



# LIFE CYCLE OF A TRADEMARK





# THE NINE STAGES IN A TRADEMARKS LIFE CYCLE

Thomson CompuMark is the world's leading provider of trademark and copyright research services. We're pleased to provide you with informational materials such as this brochure. The Life Cycle of a Trademark has been designed to provide a basic framework of information for each of the nine stages in a trademark's life cycle.

A trademark is a word, symbol, design, combination of letters and numbers, or other device, that identifies and distinguishes products and services in the marketplace. A trademark can be a company name, product name, a logo—even a specific color or smell associated with a product or company.

Maximum legal protection is afforded by registering your trademark in the U.S. or internationally. Therefore, it's important to choose a trademark with a high potential for being registered. This is becoming more difficult, as the number of existing trademarks increases and the internet increases the opportunities for conflicts with domain names. As a result, it's more important than ever to make sure you take all necessary steps to create, register, protect and maintain your trademark—one of your company's most valuable assets.

To learn more about how Thomson CompuMark can help you create and protect the value of your trademarks, copyrights and other intellectual property assets, call us at (800) 692-8833 or visit [compumark.thomson.com](http://compumark.thomson.com).

## 1. CREATION

Creation is the initial stage when a trademark, name, symbol or other device identifying your product or service is developed for use in the marketplace.

There are several guidelines to consider when creating a trademark, such as avoiding descriptive or misleading terms and watching for foreign translations that may have negative connotations. One well-known example is the car name "Nova," which translates to "it doesn't go" in Spanish.

Another issue to consider when creating a trademark is its ability to be used as a domain name. Searching your trademark against domain names up front can help you choose a name that's not already being used.

Legal counsel can provide helpful guidelines as to how to make your trademark distinctive and increase its registrability.

There are several methods for developing trademarks, including the use of brainstorming sessions, name creation software, or hiring a name creation company. However, not all trademarks are created equal.

There are various categories of strength, with coined trademarks being the strongest and generic terms being the weakest.

**Coined** No dictionary meaning:  
CHEX, HYDROX, POLAROID

**Arbitrary** Used out of context:  
OCEAN SPRAY, CAMEL, BELL

**Suggestive** Hints at or suggests the nature/attribute of a product:  
HAMBURGER HELPER

**Descriptive** Describes product, ingredients, or attributes:  
CRANBERRY ALMOND, EXTRA STRENGTH

**Generic** Common description:  
BAKING SODA, TELEPHONE

The result of the creation process is a list of several potential trademarks you will take to the Screening stage.

## 2. SCREENING

Once your list of potential trademarks has been created, the next step is to narrow the list.

The ideal method is to conduct a broad search to eliminate proposed trademarks that are obviously unavailable due to the existence of prior U.S. federal, state, or international trademark registrations or applications. At the same time, you may also want to examine whether or not your proposed trademark is being used as a domain name, in anticipation of developing a web site. This can be easily achieved with a screening search of your proposed trademark.

Screening is inexpensive and normally done as preliminary research before investing in a more extensive search. It is usually accomplished by researching trademark directories or online trademark research systems. Screening tools are available to search U.S. federal, state and international records, as well as domain names. This process can be conducted by an individual or through a trademark research company.

At the end of the screening stage, your list of proposed trademarks should be smaller, as those conflicting with existing trademarks will have been eliminated.

**Warning:** A serious error sometimes made at this point is developing an opinion based on information obtained from a screening search, skipping stages 3 and 4. Screening searches are insufficient for opinion purposes. Stage 3, Clearance and Stage 4, Investigation are crucial for making an informed decision.

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## 3. CLEARANCE

Trademarks surviving the screening process are now ready for more exhaustive research. Typically, a comprehensive search is conducted by a company specializing in trademark research. The resulting research report is used by legal counsel to determine if your intended trademark stands a good chance of being registered.

This type of research locates not only identical trademarks in all classes of goods and services, but also confusingly similar marks in classes pertinent to your product, service or industry. These similar marks can include phonetic equivalents, synonyms, homonyms, marks incorporating the same or similar prefix, suffix or root word and, if applicable, non-English translations.

International, company name, design/logo or other specialized clearance searches may also be necessary, depending on the trademark and how it will be used.

Trademark availability reports prepared to clear a trademark for U.S. federal registration usually contain U.S. federal, state and common law citations, including domain name records.

The result of the clearance stage is an in-depth trademark availability report that will help determine whether your trademark is available for use and registration.

## 4. INVESTIGATION

Trademark investigations are conducted to locate additional information on potentially conflicting trademarks cited in your research report. These investigations may be conducted by an attorney, with assistance of In-Use Investigation services provided by a trademark search firm.

The most common purpose of an investigation is to determine if the conflicting, registered or common law trademarks located in your research report are still in use in the marketplace. If they are in use, the Investigation stage will also reveal whether or not they will present a problem if you use or register your trademark. It is important to consider domain names at this stage as well, to ensure they are available to use.

The result of the investigation stage is a collection of all necessary information needed to make an informed opinion about the availability of your trademark.

## 5. OPINION

It's the job of an experienced attorney, using comprehensive trademark research reports and other related research, to render an opinion regarding the availability of your trademark for use and registration.

The result of the opinion stage is a decision as to whether your proposed trademark can safely be used and an assessment of any associated risks. Based in this opinion, you may or may not decide to proceed to the next stage: Filing and Registration.

## 6. FILING/REGISTRATION

This stage entails filing an application at the United States Patent and Trademark Office (USPTO) for federal registration. You can file two types of applications: 1) use-based and 2) intent to use (ITU). A use-based application is filed when actual use of the trademark in commerce has commenced. An ITU application is filed on the basis of good faith intent to use the mark in commerce, before actual trademark use takes place (eventual use of the mark in commerce is required before issuance of registration).

An examining attorney at the USPTO will then conduct research to determine if your proposed trademark is confusingly similar to any existing registered trademarks.

If no conflicting trademarks are found and your trademark otherwise qualifies for registration, it will be published for opposition in the USPTO's Official Gazette. Anyone who believes they would be damaged by the registration of your mark now has 30 days from the publication date to oppose your proposed registration or to obtain an extension of time to file an opposition.

Usually, a challenging party will obtain an extension of time to oppose the published mark in the hope of reaching an amicable settlement. If settlement efforts are unsuccessful, an opposition is filed and the case is heard before the Trademark Trial and Appeal Board (TTAB) of the USPTO, which then renders a decision.



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If no oppositions are filed, or if any opposition is successfully overcome, the use-based application will proceed to registration. ITU applications will receive a Notice of Allowance.

Registration of your proposed trademark as a domain name may take place at this time, or often earlier in the life cycle.

The result of the filing/registration stage determines whether or not your trademark is registered.

## 7. PROTECTION

This stage is ongoing, and its purpose is to protect, maintain and enhance the value of your trademark.

Protection commonly includes a watching program to find trademarks being applied for or used in the marketplace that may infringe or dilute the uniqueness and value of your trademark.

Watching is performed by searching the Official Gazette, trademark journals and other industry publications for marks that may be infringing or damaging to your mark. Widespread use of the Internet has expanded the scope of watching to include domain names and web sites as well. Often, watching is done by experts at trademark research companies, and is performed for word and design trademarks at various levels, including U.S. federal, state, common law and international. If a conflicting mark is found, you're notified, and you can then work with your attorney to prepare a plan of attack.

In addition to watching, the protection stage can also include internal standards and guidelines for proper use of your trademark by your company and the public. For example, you may require that your trademark appear in all capital letters. Having established trademark standards can help prevent your trademark from becoming generic, such as "elevator" or "aspirin."

The purpose of the protection stage is to ensure the value of your trademark is retained, by keeping it both unique and competitive.

## 8. MAINTENANCE

With proper maintenance, trademark rights can last forever—unlike copyright and patent rights. However, rights are contingent upon continued use of the trademark and the filing of Section 8 affidavits and renewals. A Section 8 affidavit must be filed between the fifth and sixth year after the date of registration and in the year prior to the end of each registration term. This filing affirms that the trademark is still being used in commerce in connection with all or some of the goods and services specified in the original registration. An application for renewal must be filed in the year prior to each registration term. Both the Section 8 affidavit and renewal application may be filed up to six months late with the payment of an additional "grace period" fee.

In addition, once a trademark registration becomes five years old, you can obtain incontestability status by filing a Section 15 affidavit with the USPTO. The registration then becomes much stronger, as an incontestable

registration can be challenged on fewer and narrower grounds than one that has not achieved incontestable status.

Domain names can be renewed for periods of one to 10 years, depending on the registrar's renewal plan.

Maintenance can be handled by you, your attorney or a trademark service company.

The purpose of a maintenance program is to ensure your trademark registrations are not canceled for failure to file necessary documents.

## 9. COMMERCIAL EXPLOITATION

Once your trademark is well known, steps can be taken to capitalize on its popularity. A common avenue is through licensing programs. These programs involve using your trademark, trade name or logo on merchandise not related to your original product. This type of merchandise may include items such as clothing, toys, food packaging, collectibles (such as mugs or key chains) and publications.

The benefit of commercial exploitation is that it can help you earn the most from your investment in your trademark and capitalize on its popularity and visibility.

500 Victory Road  
North Quincy, MA 02171-3145  
Phone (800) 692-8833

[thomsonreuters.com](http://thomsonreuters.com)  
[compumark.thomson.com](http://compumark.thomson.com)

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