

Trademark and Licensing

Trademark Registration

If your college or unit is interested in pursuing a federal registration for a brand to be used on a service or product to be sold or otherwise distributed into the marketplace, complete this form and e-mail to licensing@nau.edu. Whether the brand takes the form of a wordmark or a logo or design (marks), we can consider applying for a U.S. federal trademark registration.

College / Unit Responsibilities

In order to ensure that individual college and unit wordmarks, logos and designs are aligned with the University's overall branding, colleges and units are required to submit their proposed mark to the University Marketing department (UM) for review prior to implementation. If wordmarks, logos or designs have not gone through this review process and the college/unit wants them to be considered for federal registration, such marks must meet the requirements of UM pursuant to the visual identity guide and brand standards and ensuing final review. Any requests for federal registration of marks that do not meet University Marketing guidelines and have not gone through the above approval process will not be considered. All requests for mark registration must have the permission of the Vice President who oversees the requesting college/unit before submitting the questionnaire.

There is a cost to file an application and, if a registration is granted, there is an additional cost to maintain that registration with the United States Patent and Trademark Office (USPTO). Application and maintenance costs will be borne by the college/unit seeking to register the mark. The Office of General Counsel (OGC) works closely with our office and OGC selects expert counsel, as appropriate, to handle all registrations with the USPTO, as well as all follow-up and maintenance.

If a registration results from the application, in order to maintain the registration, the college/unit will have to prove that it is still using the mark as filed (in connection with the services or goods identified in the application) between the fifth and sixth years of registration. Registrations are valid for ten years and then renewable for additional ten-year periods as long as the college/unit can prove that it is still continuing to use the mark as filed and in connection with the same services or goods listed in the registration.

Also, colleges/units will be required to enforce their marks against third parties who use such marks without NAU's permission in order to maintain the rights NAU has to the

marks. Cease and desist letters and sometimes even litigation might be necessary to ensure that colleges/units are fulfilling their obligations, as required by applicable law.

Cost Estimates for Federal Registration*

As of April 2020

Application filing fee for one class: \$225 - \$275 per class

Attorney fees for filing the initial application / paperwork: \$800 - \$1,200 per mark

- Additional fees may be assessed if the examiner issues an office action

Full trademark search: \$2,000 - \$2,300 (search company cost and legal review and analysis)

Statement of use for intent to use for applications: \$100 per class & \$600 - \$900 legal fees

Six-month extension of time to file statement of use: \$125 per class & \$250 - \$350 legal fees

5/6-year affidavits fees & government fees: \$325 per class & \$500 - \$800 legal fees

10-year renewal fees & government fees: \$425 per class & \$600 - \$900 legal fees

*Additional costs and/or fees may be required, including legal fees for expert counsel, if unforeseen issues arise regarding a particular registration application. All determinations of whether legal action is necessary are made by OGC, working with expert counsel as deemed appropriate by OGC.

Timeline Estimates for Federal Registration

Please visit the USPTO website for a step-by-step review of the estimated timeline for the federal registration application process:

[USPTO Federal Registration - Application Timeline](#)

Trademark Registration Questionnaire

Name: _____

College / Unit: _____

Email address: _____

Phone: _____

What mark is the college/unit requesting to file with the USPTO? Attach a copy of the mark / logo.

Give a description of the products and/or services that the college/unit will offer in connection with the mark and describe the geographic area where those products and/or services will be distributed and marketed. If such products and/or services will be distributed and marketed via the Internet to those outside of Arizona, please indicate the expected geographic reach of the products and services.

When did the college/unit first distribute/sell a product into the marketplace using the mark? If the mark is not used on a physical product, but on an educational program or other service, when did the college/unit make the services available in the marketplace using the mark? If the mark is used on more than one product or service, please provide the applicable date for each product and service. Please note that merely advertising a product or service is not a relevant date; it is the date the product is actually distributed/sold, or, if a service, advertised, if the college/unit actually had the services live and available for purchase. Provide the month / day / year

How long does the college/unit plan on offering the product or service offered under the mark? How long does the college/unit plan to use the mark in connection with those products or services?

Who designed the mark? (NAU Employee or outside firm*) Please provide the name and contact information.

**If an outside firm, does NAU have a written agreement with the company?
If yes, does that written agreement assign the work product to NAU or at least designate the work as a "work made for hire"?*

Please attach a copy of the agreement.

How is the college/unit using the mark? Please provide all examples of how the mark is being used (e.g., product, web links, marketing brochures / printed materials). *Use occurs for a product when the mark is used on products, hangtags, packaging and for services when the mark is used in advertising or marketing communications, provided the services are actually provided.*

Have products/services been provided/distributed outside the state of Arizona?

Has the college/unit checked the USPTO database to see if the mark / name is already registered by someone else? www.uspto.gov

On what types of products/services does the college/unit seek permission to apply for federal registration through the USPTO?

Why does the college/unit want to protect the mark?

Is the college/unit aware of anyone else using the mark / name?

Is the college/unit working with any entity outside the university who might claim some ownership to the mark?

Applicant Signature _____

VP Signature _____

Date _____