

Should I Apply to Register My Trademark ?

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In my article "*Should I Get a Trademark*" I explained:

- what a trademark is;
- what types of things can be trademarks;
- that
 - having a trademark,
 - owning a trademark, and
 - keeping ownership of a trademark,are 3 separate things that each require different actions on the part of the trademark owner;
- what a common law trademark (a.k.a. unregistered trademark) is and how to obtain a common law trademark; and
- what a registered trademark is;

As stated in my article "*Should I Get a Trademark*" the easiest and most reliable way to own a trademark is to register it in the Trademark Office of the country in which you want to own that trademark. However, registering a trademark is not like buying something, where you pay your money and you get the thing you bought. You cannot simply register a trademark. **You have to apply to register a trademark.** There is a government Trademark Office fee you have to pay in order to file an application to register a trademark; and if you hire a lawyer or trademark agent to do the work for you, they too will charge a fee.

If your trademark application is successful, then you will own the trademark in the country in which you have registered it; you will not own it world-wide, you will own it in the country in which you have registered it, nowhere else. If your trademark application is not successful then you will not get a registered trademark. Trademark applications can be filed in as many countries as you are willing to pay for, and there are some

international conventions which allow that to be done with less effort and less expense than filing separate trademark applications in each country; but there is no such thing as a world-wide trademark where a single trademark registration gives you world-wide protection. There is also no such thing as a European trademark or an Asian trademark, where a single trademark registration gives you protection throughout Europe or throughout Asia.

Registering Your Trademark vs. Not Registering It

Two reasons a person might choose to NOT apply to register their trademark are:

- **(1)** The cost. If you are not certain that the trademark you are using for your products or services attracts customers, and you feel that the name or trademark under which you sell your goods or services is irrelevant to your sales volume, then you might find the fees to apply to register your trademark an unnecessary expense. Or if your income is not very high you might find filing fees too expensive.

On the date this article was revised, if you do everything yourself, then for a simple trademark application which covers **only one class of goods or services**, will have a government filing fee in Canada of between \$330. to \$430.; and in the States between US\$225. and US\$400. The government filing and government ancillary fees go up from time to time. If you hire a lawyer or trademark agent, you can expect their fees to range from \$400. to thousands of dollars. Lawyers' fees and trademark agent fees often have no relation to the level of service or expertise that you will receive and usually bare a huge relation to how much the lawyer or trademark agent believes you will pay to hire them.

There are other government fees that will come up between the date you file your trademark application and the date you receive your trademark registration or have your application finally rejected and do not receive a registered trademark.

My estimate, at today's costs, is that, including the government filing fee, on average the government fees for filing a trademark application and the ancillary fees for seeing it through to becoming a registered trademark or having it finally rejected,

for a simple trademark application which covers **only one class of goods or services**, will be between \$500. and \$1,000. in Canada and between US\$500. and US\$1,000. in the States.

If you hire a lawyer or trademark agent to do the work for you then their fees will be in addition to the government fees.

By way of example, a simple trademark application in one class of goods would be if the trademark is an English word or phrase, and the application is to register it for the selling of T-shirts, sweat shirts, shorts, and pants.

By way of example, a simple trademark application in one class of services would be if the trademark is an English word or phrase, and the application is to register it for providing the service of landscaping.

In each of Canada and the States there is an additional government filing fee for each additional class of goods or services that are included in the trademark application. Each item that would likely be found in a different area of a store is likely in a different class of goods. Each different type of service is likely in a different class of services. As mentioned above, each different class of goods or services adds an additional government filing charge at the time of filing the trademark application and will often also add additional ancillary fees during the course of pursuing the application to its end (ie. receiving a registered trademark or receiving a final rejection and no registered trademark).

You can view a complete list of the government trademark filing and ancillary fees at the government's trademark office's website.

- **(2)** The risk of attracting unwanted and dangerous attention to your use of your trademark.

Many corporations, literally many tens of thousands of corporations, hire services to continually check applications for the registration of trademarks. If you apply to register your trademark then it will appear on a list of applications to register a trademark. If your trademark is one that a corporation feels might infringe on their trademark, or they just don't want you to own that trademark, they can oppose your application, and they can sue you to ask a court to prevent you from using your trademark. On the other hand, if you did not apply to register your trademark, it

may never have come to the attention of that corporation and they will never sue you to get you to stop using your trademark as they will never know that it exists.

Just because a corporation, even a very large corporation, opposes your trademark registration application, does not mean they will win and your trademark will not get registered. I have fought for small businesses against some of the biggest corporations in the world and won, and the small business got their trademark registered. Just because a corporation sues you to stop you from using your trademark does not mean they will win; I have won many times for small clients against huge corporations. However, it is a lot of work and therefore the legal fees will add up; my legal fees are much much less than the legal fees of the lawyers that the huge corporations hired, but defending your trademark against attack will not be free of cost.

Therefore, the bottom line is that if you do not want to risk getting into a legal battle with someone else over your trademark it is best not to apply to register your trademark, with 4 exceptions:

- Your trademark will be used in such a way that it will come to the attention of a wide range of the public, just from your use of it; in that case it is likely that a large corporation will find out about your use of your trademark simply from your use of it, and applying to register it will not bring any additional attention to your trademark;
- your trademark is attracting customers and if you could not use your trademark or someone else began using your trademark or a very similar one, your sales volume would decline;
- you love your trademark and don't want to risk losing it;
- you don't love your trademark, but you also don't want to risk losing it.

Four reasons a person might choose to apply to register their trademark are:

- **(1)** After your trademark becomes registered you own it in the country in which you registered it for the goods/services for which you registered it. Therefore, you can go to court to stop others from using it or from using a confusingly similar trademark on the same or similar goods/services as those for which you registered

your trademark.

Whether or not you will win in court is unknown, however, with a registered trademark you have your best chance of winning.

Going to court is not free, there are court filing and other costs, and if you hire a lawyer there are legal fees which are usually huge, unless you hire me, in which case they are relatively low. But if it is your intention to try your best to ensure that no-one else uses your trademark or a similar one, on the same or similar goods/services as those on which you use your trademark, then definitely apply to register your trademark, as if you get it registered then you will have your best chance of being able to stop others in the country in which you registered your trademark.

- **(2)** After your trademark becomes registered you own it in the country in which you registered it for the goods/services for which you registered it. Therefore, it would be very difficult for others to succeed in suing you to get you to stop using your trademark on the goods/services for which you registered your trademark.

- **(3)** After your trademark becomes registered you own it in the country in which you registered it for the goods/services for which you registered it. Therefore, potential trademark poachers will not be able to register your trademark or a similar trademark for the same or similar goods/services as those for which you registered your trademark. If you do not register your trademark and a trademark poacher succeeds in registering your trademark (which then becomes their trademark) for the same or similar goods/services as those for which you use your trademark; then they will own your trademark and can stop you from using it.

- **(4)** For the trademark owner to also own the appreciation in value of the trademark, usually the trademark must be a registered trademark. As explained in my paper "*Should I Get a Trademark*" it is difficult to prove ownership of an unregistered trademark, and it is even more difficult to prove ownership of an unregistered trademark in areas beyond the geographical bounds of your normal customer base. As also explained in my aforesaid paper, if you cannot prove ownership of your unregistered trademark sufficiently to satisfy a court, then you don't own it and anyone can use it without your permission, hence any appreciation in value of that trademark did not accrue to you, as others can use it without out paying you to use it. *¹ If your trademark is registered then the law says you own it

*¹ It is more complicated than as just explained, for a full explanation read my paper "*Should I Get a Trademark*"

in the whole country in which it is registered and therefore people in that country must pay you to use it, or you can forbid people from using it in that country; hence any appreciation in value of that trademark accrued to you.

Hiring a lawyer or trademark agent vs. Not

One reason a person might choose to NOT hire a lawyer or trademark agent:

- **(1)** The cost. Some of them are very expensive, and an expensive lawyer or trademark agent does not equal a lawyer or trademark agent that does good work. An expensive lawyer or trademark agent is just as likely to do good work as they are to do bad work; however even if they do good work, if they are expensive you are overpaying. ^{*2}

One reason a person might choose to hire a lawyer or trademark agent:

- **(1)** The expertise. If you know diddly squat about trademark law, then unless your trademark application is a simple trademark application which covers **only one class of goods or services**, there is a good chance you will screw it up and you will not end up with a registered trademark, or the registered trademark you end up with will have errors in it that make it less valuable and less useful than you thought it would be.

^{*2} Some lawyers or trademark agents charge a fair price and do good work; but those would not be reasons to not hire a lawyer or trademark agent.

Is trademark law complicated, is there a lot to know ?

Yes.

For example:

- to maximize your trademark ownership protection, how do you list the goods/services in your trademark application (more generic descriptions vs. less generic descriptions; longer lists vs. shorter lists; more classes vs. less classes) ?;
- for your specific trademark are multiple applications better than one application ?;
- should you include disclaimers in your trademark application(s) ?;
- should you break your trademark up into components and file separate applications on each component ?;
- does your trademark include anything that is prohibited from being registered as a trademark ?;
- does your trademark include something that might infringe on other trademarks, and hence your trademark application will be more likely draw you into a legal battle ?;
- does your trademark include something that might prevent it from being registered ?;
- if you want to register your trademark in a multiple of countries should you use a trademark convention ?;
- what type of application should you file, an application based on use, or an application based on intent to use, if some of your goods/services are already in use and some of them you are intending to use, but are not yet using ?

There are many other points in trademark law, but if you know the answers to most of the above questions, then you are also sufficiently knowledgeable to make your own determination as to whether or not to hire a lawyer or trademark agent. If you did not know the answers to most of the above questions, then you should hire a lawyer or trademark agent as you know diddly squat about trademark law.