

## Guide to Efficient Trademark Registration Applications

Before applying for trademark registration with the United States Patent and Trademark Office (USPTO), trademark owners and brand developers should consider the following key issues (many of which, incidentally, must also be addressed in the trademark registration application itself):

- **Words, Design, Colors.** It may seem obvious, but first and foremost it is important to know what exactly your trademark is. Are you going to claim exclusive rights in words only? In a graphic logo only? In a combined word-design logo? In the words independently and in the word-design combination? Is color an important feature of the trademark that you want to seek to protect?
- **Date of First Use.** If your company has already started using the trademark on its products or services, when did it start doing so? Has it started using the trademark at all? If not, an “intent-to-use” application can be used to protect the trademark before the company’s products or services go on the market.
- **“Bona Fide” Intent.** For “intent-to-use” trademark applications, the applicant must certify that they have a “bona fide” intent to make use of the trademark in commerce. This prevents companies from snatching up would-be trademarks solely in order to prevent their competitors from doing so first. If you have bona fide intent, when will the product or service be ready to launch? Intent-to-use trademark applications require supplemental filing of a “specimen” showing how the trademark is actually being used in commerce before the USPTO will issue a trademark registration certificate.
- **Products and Services.** What products or services does your company sell under the trademark? Many people do not realize that trademark registration with the USPTO provides protection only with respect to the “classes” of goods or services covered by the trademark registration application. Protection of a trademark in multiple classes of goods or services will require submission of duplicate (triplicate, etc.) filing fees.
- **Ownership.** This, too, may seem obvious, but ownership can in certain circumstances be difficult to discern—or at least require some basic legal footwork. If you operate as a sole proprietor or single-member, LLC, do you or your company own the trademark? If you used a design firm, does the contract provide for ownership by your company? If your company acquired the assets of a pre-existing business, does the asset purchase agreement appropriately address trademark rights?

- **Is it Actually a Trademark?** Many times business owners will have a misconception of whether a word or phrase they use in their business actually constitutes a trademark capable of legal protection and registration with the USPTO. Generally speaking, trademarks must be adjectives—not nouns or verbs. They must be indicative of the source of your company’s products or services. This does not mean that they must mirror your company name itself, but rather that they reflect a unique source point or service offering. If your company uses the trademark as a product or service name or non-generic identifier, it will generally be capable of obtaining trademark registration with the USPTO.
- **Is Anyone Else Using a Confusingly Similar Trademark?** Finally, and most important in many (if not all) respects, is knowing with a reasonable degree of confidence whether or not some other company has already claimed prior rights in your proposed trademark. This knowledge is obtained through performing trademark clearance research to survey the market and previous USPTO trademark filings to discover whether and to what extent other companies have already claimed exclusive rights in similar trademarked words or designs. Importantly, it is not enough that there are no *identical* trademarks on the market—the question is whether there is a “confusing similarity” in the relevant product or service markets.

With answers to these questions in hand, trademark owners can make an informed decision about how and when to file for trademark registration.

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