

# US Trademark Formalities

Application - Registration - Maintenance

## Topics

- Basic principles of US Trademark Law
- Trademark application
- Examination of applications, appeals, petitions
- Registration and publication
- Maintenance of trademark registrations and transfer of ownership
- Trademark application through the Madrid Protocol - what to consider as a foreign applicant

**an in-depth  
overview on trade-  
mark formalities**

## Your speaker



**B. Brett Heavner**  
Attorney at Law,  
Finnegan, Henderson,  
Farabow, Garrett & Dunner, LLP,  
Washington, DC (USA)

# US Trademark Formalities

## Aims and objectives

You want to support your office as competent as possible in the everyday business and therefore need specialised knowledge in US trademark law.

The seminar 'US Trademark Formalities' gives you a broad overview over formal and substantive requirements of trademark applications in the United States.

The process of the application as well as its examination and registration, opposition proceedings, fees and the maintenance of a registration is all part of the curriculum. After having attended the seminar you will know what to watch out for during applications at the USPTO and how to deal with challenges you may stumble upon with the help of practical examples and exercises.

Avoid common mistakes and establish the foundation for a successful trademark application.

## Who should attend?

This unique course addresses the needs of capable IP administrators who want to increase their expertise in US Trademark Formalities in full detail. Legal assistants, formalities managers and paralegal will also benefit from the speaker's expertise.

## Your speaker



**B. Brett Heavner**  
Attorney at Law, Finnegan,  
Henderson, Farabow,  
Garrett & Dunner, LLP,  
Washington, DC (USA)

Brett Heavner is a partner in Finnegan's Washington, DC office. His practice includes all aspects of trademark and unfair competition law, with a particular emphasis on trademark infringement, counterfeiting, false advertising litigation, and Trademark Trial and Appeal Board (TTAB) litigation. Brett assists clients in developing effective worldwide strategies for establishing and enforcing their trademark rights. He regularly counsels clients on issues regarding trademark clearance searching, trademark and copyright licensing, and certification mark programs.

He handles trademark matters in US district courts, cancellation and opposition proceedings before the TTAB, and appeal proceedings before the US Court of Appeals for the Federal Circuit. Brett has also obtained and executed ex parte searches and seizures of counterfeit goods and copyright infringements in cases involving counterfeit pharmaceuticals, counterfeit pipe couplings, and materials illegally copied through computer hacking.

## What our participants say

'Very informative, to be recommended.'

'Professional and practical.'

'Well organized and presented.'

## Your agenda

### Basic principles of the US Trademark Law

- Trademarks acquired by use and registered trademarks
- Use requirement as the rule - and the exceptions
- International trademark law: Madrid Protocol, Paris Convention, TRIPS, TLT

### Trademark application

- Trademark searches: Options and costs
- Advantages of obtaining a federal registration?
- Minimal requirements of an application for the assignment of a filing date
- Application fees
- Online application process and multi-class applications
- Tips for phrasing recitations of goods and services
- Filing Bases: Intent to use, Actual Use and foreign registration
- Assignment and transfer of applications and registrations
- Requirement of a domestic representative

### Examination of applications

- Requirements of distinctiveness and for the list of goods and services
- Examination as to conflicting earlier trade marks
- Answering Office Actions and Notice of Allowance
- How to follow the progress of your application online
- Opposition and Cancellation Proceedings, Appeals, Petitions

### Registration

- Proof of use and affidavits
- Division of registrations (and applications) and effects of the registration

### Maintenance of trademark registrations

- Section 8 Declaration (Declaration of Use)
- Section 15 Declaration (Incontestability)
- Renewal, Checking the registration status and Transfer of ownership

### Trademark application through the Madrid Protocol

- What foreign applicants should consider
- Filing requirements and application proceedings
- Changes in the practice of the United States Patent and Trademark Office

Registration under  
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## Registration Form

Yes, I will attend the seminar

US Trademark Formalities

Yes, I agree that FORUM Institut may inform me about events and relevant expert content by:  
 email; and/or  telephone.  
I may withdraw my consent at any time.

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## How to register

**Registration: +49 6221 500-500**

**Conference no.: 19 10 150**

**Website:**  
www.forum-institut.com

**Date and venue**  
Friday, 18 October 2019 in Amsterdam  
9 am - 5 pm  
DoubleTree by Hilton Amsterdam Centraal Station  
Oosterdokstraat 4 · NL 1011 Amsterdam  
Tel. +31 20 5300800 · Fax +31 20 5300801

**Fee**  
€ 990.00 (+ 21% VAT)  
The fee includes course documentation (including free download) as well as refreshments, lunch and a certificate. You will receive an invoice as well as confirmation.

## Any Further Questions?



Please feel free to contact me if you have any questions.

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