

How to Register a Trademark in the U.S.

April 15, 2017 | Ufuoma Akpotaire

In the U.S., registering your trademark with the United States Patent and Trademark Office (USPTO) allows you to enjoy federal law protection for your brand.

1. What types of trademark applications may be filed in the U.S.?

The USPTO accepts applications for registration of traditional marks (word, design, and combination marks) and nontraditional marks (color, shape, sound, scent, flavor, touch, and motion marks). In addition, an applicant may file a trademark application for collective or certification marks.

2. How are applications filed?

The USPTO encourages applicants to take advantage of its online filing platform, **TEAS** (Trademark Electronic Application System). The USPTO states that over 95 percent of trademark applications are filed electronically and offers applicants discounts for using the online system.

3. On what basis can a trademark application be filed in the U.S.?

An applicant can file an application based on use, intent-to-use or foreign application or registration.

- A **use-based application** may be filed if the applicant is already using the mark in U.S. commerce at the time the application is filed with the USPTO. This type of filing is in accordance with Section 1(a) of the Lanham Act, 5 U.S.C. § 1051(a).
- An applicant may also choose to file an **intent-to-use application**. By filing an intent-to-use application, the applicant is stating that there is a genuine intent to use the mark in the United States sometime in the future. This type of filing is allowable in accordance with Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b) however applicants need to be aware that the mark will not be registered until the applicant proves use.
- A **foreign applicant** who has a genuine intention to use the mark in commerce and who has filed an application to register, or has registered, the mark in his country of origin may file an application under Section 44 of the Lanham Act, 15 U.S.C. § 1126.

4. What information would an applicant need to provide to begin the filing process?

- The name of the applicant; the type of legal entity e.g. is the applicant an individual or a company.
- Citizenship, state or country of incorporation.
- Name and address for correspondence. For foreign applicants, a designation of a Domestic Representative.
- The applicant must also provide the basis for filing e.g. use in commerce or intent-to-use. The applicant will need to submit a specimen of use showing the mark as it is actually used in commerce.
- For design and other nontraditional marks, a drawing of the mark.
- A listing of the goods and/or services that are or will be sold or offered in connection with the mark.
- If any part of the mark is not in roman characters or requires translation, the applicant must provide an English translation or transliteration of any non-English words in the mark.
- For marks other than standard character word marks, a description of the mark.
- The filing fee for at least one class of goods or services. A filing fee for one class of goods and/or services covered by the application is required. Fees may vary depending on how the application is filed.
- For use-based applications, the applicant must provide dates related to the first use of the goods and/or services in the application before the mark can be registered. These include:
 - (i) the date of first use anywhere, and
 - (ii) the date of first use in interstate commerce or commerce that the U.S. Congress may regulate (commerce across state lines, within a territory of the United States (Guam, Puerto Rico, etc.), or between the United States and another country). For many applicants, these dates will be the same.
- A verified statement signed by one of the following persons: (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; (3) an attorney who has an actual or implied written or verbal power of attorney from the applicant.

5. How long does the entire registration process typically take?

Generally, if there are no substantive objections or additional office actions, it takes approximately 12 months for a registration to issue for applications filed electronically. For paper applications, it sometimes takes much longer.



About Ufuoma Akpotaire > 311 Articles

Ufuoma is a Senior Editor and Director of Regulatory Policy at NLIPW. She assists clients in the protection of copyrights, trademarks and patents. She counsels clients regarding validity and infringement matters and has experience acting against the infringement of IP and addressing counterfeit issues. She holds a Masters degree (LL.M.) from Columbia Law School, New York and a law degree from the University of Nigeria (LL.B. Honors). She is admitted to practice law in Nigeria and in the State of New York. Ufuoma cut her teeth in the intellectual property practice groups of some of the largest law firms in Nigeria and has years of experience working with major non-profit organizations in New York. Email: uakpotaire@nlipw.com

