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An Intellectual Property and Business Law Firm



PROCESS OF REGISTERING A FEDERAL TRADEMARK

Step 1 - The Clearance Search

The process of federally registering a trademark starts with a trademark clearance search. Certain court cases have basically mandated that an applicant conduct a sufficient trademark clearance search in order to determine whether or not they are eligible for federal registration. Failure to conduct a search can have adverse consequences down the road in potential litigation. Essentially, in some areas of the country, courts have ruled that the failure to conduct a proper clearance search may be seen as a willful blindness on the part of the non-searching party and be tantamount to bad faith use of the mark.

Step 2 - Filing of the Application

Assuming that the search results give the "OK" to go ahead and file an application, the application is filed with the United States Patent and Trademark Office (USPTO). Then it basically sits in the queue for 6-8 months. Once it reaches the top of the queue, an examining attorney will examine the application to determine if the trademark warrants federal registration. The examiner will look at factors such as 1) does the mark rise to the level of a trademark or is it a generic or merely descriptive term, 2) if the trademark is merely descriptive has it obtained wide spread secondary meaning through its use, 3) is there a likelihood of confusion between the proposed trademark and any existing federal trademark registration, and are the goods or services in which the trademark is being used sufficient and in a manner acceptable to the USPTO. The examining attorney will either allow the application or issue an initial rejection.

Step 3 - Office Actions

Rejections can be classified in two categories, technical and substantive. Technical objections usually surround some technical error with the application and are usually easily fixed. Substantive rejections deal with some issue of law that the examiner is citing as a bar to your registration. Substantive rejections may be contested, and usually require a significant amount of time to prepare a response. Often times, a well crafted response to a rejection and potentially some negotiations with the examining attorney can result in an allowance of the trademark. Some of the most common substantive rejections are for the likelihood of confusion, or that the trademark is merely descriptive and requires the trademark owner to present evidence that the mark has achieved secondary meaning. If the examining attorney is not persuaded by the applicant's arguments, they will issue a final rejection. A final rejection may be appealed to the Trademark Trial and Appeals Board, and ultimately if need be to the United States Court of Appeals for the Federal Circuit.

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Step 4 - Publication

If your trademark is allowed, it is then published in the federal gazette. In theory, this allows the mark to be open to public scrutiny and allows anybody who feels that you should not be eligible for the trademark, or that they have a better right to the trademark to file an opposition. If nobody files an opposition, after the required waiting period the trademark is then registered.

Step 5 - Post Registration Filings

Believe it or not, there are still filings and maintenance that need to be done after the USPTO has issued your registration. Filings of continued use must be filed between the 5th and 6th year after registration, and optional filings for incontestability may be five years after the registration issues. Some of these filing are required to maintain your registration. Failure to timely file these documents could lead to the USPTO canceling your mark.

Leyendecker & Lemire, LLC is a Denver-based law firm offering a full spectrum of Intellectual Property, Business and Entertainment related legal services for entrepreneurs, individual inventors, and businesses of all sizes. We pride ourselves in providing large firm quality, but with personalized service and attention the large firms do not provide to their smaller clients. Our strength is working with a client from the beginning of his/her venture to maximize the venture's value and potential, as well as, help minimize the risk of legal disputes. Call (303) 768-0123 or e-mail us at info@coloradoiplaw.com today to see how we can help you!

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