



Six Steps for Registering a Federal Trademark

This Circular explains the basic steps involved in registering a federal trademark with the U.S. Patent and Trademark Office (USPTO). It is intended as a general overview of the process. Keep in mind that trademark rights and registration outcomes often depend on factors not addressed in a general introduction but will be addressed in later Circulars.

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

Before we start, understand that the USPTO maintains the “Principal” Register and the “Supplemental” Register. A “Register” is simply an official list required by statute. Typically, trademark registration in the Principal Register is most desirable and is reserved for trademarks that the USPTO determines are distinctive or have acquired distinctiveness. “Distinctiveness” can be viewed as the degree to which a mark identifies a single commercial source. The Supplemental Register, on the other hand, is like a “holding tank” for descriptive trademarks and for trademarks that are capable of becoming distinctive, but which are not eligible for the Principal Register. A descriptive trademark is one that describes the nature of your goods and services or the purpose of your business.

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 unless used as trademarks. 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 or registrable only on the Supplemental Register. As mentioned earlier, a descriptive trademark is one that 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 USPTO. To your disappointment, the USPTO 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 on 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 trademark law are many and varied, but the scope of prohibited subject matter has narrowed significantly in recent years. While trademarks may still be refused if they are deceptive, likely to cause confusion, merely descriptive, generic, or otherwise fail to function as a source identifier, the USPTO, based on [U.S. Supreme Court](#) precedent, may no longer refuse registration merely because a mark is immoral, scandalous, or disparaging.

Certain categories of subject matter remain barred from registration. For example, a trademark may not consist of or comprise the U.S. flag or other official insignia of federal, state, or municipal governments. A mark may not falsely suggest a connection with a particular person or institution. In addition, trademarks consisting of the name, signature, or portrait of a living individual generally require that person's written consent. Despite common misconceptions, this restriction applies even where the individual is famous, including political figures.

EXAMPLE B: 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 is extensive 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 and you wish to save on filing fees, you can try using the USPTO'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 whether it is registered or not. Commercial trademark clearance searches are the best option. Many small or new businesses consider them to be a luxury but this is short-sighted.

Under U.S. law, the first to use a trademark in a particular geographical region 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. Indeed, there is a body of case law that seeks to clarify the question of whether specific goods and services are related or not. Attorneys are well-qualified to review this law and make a determination of relatedness when necessary.

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 cost of hiring a trademark lawyer at the outset are relatively small compared to the cost of responding to a cease-and-desist letter or defending your business against a lawsuit.

Automated tools exist for performing trademark searches. Those tools can be useful for initial screening, but are no substitute for an actual search and analysis by a trademark professional.

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.

Most U.S. filings are either “use in commerce” (§1(a)) or “intent to use” (§1(b)), though other bases (like foreign priority/registration and Madrid filings) also exist. 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 USPTO 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 for goods but may be acceptable for services if they show a direct association between the mark and services designated in the application.

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 USPTO reviews your application and issues a “Notice of Allowance.” You may request the USPTO 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 constructive 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 USPTO.

Since February 2022, the USPTO has required that trademark applications be filed electronically. 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 USPTO 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 USPTO'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 base filing fee is \$350 for each class of goods and services and is nonrefundable. The filing fee may increase should you wish to draft your own description of goods and services as mentioned above. Once you file your application you will receive an email acknowledgment from the USPTO providing you with the serial number of your application and telling you that it may take as long as several months before a Trademark Examiner will even look at your trademark application. You may continue to monitor the USPTO's trademark database for the status of your trademark application. The whole trademark application process may take from 10 to 11 months and even longer if there are problems with your application.

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.