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Trellis Legal, LLC

5149 Butler St., Suite 300, Pittsburgh, PA 15201

www.Trellispgh.com

4 Essential Steps to Filing a Trademark Application

DISCLAIMER: This outline is a general guide. Be sure to contact an attorney if you have questions or specific issues that need to be addressed.

The trademark application process is filled with hidden obstacles. The form itself appears simple, but there is a lot that should go on behind the scenes before filling the application out. Hopefully this list gives you a better idea of what to expect.

1. Determine if a Trademark is Right for You

The very first step you should take in the process is confirming a trademark is what you're looking for, or maybe a copyright is more appropriate? Check out our blog post on the difference between [Trademarks v. Copyrights](#).

After you've determined a trademark is appropriate because you want to secure your brand, the next step is to determine whether your mark functions as a trademark. What does this mean? Well, a brand name, logo, or slogan only functions as a trademark if it is a clear indicator of the goods and services of a specific company. Trademark law often relies on the below spectrum to determine how likely a mark functions as a trademark, and further, the likelihood of successfully registering the mark. The spectrum goes from the weakest marks (**generic**, examples: Tree Cutters, Cold Ice Cream, Hair Cutters, etc.) to the strongest marks (**fanciful**, examples: Kodak, Clorox, Google).

Generic—Descriptive—Suggestive—Arbitrary—Fanciful

2. Pick a Class(es)

Once you've determined your mark functions as a trademark (or you and your attorney have a good argument in place), the next step is to determine what class(es) you should apply under. Classes are categories and help organize the trademark system so that the same or similar word,

logo, or slogan can be registered if goods and services are different. For example, Dove chocolate and Dove Hygiene products can co-exist as trademarks because they are in different classes (Class 30: Chocolates v. Class 3: Soaps). There are a total of 45 different classes and they can be found here: [USPTO-Goods and Services](#). It's best to apply under the most amount of classes to get trademark protection in all aspects of your business.

3. Search and Strategy

Did you know that approximately 50% of trademark applications are rejected? The main reason for this is the applicant does not conduct/receive this essential step (most online legal services don't conduct a proper search). This is why it is so important to consult a trademark attorney to prepare your application.

Most trademark attorneys (including me, hi!), conduct a knockout search themselves aka a human search. If no direct hits are found in the knockout search, the TM attorney requests a comprehensive search from a third-party vendor. The third-party has advanced search tools and conducts a search of the entire U.S. Trademark database and beyond, including state registrations and common law sources to find confusingly similar marks. While the report provides a list of all similar marks (typically it is a few hundred-few thousand pages long), a trademark attorney is experienced in reviewing the marks and advising on the best strategy for success. Some of the things trademark attorneys look for when reviewing search reports are whether there are confusingly similar marks and, if so, whether there are any arguments that can be made to combat a future office action. We will often look through similar marks' files and history, along with reviewing case law for helpful guidance. To learn more about the trademark search process, check out our blog post [Don't Rely on Luck to Register Your Trademark](#).

4. File Application

The final step is to prepare and submit an application with the United States Trademark and Patent Office! The typical wait time for a trademark application to be processed is between 12-18 months, so it's best to file your trademark application once you choose your business name or as soon as possible! In the meantime, make sure to add the TM symbol next to your name, logo, or slogan to protect your rights.

If all these steps are properly followed, you have a good chance of successfully registering your mark. Unfortunately, most online legal service platforms do not conduct a search or even advise on which classes to apply for; they simply have you provide information needed for the trademark application and apply with no preparation. Because your brand is arguable your biggest asset, we advise anyone applying for a trademark to consult with a trademark attorney.

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