



BRAND STORY

Module 11: On Your Mark, Trademark!

How to Trademark Your Brand Without a Lawyer

Learning Guide | with Bruce Miller

This learning guide captures the full content of Module 11 of the Brand Story course for readers who prefer text over video. All key concepts, steps, and examples are preserved below.

Disclaimer: This module is written by a brand strategist, not a lawyer. It offers practical guidance for shoestring start-ups seeking trademark protection at minimal cost. No guarantee is made that the USPTO will grant your trademark or that you will avoid legal complications. A trademark attorney is always recommended if your budget allows.

® vs TM – Know the Difference

Two symbols appear on brand names, and they mean very different things. The ® **symbol** signifies a federally registered trademark — a legal designation granted by the U.S. Patent and Trademark Office (USPTO). The ™ **symbol**, by contrast, has no legal meaning whatsoever.

Marketing teams routinely place ™ on product names and taglines for three reasons: To suggest ownership of a name, to signal an intent to register it, or to create market differentiation — a secret sauce. Used sparingly and strategically, this is acceptable. But sprinkling TMs indiscriminately on every branded term — as many agencies do — is a mistake. You might invite objections from actual trademark owners who could challenge your use of the mark.

This module is about earning the real thing: the ®. The federal filing fee is \$350. The process can be managed without an attorney. And the protection it provides is well worth the effort.



Key Insight: The ™ symbol has no legal weight. The ® symbol does. If you're serious about protecting your brand, go for the registered mark.

Why Trademark Protection Matters

Who Needs It – Not every business needs a federal trademark. A local plumber, salon, or coffee shop operating within a single geographic area can generally function without one. But if you sell products online, plan to expand into other states, or have ambition to scale, trademark protection is essential. The moment you operate online, your brand competes in a national (and international) marketplace.



State trademark registration is an intermediate option for in-state businesses: easier and cheaper than federal registration, and it establishes the date you first used the mark. But it doesn't give you true national ownership. International trademark protection is also available for businesses operating across borders.

The Cost of Not Registering: Three Trademark Stories

Donnie's Green Planet Lawn Care:

Donnie builds his lawn care business from high school through college. He's unaware that a franchising operation in Pennsylvania has registered "Green Planet" as a trademark and begun selling franchises — including one in Donnie's town.



The new franchise owner sends Donnie a cease-and-desist letter. Donnie has common law rights to the name in his geographic area, but common law rights mean nothing without the resources to fight in court. The unregistered name becomes a liability.

The Grange Public House:

True story: Three Irish siblings open the Grange, a beloved neighborhood pub in Atlanta. After years of operation, the National Grange of the Order of Patrons of Husbandry — a fraternal farming organization — demands that they stop using the name. The conflict may seem absurd, but without trademark protection, the pub couldn't afford a legal battle. At great expense, they rebranded as The Marley House.



Nann Miller Enterprises:

My mother operated her Los Angeles PR agency under her own name, without registering a trademark. A second PR professional, Nan Miller, in Chicago owned the trademark and challenged the use of the name. An out-of-court resolution required my mom to add an extra “n” to Nann and rebrand accordingly — a disruption that a \$350 filing fee would have prevented.

Key Insight: *Your rights don’t matter if you can’t afford a legal fight. A registered trademark is the only protection that holds.*

PRINCIPAL REGISTER Service Mark

Ser. No. 236,620, filed Jan. 17, 1966

NAN MILLER

Nan Miller & Associates, Inc. (Illinois corporation)
55 E. Washington St.
Chicago, Ill. 60602

For: PROMOTING THE SALE OF GOODS AND
SERVICES OF OTHERS BY ARRANGING FOR THE
AWARDING OF PRIZES AT CONVENTIONS,
TRADE AND PROFESSIONAL ORGANIZATIONAL

MEETINGS, FAIRS, AND EXHIBITIONS; PUBLIC
RELATIONS SERVICES — NAMELY, PROVIDING
EMPLOYEES WITH GIFTS IN RECOGNITION OF
THEIR YEARS OF SERVICE, BIRTHDAYS, AND
PROMOTIONS—in CLASS 101 (INT. CL. 35).

First use Jan. 2, 1963; in commerce Jan. 2, 1963.

M. H. MARKS, Examiner.

What Is a Trademark?

A trademark is a form of intellectual property issued by the federal government to prevent confusion in the marketplace. It can protect a brand name, a tagline, or a distinctive visual design. Coca-Cola, for example, holds trademarks on both its name and its iconic bottle shape.

The purpose of the system is straightforward: If a competitor launched a new kombucha called “**Koka-Boocha**,” the Coca-Cola Company would likely object because consumers might assume it was a Coke-branded product.

The USPTO’s role is to referee these decisions. Federal examiners follow the Trademark Manual of Examining Procedure and apply thirteen factors — known as the **DuPont Factors** — to assess the “Likelihood of Confusion” between competing marks.



The Spectrum of Trademarkability

Every potential trademark lives on a spectrum from Generic (the weakest, cannot be registered) to Coined (the strongest, most easily registered). Understanding where your name falls on this spectrum tells you how straightforward — or difficult — your registration will be.

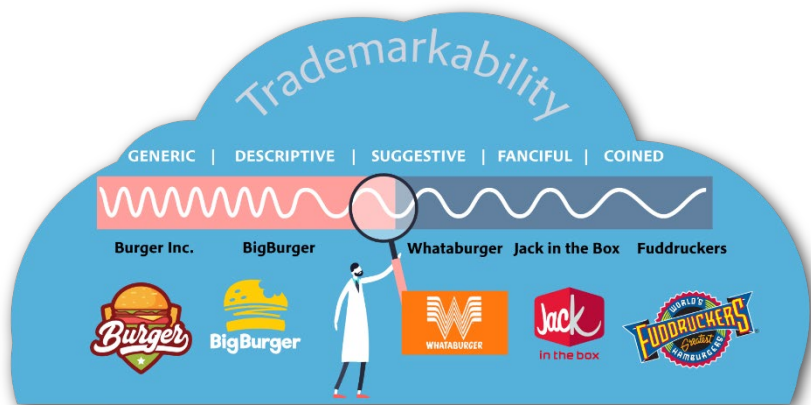
Type	Strength	What It Means	Examples
Generic	<i>Weakest — unregistrable</i>	An everyday, commonly used word. You cannot own it as a trademark.	<i>Burger, Gas and Oil, Steak 'n Shake (would not qualify today)</i>
Descriptive	<i>Difficult to register</i>	Describes the product directly. May be approved, but lives in a gray zone.	<i>Hot Pockets® — describes the food item, but received approval</i>
Suggestive	<i>Gray zone — registrable</i>	Conjures feelings or qualities associated with the product without literally describing it.	<i>PizzaFire®, Whataburger® — implies quality or method, not a literal description. The pizza is not ablaze.</i>

Fanciful	<i>Strong — easily registered</i>	A common word used in a novel, unrelated context.	<i>Apple Inc. computers have nothing to do with apples. Dove soap has no bird ingredients.</i>
Coined	<i>Strongest — easiest to register</i>	An invented word with no dictionary meaning.	<i>Häagen-Dazs®, Fuddruckers® — completely made-up words</i>

Suppose you want to trademark a burger shack by the beach:

The spectrum works like this:

- **Le Burger (Generic, won't fly).**
- **Big Burger (Descriptive, specializing in half-pound burgers, hard to register).**
- **Whataburger® (suggestive — In the gray area but succeeded. Its origin story ("What a great burger!") supported the mark)**
- **Jack in the Box® (fanciful — Easy to register; a child's toy has nothing to do with burgers).**
- **Fuddruckers® (coined — made-up word, strongest protection).**



Step 1: Perform the Trademark Search

Before filing, you must verify that your brand isn't already registered by someone else. This search is the core work performed by trademark attorneys. You can do it yourself at the USPTO Trademark Search database.

Here's how, using Donnie's **Green Planet Lawn Care** as the example:

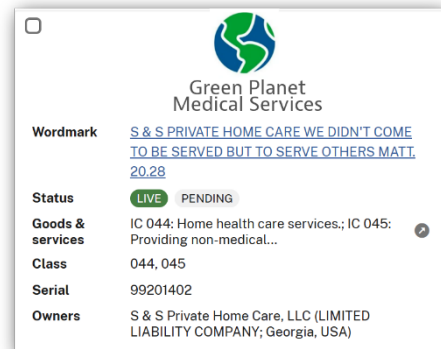
1. **Go to the USPTO website** and run an **Expert Word Search** on your full business name. Initial results will likely number in the thousands — including many “dead” (expired or abandoned) marks. **Uncheck the Dead filter** to remove them for fewer results.
2. **Filter by your International Class.** There are 45 trademark classes (34 for goods, 11 for services). Donnie's lawn care falls in Class 44. Use Google Search or an AI to confirm your class if you're unsure. Some classes are counterintuitive: (Medical services, beauty products, veterinarians, and landscaping are all in Class 44.)
3. **Uncheck Coordinated** – Removes adjacent classes (when checked, it will show similar brands in adjacent classes). For example, CHANEL offers Class 25 clothing and adjacent Class 14 jewelry. Unchecking narrows the results if you are just selling clothing.
4. Search again with **Coordinated checked** for a safety review (allowing you to double check adjacent brands).

5. **Strip out the generic words** from your search. For **Green Planet Lawn Care**, remove the generic “Lawn Care” and search on “**Green Planet**” alone to see if anyone has claimed that specific brand in your class.
6. **Review the narrowed results** carefully, scrolling through all matches. Look not only for exact matches but for similar-sounding names. A fashion line called **T.Markey** could block a registration for **Marquee Tees** under the DuPont Factors.

Suppose while searching your Class 44 lawn care brand, you discover **Green Planet Medical Services**, in the same Class 44.

Trademark law is meant to prevent "likelihood of confusion." Consumers likely won't mix up medicine with lawn care, so Donnie could likely register **Green Planet Lawn Care** even if **Green Planet Medical Services** is in the same Class 44.

It seems fuzzy, but this is how the examiner will make his decision.



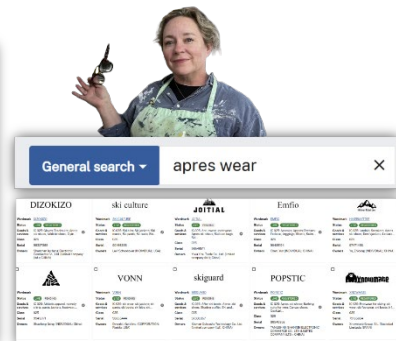
To succeed, the application description must state that it is **Lawn Care**, not **Medical Services**. And yes, this is obvious.

Donnie's search finds no active registration for “**Green Planet**” in Class 44 — not even in adjacent classes. The path looks clear.

Caution: Search accuracy is everything.

*When helping a friend register **Après Wear**, I searched for “**Apres**” without the accent mark — missing an existing trademark.*

That error cost \$350 in wasted filing fees. Always search with and without accent marks, alternate spellings, and phonetic variations.

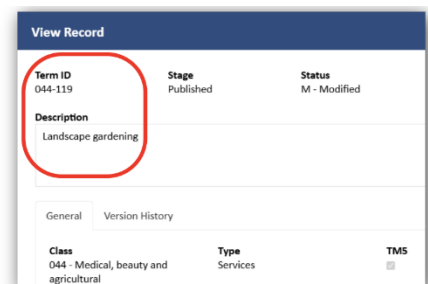
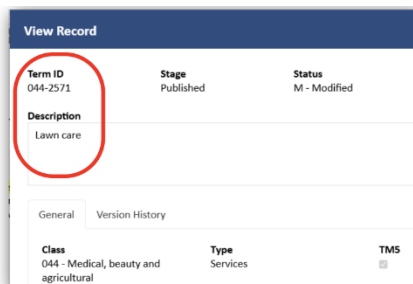


Step 2: Select Your Description from the Trademark ID Manual

The USPTO strongly prefers that applicants use pre-approved descriptions from the Trademark ID Manual rather than writing custom descriptions. Custom descriptions require an additional \$200 fee and are generally discouraged.

To find your description, go to the **Trademark ID Manual** (accessible from the USPTO homepage or via Google) and search on terms that describe your goods or services. Think of it as a dinner menu: browse the options and select the descriptions that most precisely fit what you offer.

Donnie searched on “lawn,” “gardening,” and “landscaping.” He found:



- 044-119: Landscape gardening
- 044-2571: Lawn care
- 044-2572: Lawn mowing services

He selected both 044-119 (Gardening) and 044-2571 (Lawn care) for his application. If you sell multiple products within the same class — shirts, pants, socks (all Class 25) — you select a separate description for each item but pay only one class filing fee.

Step 3: Prepare Your Specimen

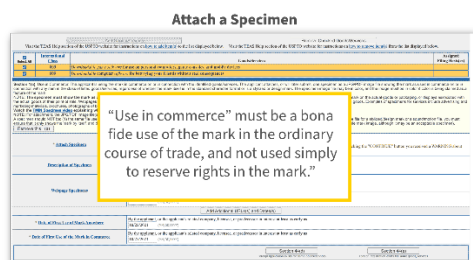
The USPTO requires evidence that your trademark is in actual commercial use. Proof of a finished product or a launched service is the specimen.

As a start-up, this can feel like a Catch-22: You want to register the trademark before you invest in the brand, but the USPTO wants proof of use before granting registration.

There are practical options for both service businesses and product businesses to submit an acceptable specimen, as well as an “Intent to Use” option for those not yet in commerce:

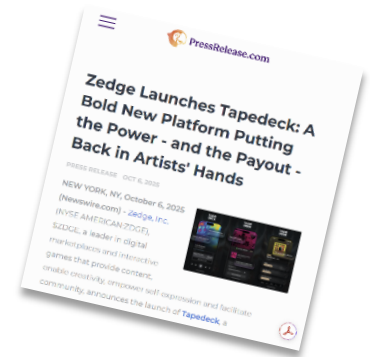


Business Type	Acceptable Specimen Options	Key Note
Service Business	• Website screenshot (use Wayback Machine for timestamp), • Press release (PR.com from \$60), • Business cards • Marketing brochures	<i>If you're ready to accept your first sale today, you are technically in commerce.</i> <i>You must submit a photo of your business cards or brochures. List your services on the card to match the services in your application.</i>
Product Business	Photo of your trademark on product packaging, garment label, bottom of a mug, software startup screen	<i>Must be an actual salable product — not a prototype or design file.</i>
Not Yet in Business	File an “Intent to Use” application with the USPTO	<i>Holds the trademark for 6 months while you prepare to launch. An additional fee applies.</i>



For website specimens, search on *Wayback Machine* (Internet Archive). It provides a time-stamped capture of your site, proving it was in active use on a specific date.

A professional press release also offers time-stamped proof.



Step 4: Submit the Application

With your class identified, descriptions selected, and specimen prepared, the heavy lifting is done. Filing the application is the final step:

1. Visit the **USPTO Trademark Center** and select **Apply to Register a Trademark**.
2. Verify your identity through the **ID.me** biometric system. If you don't have an account, create one — it will take a photo and ask questions from your credit history.
3. Create an online account with the USPTO.
4. Fill out the application form. Read everything twice. The language is technical, but if you've completed the steps in this module, the core decisions are already made.



A few important details when filling out the form:

- **Words only vs. design:** Most applications are for “words only.” A design mark (like Coca-Cola, FedEx, or McDonald's) is worth pursuing if your logo design is truly distinctive.
- **Two key dates:** You will need the date the mark was first used anywhere, and the date it was first used in interstate commerce. For most start-ups, these are the same date. A press release is a clean way to establish both.
- **Processing time:** Check the USPTO website for current processing estimates. Assume approximately six months from filing to initial review.

Trademark Design



Understanding Your Filing Fee: Trademark Classes

Your \$350 filing fee protects your mark in one trademark class.

The class system is what allows **Dove soap** (Class 3 — Cosmetics and Cleaning Products) to coexist with **Dove chocolate** (Class 30 — Staple Food Products) without conflict.

Each brand stays in its lane, and consumers aren't confused.

If the chocolate Dove ever tried to introduce a **chocolate-scented shampoo**, the soap Dove could sue for infringement.

Classes are protective fences that define the territory each trademark owns.



Some brands cross multiple classes as they grow.

Arm & Hammer holds registrations across **baking soda** (Class 1), **toothpaste** (Class 3), **cat litter** (Class 5), and **nasal mist** (Class 5).

Each class requires a separate trademark registration.

GE spans light bulbs, appliances, financial services, jet engines, medical imaging, and energy.

You can file in multiple classes simultaneously, at \$350 per class.



After Registration: Mark Your Calendar

Once your trademark is granted, the work isn't entirely over. Two maintenance deadlines must be met, or your trademark will lapse:

- **Year 5:** File a Declaration of Use of Mark in Commerce Under Section 8 with the USPTO. Add a reminder to your calendar the day your registration is confirmed. The USPTO will send reminders to your registered email — keep it current.
- **Year 9–10:** File a combined Section 8 and Section 9 renewal. A larger fee applies between years 9 and 10, and then every ten years onward for the life of the trademark. This is a small price compared to a cease-and-desist letter arriving without warning.

FIVE YEARS:

"File Declaration of Use of Mark in Commerce Under Section 8."

EVERY 10 YEARS:

Pay fee to maintain trademark



Once complete, celebrate. Your business has a protected name. It is, formally and legally, in a class of its own.