

TRADEMARK PROTECTION IN 2020: 10 SIMPLE THINGS TO CONSIDER

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Last year the USPTO implemented important changes to the rules for filing and examining trademark applications. Read our 10 simple ways to strengthen your application when seeking trademark protection in 2020.

1. ENSURE SPECIMENS PROVE USE IN COMMERCE

Specimens that previously passed muster may not prove use anymore. New standards require: (1) website screenshots to include the full URL and the date of the screenshot; (2) products previously shipped in plain boxes to bear a picture or description of the goods; and (3) hang tags to be actually affixed to the goods to qualify as use.

2. HIRE A U.S. ATTORNEY

Foreign trademark applicants are no longer permitted to file applications before the USPTO, but instead must retain an attorney licensed in the U.S.

3. GO PAPERLESS

All filings with very limited exceptions must be electronic. No more paper filings unless the application is subject to a treaty or the specimen is for a sound or a flavor.

4. KNOCK OUT UNAVAILABLE TRADEMARKS

Save money by doing a knock-out search to quickly determine if the mark is a no go. Before investing in the mark, a thorough search is warranted to clear the mark and avoid litigation.

5. NAME THE RIGHT PARTY

A trademark naming the wrong owner is *void ab initio*. Failing to name the correct applicant cannot be fixed after filing the application.

6. MAKE A LIST AND CHECK IT TWICE

Give careful thought to the goods and services associated with the trademark. The list can be narrowed during prosecution, but it cannot be expanded. For renewals, you must prove use on ALL goods and services listed in the application or registration.

7. NOT ALL USE IS CREATED EQUAL

To qualify as use in commerce, goods must be sold or transported, while services must be rendered. Mere advertising with no connection to the goods or services may not qualify.

8. #notatrademark

Marks using hashtags or the hash symbol (#) are eligible for registration only if the mark functions as an identifier of the source of the applicant's goods or services. [#useitwisely](#)

9. WHAT'S THE DIFFERENCE?

Marks that are distinctive or have secondary meaning may be registered on the principal register. Marks that do not qualify are limited to the supplemental register, which allows use of the ® and is a placeholder that blocks future trademark filings. If secondary meaning is achieved, the mark can matriculate to the principal register.

10. USE IT OR LOSE IT

Trademarks must be used continuously to avoid abandonment, and renewals require sworn statements of use. Keeping records of use over the years provides protection against challenges.

ADDITIONAL INFORMATION

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