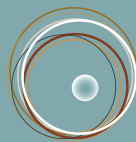


Oh No! There Was an Issue with My Trademark Application?

A Brief Guide to Overcoming USPTO Office Actions

By Steven H. Weigler, Attorney at Law



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AND EMERGING BUSINESSES

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TABLE OF CONTENTS

- INTRODUCTION 5**
- HOW DOES THE APPLICATION PROCESS WORK? 7**
 - Filing Your Application..... 7*
 - Trademark Acceptance or Denial 7*
- WHAT DOES MY OFFICE ACTION MEAN? 8**
 - Technical Issues 8*
 - GENERAL TECHNICAL ISSUES..... 8
 - DRAWING ISSUES..... 11
 - Substantive Issues 13*
 - GENERIC, DESCRIPTIVE, OR SUGGESTIVE TERMS 13
 - FUNCTIONAL TERMS 16
 - LIKELIHOOD OF CONFUSION 17
 - Deal Killers..... 18*
 - DILUTION OF FAMOUS TRADEMARKS 18
 - CANCELATION OF A DISPARAGING MARK 19
 - CANCELATION FOR ABANDONMENT OF MARK..... 19
- NOW THAT I UNDERSTAND WHY I GOT AN OFFICE ACTION,
HOW DO I RESPOND TO IT? 20**
- WHAT’S THE NEXT STEP? 21**
- ABOUT EMERGE COUNSEL 22**
 - Introducing TotalTM..... 23*

INTRODUCTION

Trademark is an arcane area of law, and statistics demonstrate that United States Patent and Trademark Office (USPTO) filings face a high percentage of failure. In fact, according to a [2013 Stanford study](#), **six out of ten trademarks filed without attorneys fail to register.**

That means that if you file a trademark application without using a trademark attorney, there's a 60% chance that your application will be denied.

Furthermore, if you file an application incorrectly, the protection for the mark could be canceled and you could even be sued by another brand for trademark infringement.

Federal trademark protection is extremely important for anyone who wants to create a unique brand and enjoy the protection of exclusivity. Trademark protection helps you:

- Deter others from remotely coming close to your brand, logo, or trade name—even if your brand is relatively new.
- Take necessary legal action in federal court and receive damages from, and injunctions against, any infringers.

In part because they offer such strong protection, trademarks are property (like a home or a car), and property has value.

For example, Google's trademark is considered its most valuable asset, and is estimated to be worth billions and billions of dollars. Why? Because trademarks protect brands, and without a strong brand, your goods or services are not very valuable—compare Google to the now-defunct InfoSeek, for example.



Furthermore, almost every major brand applies for trademarks early and often. For example, Five Guys Burger and Fries (a fast-casual restaurant chain) trademarked this:



This trademark basically protects their entire menu—as well as the look and feel—in one fell swoop. And even though their main product is hamburgers, their mark does not come close to other trademarked competitors in the same space, like McDonald’s or Burger King.



Big brands also protect their own marks. McDonald’s, for instance, protects almost every one of its products through trademark, including the Big Mac and the Filet-O-Fish.



If you are reading this, you have probably applied for a trademark and been denied (i.e., you have been issued an **Office action**). You have gotten this far because protecting your brand is important to you—so let's explore the issues you may be facing with the USPTO and figure out the best next step for you.

HOW DOES THE APPLICATION PROCESS WORK?

The USPTO is in charge of policing trademarks. Everybody who files a trademark needs to go through the same process, and even very wealthy companies are denied trademark protection sometimes. For example, Walmart was denied trademark protection for the “happy face” symbol, right, and Twitter was denied trademark protection for the word “tweet.”



Filing Your Application

Most trademark applications are completed online these days, and the USPTO has in-depth online instructions. The USPTO also has an excellent assistance center that will walk you through any technical issues (e.g., what form to use)—you can call them at 1-800-786-9199.

When an application is filed, the USPTO assigns an **examining attorney** to review it. This usually occurs within four to six months.

Trademark Acceptance or Denial

If the examining attorney sees no issues, they will move the application to publication in the USPTO Trademark Official Gazette. Publication gives the public the opportunity to review and object to the mark (although very few people actually look at the Gazette).

If the examining attorney sees perceived issues, they will file an Office action. In the Office action, the examining attorney will explain the issues and provide six months to respond to their objection(s). If you do not submit a response within six months, the application will be abandoned, meaning that your protection will be removed and your trademark could be in jeopardy.

Wondering what your Office action means? Let's go through the main types of Office actions, why they are usually issued, and how to correct the problems with your trademark application.

WHAT DOES MY OFFICE ACTION MEAN?

Okay, so you filed a trademark application and the USPTO examining attorney issued an Office action because they perceived an issue or problem with your application. What does the Office action mean? And how do you fix it?

The most common issues seen in USPTO Office actions can be grouped into three categories:

1. Technical Issues
2. Substantive Issues
3. Deal Killers

Let's go through each category to see what your Office action means and how you can fix the issues with your trademark application.

Technical Issues

Statistics gathered by the USPTO show that over [80% of trademarks filed have one or more technical issues that require a response](#). This is because trademark law is very technical, and USPTO examining attorneys need to follow the Trademark Manual of Examining Procedure, which is basically a gigantic list of guidelines, processes, and procedures.

If your Office action states that you have a technical issue, it will usually involve some version of the following:

GENERAL TECHNICAL ISSUES

1. The trademark owner listed on the application is not correct.

For example, an individual is listed in the mark, but a company is listed on the application.

2. It is not clear who will own the trademark.

Sometimes, the applicant is less than clear on who is actually applying for the trademark. Most entrepreneurs register their intellectual property to their entity (e.g., XYZ LLC as opposed to Joe Smith, who is the owner). If you want the trademark to register to the entity, include the entity's registration in your application (if the company is an LLC or corporation, this information can be found at your state's secretary of state website or in your personal records).

3. The signature is wrong because it does not indicate the authority of the application.

If you sign for an entity, you need to explain your authority over the entity and/or what gives you the legal authority to sign for it. For example, “A general partnership, by Jane Smith, General Partner” as opposed to just “by Jane Smith.”

4. The class description does not match the evidence.

This is a tricky issue. The USPTO employs a filing system called the Nice Classification (NCL), in which it classifies all trademarks. In filing an application, you were supposed to choose one or more of the classes and pay a separate fee for each class.

You can file your trademark application in one of three ways: on paper (which hardly anyone does unless they do not have access to the Internet), using TEAS (where you customize the description), or using TEAS Plus (where there are numerous [prepopulated descriptions](#)).

As you may have discovered, the TEAS Plus application is the cheapest, but the prepopulated description that the system assigns your mark sometimes does not match what you are actually doing or offering.

For example, I recently assisted a client who had filed under Class 43 (Hotels and Restaurants). However, what they identified in their specimen was their house brand of wine, which is a good (Class 33). The registration needed to be changed to match the specimen with the service (i.e., using a picture of the restaurant as opposed to a picture of their wine).

5. Certain elements of the mark need to be “disclaimed.”

We see the word “disclaimer” a lot, but what does it actually mean? According to the USPTO, a disclaimer is “a statement that you include in your application to indicate that you do not claim exclusive rights to an unregistrable portion of your mark.”

Basically, this means that you are admitting that there is something about your mark that cannot be registered, such as a common item or word that you do not (and cannot) claim ownership of.

For example, “McDonald’s Hamburgers” is trademarked, but McDonald’s had to disclaim “hamburgers” because hamburgers are made all over the world, and accordingly no party can claim ownership of the generic term. This is the same with pizza, zippers, clocks, and other common words or items.



Generally, I suggest you wait for the USPTO to request a disclaimer rather than disclaiming anything on the initial application.

If your Office action requires you to disclaim an aspect of the mark, go to [this website](#) and fill in the mark’s serial number. Click additional statements and then navigate to the area that says: “Disclaimer: No claim is made to the exclusive right to use _____ apart from the mark” and simply fill in the blank.

6. You used the wrong international category for the goods or services.

For example, if you are trademarking a law firm, the international category is IC 45. If it is indicated in the description that you write law journals, the category becomes IC 16.

You can search for the appropriate category [here](#).

One trick of the trade is to find an analogous trademark that has cleared the USPTO search. For example, if you were opening a burrito stand and needed to know your IC code, you could search the USPTO [Trademark Electronic Search System \(TESS\)](#) for the description of the Chipotle trademark to see what IC code was approved for that brand.

7. You confused an “intent to use” application with an “actual use” application.

Many applicants get confused between a **1(a) application** and a **1(b) application**.

If you filed a 1(b) application, it acts like a reservation. You have essentially told the USPTO that you intend to use the mark and are accordingly reserving it. This means that you will submit a specimen demonstrating use in commerce at a later time (six months after receiving permission to use, but you are allowed four six-month extensions per application).

If you filed a 1(a) application or a “statement of use,” you need to show actual use in commerce. You do so through a specimen. Your failure to provide a specimen creates an Office action.

If the trademark is for a good (e.g., beer), the application specimen must show the actual good in commerce (e.g., the beer logo on a bottle of beer in the store). It cannot be a website or a business card, and it usually should not be sales collateral (like a brochure).

If the trademark is for a service (e.g., law practice), you can use a website or business card in part because it is impossible to show an actual service in commerce.

DRAWING ISSUES

Before we get into the common Office actions for drawing issues, it’s important to know that there are **non-stylized word marks** and **stylized design marks**. You need to know which one you are applying for.

I usually recommend that you receive protection on both (e.g., the non-stylized word mark “NIKE” and the stylized design mark, below).

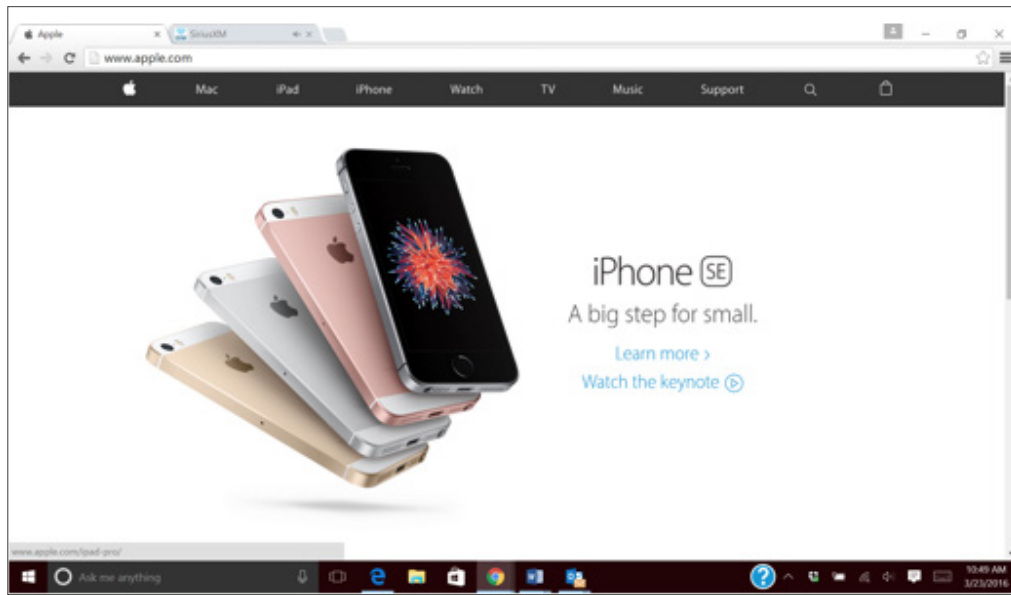


Furthermore, one does not usually protect the other. That is, if you use a stylized mark, you need to show the mark in a **drawing** as well as the mark being used in commerce (a **specimen**).

The USPTO is very picky, and specimens and drawings must follow the USPTO guidelines precisely. Here are the common problems with drawings:

1. The drawing includes items other than the mark being applied for.

The drawing has other items in it, like the below image, which is a screenshot of a Web page with the mark (the Apple logo) on it.



Make sure the drawing only includes the word or design you are attempting to protect. It should not have a TM symbol, and it has to be original enough to trademark.

2. The drawing does not match the specimen.

For example, the specimen is black and white and the drawing is in color.

If color is claimed as a feature of the mark, then both the drawing and the specimen need to be in the colors claimed. Match the colors exactly: the mark in use must mirror the drawing.

3. The specimen does not match the description of the good or service.

For example, if a party claims IC 09 for burglar alarms, the specimen should show a burglar alarm keypad and possibly some sensors next to a box on a store shelf. Remember that you need to show the mark actually being used in commerce.

4. You claimed a good as a service, or a service as a good.

There are 45 categories of goods and services classified under the USPTO's Nice Classification (NCL). The first 35 are **goods**. The rest are **services**.

Goods are something tangible (like a burrito). Services are something intangible (like the restaurant that serves the burrito). The Big Mac is a good. McDonald's is a service.

5. There is no evidence of use where evidence of use is claimed.

If you filed a 1(a) application, you needed to show the mark in commerce.

Using a mark in commerce is a fact-specific exercise, meaning that you have to establish that you are selling the good or service in the United States.

For example, if you live in Canada and bring a pie to your sister in Montana ^{in a while} **once and awhile** and only charge her for the cost of the ingredients, that is not actually using the mark in commerce. However, if you are actively and consistently selling pies, you are using the mark in commerce.

Your USPTO examining attorney is usually going to take your word for it; however, your mark may be subject to cancellation if you are less than truthful on this matter.

Substantive Issues

If you received an Office action indicating that your mark is too generic, descriptive, or suggestive, or that it may cause a likelihood of confusion, you are looking at a substantive issue.

Trademark attorneys who address these types of issues look for analogous cases where the USPTO allowed the mark. They then write a substantive response (a legal brief) where—if the evidence exists—they are able to argue the case to the examining attorney.

GENERIC, DESCRIPTIVE, OR SUGGESTIVE TERMS

USPTO Office actions that refer to **generic**, **descriptive**, or **suggestive** terms have to do with what the law, called the Lanham Act, allows to be trademarked. Under these guidelines, **fanciful marks** and **arbitrary marks** are afforded the most protection.

Fanciful marks are marks that have no built-in meaning. Famous fanciful marks include Nikon, Exxon, Lexus, and Cheerios.



Arbitrary marks are existing words with no relation to the goods or services with which they are presumed to be associated. Examples include Apple (for computers), Shell (for petroleum), and Windows (for software).



If your mark is not perceived as fanciful or arbitrary under the Lanham Act, you are afforded less protection, and your mark is most likely too generic, descriptive, or suggestive.

Too Generic

A **generic term** is the name of a particular genus or class that an individual article or service is only a member of (e.g., aspirin or cellophane). A generic term is not protectable, and when a trademarked term becomes too generic, the mark's registration is canceled.

For example, in *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, the U.S. Court of Appeals for the Federal Circuit ruled that using the term "Pretzel Crisp" for a type of pretzel crackers was too generic to be trademarked. Accordingly, the trademark was canceled, even though a company was branding under that name. This allowed Frito Lay to use the term "Pretzel Crisp." In a surprising twist, the Court overturned their ruling in May 2015 and accordingly, Frito Lay can no longer utilize "Pretzel Crisp."

Receiving this objection from a USPTO examining attorney is rare, and it can be very difficult to overcome.

Too Descriptive

A **descriptive term** identifies a characteristic or quality of an article or service (e.g., “Vision Center” for a business offering optical goods and services).

For example, in *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc. dba Watermark Cruises*, the Trademark Trial and Appeal Board (TTAB) canceled “Annapolis Tours” for guided tours of cities because the name was merely a descriptive term.

Similarly, in *DuoProSS Meditech Co. v. Inviro Medical Devices, Ltd.*, the U.S. Court of Appeals for the Federal Circuit found the marks and design of “Snap” and “Snap Simply Safer” were merely descriptive for medical syringes.

Too Suggestive

As opposed to a descriptive term, a **suggestive term** may be protected if it is primarily distinctive. A suggestive term suggests, rather than describes, particular characteristics of the goods or services to which it applies.

A suggestive term requires the consumer to exercise imagination in order to draw a conclusion as to the nature of the goods and services (e.g., Coppertone, Roach Motel).

In *In re King Productions, Inc.*, the TTAB sought registration for the mark “Rock Your Body” for books and DVDs in the fields of dance, exercise, and fitness. This mark was found protectable by trademark because the applicant made a sufficient showing that the mark was suggestive enough to have acquired distinctiveness.

If the USPTO examining attorney considers your mark too descriptive or suggestive, you will need to explain why it is distinctive enough to be placed on the Principal Register.

Explaining Why Your Mark is Distinctive as Opposed to Descriptive or Suggestive

If the mark has been used in commerce for over five years, the USPTO will likely assume that the mark is descriptive. For example, “Denver Country Club” is at first glance a descriptive mark because there is a country club and it is in Denver. However, because the country club has been around for so long in Denver, there is a connotation of secondary meaning (i.e., it is not just a country club in Denver).

The same holds true with “The White House,” which is obviously not just a white house. Instead, it has a secondary meaning: it is where the president of the United States lives and conducts his business.

If the mark is new (or less than five years old), you can still claim that the mark is distinctive by collecting evidence on how the general public sees it as being distinctive. You will need to show how the descriptive mark has essentially become a brand, and you can do this through market studies, surveys, or by demonstrating a large marketing budget.

I would suggest contacting the USPTO examining attorney to review your proposed evidence before taking on the time and expense required to collect this evidence.

Explaining that your mark is distinctive is a difficult (but possible!) process, and you may want to hire a trademark attorney to assist you.

FUNCTIONAL TERMS

Trademarks cannot be functional (i.e., essential to the use or purpose of the article, or affecting the cost or quality of the article). This rule prevents trademark law from inhibiting legitimate competition by allowing one producer to control a useful product feature.

In *In re Florists’ Transworld Delivery, Inc.*, the TTAB upheld a refusal to register a specific color as applied to packaging for flowers and floral arrangements because it was aesthetically **functional**.

Likewise, in *re Pohl-Boskamp GmbH & Co. KG*, the TTAB refused registration of the flavor and scent of peppermint for nitroglycerin spray (to prevent heart attacks), finding that the flavor was **functional** and a product attribute as opposed to a source indicator.

A trademark is how you market your goods and service—it is not literally your actual good or service. If the USPTO cannot find enough evidence that the mark is not related to how you hold yourself out to the relevant market, there is a flaw in how you claimed the mark.

If you received an Office action that objected to your trademark because it was too functional, you should then take a step back to assure that you prepared an application that shows how the mark holds itself out to your market. For example, as opposed to claiming the peppermint scent above, the company could claim the name of scent as “Bad Breath Saver” instead.

LIKELIHOOD OF CONFUSION

Likelihood of confusion means that your mark is similar enough to another that confusion can be expected. When goods are totally unrelated, there can be no likelihood of confusion. When goods are in related fields, however, marks can be confusing. **This is the most common trademark refusal.** It is essential to do a thorough trademark search through a trademark attorney or another experienced source to avoid losing your trademark due to the likelihood of confusion (also called a “confusion refusal”).

A confusion refusal can also tip off the original trademark owner, leading him or her to possibly sue you for trademark infringement damages.

Examples of likelihood of confusion include the following:

In *In re Viterra Inc.*, the U.S. Court of Appeals for the Federal Circuit issued an opinion ruling that Viterra’s proposed “Xceed” trademark for agricultural seeds was likely to cause confusion with another company’s already-registered “X-seed” word and design mark for identical goods.

In *Central Garden & Pet Company v. Dorskocil Manufacturing Company, Inc.*, The TTAB canceled “Zilla” based on the likelihood of confusion with the registered “Petzilla” and “Dogzilla.”

In *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, Nestle’s “Beggin’ Strips” mark for pet treats has been in use since 1988 and was registered in 1989. A company tried to trademark “Waggin’ Strips” and was prohibited from doing so because the Federal Circuit indicated that a) Nestle’s “Beggin’ Strips” was filed first, b) Nestle had large strength in the mark, c) the marks were overly similar, d) the products were identical, and e) trade channels and customers for the product overlapped.

Although there are many factors in play here, you likely received a confusion refusal because:

- Your mark is similar to another registered mark in appearance, sound, connotation, and/or commercial impression.
- The already-registered mark is well known or famous.
- You are found not to have the right to exclude others from using the mark or a similar mark.
- The already-registered mark is within your market (e.g., fast food), or in a similar market.

If you are not sure how to respond to this Office action, consider hiring a trademark attorney to help you navigate the waters and prepare a solid response.

Deal Killers

If you find yourself addressing an Office action that deals with the following issues, you most likely have serious trademark problems, and you may want to hire a trademark attorney and possibly even consider rebranding.

DILUTION OF FAMOUS TRADEMARKS

If a trademark is famous (e.g., Coca-Cola, AT&T), it is afforded additional protection separate from the “likelihood of confusion” protection.

For example, in *Defining Presence Marketing Group, Inc. (DPMG)*, the company filed four separate applications to register the mark “Crackberry” for various marketing services, computer services, online chat rooms, electronic bulletin-board services, and assorted clothing items. The mark was denied protection because “Blackberry” is a famous mark.

CANCELATION OF A DISPARAGING MARK

Anyone can challenge a mark because it is disparaging against a class of people.

For example, in *Harijo v. Pro Football, Inc.*, the TTAB ordered the cancellation of six Pro-Football, Inc. “Redskins” trademark registrations, finding the marks disparaging to Native Americans. However, the courts reversed the decision and the case is currently in flux.



CANCELATION FOR ABANDONMENT OF MARK

There are many ways that this may come up. The first is administrative: for example, you filed a trademark application and then never filed a response to Office action. Usually [you can revive it for a fee](#), as long as no other party has claimed the mark at issue.

Cancellation also occurs when you are found to not be actively using the mark, or if you have tried to register a mark just for the purpose of registering it. It is important to keep trademark filings current and utilize the mark consistently.

For example, in *City National Bank v. OPGI Management GP Inc.*, the TTAB granted a petition to cancel a registration for the mark “TreasuryNet” for financial information services on the ground of abandonment, finding that the registrant’s internal use of the mark for its own benefit was not a use in commerce. Specifically, there was no advertising or outside use of the “TreasuryNet” mark.

Similarly, in *SaddleSprings, Inc. v. Mad Croc Brands, Inc.*, the TTAB ruled that even though the mark “Croc-Tail” was used internationally, it was never used in the United States. Accordingly, the USPTO could cancel the mark for non-use.

Just because you have obtained or are close to receiving a trademark, this does not mean that you will not ultimately have to demonstrate that you are actually **using it in commerce**.

If another party cares enough to bring it up to the USPTO and there is ultimately no evidence of use, this brings up serious problems that are going to be hard to overcome (in part because you would not have the mark unless you told the USPTO that you were actually using the mark in commerce).

NOW THAT I UNDERSTAND WHY I GOT AN OFFICE ACTION, HOW DO I RESPOND TO IT?

Filing a response to an Office action can be daunting. If you decide to file the [USPTO Response to Office Action form](#) yourself, you can do so [here](#). (Filling in the serial number will auto-populate the document.)

If you mess up your response, you will usually get another chance, but not always. Your USPTO attorney might call you, explain the problem, and then issue what is called a **priority action**.

Alternatively, your attorney could issue a **final Office action**, which explains that you have failed to amend the problems raised in the initial Office action. If you receive a final Office action, it is time to call a trademark attorney. Things to remember in your response:

- Your response (and your entire trademark application) is a legal document. Accordingly, anything you write can be used against you in a court of law.
- Pay particular attention to what the USPTO examining attorney emphasizes, and focus your response on the particular factors they bring up.
- USPTO examining attorneys are presumed to be correct in their determination that there is a likelihood of confusion. That is partially why this particular objection can be difficult to argue successfully.
- A **coexistence agreement** (showing that the parties have worked out how the marks can coexist) or a **consent agreement** (showing that the senior party has allowed the junior party the right to coexist, or does not see an issue) will usually overcome the USPTO examining attorney's objection. However, notifying a party who has a trademark that you may be emulating is very risky, and the outcome may be a cease and desist order and perhaps even a threatened lawsuit against you. Accordingly, if you are in this situation, I strongly encourage you to strategize and negotiate the terms of the contract with an experienced trademark attorney.
- USPTO examining attorneys have limited time and patience for addressing this issue. Accordingly, remember to consider their issues and be respectful of their time.

Important things to note:

- USPTO examining attorneys always list their contact information at the bottom of the Office action. They are supposed to return your calls and emails, and most are extremely professional and do so. Some examining attorneys are extremely helpful; some are not. Regardless, you should absolutely reach out to the USPTO examining attorney before you issue a response in order to make sure you are doing it right.
- Do not sit on the application or procrastinate taking the necessary action. If you miss the six-month deadline, your trademark will be considered “dead,” and you will need to re-file...if you are still allowed to.
- Trademark attorneys can address these issues quickly and efficiently—if you have questions about your Office action(s) or need help with your response, it may be worthwhile to hire a trademark attorney.

WHAT'S THE NEXT STEP?

I hope this guide has helped you understand why you received a USPTO Office action and how you should respond.

Trademark law is a very arcane area with lots of tricky procedural and substantive issues.

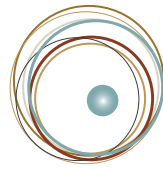
Time is money, and a trademark attorney can give you the peace of mind that your trademark application or Office action response has been handled in the best way possible.

Remember: even if you are able to get past an Office action successfully on your own, your brand is still vulnerable. A good trademark attorney will help you protect your entire brand strategy and should ensure that you are getting the maximum amount of intellectual property protection for the minimum price.

If you are currently facing a USPTO Office action, hiring an experienced intellectual property (IP) attorney is your best shot at turning your trademark goals into a reality.

ABOUT EMERSECOUNSEL

EmergeCounsel focuses on intellectual property (IP) protection and general counsel services for businesses across the U.S. The founder of EmmergeCounsel, Steven Weigler, has over a decade of branding and marketing experience and is a specialist in all areas of trademark law. We are located in Denver, Colorado, and we are available to help you strategize your intellectual property protection and overall business needs. Give us a call or visit our website for more information.



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Introducing TotalTM

EmergeCounsel's number-one mission is to offer you the maximum amount of trademark protection at a minimum cost. As a TotalTM client, you will benefit from comprehensive services usually provided to major corporations by the large (and very expensive) law firms. We are your partners in securing and protecting your trademark.

TOTALTM'S OFFICE ACTION RESPONSE SERVICE

Are you facing a USPTO Office action on your trademark application? EmERGEcounsel has years of technical trademark experience, and can quickly define the problem and offer expert advice on how to overcome it.

For technical office actions, we will issue a response for a flat rate of \$285 (this is included in the TotalTM Complete Trademark Package).

For complex office actions (likelihood of confusion, descriptiveness, etc.), we will research, strategize, and submit a response for \$285 per hour or a \$1,000 flat fee—whichever is most cost-effective for you.

TOTALTM'S COMPLETE TRADEMARK PACKAGE

The TotalTM Complete Trademark Package has everything you'll need to plan for, register, and protect your trademark, including:

1. **Strategic discussions** about your branding and trademark needs.
2. A comprehensive **trademark search** using multiple sources.
3. Suggestions for proper **trademark categorization** to minimize cost and maximize your trademark's protection.
4. Phone or in-person **consultations** as needed.
5. USPTO trademark **application preparation**.
6. **Responding to technical Office actions** issued by the USPTO.
7. **Filing all forms and paperwork** throughout the process.
8. One year of **defensive monitoring** alerting you to any possible threats to your trademark.
9. **Discounted rates** for EmERGEcounsel's other customized legal services.

The Total™ Complete Trademark Package is available to EmergeCounsel clients at the low rate of \$850 plus the USPTO filing fee, which ranges from \$225 to \$325. There are discounts for multiple marks—contact us for pricing.

Contact us at 720-213-0687 or emergecounsel.com to learn more about Total™ and our other trademark services. Start protecting your intellectual property today!

DISCLAIMERS

Steven Wiegler and EmergeCounsel are not providing legal advice in this eBook. This eBook was prepared for general information purposes only. Furthermore, there is no attorney-client relationship until and unless one is entered into.

This eBook is intended to address the most common situations related to Office actions. There are a number of other things that can happen with a trademark that are outside the scope of this guide. There are also issues of Office actions related to international registration, which this guide does not cover.

Every U.S. state has trademark registries. Some utilize the same process and procedures. Some do not even review the mark. Regardless, the laws of each state, although analogous to federal law, are not the same. Accordingly, if you receive some sort of objection from a state, you must utilize and apply state law.