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THE PRIVATE BRIEF · AI & IP

Do You Need a Trademark Attorney? The Honest Answer

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IN BRIEF

- ◆ Applicants, registrants and parties to Trademark Trial and Appeal Board proceedings whose domicile is outside the United States must be represented at the USPTO by an attorney licensed to practice law in the United States.
 - ◆ Applicants domiciled in the United States are not required to have an attorney. The USPTO accepts applications filed by owners and encourages them to hire counsel, and its own employees cannot give legal advice.
 - ◆ What decides it is how distinctive the name is, whether anything close already exists, whether your goods fit the USPTO's standard descriptions, whether you are already selling, and how much is already riding on the name.
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You have read the U.S. Patent and Trademark Office's pages, opened the online application, and it looks like an hour's work. The USPTO's fee schedule currently puts the base filing fee at \$350 per class. So the question is fair: why would you pay a lawyer to fill in a form?

There are two answers, and which one applies depends first on where you live, and then on the name itself.

The rule that settles it for some people

If your domicile is outside the United States and its territories, the USPTO requires you to be represented by an attorney licensed to practice law in the United States. That covers applicants, registrants, and parties to proceedings before the Trademark Trial and Appeal Board (the USPTO's tribunal for disputes between owners). Domicile has a specific meaning here: for a person, the permanent legal place of residence; for a business, its principal place of business, which is where its senior executives actually direct and control it. If that place is abroad, the rule applies, and there is nothing to weigh.

Only a lawyer who is an active member in good standing of the bar of the highest court of a U.S. state or territory can represent you in a trademark matter at the USPTO. A lawyer licensed only abroad cannot, and neither can a filing service run by non-lawyers.

For everyone else, it is a real choice

If you are domiciled in the United States, you are not required to have a lawyer. The USPTO accepts applications filed by the owners themselves. It strongly encourages applicants to hire a U.S.-licensed trademark attorney, but it does not compel it. And there is one limit on its help worth knowing up front: USPTO examining attorneys can explain the registration process, but USPTO employees cannot give you legal advice.

So the honest answer for a U.S. applicant is: sometimes. Here is how to tell.

When filing it yourself is reasonable

We say this plainly, because it is true. Filing yourself is a reasonable choice when most of the following are true:

- ◆ **The name is invented or unrelated to what you sell**, a coined word or an ordinary word used in an unexpected way. Names like that are strong precisely because they describe nothing.
- ◆ **A careful search turns up nothing close**, on the USPTO's free database and on the open web.
- ◆ **Your goods or services are in the USPTO's ID Manual** (its list of pre-approved descriptions) in wording that genuinely fits, so you never need the free-form text box and the surcharge that comes with it.
- ◆ **You are already selling** under the name, so you can file on actual use and have a clean specimen (a real example of the mark in use, such as a label or a web page).
- ◆ **One class covers it.** (A class is one of the 45 categories the USPTO uses to sort goods and services.)
- ◆ **The name is not yet carrying weight.** Little has been spent, nothing is printed, and changing it next month would be an inconvenience rather than a crisis.

That is a real profile. If it fits yours, the USPTO's own guides will walk you through it.

When it stops being a reasonable bet

These are the things that change the answer:

1. **The name says something about the goods.** A name that merely describes what you sell can be refused as descriptive. Getting past that refusal can mean proving acquired distinctiveness (that customers have come to see the words as pointing to your business) with evidence of years of use, sales and advertising. The name usually sounded good in the meeting for exactly the reason it gets refused.

2. **Something close already exists.** A likelihood-of-confusion refusal, the USPTO's most common reason for refusing registration, is answered with analysis and evidence, not with a form.
3. **Your goods or services are not in the ID Manual.** The description then has to be written, and it sets the scope of what you protect for as long as the registration lives. It also brings a USPTO surcharge for each class that uses free-form text.
4. **You are filing on intent to use.** That route has a second half: after approval, the mark registers only when you file a statement of use, on a deadline. Extensions are limited in total, and an application that misses the last one is abandoned.
5. **Several classes, or a logo as well as the word.** More filings, more decisions, more places to be inconsistent.
6. **Someone objects.** An opposition or cancellation at the Trademark Trial and Appeal Board is, in the USPTO's own words, a trial proceeding similar to litigation in federal court.
7. **Money is already committed.** Packaging ordered, a launch booked. At that point the question stops being "can I file this myself?" and becomes "what does it cost me to be wrong?"

*The name usually sounded good in the
meeting for exactly the reason it gets refused.*

Two illustrations

Both are composites, not clients.

Reasonable to file yourself: an independent consultant already invoicing under an invented one-word name, one class of consulting services described by an ID Manual entry selected straight from the list, nothing similar found on the register or the web, and the consultant's own website advertising the services as the specimen. The government cost is the USPTO's \$350 base fee for one class, provided nothing required is left out and the description is chosen from the ID Manual rather than pasted into the free-form box.

Not reasonable: a food company launching cold-pressed juice under a name that simply describes the product (say, COLD PRESSED GREENS, an invented example). The name is doing marketing work, which is another way of saying it describes the goods. The juice line needs custom description wording, the company wants two classes, and the packaging run is booked for six weeks out. That company is not buying a form. It is buying a read on whether to keep the name.

If you already filed, and it went sideways

You missed a deadline and the application was abandoned. Where the delay was unintentional, a petition to revive is available, at a \$250 USPTO fee. It has its own short deadline, generally two months from the notice of abandonment, so this is not something to sit on.

You got a refusal and let the application go. An abandoned application does not by itself end your rights in the name, because rights in the United States come from use. You can file again, and sometimes a new application with a better-drafted description is a cleaner path than arguing. What a lapsed application costs you is its filing date. Once a mark registers, its filing date counts as nationwide use of the mark, which is exactly what a later applicant will be glad to have instead of you.

What we would tell you either way

The point of a clearance-and-filing engagement is not the form. Anyone can fill in the form. What you are paying for is the moment someone who has read the register tells you the name is a problem before you commit to it. If your mark is clean, distinctive, and describable in the USPTO's standard wording, the firm will say so, and you may reasonably decide to take it from there.

Trademark filing is federal practice, and the firm represents applicants anywhere in the United States. Its clearance, application and office action fees are published on its trademark page, so you can weigh the actual numbers.

Anyone can fill in the form.

One last thing is true whoever files: registration is never guaranteed. The USPTO decides, and it sets its own examination pace. No attorney controls either.

Where to start

This week, run three checks. Search the USPTO's free trademark database for your name, its closest spellings and its sound-alikes. Look up what you sell in the ID Manual and see whether an entry truly fits. And decide honestly whether you are selling under the name today or planning to. If all three come back clean, filing yourself may be reasonable. If any one of them does not, that is the conversation to have before you file.

This is general information about deciding whether to hire a trademark attorney, not legal advice about your application. USPTO fees change, so check the current fee schedule before relying on any figure here.

WRITTEN BY

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Anthony is the Managing Partner of Clemenza Law Group and serves as general counsel to a wide range of companies and philanthropic organizations. Nearly every essay here began as a real question from a real client: the contract that landed at 4 p.m., the board that meets on Thursday. He writes them the way he would answer you across the table, plainly and with care.

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