

Trademark 101 Part 3: How and Why to Register a Trademark

[These flow charts](#) might be helpful in understand the trademark application and registration process.

Your business's identity is one of its most valuable assets. You invest a lot in developing the brands that represent your company and your products to the world, whether it be product names, logos, taglines, or other identifiers – otherwise known as your trademarks.

To fully protect your investment, you must proactively take certain steps. The first step to protecting your trademarks is [to register them](#). You should also be sure to [use your trademarks correctly](#) and to protect against others who infringe your trademark or [use it in a generic manner](#).

Why should I register a trademark?

The simple answer is: Registration increases the value of your brand. When you register your trademark with the U.S. Patent & Trademark Office (“PTO”), you obtain the rights to use your trademark across the entire U.S, with carve-outs for any pre-existing conflicting common-law uses (uses of unregistered trademarks). Registration also enhances your ability to protect your trademark against infringements and may entitle you to greater damages and attorneys’ fees.

Federal registration:

- Serves as evidence of the validity of the mark, your exclusive ownership of it, and your exclusive right to use the mark.
- Provides constructive notice nationwide of your ownership of the mark as of the registration date, preventing others from claiming unknowing “good faith” use of an infringing mark.
- Grants the right to sue for infringement in federal court and, in some cases, to obtain treble damages and attorneys’ fees.
- Entitles you to statutory damages in cases of counterfeiting.
- If you record the registration with U.S. Customs and Border Protection, empowers U.S. Customs to block importation of counterfeits or goods bearing infringements of the mark.
- Can serve as the basis for registering the trademark in other countries.

A state registration (appropriate when you’re using your trademark in only one state) gives you rights to use your trademark throughout the entire state (again, with carve-outs for any pre-existing conflicting common-law uses) and provides some but not all of the benefits of a federal registration.

Should I hire an attorney to file my application?

The short answer is: Yes. The trademark application/registration process is complicated, time-consuming, and lengthy. If you get it wrong, not only do you lose the time and effort you spent and the filing fees you paid, but you also risk weakening – or even losing – any rights you might have in the mark.

An experienced trademark attorney can help prevent wasted time and money, handle the complicated parts for you, and provide invaluable advice regarding how to strengthen your trademark rights by registration and more.

When should I file an application?

Ideally, you should file an application **before** you start using the mark, but **after** you've had [searches conducted to determine that your mark will not infringe someone else's](#).

A trademark cannot be registered until the mark is in use in “interstate commerce” (offering the goods/services for sale across state lines), but you may file an application before you begin using the mark, so long as you have a bona fide intent to use the mark. This is called an “intent-to-use” application. (An application for a trademark that is currently in use in interstate commerce is a “use-based” application.) Registration will not issue until use in interstate commerce has begun.

What information will my attorney need to prepare an application?

In any application for trademark registration, the applicant must describe the goods and/or services with which the mark will be used. This is not always as simple as it sounds, especially in cases of services rather than tangible goods, and for technology-oriented goods or services. Your attorney will work with you to hone a description that gives you the broadest rights possible and will be acceptable to the PTO.

Once you've done this, your attorney will determine how to classify your description. The PTO requires that this description be broken into categories called “International Classes” (because this is an international classification system). Your fees will be based on the number of classes in which you are claiming goods/services.

In addition, your attorney will need to know:

- The legal name and state of incorporation of the entity owning the trademark (or if an individual, the name and state of domicile)
- The mailing address for the entity or individual
- For each Class, the date you first began using the mark **anywhere** in association with all of the goods/services you are claiming

- For each Class, the date you first began using the mark in **interstate commerce** in association with all of the goods/services you are claiming

If you are filing a use-based application, your attorney will also need a [specimen of use](#) for each Class of goods/services. See [What Makes a Good Specimen of Use?](#) for more information.

How much does it cost?

Our law firm charges flat fees for most of our trademark application and registration work. Nonetheless, the total cost for preparing and filing a trademark application and seeing it through to registration depends on many factors. [Contact us](#) to discuss your specific situation and needs, at which point we can determine and explain the costs.

What happens after the application is filed?

[This flow chart](#) may help in understanding the application and registration process explained below.

Examination

The PTO will examine your trademark application for both minor and non-substantive issues, like the wording in your goods/services description, and substantive issues, such as whether the PTO thinks your trademark infringes the rights of a registered trademark or an existing application. This process typically takes 2-4 months.

If the PTO has a problem with your trademark application, it will inform your attorney in an “Office Action.” You will have 6 months to respond to the Office Action to make any corrections or to present your arguments to the PTO.

Publication

If the PTO does not find any problems with your application, or if you receive an Office Action and overcome all objections, the application will then be “published” in the PTO Official Gazette. This puts the public on notice that you intend to register your mark and gives anyone who believes their rights will be harmed by such registration 30 days to oppose your application. This usually does not happen (especially if you’ve been diligent about [researching the “availability” of your mark](#) before filing an application).

Registration or Statement of Use

Assuming no oppositions are filed, or you have resolved any that are, a use-based application will then proceed to registration.

If you have filed an intent-to-use application, you will be given 6 months to begin using the mark in interstate commerce for all of the goods/services claimed in your application and to submit a declaration of such use and a specimen of use.

If you have not begun interstate commerce use by that deadline, you may extend the deadline by an additional 6 months. You may request up to 5 such extensions.

What do I need to do to keep my registration?

Your rights in your trademark depend on your continued use of the trademark for the goods/services claimed in your registration. You will likely lose the right to claim the trademark for any goods/services for which you stop using it.

You must also meet certain formalities to maintain your federal registration:

- Between 5 and 6 years from the registration date, you must file a Declaration of Continued Use (“Section 8”) of the mark, accompanied by a specimen of use.
- At the same time, you may file a Declaration of Incontestability (“Section 15”), which provides increased protection of the mark in cases of certain types of challenges.
- Every 10 years, you must file a Combined Declaration of Use and Application for Renewal (“Sections 8 & 9”), accompanied by a specimen of use, with the first being filed between 9 and 10 years after the registration date, and subsequent filings during the same time frame as each decade anniversary of registration approaches.