

U.S. Trademark Filing Process: A Step-by-Step Guide

Introduction: Filing a trademark in the United States involves navigating specific legal requirements and procedures that may differ from other jurisdictions. Foreign trademark attorneys should be aware that U.S. registration demands a **distinctive** mark that is or will be used in commerce, and compliance with U.S. rules and timelines ([Lanham Act | Wex | US Law | LII / Legal Information Institute](#)) ([What Are the Three Requirements for Trademarks?](#)). (Note: As of 2019, foreign-domiciled applicants must hire a U.S.-licensed attorney to prosecute a U.S. trademark application ([Do I need an attorney? | USPTO](#)).) This white paper provides a structured overview of the **basic U.S. trademark filing process**, including eligibility criteria, filing bases, the USPTO application steps, key timelines, how to handle office actions, and post-registration maintenance.

Trademark Eligibility and Distinctiveness

To qualify for federal trademark registration in the U.S., a mark must meet certain basic requirements:

- **Use in Commerce:** The mark must be used (or intended to be used) in interstate commerce (commerce between U.S. states or with foreign countries) in connection with the applicant's goods or services ([Lanham Act | Wex | US Law | LII / Legal Information Institute](#)). Actual use is not required at the moment of filing if the applicant files on an intent-to-use basis (see Filing Bases below), but **proof of use** will eventually be required to obtain and keep the registration. "Use in commerce" generally means bona fide use of the mark in the ordinary course of trade, such as selling a product with the mark on it or offering a service under the mark.

- **Distinctiveness:** The mark must be capable of distinguishing the applicant's goods/services from others ([Lanham Act | Wex | US Law | LII / Legal Information Institute](#)). Generic terms (common product names) cannot function as trademarks at all, and descriptive terms are not registerable on the Principal Register unless they have acquired **secondary meaning** (distinctiveness through use) ([What Are the Three Requirements for Trademarks?](#)). In practice, **inherently distinctive** marks (suggestive, arbitrary, or fanciful terms) are eligible for registration, whereas marks that are merely descriptive, primarily a surname, or geographically descriptive will face refusal absent proof that consumers recognize them as a brand (acquired distinctiveness). Marks that are **deceptive or functional** (product features essential to use or affecting cost/quality) are unregistrable on absolute grounds.
- **No Likelihood of Confusion:** The mark should not conflict with any earlier registered or pending trademark for related goods/services. The USPTO examiner will refuse registration if the proposed mark is too similar to a prior mark such that consumers would likely be confused ([What Are the Three Requirements for Trademarks?](#)). It's advisable to conduct a clearance search before filing to avoid this issue. (Letters of consent from owners of similar marks can sometimes overcome a refusal, but only if they convincingly show no confusion will result ([At a glance: trademark registration and use in the USA - Lexology](#)) ([At a glance: trademark registration and use in the USA - Lexology](#))).)
- **Other Legal Bars:** U.S. law also prohibits registration of marks that are scandalous or offensive (recent court decisions have struck down some of these bans on free speech grounds), that falsely suggest a connection with persons or institutions, or that consist of government flags, insignia, or the name/signature of a living individual without consent. These are less common issues but worth noting for completeness.

U.S. Trademark Filing Bases (1(a), 1(b), 44, and 66)

When preparing a U.S. trademark application, the **filing basis** must be identified. This indicates the legal grounds on which the application is filed under the U.S. Trademark (Lanham) Act:

- **Section 1(a) – Use in Commerce:** The applicant has already **used the mark in U.S. commerce** on the goods or services. A specimen (evidence of use, such as a product label or screenshot of a webpage showing the mark being offered) must be submitted with the application, and the date of first use (anywhere and in U.S. commerce) must be declared ([Timelines for the trademark application and post-registration process | USPTO](#)). This basis is appropriate for marks that are already being marketed or sold in the U.S.
- **Section 1(b) – Intent to Use:** The applicant has a **bona fide intention to use** the mark in U.S. commerce in the near future ([Timelines for the trademark application and post-registration process | USPTO](#)). No specimen is required at filing, but the applicant will need to provide proof of use later (see Step-by-Step Process below). This basis lets you secure a filing date while you are still in the planning or launch phase. An *intent-to-use* application will not register until actual use is proven.
- **Section 44(d) – Foreign Application (Priority Basis):** The applicant has filed a **foreign application** for the same mark within the last six months, and seeks to claim that foreign filing date as a priority date in the U.S. ([Timelines for the trademark application and post-registration process | USPTO](#)). A U.S. application can be filed under 44(d) before the mark is used in the U.S., as long as a corresponding foreign application exists. However, this alone doesn't let the mark register without use; it typically is paired with 44(e) or 1(b).
- **Section 44(e) – Foreign Registration:** The applicant **owns a foreign registration** for the same mark (from the applicant's country of origin) ([Timelines for the trademark application and post-registration process | USPTO](#)). If the foreign registration is granted, the applicant can obtain a U.S. registration **without proving use in the U.S. prior to registration**. (Use will eventually be required to

maintain the registration.) The foreign registration certificate will need to be provided. Section 44(e) applications are common for brand owners expanding into the U.S. from abroad.

- **Section 66(a) – Madrid Protocol:** The application is a request for extension of protection to the U.S. via the **Madrid Protocol international registration** system ([Timelines for the trademark application and post-registration process | USPTO](#)). In this case, the International Bureau (WIPO) submits the request to USPTO. Like 44(e), no proof of use is required to register, but **use in commerce** will be required to maintain the registration after issuance. Madrid applications still undergo USPTO examination like any other U.S. application.

Choosing the correct basis is important. For foreign clients, often a combination is used (e.g. 1(b) + 44(d) priority, or 44(e) via an existing foreign registration). Note that **all bases** (except Section 66) require an assertion of use before registration, either at filing or after allowance. The basis can also affect timeline and documentation, as discussed next.

Step-by-Step USPTO Trademark Application Process

The U.S. Patent and Trademark Office (USPTO) process from application to registration involves several stages. Below is a step-by-step breakdown assuming a standard application on the **Principal Register**:

1. **Pre-filing – Clearance (Optional):** Although not required, it is prudent to conduct a **trademark search** before filing to ensure the mark isn't already in use or registered in the U.S. in a confusingly similar manner. A thorough search (including the USPTO database and common law uses) can prevent costly conflicts. This step, while outside the USPTO process, is a best practice many U.S. attorneys perform.
2. **Filing the Application:** The process officially begins by filing a **Trademark Electronic Application System (TEAS)** form with the USPTO. The application

must include key details: the applicant's information and domicile, the mark itself (standard word mark or an image of the logo, etc.), a list of the goods and/or services grouped by international class, the chosen **filing basis** (use, intent-to-use, etc.), and if filing under **Section 1(a)** (use), a specimen of use and first use dates ([Timelines for the trademark application and post-registration process | USPTO](#)). All communications are electronic, and filing fees are paid per class of goods/services. Once filed, the application is assigned a serial number and the filing date is set.

3. **USPTO Examination – Formalities & Substantive Review:** The application is typically assigned to an examining attorney at the USPTO **about 3 months after filing** (current timelines can vary) ([Section 1\(a\) timeline | USPTO](#)) ([Section 1\(a\) timeline | USPTO](#)). The examiner reviews the application for compliance with formal requirements and assesses **registrability** under U.S. law. This includes checking for any **conflicting marks** in the USPTO database (relative grounds) and evaluating if the mark is inherently distinctive or needs a disclaimer, etc. During this review, the examiner may identify issues such as: likelihood of confusion with an earlier mark, mere descriptiveness, genericness, unacceptable specimen, improper identification of goods, or other statutory bars.
4. **Office Action (if issues found):** If the examining attorney finds any problems or objections, they will issue an **Office Action**, which is an official letter detailing refusals or requirements ([Section 1\(a\) timeline | USPTO](#)). Office Actions can be **non-final** (raising initial issues and allowing response) or **final** (maintaining objections after an unsatisfactory response). Common refusals include Section 2(d) likelihood of confusion with a prior mark, Section 2(e) descriptiveness, or procedural requirements like clarifying the goods description or providing a new specimen. The applicant has **3 months to respond** to an Office Action (an extension of 3 additional months is available for a fee) ([Section 1\(a\) timeline | USPTO](#)). If no response is filed, the application will abandon ([Section 1\(a\) timeline | USPTO](#)).

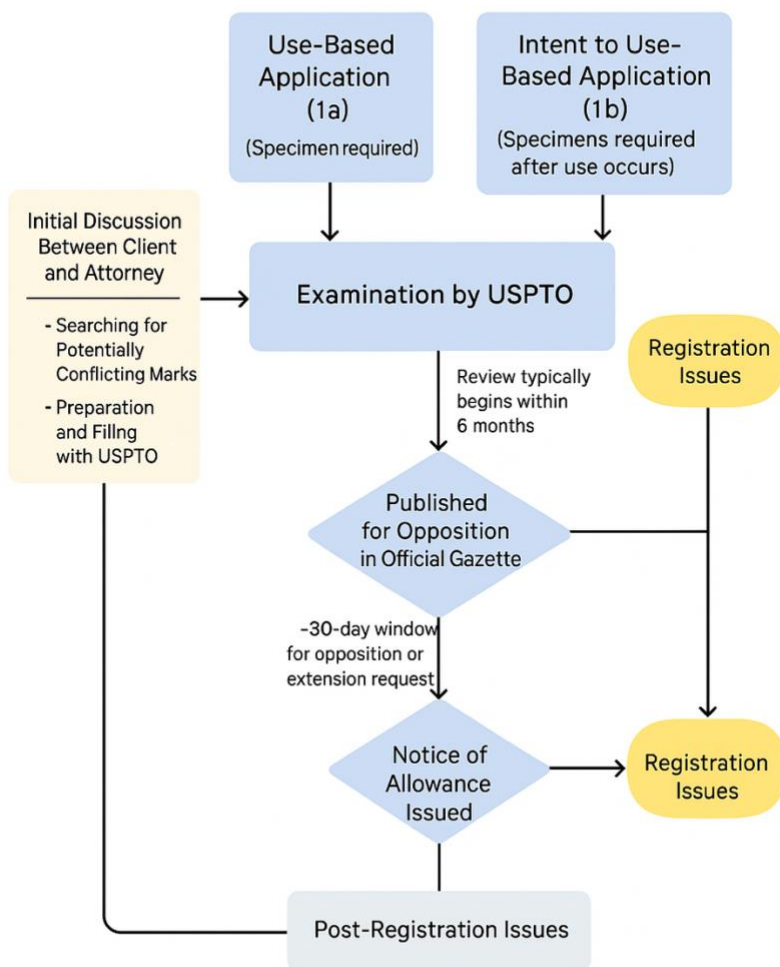
5. **Response to Office Action:** The applicant (through U.S. counsel, if applicable) must submit a **timely response** addressing each issue. This may involve legal arguments (e.g. arguing the marks are not confusingly similar, or that a term is suggestive, not descriptive) and/or amendments (e.g. adding a disclaimer, revising the identification of goods, or submitting a substitute specimen) ([Section 1\(a\) timeline | USPTO](#)). If the response overcomes all objections, the examiner will move the application forward. If not, the examiner will issue a **Final Office Action** maintaining the refusal(s).
6. **Final Refusal and Appeal (if necessary):** Upon a final refusal, the applicant has the option to **appeal to the Trademark Trial and Appeal Board (TTAB)** or file a **Request for Reconsideration** (or both). An appeal to the TTAB is initiated by filing a Notice of Appeal (within the deadline, traditionally 6 months from the final action, though practitioners now effectively have 3 months with extension under new rules) ([Section 1\(a\) timeline | USPTO](#)) ([Section 1\(a\) timeline | USPTO](#)). The TTAB is a body of administrative judges that will review the examiner's decision (appeal procedure is discussed in the second white paper below). Many issues can often be resolved without an appeal by negotiating with the examiner or narrowing the application, but the appeal route exists for contested refusals.
7. **Publication in Official Gazette:** If the examining attorney raises no objections or all issues are resolved, the USPTO will approve the mark for publication ([Section 1\(a\) timeline | USPTO](#)). The application is then **published in the Trademark Official Gazette (TMOG)**, an online weekly publication, to give the public notice of the pending registration ([Section 1\(a\) timeline | USPTO](#)). The publication date starts a **30-day opposition period** during which anyone who believes they would be damaged by the registration can file an **Opposition** proceeding with the TTAB ([Section 1\(a\) timeline | USPTO](#)). (An opposer typically is the owner of an earlier trademark who finds the published mark conflicting.) If no opposition is filed within 30 days (or an extension requested by a third party), the application moves forward.

8. **Opposition (if filed):** In the event that an opposition is filed, the registration process is put on hold while the TTAB conducts an **opposition proceeding**, which is akin to litigation between the applicant and the opposer ([Section 1\(a\) timeline | USPTO](#)). This process can result in the application being abandoned or proceeding to registration depending on the outcome of the case. (Oppositions are covered in detail in the second white paper.) If an opposition is successful, the application will not register. If the opposition is unsuccessful or settled in the applicant's favor, the application resumes its course.
9. **Notice of Allowance (for 1(b) applications):** For **intent-to-use (Section 1(b)) applications**, if no opposition is filed (or an opposition is overcome) after publication, the USPTO does **not** register the mark immediately. Instead, it issues a **Notice of Allowance (NOA)**. The NOA signals that the mark is allowed, but the applicant must now **submit proof of use**. The applicant has 6 months from the NOA date to either file a **Statement of Use** (also called an Allegation of Use) with a specimen and first use dates, or file for a 6-month **extension of time**. Up to 5 extensions (30 months total) are allowed ([Fundamentals of the Trademark Trial and Appeal Board Opposition Process - The Rapacke Law Group](#)), so an intent-to-use applicant can have up to three years from the NOA to put the mark in use. Once a Statement of Use is filed and accepted by the USPTO, the application can proceed to registration. (If the applicant filed under 44 or 66, no NOA is issued; the mark will register without proof of use, but the owner must still use the mark to maintain the registration.)
10. **Registration Certificate Issuance:** If the opposition period passes with no oppositions (or any opposition is resolved in favor of the applicant), and for 1(b) cases a Statement of Use is accepted, the USPTO will **issue the registration**. The certificate of registration is mailed (in electronic form as of 2022, e-certificates) and the mark is officially registered on the Principal Register ([Section 1\(a\) timeline | USPTO](#)). The time from filing to registration can vary widely: in a smooth case with no objections, it might be as quick as 8–12 months; cases with office actions

or extensions of time will take longer (often 1–2 years or more). At registration, the registrant gains the benefits of federal registration (the ® symbol, nationwide presumptive rights, etc.).

Flowchart – Application Process: The flowchart below illustrates the general USPTO process for a use-based application versus an intent-to-use application, from filing to registration ([What to Expect from the U.S. Trademark Application Process | Privacy and IP Law Blog](#)). The flowchart outlines the USPTO trademark application process for Use-Based (1a, specimen required) and Intent to Use-Based (1b, specimens required after use) applications. Both proceed to Examination by USPTO (blue highlighted), potentially facing Registration Issues. Upon publication in the Official Gazette (30-day opposition window), Use-Based applications can proceed to registration if unopposed, while Intent to Use applications receive a Notice of Allowance, requiring proof of use before registration. Both tracks involve potential Office Actions and culminate in Post-Registration Issues. The filing basis dictates post-publication steps: 1(b) adds a use verification stage, unlike 1(a) which can go directly to registration after allowance and no opposition.

USPTO TRADEMARK APPLICATION PROCESS



Office Actions and Responses

During the examination phase, encountering an **Office Action** is common. International attorneys should not be alarmed by a USPTO Office Action; it is an invitation to **clarify or**

argue the application rather than an outright rejection. There are two types of Office Actions:

- **Non-Final Office Action:** This is typically the first Office Action. The examiner lists all refusals (e.g. conflicts or descriptiveness) and requirements (e.g. disclaimer of a generic term, amendment of description, etc.) that must be addressed. The applicant has a non-extendable 3-month deadline (extendable to 6 months) to respond ([Section 1\(a\) timeline | USPTO](#)). In the response, the applicant can present legal arguments and evidence to overcome refusals and make any required amendments. For example, if registration is refused due to likelihood of confusion with another mark, the response might argue differences in appearance, sound, meaning, or commercial impression, and might include evidence of coexistence of similar marks. If the issue is descriptiveness, the applicant might argue the mark is suggestive or provide evidence of acquired distinctiveness. **Collaboration with U.S. counsel** is key in this stage to craft persuasive arguments grounded in U.S. trademark case law and practice.
- **Final Office Action:** If the USPTO is not persuaded by the response, the examiner may issue a Final Office Action maintaining the refusal(s). At this stage, the options narrow. The applicant can **(a)** file an appeal to the TTAB, **(b)** file a Request for Reconsideration (often with additional evidence or amendments) which, if it raises a new issue, may push the application back to non-final status, or **(c)** in some cases, make limited amendments (for example, entering a disclaimer or accepting a narrower identification) if offered by the examiner. The deadline for responding to a final action is the same (3 months + extension). Failing to take action will result in **abandonment** of the application ([Section 1\(a\) timeline | USPTO](#)), but even then a late remedy (Petition to Revive within 2 months of abandonment) may be available with a showing that the delay was unintentional ([Section 1\(a\) timeline | USPTO](#)).

Throughout the Office Action process, maintaining a professional dialogue with the examining attorney can be helpful. Often, examiners will call or email the attorney of record to suggest minor amendments that can swiftly resolve an issue (*examiner's amendment*). More substantive refusals require formal written arguments. U.S. trademark practitioners will be familiar with common refusal rationales and how to address them. As a foreign attorney, you can rely on U.S. local counsel's expertise here – for instance, providing evidence of how a term is understood abroad can sometimes help in arguing it's not descriptive in the U.S., etc.

If an appeal is filed (or anticipated), note that **TTAB proceedings for appeals** are typically based on the existing application record, so it's important to submit any evidence (e.g. consumer testimonials, articles, or survey results if arguing acquired distinctiveness) during prosecution or with a request for reconsideration, since introducing new evidence on appeal is limited.

Registration and Post-Registration Maintenance

Achieving registration is a significant milestone, but it is not the end of the journey. U.S. trademarks require ongoing **maintenance filings** to remain in force. Key post-registration concepts include:

- **Declaration of Use (Section 8) – 5th to 6th Year:** Between the **5th and 6th anniversary** of the registration, the registrant must file a Section 8 Declaration of Continued Use (or Excusable Non-use) with the USPTO ([Section 1\(a\) timeline | USPTO](#)). This filing includes a statement verifying that the mark is in use on the goods/services in the registration, along with a current specimen for each class. There is a grace period of six months after the 6th year (with an extra fee) if missed ([Section 1\(a\) timeline | USPTO](#)). Failing to file the Section 8 will result in the registration being **cancelled** ([Section 1\(a\) timeline | USPTO](#)). This requirement is a safeguard to clear “dead wood” (marks not actually in use) from the register.

- **Optional Incontestability (Section 15) – 5th Year:** Often combined with the 6th-year filing, a registrant who has **five years of continuous use** of the mark in commerce post-registration can file a Section 15 Declaration of Incontestability. This is optional but highly valuable – once granted, the mark becomes “incontestable,” meaning certain grounds of challenge (like mere descriptiveness) can no longer be used against it. The Section 15 can be filed with the Section 8 (commonly called a “§8 and 15 combined filing”).
- **Renewal (Section 9) and Ongoing Use – Every 10 Years:** U.S. registrations are valid for ten years from the registration date and can be renewed indefinitely every ten years, provided the mark remains in use. A Combined **Section 8 Declaration and Section 9 Renewal** application is due **every 10th year** (between year 9 and 10, with a 6-month grace period after year 10) ([Section 1\(a\) timeline | USPTO](#)). This filing again requires proof of continued use. Essentially, after the first 5-6 year maintenance, the registrant must then renew at year 10, 20, 30, etc., with proof of use each time. Each renewal extends the registration for another 10-year term.
- **Monitoring and Enforcement:** Although not a formal “maintenance” requirement, it is the registrant’s responsibility to **police the trademark**. The USPTO does not monitor infringement. The owner should monitor for confusingly similar uses by others and send cease & desist letters or take legal action if necessary to prevent dilution or loss of rights. Also, be wary of trademark **scams** – after registration, the owner’s address is public and many registrants receive fake invoices or solicitations. U.S. counsel typically warns clients about these.
- **Changes and Assignments:** If the trademark owner (registrant) changes name or address, those changes should be recorded with the USPTO. If the trademark is **assigned** to a new owner or if there is a change in ownership structure, an Assignment recordation with the USPTO is necessary to keep the ownership information current. Also, any licensed use should be under quality control (to avoid “naked licensing” which can jeopardize rights).

In summary, a U.S. trademark, once registered, can last indefinitely **as long as it is properly maintained and continuously used**. The USPTO's post-registration requirements are strict about use: **non-use for three consecutive years** creates a presumption of abandonment of the trademark rights ([At a glance: trademark registration and use in the USA - Lexology](#)) (unless proven otherwise). Therefore, brand owners should institute internal docketing for these deadlines (5-year and 10-year filings) and ensure the mark remains in bona fide use on the goods/services. Missing a filing can usually be fixed within the grace period for a fee, but if the registration is cancelled, the only remedy is to file a new application, potentially losing your original priority date and protection gap in the interim.

Key Takeaways: By understanding the U.S. trademark filing process, foreign attorneys can better advise their clients or coordinate with U.S. counsel. The U.S. system emphasizes actual use of trademarks and procedural deadlines. To recap:

- A mark must be distinctive and used in commerce (or have a bona fide intent to use) to be registered ([Lanham Act | Wex | US Law | LII / Legal Information Institute](#)).
- Choose the appropriate **filing basis** – use-based, intent-to-use, foreign registration, or Madrid – to fit the client's circumstances ([Timelines for the trademark application and post-registration process | USPTO](#)) ([Timelines for the trademark application and post-registration process | USPTO](#)).
- Follow the **USPTO process**: application, examination, address any Office Actions within 3–6 months ([Section 1\(a\) timeline | USPTO](#)), and proceed to publication and registration (or Notice of Allowance for intent-to-use).
- **Engage U.S. counsel** for representation and to navigate subtleties like argument strategies, which is mandatory for foreign applicants in any case ([Do I need an attorney? | USPTO](#)).
- Diarize **deadlines**: Office Action responses (3 months), Statement of Use (6 months increments), Opposition (30 days post-publication), and post-registration

maintenance (at 6 years and each 10-year interval) ([Section 1\(a\) timeline | USPTO](#)) ([Section 1\(a\) timeline | USPTO](#)).

- Once registered, use the mark continuously and **monitor** the market. Enforce your rights and renew the registration as required to enjoy ongoing protection.

By adhering to these steps and requirements, international practitioners can successfully secure and maintain U.S. trademark registrations, thereby protecting their clients' brands in the United States' large marketplace.