



How to Trademark in 2 Steps: The Search & The Application

podcast episode 25 tip sheet

Want to trademark your business name or logo but have NO idea what steps to take? Maybe you're aware that federal trademark protection is available but you're not sure if you really need to do a full Trademark Search or what's involved with filing an Application. This episode covers how to trademark in 2 steps – The Trademark Search & Trademark Application.

Why should you file for a registered Trademark?

The whole point of filing for a registered trademark through the US Patent & Trademark Office (USPTO) is to protect your brand.

Trademarking allows you to receive legal protection to use words or a logo related to your brand in a certain context, and to keep others from benefitting from your branding identity, market recognition and goodwill by using the same or similar words or logo in a comparable field.

What are the benefits to you?

A registered Trademark under US federal law gives you several benefits:

1. It gives you the exclusive right to use your words or logo in a particular Trademark class for 10 years – and you can renew for additional 10-year periods if you wish.
2. It prevents others doing work in a similar field from using words or graphics that are the same or “confusingly similar” to yours.
3. It aims to prevent “brand confusion” so the uniqueness and value of your brand isn't diminished in the marketplace.

Trademarking is a 2-step process. Step 1 is the Trademark Search. Step 2 is the Trademark Application.

At first glance, Trademarking looks super-easy, but it's actually quite tricky.

Step 1—The Trademark Search

The first step in the Trademarking Process is to have a lawyer conduct a Trademark Search. The purpose of a Trademark Search is to make sure that the word, phrase or graphic you want to Trademark is available, and that you're not going to be treading on someone else's existing Trademark.

It's not enough to do a quick check in the USPTO database to see if your exact phrase is already Trademarked. That's a good initial step, but you can't stop there.

Why can it be risky to do a Trademark Search on your own?

Simply put, most people aren't trained to think like the USPTO. The job of a Trademark Lawyer is to look at the existing Trademarks to make an assessment and look for the EXACT same words or logo, but also words and logos that are "confusingly similar" to the words or logo you want to Trademark - and get this - but it's from the perspective of the USPTO. Not from your perspective or a person off the street's perspective...it's from the USPTO's legal perspective.

You want to make sure there aren't any other "confusingly similar" Trademarks already filed. These are similar-sounding enough to cause brand confusion in the marketplace such that the public could mix them up or think that both were associated with the SAME business.

What a good attorney will tell you is that if a Trademark Search comes back where it looks like there is a high risk of the government shooting down your mark, there's no sense in moving forward with investing in the Trademark Application.

Step 2—The Trademark Application

After you've had a Trademark Search done by a lawyer, your next step is to file the Trademark Application. There are 4 key components to the Trademark Application:

First, determine your filing status as “In Use” or with the “Intent to Use”.

In Use – File as “In Use” if you’re already using your words or logo actively in your business.

Intent to Use – File as with the “Intent to Use” if you’re not actively using your words or logo on your website or in your branding yet, but you have the “intent to use” to use them in the next six months. You’ll have to start using them in that time frame, or you can file for multiple extensions.

Second, get clear about your Trademark description.

The way you write your Trademark description is important. You want your Trademark description on your Application to be thorough and accurate and written in a way that can prevent others with similar services from filing a similar mark or sneaking in the back door.

Third, identify the Trademark classes in which you plan to file.

You want to properly identify the right classes for the programs, products and services you offer. There are 45 Trademark Classes - or categories – identified by the USPTO that all Trademarks must fit into. Strategically determining which classes are appropriate for your Trademark Application based on the type of work that you do is key. Often a lawyer can flesh this out for you in the Trademark Search step of the process.

Fourth, you’ll want to gather and submit the Trademark samples to the USPTO.

The Trademark samples – which are formally called “proof of use” or “specimens” (yes, they’re really called “specimens” – like you’re in high school science lab!) - need to show HOW you’re using the term on your website and in your marketing. The USPTO needs to see compelling use of how you are using the words or logo and what you are selling – not merely that you have a hobby.

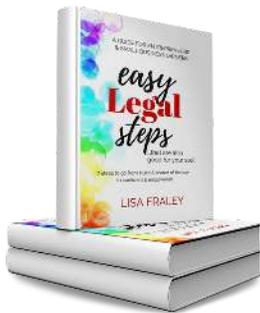
The Trademark Application requires precision, attention, accuracy and responsiveness. The Trademark process can be LONG – 6-18 months – with an average of 10 months. Your lawyer can also handle the communication and back and forth with the USPTO which can be confusing to do on your own, and make legal arguments on your behalf.

There's one other thing you need to know about Trademarks.

Trademarks are ASSETS.

Trademarks protect your brand identity and value - but not only that, Trademarks are tangible assets that can be owned by your business and that have financial value. In other words, they can be transferred, bought and sold.

If you've ever watched "Shark Tank" on TV you might recall that Kevin O'Leary, aka Mr. Wonderful, often asks the entrepreneurs whether they own their trademarks. Why? Because he knows that it's an ASSET that can be sold to others for MONEY.



As I say in Chapter 7 of my book "Easy Legal Steps...That are Also Good for Your Soul", obtaining a Trademark is the crown jewel for a small business owner or entrepreneur. It gives you supreme federal protection along with peace of mind and confidence that you're protecting your brand.

Trademarking is such a high frequency action that I align it with your **crown chakra**. The crown chakra is represented by the color of purple and is connected to your highest potential, wisdom, divinity, awareness, and connection to the bigger Universe. Trademarks are one of the ways that you connect your brand to something larger than you—the greater marketplace—and you create a brand legacy for your business.



If you can make a lot of money with your creative biz name or tagline, don't delay! You're wise to Trademark it now before someone else snags it.

Find out if you have something to Trademark and then start the process today by talking with a lawyer about Step 1 - the Trademark Search – and Step 2 - the Trademark Application.



Have questions about Trademarking or want to get started with a Trademark Search or Trademark Application?

Learn more at lisafraley.com/trademark or feel free to reach out to my team at clientlove@lisafraley.com.



Kudos to you for listening to this episode to find out how a Trademarking works. Thanks for being part of the Legal Love tribe. Here's to getting legally enlightened!

With Legal Love,

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Lisa Fraley, JD, CHHC, AADP, is an acclaimed attorney, Legal Coach®, speaker and #1 Best Selling Author of "Easy Legal Steps...That are Also Good for Your Soul." With her unique blend of coaching, legal expertise, and spirituality, Lisa has supported thousands of heart-centered entrepreneurs and small business owners to protect themselves, their businesses and their brands through DIY legal templates, online legal courses and one-on-one services.

From sharing international stages with thought leaders like Kris Carr and Gabrielle Bernstein to being featured on hundreds of podcasts, webinars, radio shows and bonus calls, Lisa has made it her mission to help every single small business owner understand that the law can be accessible, empowering, loving, and even spiritual. When she's not saving the world (with Legal Love) one contract at a time, she's posting free legal tips and connecting with her tribe at lisafraley.com.