



**Greg Butler Law**

# TRADEMARK

Application Overview →  
A Cheatsheet to Your Achieving  
Trademark Protection

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# Introduction

## Scope

If you have a mark and you want it protected, this cheatsheet has you covered. The following is an **overview of the trademark application process**. Take this guide as useful information to help your business navigate through trademark registration with the **United States Patent and Trademark Office ("USPTO")**.

Trademark law is rather complex, we don't want to bore you with the nitty gritty, this tool will explain the basics to get you started on the path towards trademark protection!

We are going to walk you through the steps of the trademark prosecution process. Starting from trademark analysis → going through the application process → all the way through having your mark registered (that's the exciting part!) Additionally, we'll provide some important information on how to keep your mark through maintenance, monitoring usage, and enforcing your rights.

Reach out to us if you need further guidance or have any questions!

## Disclaimer

We're lawyers, so we have to cover the boring stuff first. It is important to point out that the information presented in this guide is information and not specific legal advice. Advice is only something that can be provided after a thorough review of your particular situation and by a licensed and experienced attorney.

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# Trademark Application Process

You probably already know that trademark protection is about use (and you know that by use we mean "*use as a trademark*.") You also probably know that registration is not technically necessary to get trademark protection when your mark is already in use, as you will have common law trademark rights.

NOTE: Just in case there is any confusion, **common law** is law based in practice and case precedent. **Federal law** here is based on statutes, or written laws that make "XYZ" legal or not. The applicable Federal law is the Lanham Act. Does that make sense? This is an important distinction for achieving full trademark protection in the US.

**Federal registration gives a trademark owner several rights not available under common law** and enhances the level of protection of the mark. We are fans of cautionary measures, so seeking federal registration is generally a good idea.

Here are just a few advantages of having federal registration:

<b>Federal Registration Protection</b>	<b>Common Law Protection</b>
Your rights can be enforced throughout the United States and its territories.	Your rights can only be enforced in the geographical area in which the mark is used.
You can use the symbol ®.	You cannot use the symbol ®.
Your mark will be listed in the USPTO database and it will give notice to the public about your mark.	Your mark will not be listed in the USPTO database and it is less likely that the public will know your trademark exists.
There is a presumption of ownership of the mark.	There is no presumption of ownership of the mark.
There is a presumption of validity of the mark.	There is no presumption of validity of the mark.

In addition, there are advantages to getting your **mark filed first!** As you will see in more detail further in this guide, once you file your application, the examining attorney may refuse your application based on the fact that your mark is similar to a previously registered or applied for mark(s) used with goods or services that are related to yours. So if you get to file your trademark application first, this will be one less thing for you to worry about!

In order to get your trademark registered with the USPTO you need to understand the trademark prosecution process.

This guide will help you with that as we walk through the following steps:

- (1) Trademark Analysis
- (2) Trademark Search and Clearance
- (3) Trademark Use
- (4) Application for Federal Registration of a Trademark
- (5) Office Actions
- (6) Publication in the Trademark Official Gazette
- (7) Trademark Registration
- (8) Maintaining Your Trademark
- (9) Monitoring Your Trademark Use
- (10) Trademark Policing & Enforcement

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# Trademark Analysis

So you have a trademark picked out, it's perfect, your team loves it. What's next?

Next we **evaluate whether or not your mark can be registered with the USPTO**. There are a few steps involved in the registration process.

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**FIRST**, you have to review the mark's eligibility.

A mark is eligible for trademark protection if it is capable of distinguishing the goods or services from one source to another. Whether a mark is capable of doing this depends on whether the mark is ***inherently distinctive***.

Quick pause. We've just thrown a lot of jargon at you. Let's explain.

**Distinctiveness** is evaluated along a spectrum ranging from highly distinctive marks to terms that are generic for the type of goods or services for which the mark is used, and therefore cannot be protected.

Inherently distinctive marks = the mark's intrinsic nature serves to identify a particular source

There are five categories along the spectrum, from strongest to weakest:

(1) **Fanciful,**

- Marks that are completely fabricated/created by their owners and have no separate dictionary meaning.

(2) **Arbitrary,**

- Marks that have a dictionary meaning, but that meaning is unrelated to the product/service. These marks do not at all describe the goods/services that they are attached to. This type of mark is distinctive only in that product/service's market and the protection follows in that market.

(3) **Suggestive,**

- Marks that have a level of description, but mostly require the consumer to use their imagination to determine the nature of the product/service.

(4) **Descriptive,**

- Marks that require really no imagination, they describe a quality, function, or characteristic of a product/service.

(5) **Generic.**

- Marks that are so descriptive, they are not distinct.

→The **first three categories are considered inherently distinctive**. Inherently distinctive marks are **more likely to be approved, as they are more capable of distinguishing** the goods or services from one source to another.

→**Descriptive marks require a secondary meaning** in order to be approved as a trademark as they are not inherently distinctive.

- Secondary meaning arises over time through consumer usage of the product (ie. Coca-Cola, everyone knows that means soda because of the strength of their brand power over time).

→Holding up the weakest end of the scale of distinctiveness, **generic marks will not be approved** as trademarks as they cannot be distinguished due to their high level of distinctiveness.

The classification of the mark distinctiveness is a question of fact because choosing the category is somewhat subjective. The lines between categories blur and it really just depends on the product/service and the situation of the product/service in the market.

The likelihood of approval is not the only thing that you need to keep in mind. Don't forget that distinctiveness also plays an important role in trademark protection, as a higher level of distinctiveness will make your mark stronger and unique. Think about your mark, is it unique and requires a bit of perceptiveness on the part of the customer? Or is it glaringly straightforward?

NOTE: Please see our **Trademark Primer Guide** for an indepth look at trademark eligibility.

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**SECOND**, ensure that the trademark is not excluded from protection.

Not every word can function as a trademark and the law can prohibit or restrict its registration if the mark consists or comprises:

- (1) Deceptive matters;
- (2) Matters that falsely suggest an association with persons, institutions, beliefs, or national symbols;

- (3) A geographic term that identifies a place other than the origin of the goods (when related to wines or spirits);
- (4) The flag, coat of arms, or insignia of the United States, or any state or municipality, or any foreign Nation;
- (5) Names, portraits, or signature of a particular living person or deceased U.S. President during the life of his/her widow;
- (6) Confusingly similar marks;
- (7) Matters that are *primarily* geographically descriptive or *primarily* geographically deceptively misdescriptive;
- (8) Merely descriptive;
- (9) Deceptive misdescriptive matter;
- (10) *Primarily* merely surnames;
- (11) Statutory protection.

**NOTE:** For further insight regarding Trademarks Excluded from Registration, please see the **Trademark Primer Guide**.

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**THIRD**, conduct a search and clearance.

Okay, you got this far, if you believe that your mark is inherently distinctive and not excluded from protection, you now need to search to ensure that the mark is available for registration.

**NOTE:** A trademark **search is something that we recommend you to do before** starting using your mark to avoid wasting your time and money if you can't own the mark! But even if you did this before, we highly recommend that you run another search before applying for registration.

As the trademark search and clearance process is very involved, read on for more in depth details!

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## Trademark Search and Clearance

During this step, you will **search for and analyze other registered and unregistered marks** to determine the likelihood of success in prosecuting your mark, as well as assess the potential future risks of other marks challenging your use.

Choosing not to conduct a trademark search and clearance prior to its use and registration can result in loss of time and money. So, don't do it. Truly. Take the time to conduct search and clearance for the sake of efficiency and cost!

## Preliminary Search

Before conducting a comprehensive search and clearance for your proposed mark, it's a good idea to do a **basic search to look for "knock out" marks** that are clear barriers to registration of your proposed mark.

Knock out potential "knock out" marks:

- (1) Search the USPTO database;
- (2) Internet search for your proposed mark and likely alternative spellings; and
- (3) Search available domain names and social media profile names (if they are a part of your branding strategy)

## Comprehensive Search

The most complete search consists in reviewing federally and state registered trademarks AND also common law trademarks.

### Federally Registered Trademarks

Generally the first step in the trademark search and clearance process is to search the **USPTO Trademark Electronic Search System ("TESS")** available on the [USPTO website](#). This search should include a look at not only existing registered marks, but applied-for marks and expired marks as well. Examining Attorneys at the USPTO will search the TESS database, and any confusingly similar registered marks *or* applied-for marks whose date of application predates yours, will likely lead to an office action based on the likelihood of confusion.

Pause. What's an office action?

**Office Action** = an official action issued on a trademark application by the USPTO. Such actions generally require a trademark applicant to respond within six months to fix any issues with the application or respond to a trademark application refusal.

By conducting a comprehensive search early in the process, you can potentially reduce the likelihood of receiving an office action, or at least be better prepared for the time and expense that it will take to potentially overcome it.

We want to avoid costly hiccups and reactive thinking, it is always better to be proactive! Not to mention – it's cheaper.

### **State Registered Trademarks**

In addition to the federal registry, states often allow for registration on a state trademark registry. While the fact that another similar mark is on a state registry may or may not impact you, it is wise to conduct a search to be aware of the existence of another mark. This knowledge allows you to assess the likelihood of that entity challenging your federal registration or coming after you later for trademark infringement.

Further, it is always a good idea to be aware of your state's trademark laws and compliance regulations because depending on the state – there may be differences between state and federal trademark laws.

### **Common Law Trademarks**

As previously mentioned, **trademark rights in the United States arise from use, not registration.** For this reason, a mark that has been used by one individual or entity, in commerce, may have priority over another's use of the same or similar mark, even where the later user was the first to file a federal trademark application.

US trademark rights = first to *use*, NOT first to *file*

It is important, therefore, to consider not only the federal trademark registry, but other sources as well (such as from an internet search) when determining if a trademark is available.

We know that it is impossible to conduct a 100% search of all possible common law uses of a mark, but at the minimum, a detailed search across multiple internet search engines and social media sites should be conducted to prevent an earlier user from asserting their rights later.

***And remember!*** *Just because another entity has not registered their mark does not mean that they do not have standing to oppose your use or registration of your mark.*

### **Attention → Clarification on "Confusion"**

Another important thing to keep in mind while conducting your search is that for your proposed mark to be barred, it need not only be the *same* as another mark, it just has to be "*confusingly similar.*" Whether a mark is confusingly similar to another is often a very subjective determination.



For federal trademark prosecution purposes, the following factors are used to compare marks:

- (1) The **similarity or dissimilarity** of the marks in their entireties as to **appearance, sound, connotation, and commercial impression;**
- (2) The **relatedness** of the goods or services as described in the application and registration(s);
- (3) The **similarity or dissimilarity** of established, likely-to-continue **trade channels;**
- (4) The conditions under which/buyers to whom sales are made, i.e., **“impulse” vs. careful, sophisticated purchasing;**
- (5) The **number and nature of similar marks in use** on similar goods;
- (6) The existence of a **valid consent agreement between the applicant and the owner** of the previously registered mark.

While all these factors may be applicable to the overall determination of likelihood of confusion, the **first two are key** considerations.

A full explanation of each element is outside the scope of this guide, but here are a few key takeaways that can be applied to the early selection process for a mark:

- (a) Changing the pronunciation will have no impact if two marks **appear** similar;
- (b) Spelling does not matter - marks will be compared based on their **sound;**
- (c) The more **related** the goods/services, the less similar the marks can be.

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## Trademark Use

You already know that trademark protection exists in the first use of a mark. But you cannot forget that the **use of the mark needs to be “as a trademark.”** Use “as a trademark” means that the **mark is capable of identifying the goods or services of one supplier** from that of another and the use has to be **“in commerce”** ( you have to actually be selling or offering to sell the goods and services represented by your trademark.)

Use of a trademark = capable of identifying the goods/services of one entity + in commerce

This use requirement exists both at common law (without registration), and in obtaining a federal trademark registration from the USPTO.

In order to show use in a trademark application with the USPTO, a **specimen** showing how the mark is being used in commerce in the United States is required (don’t worry, we’ll explain). Thus, if you claim to offer a particular good or service, whether in advertising or in

your trademark application, those goods and services must actually be available for purchase from the time you allege use. However, it is possible to “reserve your right” in a particular mark before actually using it in commerce through an “intent to use” application, but you will have to prove use later on in the process and before getting your trademark registered. Hang tight, we’ve got you covered further into this guide!

**NOTE:** Merely obtaining a trademark registration does not mean that your “use in commerce” requirement has been met. The USPTO does not inquire into use, but competitors may, and they can utilize your lack of use against you to invalidate your trademark or portions thereof. For more details about trademark use please check **Trademark Usage Guidelines**.

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## Federal Registration of a Trademark Application

Once you have chosen a mark that you reasonably believe is available and registrable, then you are ready to file for federal trademark protection through the USPTO’s electronic filing system. Here are a few things that you need to know when filing your application for federal registration of a trademark.

Mark that is available and registrable → file for trademark protection through the USPTO

### Mark Format

The first decision that you need to make for your application is to determine the format of your mark.

Available formats include:

- (1) Standard Character Mark,
  - Protects just the combination of letters, words, and/or numbers in your intended mark, without any reference to the particular design (such as font or arrangement of the letters) of the mark.
- (2) Stylized/Design Mark, or
  - Protect the way your mark is visually represented, such as the particular font, color, and/or logo used.
- (3) Sound or Scent Mark.
  - Protects the nonvisual matter.

The decision as to the **format used depends on what you are trying to protect**. Standard character marks will provide stronger protection for the words themselves, since it does not matter what design others apply to it - if the words are the same/confusingly similar, you are protected. Alternatively, if you have a unique look to your name, or need to get around another design mark, you can choose to protect your specific design with a stylized/design mark.

## Identification of Goods and Services

One of the most important, yet challenging, steps in the application process is to **precisely describe the goods and services represented** by your mark.

There are two components to the identification:

- (1) Classification, and
- (2) Description.

→ Classifications fall into one or more of the forty-five “international classes.” Users can search the list of classes on the USPTO website [here](#). Often the goods and services represented by a mark will fall into more than one category, which will require an additional “multi-class” filing fee with the USPTO.

→ Using properly crafted descriptions of goods and services will help to minimize delays and non-substantive office actions requiring modification. As a general rule, the identification of goods and services cannot be broadened after an application is filed. The goods/services may be clarified or limited, but any additional items would require an additional and separate application. So, be clear and descriptive to avoid delays based on lack of clarity!

## Filing Basis

There are two essential bases for filing:

- (1) In use, or
- (2) Intent to use.

These are often referred to as “**1A**” and “**1B**” filing bases, respectively.

→A **1A application** requires that the **mark is in use as of the date of filing** the application.

→A **1B application** permits an **applicant to “reserve” the use of a mark until they are ready** to use it. An intent to use application requires a later showing of use through a

statement of use submitted to the USPTO before registration can be permitted. Use must be shown within six months of a Notice of Allowance, unless extensions are submitted and approved by the USPTO.

NOTE: There are two additional bases for filing related to foreign registrations (44(e)) and foreign applications (44(d)) that apply when foreign applicants/registrants seek trademark registration in the United States.

## Specimens

In order to show *use* in a trademark application with the USPTO, a **specimen** showing how the mark is being used in commerce in the United States is required. **One specimen is required** per class of goods and/or services, however the **mark must actually be in use** for all the goods or services claimed.

Specimen + Mark is in Use → Trademark Application

### For Goods:

- Proper specimens include: product labels, tags, packaging, or photographs of the product that clearly show use of the mark on the packaging or product itself.
- Point-of-sale displays can also be acceptable specimens if the display relates to the sale of the goods.
- Catalogs and websites may be sufficient “point-of-sale” specimens, provided that certain conditions are met, including:
  - Placement of the mark sufficiently near the goods such that consumers would associate the mark with the goods, and
  - There must be information about how to order the goods (such as a “buy” button).

### For Services:

- Acceptable specimens include advertisements, website printouts, invoices, brochures, or other promotional materials that show the mark in connection with the services rendered.

NOTE: The **rules for acceptable specimens are different for goods versus services**. This is because services are intangible so it is impossible to affix the trademark onto the service. Since it *is* possible for goods, the best way to show use is with your mark physically attached to the actual product.

ANOTHER NOTE: **Simply placing your mark on a product does not necessarily suffice for specimen purposes**, it must still be “used as a trademark.” Common errors here are displaying a trademark in large font across the front of a shirt (inviting a “merely ornamental” refusal from the Trademark Office, or worse, an attack from a competitor!), or

putting your trademark on a website header but nowhere near an actual product or service available for purchase.

FINAL NOTE (AND DISCLAIMER BECAUSE WE'RE LAWYERS): Proper trademark use is tricky stuff, and should be evaluated by a trained trademark attorney. This guide is by no means exclusive, nor is it intended to be, so you are **advised to speak with an intellectual property attorney who can advise you** about your particular mark and usage.

## Principal and Supplemental Registers

When registering a trademark you should also consider if you are seeking registration on the **Principal Register** or the **Supplemental Register**. Both registers give the applicant the right to use the registration symbol ® , but there are some differences between them, such as the following (this is a non-exhaustive list):

Principal Register	Supplemental Register
It is the primary trademark register.	It is the supplemental trademark register.
It offers a wider scope of protection.	It offers a narrower scope of protection.
Only for distinctive trademarks.	Only for nondistinctive trademarks.
It is a prima facie evidence of the registrant's exclusive right to use the mark.	It does not have such evidentiary effects.
Provides constructive notice of a claim of ownership so as to eliminate a defense of good faith in an infringement lawsuit.	Does not provide constructive notice of a claim of ownership.
Can become incontestable by filing a Section 15 declaration after five years.	Cannot become incontestable.
Can be used to stop importations of infringing goods into the US.	Cannot be used to stop importations of infringing goods into the US.

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## Office Actions

After the trademark application is filed with the USPTO, an official USPTO file is created and an examining attorney is assigned to review the application. If there are any legal issues in the trademark application itself ("**requirements**") or with the chosen trademark ("**refusals**"), the assigned examining attorney will issue an **office action**.

Remember, an **office action is an official action** issued on a trademark application by the USPTO that generally requires a trademark applicant to respond within six months to fix any issues with the application/refusal.

The most common basis for requirements and refusals are:

### **“Definite” Identification of Goods or Services**

The examining attorney will require you to replace the choice of words used to describe the goods and services because they were **not specific, unclear, indefinite and/or too broad**. But remember, you can change the identification of goods and services only to clarify or limit them, you **can’t broaden the identification** to include goods or services that were not in your original identification. In addition, keep in mind that once the examining attorney accepts your changes, you can’t change it back to the original identification.

### **“Disclaim” a Portion of Your Trademark**

The examining attorney will require you to provide a **disclaimer (statement)** that a **specific element of a composite mark is freely available for other businesses** because that element is not registrable. The disclaimer will not affect the appearance of your mark or the way you use it.

### **Unacceptable or Inexistent Specimen**

The examining attorney may refuse your application based on the fact that you did not provide an acceptable specimen or because you did not provide one at all. As we explained above, the rules for acceptable specimens are different for goods versus services, and you need to be **aware of the acceptable specimen for your specific case**. Depending on the reasoning for the refusal you will not be able to fix it or the issue will be fixed by sending a different specimen. Sometimes, a written response pointing out the reasons for the acceptance of the specimen is the way to go.

### **Likelihood of Confusion**

The examining attorney may refuse your application based on the fact that your **mark is similar to a previously registered or applied for mark(s)** used with goods or services that are related to yours. This similarity needs to be **capable of causing confusion** about the sources of your goods and/or services among the consumers. However, the goods and/or services of another need not to be identical to yours for confusion to be found.

“Likelihood of confusion” is the most common objection made by the USPTO and, as we explained above, for federal trademark prosecution purposes, the following criteria is used to compare marks:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- (2) The relatedness of the goods or services as described in the application and registration(s);
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
- (5) The number and nature of similar marks in use on similar goods;
- (6) The existence of a valid consent agreement between the applicant and the owner of the previously registered mark.

In order for you to overcome this refusal you will need to show that the cited criterias were not met. Alternatively, you can also seek a license to use the mark or seek a consent to coexist registration (however the USPTO is not bound to accept such agreement between the parties).

### **Descriptiveness**

The examining attorney may refuse your application if your **mark merely describes the material, content, quality, characteristic, function, composition, or use of the goods and/or the services**. You can try to overcome the refusal showing for example that your mark is not descriptive but rather suggestive or that it has been in commerce for five years or more and has acquired distinctiveness. However, if you agree that your mark is descriptive, you can amend your application to seek registration on the Supplemental Register.

### **Commonly Used Phrase**

The examining attorney may refuse your application if your **mark is a commonly used phrase, as they don't indicate the source of goods or services**. You can try to overcome this refusal by showing that your mark is not a commonly used phrase, or that your mark actually identifies your goods and/or services.

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## **Office Action Responses**

Generally, an office action must be responded to within six months from the date it was issued, but some office actions have a shorter deadline. Some office actions require a written response (substantial refusal), but more simple issues can be resolved by phone or

email (which can result in an amendment to your application). However, if you fail to respond to an office action, it will result in abandonment of your application.

So review all communications from the USPTO thoroughly to understand what needs to be done in your particular case.

After you respond to an office action, things can get a little bit complicated as the examining attorney can, after reviewing your response, issue a second office action or a final office action. Remember that you are entitled to at least one opportunity to respond to an office action, so when responding to the first office action you need to keep in mind that the examining attorney can issue a final office action if he/she does not agree with your arguments. If this happens, you can either (but not as simple as it appears to be): (1) file a request for reconsideration; (2) appeal the refusal to the Trademark Trial and Appeal Board (TTAB).

On the other hand, if there are no defects in your application, or if the examining attorney accepts your arguments, or if you make the necessary amendments to your application, the USPTO will approve the application for publication in the Official Gazette. Then you and your trademark are good-to-go, in the clear!

You. Have. A. Trademark!

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## Publication in the Trademark Official Gazette

In a situation where there are no defects in your trademark application or where you can overcome an office action, the USPTO will approve your application for publication in the Official Gazette.

The Trademark Official Gazette is the official journal of the USPTO.

The trademark publications are weekly (each Tuesday) and the purpose of publication is to give the opportunity for the public to challenge the registration of the trademark by filing a Notice of Opposition during a 30-day window (if no extension is requested).

It is important to remember that the fact that your mark was approved for publication does not mean that you can use the ® symbol. Your mark is not registered yet!



NOTES: Application for marks filed on the Supplemental Register are not published for opposition, but are published on registration in the Official Gazette.

ANOTHER NOTE: Don't forget that in an application based on an intent-to-use, you will have to file proof of the use before the mark is approved by the U.S. Trademark Office or within six months thereafter (if no extension is requested.) The application cannot proceed to registration until you can show actual use of your mark.

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## Trademark Registration

After your application is published in the Official Gazette and no opposition is filed by any third party (or if you win or settle the trademark opposition with the opposing party), the mark will be registered and a certification of registration will be issued.

Now is the right time to celebrate and use the federal registration symbol ®

And as you already know, you will have another great number of advantages that only a federal registration can provide to you and that will help you protect your trademark. But don't forget! Federal Registration may give you the tools to protect your trademark, however you are the one responsible for **policing and protecting your trademark**.

In a way, the work is never done. Protect your brand, protect your business. For more details about how to maintain your trademark and enforce your trademark rights please check our **Trademark Post-Registration Overview guide**.

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## Note About “DIY” Trademark Registration

The entirety of this process can feel daunting. You may be tempted to file a trademark yourself directly with the USPTO, or use a third-party registration service or non-trademark attorney to assist you. While there certainly may be cost-savings to this approach if everything is done correctly . . . DON'T DO IT.

We are often brought in to “clean up” where the DIY method fell short. And clean up is far more confusing and laborious than doing it right the first time around. Lawyers love proactive thinking, because a reactive approach is more stressful and cumbersome.

Here are just a few of the common issues that we see with DIY trademark applications:

## Search and Clearance

When conducting a search on your own, or through a third-party trademark search service, you can very easily miss a ***confusingly similar*** mark already in use or registered. Determining what is “confusingly similar” is very subjective, and often requires the experience and judgment of a trademark attorney to assess. For a relatively small fee, you can get a comprehensive search completed that will increase your chances of obtaining trademark registration, reduce the likelihood of opposition proceedings, and ideally avoid infringement of another trademark - all of which can make doing it yourself very costly.

We continue to emphasize search and clearance because spending the money initially, has a high chance of paying off greatly later.

## Application Process

The USPTO provides a lot of useful resources on their website along with detailed instructions. They make it appear as if applying for a trademark is easy. While the application process itself is not overly challenging, it also is not completely straightforward - and if mistakes are made, correcting them will likely result in additional fees and headaches that usually do not outweigh the money saved filing on your own.

## Incorrect or Limited Goods and Services

Your trademark only protects the goods and services listed in your application, with a small amount of room for expansion. Additionally, the trademark is only valid for the goods and services that are actually commercially available as of the date of your application (or when filing a statement of use for intent-to-use applications). What this means is that your trademark protection could be too limited by not covering all the goods and services you offer, or by unnecessarily limiting the description of your goods and services and thus permitting competitors to freely use the same or similar marks.

The description could also be too broad and include goods and services that are not commercially available. Since at the end of the trademark application you have to attest to the accuracy of the information in your application, if something in the application turns out not to be true or factually supported, it may be used against you by competitors seeking to oppose or cancel your registration. Fighting this will cost much more than getting it right the first time.

## Improper Specimen

Another common problem we see with DIY applications, as well as applications filed through online service providers or non-trademark attorneys, involves the specimen. If the specimen is filed incorrectly, the best case scenario is that the examining attorney objects to it and suggests what is needed to supply a “proper” specimen. The worst case scenario, however, is that your specimen does not properly prove use of the mark for all or some of the goods and services listed in your application. While it may be good enough to pass muster with the examining attorney, it could come back to haunt you when another attorney starts looking into it for the purposes of an opposition, cancellation, or trademark infringement action.

## Responding to Office Actions

If you are able to complete the *application*, on your own, that’s only one small part of the *prosecution* process that must be completed before you will actually own a registered trademark. In some instances, minor mistakes or corrections will need to be made to your application, and the trademark examiner may even provide some suggestions to you to get them fixed fairly quickly and easily. But what do you do if you get a substantive office action from the USPTO? How will you respond? If this is the point where you decide you need a trademark attorney, there’s a good chance that for a smaller fee at the beginning, you could have potentially avoided the office action altogether.

## A Word of Caution

It is common for unrepresented trademark applicants to be contacted by a wide range of individuals looking to provide “service” and demanding certain fees be paid. This is because the USPTO registry is a public record, and it includes the name, email, and mailing address of the applicants. While some of the services offered may be legitimate, others, unfortunately are not. It is important to verify the source of all correspondence that you receive after you file your application and to remember that any official correspondence from the USPTO will be coming from their office in Alexandria, Virginia, or by email from the domain name “@uspto.gov.”

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## Thank You!

Thank you for reading our Trademark Application Overview. We know the process can seem formidable so refer back to this guide as needed throughout the steps of your trademark application. And remember our cardinal rule, it is far more cost effective to hire a specialized trademark attorney from the beginning of this journey, then to consult one

later if something goes wrong. Contact us at Dev Counsel for more information and any questions you may have!