

Steps for Clearance and Registration of a Trademark

This summary address the steps routinely involved in clearance and registration of a trademark with the United States Patent and Trademark Office (USPTO). Non-routine cases may involve additional steps.

Screening: If one or more marks are under consideration, a preliminary screening search of the U.S. Patent and Trademark Office (USPTO) database can determine the extent to which others may have registered the identical or nearly identical mark, for the purposes of narrowing a list of potential marks or determining whether more comprehensive searching is warranted.

Searching: Before filing a trademark application a comprehensive search of U.S. Federal and State trademark databases, common law sources, Internet domain names, Internet content and business names is strongly recommended, including professional review and commentary on the results. Searches are typically received within 3 business days, with expedited searches available. A brief opinion regarding the level of risk associated with adopting and registering a mark can typically be provided relatively quickly.

Filing: An application can be filed based on Intent to Use (ITU), based upon actual use in commerce, or based upon a foreign registration (or foreign application filed less than 6 months before the U.S. filing date). An ITU application incurs additional costs as compared to other types of applications, as detailed below. Each application must provide an identification of the goods or services for which the applicant wishes to register the mark. The USPTO categorizes goods and services into 45 different classes and charges an application fee for *each* class of goods and services included in the application. If the registration is based upon use, the applicant must provide a specimen showing how the mark is used on goods or in advertising for services, for each class of goods and services for which registration is sought. If the mark has a design element, a suitable drawing is required. Such a drawing can be prepared by a draftsman to USPTO standards, if no suitable drawing is readily available.

Prosecution: After filing, applications are examined by the USPTO. The USPTO may approve the application by issuing a Notice of Publication, or issue an Office Action refusing registration for one or more of any number of reasons. The most common reasons are descriptiveness, likelihood of confusion based upon an earlier filed registration or application, objections to the identification or classification of goods and services, or some combination thereof. A response to the Office Action must be filed within 6 months of receipt. If the USPTO reclassifies the goods and services to include one or more additional classes not in the original application, an additional government fee must be paid for each new class added to the application. Following the applicant's response, the USPTO may issue an additional Office Action or approve the application for publication. If the USPTO issues a Final Office Action that is unable to be resolved with the Examining Attorney, the applicant can file a Notice of Appeal, followed by an Appeal Brief.

Allowance: After approval, the application is published for a 30-day opposition period (which is extendible by a third party for no more 90 days, except with the consent of the application owner). If no third party files an opposition before the end of the opposition period, a Certificate of Registration will be issued for non-ITU applications within approximately 2 months. For ITU applications, the USPTO issues a Notice of Allowance. Within 6 months after issuance of that Notice, a Statement of Use or a Request for an Extension of Time to file the Statement of Use must be filed. Up to 5 requests for extension can be filed. If no Statement of Use has been filed within 3 years after the Notice of Allowance, the application will go abandoned.

Maintenance: A Declaration of Use must be filed between the fifth and sixth registration anniversaries. Often this is combined with an optional Declaration of Incontestability, which can be filed following any five years of continuous use. Every ten years after registration, a Renewal Application along with Declaration of Continued Use must also be filed.