

## **RISKS IN USING ONLINE LEGAL DOCUMENT SERVICES FOR TRADEMARK APPLICATIONS**

By: Ruy M. Garcia-Zamor

As the Internet matures, there are an increasing number of Internet based legal document services that allow individuals to file trademark applications directly without the assistance of an attorney. Using one size fits all legal forms/solutions without the benefit of specialized legal advice can entail some significant risks not immediately apparent to a trademark applicant. These risks include the loss or reduction in scope of trademark rights and a possible increase in the total cost of pursuing the trademark application at the U.S. Patent and Trademark Office (“USPTO”).

While many of the online legal document services appear to be providing legal services, there is often a carefully worded disclaimer (prepared by an attorney) explaining otherwise. For example, one online legal document service, LegalZoom™, provides the following as part of its disclaimer:

LegalZoom is not a law firm, and the employees of LegalZoom are not acting as your attorney. LegalZoom does not practice law and does not give legal advice. This site is not intended to create an attorney-client relationship, and by using LegalZoom, no attorney-client relationship will be created with LegalZoom. Instead, you are representing yourself in any legal matter you undertake through LegalZoom's legal document service. ... This website is not a substitute for the advice of an attorney.

Furthermore, the legal information on this site is not legal advice and is not guaranteed to be correct, complete or up-to-date. Because the law changes rapidly, LegalZoom cannot guarantee that all the information on the site is completely current. The law is different from jurisdiction to jurisdiction, and is also subject to interpretation by different courts. The law is a personal matter, and no general information or legal tool like the kind LegalZoom provides can fit every circumstance.

(LegalZoom™ disclaimer, August 22, 2007)

If nothing goes wrong during the trademark application process or afterwards and if the trademark is never challenged or asserted, then the lack of specialized legal advice may not matter. However, one definite drawback of not using an attorney is that you are your own representative and, accordingly, are responsible for monitoring the progress of the application, responding to notices from the USPTO, and developing legal analysis in response to any rejections from the USPTO. Furthermore, handling your own trademark application will also require docketing the trademark registration date and following up with the requisite post registration filings that are necessary to keep the registered mark from expiring prematurely.

Some of the services provided by Garcia-Zamor Intellectual Property Law for trademark clients are:

1. Providing advice for determining a suitable trademark application filing strategy and how the trademark application fits into an overall branding strategy;
2. Maintaining independent copies and proof of all filings and related dates;
3. Reporting and explaining all official communications from the USPTO;
4. Providing legal analysis and advice for responding to rejections from the USPTO and other formal notices;
5. Docketing deadlines for responding to notices and rejections from the USPTO;
6. Providing information regarding deadlines for filing related trademarks abroad;
7. Advising clients if their mark is opposed by a third party after publication;
8. Explaining the proper requirements for filing statements of use or extensions of time after allowance of a trademark application; and
9. Docketing registered trademark deadlines for filing of subsequent petitions and renewals.

If you would like to see whether the same services are provided by a particular online legal document services here are some questions you can ask the service:

1. Are they providing legal advice?
2. Do they provide advice regarding trademark selection and branding strategy?
3. Do they have a number that you can call to speak with an attorney?
4. If you can call an attorney, is the attorney licensed in the U.S. by a state bar and how many years of experience does the attorney have?
5. Do they report and explain official notices received from the USPTO?
6. What can they do for you when something goes wrong or an application is rejected?
7. Will they monitor deadlines for responding to office actions and official notices?
8. Will they prepare legal responses to rejections or official documents received from the USPTO?
9. Will they explain what filings need to be made after a trademark is registered and docket the appropriate deadlines?

Of course, trademark applications can be transferred to an attorney part way through the application process, but doing so often entails an increased cost for reviewing and becoming familiar with an existing application. Additionally, it is sometimes more difficult and expensive to fix a problem retroactively.

If you have any questions regarding your trademarks and related branding strategy, please contact Garcia-Zamor Intellectual Property Law.