

## Filing your Federal Trademark

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Filing a trademark with the United States Patent and Trademark Office (USPTO) is more than just filling out a form and paying the fee; it's a multi-step process lasting upwards of a year that can give rise to lawsuits and unnecessary expense if done incorrectly. Hiring an experienced trademark attorney from The Law Offices of Donald W. Hudspeth will help to guide you around the common pitfalls and hurdles associated with this nuanced process and ensure the eventual protection of both your mark and your sanity.<sup>1</sup>

### A General Overview:

A trademark protects brand names and logos of services or goods.<sup>2</sup> If you are a business owner using a specific logo, name, or sound, you may want to consider filing for a federal trademark to help protect it and keep others from infringing upon it.

Once someone decides to file a trademark, they are required to go through a multi-step process to register it. First, you must decide on the format of the mark. Though this may seem simple, there are many details that play into the decision. When the format and design of the mark is chosen, you then get the privilege of wading through an extensive data base and deciding on the precise categories of goods or services that your mark will apply to (keeping in mind that there is a surcharge for each and every category you choose.) You then must decide what type of application you plan on filing: an application with proof of your mark already being used “in commerce” or an application showing your “intent to use” the trademark in commerce.

Once you've made these decisions, you must then search through the massive database at the USPTO to guarantee that no one else is using your mark or something similar to it. If you attempt to register something that is already in use, your application will be rejected and your filing fee will be gone forever. If you're sure you won't be infringing on someone else's trademark, you then fill out the registration forms and pay the non-refundable fee. This fee will not be refunded even if your mark never registers, so you have to make sure you're committed to dealing with the remainder of the process.

At this point, your application will be reviewed for errors by a very thorough in-house examiner at the USPTO. If the examiner discovers any errors, he will send an official letter (known as an Office Action) giving a statutory deadline by which to submit changes. A proper response must be submitted by this deadline or the application risks abandonment and loss of your application fee. This process can occur multiple times until the application has been thoroughly vetted by the examining attorney. Eventually, if you have addressed all of the errors and haven't given up on your application or your sanity in general, the USPTO will publish the mark to its weekly publication, the *Official Gazette*. This publication gives any outside parties thirty days to oppose the registration of your mark. If opposition occurs, the case will continue much

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<sup>1</sup> Information for this article provided by the Law Offices of Donald W. Hudspeth in Phoenix, AZ and the site for the United States Patent and Trademark Office at <http://www.uspto.gov/trademarks/process/index.jsp>.

<sup>2</sup> *Basic Facts about Trademarks*. UNITED STATES PATENT AND TRADEMARK OFFICE, 2012. <http://www.uspto.gov/trademarks/basics/BasicFacts.pdf>.

like a case before a judge in a regular court of law. This could easily give rise to a hefty expense, especially if you have multiple parties opposing the registration.

If you've done your homework before filing your mark, you may not get any opposition. If you've already filed proof of your mark being used in commerce (see above), the Office will issue a Registration Certificate roughly three months after your mark published. If, however, you only originally filed an "intent-to-use" application, you have six months to actually show that the mark is being used in commerce. Failure to do so without asking for an extension will result in abandonment of the application, loss of your filing fee, and you having wasted a large amount of your valuable time. Even if you file this "statement of use," you're still not home-free. The examining attorney will then review the statement and make sure that it's satisfactory proof of your trademark being used in commerce. If it's not, you will again have the privilege of responding to more Office Actions from the disgruntled examining attorney.

If, after all this time, you have managed to traverse the obstacle course that is trademark registration without abandoning your application, losing your filing fee, or losing your mind, you will receive a Registration Certificate from the Office, certifying that your trademark has (finally) registered. You can then breathe a sigh of relief and return to your normal life where you weren't constantly worried about your trademark or losing your hair worrying that you'll find an Office Action in your mailbox.

**OR**, instead of risking money, time, and the loss of your mind, you could hire the experienced Trademark attorneys at The Law Offices of Donald W. Hudspeth. We have over 20 years of experience dealing with the USPTO and will monitor every step of any trademark we file for your company, saving you time, money, and sanity. In the event your trademark registration is denied by the examining attorney or challenged by another trademark holder (inter parties' dispute), the firm can represent you.

Avoid the expense of dealing with errors and litigation down the road by calling the experienced attorneys at The Law Offices of Donald W. Hudspeth today!