

Key Steps in Filing Your Trademark Application

Typically, there are two types of trademark applications: an “in-use” application, which is appropriate when the applicant is currently or has been using the proposed trademark in interstate commerce, and an “intent-to-use” application, which is appropriate when the applicant has a serious intention to use the proposed trademark in interstate commerce.

Before filing a trademark application, one should conduct a search to ascertain whether another entity already has rights to the proposed trademark or a confusingly similar version thereof. There are two types of searches we offer. The first, which is by our own paralegal, is a database search of registered and pending applications. This search can be undertaken with our opinion for registrability. The second type, prepared by an outside company, is a database search of registered and pending applications, registrations, and other sources identifying common law trademark usages and domain names.

Next, we prepare the trademark application. Once prepared, the application is filed with the PTO, which charges a fee per class. For multiple classes, the PTO requires a separate fee for each class.

At the PTO, an Examiner conducts a thorough search through the pending and registered trademarks. If relevant information is uncovered, an Office Action will issue with the Examiner's reasons for rejection of the application. This is not uncommon. We review those reasons, report receipt of the Office Action and offer recommendations to you.

If an Office Action is not responded to within a given time frame, the application goes abandoned. If we are successful in responding, the application is then published. There is also a fee for reviewing and reporting the Notice of Publication.

If we are unable to convince an Examiner that the mark is registrable, the applicant can cease further prosecution, which would result in its abandonment, or appeal to the U.S. Trademark Trial and Appeal Board.

Once published, a one-month period begins in which anyone who feels that he or she may be harmed by the registration may file a Notice of Opposition. We must respond to the Notice of Opposition as well. Few applications receive a Notice of Opposition, and we work at keeping those costs to a minimum.

After publication without an Opposition, an “in-use” application is registered, and the Certificate of Registration is reviewed and forwarded to you. An “intent-to-use” application is passed to allowance, and a Notice of Allowance is issued. Once the Notice is received, a six-month period begins in which a Statement of Use must be filed. Once the Statement of Use is filed and accepted, the application will pass to registration. Again, we would review and forward the Certificate of Registration to you.

