

**PRACTICE TIPS
FOR TRADEMARK
PROSECUTION
BEFORE THE USPTO**

HERSHKOVITZ IP GROUP

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Who am I?

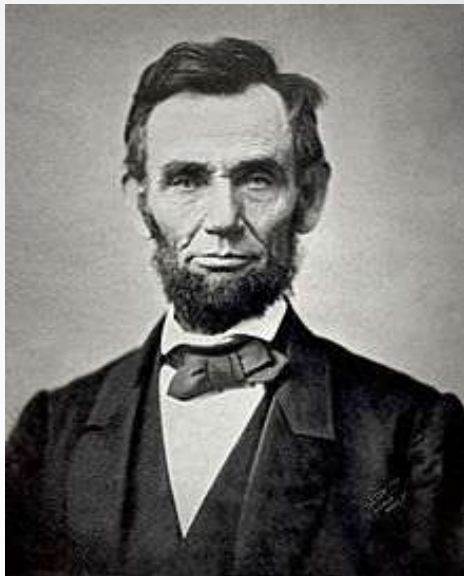


I am an Adjunct Professor of Trademark and Unfair Competition Law and a full time practitioner in this area of the law. I have taught this subject at Georgetown University Law Center and at the George Mason University School of Law for more that a decade. In addition, I have been a USPTO Trademark Examiner and Trademark Counsel for multinational U.S. corporations during my 38 years of legal practice. I have lectured, written published articles and I serve as Editor-in-Chief and co-author for the ABA IPL/BNA *Trademark Infringement Remedies* treatise on U.S. practice.

My goal today is share how to minimize the expense of obtaining a registration for your client in the USPTO.

Successful legal representation requires the ability to accurately anticipate and then manage your client's expectations. A little luck is also helpful.

Abraham Lincoln, the 16th President of the United States, was an Illinois attorney and inventor before he came to Washington in March 1861. He once said, "You can fool all the people some of the time, and some of the people all the time, but you cannot fool all the people all the time."



Tip: Keep your clients informed of developments regarding matters in your care. Clients do not like surprises.

HOW DO SO MANY LEGAL PROBLEMS VISIT OUR CLIENTS?

“WE HAVE MET THE ENEMY AND IT IS ... US.”

Clients often seek our help **AFTER** they make business decisions and participate in actions which create huge legal problems for their business goals. Experience it is said, is the best teacher. However, the tuition is often too great to ignore.

Tip: Get your clients to talk with you about their future plans not just their past and existing legal problems.

When appropriate, ask your client, “What is your goal in this matter and what amount of effort are you willing to commit to?” If the goal is for example to have an infringement of a mark stopped, document that goal and remind the client of that goal. If the goal includes something else, document and remind the client. Understand that clients change direction and people within client organizations assume new responsibilities so goal statements are very valuable to you.

WHAT IS THE GOAL YOU WANT TO ACHIEVE?

If the applicant's goal is to obtain a federal registration in the quickest time and at the least cost and delay... the obvious approach must include a TEAS Plus filing form for national applications based on use in commerce. First, the filing fee is the lowest among the three alternative fees. Second, the identification of services or goods is, by definition, pre-approved by the USPTO. Third, where none of the *obvious* grounds for rejection are involved, a TEAS Plus application has a very good chance of a first action publication of the mark for opposition. This saves applicants time, expense and places the mark on the shortest path to registration.

THINK BEFORE YOU COMMIT! IS REGISTRATION POSSIBLE?

After conducting an availability search and identifying no confusingly similar prior registrations ask if the brand candidate has other *obvious* problems in relation to the goods or services.

Is the candidate mark:

- Lacking distinctiveness or generic;
- Primarily merely a surname;
- A merely descriptive or deceptive term in relation to the goods;
- A primarily geographically descriptive term in relation to the applicant;
- A primarily geographically deceptively misdescriptive term in connection with the goods;
- A functional representation of the goods or qualities of the goods;

MANY APPLICANTS HAVE NEVER CONSIDERED THESE QUESTIONS AND RECEIVE INITIAL REFUSALS

- The name, portrait or signature of a living individual whose consent is not of record;
- Is the mark disparaging;
- Does it falsely suggest a connection;
- Is it deceptive, scandalous or immoral under US law;
- A simulation of some government symbol?

When in doubt, run the question by your U.S. attorney or associate for a quick opinion before filing the new application.

Remember, Trademark Examining Attorneys differ among themselves over these questions so there are no guarantees.

FILING FORM AND BASES IN PROSECUTION

Select the appropriate form for the application.

Paper form **\$375 per class**

Electronic (TEAS) **\$325 per class**

**Electronic filing and
prosecution using a
previously approved
identification** **\$275 per class**

Select the appropriate filing basis for the application.

Section 1(a) Use in Commerce

Section 1(b) Intent to Use

Section 44 Priority Foreign Application

Section 44 Foreign Registration from country of origin

**Section 66 Madrid Protocol Extension of Protection of an
International Registration at WIPO**

PROSECUTION

Tip: Every TEAS Plus application must be filed using an accepted identification pre-approved by the USPTO. This means that the Trademark Examining Attorney does not need to review the identification. Therefore, examiner time is saved. All other requirements are identical.

Most applicants want electronic form filing with their own identification of goods and/or services so today most applications are filed using the TEAS electronic form.

If the applicant wants to keep a application in limbo for the longest possible time regardless of the cost involved, then a paper application is the filing basis to use. By submitting an intent to use trademark and service mark application with a payment of only one fee in paper with only class headings for all 45 International Classes, the applicant can easily generate five years of Office Actions in this type of application. The Office will initially ask for 44 additional class fees plus a more definite statement of each class of goods and services using common commercial names only in the amended identification.

Foreign Applicants Need to Proceed Carefully at the USPTO

While the Madrid Protocol has saved everyone expense and time in protecting our clients valuable brands, it also has created certain unanticipated restraints and expense for ex-U.S. applicants.

Since all Extensions of Protection of International Registrations are examined by the U.S. Patent and Trademark Office for compliance with U.S. law (the Lanham Act) I will begin by outlining the most frequent substantive and procedural problems that occur and recommend ways to avoid these problems.

MADRID PROTOCOL PROSECUTION PROBLEMS OFTEN ENCOUNTERED AT THE USPTO

Likelihood of confusion refusals due to applicant's extension without conducting a search.

Indefinite identification of goods and services due to differences in specification requirements between WIPO and the USPTO.

Citizenship questions of applicant due to differences in filing requirements between WIPO and the USPTO

Surname refusals. If the mark is primarily merely a surname under U.S. practice, the application will be refused. National refiling as a Section 44, and/or Section 1(a) or (b) application will permit the same mark to be placed on the Supplemental Register. This course of action is not available under Madrid.

Deceptive or descriptive refusals. If the mark is found to be deceptive or merely descriptive in some way it will be refused.

PROSECUTION

The Section 44 foreign application or registration basis and the Section 66 Madrid Protocol Extension of Protection basis may not *normally* be filed by U.S. entities. These are exceptions. A Virginia corporation may first file an application in Mexico and then file the same application in the U.S. under Section 44(d) and claim the priority filing date of the Mexican application. If the Virginia applicant proves that it has a bona fide and effective industrial or commercial establishment in Mexico or is domiciled in Mexico then it may file a copy of the Mexican certificate of registration in the Section 44 application and have it mature into a registration.

Tip: The Trademark Act defines the applicant's country of origin as "the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment, the country in which he is domiciled, or if he has not a domicile in any of the countries described in paragraph (b) of this section, the country of which he is a national." Under this definition, an applicant can have more than one country of origin.

By Treaty, Sections 44 and 66 applications do not require a date of first use in commerce or a specimen of use of the mark in commerce prior to maturing into a valid federal registration.

PROSECUTION UNDER TREATIES / REGISTRATION DOES NOT GRANT THE RIGHT TO ENFORCEMENT IN COURT

The USPTO will enforce these registrations against confusingly similar subsequently filed applications. However, enforcement of a registration obtained under Section 44 or Section 66 against a U.S. brand infringer in federal court (where the registrant's goal is to obtain an injunction and/or seizure of the infringing goods) will require proof of the registrant's prior actual use of the mark in commerce on the goods reflected in the registration. Despite treaty obligations regarding registration, U.S. law requires actual use of a mark on goods or services in commerce regulated by Congress so that consumer likelihood of confusion as to origin, source or sponsorship may logically arise. With no actual use of the registered trademark in commerce there can be no likelihood of confusion. A complaint for infringement of a registration without proof of commercial use will be subject to a favorable action on defendant's Motion to Dismiss.

Chapter 1000 of The Trademark Manual of Examining Procedure (TMETP) addresses the prosecution requirements for Section 44 applications and Chapter 1900 addresses the different requirements for extension of protection applications under the Madrid Protocol.

Tip: Use the mark properly, police third party uses of similar marks, object to marks published for Opposition that are too close and maintain your registrations at the USPTO.

MAINTENANCE PROBLEMS

Proper and continuous use of the mark on the services or goods listed in the registration is very important to maintenance.

Rights are based on proper and continuous use. Timely filing use declarations and renewals at the USPTO is also important to preserve the registration.

Tip: Be sure the specimen of use clearly shows the mark on the goods or their packaging to support the declarations. Labels are best but packaging will also work. Displays associated with the sale of goods are usually acceptable but they can raise problems. Submit more than one specimen.

Plan well in advance by asking the registrant for pictures of the mark on the goods three years and two years before the registrant will be required to file the use declaration.

Tip: Often the goods will change or new goods will be added to the registrant's line. Ask the client if this has occurred. If it has, consider recommending the filing a new application for the same mark for the expanded goods list one year before the use declaration in the existing registration is due.

To modify U.S. requirements regarding the duration of Extension of Protection Registrations and related affidavits and fees the Trademark Technical and Conforming Amendment Act of 2010 was signed by the President March 17, 2010.

As of that date Madrid Protocol registrants have the same periods within which to file Declarations of Use (or Excusable Nonuse) as other U.S. trademark registrants.

Holders of International Registrations with an extension of protection to the U.S. under the Madrid Protocol must timely file a Declaration of Use (or Excusable Nonuse) as follows:

- 1) A Declaration of Use (or Excusable Nonuse) along with a fee must be filed with the USPTO between the 5th and 6th years after the U.S. registration date.
- 2) A Declaration of Use (or Excusable Nonuse) along with a fee must be filed with the USPTO between 9th and 10th years after the U.S. registration date.


NEW SUPPLEMENT!

**TRADEMARK
INFRINGEMENT
REMEDIES**, with *NEW*
2011 CUMULATIVE SUPPLEMENT


Brian E. Banner, Editor-in-Chief
ABA Section of Intellectual Property Law

Also Inside:

- TRADEMARK DEFINITION: FEDERAL, STATE, AND INTERNATIONAL
LAW, with 2011 CUMULATIVE SUPPLEMENT
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If you have questions later on when you return home send me an email, remind me we met at INTA 2012, and I will reply to your inquiry.

Lets open this up to any questions you may have today.

Questions?. Go enjoy INTA and the Capital City.



Thank You

■ Brian Edward Banner

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U.S. PATENT AND TRADEMARK OFFICE

The End

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