SUITE 900 45 SHEPPARD AVE. EAST TORONTO, ONTARIO CANADA, M2N 5W9

TEL: (416) 221 – 2600 FAX: (416) 221 – 2640 WWW.PINSKYLAW.CA

USA Trademark Application Flowchart

Optional Thomson & Thomson Search Phase: Scope of search includes: active USPTO A decision is made to submit the trademark trademark applications and registrations filed with the USPTO since 1884, and expired, canceled application to register the trademark. Two or abandoned marks since 1984. New applications and status changes are updated daily, and types of trademark applications may be filed: provide enhanced Trademark Trial & Appeal Board detail; state trademark database including (1) a "USE" application for a trademark records from all 50 US states, plus Puerto Rico and Guam; search for trademarks that may not be currently in use in the USA; or (2) an "intent to registered but may be protected under common law rights, common law databases include Gale, use" (ITU) if the trademark has not yet been Dun & Bradstreet and American Business Information databases; Includes identical and similar used in the USA, but there is a good faith Madrid Protocol applications and registrations which have requested protection in the US. Based intent to do so. on the results, an opinion is drafted regarding the availability of the mark for registration. Turnaround time is typically two weeks (CAD\$3,800 legal fee). Intent to Use (ITU) Application: An application is filed with the USPTO for the trademark that will be used at a future date. The filing of ITU application establishes a filing date that prevents a competitor from subsequently using the same trademark in all 50 states. (CAD\$760 legal fee) USE Application: An application is filed with the USPTO for the trademark claming a date of first use prior to the application filing date. A specimen of the If trademark is used before trademark examiner approves application, then trademark Allegation of mark is required. (CAD\$760 legal fee) Use application is filed with specimens. (CAD\$380 legal fee) Trademark examiner reviews ITU application after Allegation of Use Trademark examiner reviews USE application after approximately 6 - 8 months. application filed & approximately 6 - 8 months. accepted. Examiner approves Examiner rejects Examiner rejects Examiner approves Examiner rejects Examiner rejects application due to application without application due to application without application due to application due to changes (40% cases) changes (40% cases) minor technical substantive issue minor technical substantive issue issue (40% cases). (20% cases). issue (40% cases). (20% cases). Trademark is Revised application Trademark is Revised application Revised application Revised application published for is prepared and filed is prepared and filed published for is prepared and filed is prepared and filed opposition in about (CAD\$380 legal fee (CAD\$760 - \$1,520 opposition in about (CAD\$760 - \$1,520 (CAD\$380 legal fee 6 months. typically). legal fee). 6 months. typically). legal fee). Applicant must file a Statement of Use (SOU) A combined §8 and §15 Affidavit is filed during 6th year after registration (CAD\$380 with specimens within 6 months of allowance legal fee + US\$400 government fee). of ITU application (CAD\$380 legal fee). The time period may be extended up to 3 years, but Afterwards, a §9 must be filed every ten years Trademark becomes an extension government fee for each after the date of registration (CAD\$380 legal registered. Applicant additional 6 months extension period must be fee + US\$400 government fee). Opposition may now use ® paid (US\$200). proceedings (2-3%). designation on Litigation at hourly products. rates.