

As featured in **Seattle Business**

Intellectual Property

Should you file trademark applications on your own?



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Recent news articles have talked about the pros and cons of individuals filing their own trademark applications without the benefit of experienced counsel. While this is an option to consider, intricacies in the filing rules and the trademark selection process may make the application process more difficult than merely filling out an online application and paying the fee.

Let's backtrack. First, individuals *may* file for trademarks on their own, and non-lawyers within corporations can file for trademark applications for their companies without using an attorney. However, individuals who are not attorneys *may not* file trademark applications on behalf of other individuals or corporations.

But the real question is: "Should you file an application without the benefit of counsel?" The "official" legal opinion on this is "it depends." Before considering filing your own application, you must know the rules regarding filing and be able to answer the pertinent

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filing questions. For example, how do you complete an application, how do you properly identify your goods and services, what does a Section 1(b) or "intent-to-use" application mean compared to a "use-based" application and how do you determine the date of first use? The answers to these questions may not always be straightforward. The U.S. Patent and Trademark Office (USPTO) has a listing of acceptable goods and services in the *Acceptable Identification of Goods and Services Manual*. But what if your goods or services do not appear in the listing? How do you know what type of goods yours comes closest to? Getting this question wrong can mean a denial of your application without any refund of the filing fees.

If — and here come a lot of what-ifs — (1) the filer is only going to be filing for a finite set of goods; (2) those goods are explicitly identified in the *Acceptable Identification of Goods and Services Manual*; and (3) there is little likelihood of expanding the offerings beyond those finite goods, then the answer to whether you should file on your own is "maybe." Another consideration is whether the filer has already conducted a screening search looking for other similar or potentially

confusing marks. If the filer has conducted such a search, preferably beyond the USPTO website and including both a Bing and a Google search, then the answer is a less-qualified "maybe."

The downside to filing a trademark application on your own is risk of the unknown, whereas an experienced trademark lawyer is more likely to have run across a similar scenario in the past. For example, can you apply to register for marks that include a ".com" in the name? (Generally, the answer is no.) How likely are you to trigger a cease-and-desist letter or an opposition from a company whose trademark is similar to the one applied for? If there is a similar or even identical mark that you found in your search, but it is being used for a different type of goods or services, can you still apply to use it? How should you describe the use you intend to make or already are making of your mark? And, finally, what should you include in your description of goods and services?

There are many traps here for the unwary. While it can be fraud on the Trademark Office to identify goods that you do not intend to use, applicants face the reverse problem as well. Too narrowly limiting your identification may cut off your ability to protect actual use of your mark. And trademark rules do not allow an applicant to add to identification of goods and services after the initial filing. You can limit goods and services, but not expand them after the filing.

Because all the questions posed here are fact- and mark-specific, and because of the filing considerations involved in a trademark application, the less risky and more practical answer to the question "should you file your own trademark applications?" is actually "probably not." The USPTO lists trademark facts and resources at uspto.gov/learning-and-resources/trademark-faqs, and offers guidance on using private legal services, including "what a private attorney could do to help avoid potential pitfalls," at uspto.gov/trademarks-getting-started/using-private-legal-services.

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