

Noli IP Newsletter

NOLI IP Solutions, PC

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Time to Renew My Trademark Registration: How to Avoid a Rejection By Luciana E. Noli and Thomas Reynolds

Renewal conditions vary internationally. Consequently, if you want to avoid issues that you may not be able to fix in the future when renewing your trademark registration, we suggest that you do your

There is not a single answer to this question, but one thing is certain: you will encounter issues when renewing your trademark registration in most countries if you are not using the mark as registered.

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One of our clients recently approached us asking if it would be possible for them to use a variation of one of their registered trademarks. The client had already invested thousands of dollars, and now wanted to use a variation of the mark as registered.

We focused our investigation in some of the countries in Latin America, such as Argentina, Brazil, Colombia, Honduras, Costa Rica, Guatemala, Panama, and Peru, as well as Canada, China, Europe and the United States, all of which were relevant to that particular client's business.

New Addition: Ms. Judit Marai



Judit Marai is an European licensed attorney with more than ten years of experience in intellectual property law. With her vast experience in our field both in Europe and the United States, we believe Ms. Marai will be a great addition to our team.

Ms. Marai has worked at several law firms in California and recently received her master degree in Intellectual Property from the University Of San Diego School Of Law.

Ms. Marai has been working in our San Diego Office since December and she may be contacted at judit@noli-ipsolutions.com. We are truly excited to announce that Judit has joined our trademark group at NOLI IP SOLUTIONS PC.

In **Argentina**, you must renew your trademark registration every ten years. It is necessary to declare the use of the trademark in the last five years. However, if you are using a variation of the mark as registered, a new application is needed.

The period to renew your trademark registration is also ten years for the rest of the countries that we considered, except Canada, which requires renewal every fifteen years. You will need to file a new application in Brazil, China, Canada, Colombia, Honduras, Costa Rica, Europe, Guatemala, Panama and Peru if the mark as used is different from the registered version. However, minor modifications may not be cause of refusal by the Trademark Offices in Peru and the United States.

In the **United States**, for a trademark registration to

remain valid the registrant must file an Affidavit of Use (Section 8 Affidavit) (1) between the fifth and sixth year following registration, and (2) within the year before the end of every ten-year period after the date of registration. The registrant may file the Section 8 Affidavit and the Section 9 Renewal Application (Section 9 Renewal) within a grace period of six months after the end of the period, with payment of an additional fee. Assuming the Section 8 Affidavit and Section 9 Renewal are timely-filed, the registration will be renewed for a 10-year term. If not, the registration will be cancelled. It is important to keep in mind that registrations cancelled due to the failure to file a Section 8 Affidavit and Section 9 Renewal cannot be revived or reinstated.

While the use of the mark is necessary to keep your

trademark registration in the US, it is not required in countries such as Brazil, China, Colombia, Honduras, Brazil, Panama and Peru.

In Canada a registrant is not required to show use of the mark, however, he or she may be required to submit a Declaration of Use at the request of the Trademark Office or of a third party after three years from registration. In other countries such as Costa Rica, Europe and Guatemala, if the mark is not in use after five year from grant, the registration may be cancelled.

Our advice is that it is always better (and cheaper) to prevent than to cure, as the popular saying goes. Please feel free to contact our team at mail@noli-ipsolutions.com should you have any questions in connection with this topic.

Why Can't I Get my Trademark Registered in the US?

By Mariana Noli and Judit Marai

Choosing the right trademark is never an easy job. Much thought, time, research, among other things goes into the trademark selection process. Once your

trademark has been selected, the process of getting it registered may also involve some challenges.

While the reasons to refuse registration of a trademark in

the United States are not always the same, you should know what you can expect to hear from the US Patent and Trademark Office.

Truth be told the USPTO may refuse to register your mark on numerous grounds, such as (1) Likelihood of Confusion; (2) Merely Descriptive and Deceptively Misdescriptive; (3) Primarily Geographically Descriptive, Primarily Geographically Deceptively Misdescriptive; (4) Primarily Merely a Surname; (5) Ornamentation, to name a few.

Your mark will be rejected if it is likely to cause confusion, mistake or deception with a mark already registered with the USPTO. When you file a new trademark application, the examiner assigned to your case will conduct a search of the USPTO records for conflicting marks as part of the official examination of an application to determine whether there is a conflict between the mark in your application and a mark that is either registered or pending in the USPTO. If a conflict exists between your mark and a registered mark, the trademark examiner will issue an Office Action refusing the registration of your mark on the ground of likelihood of confusion.

No trademark registration will be granted if your

proposed trademark is merely descriptive or deceptively misdescriptive of your goods or services. Examples of merely descriptive trademarks are "medical guide" for website services featuring medical guides, "denim" for jeans, and "spicy sauce" for salsa. Such a mark will be rejected as merely descriptive of the goods and services if it has not acquired secondary meaning. The examining attorney will refuse registration of your mark if it immediately describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services or if your mark misdescribes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. Note that you may be able to register such a mark on the weaker Supplemental Register.

The PTO is likely to refuse registration of a trademark application if your proposed trademark is primarily geographically descriptive or deceptively geographically misdescriptive of your goods or services. Your mark will be rejected if it primarily describes, or is deceptive

about, the geographic origins of the goods and services covered by the application. The examining attorney will refuse registration of your mark as primarily geographically descriptive if: (1) the primary significance of your mark is geographic; (2) purchasers would be likely to think that your goods or services originate in the geographic place identified in your mark, i.e., purchasers would make a goods/place or services/place association; and (3) your mark identifies the geographic origin of your goods or services. Your mark will be refused as primarily geographically deceptively misdescriptive in similar circumstances.

According to US trademark law, the examining attorney will not authorize registration of your mark if the primary significance to the purchasing public is merely a surname. If your proposed trademark consists of or comprises a name, portrait or signature identifying a particular living individual, you may obtain trademark registration by submitting that individual's written consent.

Matter that, as a whole, is functional cannot be protected

as a trademark. For example, the word "Fragile" cannot be used to trademark labels bearing that word to connote fragility of a package's contents. In general, the examining attorney will refuse registration if your mark is merely a decorative feature or part of the "dress" of the goods. Such matter is merely ornamentation and does not serve the trademark function of identifying and distinguishing your goods from those of others.

While the above mentioned reasons for refusal are the most popular, the USPTO will

also object to the registration of your proposed trademark if it consists of a generic term or it is deemed immoral, deceptive, or scandalous, or it disparages or falsely suggests a connection with people, institutions, beliefs or national symbols.

The name you or your company choose/s under which you/it will offer and sell your/its services and/or products is very important to your future success. It is always better to plan ahead and take your time during the trademark selection process keeping in mind the possible

reasons of refusal for the Trademark Office to refuse its registration.

We highly recommend our clients to invest time and effort at the beginning stages when first choosing the mark for your business. We are here to help you select the right trademark to save you time, money and headaches in the future. Please feel free to contact our office at mail@noli-ipsolutions.com should you have any questions when selecting and protecting your trademark.

DECEMBER, THE MONTH OF GIVING

We, at NOLI IP Solutions, PC, encouraged our members and proudly participated to the Give from the Heart Gift Drive by the Promises2Kids during this past holiday season.

For more information on the work of this organization, please visit: <http://promises2kids.org/>

