

TRADEMARK REGISTRATION PROCESS AT THE UNITED STATES PATENT AND TRADEMARK OFFICE

Dear Clients,

Av. Faruk Aktay, Esq. is qualified as a lawyer in Istanbul, New York and London with in-depth knowledge of Turkish, American and English law. He is also authorized before the United States Patent and Trademark Office ("USPTO").

As Aktay Law Firm, we attach importance to the protection of our clients' trademarks by registering them with the Turkish Patent and Trademark Office. However, we advise our clients who export their goods or services using their trademark in the United States of America ("USA") to register and protect their trademarks. In this process, we always support our clients in trademark applications in the USA, and the following stages, without a lawyer/trademark attorney abroad.

1. What are federal and state registrations?

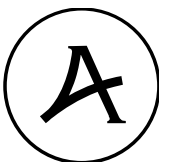
In the USA, trademark rights can be protected through state or federal registration. International trademark registration conducted by the World Intellectual Property Organization ("WIPO") provides protection under the federal registry as it is submitted directly to the USPTO. In contrast, trademark applications to state trademark registries are financially more affordable and faster than the USPTO but are protected only within that state.

2. What are the common law trademarks?

Trademarks that obtain protection on certain goods or services for the first time are called "common law" trademarks. These trademarks are protected only in the geographical area in which they are used. Even if the same or similar trademark is registered with the USPTO or the state registry, the owner of the common law mark may claim that he/she has used the mark before, thereby ensuring that the protection arising from the registration cannot be claimed against him/her. Common law trademarks may optionally include the symbols "TM" or "SM" but cannot include the "®" symbol.

3. What are the federal registration trademarks?

Federal registration trademarks constitute the legal presumption that you own the trademark and have the right to use it in all 50 states and U.S. territories. When the trademark is registered with



the USPTO, it enables recordation of registration with the US Customs and Border Protection, and with this registration, counterfeit products infringing the trademark rights are prevented from entering the USA.

The trademark you have registered with the USPTO can be used as a basis for filing in another country. Also, it provides the right to bring legal action concerning the trademark in federal court. Federal registration trademarks may optionally include the symbols “TM” or “SM”. In addition, it is also allowed to use the “®” symbol.

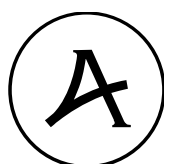
4. What are the principal and supplemental registers?

The federal trademark register consists of two separate registers, the "principal register" and the "supplementary register". The principal register provides protection for distinctive marks. On the other hand, the supplemental register provides protection for non-distinctive marks that have the potential of acquiring distinctiveness. The supplementary register does not provide the protection provided by the registration in the principal register. Once the trademark has become distinctive with further acquired distinctiveness, it may be obtained registration on Principal Register.

5. What is the filing basis?

There are four filing bases for trademark or service mark applications in the Trademark Act. You may apply for a trademark or service mark by choosing one of these filing bases, each has different requirements at the time of application.

- If you are currently using your mark in commerce with your goods and/or services, you may apply based on the **“use in commerce” basis under Section 1(a) of the Trademark Act.**
- If you have a bona fide intention to use your mark in commerce with your goods and/or services in the near future, you may apply based on the **“intent-to-use” basis under Section 1(b) of the Trademark Act.**
- If you own a foreign registration of the same mark for the same goods and/or services from your country of origin, you may apply based on the **“foreign registration” basis under Section 44(e) of the Trademark Act.**
- If you own an earlier-filed foreign application that was filed within six months of your U.S. application for the same mark and the same goods and/or services, you may apply based on the **“foreign application” basis under Section 44(d) of the Trademark Act.** You may also request a “priority” filing date for your U.S. application that is the same date as that of the foreign application filing date.



You may also request different filing bases for different international classes of goods and/or services and for certain goods and/or services within an international class.

6. How to apply for a trademark registration? what is the difference between TEAS Plus and TEAS Standard?

The trademark application must be made using the Trademark Electronic Application System (“TEAS”). There are two filing options, the TEAS Plus and the TEAS Standard.

The filing fee is \$250 per international class for TEAS Plus. There are more requirements at the time of trademark application. You may choose from a pre-determined list for the class of goods and/or services.

In contrast, the filing fee is \$350 per international class for TEAS Standard. However, the requirements are less than the TEAS Plus. Instead of choosing from a specific list, you may make a specific description for your class of goods and/or services.

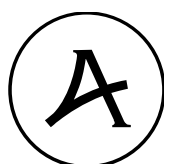
7. What is a specimen?

The specimen provides evidence of how the mark is used in commerce. At least one specimen must be submitted for each class of goods and/or services when applying for a trademark. Labels, packaging, the trademark used on the goods themselves and the image of the point-of-sale display are the specimens for the goods classes. Website, advertisement, and advertising brochure are the specimens for the services classes.

8. How is the process after the trademark application?

Examining attorney reviews application about 8 months after application filed. Within 7 days of beginning the review, the examining attorney approves the application for publication, discusses the outstanding issues with the applicant, or issues an office action rejecting the application and containing the reasons for the rejection.

The applicant responds to the office action within 3 months and one 3-month extension is available per office action upon request. The examining attorney may decide to publish your trademark application or issue a final office action by reviewing the response. In response to the final office action, the applicant submits a request for reconsideration or files an appeal of the final decision with the Trademark Trial and Appeal Board (“TTAB”) or both submit a request for reconsideration and file an appeal. The TTAB renders a decision in about 10 months and according to the decision rendered by TTAB, the application is returned to the examining attorney for approval or abandonment.



If the examining attorney approves your application, the trademark application is published in the Official Gazette. Right holders may object to the trademark application within 30 days from the publication date. If there is no objection, USPTO issues a registration certificate for applications based on use in commerce and a notice of allowance (“NOA”) for applications based on intent to use.

9. What is a statement of use (“SOU”)?

The applicant must submit the SOU to the USPTO confirming the commercial use of the mark within 6 months of issuing the NOA. If the trademark is not yet used in trade, the applicant may request an extension of the 6-month period. The applicant may request 5 times to extend this period. Trademark applications made on the intent-to-use basis cannot be registered unless the SOU is made.

10. What are the declarations that need to be made or can be made after the trademark is registered?

After the trademark has been registered, (i) “Section 8: Declaration of Continued Use”, (ii) “Section 8: Declaration of Continued Use and Section 9: Renewal Application” or (iii) “Section 71: Declaration of Continued Use” for internationally registered trademarks must be submitted.

In addition, (i) “Section 15: Declaration of Incontestability” and/or (ii) “Section 7: Request for Amendment or Correction of Registration Certificate” may be optionally submitted.

