

## **U.S. Trademark Application Process**

*As a law firm which counsels businesses, this information will help you know the process for registering your trademark with the U.S. Trademark Office.*

Once your business has a trademark that it wants to protect, you should begin the U.S. Trademark Office application process for national trademark protection. Doing so will give you the exclusive right nationally to use this trademark and your competitors cannot. You can apply for registration even if the trademark is not in use yet.

### **Step 1: Meet with your attorney and gather all required information.**

We will need information about the trademark, including what your mark will be, whether you want to protect a specific design, logo, or piece of artwork, and what goods or services will be associated with the mark.

### **Step 2: Conduct a search to determine whether or not your trademark is already in use.**

If another trademark similar to yours has been used before your trademark was first used, you may not have the right to use your trademark. A prudent business will conduct a trademark search to know if a similar trademark for similar goods and services has been used before your trademark. Doing a trademark search will secure maximum protection for your business. We can describe the different types of searches. You may waive a search in your discretion.

### **Step 3: Complete the trademark application.**

All of the data previously gathered will be submitted to the U.S. Trademark Office in your trademark application. If you are already using your mark, the application should include a "specimen" showing the mark in use. This could be a picture of a product label or packaging in the case of goods or a brochure or website in the case of services. If your mark is not yet in use, a "statement of use" will need to be filed later, documenting when you began using the mark and including a specimen showing its use.

### **Step 4: The U.S. Trademark Office will review the application.**

An Examining Attorney at the U.S. Trademark Office will determine whether the application is complete and has met all of the applicable legal requirements and standards. This will include a search for possible conflicting trademarks in the Trademark Office records.

### **Step 5: Review and respond to any U.S. Trademark Office "Office Actions".**

If the Examining Attorney finds a problem with the application, or if there is a previously existing trademark in their records, he or she will issue an "Office Action" stating why registration of the mark is being refused. Office Actions are common, even in the case of well drafted applications. Common reasons for an Office Action include the existence of a conflicting or overly similar mark, a mark that is merely descriptive of the goods or services with which it is associated, an improper specimen, or a flawed goods and services description. We will formulate a legal response to the Office Action or, if necessary, amend your application so that we hope it meets the U.S. Trademark Office requirements for registration.

**Step 6: The mark is published for opposition.**

If we are successful in overcoming the objections by the Examining Attorney, the U.S. Trademark Office will publish the application for “opposition”. Third parties have 30 days from the date of publication to contest your mark's registration on the basis that they will be harmed by the registration of your mark.

**Step 7: The mark registers.**

If no objection is received, the mark will be registered in due time, about 90 days later. Congratulations! Or, if an opposition is received during the public notice period, we will need to address the objection before the application can continue to move forward.

**Maintenance.**

After registration, a U.S. trademark registration must be maintained to remain in effect. Your attorney can help you meet trademark renewal deadlines and, after a certain amount of time has passed, file for even greater protection for your trademark. Stay on top of these issues and your valuable intellectual property will be protected for years to come.

**Talk to Us**

If we can help you or you would just like to talk to us, please call our office or send us an e-mail. References are available upon request and at <https://corplaw.com/testimonials>.

We wish you the best of luck with your business!

Cordially,

*Charlie Brown*

Charles B. Brown  
Principal  
CorpLaw Intellectual Property Law Firm  
(847) 784-1300  
<https://corplaw.com> | [charlie@corplaw.com](mailto:charlie@corplaw.com)  
400 Central Avenue, Suite 150, Northfield, Illinois 60093

Charlie concentrates in IP (Intellectual Property) Law. Charlie has 36 years of experience as an accomplished IP attorney for businesses in diverse industries nationally and internationally, including as in-house counsel where he came to fully understand how to serve business clients best. He has served in leadership roles at the Chicago Bar Association and Association of Corporate Counsel and writes on IP topics.