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Protecting Your Innovations and Trademarks Through
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PROCEDURES AND COSTS FOR TRADEMARKS

PLEASE NOTE: This information is provided for general informational purposes only, and does not constitute legal advice for any specific situation or facts. For legal advice, please contact one of our attorneys. The purpose of this document is to provide as much detailed information as practical but it is impossible to include all the variations and exceptions of the law.

1. Introduction

Your business uses words, logos or packaging designs that have become associated in customers' minds with your business. If the words, logos or other associated images were used by a competitor, customers would be misled into the mistaken belief that the competitor's product comes from you. You want to be able to stop any competitor from such a misleading use. Trademark protection gives you the opportunity to do so.. A trademark registration may be the best way for you to protect your rights, but how do you go about obtaining one? This is a brief outline of the major steps and some typical costs incurred to obtain a U.S. Trademark Registration.

Numerous cost ranges are listed below in order for you to have an idea of what might be the cost in a typical case. These should not be taken as quotes for any particular case. If you have any questions about costs, payment or any other matter, we sincerely hope you will raise those so we can resolve them. Furthermore, filing fee increases by the U.S. Patent and Trademark Office and inflation can result in increases in these costs. The costs estimated in this document are current for February 2025.

2. Selecting A Trademark Or Service Mark

A trademark is a word, group of words, symbol or combination of these that distinguishes the products of one competitor from the products of other competitors in the marketplace. For example, hamburgers are sold by Burger King, Wendy's and McDonald's. Their trademarks are the principal way that customers distinguish one competitor from the others. The goal is to select and clear a trademark that has sufficient legal strength that enables its owner to stop others from using the mark, avoids or minimizes the expenses necessary to defend or enforce it, and minimizes the risk that its owner will be required to stop using it after having built up a reputation associated with it.

To understand how to select a trademark and what to select, clients should understand what a trademark does and does not do in the marketplace. Legal principles are based on the purpose of a trademark and poor choices are usually based upon a misunderstanding of this purpose. When a customer purchases goods or services that have a prominently displayed trademark associated with those goods and services, customers usually at least see that trademark. If they like or dislike a product they purchase, they are likely to associate their favorable or unfavorable impressions of the product with the trademark. The next time they see another product with the same trademark, they will remember the impression they gained from the prior purchase. These impressions accumulate as a result of customer experiences, which include not only the purchase of products but also their exposure to advertising and what others have said about products sold under various trademarks. Therefore, a trademark acquires a reputation, commonly called goodwill, although unfavorable experiences may create badwill and different people may have different impressions. Nonetheless, use of a trademark creates a composite reputation among the consuming public. This reputation grows in response to the length of time the trademark is used and the extent to which the trademark is promoted. One purpose of trademark law is to protect this reputation/goodwill for a trademark owner who earned it by providing good products and/or paying for advertising. Another goal is to protect the public from being misled or deceived. Such a deception occurs if a second company later adopts a trademark that is so similar to an already established trademark that customers are likely to purchase the product of the second company in the mistaken belief they are getting a product which comes from or is approved by the company that established the reputation and goodwill in the trademark by first selling products in association with its trademark.

What should a business person choose as a trademark? Let's start with what they should not choose. Trademarks that are descriptive should be avoided. "Descriptive" means that the word, word combination, or symbol describes some characteristic or feature of the product or service sold with the trademark. Descriptive words give

information to the ordinary customer about the product. The reason the law does not protect descriptive marks, with some exceptions, is that all competitors in the marketplace must be able to tell their customers about the characteristics and features of their products. Examples of descriptive marks are "Commercial Door Company", "Basement Repair Specialists", or "Ohio Equities". Furthermore, many people choose descriptive terms, and therefore choosing a descriptive term also increases the probability that someone is already using something similar. Generally, surnames should also be avoided. The courts are reluctant to stop others from using the same surname because they do not like to prevent someone from using his or her own name in a business.

Although the law seeks to avoid protecting descriptive marks, there are exceptions. If a descriptive term or surname is used so long and so extensively that customers have come to associate a particular company with that term, then such marks can be protected. Consequently, we have trademarks like MCDONALD'S, SEARS, and KROGER, all of which are surnames, and we have marks like OLD FASHIONED HAMBURGERS which was initially descriptive of the associated product. If a descriptive mark or a surname is used, it is likely that the passage of substantial time, and possibly the expenditure of a substantial amount of money for promotion, will be necessary before that mark qualifies as an exception. In the meantime the right of an owner of a descriptive trademark to stop others from using the trademark will be uncertain and may never come into existence.

Instead of a descriptive mark, the better choice is a trademark that is coined, arbitrary or suggestive. A coined mark is one that has no meaning in the language, such as GOOGLE, KODAK or XEROX. A coined word, because it is unknown elsewhere, can become strongly associated with its owner in the minds of customers. An alternative is an arbitrary mark which is one found elsewhere in the language but is without any meaning associated with the particular business. Examples are GIANT EAGLE for grocery store services or APPLE for electronic devices.

Another alternative is a suggestive mark which is not descriptive, but nevertheless creates a favorable image or suggests a desirable connection to the product. Examples of a suggestive mark are GUARDIAN fence, HURRICANE ram-doubling software, and BUDGET car rental. None of those words is descriptive of the goods or services because they require human imagination to connect the goods/services with the mark. Nevertheless, these marks create a favorable impression because of the images that are formed in the human mind as suggested by the mark. It can also be helpful to choose recognizable portions of words and combine them into a mark. Examples include MICROSOFT, LOGITECH, or NETSCAPE, a clever combination of network and landscape.

It is difficult to think of a good trademark. Many companies spend a lot of time and go to great expense to find suitable trademarks. Those who are trying to select or coin a mark should avoid thinking in terms of using the trademark to convey information, because this normally results in descriptive terms. The mark EXXON was chosen by having a computer generate hundreds of letter combinations into made-up words and having a human scan through them for something desirable. Another way is to look at lists of words. For example, one might go through a dictionary word by word. If a word is descriptive of a characteristic or feature of the goods or services, go to the next word. If it is not, think about whether it would present a desirable image to be associated with the goods or services. This can also be accomplished by checking through text, such as advertising literature, to simply go word by word treating the text as a list of words. As noted above, one may also look for pieces of words that convey a good image and which may be combined with other pieces.

After a mark is selected, it should be cleared by finding out if someone is already using a similar mark. That requires a trademark search. The question is: how similar is too similar and therefore would result in a conflict. This is determined by imagining an ordinary customer who observed the mark in connection with the goods or services and observed the possibly conflicting mark used in connection with the other company's goods or services. The question is whether that ordinary customer would be likely to believe, as a result of the similarity of the marks, the similarity of the products, and other market circumstances, that the product of one company comes from the other company, is approved by the other company, or that the two products come from related companies.

There are three other important items clients should remember in selecting a mark. First, the fact that one has a corporate or company name registered with the Secretary of State does not ensure that the Secretary of State has researched other names and confirmed that the name is a trademark or service mark that one may use in business. Second, businesses obtain important legal rights just by using a trademark in the marketplace even without obtaining a registration of the mark. The rights obtained without registration are called "common law" rights for historical reasons. Although a registration is not necessary, a trademark registration greatly strengthens the mark and the legal right to stop others from using a similar mark. Finally, it is prohibited to use the symbol for trademark registrations (the ® symbol) until one has a trademark that is registered with the U.S. Patent and Trademark Office. Until then, it is typical to use a superscript TM to indicate to others that you consider a mark to be your trademark.

3. Trademark Search

Sometimes it is preferable to do a trademark search before applying to register. In a more limited trademark search we are looking for existing registrations or pending applications of others of trademarks that might be in legal conflict with a client's mark. In a more extensive search we are also looking for uses of a similar trademark by others who have not registered the trademark, because some important legal rights to a trademark are obtained by merely using a trademark even without a registration of that mark. However, a trademark registration cannot take away legal rights previously obtained by use of the trademark before a registration.

One reason to perform a search is to get some idea, before you expend the time and money to build up a reputation and goodwill in a mark, whether you are likely to encounter a conflict with someone else's mark later. It is desirable to estimate the probability that you might be forced to stop using a mark because of such a conflict.

Another reason to search is that there may already be a registered mark, or an application to register a mark, with which your proposed trademark would conflict and therefore which would prevent you from obtaining a registration after applying. However, a search may not be worth the cost if so much goodwill in a mark has already been established that, even if there were a conflict, its owner would not change the mark.

Another consideration is that a search can cost nearly as much as the cost of applying to register, depending upon the extent of the search. Therefore, it may be preferable simply to apply and see what the United States Patent and Trademark Office finds as potentially conflicting marks. However, because the United States Patent and Trademark Office does not look for unregistered uses of a trademark, clients should not be misled into the belief that there is no risk of conflict just because the United States Patent and Trademark Office finds no conflicting mark.

This choice of whether to search first or apply without a search requires a balancing of these competing factors and evaluation of risks and costs. You must make that decision, because no attorney can weigh risks and costs for you. However, we can advise you as you consider the many factors involved. If there are any significant doubts, it is typically more prudent to conduct a search.

Although trademark searching can be conducted over a broad range of effort and expense, we believe there are two levels of searching which are appropriate for most situations. The first and most important level is to search in the U.S. Patent and Trademark Office. However, that search is limited to applications and registrations in the U. S. Patent and Trademark Office and does not extend to state registrations, domain names and common law uses without a registration.

The second level extends the search to additionally include state registrations, internet domain names and common law uses by others who have not registered, but who might have some important legal rights as a result of their use. The second level takes longer and is the most expensive search. The greater the extent of a search, the greater the likelihood that someone else with substantial rights to a similar mark would be found, but also the more expensive the search becomes. No amount of search effort can completely eliminate all the risk of missing another user of a conflicting mark.

If the cost of searching is justified, ordinarily, it is desirable to perform a preliminary screening search at the first level to initially determine if there are any obvious, clearly conflicting marks and then, if there are no obvious conflicts, proceed to a comprehensive search at the second level. This is especially true if you have more than one prospective mark you may be considering adopting. Although it cannot be considered sufficient, clients can do some preliminary screening on the web site of the U. S. Patent and Trademark Office at www.uspto.gov. Of course, we recommend against relying solely on your trademark searching skills and your ideas of the law of trademarks. However, such search results could turn up one or more similar marks that we could evaluate for conflicts.

We can do the preliminary screening search that will also include our legal opinion and will cost approximately \$900 - \$1200, depending on several factors. A comprehensive search at the second level, including our legal opinion, will cost \$2500 to \$3000. The second level is the safest and most reliable, but also is the most expensive search we make under ordinary circumstances.

4. Conflicts Between Trademarks

When determining whether there is a conflict between your mark and another mark, such as must be done in connection with a search, we must form an opinion whether there is a "likelihood of confusion" between uses of the two marks. Two marks are in conflict if their use would be likely to confuse ordinary customers into the mistaken belief that the two companies using the two marks are really one, or are related to each other, or that the product or service of one is approved by the other. To evaluate this, we compare not only the marks but also various other aspects of the use of the marks in the commercial world. For example, we consider the nature of the goods or services for which each of the marks are used, the channels of trade, the nature of the customers and the extent to which similar terms are used by others.

5. Descriptive Terms

The purpose of a trademark is to distinguish the source of the goods or services of one company from the source of the goods or services of another company. As explained

above, the purpose is not to convey information about the product. A competitive market system requires that all competitors be permitted to describe the characteristics or features of their goods or services. As a result, words that ordinary customers would perceive as describing characteristics or features of the goods or services cannot be protected as trademarks with some exceptions. For example, words that are initially descriptive are used by one competitor so extensively that they come to be associated by ordinary customers with one competitor, then they can be protected as trademarks. Thus, while “frigid air” might describe what a refrigerator makes, Frigidaire can become a trademark. However, it can be difficult and risky to prove that there has been enough exposure of the term to customers that they associate it with a particular company. Similar principles apply to geographically descriptive words and to surnames. For more on this topic, see section 2 of this document (Selecting A Trademark Or Service Mark).

6. Graphics Plus Words

Sometimes a trademark consists of two principal parts: a word portion and a graphical portion. Ordinarily there are the possibilities of registering the word portion alone, the graphics alone, or the combination. The first two possibilities do not exist if the word portion and the graphics are inseparable, that is, the words and graphics are so intertwined that they do not create separate impressions.

An application to register the combination of one or more words combined with a graphical feature or logo is subject to refusal based on either of the component parts. However, if approved and registered, then it is likely, but not certain, that either component could be registered alone. Unless a client wishes to attempt to register all three ways, the client should make a practical determination whether either the graphical feature or the word feature is considerably more important to the client than the other. Ordinarily, words are of greater importance because they can be verbalized by an ordinary customer and therefore are more easily remembered and communicated to others. Typically the more important features would be registered first.

The registration of the combination carries the least strength for the following reasons. The purpose of obtaining a registration is to stop others from using the same or a similar mark. If another company adopts a mark that a trademark owner would wish to enjoin, a court would compare the mark as registered by the owner to the mark as used by the other company. The more that is shown on the registration, the more the company has to point to as being differences between the company's mark and the owner's registered mark. Thus, for example, if we registered the combination, a company that used the word alone would point to the absence of the graphical feature in its mark, along with the presence of the graphical feature in the owner's mark as registered, as being an important difference that would weigh against infringement. Consequently, if either the

graphics or the word is clearly more important than the other portion, then the most important portion should be registered alone. The secondary portion may also be registered, but only if the secondary portion is important enough to justify the additional cost of a second registration.

7. Registration Procedure

A trademark application can be filed following an actual use of the mark in business in association with the sale of goods or services, or an application may be filed before use upon the basis of a good faith “intent to use” the mark. However, although the mark in an application based on intent to use can be *approved* for registration before an actual use occurs, an actual use must occur and evidence (a “specimen”) of that use must be submitted before the registration will be granted. An intent to use application prevents a second party from learning of a first company's plans to use a mark and then gaining superior rights to the mark by using the same mark itself before the first company has an opportunity to do so. It also offers protection against an inadvertent innocent use of the mark by another company in that interim period between a decision to use a mark and actually using it. The filing date of an intent to use application can also provide a legal date of first use, which is usually important in resolving conflicting rights.

The registration procedure for both actual use and intent to use applications begins with the preparation and filing of an application to register a trademark. A typical cost for filing a basic application is \$1350 that includes an attorney fee of \$1000 and a \$350 filing fee for one class. But the cost can be more because of application filing requirements and government filing fees that the U.S. Patent and Trademark Office adopted and can result in a filing fee that is \$200 more per class. We can give you an estimate for filing your application after we learn from you some important information about your trademark, especially the goods and/or services that are or will be sold by you in association with your trademark. There are several factors that determine the cost. For determining filing fees, the U.S. Patent and Trademark Office uses a classification system for specific goods and services. Each item of goods and each kind of service falls into one of their classes. The government filing fee for filing a trademark application in part depends upon the number of classes that your goods and services require and whether your goods and/or services are unusual or common. The cost for attorney services can be increased if your application requires an unusually large number of goods and/or services or includes uncommon goods and/or services because those can increase the amount of work that your attorney must do in order to prepare your application. Therefore, it is desirable to let us give you a cost estimate before you decide whether to have a trademark application filed.

After receipt in the U.S. Patent and Trademark Office, the application will await its turn to be examined. After several months, a trademark examining attorney will read the application, perform a search for conflicting trademarks in the U.S. Patent and Trademark Office, and look for other matters to which he or she may object as preventing registration. The examination is very rigorous. The trademark examining attorney will then communicate in writing to us stating the initial position of the Office and will, in most instances, require various changes. It will then be necessary to make the changes in the application to accommodate the legitimate concerns of the examining attorney, or point out to the examining attorney how the concern is inappropriate, in error, or not well founded. The U.S. Patent and Trademark Office allows 3 months to submit any changes and explanations. An additional 3 months can be obtained but at a cost.

For example, the examining attorney may object that the mark conflicts with another mark already registered in the U.S. Patent and Trademark Office. The examining attorney may object that the mark is descriptive or a surname or does not conform to the mark as used on any specimens. Usually the examining attorney seeks a change in the description of the goods or services recited in the application because he or she wants such descriptions to conform to already accepted descriptions to the extent possible. The application should describe the specific goods upon which the mark has been or will be used. The description is not supposed to be a claim to a class or kind of goods for which the applicant has rights. Goods or services that are not in a trademark registration can still infringe the trademark if they are sufficiently similar or related to the goods or services that are in the registration. The courts decide whether they are sufficiently related if there is litigation involving the mark. Also, the Office does not permit a broadening of, or additions to, the goods or services that are described in the initial application, nor does it permit any changes of substance to the drawing of the mark. Consequently, the initial application should describe the services in a sufficiently broad manner to permit later changes to a narrower, more specific description.

In light of the possible bases for objection, it is usually necessary that we communicate at least once, if not a few times, with the trademark examining attorney. This results in additional cost. While it is impossible to predict the additional cost because we cannot predict what the examining attorney will do (and therefore what we will need to do in response), our experience is that typically you can expect the additional cost to be in a range between a few hundred to a few thousand dollars, and usually it is around the middle. For exceptionally complex or lengthy communications, the cost could be substantially more. Registration, of course, is not guaranteed.

If the examining attorney finally approves the mark for registration, the mark will be published for opposition. Any person or company that believes damage would occur to it

as a result of your registration may oppose registration. In that event, a proceeding is conducted under the supervision of the U.S. Patent and Trademark Office to determine whether the objection is appropriate. Such oppositions are relatively infrequent. Cost estimates for oppositions are uncertain because they depend upon the particular facts and what the other party does. Usually oppositions are settled by reaching an agreement.

If there is no opposition or if the applicant prevails in the opposition, the mark qualifies for registration. If the application was based on actual use, it is then registered. If the application was based on an intent to use, then it will be registered only after a statement of use is filed along with specimens of that use. There are time limitations and opportunities for six month extensions of time in appropriate circumstances for up to a total of three years. The cost for filing evidence that the mark has been used is typically around \$500, plus a \$150 per class fee which needs to be paid to the U. S. Patent and Trademark Office. The cost for obtaining time extensions is approximately \$200, plus a \$125 per class fee paid to the Patent and Trademark Office. All government fees are periodically increased.

8. Post Registration Requirements

Rights in a federally-registered trademark can last indefinitely so long as the owner continues to use the mark to identify its goods and/or services and files all necessary documentation in the United States Patent and Trademark Office. In order to maintain a registration, the owner of the registration must file affidavits at appropriate times.

Between the 5th year and the 6th year after registration, the owner of a trademark registration must file a Declaration of Continued Use or Excusable Nonuse (also known as a "Section 8 Declaration"). Failure to file this affidavit results in cancellation of the registration. Additionally, after 5 consecutive years of continuous use in commerce following registration the owner may file, but is not required to file, a Declaration of Incontestability under Section 15 of the Trademark Act ("Section 15 Declaration"). It is common for us to remind clients of the deadlines to file these affidavits and the need and benefit of filing both affidavits simultaneously, but we recommend clients keep track of these dates themselves because of their importance. The cost for filing both declarations (not each) at the same time is approximately \$500 for attorney services and \$425 per class for the government filing fee.

In addition to the filing between the 5th and 6th years, it is also necessary between the 9th year and the 10th year after registration to file a Section 8 Declaration and an Application for Renewal under Section 9 of the Trademark Act (also known as a "Section 9 Renewal"). Failure to file these documents results in cancellation of the registration. Again, we remind clients of these dates, but because of their importance

they should also be tracked by clients. The approximate cost for filing an application to renew a registration is typically around \$600 for attorney services plus \$525 per class for the government filing fee.

Once these affidavits have been filed, the owner of the registration must file Section 8 and Section 9 renewal affidavits before every subsequent 10 year anniversary for as long as the owner uses the trademark and wishes to maintain the registration in force.

9. Conclusion

It is important that you understand the anticipated events and costs before you proceed. No one wants you to be surprised. Therefore, please ask any questions which occur to you at any time. We would be pleased to have the opportunity to serve you in trademark matters.

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