

## **Registration of a US or Canadian Trademark**

### **Introduction**

Many businesses are keen to ensure that their brands have the widest possible protection. The North American market is a particularly important one for many UK-based businesses. This note explains how we can assist with the registration of your trademark in the US and Canada.

### **Application procedure**

The application procedure for trademarks in the US is similar to that followed in the UK and EU but has one significant difference which may affect your strategy and will certainly affect the fees required.

As with a UK or a Community Trademark your application will go through the following stages:

1. Filing – you will need to begin the process by filing an application with the United States Patent and Trademark Office (USPTO). The application will need to include a clear representation of the mark and a specification detailing the classes and goods in which you wish to have the mark registered.
2. Examination – subject to the application being filed correctly, the mark will then be examined by the USPTO to ensure it complies with all necessary requirements and is capable of being registered i.e. that it is distinctive; not descriptive; not capable of being confused with another registered mark.
3. Publication – if the USPTO raise no objections, the mark will then be published in the 'Official Gazette'. Any other mark owner who believes the mark could be confused with theirs has 30 days from publication in which to file an opposition to your application with the USPTO.
4. Registration – providing there is no opposition to the application or that any opposition is unsuccessful the USPTO will proceed to register the mark and should issue a certificate of registration within 12 weeks of it being published.

### **Use**

The major difference with a US trademark application is that before the mark can be registered you need to be able to demonstrate that it is in use on goods and/or services in the US.

You are able to apply before the mark is in use and in such a case your application will be made on an intent-to-use basis. Should an intent-to-use application successfully reach stage

4 above then instead of the mark being registered a Notice of Allowance will be issued. Within six months of the Notice of Allowance being issued you will need to file a Statement of Use which demonstrates the mark is being used in commerce with the goods and/or services for which you wish to register the mark.

If the mark is still not in use within six months then you can apply for an extension of time giving a further six months in which to file the Statement of Use. Such extensions can be applied for five times meaning that in effect you have three years from the Notice of Allowance to put the mark into use (or approximately four years from when you first apply).

Filing a Statement of Use and an application for an extension of time will necessarily incur additional costs (see below for fees information). One way to deal with this issue is for your specification of goods to be narrowed to only include those on which the mark will be (or is already) in use in the US in the near future. Alternatively, the specification can be broader and include goods with which the mark might be in use within the next 3 to 4 years. If some goods specified do come into use but others do not the application can be split with a Statement of Use filed in relation to the goods where the mark is actually in use (with Registration following accordingly) and the application continuing on an intent-to-use basis for those other goods (with extensions of time applied for as appropriate). Following the final permitted extension the application will lapse in relation to those goods where the mark is not in use.

## **Fees**

For US trademark applications we instruct a law firm in the US as our agents with whom we have negotiated very competitive rates. Please get in touch for more information about the fees and costs involved.

## **Canada**

The process for registering a trademark in Canada follows a similar procedure to that outlined above for the US – following filing of an application, there will be a period of examination followed by publication when there is an opportunity for others to oppose the application. Assuming there is no opposition or any opposition is overcome the mark will be registered and the whole process should take between 18 and 24 months (assuming there are no objections and nobody files an opposition)

As with the US, registration will only be granted if you make a declaration of use of the mark on those goods for which you have applied for the mark to be registered. If this cannot be provided when it comes to the registration stage then you are again able to file an extension of time application (for an additional fee).

Unlike with the US, there is no classification system in Canada so you will not need to pay additional fees for additional classes.

Our US agents are also able to deal with an application in Canada.

Please contact Guy Wilmot on 0208 394 6531 if you have any queries.

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