

PUBLICATION

"Do It Yourself" May Work Around the House, but Not for Trademark Applications

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Today, every business is pinching pennies. In an effort to cut back on expenses, you may be tempted to use a "do it yourself" legal documentation service to incorporate your business, register a trademark or prepare a lease. Proceed with extreme caution if you decide to engage one of the many online providers offering such services.

One leading purveyor of these types of services touts that the company was "founded by attorneys who have worked at some of the most prestigious law firms in the country" and that "all of [their] forms were developed by experienced attorneys, so you can be sure that [their] documents are dependable." The company's disclaimer, however, provides the following additional information about the company and its services:

- The service is not a substitute for the advice of an attorney.
- The legal information provided is not legal advice and is not guaranteed to be correct, complete or up-to-date.
- If you need legal advice for your specific problem, or if your specific problem is too complex to be addressed by their service, you should consult a licensed attorney.
- The company does not review the answers you provide for legal sufficiency, draw legal conclusions, provide legal advice or apply the law to the facts of your particular situation.

In contrast, when you engage an attorney you are getting actual legal advice, and that advice does not come with the caveat that it may not be correct, complete or up-to-date. Further, an attorney does draw legal conclusions and will apply the law to the facts of your particular situation, which provides the peace of mind that your legal matters are being handled with the appropriate level of care.

One service provided by the aforementioned company is the filing of federal trademark applications. Contrary to what you might think (and what do-it-yourself legal documentation services might have you believe), the preparation and filing of federal trademark applications is not merely a matter of filling out forms and is, in fact, full of traps for the unwary. Consider the following:

- You must determine whether you wish to apply for your mark in standard characters (plain typed font) or in a specialized font or color scheme. You may think you will achieve the strongest protection for your mark by registering the mark in a particular font and/or color scheme; however, in many instances you will be best served by registering the mark in black and white standard characters because (1) doing so may provide you with broader rights and (2) you may not have to file a new application in the future if you alter the font and/or color scheme associated with the mark, thereby saving you money in the long run. After all, how often do you change the font and style of your advertising? More frequently than every 10 years?
- Chances are good that the U.S. Trademark Office will issue an Office Action initially refusing your application for registration. According to the Trademark Performance Report available through the U.S. Trademark Office website, in the first quarter of 2009 slightly more than 31% of "TEAS Plus" applications (those filed using the simplest and most efficient application procedure) were approved

by the Trademark Office at the outset. This means that the Trademark Office found fault with approximately 69% of TEAS Plus applications, leading those applicants to receive Office Actions requiring a deadline-driven response addressing the problems identified by the Trademark Office. The Trademark Performance Report suggests that the first action approval rate for applications filed using the *standard* TEAS procedure is merely 15-16%, meaning that approximately 85% of those applicants will receive Office Actions requiring a response.

Office Actions can contain a significant amount of trademark legal jargon, and many applicants acting without an attorney therefore simply set them aside and fail to respond appropriately. If an applicant fails to respond within six months of the issuance of the Office Action, the application will become abandoned, in which case the applicant will likely have to file a new application and will have not only forfeited the fee paid to the legal documentation service provider as well as the government filing fee, but may also have lost the benefit of the application priority date. Consulting an experienced trademark attorney familiar with trademark application requirements can reduce the likelihood that you receive an Office Action at the outset and, in the event that an Office Action is issued, your attorney can ensure an appropriate response is filed on time.

- Your trademark application must be signed by an authorized signatory. An application that is signed by an inappropriate signatory – for example, a representative from the applicant's advertising agency – will likely be void. An experienced trademark attorney can help you avoid this problem by providing you with guidance as to who is considered an authorized signatory for your trademark applications.
- You must be careful when asserting your date of first use of your mark in commerce. Whether you file your trademark application based on current use or your intent to use your mark in the future, before a registration will be issued you will be required to declare that the mark is in use in commerce and provide the date that such use began. Your declaration pertains to every good and service listed in the application, and asserting that the mark is in use for all listed goods and services when it is not and/or the failure to provide an accurate date of first use can cause the resulting registration to be vulnerable to cancellation, especially if the provision of inaccurate information is done knowingly. Further, the Trademark Office has very specific rules regarding what is considered a “use in commerce” and what is not. Getting the advice of a trademark attorney before making any assertions to the Trademark Office regarding use of your mark in commerce may well prevent you from walking headfirst into a challenge to the validity of your resulting registration.

The temptation to use online, low price do-it-yourself services is understandable, but these services are no substitute for the advice of an experienced trademark attorney. Consider the possibility that while do-it-yourself legal documents might seem like a good deal, in the end, many users of these services may find that they have been penny wise and pound foolish.