



Penny Wise and Pound Foolish: The Folly of Registering Your Trademark Without an Attorney's Help

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If you own a small business, chances are you are not afraid to take things on, try new things, and do it yourself. So when I give presentations to groups of small business owners, I often get asked whether it is possible to register a trademark without using a lawyer. The short answer is yes, you can. There is a relatively short online application form you can submit, available through the Patent and Trademark Office [website](#). For small business owners looking to save money, this may be an attractive option. But in my opinion, preparing and filing your own trademark application is penny wise and pound foolish.

Using a Trademark Attorney Upfront Pays For Itself In the Short Run

Usually, if you submit your own trademark registration application, that is not going to be the end of your experience with the trademark office (more detailed information about the trademark examination process [here](#)). More than likely, your application will not initially be in condition for allowance and you will receive an Office Action from the Examiner detailing the deficiencies.

Many times, this Office Action will contain legal jargon and will be essentially incomprehensible (to a layperson). Sure, you can try to muddle along on your own, but you will have a greatly heightened chance of receiving a final refusal of registration or of accepting a proposal from the Trademark Examiner that greatly damages your legal standing. Most people do not know what to do at this point.

Often, this is where I enter the process. Someone will tell me they got something from the Trademark Examiner and they do not know what to do with it, and I will take a look. Then, I respond to the Office Action and resolve the outstanding issues. I do not mind doing this, but the reality is that many of these problems could have been avoided by bringing me (or another competent trademark attorney) in to take care of the initial application. If the application is done right, it reduces the number of responses necessary or eliminates them entirely.

So, you may save some money now by filing on your own, but that savings may be lost on the back end when you have to pay an attorney to get your application allowed. Paying a lawyer to take care of your application also frees you up to do more valuable things than puzzling out legal jargon. Why waste your valuable time? Since an application for trademark registration carries a government fee of \$325, if you can afford an application you probably can also afford an attorney's help, which is often about the same cost (in addition to the government fee).

Finding the right lawyer can be hard, but you will probably need a lawyer at some point, if not to prepare a response then to file later forms like the Statement of Use, Statement of Incontestability, and Renewal. You might as well find a good one right now, at the beginning of the process.

Using a Trademark Attorney Upfront Pays For Itself Many Times Over In the Long Run

Trademarks can last a lifetime. Maybe your business is just starting up now, but where do you hope to be in five years? In ten? You may hope not just to succeed, but to build your business and expand. Once you have achieved success in the marketplace and built a reputation

and client base, it is difficult to overhaul your logo or other trademarks. Your customers expect to see your logo or brand and may be confused or unable to find you if you change it.

That means you may have the trademark you are applying for now for ten or twenty years or longer. There is no limit to how long a trademark can be used. A trademark registration is a long-term asset. You should use an expert- someone who deals with trademarks over and over again- to help you with your application- and ideally, to help you come up with a good mark in the first place. A trademark lawyer can provide you with good input as to:

- What makes a good or bad trademark in business- which marks are easiest to register and give you the best protection
- Exactly what mark to apply for (just the words? words plus design? just the design?)
- Whether you should claim color or use black and white
- Whether a registrability search should be performed and how thorough it needs to be
- What goods and services should be listed in your application
- Who should be listed as the owner of the mark
- Whether a disclaimer or other statement is necessary or proper
- How to protect your trademark by displaying it and using notice symbols
- How to defend your trademark from future challenge or infringement

And this list is by no means exhaustive. Lawyers can give you great advice. They are referred to as counselors for a reason. Heed their counsel! If you do not use an attorney at an early stage, you can end up with big problems down the line. The last thing you want is for a problem to pop up with your registration five or ten years later just when you are trying to expand.

Without a lawyer's input, you may end up with much less protection than you thought you had, resulting in an inability to prevent your competitors from using similar trademarks. You may leave yourself vulnerable to a petition to cancel your registration years later, or even to an infringement suit. A trademark cancellation proceeding or infringement suit can cost tens or hundreds of thousands of dollars.

Avoid those enormous headaches by taking simple and inexpensive action now: use a trademark attorney to file your application.