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Intellectual Property: Frequently Asked Questions

What is a trademark?

A trademark is essentially the identity of your business. It is a brand associated with goods or services to distinguish your goods and services from all others, Trademarks can be any word, slogan, symbol, design or any combination of these. Some non-traditional trademarks can be a sound, color or smell. Examples: Nike®, Starbucks®

Why do I need a trademark registration?

A trademark registration allows you to protect your rights as the owner of the brand, business and/or product line. The registration will help you prevent competitors from diluting or tarnishing your brand of services or products. It can also be used to stop competitors from using your mark or anything that is confusingly similar to promote their products and services.

If you are only using your trademark in a single state, make sure you obtain a trademark registration in that state to document your date of first use in commerce and ownership of the trademark. The date of first use of the trademark in commerce establishes priority of use in the marketplace, which is very important in the world of trademarks.

If you are using the trademark in interstate commerce or in a foreign country, make sure you obtain a trademark registration through the United States Patent and Trademark Office (USPTO). The USPTO certificate of registration provides a number of advantages. First, the registration provides nationwide notice to possible infringers and allows you to use the ® symbol next to your mark. The registration allows the owner to sue in federal courts, recover monetary damages, profits and costs from a trademark infringer. Plus, the registration conveys a presumption of validity to the ownership and right to use the mark. After the trademark has been registered for 5 years, the mark may be declared incontestable. The USPTO registration also allows you to file for registration in foreign countries.

How much does a trademark application for registration cost?

The filing fees from state to state range, so you will need to contact the state agency. Usually you will need to contact the division of corporations that manages trademark registrations and find out how much it costs to file the trademark application.

The USPTO filing fees range from \$225 to \$375 per class depending upon whether you file the application electronically or send a paper filing. The filing fee also depends on the description of goods and services you insert into the application. If you use a description from the “Acceptable Identification



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of Goods and Services Manual (ID Manual)” then it costs \$225 when you file the application electronically. If you customize your description of goods and services, then it costs more.

Some on-line entities charge low, flat fees for preparing and filing trademark applications. You will receive no legal advice as you complete the templated on-line form.

Some attorneys charge flat fees that include preparing and filing a trademark application. Other attorneys charge an hourly rate for the same service. Before you pay for anyone to file a trademark application, find out how much they will charge to defend the application if the USPTO refuses to register the trademark. Some attorneys will charge an hourly rate to defend an application and others will include it in a flat fee.

There are many variables to consider with preparing and filing a trademark application, such as is the mark a simple word mark or is there a complex design in color that needs to be described in detail. You also need to determine how many different classes in which you want to register your product/service. For example, if you are opening a coffee shop that also sells food and coffee accessories you could register in many different classes (i.e. Class 43 for coffee shop, Class 30 for coffee, Class 11 for coffee roasters, Class 21 for coffee mugs, scoops). All of these factors determine how much it costs to register a trademark.

Do I need an attorney to prepare and file the trademark application?

A trademark attorney who knows trademark law is going to be invaluable to you in obtaining a trademark registration. The attorney should advise you on proper trademark searches, the strength of your trademark and the likelihood that the USPTO will accept your application.

If you try to prepare and file the application on your own, or you hire a lawyer who has very little experience, you will not receive the necessary legal counsel or attention to detail when preparing the application that is necessary for a successful registration.

Once I obtain a trademark registration, do I have to do anything to maintain the registration?

Yes. Use your mark correctly in commerce so the mark’s character is preserved and always use the ® symbol next to the mark. If you do not consistently and correctly use your mark in commerce, someone else may start using your mark and accuse you of abandoning your trademark.

Between the fifth and the sixth year from the date of registration, you need to file a Combined Declaration of Use and Incontestability under Sections 8 & 15 of the Lanham Act, 15 U.S.C. §§ 1058 & 1065. You must file the Combined Declaration along with a specimen of use in commerce and pay a fee.



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Between the ninth and tenth year from the date of registration, you need to file a Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Sections 8 & 9 of the Lanham Act, 15 U.S.C. §§ 1058 & 1059. You must file the Combined Declaration along with a specimen of use in commerce and a pay fee. You will need to file the Combined Declaration under Sections 8 & 9 of the Lanham Act each successive ten year period thereafter.

Do I need to register my trademark in any other countries?

If you are selling products and services in a foreign country you should register your trademarks in that country. In addition, if you are manufacturing your goods in another country and then exporting them to the U.S., you should consider registering your trademarks in the country where the goods are manufactured to help you protect your brand from counterfeiters.

What is a copyright?

A copyright is a form of statutory protection provided to original works of authorship fixed in a tangible medium of expression, including literary, musical, dramatic, choreographic, pictorial, graphic and sculptural, motion picture, audio visual, sound recordings and architectural works.

Why do I need a copyright registration?

A copyright registration offers significant benefits to the owner of the registration. First, the registration establishes a public record of the copyright claim. A registration of a U.S. work is necessary before any copyright infringement lawsuit may be filed in the courts. If a registration is made before or within five years of publication, the registration establishes a presumption in court as to the validity of the copyright and of the facts stated in the certificate. If a registration is made within three months after publication of the work and prior to infringement, statutory damages and attorney's fees are available to the copyright owner in court actions. Otherwise, the copyright owner may only seek actual damages and profits.

How long does a copyright last?

In cases of works by individual authors, the term of the copyright is the life of the author, plus 70 years after the author's death.

The term of copyright in works for hire or corporate owned works is 95 years from the first date of publication, or 120 years from creation, whichever is longer.

Copyrights cannot be renewed under the current copyright statute.



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Once I obtain a copyright registration do I have to do anything to maintain the registration?
No. Once you obtain the copyright registration from the U.S. Copyright Office you do not have to file any additional paperwork.

What is a trade secret?

The term “trade secret” means all forms and types of financial, business, scientific, technical, economic, or engineering information, including patterns, plans, compilations, program devices, formulas, designs, prototypes, methods, techniques, processes, procedures, programs, or codes, whether tangible or intangible, and whether or how stored, compiled, or memorialized physically, electronically, graphically, photographically, or in writing if -

- (A) the owner thereof has taken reasonable measures to keep such information secret; and
 - (B) the information derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by another person who can obtain economic value from the disclosure or use of the information;
- 18 U.S.C. § 1839(3)

How can I protect my trade secrets?

How you protect a trade secret depends on the type of secret. You may lock some secrets in a safe. You should ensure a limited number of people have access to the safe, and that those people have reviewed and signed confidentiality agreements. Other trade secrets can only be protected by establishing policies regarding trade secret information with appropriate non-disclosure and confidentiality agreements in place. If the secrets are stored on a computer system, then you need to make sure you use passwords and/or encrypted files along with having appropriate policies and agreements in place.

Helpful Links

United States Patent and Trademark Office – www.uspto.gov

United States Copyright Office – www.copyright.gov

Copyright Clearance Center – www.copyright.com

International Trademark Association – www.inta.org

World Intellectual Property Organization – www.wipo.int



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Crystal Broughan is an intellectual property law attorney with Marks Gray, P.A. If you would like to learn more about Marks Gray's intellectual property law services, please contact Ms. Broughan at cbroughan@marksgray.com or 904-807-2180. She can be found on [LinkedIn](#) or by visiting the Marks Gray [Intellectual Property Resources page](#).

Marks Gray, P.A.

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