

# LIFECYCLE OF A TRADEMARK APPLICATION

Your trademark timeline and costs depend on the filing basis you select in your application. You are either *already using* the mark in interstate commerce or you are *planning to use* the trademark but are *not yet using it* in interstate commerce (*interstate* commerce means among several states).

## Trademark Budget

*“How do I protect my brand/ logo if I’m already using it in the marketplace?”*

- ✓ File a trademark application with the USPTO based on use.

*“What if I’m not yet using my brand/logo but plan to?”*

- ✓ File an intent-to-use (ITU) trademark application with the USPTO and then a declaration when you start selling.

*“What if I do not start using my brand /logo after the USPTO approves of my intent to use application?”*

- ✓ You can extend time to use such by paying a fee.

### COSTS:

USPTO Filing fee – each trademark – each good/service: \$250

Attorney fees for application and search: \$1,000 to \$1,500

TM Search report cost: \$100 to \$250

Plus (if ITU application):

Extend Time to Use fee: \$125  
or Allegation of Use filing fee: \$100

Paralegal fees to prepare Extensions: \$165

Attorney fees to prepare Declaration of Use (if ITU app): \$500

✓ TRADEMARK APPLICATIONS are filed electronically with the United States Patent and Trademark Office (USPTO). A trademark application is filed for a particular category of goods or services which the USPTO refers to as **Classes**. Each Class has a separate filing fee. A trademark application is filed for each trademark for each type of goods or services it is being used in. A trademark can be a word mark, design mark or a sound mark. Separate applications are required for a word mark and a design mark.

✓ INTENT TO USE. An application is filed on an *intent to use basis*, you will have 36 months to begin to file the mark after the USPTO approves the application and issues a **Notice of Allowance**. If you are not yet using the mark by this time in interstate commerce, every six months and for a period of 36 months, you may file a **Request for an Extension of Time**. However, if by the time of the Notice of Allowance deadline you are using the mark in commerce, there is no need to request an extension and an **Affidavit of Use** is filed instead.

✓ SPECIMENS. An Affidavit of Use must prove use of the *exact* mark filed on the *exact* products or services filed for and include product samples in order to be approved and obtain trademark registration. Digital product samples must be in correct USPTO format.

✓ TRADEMARK SEARCH REPORT. Prior to filing a new application and spending money on marketing, product manufacturing or use, a complete search for other’s using the mark in other states, domain names, business names and other common law (actual, but non-registered use) must be done. This is to evaluate potential conflicts preventing your use.

✓ TRADEMARK APPLICATION TIMELINE:

1. Research and **clear for trademark filing** availability and if available, file application.
2. **USPTO Examining Attorney review** – about 4 to 6 months after application filed and will allow the mark to

proceed to publication (if you are using the mark) *or* issues a Notice of Allowance (see above) *or* issues

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**Tamara L. Harper, a Professional Corporation.** *“Navigating You To Safe Harbors.”* **805-409-0530**

*Navigating entrepreneurs and businesses to safe harbors through the maze of business and employment laws, intellectual property protection, asset protection, legacy and estate planning and trust administration.*

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an Office Action (there may be a likelihood of confusion with another mark or is generic or descriptive, for example).

3. **Responding to USPTO Office Action.** There are many issues that we try to prevent by filing a good application, having excellent specimens of use and conducting the search report (see above). I cannot estimate the costs for responding to an Office Action since we do not know the extent of the Office Action or the grounds cited by the Examining Attorney, if any, or if there is even an Office Action issued. My **goal is to avoid them** if at all possible. If one is issued, I discuss and review the proposed budget first with you prior to responding. There is a **6 month time frame to respond** to such after issuance. Responding quickly moves the application along quicker.

4. If you are using the mark, or once Affidavit of Use is filed, the **mark publishes** in the USPTO Official Gazette. If no one in the world files an Opposition within 30 days (or requests an extension of time to do so) then the **mark proceeds to registration** about 3 to 5 months thereafter.

5. **Trademark Renewal – Post Registration.** Initial registration lasts 5 years. If you continue to use your trademark, you must declare such to be true and renew it between years 5 and 6 after registration and between years 9 and 10 after registration and again each 10 years thereafter. USPTO post registration fees at year 5 after registration are \$425 and at year 10 are \$525. These are the USPTO filing fees as of January 1, 2021. Note they may change in the future.



“THERE ARE MANY VARIABLES WHICH YOU DECIDE: WHEN YOU START USING THE TRADEMARK, HOW MANY TRADEMARKS TO FILE, & WHAT PRODUCTS OR SERVICES YOU ARE USING; ALL OF WHICH DICTATE FEES AND COSTS.”

These are the reasons why my retainer is an estimate only and provides a range or sets forth a retainer (as opposed to a flat fee). I can estimate how long it takes me to do the application and affidavits or extensions and advise you of the filing fee costs.

I appreciate your referrals and your

business and look forward to working with you and showing you ways to protect and maximize your wealth and discuss protecting your intellectual property and business as well as your personal assets!

I am passionate about protecting and educating my clients and offer checklists and worksheets to assist you, as well as articles that I frequently write about topics pertinent to you. I stay educated to be on top of developing issues relevant to estate planning, business, including employment laws, asset protection and intellectual property protection. **For more information about copyrights and trademarks, I have the following articles to share with you – just give us a call to ask for:**

- *Checklist for Maintaining Confidentiality of Trade Secrets and Proprietary Information*
- *Common Law Trademark Rights*
- *Copyright Protection and Registration*
- *Copyright Infringement and Fair Use Defense*
- *Foreign and International Copyright*
- *Trademark Searches Explained (Circular)*
- *TM Watch Service – Guard Your Brand Protect Your Investment*
- *Making a Name Distinctive and Distinguishable Trademarks*
- *USPTO TM Filing Timeline Charts*

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