



TRADEMARK GUIDE & QUESTIONNAIRE

Thank you for contacting the Trademark Licensing Office about a new name or logo for your Program. This name or logo will function as a “trademark” or a “service-mark,” helping to identify and distinguish your Program (or your department) and the University as the source of the product or service that you are offering or are planning to offer. **This trademark or service-mark (“your proposed mark”) will be owned by the University.**

This *Trademark Guide & Questionnaire* is designed to help you understand the **trademark clearance and registration process**, and make a decision on **whether you should continue or begin using your proposed mark, and should pursue its registration with the U.S. Patent and Trademark Office**. It also addresses two other related and important points: (1) ensuring that your proposed mark will not infringe on the rights of any third party; and (2) determining whether your proposed mark can be protected from misuse by other parties.

Please read the entire *Questionnaire* carefully: it includes **sections that must be completed by you** (Part I, *Your Proposed Mark*; Part II, *Your Program and Use of Your Proposed Mark*; and Part V, *Acknowledgement*), and a **discussion on the costs and conditions related to trademark clearance and registration** (Part III, *Costs*; and Part IV, *General Conditions*). After you complete this *Questionnaire* and **gather all requested materials** (Part I, Section 1; and Part II, Section 4), please return them to Brand Engagement & Governance, via e-mail to brandengagement@vanderbilt.edu, with all physical copies to follow by mail or hand-delivery to:

Brand Engagement & Governance
Vanderbilt University
Lowes Office Tower
2100 West End Avenue, Suite 1100
Nashville, TN 37203

PART I. YOUR PROPOSED MARK

1. **What is your proposed new name or logo?** For a logo, please enclose a high-resolution digital image, in .jpg format, no smaller than 250 pixels in any direction, in (a) black-and-white (not a grayscale), and (b) in color, if applicable. Please also include a detailed description of all logo elements, both the graphics and, if your logo is in color, the specific colors.
2. **How did you choose this mark?** If the mark includes any design (logo) elements, who created them? Please describe as completely as possible.
3. **Do you know of any other institution of higher education, of any healthcare provider, or of any other party that has a similar name or logo?** If yes, please describe in detail and provide all corresponding references to any materials available online.
4. **Have you completed a search online for your proposed mark?** Please state results using the Preliminary Trademark Search document and submit along with this form (Appendix A). *Please note that results of an online search can help you identify obvious direct conflicts with the use of your proposed mark, such as use of an identical name for a program in the same field, or for a product in the same merchandise category. However, to know whether a mark is available for registration with the U.S. Patent and Trademark Office (“USPTO”), and whether you may continue to use the mark, or engage in its proposed use, a trademark availability search by a trademark attorney must be completed. Please refer to Part III, Section 1, on page 6.*
5. **Is the mark used or proposed to be used in conjunction with either the name “Vanderbilt” or any other trademark of the University?** If so, please attach an example of such use or proposed use and explain the reasons for obtaining a separate protection for this mark.
6. **Please include any questions that you have about Sections 1-5 above, provide any other information about your proposed mark that you believe to be relevant, and then complete Part II.**

PART II. YOUR PROGRAM AND USE OF YOUR PROPOSED MARK

1. What is the principal activity of the Program completing this *Questionnaire*?
2. Is the Program's mark related to a technology that is being handled by the Center for Technology Transfer & Commercialization?
3. How does the Program use or expect to use the mark?
 - Please describe, as completely as possible, **all** current and currently planned uses of the mark.
 - Please specify (1) whether the mark is used (planned to be used) for internal purposes only, (2) whether your Program produces or sells (or expects to produce or sell) merchandise with the mark, and (3) how long you expect to use the mark.
 - Your description should also identify the **type of any product or merchandise** – e.g., “t-shirts,” “toys,” “beverageware,” “software program for [include (1) the purpose and (2) function of the program, and indicate whether the program is downloadable or non-downloadable]” – and the **nature of any service, described in plain terms** – e.g., “community events in the nature of [describe the type or the purpose of the events – e.g., outreach, education],” “athletic competitions and exhibitions,” “scientific research in field of [describe all applicable fields],” “educational services, including [describe (1) the type – i.e., college courses, post-graduate courses, classes, conferences, meetings, training programs, workshops – of the Program, and (2) the applicable field(s) – i.e., arts, business, technology]”;
 - Please **include as much detail as possible and as you believe to be relevant** about your current and any potential new products or services.
4. If the Program is already using the mark, please attach examples of this use.
 - Please include **at least 3 to 5** examples of how you are using or expect to use the mark.
 - All examples of use must clearly show the mark being used to identify the Program's product(s) or service(s).
 - If the mark you described in Part I includes any design elements (a logo), it must be an **exact** match of the mark appearing on your example(s) of use.
 - For academic programs, athletic events, community outreach, and research, please include informational or promotional materials, such as brochures, flyers or webpages.

5. If your proposed mark includes both a **literal element** (*word(s), letter(s), number(s), punctuation mark(s), or other typed symbols*) and a **graphic element** (*logo(s), design(s), color(s)*), please explain whether you anticipate using these elements together at all times, or if they are or may be used separately.
 - Please include examples of use or proposed use of **all** elements of the mark, as they are used – or are proposed to be used – together **and** separately.
 - If any part of the mark is in color, please explain whether the color(s) itself has any “branding” significance and is an element that you wish to protect.
6. If you are already using the mark, what is the date (*day, month, year*) on which the mark was used for the very first time, as you described in Section 3 and as shown on the examples of use that you submitted under Section 4, above? Please include all relevant dates. If you have not yet used your proposed mark, what is the date on which you expect to begin its use?

Please note that registration with the USPTO requires actual use of a mark “in commerce.” The most important element of “use in commerce” is bona fide use in the ordinary course of offering a product or a service to the public. This use also may not be strictly for internal purposes, although some programs will qualify as “use in commerce” even if they are available only to Vanderbilt students or employees. If the mark is not in use but is expected to be used within the next approximately three to four years, an “intent-to-use” application may be filed, but additional USPTO fees and attorney fees will be incurred, as explained in Part IV, Paragraph 2, below.

7. If your Program is funded by a third party, are expenditures relating to trademark registration and protection consistent with the terms of your funding obligations?
8. Who is the Program's team member responsible for receiving invoices related to the trademark clearance and/or registration expenditures? Please include the name, a telephone number and an e-mail address.
9. Please include any questions that you have about Part II, provide any other information that you believe to be relevant, and then carefully review Parts III and IV.

PART III. COSTS

Your Program will be responsible for all costs of trademark clearance, registration, and registration maintenance. Please read the entire Part III carefully, and please also note the conditions set out in Part IV. The cost to federally register a trademark will vary depending on the complexity and type of legal services needed. A written estimate of the anticipated legal and USPTO fees will be provided following completion of this questionnaire and initial consultation by the attorney.

Types of Legal and USPTO Fees:

1. **Trademark Clearance.** To know whether you may continue to use your mark, or may begin use of a proposed mark, a trademark availability review (“trademark clearance”) must be completed. Because one of the goals of trademark clearance is to ensure that your proposed mark will not infringe on someone else’s rights, the Office of the General Counsel may require that a clearance review be completed even if you do not wish to pursue trademark registration. If your proposed mark includes both a literal element (*word(s), letter(s), number(s), punctuation mark(s), or other typed symbols*) and a design element (*logo(s), design(s), color(s)*), separate trademark clearance must be completed for each of these elements. All trademark clearance is completed on a five-business-day turnaround, and with reference to a specific Class(es) and specific products or services. For a discussion of the meaning of “Class,” please refer to Part IV. The advisable format and scope of the trademark availability review will depend on the specifics of the mark and will be established in consultation with the Trademark Licensing Office, the University’s outside trademark attorney, and, if applicable, the search firm supplying the clearance research. Further, in lieu of, or in addition to, trademark clearance, it may be necessary to engage outside counsel – before and/or after trademark availability review is completed – for consultation and research on the best approach for protecting your proposed mark. Please carefully review the discussion both in the subsection (1)(a) directly below, and in Section 2, on the next page.

- a. Trademark protection consultation and research: a consultation with the University’s outside trademark attorney may be required before a clearance search is completed, or in place of a search.
- b. Trademark clearance for a literal element – word(s), letter(s), number(s), punctuation mark(s), or other typed symbols:
 - i) a preliminary trademark availability search: review of the records of the USPTO and of the trademark registries of the fifty U.S. states, for identical and highly-similar marks, in connection with identical products or services.
 - ii) a comprehensive trademark availability search: review of the records of the USPTO, of the State trademark registration records, business registration/corporate filings records of the fifty states, unregistered business name records of the fifty states, U.S. news articles, on-line citations, and domain name registrations, for identical, highly-similar, and potentially confusingly-similar marks, in connection with one to two sets of related products or services.
 - iii) a brand expansion search: similar to a comprehensive trademark availability search but encompassing a broad variety of potential products and/or services, in connection with three or more sets of unrelated goods or services.
- c. Trademark clearance for a design (logo) element:
 - i) a preliminary review of the USPTO records: review of the records of the USPTO, for identical and highly-similar logos, in connection with identical products and services, in one Class.

- ii) **an expanded review of the USPTO records:** review of the records of the USPTO, for identical, highly-similar, and potentially confusingly-similar logos, in connection with products and services in one Class.
- iii) **a screening search of on-line records:** review of the digital records available on-line, for identical and highly-similar designs.
- iii) **a comprehensive search of on-line records:** an extensive review of the digital records available on-line, for identical, highly-similar, and potentially confusingly-similar marks; requires at least ten business days: pricing and availability depends on rates set by, and services available from, a third-party search firm and must be confirmed prior to ordering the search.

- *Ownership of a trademark is conferred by its use and not by its registration. However, a preliminary search provides some assurance that we are not likely to receive a refusal to register the mark from the USPTO because of a directly-conflicting application(s) or registration(s). A comprehensive search provides a more complete possible picture as to potential competing trademark rights and as to the scope of the trademark rights that we may be able to establish and protect. An expanded brand search considers potential conflicts across a broad range of products and services.*
- *Trademark clearance is completed by a trademark attorney retained by the University's Office of the General Counsel, in consultation with the Trademark Licensing Office.*
- *Because ownership of a trademark is conferred by its use and not by its registration, there is always a possibility that a prior but unregistered user of a similar mark exists, and such user may not be discovered even with a comprehensive search. Also, with all searching, records subject to review are not available in "real-time": there may be two weeks' or greater delay between the actual records and the records available for searching and viewing. The relevant records change constantly, and may change by the date of filing the application with the USPTO. In addition, the filing priority is determined by the date of filing, and, during examination, the USPTO does not make a determination on priority of ownership. For these reasons, if the results of the availability review do not disclose a conflict, it is advisable to avoid delay between the date of these results and the date of application filing.*

2. Consultation about Trademark Clearance Results, and Possible Additional Trademark Availability Review.

If the results of the trademark clearance completed for your proposed mark indicate that the mark is available, the next step may be to proceed with the preparation and filing of a trademark application. However, if the trademark clearance review reveals a conflict or other grounds on which your proposed mark may not be available for use or eligible for registration, additional work will likely be required. This work may include consultation with the outside trademark attorney about possible revisions to the mark, or about adopting a potential alternative mark, and may also include new trademark clearance review.

- a. Consultation with outside counsel regarding search results.
- b. **Follow-up trademark clearance:** if it is advisable to complete additional trademark clearance, this work will be subject to the same costs as set out in Section 1 above.

3. Preparation and Filing of the Application. To prepare and file an application to register your proposed mark with the USPTO, we will need the Program's **examples of use of the mark and the date(s) of its first use**, as described in Part II above. The following fees will apply:

- a. USPTO filing fees
- b. Attorney fees

- *The final decision on the format in which the mark should be registered will depend on the results of the trademark clearance review and will be made by the Office of the General Counsel, in consultation with the requesting Program, the Trademark Licensing Office and with the University's outside trademark counsel.*
- *After an application is filed, it will undergo several stages of examination at the USPTO. As a result, the time for completion of a registration, from the time of the application filing and through the receipt of the Certificate of Registration, varies. This time period may be as short as seven months in an application where no substantive issues are raised, to as long as 18 months, or longer, in an application where either the USPTO, or a third-party raises objections to registration.*

4. Application Examination. Following the filing of the application, it will go through several stages of examination and other procedures at the USPTO, before registration may be issued. The total costs depend on the actions taken by the USPTO, and the Program's corresponding response.

- a. **Initial review by the USPTO Trademark Examining Attorney and subsequent USPTO review:** Approximately **three to four months after the application is filed**, it will be reviewed by an USPTO Trademark Examining Attorney. If the Examining Attorney determines that the mark is eligible for registration and that the application does not require any amendments, the USPTO will approve the mark for publication. However, if the Examiner determines that the mark cannot be registered and/or that an amendment(s) to the application must be entered, s/he will telephone and/or send correspondence to the University's outside trademark counsel explaining the reasons for refusals and/or stating other requirements. The USPTO's written communications may be in the form of a "Notice of Suspension," a "Priority Action," an "Office Action" or an "Examiner's Amendment." The USPTO may issue more than one letter of action – of the same or a different type (raising new, or restating previous, issues and/or requirements) – in a single application. The USPTO may issue letters of action at various stages of the registration process, including following the initial review, before or after publication, or during the final examination immediately preceding the issuance of the Certificate of Registration.
 - i) Attorney fees for analyzing each USPTO telephone inquiry or written letter of action, and preparing a blueprint for how to respond to the USPTO.
 - ii) Submitting each Response to a USPTO inquiry or letter of action, if the Program decides to respond following receipt and review of the blueprint for Response:
 1. **Response complying with USPTO technical requirements:** examples of technical requirements include requests for entry of a disclaimer, submission of a substitute specimen of use, submission of a new mark image, and revisions to the classification or the description of the products or services, or to the description of a logo; and/or
 2. **Response arguing against USPTO's refusal of registration:** the USPTO may refuse registration on "statutory grounds" – as when the USPTO finds the mark to be similar to a mark in the USPTO records or to be merely descriptive, but the USPTO may also refuse registration for non-compliance with technical requirements.
- b. **Petition to Revive.** The USPTO allows six months to respond to most of its communications. In the event that a response cannot be timely submitted to the USPTO, the application will become abandoned. In certain circumstances, a petition to "revive" the application may be filed with the USPTO, within 60 days of the Notice of Abandonment; this petition must be accompanied by a substantive response to the USPTO's requirements. The following fees may apply:
 - i) USPTO filing fees for a Petition to Revive:
 - ii) Attorney fees for preparing and filing a Petition to Revive (apart from and in addition to the fees related to the preparation of the Response)

5. **Publication.** If the mark is approved for registration, it will be published in the *Official Gazette*, for a period of 30 days, to allow any third parties who believe they may be damaged by this registration, to oppose it; attorney fees for reviewing, confirming and reporting a Notice of Publication.
6. **Certificate of Registration.** If no opposition is filed during the publication period, the USPTO will issue a Certificate of Registration for the mark, within approximately six to ten weeks following the expiration of the publication period; attorney fees for reviewing, verifying and reporting a Certificate of Registration.
7. **Registration Maintenance.** The USPTO requires certain periodic filings in order to keep a registration in force.
 - a. A Declaration of Continued Use and Incontestability must be filed within the year following a registration's fifth anniversary. An Application for Renewal must be filed in the year following a registration's ninth anniversary and, subsequently, every ten years. These filings must be accompanied by proof that the registered mark continues to be in use. If you are not able to submit such proof, the registration will become inactive. The following fees will apply:
 - i) USPTO filing fees for the Declaration of Continued Use and Incontestability.
 - ii) USPTO filing fees for the Application for Renewal.
 - b. The USPTO may issue a letter(s) of action with respect to the Declaration of Continued Use and/or the Application for Renewal, requiring the preparation and filing of a Response(s), similarly to the letters of action and Responses during the application examination and processing (as described in Section (4) above).
8. Please include any questions that you have about either the process or the costs for a trademark registration and registration maintenance, and then carefully review the conditions set out in Part IV.

PART IV. GENERAL CONDITIONS

The following statements address the most common issues and questions related to trademark registration and enforcement. Other issues may be relevant in the clearance, registration and enforcement of the proposed mark and addressing such issues may result in additional expenses to the Program. The appropriate action will be determined in each instance by the Office of the General Counsel, in consultation with the Program and the Trademark Licensing Office.

1. An application may be filed even before use of a mark in interstate commerce begins, if your Program has intent to use the mark in the future. However an “intent-to-use” application requires preparation and filing of additional documents, accompanied by filing fees, and additional attorney fees. These expenses depend on the length of time between the date of application and the date on which the Program can demonstrate that the mark has been used in interstate commerce.
2. Each application can include only a **single** mark. A single mark may consist of a name or a phrase (words, numbers, letters, punctuation marks, and/or other typed symbols) and a logo (design), and even additional elements, if this combination is consistently used as a single mark. If the name is at times used without the logo or without the additional elements, then the name, the logo, and each additional element should be registered under separate applications.
3. Each application covers a **single** International Class (i.e., Class 16 for stickers or other paper products, Class 25 for clothing, Class 41 for athletic events or academic programs).
4. The number of “Classes” for trademark registration or trademark clearance is determined through reference to the international classification system of all products and services, as adopted by the USPTO.
5. If an agreement with a third party is necessary for a Response to a USPTO inquiry or letter of action, if trademark registration and/or clearance requires additional factual investigation(s) and/or action against a third party, if a voluntary amendment(s) to a filed application is required, if there are changes to the original filing instructions from the Program, if we file an appeal to the Trademark Trial and Appeal Board, if an opposition or an extension of time to oppose is filed against registration of your proposed mark, if we encounter USPTO error, or in the event of other extraordinary circumstances, **all resulting necessary actions, and the related charges, will be in addition to the fees and expenditures discussed in Part III, subject to prior approval by the Office of the General Counsel and by the Program.** Additional fees will also result from delayed or inadequate instructions, or incomplete responses to the information and materials requested in this *Questionnaire*, from changes to the received responses and materials, and/or introduction of new documents or information. **All additional fees will be billed on an hourly basis and calculated at the outside counsel’s then-current billable rates.**
6. Please note that all official filing fees are set by the USPTO and are **subject to change** by the USPTO at any time and without notice, and that attorney hourly rates are **subject to change** by the University’s outside counsel.
7. Please keep the Trademark Licensing Office up-to-date on any changes to the use of the mark by the Program. We have a duty to ensure that the registration record accurately reflects **actual use** of the mark, at all times. Further, the current registration process covers use of the mark only with the specific products and/or services that are identified during the current registration process. To the extent that **new use** of the mark is not encompassed in the original description of the products and/or services, a new registration may be necessary to ensure that the mark is protected adequately.

8. In an event of misuse (infringement) of the mark by another party, legal action to enforce the University's rights in the mark may be necessary. Such action must be first approved by the Office of the General Counsel and may result in **additional expenses** to the Program.
9. Please note that you will need to comply with all instructions by the Trademark Licensing Office and the Office of the General Counsel on the proper format for your mark, including the applicable branding standards and trademark rights and registration symbols. In general, you may use the symbol **TM** next to your mark if your mark identifies a product (including any merchandise), and the symbol **SM** if your mark identifies a service. These symbols may be used while your application with the USPTO is pending and even if an application has not (or has not yet) been filed. You may use the symbol **®** next to your mark – regardless of whether the Program offers a product or a service – **after** we receive the Certificate of Registration from the USPTO. If you believe that it will not be feasible to use any of these symbols with the Program's mark, please include a detailed explanation in the questions section below.

Please include any questions that you have about Part IV and then complete Part V.

PART V. ACKNOWLEDGMENT

The undersigned have reviewed the above responses, considered the estimated expenses, and desire to communicate with the Trademark Licensing Office and a trademark attorney retained by the Office of the General Counsel, in consultation with the Trademark Licensing Office, about the continued or proposed use, the clearance, and/or the registration with the U.S. Patent and Trademark Office of the trademark or service-mark described in Part I, for _____ *(Program name)*.

Trademark Guide & Questionnaire
submitted by:

Signature

Name, Title (Program Director/Department Chair)

Date

Trademark Guide & Questionnaire
reviewed and approved by:

Signature

Name, Title (Vice-Chancellor or Designee)

Date