

INTEROFFICE RESEARCH MEMORANDUM

To: Attorney Elias Paulson
From: Paralegal Noah Eskew
Re: My Trademark
Case No: Cr. 10-100

You have asked me to prepare a memorandum addressing the trademark registration process, maintenance of a trademark, and transfers of trademarks.

ISSUE

The processes for registering, maintaining and transferring my trademark are found in the Lanham Act (Trademark Act of 1946) and its 15 amendments.

This mark features an anthropomorphized tomato, wearing a chef's hat and a mustache, situated on a fork. It also features the words: Mr. Marinara's Pizza and Pasta To-Go, which serve as the brand's name.

Mr. Marinara's



PIZZA AND PASTA TO-GO

FACTS

My trademark is a brand name (Mr. Marinara's Pizza and Pasta To-Go) and a logo to support the selling of fast-food restaurant services. While customers may purchase foods, beverages, and other products, this mark will be used to market the services that the restaurant provides — making the name and logo a service mark. The mark is presently in-use and featured on the “coming soon” billboard as well as on the internet. However, more uses are on the way: The logo will be featured on bags, cups, and the restaurant itself.

ANALYSIS

No restaurant services have currently registered the word ‘marinara’ in their brand name. While there are some grocery store products and specific menu items that may utilize the word, this is still a unique name in the food service industry.

This mark is also flexible. If rejected by USPTO, the name could be shortened to just “Mr. Marinara’s” and/or the logo removed in favor of a standard word mark.

After issuing an online form, applicants are assigned to an examining attorney (in this case an expert in food service marks) who will retrace our steps of research. This will verify that the mark is not in use by other applicant(s) and is eligible for federal protection.

Provided that the mark is still in use, owners must file an ‘Affidavit of Use’ between the 5th and 6th year after registration. This form verifies to the USPTO that the mark is still being used in commerce. Additionally, a renewal form must be filed after 9 years; although a 6 month grace period does exist (allowing owners to renew their mark after the 10 year protections expire).

This mark meets the standards for compliance by being the sole logo for the brand and its presence on all advertising, cups, bags, and store locations.

This trademark could be assigned to another ownership party. Paperwork such as another affidavit or assignment documents may be required by law. However, since this transaction of ownership rights would most certainly involve money, proper documentation is necessary between the assignor and the assignee.

The rights to the logo could be licensed to other organizations for promotional purposes. The brand could sponsor a minor league baseball team such as, the Norfolk Tides, and allow that organization to print the logo on tickets, t-shirts, banners, and more. It would be wise to establish legally binding documents to this agreement that describe the licensing in greater detail.

CONCLUSION

Registering a trademark with the USPTO requires an overall understanding and analysis of the service mark, a good amount of paperwork, and a time-centered workflow. Following the guidelines set by the federal government makes it simple to search for marks, register, and complete other legal tasks.

RECOMMENDATIONS

Remembering to renew federal protections is paramount. Many former trademarks have been lost due to faulty renewals. Establishing reminders can be beneficial to the entire process. Nowadays, digital notifications can be scheduled on computers, email accounts, and internet applications. However, firms could also physically mark the date of registry and follow up by transferring that information to each of the next 10 years' calendars.