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## Deciding if You Need a Trademark and How to Register a Trademark

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## **Deciding if You Need a Trademark and How to Register a Trademark**

The Sul Lee Law Firm focuses in Trademark registration. We frequently encounter clients who want to know if they need to register their trademark. To answer that question, it is essential that you first understand what a trademark is and what registration accomplishes.

### **What is a Trademark?**

A [trademark](#) is a word, symbol, phrase, design, or some combination that identifies your business or products. A trademark is uniquely associated with your company and helps you build brand recognition. A trademark is an [intellectual property](#), and as such, it is eligible for the full protection of intellectual property laws.

Think about the famous checkmark that the world associates with Nike products, or the distinct red and white coloring of Coca Cola products. Not all trademarks are as well known, but a trademark represents the name of your business and stands as a symbol of the reputation you have worked hard to build.

### **Do I Need to Register My Trademark?**

You have some protection, under common law, from other businesses using the name of your business or your trademark. You do need to consider filing for trademark registration if your company fits in one of the below categories.

#### **Highly Competitive Industry**

Restaurants, cafes, food trucks, cosmetics, fashion, and technology are all examples of highly competitive markets. The more competitive the field, the more you need to protect your reputation and help your business stand apart from the competition.

For example, if your restaurant has a signature menu, you want that menu to be protected from the competition creating a similar menu with similar dishes and capitalizing off the hard work you invested into your reputation.

#### **Franchising**

If you plan to franchise your business, a trademark will be a necessity. A trademark is a legal right that you will grant to the franchisees, so protecting your exclusive right to determine who uses the trademark is crucial for a successful franchise.

The goal of a franchise is to be able to replicate your business model, again and again, building your brand and name recognition as you do.

#### **A Service or Item That is Easily Accessible**

If your business model relies on marketing a service or selling items for which there is a large market, you will work hard to establish both your reputation and your customer base. You want to protect this hard work by registering your trademark, which will prevent other companies from imitating your efforts.

## **How to Register a Trademark**

A trademark is registered through the [United States Patent and Trademark Office](#) (USPTO). Registering your trademark protects you from infringement, copying, or imitating your trademark by your competitors. Trademark registration is the cheapest and smartest way to create exclusive rights to the originality of your brand and the hard work you have put into building the value of your name and reputation.

## **How Does Trademark Protection Work?**

There are two different forms of trademark protection. One type of protection occurs passively, through common law. The other protection is an active measure that happens when you complete the USPTO trademark registration process.

### **Common-Law Trademark Protection**

When you use your trademark in everyday business commerce, you can automatically acquire trademark rights under common law. Common law provides that if you are the first business to use the trademark within a set geographical area, then your rights to the trademark will be considered superior to those of any later competition.

The distinct advantage of common-law trademark protection is that it requires no active measures on your part. The protection is automatically conferred to your business. However, the disadvantage of common-law trademark protection is that it is limited to a small geographic region. If someone infringes on your common-law rights to your trademark, it will also be your responsibility to prove you had first rights to the use of the trademark.

### **Registration With the USPTO**

Sul Lee Law Firm can help you through the process of registering your trademark with the USPTO to offer you the best form of protection against infringement on your trademark. Once registered, your trademark will be afforded nationwide protection, meaning you will have exclusive right to use your mark except for a few exceptions.

Registering your trademark, with the help of a qualified intellectual property attorney, usually takes about one year from the date of application to the date that your trademark is officially registered. Working with an attorney makes the process simple, streamlined, and cost-effective. The process for achieving USPTO trademark registration include:

- Trademark review—your attorney will want to know what you want to be included in your trademarks, such as the name of your business and your logo. The attorney will need to know the date that you first began to use the trademark and the products or services you provide. The exact nature of your business is vital because the USPTO process will be specific to the market or industry of your current business.
- Preliminary search—Often, the biggest obstacle to registration is the existence of a competing trademark or logo already registered to the USPTO. Before filing the trademark registration, your attorney will search for similar trademarks or logos that might keep you from receiving the registration you seek. If any are found, your attorney will consult with you to discuss options.

You may decide at that point to change some part of your logo or name to avoid infringing on an already registered trademark.

- Preparing the USPTO application—once the initial search is complete, the attorney will prepare a registration application to be filed online. Filing fees will need to be paid to the USPTO.
- The next step in the process occurs when the USPTO appoints an examining attorney. The appointment usually occurs in four to six months after filing. The examining attorney will review your trademark and decide whether it will be approved for registration.

The examining attorney will determine whether your trademark meets the legal criteria for registration and searching for conflicting trademarks already registered with the USPTO. The attorney will search the database to make sure there are no other trademarks that are too similar to yours.

- If there is a problem, the USPTO office will issue an Office Action letter. You, or your attorney, will have six months to respond. Sul Lee is experienced in the USPTO process and works diligently to make sure your trademark makes it through the process without problems arising. If unforeseen issues do arise, she will contact you immediately to discuss potential remedies.
- If there are no problems, or the problems are resolved, the examining attorney will approve your trademark application. At this point, your trademark will be scheduled for publication, which serves as the notification phase. Unless someone files an objection, your trademark will be granted registration.
- Once the publication stage passes without objection, your trademark will then be cleared for registration.

You will be required to make periodic filings with the USPTO to keep your trademark registration active. These filings usually take place every sixth and tenth year. They are known as the Declaration of Continued Use and the Combined Declaration of Continued Use and Renewal, respectively.

## **Sul Lee Law Firm**

To discuss the trademark process, or if you have any questions, contact the Sul Lee Law Firm at (214) 202-4064 to schedule a Legal Strategy Session. You have worked hard to establish your business reputation, and trademark registration is an easy and cost-effective way to protect your hard work. We look forward to working with you to make sure your company is successful and protected.

## **Sul Lee Law Firm**



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