

Trademarks: How long does it take get a Trademark approved?

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You just started a new business, have a new trade name or a new service and you would like to have your trade name or service name protected by filing for a trademark. Either you or your attorney will file a trademark application with the Patent and Trademark Office (PTO). The trade name or service name you file is called a “mark”, for example the trade name “Levi’s®” is the “mark” for Levi’s jeans. You want to know how long it takes to get your trademark application approved. The short answer is typically it takes nine months to two years to obtain approval from the PTO. The following explains the trademark application process.

Your trademark application will receive a serial number. The status of your application can be determined by going to <http://tarr.uspto.gov> and entering your serial number. Once you have filed your application, you are placed “in line” and your rights to your mark are determined on a first come first served basis. In other words, if your mark is “XYZ” and your neighbor files for “XYZ” the very next day, you have superior rights over your neighbor. You should also note that once you file your application, it becomes public knowledge and can be easily found on the PTO’s web site.

Your application is assigned to a trademark examiner within the PTO’s office. However, it could take two to four months before a trademark examiner is assigned. The examiner will review your application and determine if it is complete and whether it is eligible for registration. If the examiner finds a problem with the proposed mark, he or she will issue an “office action”. All office actions must be addressed and cleared up before your mark is accepted for registration.

Office actions generally fall into two broad categories, substantive and technical. A technical office action means that the application has a minor defect or that your application did not follow the correct procedure. A substantive office action could be for several reasons. Two examples of a substantive office action are when the examiner believes that your proposed mark is: (i) merely descriptive or (ii) confusingly similar to an existing trademark (a “likelihood of confusion”).

An office action must be responded to in the time frame given by the examiner. If you fail to respond to the office action, your application is considered abandoned. If this happens, your mark will not be registered.

If you do respond to the office action, the examiner will consider your response and decide if you have overcome the examiner’s reasons for the office action. Your response to an office action must address and respond to each and every reason stated in the examiner’s office action. If you fail to respond to a particular rejection, your application could be rejected for that reason alone.

The examiner will review your response and determine if your mark is now eligible for registration. Alternatively, the examiner may send a second office action. The examiner would send a second office action when he or she believes that you have not properly responded to the

first office action. Again, you must respond to the second office action within the appropriate time frame, otherwise your application will be deemed abandoned.

The examiner may mark the second office action (or any subsequent office actions) as “final”. If an office action is marked final, you have two options: (i) file an appeal or (ii) comply with the examiner’s outstanding requirements. If you do not avail yourself of these two options your application will be deemed abandoned.

If the second office action is not marked final the examiner may issue more office actions, depending on whether or not the examiner believes your response to be sufficient.

At some point in the process, the examiner will either determine that your mark is entitled to federal registration or state that the application has been abandoned. A mark that is deemed to be entitled to federal registration will be published in the Official Gazette of the U.S. Patent and Trademark Office.

A mark is published in the Official Gazette to allow the public to challenge your registration. in an opposition proceeding. The public is given thirty days to file an opposition to your mark (if an opposition is filed, that person or entity is called the “opposer”). If no objection is filed your trademark it will be registered about thirty - sixty days after the opposition period expires. However, if an opposition is filed, then you will need to demonstrate why you should be granted your trademark in an opposition proceeding.

The bottom line is this: if no opposition is filed, it generally takes anywhere from nine months to two years before your trademark application is actually registered. If an opposition is filed and you succeed in the opposition proceeding, your trademark application will take significantly longer before it is accepted for registration.

Once your mark is accepted for registration, you can use the circle-R designation (“®”). Before that time, you can use the “TM” (“™”) or “SM” (“SM”) designation.

You have “common law” rights in your mark as soon as you start using it. However, you obtain substantially stronger rights by registering your trademark with the PTO. Another alternative is to register your trademark with your state. In most states, obtaining a state registration is a simple process and does not take as long as obtaining Federal trademark registration.

If you require help in obtaining a trademark, please contact David P. Badanes, Esq. of the Badanes Law Office.

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