

EXPERT OPINION

So, you want a trademark. What does the timeline look like? | IP Frontiers

■ KATELIN SCHAUB [SPECIAL TO THE DAILY RECORD](#)



Katelin Schaub

First, why should you file for a trademark? The Lanham Act created a national system for trademark registration. Federal trademark registration with the United States Patent and Trademark Office (USPTO) has several benefits including: public registration of your mark in the USPTO databases providing public notice to other, and legal presumption that you own the mark and have the right to use it. Trademark protection can also potentially last forever.

STEP 1: THINK ABOUT WHAT YOU WANT TO PROTECT. DO YOU WANT A TRADEMARK?

Before starting the trademark registration process, consider if a trademark is the type of intellectual property that you want. A Trademark protects a word, phrase or design that functions as a brand or logo to identify goods or services you offer. The trademark identifies these goods or services

as originating from your company and helps differentiate you from competitors.

Once you have decided you do in fact want trademark protection, think about the trademark you want registered and ask yourself the following questions:

- Are you currently using your mark in connection with goods and services or will you be in the future?
- Is your trademark distinctive?
- Does your trademark do more than just describe a functional component of the goods?

For federal protection in the United States a trademark must be used in commerce, be distinctive and not be merely a functional feature of the goods and services that you are offering. However, even if you are not currently using your trademark you can still proceed with filing out and filing an application on an intent-to-use basis.

STEP 2: PREPARING AND FILING OF APPLICATION. DO YOU NEED AN ATTORNEY?

The next step is preparing and filing your trademark application.

If you are a business or person who does not reside in the United States, you will need a U.S. licensed attorney to help you. Even if you do live within the United States, an attorney with experience in trademark law can still help you with the filing process.

In the process of filing an application, an attorney or applicant themselves will likely conduct a trademark knockout search. This involves searching the USPTO trademark database for any trademarks that are confusingly similar to yours, considering how the marks look, sound, what the trademarks mean, the marks' commercial impression, and whether the goods and services in connection with the mark are similar to yours. Depending on the outcome of the search, you will have a better idea of the potential success or failure of your application.

STEP 3: USPTO REVIEW OF THE APPLICATION.

After your application is filed, the USPTO will assign an examining attorney to examine your application. The examining attorney will review your application for

compliance with all rules, statute and fees, and do a search for other trademarks that may conflict with yours. This process usually takes a little over four months to get a response from the USPTO. Currently the USPTO is reviewing applications submitted from Mid to late March of 2026.

If the examining attorney has no objections to the registration, the trademark will be published in the Trademark Official Gazette. After publication, other parties have thirty (30) days to file an opposition proceeding to attempt to prevent your mark from registering.

An opposition proceeding is similar to a court proceeding except that it is in front of the Trademark Trial and Appeal Board, it is based on a written record, and the issue is solely if your mark can register. A potential opposer can file an extension to file an opposition, but in no case can an opposition be filed beyond one hundred and eighty (180) days after when the mark was published in the Trademark Official Gazette.

STEP 4: RESPONDING TO A REFUSAL OF YOUR APPLICATION.

If the examining attorney does refuse to register your mark, they will send you a letter explaining why they have refused to register your mark. This is known as an Office Action. You or your attorney may submit a response to this letter addressing all of the reasons for refusal to register. You have three months to respond to the office action, or the application will be abandoned. However, you

can receive an additional three-month extension (for a total of six months) for an additional fee.

If your response fails to overcome the refusals, the examining attorney will issue a final office action. You can respond to the final office action by either replying and overcoming the refusal or by appealing to the Trademark Trial and Appeals Board.

STEP 5: AFTER APPROVAL OF YOUR TRADEMARK.

If you submitted a trademark application based on current use in commerce, the USPTO will issue a registration certificate.

If you filed an intent-to-use application, you will receive a notice of allowance about eight weeks after the date the trademark was published. You then have six months from the notice of allowance to submit a statement of use or request a six-month extension of time to file a statement of use. A statement of use includes a fee, at least one example of the mark as used in commerce and a verification signed by you stating that the mark is used in commerce. The examining attorney then reviews your statement of use for potential refusals, repeating the same process as above. If the statement of use is approved a registration will be issued within approximately two months.

STEP 6: AFTER REGISTRATION: WHAT ARE THE UPKEEP OBLIGATIONS?

Once your mark is registered you can begin using the federal trade-

mark registration symbol ® to show your mark is registered with the USPTO.

After registration there are some important maintenance documents that you need to file to keep your registration alive. Between the fifth and sixth anniversary of registration of your trademark, you may file a combined Declaration of Use and Incontestability under Sections 8 and 15 of the Lanham Act, if you have used your trademark continuously for five consecutive years after the date of registration. If you have not used the mark continuously you still need to file a section 8 declaration. Additionally, you need to file another section 8 declaration of use on or between the 9th and 10th anniversaries of your registration and every ten-year period after. If you fail to file a declaration of use, your trademark registration will be cancelled.

Further, you, the trademark owner, are responsible for enforcing your own rights. If you suspect that another pending trademark is infringing your mark, consider instituting an opposition proceeding. Alternatively for a registered mark you can petition for a cancellation, to remove another's trademark registration.

Katelin Schaub is an Associate and registered patent agent with the law firm of Heslin Rothenberg Farley & Mesiti P.C. Her expertise includes patent research, preparation, and prosecution. She can be reached at 518-452-5600 or katie.schaub@hrfm.