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Trademarks: USPTO, CIPO, and the Madrid Protocol

How to Register a Trademark Yourself and Protect Your Brand

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CHAPTER 1

Why You Need a Trademark and What It Protects

A trademark is a symbol (a word, logo, slogan, color, or sound) that distinguishes your goods or services from those of your competitors. Registering a trademark gives you the exclusive right to use that symbol in a particular jurisdiction and in particular classes of goods and services.

What a trademark protects: the right to use the mark. The right to stop others from using a similar mark in the same classes. The right to sue infringers. The right to use the ® symbol (only after registration; you can use ™ without registration as a claim of ownership).

What a trademark does NOT protect: it does not protect the idea behind a product. It does not stop someone from selling a similar product (only from using a similar name or logo). It does not work outside the jurisdictions where it is registered. It does not replace a patent (for inventions) or copyright (for creative works).

Why it pays to register early: the first applicant has the advantage (especially in the US). Registration creates a public record of your right. A registered mark is easier to defend in court. Amazon Brand Registry, the Apple App Store, and Google Play require or prefer registered trademarks. For an international business, a registered mark is needed to work with distributors and partners.

Common mistakes: registering a mark in only one country when the business is international. Skipping the search before filing (the risk is a refusal or a lawsuit). Registering in the wrong classes of goods. Failing to renew (an expired mark is lost). Using ® before the registration is granted.

The cost of registration: USPTO: $250–$350 per class (TEAS Plus vs. Standard). CIPO (Canada): CAD$458 for the first class

online. Madrid Protocol: a basic fee of CHF 653 plus the fees of the target countries. A trademark attorney: $1,000–$3,000 for a basic registration. Filing on your own is possible and saves money if you approach it carefully.

CHAPTER 2

Trademark Search: What to Check Before You File

A search before filing is insurance against two risks: being refused by the USPTO or CIPO because a similar mark already exists, and being sued by the owner of a similar mark even if the USPTO approved yours.

Levels of search: Basic (do it yourself): the USPTO TESS database (tmsearch.uspto.gov). The CIPO Trademark Database (trademarks.ic.gc.ca). Google and Bing: search the name plus your industry. Domain names. Social media handles. Professional (recommended): a patent attorney runs a comprehensive clearance search. It includes: common law marks (unregistered ones). Phonetically similar marks. Visually similar logos. Cost: $500–$1,500.

USPTO TESS search: available at tmsearch.uspto.gov. Search types: Basic Word Mark Search, for an exact match on the word. Design Code Search, which searches by the visual elements of a logo. Combined, which mixes the two. Filters: Status (Live/Dead; dead marks are less relevant but can create prior art). International Class. How to evaluate the results: a mark is “confusingly similar” if it resembles yours in sound, spelling, appearance, and/or concept. An exact match is not required. If your name sounds like an existing mark in the same class, the risk of refusal is high.

The concept of “likelihood of confusion”: the USPTO weighs 13 factors (the DuPont factors). The main ones: similarity of the marks (sound, appearance, meaning). Relatedness of the goods or services. Channels of trade. Sophistication of the buyers. Strength of the existing mark (the better known it is, the broader its protection). If the existing mark is similar BUT in a completely different class (clothing vs. software), the risk is lower, but not zero.

Common law trademark rights: in the US (and Canada), using a mark in commerce gives you rights “in fact” (a common law trademark) even without registration. This means that even if your mark is not in TESS, a small local business may have prior rights in its own region. A comprehensive search checks common law marks through: State and provincial Secretary of State databases. The BBB (Better Business Bureau). Industry databases. DBA registrations.

Registrability: not every mark can be registered. The USPTO refuses: Purely descriptive marks that simply describe the product (“Cold Ice Cream” for ice cream). Generic marks, the common name of the product (“Computer” for computers). Marks that are primarily merely a surname. Immoral or scandalous matter. Deceptive marks. Government symbols and flags. Living people without their consent. Ideal marks: Arbitrary (an unrelated word, such as Apple for computers). Fanciful (an invented word, such as Kodak or Xerox). Suggestive (hinting at the product without describing it, such as Netflix or Spotify).

CHAPTER 3

USPTO: Registering in the US Step by Step

The US is the largest market and the most important jurisdiction for most technology brands. A USPTO registration gives you rights across the entire United States and strengthens your position in any international registration.

Preparation: choose the mark to register (word mark, design mark, or combined mark). Determine the classes of goods and services (Nice Classification). Write the identification of goods/services (the specification). Find the date of first use in commerce (if you already use the mark).

Nice Classification (international classes): 45 classes: 1–34 for goods, 35–45 for services. Examples: Class 9: Software, apps, electronic devices. Class 35: Business management, advertising services. Class 41: Education, entertainment, training. Class 42: IT services, SaaS, software development. You need to register in every class where you operate. Each class carries a separate fee ($250–$350).

Identification of Goods/Services: this is the most technically difficult part of filing on your own. A description that is too narrow does not cover your real business. One that is too broad will be refused by the USPTO or sent back for clarification. Use the USPTO ID Manual (idm.uspto.gov), a database of approved descriptions. An example of a good one: “Providing a website featuring information about business management; Online retail store services featuring business supplies” (Class 35).

Basis for Application: Use in Commerce (§1(a)) if you already use the mark in commerce. You need a Specimen (an example of use). Intent to Use (§1(b)) if you do not use it yet but intend to. You first receive a Notice of Allowance, then you must file a Statement of Use within 6 months (with possible extensions).

Filing through TEAS: TEAS Plus ($250 per class): stricter requirements (use the ready-made descriptions from the ID Manual). If the examiner finds an error, a $100 per class penalty is possible. TEAS Standard ($350 per class): you can write your own descriptions. More flexible. The filing process: create an account on USPTO.gov. Open the TEAS form. Fill in: owner information, mark description, classes, specimens (for §1(a)), filing fee. Sign (electronically) and pay.

After filing: a Serial Number is assigned immediately. Examination: a USPTO Examining Attorney reviews the application (about 8–12 months in the queue). If there are no problems, the mark goes to Publication for Opposition (30 days for third parties to object). If there is no opposition: for §1(b), a Notice of Allowance. For §1(a), a Registration Certificate.

CHAPTER 4

Office Actions: How to Respond to USPTO Objections

An Office Action (OA) is an official letter from a USPTO Examining Attorney raising objections to your application. Getting an OA is normal: about 80% of applications receive at least one. It is not a refusal. It is a dialogue. A well-built response to an OA often leads to approval.

Types of Office Actions: Non-Final OA: the first objection. You have 3 months to respond (extendable to 6 for an additional fee). Final OA: issued if your response did not resolve all the objections. You have 3 months to respond (with an extension). After a Final OA you can file a Request for Reconsideration or an Appeal.

The most common grounds for an OA:

Likelihood of Confusion (Section 2(d)): the examiner found a similar mark. Response: argue the differences. Present evidence that the markets are different. Obtain a Consent Agreement from the owner of the existing mark. Sometimes: narrow the specification to non-overlapping goods only.

Merely Descriptive (Section 2(e)(1)): the mark simply describes the product. Response: argue that the mark is “suggestive,” not “descriptive.” Or file under §2(f) with evidence of acquired distinctiveness (5 years of use, $500K spent on advertising, a sworn declaration). Or move to the Supplemental Register (weaker, but a real registration).

Identification Issues: the description is too broad or unclear. Response: clarify the description using the ID Manual.

Specimen Issues: the example of use was not accepted. Response: provide a different specimen. For software and apps: a screenshot of the app showing the name. For services: a screenshot of a webpage with a description of the service.

How to write a response to an OA: Deadline: observe it strictly. If you miss the 3 months, the application is considered abandoned. Structure: address each issue separately. Provide arguments and evidence for each point. Sign and submit through the TEAS Response form. Tips: responding ahead of the deadline is good practice. The examiner may agree in part, so be ready to compromise. If the OA is complicated, bring in a trademark attorney at least for a consultation ($300–$500/hour).

CHAPTER 5

CIPO: Registering a Trademark in Canada

The Canadian Intellectual Property Office (CIPO) administers trademarks in Canada. The Canadian system has several features that set it apart from the USPTO.

Features of Canadian trademark law: Canada applies the territorial principle: rights extend only to Canada. Bilingualism: marks may be used in English and French. A mark in one language does not have to be registered in the other, but protection is better if you register both versions.

Grounds for registration in Canada: Use: use in Canada. Proposed Use: an intention to use. Made Known: use abroad (for marks that are known in Canada). Registration Abroad: if the mark is already registered in a country that is a party to the Paris Convention (including the US), you can file in Canada within 6 months with the same priority date.

The CIPO process: Search: the CIPO Canadian Trademark Database (trademarks.ic.gc.ca). Filing: through CIPO Online Services. Fee: CAD$458 for the first class, +$306 for each additional class. Examination: 12–18 months on average. If there are no objections, the mark goes to Advertisement for Opposition (2 months). If there is no opposition, it proceeds to registration. Term: 10 years, renewable.

Differences from the USPTO: Canada has no TEAS equivalent; you file through the CIPO portal. The Nice Classification has been used since 2019 (a different system applied before). Examination is stricter on “clearly descriptive” marks. Registered User (licensing): Canada’s transfer rules are different.

Specimen requirements in Canada: similar to the USPTO; you need a sample of use. However, CIPO also accepts specimens in French without requiring an English version.

After registration in Canada: Maintenance: there is no equivalent of the USPTO Declaration of Use at year 5. There is only renewal every 10 years. Enforcement: if someone infringes your mark, you can: send a cease & desist letter. Go to the Federal Court. Use a CIPO Opposition proceeding (if the infringer also files a mark). Amazon Brand Registry Canada requires an active CIPO registration.

Canada-US brand strategy: most international brands register in both countries. Priority: start with the country of your main market. Use Paris Convention priority if you file within 6 months of the first filing. The examinations differ: the USPTO may approve what CIPO refuses, and vice versa. Hire a trademark agent with experience in both systems for a coordinated strategy.

CHAPTER 6

Madrid Protocol: International Registration

The Madrid Protocol is an international system for registering trademarks through WIPO (the World Intellectual Property Organization). It lets you file one international application and extend the mark's protection to 130+ member countries.

Advantages of the Madrid Protocol: a single application for many countries. A single fee (plus the target countries' fees). Centralized management (updates and renewals through WIPO). Cheaper than filing separately in each country.

Limitations of the Madrid Protocol: you need a "basic application" or registration in your country of origin (your home country). If the basic mark is cancelled within the first 5 years, all the international registrations are cancelled too ("central attack"). Not every country takes part (Canada has been a member since 2019; the US and most developed countries are members too).

How the process works: you file an international application through the USPTO (if your basic mark is American) or CIPO (if it is Canadian). WIPO checks the formal requirements. It sends the application to each target country. Each country examines it under its own rules. It may approve or refuse within 12–18 months.

Madrid Protocol fees: Basic WIPO fee: CHF 653 (black-and-white mark) or CHF 903 (color mark). Additional fees: depend on the country. Examples: EU (one region through the EUIPO): CHF 1,050. UK: CHF 259. Japan: CHF 594. Australia: CHF 304. China: CHF 348. The total for US + EU + UK + Australia + Canada: roughly $3,000–$4,000 (vs. $8,000–$15,000 when filing separately in each country).

European Union Trade Mark (EUTM): a special case. An EUTM through the EUIPO gives you protection in all 27 EU countries with one application. Fee: €850 for one class online. It applies uniformly

across the EU. A refusal in one country does not block the others (unlike the Madrid Protocol, where each country is independent). For companies focused on the EU market, an EUTM through the EUIPO is often better than the Madrid Protocol + EU.

When to use the Madrid Protocol: you have a registered basic mark. You want protection in 5+ countries. You are planning international expansion. Recommended sequence: Year 1: register in your main market (the USA or Canada). Years 1–2: the Madrid Protocol for additional markets. Target countries where you already have sales or specific plans.

CHAPTER 7

Defending Your Mark: From Monitoring to Court

Registering a trademark is only the beginning. For your rights to work in practice, you need to monitor actively for infringement and respond in time.

Monitoring new applications: USPTO: subscribe to a USPTO Trademark Alert through IP Australia or third-party services (TrademarkNow, CompuMark from Clarivate). You get notifications when someone files a mark similar to yours. CIPO: similar monitoring through CIPO or third-party services. WIPO GlobalBrand Alert is a free service for international monitoring. Why monitor: you have a 30-day window for Opposition against similar applications. Once an infringer has registered, challenging it is much harder and more expensive.

Cease & Desist Letter: the first step when someone infringes. A letter to the infringer demanding that they: stop using the mark. Destroy materials bearing the infringing mark. Transfer the domain, if applicable. Pay damages (optional). Most infringements are resolved at this stage. The infringer often did not know about your mark or did not expect a serious response.

Domain squatting: someone has registered a domain containing your trademark. UDRP (Uniform Domain Name Dispute Resolution Policy): a WIPO arbitration procedure. Cheaper and faster than court ($1,500–$4,000, 60 days). Criteria for winning: the domain is identical or confusingly similar. The owner has no legitimate rights. It was registered and is being used in bad faith.

Amazon Brand Registry: after your USPTO (or CIPO) registration, apply to Amazon Brand Registry. It gives you: the right to file complaints about infringement of your mark on Amazon. Tools for removing counterfeit listings. Enhanced Brand Content. A+ Content. Sponsored Brands advertising.

Opposition proceeding: if someone files a mark similar to yours: USPTO Opposition has a 30-day deadline from Publication for Opposition. CIPO Opposition has a 2-month deadline. Contact a trademark attorney; this is a specialized procedure. If you do not react, the infringer will get the registration and become an equal rights holder.

Cancellation proceeding: the mark is already registered but infringes your rights. The TTAB (Trademark Trial and Appeal Board) handles this for the USPTO. Grounds: likelihood of confusion with your prior mark. Fraud on the USPTO. Non-use of the mark. The procedure takes 12–24 months. Cost with an attorney: $10,000–$50,000+. It is a more expensive route than Opposition, so it is better to monitor and react earlier.

Maintenance and renewal: USPTO: the §8 Declaration of Use is filed between years 5 and 6 after registration (proof that the mark is in use). The §9 Renewal is due every 10 years. If you miss it, the mark is cancelled automatically. CIPO: only renewal every 10 years ($CAD400). Madrid: renewal through WIPO every 10 years (covers all countries in one operation).

CHAPTER 8

Trademarks for SaaS and Digital Products

SaaS companies and digital products have specific intellectual property protection needs. Unlike physical goods, digital brand protection goes far beyond traditional trademarks.

What to register for SaaS: the product or brand name (a word mark). The logo (a design mark). The slogan, if it is short and not descriptive. The mobile app name, if it differs from the main brand. Sub-brands (Enterprise edition, Pro tier, and so on) if you plan to promote them actively.

Classes for SaaS (Nice Classification): Class 42: Software as a service (SaaS); cloud computing; software development. Class 35: Business management software; advertising; data analysis. Class 38: Telecommunications; online communication. Class 9: Software (recorded on media); mobile apps. Register at least Classes 42 and 9 for most SaaS products.

GitHub, npm, PyPI, and namespace squatting: before you register the trademark, claim your name on: GitHub (organization and personal). npm (for JavaScript packages). PyPI, RubyGems, Maven, Docker Hub. The App Store and Google Play. If someone has already taken it, that is a warning sign. You may need to choose a different name.

Social media handles: Twitter/X, LinkedIn, Facebook, Instagram, TikTok. Take the same name everywhere. Namechk.com checks all the social networks at once. This is not legal protection, but it is an important part of brand coherence.

Open source and trademarks: if your product is open source, a trademark matters even more. Examples: the Linux Foundation owns the “Linux” mark. Mozilla owns “Firefox.” The WordPress Foundation owns “WordPress.” This protects you from forks that use your name commercially without permission.

Trademark licensing for SaaS: if you want to let partners use your mark (resellers, integrators): a Trademark License Agreement is mandatory. It must contain quality control provisions. Otherwise you risk a “naked license,” which can invalidate your mark (USPTO precedents). A franchise is a more serious kind of license with full control.

Trade secrets vs. patents vs. trademarks for tech: your algorithm is a trade secret (do not disclose it publicly). Your unique UI/UX is covered by copyright. Your innovative method is a patent (expensive, complicated, 20 years). Your brand is a trademark (indefinite, as long as you renew and use it). For most SaaS companies, trademark + trade secrets is the best IP strategy.

IP audit before fundraising: serious investors (VCs, PE) run IP due diligence. What they check: are there registered trademarks? Are the domain names registered? Are there Employee IP Assignment Agreements (employees have assigned their IP to the company)? Are there IP litigation risks? Unregistered IP before a round means a lower valuation and additional terms from investors.

What next

Thank you for reading “Trademarks: USPTO, CIPO, and the Madrid Protocol”.

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