clarify them)

However, the USPTO ultimately requires the goods and services to be described with specificity, and frequently requests amendments that provide for such specificity. For example, while it is permissible to identify “clothing” in an initial application, the USPTO would generally require the applicant to itemize the specific types of clothing (e.g., t-shirts and pants) before approving the application for registration.

Also bear in mind that it is not necessary to identify each and every item provided or intended to be provided under the mark in order to adequately protect the mark. Under the “related goods” doctrine in U.S. trademark law, the mark would receive protection for those goods and services which are closely related to the ones included in the application. For example, an application including t-shirts would likely protect use of the mark in connection with long sleeve shirts, but not in connection with mobile devices.

Indeed, the broader the identification of goods or services, the greater the risk of encountering conflict with third-party marks (i.e., the greater the chance that the goods or services may be considered related to those covered by confusingly similar marks). Thus, a trademark search is recommended prior to filing in order to develop a filing strategy which balances broadened protection with the risk of objection by the Examining Attorney and/or a third party.

For guidance on trademark searches, see [Trademark Clearance Searches](#), [Trademark Clearance Search Checklist](#), and [Trademark Clearance Search Questionnaire](#).

Note that it is improper to designate ancillary goods or services intended for one’s own use. For instance, if a company offers strategic business planning services for

others, it should so identify those services in the application. But if, in the course of providing such planning services, it advertises its own services, it should not include advertising services (advertising services should be limited to advertising agencies and companies providing advertising services to others). Only those goods and services offered to others at arms length in the ordinary course of business should be listed in the application.

ID Manual

To aid applicants and practitioners, the USPTO provides the Acceptable Identification of Goods and Services Manual (ID Manual), a searchable database that compiles a list of approved goods and services. Using this tool helps to avoid a future objection based on lack of specificity. The ID Manual is accessible through the application form, as well as on the USPTO website (available [here](#)).

Though helpful in identifying certain language, use of the ID Manual is not required for TEAS Regular and TEAS RF applications; any desired goods and/or services may be listed. The Examining Attorney will accept the identification if it identifies generic terms and is understandable to the average person. Allowing the applicant to craft its own identification is also beneficial, especially since the ID Manual is not a complete list of accepted terminology.

Note, however, that applicants filing a TEAS Plus form can identify **only** the goods and services listed in the ID Manual, which is a significant restriction for such application forms.

Classification of Goods/Services

The USPTO divides goods and services into 45 different classes; Classes 1–34 cover goods, and Classes 35–45 cover services. For example, computer software and electronics fall in Class 9, clothing is in Class 25, and medical services are in Class 44. Classification is merely for the administrative convenience of the USPTO and does not affect the scope of protection for the mark. For a chart displaying the classes with their corresponding class headings (i.e., the non-exhaustive general descriptions of what goods or services may be found in each particular class), see [Goods and Services Classification Chart](#).

It is often helpful to search the ID Manual when attempting to properly classify the goods and/or services contained in a trademark application, as the ID Manual provides the proper classification for each of its approved terms.

Filing Basis

In order to file an application, you must claim a filing basis. There are four separate filing bases:

- Current use of the mark in U.S. commerce
- Intent-to-use the mark in U.S. commerce
- Country of origin registration (i.e., registration of substantially the same mark in the applicant's country of origin)
- An earlier-filed foreign application (if the U.S. application is filed within six months of the foreign application)

Each filing basis is discussed below.

While it is possible to claim more than one filing basis, certain combinations may unnecessarily complicate the application. For example, combining use and intent-to-use bases may hold up an application while the applicant proves use of the mark for those goods and/or services filed on an intent-to-use basis. This, in turn, may cause the applicant to divide the application down the road, which would lead to more than one registration to maintain.

Use in Commerce

Where the mark is currently used in U.S. commerce (i.e., interstate commerce or foreign commerce with the United States), select “use” as the filing basis, as set forth in Section 1(a) of the Trademark Act. 15 U.S.C. § 1051(a). A mark is “used in commerce” when it is used in the ordinary course of trade on or in connection with goods sold or transported, or services rendered, in U.S. commerce.

Dates of First Use

In order to perfect the use basis, you must identify the date of first use of the mark for any one item in each class of goods/services. For each such item, specify the date the mark was first used:

- Anywhere in the world (e.g., intrastate use or foreign use)
- In U.S. commerce

The exact day of first use is not necessary. The month and year are sufficient if before the current month, and the year is sufficient if before the current year.

For instance, if the goods are porcelain figurines made and first sold in Spain, the date of first use of the mark anywhere would be the date the trademarked goods were first sold in Spain, and the date of first use in U.S. commerce would be the date the goods were first shipped to the United States.

Because trademark rights in the U.S. are based on actual use of the mark, the first use date is frequently used to determine priority (the party that uses a mark first in commerce for specific goods and services will have rights over subsequent users of a confusingly similar mark for related goods and services). Thus, applicants should identify

the earliest date possible for each required first use date. Truthful and accurate dates of first use are imperative, as falsely identifying an earlier date or fabricating use that is not in the ordinary course of trade may constitute fraud on the USPTO (which could result in cancellation of the eventual registration).

Given the importance of the dates of first use, you should recommend that clients maintain business records showing each first use date listed in the application, which could be important evidence if a question of priority arises down the line. For a more detailed discussion on priority, see Gilson on Trademarks § 3.03.

Specimens of Use

You must also submit a current “specimen of use” for any one item in each class of goods and/or services listed in the application and describe each specimen. (Even though only one specimen per class is required, some attorneys ask their clients for specimens for each separate good or service so as to reduce the possibility of over-claiming.)

For goods, the specimen may consist of materials such as photographs or photocopies showing the mark as applied directly to the goods or to their packaging, labeling, or tags. For services, the specimen may consist of advertising or promotional materials. Importantly, advertising or promotional material is usually not considered a proper specimen of use for goods. The specimen may be submitted as a .jpg or .pdf file.

The specimen of use must be “current.” Apply a rule of reason in deciding whether or not the specimen is sufficiently current. Greater latitude in time is granted to expensive products and services which are only infrequently sold or rendered.

Intent-to-Use

When the mark is not currently in use, an applicant may nonetheless file an application on an “intent-to-use” basis pursuant to Section 1(b) of the Trademark Act. 15 U.S.C. § 1051(b). This means that the applicant has a bona fide (i.e., genuine) intention to use the mark in U.S. commerce for the goods or services identified in the application. An absence of such an intent may subject the application or resulting registration to attack by others on the ground of fraud upon the USPTO.

To illustrate, if an individual is starting a new distillery called CRYSTALLINE, it should file an intent-to-use application for a broad category of goods like liquors. It can later amend the identification of goods to cover specific spirits it is likely to

sell, such as vodka or gin. However, even though the goods are related, it should not identify items which it is unlikely to sell, like beer.

Filing an intent-to-use application is beneficial because it puts the world on notice that the applicant intends to use the mark (and thus that others should not adopt a confusingly similar mark). Additionally, the filing date of an intent-to-use application constitutes constructive first use of the mark, thus providing an applicant with an earlier priority date (i.e., earlier than the actual first use date) upon which it may rely in actions against confusingly similar marks.

(Note that if an intent-to-use basis is selected but it turns out the applicant could have filed the application based upon use, it is possible to later file an [Amendment to Allege Use](#), discussed below, and claim an earlier use date. This is often helpful in situations where an exact first use date is difficult to determine at the time of filing an application, but where an applicant wants to file quickly.)

When filing on an intent-to-use basis, the applicant must eventually use the mark in commerce and submit proof of use before the registration will issue. To prove use, applicant must submit a specimen of use and indicate the dates of first use for any one item in each class of goods and/or services. For more on these requirements, see “Use in Commerce” above.

Depending on whether applicant submits this information before or after the [Notice of Allowance](#) issues, the form is called either:

- An [Amendment to Allege Use](#) (before Notice of Allowance)
- A [Statement of Use](#) (after Notice of Allowance)

The required fee for both forms is \$100 per class (if filed electronically).

After the Notice of Allowance issues, applicant has three years to prove use of the mark, provided that the necessary extensions of time and additional fees are filed every six months. The fee for each extension request is \$125 per class (if filed electronically).

Bear in mind that an intent-to-use application should not be assigned before filing proof of use unless the portion of the business related to the mark, if ongoing and existing, is assigned as well. This limitation is intended to prevent so-called trafficking in trademarks. For more on this issue, see “Assignment of Intent-to-Use-Based Trademark Applications” in [Assignments of Trademarks – Express Assignment of U.S. Trademarks](#). For a more detailed discussion on intent-to-use applications generally, see [Intent-to-Use Trademark Applications: Allowance and Issuance](#).

Country of Origin Registration

Under Section 44(e) of the Trademark Act, a foreign applicant can obtain registration in the United States based on its registration of substantially the same mark in its “country of origin.” 15 U.S.C. § 1126(e). An applicant’s country of origin is any country in which the applicant:

- Has a bona fide and effective industrial or commercial establishment
- Is domiciled
- Is a national

The mark in the U.S. application must be substantially the same as the mark in the foreign registration and the scope of the goods/services in the U.S. application cannot exceed the scope of the goods/services in the foreign registration (though they can be narrower) unless the applicant is relying on another filing basis.

To claim the country of origin filing basis, an applicant must submit:

- A copy of the foreign registration certificate
- A translation (if not in English)

Unlike the use or intent-to-use bases, applicants claiming a valid country of origin basis need not prove use of the mark in the United States before the registration will issue. However, even if goods or services are covered by the foreign registration, an applicant must still have a bona fide intent to use the mark for such goods or services in U.S. commerce. Otherwise, the application or resulting registration may be vulnerable to attack by others based upon fraud on the USPTO.

Additionally, there is a notable disadvantage to relying upon the country of origin basis: unless use of the mark in U.S. commerce is claimed as an additional registration basis, no use information will appear in the registration certificate when it issues. This may cause others who come upon the registration in search reports to discount the value of the mark to the registrant. Put another way, others may be more reluctant to adopt a confusingly similar mark if they believe that the registrant is commercializing its mark in the United States. Thus, although it adds some complication, if an applicant can claim use of the mark in commerce, it may wish to consider doing so instead of, or in addition to, the country of origin basis.

For more information on Section 44(e) applications, see Gilson on Trademarks § 3.04[8].

Earlier-Filed Foreign Application (Priority)

In certain circumstances, pursuant to Section 44(d) of the Trademark Act, a U.S. application may be entitled to receive the benefit of the filing date of an earlier-filed foreign application if the U.S. application is filed within six months of the foreign filing. 15 U.S.C. § 1126(d). This could be advantageous in priority disputes with others, giving the applicant an earlier date upon which to rely when determining which party has prior trademark rights.

The requirements for claiming priority under Section 44(d) include:

- The mark in the U.S. application must be a substantially exact representation of the mark in the foreign application.
- The goods/services in the U.S. application must be covered by the foreign application (they can be narrower than those identified in the foreign application but not broader, unless the applicant relies on another filing basis).
- The foreign application must be the first-filed application for the same mark for the same goods or services anywhere in the world.

As long as these requirements are met at the time of filing, an applicant can retain the earlier priority date in the United States, even if the foreign application is later abandoned.

Note that while applicants may claim priority as a **filing** basis, before the Examining Attorney approves an application for publication, they will also be required to identify a **registration** basis (use in commerce, intent-to-use, or country of origin registration). Thus, to avoid an objection from the Examining Attorney, it may be wise to combine the priority filing basis with a basis for registration when filing the U.S. application. Multiple bases are permitted.

For instance, the priority filing basis is frequently combined with the country of origin basis. Note, however, that this strategy could delay registration of the U.S. application, as the Examining Attorney will suspend further action in the U.S. application pending receipt of the home country registration (which may not have registered yet). Thus, it may not make sense to claim priority under Section 44(d) if the difference in time between the foreign application and the U.S. application is very short.

For more information on Section 44(d) applications, see Gilson on Trademarks § 3.04[8].

Correspondence Information; Domestic Representative

Effective December 21, 2019, both the applicant's email address and its attorney's email address must be provided for correspondence purposes, along with the attorney's name and postal address (if applicant is represented by a qualified practitioner). Usually, in addition to their own email address, attorneys will also identify a firm email address dedicated to tracking trademark-related correspondence (such as `tmdocket@firmname.com`). Be sure to put in a file reference number to make it easier to find the client's file when receiving correspondence from the USPTO.

If an applicant is not domiciled in the United States, the applicant may designate a domestic representative (i.e., a person residing in the United States on whom notices or process in proceedings affecting the mark may be served). The USPTO encourages such applicants to designate domestic representatives, but it is not mandatory.

If a domestic representative is designated, you must identify the representative's name, email address, and postal address. The designation must also be signed pursuant to 37 C.F.R. § 2.193(e)(8). Most attorneys designate themselves as domestic representatives when applicants are located outside the United States.

Declaration

The application must include a sworn declaration verifying that the information in the application is true and correct. Falsities in the declaration are punishable by penalty of perjury and may affect the validity of the application or resulting registration.

For example, the declaration for an intent-to-use application would verify that the applicant claims a bona fide intent to

use the mark in U.S. commerce for all identified goods and services. If the applicant lacks such a bona fide intent, the application or resulting registration could be attacked by others on the ground of fraud upon the USPTO. This could result in the application or registration being declared invalid in whole or in part.

The declaration must be signed by the trademark owner or by someone authorized to sign on the owner's behalf, namely:

- Someone with authority to bind the owner (such as a corporate officer or partner)
- Someone with first-hand knowledge of the facts and actual or implied authority to act on the owner's behalf
- The owner's attorney (if the attorney has actual written or verbal power of attorney or an implied power of attorney from the owner)

The declaration may be signed directly, e-mailed as a text form to a second party for signature, printed for handwritten pen-and-ink signature, or submitted unsigned.

While attorneys are permitted to sign for their applicant clients, some attorneys prefer to have clients sign the declaration to ensure the accuracy of the information in the application and to avoid the risk of becoming a fact witness in the event of a dispute. Other attorneys take a middle of the road approach, signing declarations for intent-to-use applications and applications based upon priority or a foreign registration (but having clients sign where use is claimed).

If signing on behalf of a client, it is good practice to have some form of written confirmation from the client (e.g., an e-mail regarding its first use of the mark or its bona fide intent to use the mark) to maintain in the attorney's file.

Peter S. Sloane, Partner, Leason Ellis LLP

A partner at Leason Ellis LLP, Peter Sloane counsels clients, prosecutes trademark and copyright applications, and litigates intellectual property disputes. His clients span from major well-known companies to privately owned businesses to individuals. They operate in fields as diverse as consumer electronics, luxury goods, entertainment, pharmaceuticals and industrial products.

Peter counsels clients on all aspects of trademark adoption and protection including licensing. From advising clients on issues of inherent registrability to computer database and full searching, he is adept at taking the steps necessary to ensure that a mark is properly vetted prior to adoption. Peter is also familiar with the issues that arise in foreign trademark searching when a client has plans to use its mark abroad. Over the years, he has handled a number of global trademark portfolios.

Michelle J. Levin, Associate, Leason Ellis LLP

Michelle (Dorman) Levin practices in all aspects of domestic and foreign trademark prosecution. Her experience extends to a wide range of industries including luxury goods, publishing, electronics and food and beverages.

Michelle has conducted all phases of trademark prosecution and maintenance before the U.S. Patent and Trademark Office, including preparing and filing responses to Office Actions in all types of substantive refusals. Michelle has also conducted trademark searches and drafted opinions regarding the availability and registrability of trademarks, counseled clients regarding registration requirements in the U.S., negotiated license agreements, and conducted intellectual property due diligences. Outside the U.S., she has worked on trademark matters in over 100 countries, prosecuting foreign trademark applications, including international applications filed through WIPO, and maintaining international trademark portfolios.

Michelle has also assisted in copyright, trademark, and patent litigations, including extensive legal research, and prepared and filed documents for trademark opposition proceedings before the Trademark Trial and Appeal Board. She has also registered and maintained domain name registrations, handled UDRP proceedings, and prepared and filed copyright applications.

While in law school, Michelle interned at Burberry Limited, where she conducted internet trademark enforcement and drafted trademark settlement agreements, cease-and-desist letters, and correspondence to infringing parties. She also interned at Classic Media, Inc., where she drafted licensing, merchandising, promotional, agency, and work for hire agreements.

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