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CLIENT INFORMATION SHEET

The Trademark Process

In procuring trademarks / service marks, the following general information will assist you in an understanding of the procedures and costs involved in obtaining trademark protection.

The starting point for consideration of a proposed new trademark is checking the availability of the new mark with a pre filing search. If we bypass this procedure we risk the possibility of running into a conflict within the Trademark Office after incurring the expense of filing procedures, not to mention the expenses that may be incurred in changing various print materials. Accordingly, we generally recommend that a search for availability of a proposed mark be conducted. Our office accesses the SAEGIS on-line trademark database service which database includes pending and issued federal and state applications and registrations.

The availability of a proposed trademark must be determined by considering whether any confusing similarity exists between the proposed mark and the marks turned up in the search. In addition, consideration must be given to the nature of the respective goods and services in determining whether any conflict exists. If it is determined that the marks are similar and the goods or services operate in the same or related channel of trade, then a conflict exists and the mark would not be available.

A preliminary search is usually a good indication of availability. The cost of conducting a preliminary, on-line database search is based upon the actual online time, expense and the attorney's time involved in considering and reporting the search results. Common or frequently used words in the trademark will obviously involve greater searching time. Searches directed to designs or logos may be more.

A Preliminary Trademark Search takes into account federal trademark registrations and pending federal trademark applications. The preliminary search does not extend to non-registered or common law sources, nor does it cover similar or identical trade name usage (business and corporate names) or design / logo-style marks. This information can only be obtained by a full search which we would recommend before adopting a mark, and before any major expenditures for advertising and marketing are undertaken.

If, after completing the preliminary search, a more comprehensive search is necessary, a full search can be conducted through a professional searching organization such as Thomson Reuters. The Full Search extends to areas such as state trademark files, trade directories, logo-style marks and domain name registrations. If a pre-filing search is not conducted, we cannot render any opinion as to registerability and availability of the mark.

Marks which appear available for use and registration may then be filed with the U.S. Patent and Trademark Office. The procedure for filing a mark is the same in both the case of a mark which has been used in interstate commerce and a mark to which there is a bona fide intention to use ("ITU"). Also, if the mark incorporates a design, there may be an additional

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drafting expense for the requisite formal drawing, if the client cannot provide acceptable artwork in .jpg or .pdf format.

Prosecution procedures will vary for those applications which are based on an intent to use the mark. If a rejection letter is received, then additional legal fees may be incurred in responding. These fees are based on an hourly attorney rate.

As an office practice, we routinely bill our clients monthly for services rendered. Such statements are payable in thirty (30) days. However, because full searches involve substantial out-of-pocket expenditures, we require payment in advance of at least one-half of the estimated cost of the search with the balance due immediately upon reporting the search results. With regard to the preparation and filing of trademark applications, we require the invoiced balance to be paid before we forward the application to the U.S. Patent & Trademark Office.

Once an application for trademark registration has been approved by the Patent & Trademark Office, it is published in the Official Gazette of the United States for purposes of opposition by anyone who believes they will be damaged by issuance of the registration. If no opposition is filed, then the registration will issue in due course. An affidavit of continuous use is due five (5) years from the date of issuance and a registration must be renewed every ten (10) years for the mark to remain in force.



Paul B. Heynssens is the Managing Member and registered patent attorney with a substantial background in electrical engineering. He counsels clients in a variety of intellectual property and technology matters including patent prosecution and portfolio management, preparation of patent validity and infringement opinions, and preparation of licensing agreements, non-disclosure agreements and other intellectual property agreements. Mr. Heynssens has prepared and prosecuted many patent applications in the area of electronics, software, semiconductors, lasers and computers, among others.

Paul B. Heynssens Attorney at Law, PLC prepares Client Information Sheets to provide information about legal developments that may affect or be of interest to our clients. The information and opinions contained in this Client Information Sheet do not constitute legal advice.

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