

Greenberg Traurig, LLP (www.gtlaw.com)

U.S. Trademark Registration Process Explained

SUMMARY OF APPLICATION PROCESS

(See the Detailed Explanation of the Process following this Summary)

1. Clear the Mark

- Searches, analysis, some investigation possible
- May need to get consents, or acquire marks or file cancellation proceeding

2. Prepare and File Application

- Choose goods and services and International Classes
- Decide if ITU or Use Based
 - If Use-Based, need “specimens” showing use
- Decide if logo form or “block” form of mark to be registered
- Decide if color should be registered

3. Prosecution

- Use Based
 - Possible Office Actions and Responses to Office Actions and possible appeal
 - If approved, publication, possible opposition, and if no opposition, registered
- ITU
 - Possible Office Actions and Responses to Office Actions and possible appeal
 - If start using before approval, file an Amendment to Allege Use
 - If don't file an Amendment to Allege Use and application is approved, published, possible opposition, and if no opposition, Notice of Allowance issues
 - After Notice of Allowance issues, need to file a Statement of Use once you start using the mark. Can file Requests for Extension of Time to File Statement of Use every six months for about 2 years.

- Need to file Statement of Use in order for registration to issue. Statement of Use is examined and possible Office Action and Response required, and possible appeal. Need to file Requests for Extension of Time to File Statement of Use with the Statement of Use in order to avoid lapse of application if problems with Statement of Use.

4. Post-registration.

- File Declaration of Continuing Use during 5th and 6th anniversary of registration.
- File Declaration of Incontestability after 5 years of continued use of mark. This often gets filed with the Declaration of Continuing Use.
- File Renewal Application with Continued Use Declaration between 9th and 10th registration anniversary date.

DETAILED DESCRIPTION OF THE PROCESS

Step 1. Clearance

Purpose: to select marks that are not registered or being used by anyone else and that the Trademark Office (PTO) will register and that can be defended and enforced in the US and, if applicable, international markets. The PTO will *not* register marks that (a) are the generic name for the product, (b) describe some aspect or quality of the product, (c) are similar in appearance, sound and/or meaning to a prior registered mark, (d) are deceptive or misleading, (e) are the names of living people without consent, (f) are a national symbol, (g) are scandalous, or (h) are primarily geographic in nature.

Choosing Marks:

- Try to choose words that are not descriptive of any qualities or characteristics of the product, or which look or sound like a mark a competitor is using, or which otherwise fall into one of the prohibited categories.

Contact Us to Order a Clearance Search:

- Email us (a) the mark and (b) the products or services for which you want to use the mark. The PTO requires that we be specific in describing the goods or services. So rather than telling us: "software," instead tell us "customer relationship management ("CRM") software sold both online and through standard software retail channels." Or instead of telling us "food and beverages," tell us "prepared pastas, salads, pizzas and non-alcoholic fruit smoothies sold frozen and non-frozen in supermarkets and convenience stores." For services, instead of telling us "Internet consulting services" tell us Internet web hosting, domain name registration and management, web site design, and e-commerce strategic consulting and implementation, targeted primarily at Fortune 500 auto parts companies."
- Tell us if you plan to sell anywhere other than the US. If so, tell us the other markets so we can order searches in those countries.
- We then order a search, which usually takes 4-5 business days from ordering to receipt. For additional cost, we can get results in 24, 36 or 72 hours.

- **Costs:** a “full” US search costs \$400. Reviewing and analyzing the search is performed on an hourly basis.
- If the search shows that there are others who have similar marks, we do an investigation using various public electronic databases. This work is included in the flat fee. Sometimes a more extensive investigation is necessary, in which case, with your approval, we retain an investigator. Most investigations of this kind cost \$1500 or less.
- If the search shows us that one or more of the marks is available, we let you know that, and we go to Step 2.
- International searching is about the same cost as US searches. We can order a “direct hit” search that covers about 200 countries for \$1000 that will tell us whether the exact mark is registered in these countries.

Step 2. Trademark Application Preparation

- **Terminology.** The word or design you want to use as the product name is the “*trademark*.” Trademark protection comes into play once you actually start using the mark. However, the only way to be assured to get nationwide protection is to *register* the mark. In order to get a mark registered, we have to file an *application* with the US Patent and Trademark Office. Once the application has been approved, the mark will be *registered*. It usually takes between 1 and 2 years from filing an application to the issuance of a registration. Once the mark is registered, you can use the ® symbol with the mark, e.g., Kookamunga®. Before then, you can use the ™ symbol, i.e., Kookamunga™ or, if a service mark, the ℠ symbol.

Marks are filed for specific categories of products or services. These categories are called *International Classes*. There are over 20 International Classes for products and about 10 for services. These International Classes are the same throughout most of the world. For example, if you are using the same trademark for a food product, on t-shirts, on school stationery, on a web site, and for educational services, you would file in 5 separate International Classes. Government *filing fees* (the fees charged by governments) are based on International Classes, i.e, there’s a separate filing fee for each class.

- **Choose a Basis.** We can file an application on one of two bases: (1) you have already started to use the mark (i.e., you have launched the product) or (2) you are planning to use the mark, but haven't started to use it yet (you haven't launched yet).
 - It's *faster* and *cheaper* to file applications in the U.S. *after* you have launched the product. But if you haven't decided yet and want to reserve the name, we can file it before you start using it. We can file in nearly all other countries before you have started using the mark.
 - If we file on the basis that you have started using the mark, we call that a “Use Based Application”. If we file on the basis that the mark hasn't been used yet, we call that an “Intent to Use (or ITU) Application.”
- **Review and Approve the Application.** We will prepare an application that identifies the mark, the products for which it will be used, and if it is a Use Based Application, the date the products under that name were first shipped. *You need to give us this*

information. If it's a Use Based Application, you'll also have to send us three identical packages or containers for the product(s).

- **Cost:** The PTO charges a filing fee of \$325 for *each mark* in *each International Class* ("IC") for which you are seeking registration. We charge an application preparation fee of \$1100 for each mark in the first class, and then an additional \$250 for each additional Class. Our fee covers all of the activity leading up to the preparation and filing of the application and related administrative costs.
- **Example.** You want to register "Gilgox" for (a) software in Class 9, (b) t-shirts in Class 25, and (c) beer in Class 33. This would be 3 separate Classes. The costs would be: PTO filing fee of \$325 x 3 (there are 3 classes) plus our base fee of \$1100 plus \$250 (for the second Class) plus \$250 (for the third Class).
- **Filing and Billing Process:** we open a separate file for each mark in each class. So for the above example, we would open 3 separate files: Gilgox in IC3, Gilgox in IC5 and Gilgox in IC 28. If you asked us to also file applications for each of these in Canada, each one of those applications would get a separate file. When we send you correspondence or bills relating to these applications, you would get a separate letter and a separate bill for each file.
- **Other Application Preparation Fees.** If you want to register a mark that includes a design (for example, the NIKE plus Swoosh Design), our fee is \$1200 since we have to get a special drawing of the design made to submit with the application.

Step 3. Application Prosecution Process

- What happens next depends on whether we file a Use Based Application or an Intent to Use (ITU) Application. The entire process can take up to two or more years.
- **Use Based Applications.** Once the application is filed, it is assigned a *Serial Number*, which is the tracking number throughout the *examination* process. The application is forwarded to an *Examining Attorney*, a lawyer who works for the Trademark Office. If the Examining Attorney believes that the mark is descriptive, or is too similar to a prior registered mark, or is slanderous, or violates some other rule or if the application requires a technical correction, s/he issues an *Office Action* identifying the problems. We then have 6 months to respond to the Office Action by filing a *Response to Office Action*. If the Examining Attorney agrees with our Response, the application is approved for *publication* in a Trademark Office magazine called the Official Gazette. If no one opposes the mark (see discussion below), the mark will be registered. If the Examining Attorney disagrees, s/he will send out another Office Action, to which we will have 6 months to respond. If the Examining Attorney again doesn't agree with us, a Final Refusal will be issued by the Trademark Office, and we have to file an appeal to the Trademark Office court in Washington DC, called the *Trademark Trial and Appeal Board*. If we win the appeal, the mark will be registered.

Responses to Office Actions can be either very simple or very complex --requiring the submission of evidence and legal argument --and can add a *few thousand dollars* to the cost of the clearance process. The average response cost is under \$1000. Technical responses are often under \$200.

- **Intent to Use Applications ("ITU Applications").** These are applications based on a good faith intention to use the mark. One of the advantages of the ITU process is that if you want to test a number of possible names for the same product before you decide on which name you want to use, you can file an ITU application for each of the marks being tested. However, in order to get a registration, you have to start commercially using the mark you want to register. This means that at some point after the application has been filed, you have to start commercial use of the mark and notify the PTO that you have started using the mark.
- **Notifying the PTO that You have Started Using the Mark.** The ITU examination process is in two stages: the initial examination and the post-use examination. During the first stage, if you start using the mark, we file an amendment to the application called an *Amendment to Allege Use*, which is essentially a declaration under oath that you have started using the mark. We also file a specimen showing how the mark is used, such as product packaging. The application at that point converts into a Use Based Application and is treated like one.

If you have not filed an Amendment to Allege Use prior to the end of the initial examination, the ability to file a notification of use is *suspended* until after the mark has been published and no opposition is filed. If no opposition is filed, the PTO issues a document called a *Notice of Allowance*. The receipt of this Notice triggers the second stage of the ITU examination process. Nothing happens until you start using the mark and notify the PTO that you have started using the mark. As soon as you tell us that you have started using the mark, we file a *Statement of Use*, which is a declaration that you are using the mark, accompanied by a specimen showing the use. A PTO Examiner looks at the specimen and decides if there are any reasons for refusing registration based on the specimen. Typical reasons are that the mark in the specimen is different than the one applied for or the mark is descriptive. If there is no objection by the Examiner, the mark will be registered. If there is an objection, the Examiner issues an Office Action, which we must respond to.

If a Statement of Use is not filed within six months after the Notice of Allowance issues, we have to file a *Request for an Extension of Time to File a Statement of Use* before the end of the sixth month. We have to file one of these every six months thereafter until a Statement of Use is filed. We always file a Request for an Extension of Time with a Statement of Use because if for any reason the PTO doesn't accept the Statement of Use, if we haven't filed a Request for an Extension, the application could lapse.

Once the Statement of Use is accepted by the PTO, the mark will be registered.

- **Costs:** The PTO charges \$100 as a filing fee for the Statement of Use and \$ 150 for each Request for an Extension of Time to File a Statement of Use. Our legal fees are \$500 for the preparation, filing and docketing of the Statement of Use and \$300 for each Request for an Extension of Time.
- **The sooner you start using the mark and tell us that you started using it the better.** Why? It costs less (you don't have to keep filing Extension Requests) and the mark will be registered more quickly.

- **Oppositions.** After the mark has been approved for publication and published in the Official Gazette, any one who believes that it would be damaged by the registration can file a proceeding to oppose registration of the mark. This is a litigation in the PTO court, the Trademark Trial and Appeal Board. If the opposition is successful, the mark is not registered. Most oppositions take 1 to 2 years, and can be expensive. For example, the average cost of an opposition that doesn't settle is \$30,000 - \$75,000.

Step 4. Post-Registration Process

- Between the 5th and 6th year of registration, we have to file a declaration stating that you are still using the mark for the goods identified in the registration. If we do not file this *Declaration of Continued Use under Section 8 of the Trademark Act*, the registration dies. If the mark also has been used continuously for 5 years and it is not in litigation, we also file a *Declaration of Incontestability under Section 15 of the Trademark Act*, which endows the registration with extra protection. For example, it cannot be challenged as being descriptive or that someone else has prior rights in the mark.
- Between the 9th and 10th year, we have to file another Declaration of Continued Use and an *Application for Renewal*. Trademark registrations have to be renewed every 10 years, and only can be renewed if the mark is in use.

Step 5. International Registration

- Registration of a mark in the United States only protects it against infringement in the United States. Every country has its own trademark law. In most countries, the person who first files an application to register a mark will own the mark for the actual goods in the application or in some countries, for the entire International Class.
- **If you plan to market your product outside of the U.S., it is critical to file an application to register the mark in the countries where the product will be marketed.**
- One of the treaties the US belongs to is the *Paris Convention*. Under the Convention, if you file an application in the U.S., you have up to 6 months thereafter to file applications in other countries that belong, and get the filing date of the U.S. application. Thus, if someone files applications in countries you are interested in between the US filing date and the end of the 6 month Convention period, and you then file an application in the same countries before the end of the 6 month Convention period, you can knock them out because your application will be considered as having been filed on the US application filing date. This is of special importance in those countries in which the first to file rule applies.
- **Costs.** On average, it costs \$2500-4000 to register a mark in one International Class in each country. While this seems expensive, it is much less than losing the opportunity of using the mark in an important country because someone else filed an application before you did.
 - The costs of international filings can be decreased two ways: (1) in the European Union ("EU"), you can file for a Community Trademark which, for about \$9000, gives

you a registration for a mark throughout the EU. (2) if your company has an established office in the EU or another country that is a member of the Madrid Convention and Madrid Protocol, you can file in the country in which your office is established, and then extend that application to other member countries. This is sometimes referred to as getting an "international registration." This process is expected to be available to US companies filing in the US sometime in 2004. For now, we would have to file first in another country to get this benefit.

What You Get With a Registration.

- A federal registration gives you exclusive national rights in the mark, which means that you have the right to exclude anyone who starts using a confusingly similar mark for competitive or related products or services after the issuance date of your registration.
- However, if someone infringes your registered mark, it doesn't mean that you can automatically stop them. You still have to go to court and prove that people are likely to be confused into believing that there is some connection between the other's use and yours. The average cost of a trademark infringement suit in federal court through trial is \$500,000.00. If a preliminary injunction is involved, the cost can easily double or triple.
- While protection is not automatic, the registration does give many benefits in a litigation, and it is far better having a registration than not having one. Plus, if you are marketing internationally, having a US registration makes it easier and less expensive to register abroad.

Have Questions?

Please call Steve Weinberg at 310 586 7722, or email to weinbergs@gtlaw.com.

For Use Based Trademark Applications

Action	What We Do	Costs
Prepare and file application	Prepare the application for filing; file the application;	USPTO filing fee of \$325 per mark per International Class; Our fee: \$1100 for the first mark and first International Class, and \$250 for each additional Class; 10% volume discount may be applied
Receive confirmation from the USPTO that application has been received and	Docket the confirmation; review USPTO conformation notice for accuracy and contact USPTO if there are any errors; send letter to client	No charge; Included in flat fee

assigned a serial number	advising of official filing	
Receive USPTO Office Action(s)	Docket receipt of Office Action from the USPTO; review of Office Action by lawyer; send copy of Office Action to client; discuss with client	Hourly
Respond to Office Action(s)	Prepare and file written response to Office Action	Hourly
If Final refusal, file reconsideration or ex parte appeal	Notify client of final refusal and options; prepare and file Request for Reconsideration (with Notice of Appeal and Motion to Stay Appeal)	Hourly
Notice of Publication	Receive Notice of Publication and docket same; letter to client re publication	No charge; Included in flat fee
Receive notice of potential opposition (if any)	Docket notice and send to client with letter advising of possible opposition	Hourly
Opposition filed	Notify client; defend opposition or resolve	Hourly
Notice of Registration	Receive Certificate of Registration; docket same for future dates; letter to client	No charge; Included in flat fee

For Intent to Use Applications

Action	What We Do	Costs
Prepare and file application	Prepare the application for filing; file the application;	USPTO filing fee of \$325 per mark per International Class; Our fee: \$1100 for the first mark and International Class, and \$250 for each additional Class; 10% volume discount may be applied
Receive confirmation from the USPTO that application has been received and	Docket the confirmation; review USPTO conformation notice for accuracy and contact USPTO if there are any errors; send letter to client	No charge; Included in flat fee

assigned a serial number	advising of official filing	
Receive USPTO Office Action(s)	Docket receipt of Office Action from the USPTO; review of Office Action by lawyer; send copy of Office Action to client; discuss with client	Hourly
Respond to Office Action(s)	Prepare and file written response to Office Action	Hourly
If use has begun, file Amendment of Application to Use-Based	Obtain package/label specimen and first use date from client; prepare and file Amendment to Allege Use	Hourly
If Final refusal, file reconsideration or ex parte appeal	Notify client of final refusal and options; prepare and file Request for Reconsideration (with Notice of Appeal and Motion to Stay Appeal)	Hourly
Notice of Publication	Receive Notice of Publication and docket same; letter to client re publication	No charge; Included in flat fee
If not yet used, and no opposition filed, receive Notice of Allowance	Docket Notice of Allowance; send letter to client advising of receipt	No charge; Included in flat fee
Opposition Filed	Notify client; defend opposition or resolve	Hourly
If no opposition filed and received Notice of Allowance	Send letters to client every 5 months reminding of need to file Statement of Use	Hourly
File Requests for Extension of time to file Statement of Use (every six months as necessary)	Prepare and file Requests with the USPTO	USPTO filing fee of \$150; Legal fees flat fee of \$300
File Statement of Use	Prepare and file Statement of Use and Request for Extension of Time to file Statement of Use	USPTO filing fee of \$100; Legal Fees flat fee of \$500 per mark
Receive Office Action on Statement of Use	Notify client; respond to Office Action	Hourly
Statement of Use Accepted by USPTO	Send letter to client advising of acceptance	Hourly

Notice of Registration	Receive Certificate of Registration; docket same for future dates; letter to client	No charge; Included in flat fee

Post –Registration Procedures

File Section 8 Declaration	Reminders to client in advance of filing dates; receive information and prepare and file Section 8 Declaration	Hourly for reminders; USPTO filing fee of \$100 per mark per class; Legal fees flat fee of \$500 for preparation and filing
File Section 15 Declaration	Reminders to client in advance of filing dates; receive information and prepare and file Section 15 Declaration or combine with Section 8 Declaration	Hourly for reminders; USPTO filing fee of \$200 per mark per class; Legal fees flat fee of \$500 for preparation and filing and \$750 for combined Section 8 and 15 preparation and filing
Renewal (every 10 years)	Reminders to client in advance of filing dates; receive information and prepare and file Renewal documents	Hourly for reminders; USPTO filing fee of \$400 per mark per class; Legal fees flat fee of \$750 for preparation and filing per mark and \$150 each additional class
Amendment of Application for Non-material change in Mark	Prepare and file Amendment of Registration	Flat fee of \$250
Cancellation or Opposition Proceeding Filed	File proceeding or resolve	Hourly; USPTO filing fee of \$300
Assignment	Record assignment	USPTO fee is based on number of pages

Glossary of Terms

1. **Trademark.** Any word, design, slogan, sound or other perceptible designation used as a brand name for products.
2. **Service Mark.** Any word, design, slogan, sound or other perceptible designation used as a brand name for services.

3. **Used Based Application.** An application for registration of a trademark or service mark (“mark”) for a mark that is in use at the time the application is filed.
4. **Intent to Use (ITU) Application:** An application for a mark not yet in use, but for which there is a genuine intent to use. Must be converted into a use based application in order for registration to occur
5. **Serial number.** The number assigned to an application by the US Patent and Trademark Office (USPTO) for tracking purposes
6. **International Class.** The official category into which the product or service for which the mark is used is assigned based on an international classification system established by the World Intellectual Property Association and used in most countries.
7. **Filing Fee.** A fee charged by the USPTO for the filing of a document.
8. **Office Action.** A written document issued by the USPTO **Examining Attorney** assigned to the application that identifies issues relating to the application and usually requires a written response within 6 months. Usually the Office Action raises questions regarding technical issues, or refuses registration based on any number of grounds, e.g., the mark is descriptive or there is a prior registered mark to which the Examining Attorney believes your mark is confusingly similar and therefore blocked from registration. At least one Office Action is issued for each application, although sometimes there is none and sometimes two or more. Examining Attorneys are lawyers employed by the USPTO who examine the applications.
9. **Examiner’s Amendment.** Sometimes the Examining Attorney emails or calls the Applicant’s attorney and tries to resolve an issue without having to send out an Office Action. If the issue is resolved in this manner, the Examining Attorney will issue a document called an Examiner’s Amendment that identifies the issue and its resolution. This also avoids having to prepare an Office Action Response.
10. **Office Action Response.** The written response to an Office Action prepared by our office. These can be fairly substantial, often requiring legal and factual research, affidavits from the client and customers, and sometimes surveys.
11. **Petition to Revive.** If a response to an office action is not filed within six months from the mailing date of the office action, the application will immediately be deemed abandoned by the USPTO. A petition to revive must be filed within two months after receiving notice of abandonment in order to revive the application. If an application is not revived and the applicant still wants to register the mark, a new application has to be filed.
12. **Ex parte appeal.** If the Examining Attorney issues a FINAL Office Action, the Applicant has to either seek **reconsideration** of the final refusal or file an appeal to the **Trademark Trial and Appeal Board (TTAB)**, the administrative court of the USPTO.

13. **Notice of Publication.** When the Examining Attorney has approved the mark for registration, the mark is scheduled for **publication** in a magazine called the **Official Gazette**. We receive written notice of the publication date from the USPTO. Once the mark is published, anyone who believes that he/she will be damaged by the registration has up to 120 days to file an **opposition proceeding**, which is an administrative litigation that has as its purpose keeping the mark from getting registered.
14. **Amendment to Allege Use.** For ITU based applications, a written amendment to the application that notifies the USPTO that the mark is now in use and can be registered. An amendment to allege use must be filed *before* a **Notice of Allowance** issues. Otherwise, a **Statement of Use** must at some point be filed before the mark can be registered.
15. **Notice of Allowance.** For ITU based applications, a written notice from the USPTO that an approved mark that no opposition proceeding was filed against the mark.
16. **Statement of Use.** For ITU based applications, a written document filed with the USPTO after a Notice of Allowance issues that notifies the USPTO that the mark is in use and can be registered.
17. **Office Action on Statement of Use.** For ITU based applications, the Examining Attorney examines the Statement of Use and may issue an Office Action relating to an issue raised by the Statement. For example, the Examining Attorney may believe that the mark as actually used is materially different from the mark as applied for or is not used properly as a trademark. These Office Actions also require written **responses**.
18. **Request for Extension of Time to File Statement of Use.** For ITU based applications, after a Notice of Allowance has issued, written requests to the USPTO must be filed every six months until the mark is used and a Statement of Use can be filed. These requests are required to keep the application alive.
19. **Certificate of Registration.** The official written certificate issued by the USPTO evidencing the registration of the mark. Once the mark is registered, the ® symbol can be used with the mark for the product(s) or service(s) for which the mark has been registered. Until then, the ™ or ℠ symbols can (and should) be used. These latter two symbols can be used even if an application is never filed for the mark.
20. **Section 8 Declaration.** A mandatory filing with the USPTO during the fifth and sixth year of the registration date that certifies that the mark is still in use for all or some of the products or services identified in the registration certificate. This filing keeps the registration alive.
21. **Section 15 Declaration.** Filed anytime after the registered mark has been used continuously for five consecutive years, and is not in litigation at the fifth anniversary of continuous use. Endows the registered mark with “incontestability” which protects the mark from a variety of attacks

22. **Renewal Application.** The registration must be renewed every ten years. This application is filed with a **Section 9 Declaration** that attests that the mark is still in use for all or some of the products or services identified in the registration certificate.
23. **Amendment of Registration.** If the appearance of a mark is changed in a non-material way, the registration can be amended to reflect the updated format. Not required, but useful in saving money if the mark is going to be used in litigation.
24. **Opposition Proceeding.** An administrative litigation brought by a third party in the TTAB after the mark has been published to prevent registration of the mark. If the opposition is “sustained” (the challenger wins) the mark is not registered. If the opposition is not sustained (the applicant wins), the mark is registered. A typical opposition proceeding costs between \$15,000 to \$40,000. Also, it just affects the right to register the mark. Thus, even if the opposition is sustained (the challenger wins), the Applicant still has the right to use the mark. The challenger must win a trademark infringement litigation in state or federal court to stop the applicant’s use. The losing party can appeal the decision of the TTAB in an opposition to either the Court of Appeals for the Federal Circuit or to a federal district court.
25. **Cancellation Proceeding.** An administrative litigation brought by a third party in the TTAB after the mark has been registered to cancel the registration of the mark. If the cancellation proceeding is “sustained” (the challenger wins) the mark is canceled. If the cancellation proceeding is not sustained (the registrant wins), the mark is not canceled. A typical cancellation proceeding costs between \$15,000 to \$75,000. Also, it just affects the right of registration of the mark. Thus, even if the proceeding is sustained (the challenger wins), the registrant still has the right to continue use the mark. The challenger must win a trademark infringement litigation in state or federal court to stop the registrant’s use. For a variety of reasons, the ability to bring a cancellation proceeding decreases after the mark has been registered for five years. The losing party can appeal the decision of the TTAB in a cancellation proceeding to either the Court of Appeals for the Federal Circuit or to a federal district court.
26. **Common law rights.** Trademark rights in the United States are based on the use of the mark either intrastate or in commerce (between two or more states or between the US and another country). One can therefore develop rights in an unregistered mark that is in use. These rights are called “common law rights” as opposed to rights one obtains through federal registration, which are referred to as “statutory” or “registered” rights.

美国商标注册程序讲稿

申请程序摘要

(详细说明见后)

1. 明确(将要注册的标志)

- 商标查询、分析, 并进行可能的调查
- 可能需要得到同意或取得标志, 或被提起撤消程序

2. 准备并提交申请

- 在国际分类中选择商品和服务
- 选择是基于使用还是基于意向使用而提出申请
 - 如果是基于使用, 则需要提交商标的样本以表明该标志已经使用
- 选择是以标识语 (logo) 的形式还是以“结合体”的形式提交商标注册
- 决定标志中使用的颜色是否申请保护

3. 申请程序

- **基于使用的申请**
 - 可能会有审查意见、答复审查意见和可能的上诉程序
 - 商标初审公告后可能被异议; 公告期满没有异议予以核准注册
- **基于意向使用的申请**
 - 可能会有审查意见、答复审查意见和可能的上诉程序
 - 如果是在初审前已经开始使用, 需提交使用声明的补正
 - 如果未提交使用声明的补正, 在申请被许可、公告之后可能被异议; 公告期满没有异议, 颁发许可通知。
 - 在许可通知发出后, 申请人一旦开始使用该标志, 则需提交使用声明。申请人可每 6 个月进行一次请求延期提交使用的声明, 累计不得超过 2 年。
 - 为使申请的标志获得注册, 必须要提交使用声明。对使用声明会进行审查而且可能有审查意见, 并需要进行答复或上诉。为避免因使用声明存在问题而导致申请时效的丧失, 需要在提交使用声明的同时提交延期提交使用声明的请求。

4. 注册后的程序

- 在商标注册后的第 5 到第 6 年之间提交连续使用的声明书。
- 在商标注册并连续 5 年使用之后提交该标志具有无可争议性的声明书。该声明通常同时与连续使用声明一起提交。
- 在注册日后第 9 到第 10 周年之间提交续展申请并同时提交连续使用声明。

申请注册程序详细说明

步骤 1 明确将要注册的标志

目的：没经过注册或没有被其他人使用的商标，才可能被商标局（PTO）核准注册而在美国受到保护。商标局对于以下标志不予核准注册：A) 商品通用名称； B) 描述商品的某些特点和质量的； C) 在外观、发音、含义上与在先注册的商标近似的； D) 带有欺骗性和误导性的； E) 未经他人同意而使用其姓名的； F) 国家标志； G) 带有诽谤性的； H) 与一个并非是该产品原产地相同的地名。

选择标志：

- 通常选择那些不会表述商品的质量和特征的标志，不会和其他商品生产者已经使用的商标相近似的标志，以及不会违反商标注册所禁止性规定的标志。

联系我们进行商标查询：

- 可以将您想申请的商标您选择的商品和服务通过电子邮件发给我们。PTO 要求，商品和服务的选择必须明确具体，例如，商品名称的选择上“软件”就过于笼统，而应该选择更为具体的名称“通过网上以及传统零售方式销售的客户关系管理软件”，再如，仅选择“食物和饮料”这样的商品名称就过于简单，而应详细的说明是“在超市和便利店销售的精制意大利面、沙拉、比萨、不含酒精的、冷冻或非冷冻果汁”。在选择服务的名称时，不要选择“网上咨询服务”这样过于简单的名称，可以选择“网络主机服务、域名注册及管理、网页设计、电子商务策略咨询及执行、主要针对财富 500 强的汽车配件公司等。”
- 如果您计划在美国之外的其他国家销售产品，您可以告诉我们，我们可以针对这些国家地区进行查询。
- 我们将进行查询，从接到查询单到查询结果出来需要 4-5 个工作日。增加收费的情况下，查询结果在 24、36 或 72 小时便可获得。
- **费用：**一项“全面”查询的收费是 400 美元。分析查询结果则按小时收费。
- 如果查询结果表明有其他近似商标存在，我们将通过多种公众电子数据库进行进一步的查询，这部分费用比较低。有时候需要更大范围的查询，经过当事人同意，我们将雇佣专人调查，调查的费用通常在 1500 美元左右。
- 如果查询结果表明所选择的标志可以使用，我们将会及时通知您，然后进入步骤 2。
- 国际查询与在美国国内查询的费用相同。我们能进行覆盖在 200 个国家和地区直接查询，可以查到某个标志是否在其他国家和地区被注册。该查询的费用是 1000 美元。

步骤 2 商标注册申请的准备

- **术语** 使用在商品上作为商品标志的文字和图形称为商标。标志在一经使用便可以获得保护。但是要获得全国性保护的唯一且必须的途径是对该标志进行注册。获得注册商标需要向美国专利和商标局（USPTO）提交注册申请。一旦申请被审查通过，该标志就可以被核准注册。从申请到核准注册一般需要 1-2 年。标志被核准注册后就可以将®标识连同标志一起使用，例如 KOOKAMUNGA®。在核准之前可以使用™标识用于商品，SM 标识用于服务。

商标是在具体分类中的商品和服务上注册的，这种分类称为国际分类，其中有 20 多个商品分类和 10 多个服务分类。这种国际分类是世界通用的。如果您想在一种食物、T 恤衫、学习文具、网站、教育服务上使用同一个标志，则需要在 5 个不同的类别上分别提出注册申请。官方收费是以国际分类为基础的，每一个类别发生一项单独的费用。

• 选择注册的基础

我们通常是在两种不同的基础上选择一种提交申请：1) 已经开始使用该标志（您已经开始在产品中使用）；2) 计划使用这个标志，但是还没有将其应用在商品上。（还未投放市场）。

- 将已经投放美国市场的商品标志进行申请注册，速度比较快，费用也比较低。如果您还没决定并且想保留商标名称，也可以在使用前进行注册申请。在您使用商标前我们可以在几乎所有国家进行注册申请。
- 如果在您已经在使用商标的基础上注册，我们把这申请称为基于使用的申请。如果在您以未使用的标志为基础注册，我们将这申请称为基于意向使用的申请。
- **申请的审查和通过：**我们在准备申请时会将商品和标志视为即将被使用。如果是基于使用申请，您需要提供给我们关于该商标第一次被使用的信息。同时，还需要提交该标志所用于的产品的 3 个相同的包装或容器。
- **费用：**每一类别的一个商标的官费是 325 美元，每个申请的代理费是每一商标在第一个类别注册是 1100 美元，每增加一个类别是 250 美元。我们的费用包括申请的准备阶段、提交申请以及相关的管理费用。
 - **例如：**您想注册一个商标 GILGOX 在第九类的软件，第 25 类的 T 恤，第 33 类的啤酒，这是三个不同的类别，其费用应当是，费用：官费是 325*3（有三个类别），我们的包干代理费 1100 加 325（第二个所选类别）加 325（第三个所选类别）。
 - **账单：**我们在每一个类别上单独提交一个商标的申请，就上面的例子，我们分别提交三个申请：GILGOX 在 IC3、IC5 和 IC28。如果您同时要求我们在加拿大提交以上申请，每一项申请都会被单独提交。我们寄给客户的信件和账单，也是按每一项申请分别寄出。
 - **其他提交准备的费用：**如果在注册时需要我们帮助设计您的标志（如 NIKE 加上嗖嗖作响的设计），我们的费用是 1200 美元，这是因为我们将为客户设计独特的图案用以提交申请。

步骤 3 申请过程

- 接下来的程序会取决于您所提交的申请是基于使用的申请还是基于意向使用的申请，整个申请过程将持续 2 年时间或者更长。
- **基于使用的申请** 申请提交后，将会被分配一个序列号，它是整个审查过程中使用的跟踪号码。申请由评审员进行审查，评审员通常是政府工作的律师。如果评审员认为标志具有描述性或与在先注册的商标近似或者带有诽谤性，或是违反了其他规则，或者是申请需要进行一些技术性修改，评审员将会发出审查意见指出存在的问题。我们有六个月的时间对审查意见进行答复。如果评审员同意我们的答复，该标志将会被公告在商标局刊发的官方公告（Official Gazette）上。如果没有人提出异议，该商标申请将会被核准注册。如果评审员不同意我们的答复，就会再次发出审查意见，我们仍有六个月的时间提交答复审查意见。答复如果再一次被驳回，评审员会发出终局驳回的审查意见，如果我们对此不服，则可以向位于华盛顿特区的商标审理和上诉委员会（TTAB）提起上诉。如果胜诉，该标志就可以被核准注册。

答复审查意见既可能比较简单也可能很复杂，答复时需要提供证据还要进行法律上的辩论，这一过程要花费大量的费用，平均每次答复的费用是 1000 美元以下，技术性的答复是在 200 美元左右。

- **基于意向使用的申请**，这种申请是建立在有充分的意愿来使用该商标的基础之上，该申请的好处在于如果您还没有决定在商品上使用哪个商标，这时，您可以提起已将要使用的商标为基础的上来使用每一个可能的商标，但是为了取得商标注册，您必须在商业上使用您所想要注册的商标，这就意味着您在提起商标申请的同时必须在商业上使用该商标，并且通知商标局您已经开始使用该商标。

- **通知商标局您已经在使用该商标**，基于意向使用的申请的审查过程通常有两个阶段，一个是初步审查，二就是使用后的审查。在第一个阶段中，如果您已开始使用这个商标，我们要提交一个申请补正，即使用声明，这是一个必要的声明，我们要提交一份商标的样本，表明这个商标已开始使用，例如产品包装袋，该申请在此时就转化为基于使用的申请。

如果在初步审查阶段结束之前未提交使用声明，您提交使用声明的可能性将会受到质疑，直到该标志被公告而没有被提起异议。如果没异议被提起的话，商标局将会发出一份许可证书的通知，收到这份通知书后将会进入该申请的第二阶段。在您开始使用该标志并通知 USPTO 您已开始使用该标志之前，不会有任何程序发生。一旦您通知我们您已开始使用该标志，我们提交您使用该标志的声明以及所使用的样本，商标局的评审员将会审查这个样本，进而根据样本决定是否驳回。典型的被驳回的理由是标志的样本不同于申请时提交的标志图样，或者该标志是描述性的。如果评审员没有任何的反对理由，这个商标就会被核准注册，如果存在驳回理由，评审员会发出审查意见，那我们就需要进行答复。

使用声明在准许使用证明发出后六个月内仍未提交，我们将在最后六个月内提出延期请求，如果使用声明一直未提交，我们就需要每六个月提交一次延期申请，我们通常在提交使用声明时一同提交延期申请，这是因为如果商标局不接受这个使用声明而同时我们也未提交延期申请的话，那么该商标申请将会失效。

一旦使用声明被商标局接受，那么这个商标就会被核准注册。

- **费用**：提交商标使用声明的官费是 100 美元，每次延期申请的费用为 150 美元；提交商标使用声明的代理是 500 美元，每次延期申请的代理费是 300 美元。
- **您越早开始使用您的商标，并且及时通知我们，就越有利**。这样做的优点在于申请的费用比较低(不需要提起延期申请)，那么商标也会注册的快一些。
- **异议**，在商标初审公告后任何人认为该商标有可能损害其利益的皆可提起异议，这是在 USPTO 法庭--商标审理和上诉委员会 (TTAB) --的一种诉讼，如果异议被接受这个商标将不会得到核准注册。大多数异议需要花费一到两年的时间，而且费用很高，例如平均每个异议的费用在 3 万美元到 7 万 5 美元左右。

步骤 4: 注册后的程序

- 在使用商标的第 5 年到第 6 年之间，我们需要提交一份声明来表明在指定的商品上持续使用了该注册商标，根据商标法案第 8 条，如果不提交持续使用声明，该注册商标就会失效。如果商标持续地连续使用了 5 年且没有被提起过诉讼，我们也需提供一份基于商标法案第 15 条的无可争议性声明，给予该注册以特别的保护。例如，它不能被认为是描述性的标志，其它

人也不能声称对该标志拥有在先权利。

- 在第 9 年到第 10 年之间，我们需提交另一份持续使用的声明和续展申请，注册商标需要每十年续展一次，而且只有在商标被使用的情况下可以续展。

步骤 5: 国际注册

- 美国国内的商标注册只能保护该标志在国内不被侵权。每个国家都有自己的商标法，在大多数国家，最先提起某一商标的注册申请的人将拥有在申请时所指定的商品上使用该商标的权利，在有些国家，他可能拥有在所有类别上的使用权。
- **如果您计划在美国之外开拓市场，那么有必要在您所开拓的商品市场所在的国家提起商标注册申请。**
- 美国是巴黎公约的成员国，根据该公约，在美国提交的申请，在其它国家享有六个月的优先权，并且获得美国申请的申请日。因此，如果任何人向您所感兴趣的国家的商标注册申请是在您在美国提交申请之后的六个月内，而您也想向该国家提出注册申请，那么您可以提出异议，因为您的申请日是以美国的申请日为准。
- **费用：**一般来说在一个国家注册一个类别的商标需要 2000-4000 美元，这看起来很贵，但是比起您在一个重要的国家失去使用该商标权利的机会所造成的损失要小得多。因为其他人可能会在您之前提出注册申请。这在那些采用先申请原则的国家来说就更加重要。
 - 两种降低国际申请费用的方式：1、在欧盟申请注册的话，可以提交共同体商标注册，申请的费用是 9000 美元，为您取得在所有的欧盟成员国获取注册。2、如果您在欧盟或另一个马德里协定或议定书成员国内有固定的办事机构或营业机构，您可以在该国提交商标申请，并指定其它成员国。这种情况通常被认为是取得了一项国际注册。这一程序有希望给那些在 2004 年提交了美国申请的美国公司带来好处。而现在，我们未获取这一利益，只能首先在另一国家进行注册申请。

获得商标注册后给您带来的利益：

- 在商标的联邦注册将拥有在国内独占使用该商标的权利，这意味着您在注册核准之日起有权禁止他人在竞争中或在相关的产品和服务上使用与注册商标类似的商标。
- 但是，即便有人仿冒注册商标，并不意味着您可以自动的阻止他的侵权行为。您依然需要向法院提起诉讼，证明他人的使用和您的商标存在联系可能会引起公众的混淆。商标侵权诉讼的平均费用是大致是 500,000 美金。如果包括了申请诉前禁令，费用将会是平均费用的 2-3 倍。
- 由于商标的保护是非自动获取的，注册商标在诉讼中比较有利，已注册的商标远比未经过注册的商标具有优势。而且，在跨国经营中，拥有美国注册商标会使您在国外的注册更加容易，费用也相对低廉。

Any Question?

请致电 1-310-586-7722 联系 Steve Weinberg 或 email: weinbergs@gtlaw.com

“基于使用”的商标注册申请

项 目	工 作 内 容	费 用
准备并提交申请	准备用于提交的申请文件；提交申请	官费：\$325（每标志每国际分类）； 代理费：\$1100（第一个标志的第一个国际分类），\$250（每超出一个国际分类）；可以申请总数10%的折扣
收到 USPTO 发出的正式受理通知以及分派的序列号	将受理通知归档； 检查 USPTO 发来的受理通知的准确性，如有错误则进行联系交涉； 向客户转达受理通知	不收费，已包含在包干费用中
收到 USPTO 的审查意见	将审查意见书归档； 律师对审查意见进行检查； 向客户寄送审查意见的复印件； 同客户沟通讨论	按小时收费
答复审查意见	准备并提交书面的答复审查意见书	按小时收费
如果有终局的驳回，提交再审查申请或部分上诉	通知客户关于该终局驳回并提供建议； 准备并提交再审查申请（连同上诉声明和延缓上诉）	按小时收费
公布通知	接收并将公布通知书归档； 向客户转达	不收费，已包含在包干费用中
收到可能的异议通知（如果有的话）	将通知书归档并给客户去信针对可能的异议提供建议	按小时收费
被提起异议	通知客户； 对异议进行辩护或和解	按小时收费
注册通知	收到注册证书并归档； 向客户转达	不收费，已包含在包干费用中

“基于意向使用”的注册申请

项 目	工 作 内 容	费 用
准备并提交申请	准备用于提交的申请文件；提交申请	官费：\$325（每标志每国际分类）； 代理费：\$1100（第一个标志的第一个国际分类），\$250（每超出一个国际分类）；可以申请总数10%的折扣

收到 USPTO 发出的正式受理通知以及分派的序列号	将受理通知归档; 检查 USPTO 发来的受理通知的准确性, 如有错误则进行联系交涉; 向客户转达受理通知	不收费, 已包含在包干费用中
收到 USPTO 的审查意见	将审查意见书归档; 律师对审查意见进行检查; 向客户寄送审查意见的复印件; 同客户沟通讨论	按小时收费
答复审查意见	准备并提交书面的答复审查意见书	按小时收费
如果已经使用了该标志, 提交补正书将申请更改为“基于使用”	从客户处获取该标志的样本以及首次使用的日期; 准备并提交补正书声明已经使用	按小时收费
如果有终局的驳回, 提交再审查申请或部分上诉	通知客户关于该终局驳回并提供建议; 准备并提交再审查申请 (连同上诉声明和延缓上诉)	按小时收费
公布通知	接收并将公布通知书归档; 向客户转达	不收费, 已包含在包干费用中
如果仍然还未使用该标志, 而且也没有异议, 收到许可通知	将许可通知书归档; 告知客户已收到许可	不收费, 已包含在包干费用中
有异议提交	通知客户; 对异议进行辩护或和解	按小时收费
如果没有异议提交并收到许可通知书	每 5 个月向客户发信提醒客户提交已经使用的声明	按小时收费
请求延期提交使用声明 (视情况每 6 个月一次)	准备并向 USPTO 提交请求书	官费\$150 代理费包干\$300
提交使用声明	准备并提交使用声明书以及要求延期提交使用声明的请求书	官费\$100 代理费包干每一标志\$300
收到关于使用声明的审查意见	通知客户; 答复审查意见	按小时收费
USPTO 接受了使用声明	告知客户声明已被接受	按小时收费
注册通知	收到注册证书并归档; 向客户转达	不收费, 已包含在包干费用中

注册后程序

项 目	工 作 内 容	费 用
提交第 8 条要求的声明	预先提醒客户告知提交日; 收到信息并准备和提交第 8 条要求的声明	对于提醒, 按小时收费 官费: \$100 (每标志每国际分类);

		代理费包干：\$500 用于准备和提交声明
提交第 15 条要求的声明	预先提醒客户告知提交日； 收到信息并准备和提交第 15 条要求的声明 或连同第 8 条要求的声明一起提交	对于提醒，按小时收费 官费：\$200（每标志 每国际分类）； 代理费包干：\$500 用于准备和提交声明，或\$750 用于第 8 条连同第 15 条声明 的一起准备和提交
续展（每 10 年）	预先提醒客户告知提交日； 收到信息并准备和提交续展文件	对于提醒，按小时收费 官费：\$400（每标志 每国际分类）； 代理费包干：\$750 （每一标志），\$150 （每超出一件标志）
对申请的标志作出非 实质性改变的补正	准备并提交注册的补正书	包干费用：\$250
提起撤销或异议程序	提交诉讼或和解	按小时收费； 官费\$300
转让	转让登记	官费基于页数计算

术语表

- 商标** 任何文字、图形、标语、声音或其它可感知的特定用于产品的品牌名称。
- 服务标志** 任何文字、图形、标语、声音或其它可感知的特定用于服务的品牌名称。
- 基于使用的申请** 一个标志用于商标或服务标志的注册申请，在提交申请之时已经进行了使用。
- 意向使用的申请** 一件申请的标志还未被使用，但是该标志是善意的意向使用。为完成该标志的注册，它必需被转换为基于使用的申请。
- 序列号** 美国专利商标局（USPTO）分配给一件申请的数字号码，用于跟踪处理进程。
- 国际分类** 基于世界知识产权组织确定的并被多个国家采用的国际分类系统于对现实存在的各种产品或服务进行的正式类别的划分。
- 申请费** USPTO 收取的提交申请文件的费用。
- 审查意见** USPTO 评审员对申请中相关问题发出的书面意见，通常需要在 6 个月内作出书面答复意见。通常情况下审查意见是针对技术性问题而提起的，或者是基于许多层面考虑而作出的拒绝注册，如，该标志是描述性标志，或因该标志与在先注册的标志相类似而被评审员视为可能引起混淆因而不注册。通常每一申请都会收到至少一次审查意见，尽管有些时候不会有（审查意见）而有时候会有两次或更多。评审员是 USPTO 聘任的专职进行申请审查的律师。

9. **评审员的修改** 有时候评审员会通过电子邮件或电话的方式与申请人的代理律师进行沟通来解决某些问题而不需要发出审查意见。如果通过这些方式解决了问题，那么评审员就会发出一份称为“评审员的修改”的文件，表示这些问题已经得到了解决。这样也避免了进行一次审查意见的答复。
10. **审查意见答复** 这是我们事务所对审查意见的书面答复。该答复需要清楚而充分，通常需要对法律和事实的研究、客户（委托人）和消费者的宣誓书，在某些情况下还需要有调查结论。
11. **恢复请求** 如果对审查意见的答复未能在审查意见书发出日的 6 个月内提交，该申请就会立即被 USPTO 视为放弃。为了恢复该申请，在收到放弃通知书的 2 个月内需要提交恢复请求书。如果该申请未能被恢复而申请人仍然想要得到该标志的注册的话，就需要提交一份新的申请。
12. **部分上诉** 如果评审员发出了一份终局审查意见，那么申请人就需要对该最终的驳回寻求再审查，或者向 USPTO 的行政法庭--商标审理和上诉委员会（TTAB）进行上诉。
13. **公布通知** 在评审员认可了一件标志的注册申请之后，该标志就会被安排时间出版在被称为官方公告（Official Gazette）的杂志上。我所将收到 USPTO 发来的关于公告日的书面通知。一旦该标志被公告，任何人如果认为该标志的注册会对他/她的利益造成损害，都可以在 120 天内提起异议程序，这是为阻止一件标志被注册成功的行政的诉讼方式。
14. **宣称使用的补正** 对基于意向使用的申请，需要针对该申请提交一份书面补正，告知 USPTO 该标志已经得到了使用并可被注册。宣称使用的补正必须在发出许可通知书之前提交，否则，在该标志得到注册之前就需要提交一份使用声明。
15. **许可通知** 对基于意向使用的申请，USPTO 发出书面通知，证实没有收到任何针对该标志而提交的异议程序。
16. **使用声明** 对基于意向使用的申请，在 USPTO 发出许可通知之后而提交的书面文件，告知 USPTO 该标志已经进行了使用并可被注册。
17. **对使用声明的审查意见** 对基于意向使用的申请，评审员经过审查使用声明，可能会就声明中的某些问题提出审查意见。例如，评审员可能认为该申请的标志和实际使用中的标志存在实质性的不一致，或者该标志没用正确地作为商标来使用。该审查意见同样需要提交书面答复。
18. **请求延期提交使用声明** 对基于意向使用的申请，在发出许可通知书之后，在该标志被实际使用并提交使用声明之前，每 6 个月需要向 USPTO 提交一份书面请求，该请求的目的是为了保持该申请的有效状态。
19. **注册证书** USPTO 颁发的证实某一标志得到注册的书面证明。一旦该标志被注册，就可以在注册的商标或服务标记上标注®标记。在这之前，TM或SM的标记也可以而且应当被标注，该后两种标记在某一标志即使从未进行过申请注册的情况下也可被使用。
20. **第 8 条要求的声明** 在注册日起的第 5 年至第 6 年之间，强制性要求向 USPTO 提交一份声明用于证明该标志仍然全部或部分地使用于注册证书上注明的产品或服务。该声明是为了保持注册的有效状态。
21. **第 15 条要求的声明** 注册商标连续 5 年不间断的使用并且在连续的第五个周年使用中没有被提起过任何诉讼，在这之后的任何时间内都可以提出，则可以赋予该商标以“无可争议性”而保护其免受多种可能的侵犯。
22. **续展申请** 该注册必须每 10 年进行一次续展。续展申请是基于第 9 条要求的声明，证明该标

志仍然全部或部分地使用于注册证书上注明的产品或服务。

23. **注册后的补正** 如果该标志的形象有了非实质性的改变，该注册则可以通过补正来反应这一更新后的形式。这不是必需的，但是如果该商标面临诉讼的话则可能会节省一些费用。
24. **异议程序** 第三方如果对公告后的商标持有异议或为阻止某一标志获得注册而向 **TTAB** 提起的一种行政的诉讼方式。如果该异议获得确认（控方胜诉）该申请将不能被注册。通常，异议程序的花费在\$15,000 到\$40,000 之间。当然，它仅仅影响该标志获得注册的权利，所以即便是该异议获得确认（控方胜诉），申请人仍然有权使用该标志。控方必须要赢得在州或联邦法院的提起的商标侵权诉讼才能阻止申请人使用该标志。败诉方对 **TTAB** 关于异议的决议既可以在联邦巡回上诉法院也可在联邦地区法院提起上诉。
25. **撤销程序** 第三针对已注册的商标而向 **TTAB** 提起的要求撤销该注册的行政的诉讼方式。如果该撤销申请获得确认（控方胜诉）则该注册将被撤销，如果该撤销申请未能获得确认（控方胜诉）则该注册不会被撤销。通常，撤销程序的花费在\$15,000 到\$75,000 之间。当然，它仅仅影响该标志获得注册的权利，所以即便是该撤销获得确认（控方胜诉），申请人仍然有权使用该标志。控方必须要赢得在州或联邦法院的提起的商标侵权诉讼才能阻止申请人使用该标志。出于各种因素，在一件标志被注册 5 年之后而对其提起的撤销程序的可能性就很小了。败诉方对 **TTAB** 关于撤销的决议既可以在联邦巡回上诉法院也可在联邦地区法院提起上诉。
26. **普通法上的权利** 在美国，商标权是基于该标志在州内的使用或在商业上的使用（指在美国国内两个以上的州之间使用或在美国和其它国家使用）。因而任何持有人都可以就该已经使用但未注册的标志行使其权利，这种权利由于与通过联邦注册而获取的“法定的”权利或“经登记的”权利相对应，而被称之为“普通法上的权利”。

Greenberg Traurig 律师事务所简介

Greenberg Traurig LLP 律师事务所 (www.gtlaw.com) 是一家有 30 多年历史的美国律师事务所，在美国国内的纽约、波士顿、洛杉矶、拉斯维加斯、华盛顿特区、休斯顿等近 30 个城市设有办公室。在英国伦敦、意大利米兰、荷兰阿姆斯特丹、日本东京等多个国家都设有分支机构。

该所现有律师及专职人员共 1400 多人，在 The American Lawyer (美国律师杂志) 2005 年评出的最佳律师事务所中，该所排名第一；在 National Law Journal (国家法律杂志) 2004 年按在职律师人数排名评比中，该所名列第八；在 The National Law Journal Millennium (国家法律杂志千禧版) 按近 5 年发展情况调查的全美 250 家最大律师事务所中，该所排名第一。在其他的多项调查、评比中，该所或其专职人员都是名列前茅。该所成功地代理了美国历史上有名的布什总统选票案，使得该所在美国名声大振而且和政府关系良好。

该所的业务范围涉及信息技术、能源、环保、反垄断、全球贸易、娱乐等多方面的法律事务，**知识产权是该所的一个重要业务部门**。今天，快速发展的全球市场使得知识产权的重要性日益提升。很多跨国公司都意识到专利、商标、版权、商业秘密是他们最重要的财富之一。Greenberg Traurig 事务所的知识产权部可在多个技术领域为客户提供全方位的知识产权保护，包括生物、医药、医疗设备、化学、机械、电子、计算机软件、电子商务等方面。其商标组的职能包括全球贸易管理与保护，以及商标、商号、域名的注册与保护。根据 USPTO 统计数据，2003 年度，该所代理的商标申请量为全美第一。该所的经验与能力确保他们可以处理一些非常大的案子，帮助客户保护自己的知识产权，并帮助客户对抗他方提起的知识产权侵权诉讼。



主讲人 Harley I. Lwein 简介

任职 Greenberg Traurig 的合伙人，知识产权部/零售业小组 商标和全球品牌策略的主管

教育背景：美国威斯康星大学法学院 法学博士

工作语言：英语、法语、意大利语、西班牙语

执业范围：知识产权、商标、版权、知识产权的销售规划/市场开发/开发协议、多国诉讼、雇员的欺诈、受贿调查和诉讼-全球

Harley I. Lwein 先生在商标、版权和相关的事务中有超过 25 年的从业经验。他执业的重点包括：(1) 决定商标和版权的可行性及注册商标和版权；(2) 有关商标和版权的正确使用的咨询、商业秘密的保护；(3) 通过指示、调查、谈判和诉讼等手段保护商标、版权和外观设计专利；(4) 进行涉及商标的许可问题、平行贸易、商标侵权、伪造商标、商标的淡化、错误的宣传、版权侵权和公共权利的问题的复杂的、综合的诉讼；(5) 有效解决涉及国际贸易的问题。

参加或任职的专业委员会

纽约律师协会的专利、商标和版权委员会的会员

美国知识产权法律协会的会员

国际商标协会的会员

反假冒委员会的主席（1991-1992）

海关的公众假冒教育委员会的主席，1993

国际反假冒联合会的会员