



## The Complete Lifecycle of a Trademark Registration: From Application to Examination to Post-Registration Filings

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Are you interested in registering your trademark or service mark? Want to know a little about how the process works? Here is an overview of the registration process, from the initial search and application through allowance, registration, and post-registration procedures.

### Initial Steps

The first step towards registering your trademark is determining what the trademark consists of and gathering the information necessary for the application. Your trademark can consist of text, a design, or a combination of the two. If your mark includes a design element, you will need a high quality reproduction of the mark. You will also need to know the owner of the mark (typically the company selling the goods or services with which the trademark is used), including entity type and state of organization, if applicable, and the owner's mailing address.

You will also need a list of all the goods and services for which the mark is used or will be used. Goods and services are divided into different categories, or “classes.” Your trademark attorney can help you to determine which classes your goods or services fall under. A trademark can have a list of goods or services spanning multiple classes, but each class beyond the first adds substantial cost throughout the life of your trademark registration.

If the mark is already in use in interstate commerce (used on goods shipped across state lines or to advertise services), it is important that this list is accurate, as a misstatement could result in your trademark being invalidated. Your trademark attorney may be able to come up with a draft list based on materials supplied by you (such as a website), which you can then go over with your attorney and modify as necessary.

You will also need to know the first date that your trademark was used in commerce anywhere and the date it was first used in interstate commerce. If you cannot remember the exact date, you should determine the earliest one you are certain of. When you fill in your application, a date that is mistakenly too early could be considered fraud, but a date that is mistakenly too late can be rectified at a later date if it becomes necessary. You will also need one “specimen” for each class of goods or services for which your trademark has already been used. A specimen is a picture of your mark as used in commerce.

To show use on goods, the specimen may be a photograph showing the mark on the goods, or packaging or shipping materials for the goods, or a tag or label. For services only, the specimen may be an advertisement (website printouts usually make good specimens). An advertisement is not an acceptable specimen to show use of a trademark on goods/products. Under certain circumstances, a catalog or "point of sale" display may also serve as a specimen for goods. Please contact your trademark lawyer if you have any question about the suitability of a specimen.

## **Registrability Search**

Once you have determined what the mark is and what goods or services it is or will be used with, a registrability search (also referred to as a registerability search or simply a trademark search) can be performed if so desired. You can try to do this search yourself, searching the PTO database for similar marks for similar goods or services, or you can have a trademark attorney perform it. The

attorney can also render an opinion on the registrability of your mark. In this process, the United States Patent and Trademark Office's trademark register is examined to see if any existing trademark applications or registrations would prevent registration of your mark.

When I conduct a registrability search, I also perform an Internet search for any unregistered users of similar marks that could cause you problems down the road. If you want to be as sure as you can be that no one else in the U.S. is already using a similar mark, you can also include in the search the state trademark registers (rarely used), state corporate name registers, and trade publications. If you plan on using your mark internationally, you can extend your search to cover foreign countries of interest. Of course, cost scales up rapidly along with the scope of the search.

I typically recommend a registrability search prior to filing an application. If conflicting marks are found, your mark can be modified to avoid them without the wasted time and expense of a full application and, potentially, a registration that will later be canceled.

## **Initial Application**

Once you have gathered the information you need and performed a registrability search, you are ready to file your application to register your trademark. Since you have already gathered all the necessary information and made the necessary decisions regarding the mark to be registered and the goods and services the registration will cover, the application itself is a relatively trivial matter. Essentially, the information you gathered must be entered into a form available on the website of the United States Patent and Trademark Office and submitted electronically. Nevertheless, it is easy to make a mistake if you have not done this a few times, so again it is best to leave this to your trademark attorney.

There are also a few different application forms that you can use. Using the TEAS-Plus form reduces the filing fee from \$325 to \$275 per class, but requires that you choose your goods and services

from a pre-approved list. In addition, if you have not yet used the mark in interstate commerce with some of the goods and services you wish to register the mark for, they must be assigned an “intent-to-use” (1(b)) filing basis. You will eventually have to either use the mark with these goods or services, or remove those goods and services from the application in order for a registration to be issued.

Preparing and filing your application to register your trademark entails a government fee of \$325 (or \$275 with TEAS-Plus) [per class](#) of goods or services in addition to whatever your attorney charges for his or her services. Many applications fall under a single class.

## **Examination of Your Application**

Your application will be picked up by a Trademark Examiner within about three months after your application is filed. Many times, applications are approved by the Examiner and passed to publication without the necessity for any changes. Other times, the Examiner may send out an Office Action requiring changes to your application to comply with certain formalities. The Examiner may also cite other registrations or pending applications that he or she feels prevent registration of your mark, or give other reasons that your mark is not registrable in the opinion of the Examiner.

If an Office Action is sent, it must be replied to within six months. There is no government fee on top of the amount you will be charged by your attorney for his or her services in preparing and filing the Response. If the Examiner still is not satisfied, a second Office Action may be sent. At that point you must meet all the Examiner's requirements, or appeal to the Trademark Trial and Appeal Board, or risk abandonment of your application. In some cases, registration of your mark may be refused.

## **Publication and Allowance of Your Application**

After your application is accepted, it will be published in the Official Gazette of the United States Patent and Trademark Office. This publication places all other trademark holders on notice that

your mark is about to be registered and gives them one month to oppose your registration. If your registration is not opposed, the mark will be allowed and, in the case of marks currently in use, officially registered.

## **Statement of Use (Intent-to-use applications)**

If your application was filed on an intent-to-use basis, a Statement of Use (See [TMEP § 1109](#)) must be filed within six months of allowance, along with a specimen showing use of the mark in interstate commerce, before registration will occur. A Statement of Use carries a government fee of \$100 per class.

If the mark is not yet in use by this time, you can request an extension of time to file the Statement of Use. Up to five extensions may be requested, each of which grants you an additional six months in which to use the mark and file a Statement of Use. Thus you may delay the use of your mark on the listed goods or services for up to three years after allowance of your application. If you still need more time, you will have to file a new application, because after you have used up all your extensions the original application will go abandoned. Each extension carries a government fee of \$150/class in addition to whatever your attorney charges for this service.

## **Declarations of Use and Incontestability**

Between five and six years after your mark is registered, you must file a statement of continued use under Section 8 (See [TMEP § 1604](#)). The government fee is \$100 per class. The statement can also be filed in the six-month grace period after the end of the sixth year, however filing during the grace period carries an additional \$100/class fee. This statement must set forth the goods or services listed in the registration with which the mark continues to be used and must be accompanied by one specimen

for each class of goods or services. Failure to file this statement within six and a half years after registration will result in the cancellation of your registration.

A declaration of incontestability (See [TMEP § 1605](#)) can also be filed once your registered trademark has been in continuous use for a period of five years after registration. If this affidavit is filed properly, the registration becomes “incontestable” and is conclusive evidence of the validity of the registered mark and its registration, of the registrant's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce, subject to certain defenses and exceptions. Filing this declaration carries a government fee of \$200 per class. Because the statement of use and declaration of incontestability each can first be filed five years after registration, it is common to file them together in a combined statement of use and incontestability (combined declaration under §§ 8 and 15).

Incontestability is a powerful advantage for your mark in court and grants you extra leverage in negotiations with infringers or for licensing and sales. Note that your mark also becomes stronger after being registered for five years regardless of whether you file a declaration of incontestability, in that the reasons available for someone to petition for cancellation of your mark are decreased.

## Renewals

A trademark registration expires after ten years. If you wish to keep your trademark registration active, you must file an Application for Renewal of your registration under § 9 (See [TMEP § 1606](#)) before the expiration of this ten year period. The window for filing this Renewal opens one year before expiration of the mark and a Renewal may also be filed within six months after the expiration of your mark (the “grace period”) with an additional fee. Thus, you may file a Renewal any time between nine and ten years after registration, or between ten and ten and a half years after registration, with payment of the additional fee. Each Renewal extends the life of the registration for ten years, thus a new

Renewal must be filed before the end of twenty years after registration, thirty years, etc., if you do not wish for your registration to expire.

On top of your attorney's service charge there is a government filing fee of \$400 per class for filing a Renewal. An additional fee of \$100/class is applied for filing during the six-month grace period.

Another declaration or affidavit of continued use under § 8 must also be filed within the same period as the Application for Renewal of registration. The government filing fee is \$100 per class, with an additional \$100 per class for filing during the grace period. Just like the Application for Renewal, an Affidavit of Use must be filed every ten years after registration. For this reason, the Application for Renewal and Affidavit of Use are typically filed together.

### **Keeping Track of the Deadlines**

Generally, your trademark lawyer will keep all of the relevant dates for your trademarks in a calendar and docketing system. That means you should never have to worry about missing an important deadline and allowing your trademark to lapse. This service may be included in the cost of filing renewals, etc. If you miss a deadline and your registration expires, typically your only recourse is to file a new application and go through the examination process again. Of course, your long period of use may be helpful in overcoming certain rejections the Examiner might otherwise raise.

#### Notice

This article was prepared in June 2009 and the information contained herein does not include any changes to the law after that time. Please do not rely on any information contained in this article without confirming it with your attorney.