

U.S. TRADEMARK REGISTRATION PROCESS

Protecting your brand by trademark registration is not simply a matter of filing something and waiting for the government to send a certificate. It's a process that involves careful preparation, subjective analysis, and knowledge of the substantive law and procedure.

1. Pre-filing searches.

- To make sure a mark is available for use and registration, it's necessary to do appropriate searching. We try to anticipate the Patent and Trademark Office's search, and consider not just identical marks, but sound-alikes, synonyms, and foreign equivalents. We also recommend a more thorough comprehensive search, which also picks up unregistered marks that may enjoy common-law rights. If a search reveals obstacles, your trademark lawyer can dig deeper to see whether they really do pose problems, and whether there's a workaround.

2. Preparing the application.

- Trademark rights don't exist in a vacuum – they are tied to the goods and services on which the mark is used. A good trademark lawyer will work with you to specify your products using the language the PTO requires, broad enough to cover your current and future offerings, but tailored to reduce the risk of conflict with a senior mark. If the mark is already in use, you will need to provide the dates of first use, and your trademark lawyer or paralegal will work with you to get an appropriate specimen of use (label or package for goods, website or ad for services) that complies with the PTO's rules.

3. Filing.

- When you file a trademark application with the PTO, you are making a statement under penalty of perjury to the federal government, so be sure you are satisfied that everything is true and correct. Your lawyer will file it electronically, and the PTO will issue a serial number and a filing date, which establishes the mark's priority over later applications.

4. Examination.

- After about three months or so, the application will be assigned to a PTO examiner, who will review it for compliance with technical requirements and do a search for senior conflicting marks. If the examiner finds a problem, he or she will inform the contact listed on the application (typically your lawyer). Sometimes problems can be resolved these over the phone; otherwise the PTO will send an "Office Action" requiring a written response. Your trademark lawyer or paralegal will monitor the process and periodically check its status.

5. Publication.

- If the examiner is satisfied with the application, it will be published for a 30 day (extendible) period in which others can give notice that they oppose registration. If nobody opposes, the PTO will allow the mark for registration.

6. Registration.

- If the application was filed on the basis of use, the registration will issue in a few weeks. If it was filed on the basis of intent-to use, your lawyer will need to file proof of use and a specimen in order for the registration to issue. The deadline for this filing is six months, but extendible to a total of three years.

