

# THE DOCKETING EXCELLENCE™ SERIES



# Common U.S. and Foreign Trademark Docketing Mistakes and How to Avoid Them



# Common U.S. and Foreign Trademark Docketing Mistakes and How to Avoid Them

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# What is a trademark?

## Quick Review

- A word, name, phrase or symbol used to identify the source or origin of a good or service provided through commerce
  - Trademark vs. Service Mark



- Patents protect the product or method itself

# U.S. Registration Process and Related Docketing

- **Docket Actions After Filing**
  - 3-6 month status check
  - Foreign filing priority date
    - 6 months for TMs
    - Timing of Reminders
    - Securing instructions for foreign filing

# U.S. Registration Process and Related Docketing

## Docketing Tips:

- Be sure you are docketing the correct matter type to be sure the 6 month deadline is generated
- Secure instructions as soon as possible, but no later than 3 days in advance of foreign filing deadline
- Keep the deadline active even if some filings have been ordered

# U.S. Registration Process and Related Docketing

- **Docket Actions After Office Action**
  - Early Response Deadline/Priority Office Action
    - Two Months versus Six Months
  - Request for Reconsideration Date
    - In response to Final Office Action
  - Notice of Appeal Date
  - Appeal Brief Deadline

# U.S. Registration Process and Related Docketing

## Docketing Tips:

- Always docket the full six months as well as any priority opportunities
- File Request for Reconsideration as early as possible in order to secure feedback from Examiner prior to deadline for Notice of Appeal
- Carefully docket of appeal brief and subsequent deadlines



# U.S. Registration Process and Related Docketing

- **Docket Actions After Office Action**

- Responding to Office Action May Include

- Divisional

- Separates Classes

- Not the same thing as a patent divisional

- Parent versus Child

# U.S. Registration Process and Related Docketing

## Docketing Tips:

- The child application will receive a new serial number, but it will not be assigned immediately
- All the dates carry to the child application so be sure all deadlines and proper status checks are on your docket
- Confirm accuracy of the USPTO record for both applications

# U.S. Registration Process and Related Docketing

- **Docket Actions after Notice of Allowance**
  - If application is ITU, then Applicant Files
    - Statement of Use
      - Specimen in use before filing Statement of Use
    - Extension Request for filing Statement of Use
      - Specimen in use before expiration of Extension Request
    - Filing Extension Request with Statement of Use
      - If specimen is rejected, you still have time to put new specimen into use

# U.S. Registration Process and Related Docketing

## Docketing Tip:

- Keep the extension deadline open if you file a Statement of Use before the deadline
- Take precautions if your docket system treats the Statement of Use and Extension of Time as one item.

# Foreign Registration Process and Related Docketing

- **Maintaining Foreign Registrations**
  - Rehabilitation Fees and Special Country Requirements
  - Oppositions and Cancellation Actions
  - Renewal Fees
  - EU or CTM Registration
    - Singular registration
    - No contact with individual countries

# Foreign Registration Process and Related Docketing

## Docketing Tips:

- Watch for unique country requirements
- Give yourself adequate time to gather any needed information in the event of special country documentation requirements.

# Foreign Registration Process and Related Docketing

- **Use Not Required to Obtain Foreign Protection**
  - Registration Can Issue without Proof of Use but Can Become Vulnerable
    - Vulnerability timeline differs depending on country
      - 3 years or 5 years
    - Soft Use Deadlines
      - Importance
      - Does docketing launch off filing date or registration date

# Miscellaneous U.S. and Foreign Docketing

- **Miscellaneous Docket Actions During Life of TM**
  - U.S. Watch Services
    - How to docket
  - Foreign Watch Notices
    - When to docket
  - Opposition or Cancellation
    - When do I open a matter
  - Foreign and U.S. Maintenance Actions
    - Grace Period available for most deadlines