

# LAW OFFICES OF BARBARA L. WAITE P.C.

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## Requisites for Obtaining Service or Trademark Registration from the U.S. Patent & Trademark Office Based upon an Intent-to-Use Application

### INITIAL APPLICATION

- Full name of owner of the Mark (as Applicant), legal status, address (if individual, residence; if business entity, principal place of business), citizenship or state (or country) of incorporation or organization.
- A statement of how the mark is intended to be used in interstate commerce, e.g., for goods, in packaging, advertising, etc.; for services, in literature describing the services, advertising, business cards, letterhead, etc., and a description of the goods or services. (Please note that the intention must be to use not only the service mark upon letterhead, business cards, etc. but these also must contain a description of the services.)
- If the mark is a logo with integral design elements, a digital representation of the logo must be submitted in either .pdf or .jpg format. The file may be either in black and white drawing or in color but, if in color, we must specify whether color is claimed as integral to the mark.
- A signed Declaration and a Power of Attorney (authorizing our representation regarding the application) must be signed by the applicant. These will be prepared by this office and provided for signature. The application can be submitted unsigned and supplemented with the Declaration and Power.
- We recommend that applicants budget \$2,500.00 per application to mature an application to registration, assuming no oppositions are filed. Because the Patent and Trademark Office fees are assessed on a per class basis, costs can be substantially more when there are multiple classes applied for.
- Assuming that no major difficulties arise, the average time from filing of the application filing to notice that the application is allowed is approximately

nine to twelve months. Registration is not granted until proof of actual use has been submitted. The requirements for submitting a statement of use are as follows.

### SUBMITTING STATEMENT OF ACTUAL USE

Actual use of the mark should follow filing an application based upon intent-to-use as soon as possible. The applicant must verify that the mark has been used in interstate commerce. It will be necessary, therefore, to provide the date upon which the mark was first used, and the date upon which the services or goods were first offered for sale in interstate commerce. If goods, provide a copy of the initial invoice confirming shipment of the goods on the dates claimed; if services, provide a copy of the advertisement or other literature offering the services along with some evidence that the services were in fact offered and capable of being provided on the date claimed.

Actual examples of such use must be provided as specimens of use for submission to the Patent and Trademark Office. Digital photographs may be substituted.

Please note that the description of the goods or services with which the mark is associated may not be expanded or the initial application will be invalidated. Neither may the mark or logo itself be changed in any manner. Therefore, the applicant should be certain of the mark before making application.

Proof of use may be submitted during the examination period of the initial application. So long as the mark has not been approved for publication for opposition, the application may be amended by demonstrating proof of use and, in effect, changing the application to one based upon use. Once a Notice of Allowance has issued, the applicant has six months from the notice date within which proof of use must be submitted, or the initial application will be considered as abandoned, thus eliminating the priority advantage obtained by filing the intent-to-use application. This six-month period may be extended so long as the request for extension is made before the six-month period expires. Additional six-month extension requests require a good-cause showing and may not exceed a total of 24 months.

If the statement of use is submitted during the last three months of the six-month period, we recommend submitting an extension request at the same time. This will ensure that sufficient time is allowed for approval and registration prior to expiration.

At this time, our experience is that it takes the Patent and Trademark Office three to four months to approve a proof-of-use submission and for registration to issue.

## FOREIGN SERVICE MARKS OR TRADEMARKS

A service or trademark applied for in a foreign country within six months of application for its registration in the U.S. may be eligible for priority treatment under an international convention. In addition, foreign service or trademark holders may make application under these intent-to-use provisions.

April 20, 2010