



## U.S. TRADEMARK CLEARANCE, FILING & PROSECUTION Timing, Costs and Procedures Explained

### ***TIMELINE***

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We can preliminarily search a mark for availability within a few days or less and strongly recommend conducting a search prior to filing an application. In fact, we'll even include a basic (identicals only) screening search with the preparation and filing of a new U.S. application.

Based upon USPTO data and our experience, we typically receive an office action or notice of instant approval of the new application within about three (3) months from the U.S. application filing date. If the application is not instantly approved and the examiner issues an office action, the trademark application is usually approved within a couple of months from the applicant's satisfaction of all of the examiner's stated requirements<sup>1</sup>. The application then proceeds to a 30-day publication opposition period in which any third party who believes the registration of the mark may harm them, can oppose that registration in a USPTO administrative court. Assuming the application is not opposed, registration should issue once the applicant has either alleged use of the mark in U.S. Commerce, or submitted to the USPTO its corresponding registration from its home country trademark office if registering with a foreign registration filing basis (Trademark Act Section 44(e)). We estimate this total time frame without delays to be about NINE (9) to TWELVE (12) MONTHS.

If the applicant is not able to use the mark in U.S. Commerce or provide its corresponding foreign registration to register the mark on the basis of its home country registration when the application is approved, or if the application is opposed or threatened to be opposed, then delays in this time frame can occur. The delays typically last for as long as it takes to resolve the outstanding issue or conflict with a third party opposer of the mark. An intent-to-use applicant is permitted to extend its requirement to allege use of the mark for up to three (3) years from the allowance of the application (which follows shortly after the opposition period ends) during which time the application remains pending.<sup>2</sup> An application from a non-U.S. applicant awaiting submission of the home country registration to register will be suspended until that registration is submitted to the USPTO.

### ***TRADEMARK SEARCHES and OPINIONS***

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A trademark search is not required for filing a U.S. trademark application, but it is strongly recommended to identify certain risks associated with adopting a particular mark, such as the

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<sup>1</sup> By statute, each office action provides for a six-month response period. Usually, no more than two office actions will be issued (a first action and a final action if necessary), but theoretically additional office actions may be possible. Naturally, the faster the applicant satisfactorily responds to any issued office action, the faster the application is likely to advance toward approval.

<sup>2</sup> Naturally, the earlier the mark is used in U.S. Commerce and evidence of that use is submitted to the USPTO, the sooner the application can proceed to registration.



likelihood that the new application could be opposed or refused, exposure to trademark infringement liability, and the distinctiveness and overall strength of the proposed mark. Even if the plan is to only use a mark and not register it, a trademark search is still recommended because use of a mark in the U.S. establishes rights in the mark and can infringe a similar mark that has been in use.

Staas & Halsey LLP offers the following types of trademark searches and various research/opinion letters on substantive trademark issues like distinctiveness, trademark usage and infringement studies.

1. **BASIC CLEARANCE SEARCH - complimentary with a new application** (approximately US\$350/Mark without) – A streamlined, in-house screening search consisting of only a federal (USPTO) records search and an internet search focusing primarily on identical marks. Relevant results are conveyed with minimal opinion.
2. **COMPLETE TRADEMARK CLEARANCE SEARCH** (US\$700 to US\$1,000 plus a US\$400 search vendor disbursement per mark) – A trademark search performed by our outside searching company that searches similar as well as identical marks in federal, state, internet common law, top level domain name and International Registration<sup>3</sup> databases. We review and analyze the search results and prepare a complete report in about three business days. **If selecting this search, the application preparation/filing fee will be US\$725.**
3. **Design/Logo Search** (no wording) (US\$600 plus a US\$250 search vendor disbursement per mark) – A search of design marks in the USPTO and International Registration databases based upon the USPTO design coding system performed by our outside searching company. A search of unregistered “common law” design marks is complicated and may only be available for a very high cost.
4. **Research and Opinion Letters** (hourly rates) –  
The most common reports/opinions are assessing and reporting on the distinctiveness of a mark, which typically costs US\$800 to US\$1,000; and analyzing/auditing the usage of a single mark or set of related marks, which typically costs US\$400 to US\$600. Various and more extensive research projects and opinions, such as infringement studies and opinions, are available and charged at our hourly rates.

If budget permits and the preliminary word mark search (No. 1 above) indicates the mark is available, we recommend conducting the No. 2 search (above) because marks in use but not registered or applied for in the USPTO can create recognizable trademark rights in the U.S. sufficient to interfere with the use/registration of a subsequent mark.

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<sup>3</sup> A database of the World Intellectual Property Organization (WIPO) which administers trademark applications filed under the Madrid Protocol treaty which presently consists of approximately 100 member countries.



## **FILING & PROSECUTION COSTS<sup>4</sup>**

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The following is an estimate of the typical breakdown of costs for a U.S. trademark application, which typically extends over a period of 1-2 years from application filing to registration:

1. Initial preparation and filing of one application to register a simple word mark (“standard character” mark) in one International Class of goods/services begins with our legal fee of **US\$1,000** and includes a Basic Clearance Search (no. 1 above) **PLUS**
2. The USPTO’s electronic filing government fee of **US\$275** for ONE (1) International Class.
3. Additional fees may be incurred for the following items:
  - Preparing a special form drawing of a mark (any design element) = **\$150**;
  - Each additional International Class costs **US\$375** which consists of the US\$275 per class USPTO filing fee and US\$100 per class additional Staas & Halsey fee.
  - Non-substantive trademark prosecution (responding to one office action for routine amendments) ranges from **US\$600 to US\$1,200**.
  - Responding to a substantive registration refusal issued by the USPTO incurs charges based upon our **hourly rates**.
  - Filing basis amendments, i.e. alleging use of the mark in an intent-to-use application or filing a registration from the home country of the non-U.S. applicant when basing the application on the applicant’s home country registration, costs **\$500**.
  - Any extension request for filing the Statement of Use costs at least **\$475** (consisting of our \$350 fee plus a USPTO fee of \$125/Class). This recurs every six months (up to 5 times) until the Statement of Use (filing basis amendment referenced above) can be filed.

## ***HOURLY RATES***

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- \$560/hour for a partner;
- **\$340/hour** for a senior trademark associate (incurs the most time);
- \$110/hour for a law clerk.

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<sup>4</sup> Based upon our 2017 Trademark Fee Guidelines (Handout TM-01)