

Registering Your Trademark: A Step-By-Step Guide

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There are five distinct steps in obtaining and registering a trademark.

1. First Step: Conducting a Trademark Clearance Search

Before applying for a trademark, you want to determine if your proposed name is already taken. This process is called a trademark clearance search. You can conduct a preliminary trademark clearance search on the Patent and Trademark's ("PTO") website www.uspto.gov. However, in most instances, a trademark attorney should conduct an extensive trademark search for you. This is because trademark attorneys are familiar with sophisticated search techniques on the PTO's website, which may uncover existing trademarks that are close to your proposed name. In addition, an experienced attorney will be in the best position to interpret the search results obtained from the PTO website.

2. Second Step: Filing the Trademark Application

Filing a trademark application can be done by going onto the PTO's website www.uspto.gov. You do not have to be an attorney to complete a trademark application. However, it is highly recommended that only an experienced trademark attorney complete your application. This is because completing a trademark application is complicated and if you put incorrect information in your application, you will not obtain your trademark. An incorrect application may also mean that although you may initially obtain your trademark, subsequently the trademark can be invalidated for the incorrect information in the application.

3. Third Step: Responding to the PTO

After your application is filed, the PTO reviews the application and if they have any objections they will issue an "office action". These objections (office actions) have to be responded to and they have to be responded to correctly. A trademark attorney has the experience to know the right way to respond to the PTO's objections and how to overcome them. This is where a good trademark attorney earns his or her fee. In contrast, if you try to respond to the PTO's objections and you do so incorrectly, the PTO will reject your application.

4. Fourth Step: The Public Comment Period

Once all of the PTO's objections are overcome, there is still one more hurdle to jump over before the PTO issues you a trademark. Your proposed name will be published for the public to comment on. This is called "publishing your trademark for opposition." By publishing your trademark for opposition, the PTO is allowing the public to raise any objections it may have to your trademark.

This is best illustrated by example. Assume that I want a trademark for "Nikke", but instead of selling sneakers, my Nikke store will be selling hamburgers. Perhaps the PTO will allow Nikke as a trademark and will publish it for opposition. Nike® determining that the Nikke

name is too close for comfort, will inform the PTO that it objects or opposes your trademark application. If this occurs, before your trademark application is accepted, there will be a hearing/trial, where a separate division within the PTO will decide whether your Nikke mark should be approved. A trademark attorney should be retained to represent you in this hearing/trial.

5. Fifth Step: Keeping Your Trademark Registered and Current

If no one objects to your trademark or if you win the hearing/trial, your trademark will be approved and you will receive a trademark certificate. However, you have to keep your trademark current. This means that between the 5th and 6th year after your trademark approval date, you have to inform the PTO that you are still using the trademark. This is done by filing a Statement of Use. Then between the 9th and 10th years after your trademark approval date, you again have to file another Statement of Use. If you fail to inform the PTO of your use, your trademark will be cancelled.

A trademark attorney will keep track of when you need to update the PTO and will complete the Statement of Use and any other necessary forms for you.

If you need more information about trademarks or need an attorney to help you obtain a trademark, the Badanes Law Office can help you. Contact the Badanes Law Office, which specializes in obtaining trademarks and trademark law for a free consultation. The phone number is 631-239-1702 and the website is www.dbnyiplaw.com.