

BASIC STEPS FOR CLEARING AND REGISTERING TRADEMARKS AND ESTIMATED COSTS

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This summarizes the various steps involved in clearing, filing and obtaining federal trademark registrations in the United States Patent and Trademark Office ("USPTO").

We always recommend obtaining a full trademark search for clearing any mark for registration or use in the United States. We can conduct a preliminary search of the federal trademark register on an on-line basis, and usually the fees associated with such a preliminary search are less than \$300, plus online charges usually less than \$75. If you opt to conduct a full search, it will include all federal, state, and common law usages of similar trademarks or business names. If we only conduct a preliminary on-line search which only covers federal trademark applications and registrations, there is a chance that any clearance will not be complete without evaluating the state trademark registrations. Further, common law rights may exist to allow other companies to preclude your use of a particular mark in a geographic area where a similar mark had previously been used by a senior user. An owner of a common law mark could possibly sue you for an injunction and/or damages. A preliminary on-line search does not cover these common law usages, which puts any recommendation we make at risk of being incomplete or inaccurate. If we run a full search, the cost of the search is \$495 on a normal turnaround (meaning delivery of the search to us in 5-7 business days). It usually takes about two hours to review the search and prepare our recommendations, which equates to about \$700 in attorneys fees. Thus, the cost of conducting only a preliminary search for a single mark in total is about \$375 and the cost of a full search with an opinion is about \$1200.

Each time we prepare and file a new federal trademark application, the cost is based on our hourly fees, meaning how long it actually takes us to draft up the documents. As we now conduct our business with the United States Patent and Trademark Office via electronic filings, you do not need to sign any paper documents, and your written authorization to proceed with any filing via email will suffice to proceed with any filings during our representation of your company. If we do more than one application (several different marks, a word mark and a logo, or a mark in various classes of goods or services) at the same time, there's usually a significant reduction in our hourly fees, as we are preparing similar types of documentation for all the filings (about 1/3 of the attorneys fees are saved in multiple filings).

The United States Patent and Trademark Office charges \$335 for the government filing fee per class of goods or services sought to be covered in the application. Based on the International Trademark Classification System, there are 45 different classes of goods and services categorized by function or similar features, such as clothing and shoes in International Class 25, games, toys and sporting goods in International Class 28, etc. When we prepare one application, our fees are generally around \$600. Again, if we are doing more than one at the same time, the per-application preparation cost in attorney's fees goes down to about \$400. The fees associated with the prosecution (as outlined below) normally run about \$500 per application during the next year of time for handling all the little steps involved during the application's processing. Most of these processing steps are handled by a qualified paralegal to further reduce your attorney's fees.

Generally, the cost breakdown to obtain a federal registration is approximately \$2500-\$2800 spread out over about a year and a half per basic application for a single mark in one class of goods/services. This cost is reduced by about a third for each application when multiple applications are filed at the same time. This amount does not include any allowance encountering significant problems or rejections during the mark's prosecution at the USPTO, or if it is opposed by a third party after publication.

The following is an outline of the various steps involved in obtaining a federal trademark registration, and the estimated costs associated with each procedure:

Steps for Trademark Registration:

1. Search and clear proposed mark - we give you an opinion as to the mark's registerability - (approximately \$900 - \$1200 for full search with opinion);
2. Prepare and send a letter of engagement and power of attorney to you for signature. Once you have signed and sent it back to us, we immediately file the federal application via electronic filing (1 Class approximately is \$925; add \$335 per each additional class of goods or services);
3. USPTO sends us a Filing Receipt upon receipt of our electronic filing. We will send an email or letter (at your preference) to you advising of filing information, serial number and filing date (\$50-75);
4. Application awaits review by Examining Attorney for 6-8 months. We do nothing during this time frame until we receive an official action and you incur no additional costs, absent any mistakes by the United States Patent and Trademark Office;

5. Official Action issues from Examining Attorney with substantive and procedural review about 6-8 months after filing date. We review the official action and prepare a letter to you advising you of the government's requirements. Normally we expect some sort of action by the Examining Attorney, such as a request to modify the identification of goods/services to specifically identify the products or services sought to be registered. If we previously advised you of any potential risk of rejection based on a previously registered mark, or the descriptiveness of the wording in the mark, this is when we will be advised of any substantive basis for a rejection. We will also let you know what we recommend for proceeding with a response to the Examining Attorney. (\$300-\$400, depending on severity of any rejection);

6. Response to Office Action prepared and filed within six months of issuance of Official Action. As indicated above, it can be as minor as a statement of goods amendment or it can be very difficult rejection based on a prior registration, the descriptiveness of the mark, etc. Because of the various types of Official Actions, the cost can range dramatically, depending on the type of official action. (\$100-1000);

7. Application is rejected or approved based on review of response in 3-6 months. If rejection is continued or made final, another response with arguments can be presented to the Examining Attorney;

8. If any arguments are successful, the application is passed to publication;

9. Application is allowed and the USPTO sends us a Notice of Allowance if the Mark is not opposed by any third party within 30 days after publication (or files an extension within such 30 day period);

10. If Application was filed on the basis of an intent to use in commerce, then a Statement of Use must be filed within 6 months. If use has not commenced, an Extension of Time to File a Statement of Use can be filed for each subsequent 6 month period, along with the payment of a government extension fee (\$150 government extension fee for each 6 month period per class of goods/services plus \$200 in fees or \$200 per class government fee with about \$300 in our fees for preparing and filing the actual Statement of Use);

11. USPTO issues registration certificate. CONGRATULATIONS, YOU NOW OWN A FEDERAL TRADEMARK REGISTRATION!!! We check it for accuracy, calendar the future actions for providing a declaration of use and renewal. We send you the registration certificate with a letter containing information about such required future actions (about \$150);

12. 5 YEARS LATER - after Registration Date - Declaration of use of mark on all goods/services identified in the registration is required to be filed between 5th and 6th year anniversary of registration, otherwise the registration will lapse (\$300 per class, plus about \$250 in attorneys fees for preparing and filing required documentation); and

13. 10 YEARS LATER - after Registration Date - Renewal is required to be filed with proof of continued use of the mark on goods/services (\$300 per class, plus about \$250 in attorney's fees for preparing and filing required documentation).