

Navigating the Maze of the USPTO Application Process

Welcome, and thanks for stopping by! If you're looking for quick access to information on trademarking in the United States, you've clicked on the right video series.

In this episode, we'll focus on helping you navigate the trademark application process with the United States Patent and Trademark Office, or USPTO.

Applying for registration in the U.S. can be complicated and overwhelming; a little like trying to navigate your way through a complex maze. There are so many choices, like diverging paths, that could make or break your application. There's nothing more frustrating than getting stuck at a dead end, so we're here to help you stay on the right path.

Every journey starts with the first step, so follow us — we'll lead the way.

Weaving your way through the USPTO trademark application process definitely takes some time, so when things get tedious it helps to remind yourself of what we like to call: the WHY factor. Why are you trying to register your trademark in the U.S. in the first place? Is it really worth all this effort and investment?

Absolutely! Although it isn't necessary *by law* to register your trademark in order to enter the American marketplace, ownership rights are nothing to sneeze at.

So why register a trademark with the USPTO?

- You'll gain *legitimate* legal ownership over your brand, products and services
- Registered trademarks are easier to protect and defend
- Trademarks are a valuable economic asset that appreciate over time
- There are plenty more benefits, but you get the point.

Basically, registered trademarks are worth the investment and effort. Trust us, it's what we do.

Now that you've settled on a suitable why factor, you're equipped with the motivation you need to confidently navigate the maze of USPTO filing and registration.

But wait! You never know what's waiting around the next corner of a maze, so it's best to arm yourself with the tools you need to survive every hurdle.

Trademark applications to the USPTO must follow a stringent set of rules for which you need to be prepared in order to get registered successfully.

For example, you'll need to determine which classes your marks fall under. The USPTO has a variety of classes or categories to differentiate the types of goods and services you can trademark. If the items you wish to protect fall under multiple types, you must apply under each relevant class to ensure adequate protection is given. Additional fees may apply.

Whether you apply under one class or several, the registration process all comes down to paperwork; complete, accurate paperwork. Your USPTO application documents must include:

- Your name, address and business type
- An overview of your relevant products/services

- Your basis for filing
- A drawing and description of your mark
- All applicable fees

If you want to register your trademark for use in commerce, you also need to provide:

- The date of first use for your trademark
- Proof of use for at least one product or service per class
- A verified statement of use or intention to use

As a side note, filing intent-to-use applications require an extra \$100 fee per class in addition to the application fees.

Now it's time to get a plan in place. The overall application process goes a little something like this:

Step One: prepare and submit required paperwork to the USPTO.

Step Two: examining attorney reviews application and either:

a.) Finds issue with application and sends an "office action" your way, basically identifying a problem and giving you a chance for correction.

b.) Finds no issue with your application and proceeds to the next step.

Step Three: the USPTO publishes your mark in the "Official Gazette" to notify the general public of your intent to register. If no oppositions arise within 30 days, and you're already using the mark in commerce, you get registered.

If your application is based on ***intent to use***, and there are no oppositions within the 30 days, the USPTO will send a Notice of Allowance within 8 weeks, allowing you to use your mark in commerce. That way, you can submit a statement of use. This does not mean your mark is registered yet, but it does mean you're one step closer!

Step Four: Receive certificate of registration!

You have your tools, you have your plan and you're ready to go — but it seems like we've been walking this straight path for quite a while now. Suddenly, our first fork in the road appears: deciding how to apply.

USPTO trademark applications can be filed by mail or electronically. The normal application fee is \$400 per class, but there are reduced fee options available: TEAS RF (Reduced Fee) and TEAS Plus. Let's break them down.

TEAS or T.E.A.S refers to Trademark Electronic Application System. It offers registration filing at a reduced fee as an incentive to file electronically, which is more efficient.

If you choose TEAS RF, you'll pay just \$275 per class to file a trademark application. You'll receive all correspondence from the USPTO via email and you must submit certain documentation electronically only.

TEAS Plus applications cost only \$225 per class, but you'll have to meet certain requirements including:

- Email correspondence only
- Electronic submissions only
- Filing a complete application with no empty fields whatsoever
- And all fees must be paid upfront

Once you've submitted all required documentation, you can relax a bit — but you still have some ways to go if you want to make it through the maze and reach registration.

Sometime after your application is received, it will be reviewed by a USPTO examining attorney.

What factors will the examiner look for on your application?

Mainly, they'll look for **completeness** and **compliance** to the minimum application requirements to determine registrability.

While there's never any guarantee when it comes to registration, there are ways to enhance your application and minimize your chances of rejection. After all, when you're aware of common application pitfalls, you can better avoid them.

Let's talk about possible grounds for registration refusal.

First up, office actions! These are the pesky little communications you may receive directly from the examining attorney at the USPTO should there be any missing or inaccurate information on your application.

You get **six months** to respond and correct whatever problems accordingly. Since examining attorneys will employ extensive trademark searches to determine registrability, doing some searches of your own — especially at a professional level — can help you ensure nobody else has a similar mark that may cause office actions down the road.

Trademark searches prior to application are also super useful for preventing a worse fate: oppositions.

Imagine you've nearly made it to the end of the maze -- so close you can almost taste the victory of registration... but then, you receive a notice of opposition. Someone is claiming your desired mark is too close to their own. Yikes.

On what grounds can someone oppose your registrability?

Once your desired mark has been released to the public, basically anyone who can prove that your mark would be detrimental to their business can oppose you.

Within reason, of course. Common grounds for opposition include:

- Likelihood of confusion: marks are too similar
- Desired mark is likely to cause dilution of distinctiveness for their brand
- Non-compliance with application requirements
- Date of first use dispute

So how long does the application process take?

Typically, registration with the USPTO takes about **six to nine months** from the filing date. That said, if you run into any office actions or oppositions, the process tends to take much longer — especially if your responses aren't timely and organized.

Once your application has been reviewed and all, if any, office actions and oppositions have been handled, you'll receive a Certificate of Registration.

Success — you're registered! You've made it through the maze and now you'll be protected across the U.S. for up to 10 years! After that point, you can apply for renewal, so long as the mark is still in use.

All you have to do in the meantime is monitor and police your trademark to ensure your rights are protected — but more on that next time!

Have questions?

Think of us like your pocket survival guide, always there to point you in the right direction. For more information on trademarks visit our website at tm.witmart.com, or give us a call at 1-877-948-6278.

Thanks for watching and remember to check out our next video all about life after registration!