

Filing a Federal Trademark Application

PRACTICAL LAW INTELLECTUAL PROPERTY & TECHNOLOGY,
WITH MICHAEL J. SCHWAB, MORITT HOCK & HAMROFF LLP

Search the [Resource ID numbers in blue](#) on Westlaw for more.

This Note discusses how to prepare and file an application to register a trademark or service mark with the US Patent and Trademark Office (USPTO). It outlines the elements of an application for a mark on the Principal Register based on use or an intent to use in commerce. It includes practical guidance about all aspects of the application process, from preliminary discussions with the client about the proposed mark, through prosecution of the application, to post-registration maintenance.

Federal registration is important to protecting trademarks, which are often among a business entity's most valuable assets. However, not getting the right information from the client, application filing omissions, and other mistakes can lead to costly delays and a loss of priority over competing marks. This Practice Note outlines the steps for registering a federal trademark or service mark with the US Patent and Trademark Office (USPTO) and provides practical guidance for avoiding problems along the way.

PRELIMINARY CONSIDERATIONS

A federal registration grants the trademark owner substantial benefits and more expansive rights than are available for an unregistered mark under the Lanham Act or state law (see Practice Note, [Acquiring Trademark Rights and Registrations: Benefits of Federal Registration \(2-505-1700\)](#)).

This Note covers:

- The requirements for registration on the USPTO's Principal Register (see Principal or Supplemental Register ([W-013-9729](#))).
- Federal trademark applications for trademarks for goods or services, or both.

It does **not** provide instructions for:

- Registration on the Supplemental Register.
- Applications for concurrent use marks, certification marks, or collective marks.

In this Note, "trademark" and "mark" refer to both trademarks and service marks.

TIMING

Obtaining a federal trademark registration typically takes at least one year (assuming the application is successful). However, it may take much longer than that. The timing depends on a variety of factors, including the extent to which the USPTO or third parties object to registration of the mark and the USPTO's backlog of pending applications.

For a visual representation of the general process for registering a trademark in the USPTO, see US Trademark Application Flowchart: Use-Based Application ([9-519-0444](#)) and US Trademark Application Flowchart: Intent-to-Use Application ([8-519-0487](#)).

PRE-FILING STEPS

Obtaining Information from the Client

Counsel should obtain complete information from the client about a new mark the client seeks to register in order to:

- Evaluate the mark's protectability and registrability.
- Prepare and file the application with the USPTO.

Important trademark information to discuss with the client includes:

- The format of the mark, for example, if it is a standard character mark, a stylized or design mark, or a non-traditional mark, such as a sound mark.
- Variations of the mark that the client is using or may use, which may require separate clearance and registration.
- Any meaning or significance of the proposed mark in:
 - any foreign languages; or
 - the applicant's field or industry.

- The goods and services in connection with which the mark is being or is intended to be used and for those goods and services, the relevant:
 - trade channels; and
 - target consumers.
- If the mark has been used in commerce, details about the use, including:
 - first use dates;
 - any prior (or concurrent) users;
 - the duration of the use; and
 - its geographic scope.
- Details about the origin of the mark, including who created it and when it was created.

For more on what information counsel should seek about the proposed mark, see Standard Document, Trademark Search and Registration Questionnaire ([0-508-1487](#)) and Trademark Searching and Clearance Information Checklist: Key Information to Obtain About the Trademark ([9-508-1831](#)).

Searching and Clearance

Before filing, counsel should evaluate the client's proposed mark and, ideally, clear it for registration by:

- Ensuring that it qualifies for federal registration under the Lanham Trademark Act (Lanham Act), related regulations, and applicable USPTO rules including, for example, that the mark is:
 - used in a type of commerce that Congress can regulate (for example, in connection with goods or services in or affecting interstate commerce); and
 - distinctive (meaning that the mark is not a generic term or merely descriptive of the applicable goods or services).
- Obtaining and evaluating a trademark search report to ensure the mark is not confusingly similar to any marks previously registered with the USPTO or applied for or used by third parties.

Analyzing a trademark's eligibility for federal registration and trademark search results requires knowledge of trademark law and is typically performed by an experienced trademark attorney. For a list of resources on the search and clearance process, see Trademark Searching and Clearance Toolkit ([W-012-4884](#)).

Knock-Out Searches

Trademark searches typically consist of an initial preliminary (knock-out) search followed by a full, comprehensive search. However, even if the client lacks the time or budget for the full search, counsel should still conduct the knock-out search to identify any obvious conflicts.

Knock-out searches may be done relatively quickly and inexpensively using free databases, such as the Trademark Electronic Search System (TESS), the USPTO's searchable online database of registered marks and applications. For more information, see Practice Notes, Trademark Searching and Clearance: Preliminary Trademark Searches ([4-507-2834](#)) and Acquiring Trademark Rights and Registrations: Knock-Out Search ([2-505-1700](#)).

PREPARING THE APPLICATION

PRINCIPAL OR SUPPLEMENTAL REGISTER

Most applications are filed for registration on the USPTO's Principal Register, which grants the trademark owner the most protection. A certificate of registration on the Principal Register entitles the registrant to important legal presumptions, including that:

- The trademark is valid.
- The registrant is the owner of the mark.
- The registrant has the exclusive right to use the mark in commerce on or in connection with the goods or services specified in the registration.

(15 U.S.C. § 1057(b).)

However, some terms that do not qualify for registration on the Principal Register may be eligible for registration on the Supplemental Register. These are usually merely descriptive marks for which the trademark owner cannot yet demonstrate acquired distinctiveness.

For more on the difference between the Principal and Supplemental Registers, see Practice Note, Acquiring Trademark Rights and Registrations: Principal Register ([2-505-1700](#)) and Supplemental Register ([2-505-1700](#)).

This Note covers the requirements for registration on the Principal Register.

FILING BASES

Trademark applications must claim at least one of four filing bases. The two most common bases, and the only ones covered in this Note, are:

- Use in commerce based on Section 1(a) of the Trademark Act (15 U.S.C. § 1051(a)) (see Use in Commerce).
- Intent to use (ITU) based on Section 1(b) of the Trademark Act (15 U.S.C. § 1051(b)) (see Intent to Use).

However, an applicant outside the US can benefit from its home country's participation in international trademark agreements by filing under one of the following other bases:

- As a qualified foreign applicant under Section 44 of the Trademark Act, which allows the applicant to base its application on certain foreign applications or registrations (15 U.S.C. § 1126). If applicable conditions are met, the effective filing date for the US application is the applicant's foreign application filing date. However, to achieve registration in the US, a §44 applicant needs to either:
 - have a qualifying foreign registration; or
 - also assert US use or intent to use.
- (Trademark Manual of Examining Procedure (TMEP) § 1003.03.)
- By seeking an extension of protection to the US under the Madrid Protocol, based on the applicant's home country application or registration and Section 66 of the Trademark Act (15 U.S.C. § 1141f). A Madrid Protocol applicant asserts an intent to use the mark in the US as part of its application. However no use is required before registration. (TMEP § 1904.01.)

Use in Commerce

A use-based (or Section 1(a)) application claims actual use of a mark in commerce on or in connection with the goods and services listed in the application. The use must be a bona fide use in the ordinary course of trade and not use solely made to reserve trademark rights (see Use-in-Commerce Requirements).

The mark must have been used on all the goods and services in the application, unless the applicant also claims an intent to use as a basis for some goods or services. An applicant cannot claim both bases for the same goods and services and must specify which basis covers which goods and services (37 C.F.R. § 2.34(b)).

Intent to Use

An ITU (or Section 1(b)) application is based on a bona fide intent to use the mark in connection with the goods or services listed in the application even though actual use has not yet taken place (15 U.S.C. § 1051(b)). The USPTO examines and publishes ITU applications the same way as applications claiming prior actual use of the mark. However, if the ITU application survives the examination and opposition process, the USPTO issues a Notice of Allowance.

To obtain a registration, the ITU applicant then must file an Amendment to Allege Use or a Statement of Use, along with appropriate evidence showing that it has used the mark in commerce on or in connection with the goods and services listed in the application (see Notice of Allowance).

For more on Notices of Allowance and filing a statement of use, see Standard Document, Client Letter: Trademark Notice of Allowance ([W-012-7984](#)).

APPLICATION REQUIREMENTS

The USPTO grants a filing date for an application that includes, at a minimum:

- The applicant's name.
- A name and physical address for correspondence.
- A clear drawing of the mark.
- A listing of the goods or services.
- A filing fee for at least one class of goods or services.

(37 C.F.R. § 2.21; TMEP § 202.)

In most cases, the filing date is the effective date for determining filing priority or constructive use against third parties. The USPTO rejects any application that does not include the required elements.

However, an application that contains only those elements is not considered complete and will draw an office action in which the examining attorney (also referred to as a trademark examiner or examiner) requests additional information.

To be considered complete, a trademark application must include the following:

- The applicant's name and address (see Name and Address of the Applicant).

- The applicant's legal entity type and citizenship (see Type of Legal Entity and Citizenship).
- Correspondence name and address (see Name and Address for Correspondence).
- A drawing of the mark (see Drawing or Depiction).
- A description of the mark, if it is not in standard characters (see Description of the Mark).
- A list of goods and services covered by the application (see The Goods and Services Specification (or Identification)).
- The international classes of the goods and services (see Goods and Services Classification).
- For a use-based application:
 - the dates of first use of the mark (see The Date of First Use in Commerce and The Date of First Use Anywhere); and
 - a specimen of use of the mark in connection with goods or services in each class in the application (see Specimen of Use).
- A verified statement or declaration (see Verified Statement or Declaration).
- Additional statements, as applicable (see Additional Statements).
- The applicable fee (see Fee).

(37 C.F.R. §§ 2.32, 2.33, 2.34; TMEP § 818.)

The electronic forms on the USPTO website prompt filers to include this information.

Name and Address of the Applicant

The applicant must be the owner of the trademark that is in use or, if it has not yet been used, a party entitled to use the mark in commerce. The owner does not have to be the one using the mark; the use can be by a related company. However, where the mark is used by a related company, the owner must control the nature and quality of the goods sold or services rendered under the mark. (TMEP § 1201.01.)

If an applicant does not own or is not entitled to use the mark at the time of filing, the application is void. It cannot be amended to name the correct party as the applicant, because the applicant has no right that can be assigned. (TMEP § 803.01.)

If an individual applicant is doing business under another name, the application should include both the real name and the assumed business name in the application (TMEP § 803.02(a)).

The applicant does not have to be a US citizen and can be an individual, partnership, corporation, or any other type of legal entity.

The application must include the applicant's mailing address, which appears on the registration certificate. Specific address requirements vary depending on the type of applicant, as follows:

Applicant Address Requirements

Applicant Type	Address Requirement
■ Individual	■ Business or residence address
■ Partnership or other firm	■ The address of the business and not the partners or members
■ Corporation or association	■ Business address, but if not in the applicant's state of incorporation also the address where the applicant is domiciled
■ Joint Applicants	■ Address for each party

(See TMEP § 803.05.)

Correspondence Name and Address

The application must also include contact information for correspondence from the USPTO about the application (TMEP § 803.05). If the applicant has appointed an attorney or a domestic representative, that appointee's contact information should be provided. Foreign applicants typically appoint a domestic representative to receive notices and service of process.

Email Address

Applicants should authorize the USPTO to communicate about the application by email, if possible. This can significantly shorten the time to registration by allowing the examining attorney to resolve ministerial matters quickly, such as minor changes in wording or the addition of a standard disclaimer.

The applicant can also designate addressees for duplicate courtesy copies of any application-related emails.

TEAS Reduced Fee and TEASPlus applicants must provide email addresses and prosecute their applications by email (see Filing Options).

TYPE OF LEGAL ENTITY AND CITIZENSHIP

The application must state the applicant's legal entity type, for example, partnership, joint venture, corporation. Terms, such as "company" or "firm," are indefinite and are not acceptable. The application must also include the applicant's citizenship or the state or nation under the laws of which the applicant is organized, for example:

- An individual applicant should provide its country of citizenship.
- A US corporation must specify the state in which it is incorporated.
- A partnership must provide each general partner's:
 - name;
 - legal entity type;
 - citizenship; and
 - state or country of organization.

(TMEP § 803.03.)

DRAWING OR DEPICTION

A clear drawing or depiction of the mark sought to be registered must accompany the application. The USPTO uses the drawing to give notice to the public of the applied-for mark and resulting registration by reproducing the drawing:

- On TESS (the USPTO's searchable online trademark database), which may be accessed here.
- In its *Official Gazette* when the mark is published for opposition (see Publication).
- On the certificate of registration.

Therefore, the drawing and the specimen, which shows the mark actually in use, must agree. Otherwise the USPTO refuses the application (see Specimen of Use; for strategies and sample language for responding to a refusal on this ground, see Standard Document, Trademark Office Action Response: Specimen Refusals ([W-008-6347](#))).

Drawings generally come in two forms:

- Standard character drawings (see Standard Character Drawings).
- Special form drawings (see Special Form Drawings).

Standard Character Drawings

A standard character drawing is used for a word mark without any design element that:

- Is not used or intended to be used in a particular font style, size, or color.
- Does not contain any non-Latin characters or non-Roman or non-Arabic numerals.
- Includes only standard punctuation and diacritical marks, for example no underling, superscripts or subscripts.

The USPTO maintains a list of standard characters acceptable to include in a standard character mark on its website. The list is extensive and includes many common and not so common punctuation marks, symbols, and diacritical marks, for example, &, @, ä, ç, ð, and œ.

A registration for a word mark with a standard character drawing provides the broadest protection for a mark because it covers the mark in any presentation.

For a standard character drawing, the filer simply types the mark into the electronic form or, for a paper filing, prints the mark on the application, typically on a separate page. There is no need to use any particular font or all caps, though many practitioners still do.

The application should also include the applicant's express disclaimer of any particular font style, size, or color (TMEP § 807.03(a)).

Special Form Drawings

A special form drawing, such as an illustration of the mark, typically is used for:

- Design marks.
- Word marks in a distinctive form, such as a specific font, style, or color.

The applicant should submit a special form drawing if the commercial impression of the mark changes if it is registered based on a standard character drawing, for example, where a difference in the size of letters in the mark contributes to the mark's distinctiveness (TMEP § 807.04).

Color Marks

If a mark includes color, the drawing must be in color and the application must also include:

- A color claim.
- A color location statement in the mark's description.

(See Description of the Mark; TMEP § 807.07(a).)

The on-line application form includes an optional color claim with the required wording and a space to fill in what colors are being claimed as a feature of the mark. When completing the color claim, the filer:

- Should use the generic name for the colors.
- Does not need to:
 - specify the shade of a color, although the examining attorney may ask for more details if necessary for an accurate description; or
 - refer to a third-party color identification system, such as Pantone, however some practitioners do.

Drawings for Non-Traditional Marks

The USPTO has special requirements for drawings for non-visual marks and other non-traditional marks. For example, an application for a completely non-visual mark, such as sound or scent mark, does not require a drawing. However, it must include a detailed description of the mark. An applicant seeking registration of a sound mark should also submit an audio reproduction of the mark and, if the mark includes music, a musical score sheet. (TMEP § 807.09.) For more examples, see Practice Note, Protecting Non-Traditional Trademarks: Drawings ([W-008-0911](#)).

DESCRIPTION OF THE MARK

The application must include a description of any mark that is not a standard character mark, such as:

- Marks that contain:
 - design elements;
 - non-Latin characters or non-Roman or non-Arabic numerals;
 - uncommon punctuation or diacritical marks; or
 - color or motion.
- Trade dress or non-traditional marks, such as:
 - three-dimensional marks; and
 - non-visual marks, such as sound or scent marks.

(TMEP § 808.01.)

The description should concisely describe all significant literal and design elements of the mark. If color is claimed as a feature of the mark, the description must name any colors and describe where they appear in the mark (see Color Marks).

Examples of accepted descriptions include the following:

- "The mark contains the word POM with a heart design in place of the letter 'O'" (Registration No. 3047447).
- "The color(s) blue, yellow, orange and white is/are claimed as a feature of the mark. The mark consists of the word 'TIDE' in the color blue outlined in white, superimposed on three radial symmetrical bands in the colors yellow, white and orange,

respectively, with the innermost portion of the circle also in yellow" (Registration No. 3389568).

- "The mark is a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough" (for Play-Doh modeling compound) (Registration No. 5467089).
- The color(s) blue, red, yellow, and green is/are claimed as a feature of the mark. The mark consists of the word 'GOOGLE' in a stylized font. The letters from left to right are in the following colors: blue (the letter 'G'), red (the letter 'o'), yellow (the letter 'o'), blue (the letter 'g'), green (the letter 'l') and red (the letter 'e'). The color white shown in the mark is background only and is not claimed as a feature of the mark" (Registration No. 5324610).

The descriptions for the TIDE and GOOGLE logos include the necessary color claims and color location statements.

GOODS AND SERVICES IDENTIFICATION AND CLASSIFICATION

The Goods and Services Specification (or Identification)

The trademark application must list each particular good and service in connection with which the mark is used or, for an ITU application, will be used, using common, clear, and concise terms. Broad terms, such as "clothing," are unacceptable. Instead, the specific items of clothing must be itemized (for example, "t-shirts, pants, and skirts").

The applicant should use the ordinary names for goods and services and avoid:

- Unnecessary technical or obscure terms.
- Open-ended terms, like "including" and "such as."
- Vague terms, such as "accessories" and "system."
- Third-party trademarks.

Inexperienced applicants may seek to crowd the specification with wordy descriptions and aspirational uses, often copied from a business plan or marketing language. It may help to remind clients that:

- The description must be accurate. Depending on the filing basis, the applicant must either have actually used or have a bona fide intent to use all of the goods and services listed in the application. Otherwise, the application and resulting registration may be vulnerable to fraud claims.
- More items in the identification usually makes the application more expensive as filing fees are based on the number of classes in the application (see Filing).
- Where accurate and acceptable under the USPTO's specificity requirement, broader descriptions offer a wider scope of protection and allow for minor variations in the goods and services over the life of the anticipated registration. For example, it is likely more effective to list "hats" rather than "a wide variety of ladies moderately priced fashion hats made of felt."
- Once the application is filed, the applicant can still narrow but cannot broaden the goods and services description.

The USPTO's Trademark ID Manual, a searchable database, provides examples of language that has been accepted to describe particular types of goods and services. An applicant using the TEAS Plus filing option, which costs less, must choose its goods and services from this database. (For more on TEAS Plus, see Filing.)

Another good source for acceptable descriptions is TESS, the USPTO's searchable online trademark database, because it can be useful to see what language other applicants have used to successfully register marks for similar goods or services. However, examining attorneys must examine each application on its own merits and are not bound by prior examiner determinations (see, for example, *In re Loggerhead Tools, LLC*, 119 U.S.P.Q.2d 1429, 2016 WL 3876808, at *8 (T.T.A.B. 2016); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001)).

Goods and Services International Classification

The application should include the classification of each good and service according to the 45 categories set out in the Nice Classification, an international system for categorizing trademarks for registration (TMEP §§ 1401.02 and 1401.03). Classification is strictly ministerial and intended for the USPTO's administrative convenience. It does not affect the scope of the resulting registration or the applicant's rights in the mark.

If the classification is missing from the application, the examining attorney assigns it, however this may delay the application. The examiner may also suggest re-classification if the initial listed class is incorrect. (See TMEP §1401.03(b).)

An application may include goods or services in more than one class, however filing fees are based on the number of classes in the application.

According to the USPTO, an application's goods and services identification is usually acceptable if it:

- Describes the goods and services so that an English speaker can understand what they are, even if the grammar or phrasing is not optimal.
- Conforms to the standards (though not necessarily the language) in the Trademark ID Manual.
- Does not merely name a class heading, which is too broad a description, for example:
 - pharmaceuticals (Class 5);
 - jewelry (Class 14);
 - leather goods (Class 18);
 - clothing (class 25);
 - telecommunications services (Class 38); and
 - transportation and storage services (Class 39).
- Lists goods and services in the correct classes, specifically:
 - there is no language in the identification that makes classification difficult or ambiguous; and
 - each class lists goods or services that are clearly in a single class.

(TMEP § 1402.01(a).)

USE-IN-COMMERCE REQUIREMENTS

A 1(a) or use-based application must also include, for each class of goods or services in the application:

- The date of first use in commerce (see The Date of First Use in Commerce).
- The date of first use anywhere (see The Date of First Use Anywhere).
- A specimen of use (see Specimen of Use).

The Date of First Use in Commerce

This is the date that the applicant first used the mark in commerce as a trademark or service mark on or relating to the specified goods or services. Under the Lanham Act, commerce means all commerce that Congress may regulate (15 U.S.C. § 1127). This is a broad term that includes:

- Interstate commerce.
- Commerce between the US and a foreign country.
- Intrastate commerce that affects interstate or foreign commerce.

(TMEP § 901.03.)

The Date of First Use Anywhere

The applicant must also include the date of first use of the mark anywhere. This is the date of the applicant's first use of the mark anywhere on or relating to the specified goods or services. The two use dates are often, but not always, the same. For example, the applicant may have used the mark on goods sold exclusively outside the US before commencing use in interstate commerce. (See TMEP §§ 903.01 and 903.03.)

For more information on use to support registration generally, see Practice Note, Proving Trademark Use and Priority: Trademark Use to Support Registration ([W-011-1948](#)).

Specimen of Use

An application based on use must include a specimen showing the mark as actually used in connection with each class of goods or services. The applicant must represent that it has used the applied-for mark in connection with all the goods or services in the application (see Verified Statement or Declaration), but needs to submit a specimen showing use in connection with only one good or service in each class.

The filer generally submits copies or photos of the specimen and retains the original for the file (see 37 C.F.R. § 2.56(c)). For applications filed electronically, the specimen must be submitted in JPG or PDF format (37 C.F.R. § 2.56(d)(4); TMEP § 904.02(a)).

Acceptable specimens of use for goods typically include:

- Tags.
- Labels.
- Photographs of the goods displaying the mark.

For services, acceptable specimens may include:

- Advertisements.
- Correspondence displaying the mark and referring to the service.
- Web pages showing the mark and referring to the services.

For more examples of appropriate specimens for different goods and services, see Trademark Acceptable Specimen Chart.

The specimen must:

- Be legible.
- Show use of the mark in commerce.
- Depict the mark in the application drawing (see Drawing or Depiction). Only insignificant differences, such as the inclusion of

the “TM” symbol or net weight information on the specimen, are typically allowed (see TMEP § 807.12(a)).

- If for services, show the mark being used in a way that demonstrates a direct association between the mark and the services. A business card or letterhead, for example, typically must indicate what services are being offered under the mark.
- Not be a photo of the drawing.
- Not depict the mark as mere ornamentation, for example, a depiction of the mark as a graphic on the front of a t-shirt.

Although the USPTO generally requires only one specimen per class of goods or services, even if there is more than one good or service listed in the application for that class, the examining attorney may issue an office action and request additional or substitute specimens if:

- The range of goods or services in a class is broad or the class contains unrelated items.
- The specimen is of an unusual type.
- The submitted specimen is insufficient, for example if:
 - the mark depicted in the specimen differs from the drawing in the application; or
 - the specimen is prospective, such as a webpage for pre-sale ordering of goods that are not yet available.

Therefore, if the sufficiency of the specimen is in doubt or if the nature of the specimen is unclear, the filer should consider:

- Providing an explanation. In the online form this can be done in the space provided for either:
 - the description of the specimen; or
 - the miscellaneous statement.
- Submitting extra specimens (more than one per class).

VERIFIED STATEMENT OR DECLARATION

The applicant (or an authorized representative, see Persons Authorized to Sign Application) must date and sign the declaration at the end of the application. In the declaration, the applicant represents, among other things, that:

- To the best of its knowledge and belief, the facts in the application are true.
- It believes it is the owner of the mark, and to the best of its knowledge and belief no other entity has the right to use the applied-for mark or any similar trademark in commerce relating to the identified goods or services. (Subsidiaries and licensees should not be listed as exceptions to this statement.)
- If a use-based application:
 - the mark is in use in commerce on or in connection with the claimed goods and services; and
 - the specimen submitted with the application shows the mark as used on or in connection with the claimed goods and services.
- If an ITU application, the applicant has a bona fide intent to use the mark in commerce on or in connection with the claimed goods or services.

(See TMEP § 804.02.)

The online forms require applicants to tick a separate checkbox next to each averment to draw attention to the significance of each specific statement.

The declaration also includes language for the applicant to acknowledge the penalties for filing false statements, which may include invalidation of the application (TMEP § 804.01(b)).

If the applicant submits a use-based application without a verification, the trademark examiner issues an office action requesting that the applicant submit a verified statement that relates back to the original filing date.

Persons Authorized to Sign the Declaration

The declaration can be signed by the applicant or someone properly authorized to verify facts on the applicant’s behalf, which can be one of the following:

- A person with legal authority to bind the applicant (for example, a corporate officer or general partner of a partnership).
- A person with firsthand knowledge of the facts and actual or implied authority to act on the applicant’s behalf.
- An attorney with actual written or verbal power of attorney or an implied power of attorney from the applicant.

(37 C.F.R. § 2.193(e)(1); TMEP § 611.03(a).)

With electronic filings, typically counsel prepares the application before either signing the declaration or choosing the option to have the application emailed to the applicant for signature. If counsel selects the email option, the USPTO sends counsel an email with a link to the form for signature, which counsel forwards to the signing party for electronic signature. After signing, the USPTO notifies counsel and counsel finalizes the application and submits the necessary filing fee (see Filing Fee).

Additional Statements

The online application form has an option for additional information that does not apply in all circumstances. The filer may enter the information or provide it later in response to an office action, including, if applicable:

- Prior registration claims, if the applicant owns registrations for the same or similar marks that are listed under a different owner (TMEP § 812).
- An identification of any living individual named or depicted in the mark and information about consent (TMEP § 813).
- A translation or transliteration of the mark. Any non-English words must be translated and non-Latin characters translated and transliterated. (TMEP § 809).
- The meaning or significance of technical, geographic, or unusual terms in the mark. Under 37 C.F.R. § 2.61, the applicant must furnish additional information that may be reasonably necessary for the examination of the application.
- A claim of acquired distinctiveness under Section 2(f) of the Lanham Act (15 U.S.C. § 1052(f)). Some types of marks, such as color marks and product configuration marks, can never be inherently distinctive and require a 2(f) showing of acquired

distinctiveness before they can be registered. However, a 2(f) claim is a concession that matter is not inherently distinctive (TMEP § 1212.02(b)). Therefore, for marks that do not lack inherent distinctiveness presumptively, the applicant may prefer to wait for the trademark examiner to raise the issue in an office action. The applicant can then argue that the mark is inherently distinctive, raising the 2(f) claim only in the alternative (see TMEP § 1212.02(c)).

FILING FEE

The filing fee is based on the type of application and the number of classes covered (see Filing). It must be paid when the application is filed (see Box, USPTO Filing Fees).

The USPTO accepts several forms of payment, but applicants and their counsel should consider setting up a deposit account with the USPTO. USPTO deposit accounts are pre-paid fund reserves that applicants can use to pay fees to the USPTO. A deposit account is useful for:

- Eliminating the need to send separate payments each time a fee is required.
- Preventing delays in filing the application due to a miscalculation in the necessary fees.

A deposit account application can be completed on the USPTO website. Deposit account holders must specify the individual users authorized to use the account and maintain a minimum monthly balance of \$1000 to avoid service charges.

FILING AND PROSECUTING THE APPLICATION

FILING OPTIONS

Applications can be filed either:

- Online using the USPTO's Trademark Electronic Application System (TEAS).
- In paper form, by mail or hand delivery to the relevant address. However, the USPTO has stated a preference for electronic submissions and has proposed eliminating paper filing except under certain limited circumstances (see 2018 WL 2414979, 83 Fed Reg. 24701-01 (May 23, 2018)).

There are three formats for submitting an application using TEAS:

- TEAS Regular (see TEAS Regular).
- TEAS Reduced Fee (RF) (see TEAS RF).
- TEAS Plus (see TEAS Plus).

An applicant must submit the relevant filing fee per class of goods or services claimed in the application (see Filing Fee).

TEAS Regular

This is the traditional on-line application, which has the highest application fee but none of the additional requirements of TEAS Plus or TEAS RF.

TEAS RF

TEAS RF, which costs less than a regular TEAS application, requires applicants to:

- Provide an email address and agree to communicate with the USPTO regarding the application by email.

- File additional application-related submissions using TEAS, including amendments, office action responses, and statements of use.

(37 C.F.R. § 2.23; TMEP § 820.)

The application becomes a regular TEAS application and the USPTO charges a per-class processing fee if:

- The initial application does not meet the TEAS RF requirements.
- The applicant files on paper any of the later submissions required to be filed electronically.
- The applicant stops allowing application-related correspondence with the USPTO by email.

(TMEP § 820.04.)

TEAS Plus

This option has the lowest filing fee but the strictest requirements for qualification. In addition to complying with the TEAS RF filing requirements, TEAS Plus applicants must:

- Select the goods and services for the application from the list of pre-approved descriptions in the Trademark ID Manual.
- Include in the application additional statements under certain circumstances, for example when the mark includes:
 - color;
 - a design or stylized font;
 - non-English words;
 - non-Latin characters; or
 - the name or likeness of a living person.

(For a complete list of TEAS Plus requirements, see 37 C.F.R. § 2.22 and TMEP § 819.01.)

If an applicant files a TEAS Plus application without the required information, the USPTO imposes an additional TEAS Plus processing fee of \$125 per class and examines the application as a regular TEAS application.

However, a TEAS Plus application generally can be amended without losing TEAS Plus status if:

- In the initial application, the applicant made a reasonable attempt to supply the required information.
- The amendment is made using TEAS or by an examiner.

(TMEP § 819.01.)

The USPTO maintains a chart on its website for comparing the filing requirements and fees for each of these options.

THE FILING RECEIPT

If the application includes all the necessary information and the appropriate filing fee, the USPTO assigns a serial number to the application and issues a filing receipt that includes a summary of the filed information. The applicant and applicant's counsel should:

- Ensure the summary is correct.
- Keep the receipt as a record of the application's filing date.
- Contact the USPTO immediately if there are discrepancies between the information filed in the application and the information included on the receipt.
- Docket deadlines for checking the status of the application.

CHECKING THE APPLICATION'S STATUS

Applicant or counsel can use the application serial number to search for the application on the Trademark Status and Document Retrieval (TSDR) system, which houses documents filed in connection with pending and registered marks and includes a “status” button. Applicants should check the status of the application every three to four months and notify the USPTO immediately if a filing or correspondence from the USPTO has gotten lost. A failure to monitor an application may be held against the applicant if there is ever a need to petition to revive an application that has been deemed abandoned (see Notice of Abandonment).

OFFICE ACTIONS

After receiving a trademark application, the USPTO assigns it to an examining attorney for review, which typically takes about three to six months. Once the review is complete, the examiner issues either:

- A Notice of Publication (see Publication), which signifies that the application meets all formal requirements for registration and the examining attorney has approved the mark for publication.
- An office action, a letter refusing registration of the applied-for mark and setting out the bases for the refusal.

While some applications may be approved on initial review, it is more common for an examiner to issue an office action. Common objections in office actions include:

- Defects in the formal application requirements, for example, that the specimen does not match the drawing of the mark.
- Ineligibility for registration, for example, that the product or package design elements are functional or purely decorative.
- One of the grounds for refusal under 15 U.S.C. § 1052(e), such as descriptiveness or that the proposed mark is primarily merely a surname.
- A likelihood of confusion with a previously registered or applied-for mark.

After receiving an office action, the applicant must respond and address each issue raised in the office action within six months. For more on the office action process generally, see Practice Note, Trademark Office Actions: Responding to an Office Action ([5-618-2261](#)). For additional resources on trademark office actions, including sample arguments for specific refusals, see Trademark Office Action Response Toolkit ([W-012-4902](#)).

After the applicant files a timely response to a non-final office action, the trademark examiner then issues either:

- A notice of publication or notice of allowance.
- Another (typically final) office action, if the examining attorney does not believe the refusals have been overcome and there are no new issues. If the applicant's response to a final office action is not successful, the applicant can request reconsideration of the refusal and then appeal the examiner's decision to the Trademark Trial and Appeal Board (TTAB) and, ultimately, a US federal court (see Practice Note, Trademark Office Actions: Responding to an Office Action: Options When Facing a Final Refusal ([5-618-2261](#))).

Notice of Abandonment

If the applicant does not submit a timely response to an office action, the application is considered abandoned. The USPTO issues a Notice of Abandonment and takes no further action on the application. Though it may sometimes take several months for the notice to issue, the application is considered to be abandoned as of the day after the date on which the office action response was due.

If the delay in responding was unintentional, the applicant may file a petition to revive the application, along with the required fee (see Box, USPTO Filing Fees) within two months of either:

- The Notice of Abandonment date.
- The date of actual knowledge of the abandonment, where the Notice of Abandonment was not received (if it is no later than six months after TESS reports the abandonment).

(37 C.F.R. § 2.66; TMEP § 1714.01(d).)

If the application is not revived but the applicant is still interested in registering the mark, the applicant needs to file a new application.

PUBLICATION

If an application survives the examining attorney's review without being rejected or abandoned, the USPTO publishes the mark in its *Official Gazette*. The *Official Gazette* lists each mark that has been approved for publication along with application information, including the applicant's name, a drawing of the mark, and the covered goods and services. The *Official Gazette* is published weekly and available online only.

OPPOSITION

When a new mark is published, any party that believes it would be damaged by the mark's registration on the Principal Register can, within 30 days after publication:

- Oppose the mark by filing a Notice of Opposition with the TTAB.
- Request an extension of time to oppose the mark for an additional:
 - 30 days, which the party may obtain as of right; or
 - 90 days, which the party may obtain on representation of good cause.

(15 U.S.C. § 1063(a).)

An opposition proceeding is similar to litigation in civil court but is conducted before the TTAB and subject to the TTAB's specific procedural rules (see Practice Note, TTAB Oppositions and Cancellations: Practice and Procedure ([3-515-0752](#))). Most oppositions are settled by agreement of the parties.

If the parties settle, the opposition can be dismissed and, depending on the terms of the settlement, the mark at issue may still be registered. Adverse TTAB decisions may be appealed to the US Court of Appeals for the Federal Circuit or to a federal district court. For more on TTAB opposition proceedings, see TTAB Proceedings Toolkit ([W-002-4620](#)).

If no opposition is filed against an application or a filed opposition is unsuccessful, depending on the filing basis, the USPTO either:

- Issues a Notice of Allowance (NOA), if the application was based on an intent to use (see Notice of Allowance).
- Registers the mark and issues a certificate of registration, if the application was based on use (see Certificate of Registration).

NOTICE OF ALLOWANCE

If an ITU application survives examination and opposition, the USPTO issues a Notice of Allowance. To obtain the registration as published, within six months from the date of the NOA the applicant must file a statement of use (SOU) with acceptable evidence of the mark's use in commerce on or in connection with the goods and services listed in the application.

The complete SOU must include:

- The appropriate SOU filing fee for each class of claimed goods or services.
- One specimen per class of the mark as used in commerce.
- A verified statement or declaration (see Verified Statement).

(TMEP § 1109.06.)

If the applicant has not used the mark in commerce, it may submit a request for a six-month extension of time to file a SOU along with the appropriate fee. The applicant is allowed to request a total of five six-month extensions. Each request must be filed before the end of the previous six-month period. (TMEP § 1108.)

An extension request can apply to all or just some of the goods and services in the application. The USPTO deletes from the application any goods and services not covered by the statement of use or any extension of time (TMEP § 1108.02(d)). The applicant can also file a request to divide the application, for those goods and services not yet used in commerce (TMEP § 1109.03).

After reviewing the SOU, the examining attorney either:

- Approves the SOU. Typically within two months of the SOU's approval, the USPTO registers the mark and issues a certificate of registration (see Certificate of Registration).
- Issues an office action with grounds for refusing the SOU. The applicant must then respond to the office action to keep the application alive (see Office Actions).

The application is considered abandoned if the applicant:

- Does not file an SOU or a timely request for an extension.
- Files an SOU but does not timely respond to or address all the issues in a resulting office action.

(TMEP §§ 1108.01, 1109.04.)

CERTIFICATE OF REGISTRATION

If a mark proceeds to registration, the USPTO mails the mark owner or its representative a certificate of registration. A certificate of registration is the official document issued by the USPTO evidencing the mark's registration and includes key information about the mark including:

- The owner's name and address.
- A drawing of the mark.

- A description of the mark.
- The goods and services covered by the mark.
- Filing and first use dates.
- The registration date.

Upon receiving the certificate of registration, counsel should:

- Make copies of the certificate and store the original in a safe place.
- Review and confirm the accuracy of the information recorded on the certificate.
- Promptly notify the USPTO of any mistakes.
- Inform the client that the certificate has been received. For a sample letter informing the client of the registration, see Standard Document, US Trademark Registration: Client Reporting Letter ([8-518-0389](#)).

MAINTAINING THE REGISTRATION

REQUIRED FILINGS

After the registration issues, the registration owner must file specific documents (and pay fees) at regular intervals to keep the registration valid, namely:

- Every sixth year and tenth year, either:
 - a Declaration of Continued Use, accompanied by a current specimen of use; or
 - a Declaration of Excusable Nonuse.
- ((15 U.S.C. § 1058). These are also called Section 8 Declarations or Affidavits. For more details, see Practice Note, Maintaining Trademark Registrations: Affidavit of Continued Use or Excusable Nonuse Under Section 8 or 71 ([W-001-5078](#))).
- Every tenth year, a Renewal Application (also called a Section 9 Renewal Application) (15 U.S.C. § 1059). For more details, see Practice Note, Maintaining Trademark Registrations: Renewal Application Under Section 9 ([W-001-5078](#)). The renewal is combined with the Section 8 Declaration that is due the same year.

Failure to file either the Section 8 or 9 Declarations results in cancellation of the registration.

OPTIONAL FILINGS

In addition to the required filings, the trademark owner may consider filing a Declaration of Incontestability if the mark has been registered and in use for at least five consecutive years (15 U.S.C. § 1065). Incontestability status offers many advantages, including that third parties can no longer challenge:

- Ownership of the trademark.
- The mark on the basis that it is merely descriptive of the goods or services or was improperly registered.

For more details, see Practice Note, Maintaining Trademark Registrations: Affidavit of Incontestability Under Section 15 ([W-001-5078](#)).

A Declaration of Incontestability (also called a Section 15 Declaration or Affidavit) may be filed together with the Declaration of Continued Use, the Renewal Application, or both.

A trademark owner may also need to amend its registration, for example, to delete certain goods in connection with which the mark is no longer in use or record a change in the registration's ownership (see Practice Note, Maintaining Trademark Registrations: Amendments ([W-001-5078](#)) and Changes in Ownership ([W-001-5078](#))).

For more information about maintaining a federal trademark registration, generally, see Practice Note, Maintaining Trademark Registrations ([W-001-5078](#)).

USPTO CONTACT INFORMATION

The USPTO provides extensive information on trademarks on its website, including:

- **General information:** General information on the trademark application process is available on the USPTO's Trademarks home page. Questions not answered on the website can be emailed to TrademarkAssistanceCenter@uspto.gov or posed by telephone to the Trademark Assistance Center at 1-800-786-9199.
- **Instructions on how to use the electronic forms or resolving technical issues:** Counsel may request information by email to TEAS@uspto.gov. Counsel should include a telephone number and, if existing, the relevant serial number or registration number.
- **To check application status:** Counsel can check online at TSDR or by calling the Trademark Assistance Center at 1-800-786-9199 (or 571-272-9250).

USPTO FILING FEES

The chart below sets out the USPTO's required fees, per class of goods or services, for filing certain trademark registration and maintenance documents. The fees are subject to change. The USPTO provides a full fee schedule online.

Description	Fee (per international class of goods or services)
Application for Registration	TEAS Plus Application (has stricter requirements than the regular TEAS Application): \$225 TEAS RF Application (reduced fee): \$275 TEAS Application: \$400 Paper Application: \$600
Amendment to Allege Use	\$100 (\$200 for a paper filing)
Statement of Use	\$100 (\$200 for a paper filing)
Extension of Time to File a Statement of Use	\$125 (\$225 for a paper filing)
Section 8 Declaration of Continued Use and/or Excusable Nonuse	\$125 (\$225 for a paper filing) (additional \$100 or \$200 (paper) fee applies for filing in grace period)
Section 15 Declaration of Incontestability	\$200 (\$300 for a paper filing)
Section 9 Renewal Application	\$300 (\$500 for a paper filing) (additional \$100 or \$200 (paper) fee applies for filing in grace period)
Petition to Revive	\$100 (\$200 for a paper filing)

***All fees listed are for electronic filing unless otherwise noted.**

ABOUT PRACTICAL LAW

Practical Law provides legal know-how that gives lawyers a better starting point. Our expert team of attorney editors creates and maintains thousands of up-to-date, practical resources across all major practice areas. We go beyond primary law and traditional legal research to give you the resources needed to practice more efficiently, improve client service and add more value.

If you are not currently a subscriber, we invite you to take a trial of our online services at legalsolutions.com/practical-law. For more information or to schedule training, call **1-800-733-2889** or e-mail referenceattorneys@tr.com.