

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# What Israeli trademark owners and practitioners should know about U.S. trademarks

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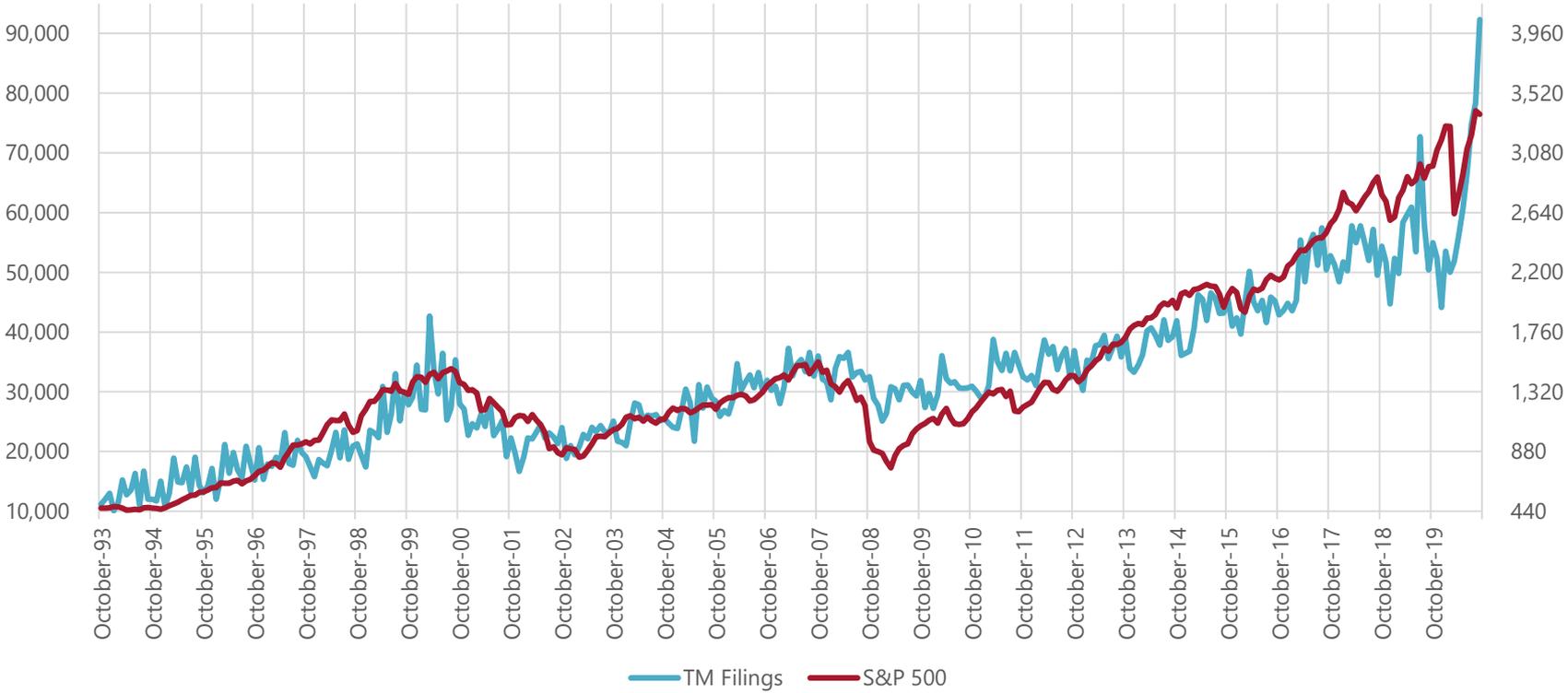


# What Israeli trademark owners and practitioners should know about U.S. trademarks

- Trademark operations
- COVID-19 special programs
- The basics of your U.S. trademark application
- Top 10 tips from law office managing attorneys
- Where to find help

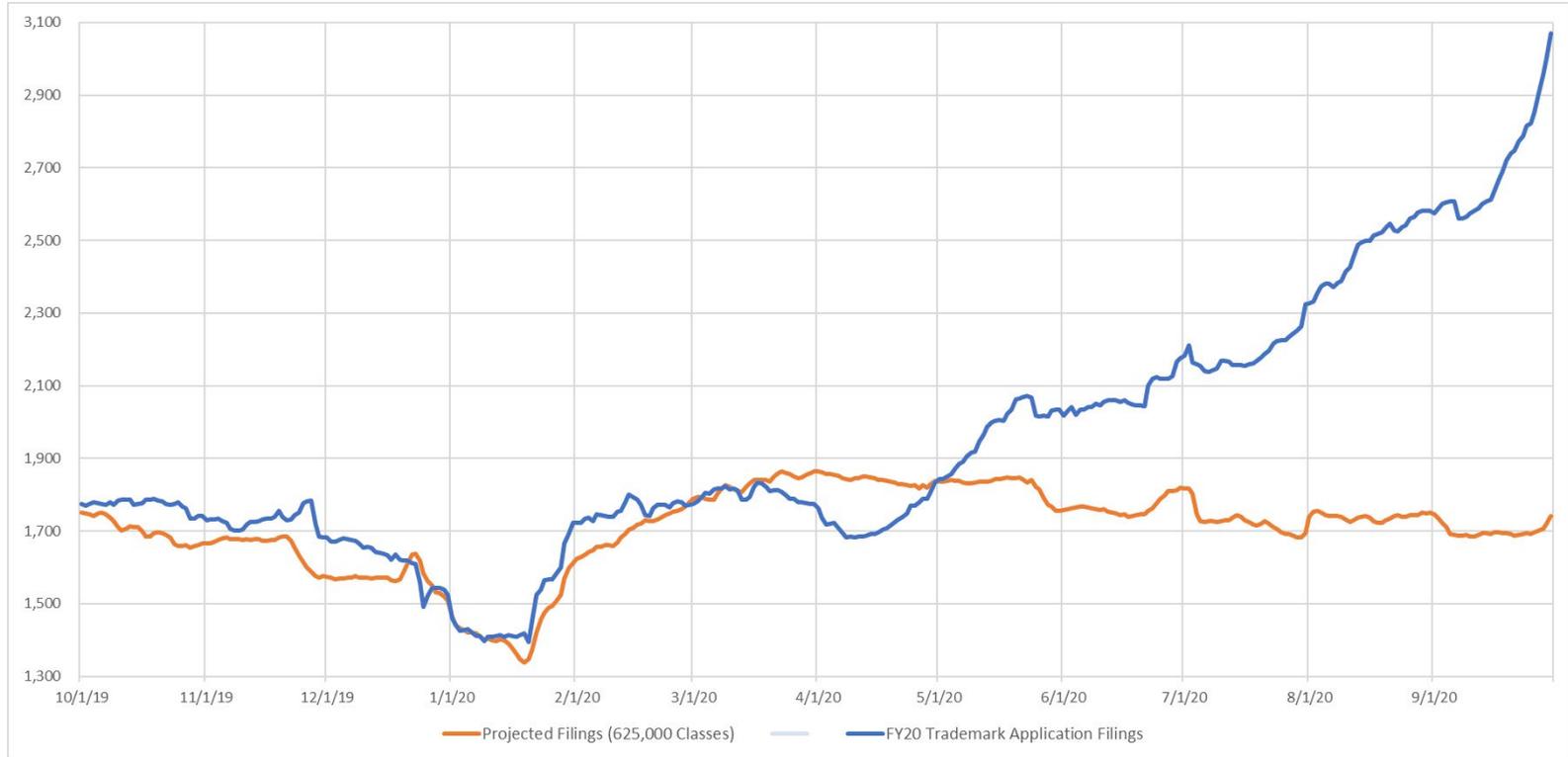
**Trademark (TM) operations**

# U.S. TM monthly filings vs. S&P 500 monthly average closing price



# FY20 daily trademark application filings

- Actuals compared to revised plan (625,000 classes)

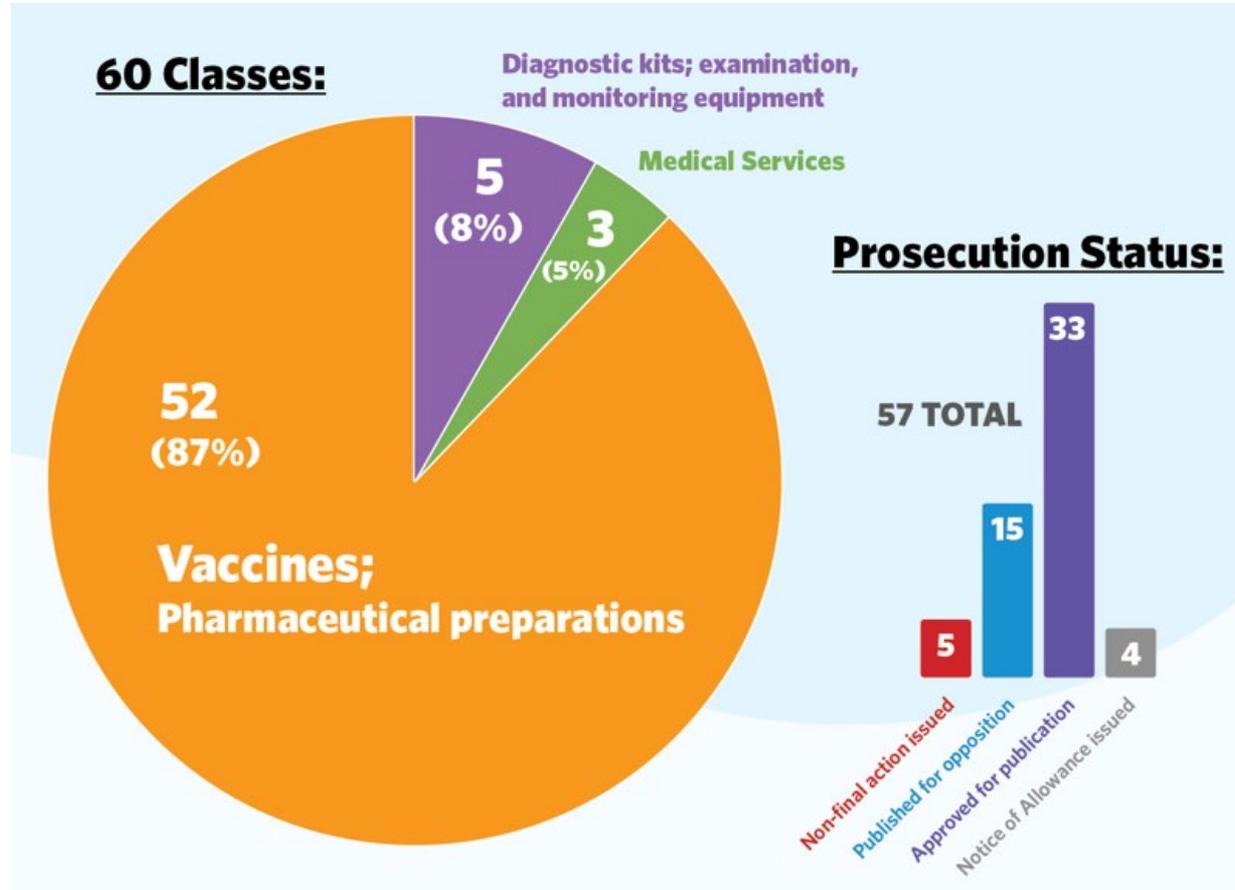


**COVID-19 special programs**

# COVID-19 customer relief

- **Priority examination program**
  - For goods/services whose aim is to fight COVID-19
  - Must be subject to FDA approval
- **Shortens the examination process by ~60 days**
- **Program started June 15, 2020**
  - 171 petitions received
  - 92 petitions granted to date

# COVID-19 customer relief



# **The basics of your U.S. trademark application**

# U.S. trademark law—The basics

- U.S. trademark system is based on the requirement of use “in commerce”
  - Interstate;
  - Territorial; and
  - Commerce between the U.S. and a foreign country
- Use required to obtain and/or to maintain a U.S. registration
- Impacts clearance, adoption, use, and protection of trademarks in the U.S.
  - Regardless of the owner’s home country



# U.S. trademark law—The basics

- U.S. law requires:
  - applicants,
  - registrants, and
  - parties to Trademark Trial and Appeal Board proceedings
    - to be represented before the USPTO by an attorney licensed in one of the 50 states
      - Effective August 3, 2019



# Filing bases

- Basis for initial filing may be:
  - **Use** in commerce (interstate or between the U.S. and another country)—section 1(a)
  - **Intent to use** (bona fide intent to use in the future)—section 1(b)
  - First filed foreign application—section 44(d)
  - Foreign registration—section 44(e)
  - Madrid Protocol applications—section 66(a)

# Specimen of use

- A specimen is an example of the mark being used in connection with the goods or services.
  - Goods: labels, hangtags, point-of-sale displays
  - Services: website, brochures, signs, or flyers

# Trademark application timelines

- Examination:
  - Current average: 3.4 months from filing to examination
- Registration:
  - Current average: 9.7 months after filing

# Maintenance required

- In the United States, registrants must submit:
  - Affidavit of continued use:
    - Between the fifth and sixth year, between the ninth and tenth year, and so on.
  - Renewal:
    - Between ninth and tenth year, and every 10 years thereafter
- Specimens of use are required

# **Top 10 tips from law office managing attorneys**

# Top 10 tips

From managing attorneys working with the office:

1. View the examiner as someone who wants to work with you to help achieve registration
  - Working with the examiner can achieve more than viewing them as an adversary

# Top 10 tips—Communications

## 2. Pick up the phone

- Respond/reach out to examiners ASAP if they've contacted you for an examiner's amendment inquiry
- Calling the managing attorney doesn't get the examiner in trouble

## 3. If an office action is issued:

- Read through any office action you receive before contacting the examining attorney
- Connect with examiner soon thereafter because establishing a dialogue may overcome any potential misunderstanding(s) on either side

# Top 10 tips—Applications

4. Use TEAS Plus if you need a registration quickly
  - It will make you provide more complete info and pick your ID from the manual, but you are more likely to get faster approval for publication
5. Volunteer a disclaimer
  - To eliminate an objection of clearly descriptive, generic, or incapable matter
6. Avoid common errors, e.g.:
  - Conflict between applicant name and entity type (e.g., name of individual in owner field but entity type that is LLC)
  - Ensure an accurate mark description and color claim (which match the depiction of the mark in the application)

# Top 10 tips—Identifications of goods and services

7. At a minimum, use IDs only from the ID manual
  - Even if don't want to or can't use Teas Plus
  - Can always narrow your ID but can't broaden it
8. Make sure you really know what the goods/services are
  - Don't just rely on what the client said
  - Resist the patent attorney urge to draft your ID like a patent claim
9. Make sure the ID reflects the end product, not the format of the specimen on which the mark appears
  - e.g., Don't describe the goods as "wine labels" when the product is actually wine.

# Top 10 tips—Specimens of use

10. If filing a use-based application, include more than one specimen in your application
  - Per class

**Where to find help**

# Educational resources

- Even if you are using U.S. counsel:
  - [www.uspto.gov/trademark](http://www.uspto.gov/trademark)
  - [“Basic Facts About Trademarks” booklet](#) or watch the [basics video](#).

The screenshot displays the USPTO website's 'Learning and Resources' section. At the top, the USPTO logo and navigation links are visible. The main content area is organized into a grid of six resource cards:

- Trademark basics** (TM icon):> Do I need a U.S.-licensed attorney?> Trademark fee information> Timeline to process an application> Free resources in your state
- Search trademarks** (Magnifying glass icon):> Develop a search strategy> How to use the Trademark Electronic Search System (TESS)
- Apply for a trademark** (ID Manual icon):> How do I apply using the Trademark Electronic Application System (TEAS)?> Respond to an office action> Select goods & services in ID Manual
- Protect trademarks** (Person icon):> Protect your trademark rights> I suspect a scam or misleading notice. What should I do?> Watch out for counterfeit goods
- Maintain your registration** (Refresh icon):> How do I renew my trademark?> What happens if my trademark registration is audited?
- Laws and rules** (Scales icon):> CARES Act FAQs> Rule making> Examination guides> Trademark Manual of Examination Procedure (TMEP)

Below this grid is a navigation bar with four options: Search (TESS), Select (ID Manual), Forms (TEAS), and Status (TSDR). Underneath are three featured content blocks:

- DIRECTOR'S BLOG**: USPTO fights trademark scams (Image: 'FRAUDULENT SOLICITATIONS to Trademark Owners')
- FAQS**: CARES Act frequently asked questions (Image: Numbers 4-9, 11-16, 18-23)
- ANTI-COUNTERFEITING CAMPAIGN**: Learn about the dangers of fake goods and services (Image: Person with a bicycle helmet)

# Need more help?

- Trademark Assistance Center
  - Provides general information about the registration process
  - Responds to status inquiries
  - 8:30 a.m. to 8 p.m. ET, Monday-Friday
  - +1 571-272-9250 or 800-786-9199
  - Email:
    - [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)



## Trademark Assistance Center (TAC)

The Trademark Assistance Center (TAC) provides general information about the trademark registration process and responds to inquiries about the status of trademark applications and registrations. The location of the Trademark Assistance Center is Madison East, Concourse Level, 600 Dulany Street, Alexandria, VA 22314. Telephone assistance is available Monday through Friday (except federal holidays) from 8:30 a.m. to 8 p.m. ET. Walk-in assistance is available Monday through Friday (except federal holidays) from 8:30 a.m. to 5 p.m. ET.

You can also check the status of an application or registration through Trademark Applications and Registrations Retrieval ("TARR") database at <http://tarr.uspto.gov/>.

800-786-9199 (toll-free) | 571-272-9250 (local)





**Thank you!**

[www.uspto.gov](http://www.uspto.gov)