

Six Steps for Registering a Federal Trademark

Do you need to register a trademark with the United States Patent and Trademark Office? Then this guide is for you.

In the United States, trademarks may be registered on the federal or on the state level. Here is a brief guide about how to register your trademark with the United States Patent and Trademark Office (“PTO”).

Before we start, understand that the PTO maintains [two trademark registers](#), the “Principal” register and the “Supplemental” register. Typically, registration in the Principal register is most desirable and is reserved for trademarks that the PTO determines are distinctive or have acquired distinctiveness. The Supplemental register, on the other hand, is like a “holding tank” for descriptive trademarks, which have not acquired distinctiveness.



STEP 1 - DO YOU HAVE A “TRADEMARK?”

Determine that the “trademark” you wish to register is actually a Trademark and is registrable.

Let’s start with the definition of terms related to a trademark.

A “*trademark*” under United States trademark law is defined as “any word, name, symbol, or device,” used by a person in commerce, or by a person who has a bona fide intention to use it in commerce and identifies and distinguishes his or her goods from those manufactured or sold by others. A trademark also indicates the origin of goods. A “*service mark*” is defined similarly but applies to services rather than goods.

A “*trade name*” or “*commercial name*,” on the other hand, means “any name used by a person to identify his or her business or vocation.” Trade names are typically registered at the state level and are not trademarks; however, if your trade name is the same or confusingly similar to a registered trademark, you may not have the rights to use your trade name and could be sued for infringement.

“*Descriptive*” trademarks are referred to as “*weak*” trademarks and are typically not registrable. A descriptive trademark describes the nature of your goods and services or the purpose of your business.

EXAMPLE A:

Say you wish to register HAIR CUTTERS to identify your new hair styling salon so you file a trademark application with the PTO. To your disappointment, the PTO refuses to register your trademark because the mark is descriptive of the services that you intend to provide. Instead, it

offers you the option to register it on the Supplemental Register. *Why?* Because, as mentioned above, descriptive marks are not registrable in the Principal Register unless they have “acquired distinctiveness.” Acquired distinctiveness is an advanced topic that is beyond the scope of this short guide and is properly discussed with a trademark attorney.

Marks that are not registrable under United States law are many and varied. For example you may not register marks consisting of or comprising “immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” You may not register marks consisting of the U.S. flag or other symbols of federal, state, or municipal governments. Also, you may not register marks consisting of the signature or identify of living individuals without consent. And, no, you may not register a trademark incorporating the portrait of a United States president.

EXAMPLE B:

The best example of a scandalous trademark is the [recent decision](#) of the Trademark Trial and Appeal Board, which canceled several trademarks owned by Pro-Football, Inc. (“Pro Football”) for the term “Redskins” on grounds that the marks were “disparaging to Native Americans.”

EXAMPLE C:

You file a trademark application for JACK QUE’S CRAZY BARBEQUE SAUCE. Jack Que is a relative and very much alive. The Trademark Examiner issues an office action requiring you to obtain Jack’s permission. What do you do? You file a consent form signed by Jack along with your response to the office action.

The list of unacceptable trademarks goes on and on so if you're unsure that the trademark you wish to register qualifies as a “trademark,” you should consult a trademark attorney.

STEP 2 - IDENTIFY GOODS OR SERVICES.

Determine the International Class for goods or services identified by Your Trademark.

After you have determined that your trademark or service mark is registrable, you must identify the goods or services that your mark will identify. You must do this in a clear and precise manner or the trademark examiner will issue an [office action](#) requesting you to clarify the applicable goods and services.

Goods and services must be identified according to the international classification published by the [World Intellectual Property Organization \(“WIPO”\)](#). The list may be found [here](#). If you have difficulty describing the goods or services, you can try using the PTO’s [Acceptable Identification of Goods and Services Manual](#).

STEP 3 - PERFORM A TRADEMARK SEARCH.

Make sure that nobody else is using your trademark or one that is confusingly similar.

Do not waste your time and money registering or attempting to register a trademark that is the same or confusingly similar to another business' trademark. Commercial trademark clearance searches are the best option. Many small or new businesses consider them to be a luxury but this is a risky attitude.

Under U.S. law, the first to use a trademark is the senior user and may have the right to demand that a junior user, even a junior user with a registered trademark, cease and desist using a confusingly similar trademark that identifies the same or related goods and services. Remember, similar marks are not only marks that look or are spelled the same but also sound the same. CAT and KAT, therefore, are confusingly similar. Also, what qualifies as a “related” good or service, another advanced subject, is not always obvious. There is a body of case law out there that seeks to clarify the question but requires a trained person to make a determination.

So, a competent pre-application trademark clearance search and analysis performed by a lawyer is like insurance against receiving a cease and desist letter or, worse, a lawsuit. The costs of hiring a trademark lawyer at the outset are small — perhaps minuscule — compared to the costs of later defending an infringement lawsuit or being forced to rebrand your business. Services such as Legal Zoom may provide you with the search results but typically do not offer an opinion on registrability unless you pay extra. You are left on your own to decipher the results.

STEP 4 - ARE YOU USING YOUR TRADEMARK IN COMMERCE?

Determine whether you wish to file an “Intent to Use” or an “In Use” Trademark Application.

The PTO offers two types of trademark applications, “intent to use” and “in use” applications. If you are using your goods or services in commerce, that is, you are offering them for sale to the public, you may file an “in use” application. Remember, that the trademark application will require you to provide the PTO with proof that you are using your trademark or service mark in commerce. The nature of that proof may consist of an image of the goods bearing the trademark, such as packaging, or an image demonstrating that you are offering your service for sale, such as an advertisement. Invoices and letterhead are typically not acceptable.

If you are not using your proposed trademark but you have a “bona fide intent” to use your trademark in commerce, you may file an “Intent to Use” trademark application. The “Intent to Use” trademark application is similar to that filed for an “In Use” trademark; however, you will incur the increased cost of filing a Statement of Use once you begin using the trademark. The Statement of Use, which requires you to prove that you are using your trademark in commerce,

must be filed within six months after the PTO reviews your application and issues a "Notice of Allowance." You may request the PTO to extend the six-month filing period up to five times for

an additional cost for each extension. By filing an "Intent to Use" trademark application, you reserve priority over the trademark, give notice to the world that you intend to use the trademark, and your date of first use will relate back to the filing date of the application, which may be an advantage should you be involved in litigation over the trademark.

STEP 5 - FILE!

File a registration application with the PTO.

Although you may file a paper trademark application with the PTO, you're better off filing the application online at the PTO website. It's quicker and less expensive. The electronic application is deceptively simple and requires an understanding of many of the principles described above. If you feel confident, move forward but realize that simple mistakes will delay the process and, at worst, result in the rejection of your trademark application and the loss of your trademark application fees.

STEP 6 - PAY UP AND MONITOR.

Pay the registration fee.

Upon completion of the online application, the PTO will require you to pay an application fee, which is based upon the number of classes for which you are registering the trademark or service mark and the manner in which you have described those goods and services. If you use one of the PTO's "canned" descriptions for goods and services contained in the [Acceptable Identification of Goods and Services Manual](#), the cost will be less expensive than if you create your own description. The application fee ranges from \$225-\$325 per class of goods and services and is nonrefundable. Once you file your application you will receive an email acknowledgment from the PTO providing you with the serial number of your application and telling you that it may take as long as three months before a Trademark Examiner will even look at your trademark application. You may continue to monitor the PTO's trademark database for the status of your trademark application. The whole process may take from 9 to 13 months and even longer if there are problems with your application.

That's all there is to it but if you have concerns protecting your brand, the lawyers at Lipton Weinberger & Husick would be pleased to advise you.

This guide is provided for general information purposes only and is not intended to be, nor should it be construed as professional legal advice. If you have a specific legal question related to the above information, please contact an attorney who is familiar with this area of the law.