



## Chapter 5

# Trademark Prosecution

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### I. Benefits of Federal Registration

There are numerous benefits to be gained from obtaining a federal trademark registration. When considering that in a best-case scenario, a registration can be secured in about 14 months at a cost of \$335 in filing fees for a single-class, use-based application (outside counsel fees vary considerably, but would in all likelihood cost about \$1000), trademark registration can provide exceptional “bang for the buck.”

For companies that require a long lead time for launching a product or service, the intent-to-use provisions of the Trademark Act, section 1(b), allow a trademark to be reserved long before use can be made. Depending upon the prosecution issues that may arise and the amount of time taken to respond and prove use, there can be, on average, 4 \_ years from the filing date until the time when proof of use must be filed. Regardless of the length of pendency, the filing date establishes a constructive use date, provided that the registration certificate issues.<sup>1</sup>

Filing an application as soon as a project is formulated and the trademark candidates are selected allows a company to discover at an early stage in the process whether there will be blocking citations, inherent registrability issues or other problems that may steer the company toward a different mark. Applications currently are receiving first Office Actions in about 3-5 months. This relatively quick feedback can provide valuable information to the trademark owner, and may also prevent the trademark owner from making a substantial investment in a trademark that ultimately cannot be protected. In addition, the information on new trademark filings is made available to

the general public in about two to three months from the filing date, allowing concerned competitors to come forward even in advance of publication of the mark.

The constructive use date is also important to trademark owners relying on Convention priority filings under section 44 of the Lanham Act. For foreign applicants, it can take years for a home country registration to issue; however, the home country filing date, which can be up to six months earlier than the U.S. filing date, will be the effective date for purposes of determining priority.<sup>2</sup> Therefore, if a third party files prior to the filing date of an applicant who is relying on a Convention country filing, but subsequent to the home country filing date of the applicant, the third party's application will be suspended pending the outcome of the application based on a Convention priority date. As will be discussed in greater detail below, this benefit is available to U.S. applicants, as well as foreign applicants, and is available even if the applicant ultimately relies on use in commerce, section 1(a), rather than a home country registration.

A trademark registration provides constructive notice of the registration, whether or not a registration symbol or other notice is used, and defeats a claim that an infringer did not know of the registration. There are benefits to using the registration symbol (®), or the words "Registered U.S. Patent and Trademark Office" or the abbreviation "Reg. U.S. Pat. & Tm. Off."). To do so gives actual notice of the registration, and permits the successful trademark owner to recover treble damages and discretionary, court-ordered attorney's fees.<sup>3</sup> It is important to note that although the constructive use date (i.e., the filing date) is the date for determining first use for purposes of priority disputes, the benefits of federal registration, including the constructive notice provision, do not become effective until the date of the registration.<sup>4</sup>

The registration also establishes the presumptive right of the trademark owner to use the mark throughout the country, even if the initial use is local. When the trademark owner is ready to expand to more remote geographical areas, the owner can then seek a court order to enjoin any third parties that began using a confusingly similar mark after the filing date of the application from which the registration issues. The presumptive right can mature into a conclusive right once there has been five years of continuous use and a section 15 declaration of incontestability is filed and accepted.<sup>5</sup> This status of incontestability grants additional strength to the registration and will be discussed below.

Most parties prefer to avoid litigation. Sending a cease-and-desist letter with a copy of a trademark registration enhances the effectiveness of a negotiated settlement of a trademark dispute. But even in advance of a trademark dispute, the registration performs the important prophylactic function of alerting others who perform trademark searches of the presence of the previously filed mark. In many cases, the mere existence of a pending application or registration will encourage third parties to select a different mark.

Another important benefit of a registration occurs when the registered mark is five years old, provided that the mark has been used substantially continuously and

exclusively since the registration date. At this point, the owner can file a declaration under section 15 of the Trademark Act, which provides that the registration can be challenged only on the grounds of abandonment, functionality, genericness or fraud.<sup>6</sup> In court, a third party loses the affirmative defense that the mark is merely descriptive of the goods or services, and also the ability to oppose injunctive relief where the incontestable mark has not yet been used.<sup>7</sup> Even in nonlitigated disputes, a section 15 declaration is helpful in strengthening the demands of the trademark owner, and precludes an infringer from contending that the mark is descriptive.

A registration on the Principal Register (but not the Supplemental Register) may be deposited with the U.S. Customs Service, and Customs will detain perceived counterfeits or, in some cases, infringements at the port of entry.<sup>8</sup> The trademark owner typically is notified and asked to verify whether or not the goods are genuine. The intended recipient in the U.S. is given an opportunity to respond, and in the event the response is not satisfactory to Customs, the goods are seized and, in some cases, confiscated. The cost to the trademark owner is minimal, and the proceedings can be completed relatively quickly.

A registration in the Principal Register can also be the basis for a seizure of counterfeit or infringing merchandise in a federal court proceeding pursuant to the Trademark Anticounterfeiting Act.<sup>9</sup> Seizures may proceed on an *ex parte* basis, or on notice. In the event that the trademark owner can persuade a federal court that infringing goods are likely to disappear in the face of a validly issued temporary restraining order or preliminary injunction, the court can order that the suspect merchandise be seized by federal marshals or other designated persons.<sup>10</sup> The evidence is then available for trial. These proceedings can be instituted under seal, so that the appearance of the marshal to seize the counterfeit goods is the first notice the counterfeiter receives.

The trademark registration performs a presumptive function in other contexts as well. The Anticybersquatting Consumer Protection Act<sup>11</sup> provides that one of the elements of proof entitling the plaintiff to recover a domain name and possibly damages from a person using a domain name claimed by the plaintiff is the fact that the domain name comprises a prior federally registered trademark. Similarly, while the Uniform Dispute Resolution Proceeding rules as administered by WIPO (the World Intellectual Property Organization) no longer list a trademark registration as an element of proof in establishing a valid claim for the transfer of a domain name from a cyberrate or cybersquatter, it would appear to be persuasive evidence.<sup>12</sup>

A federal trademark registration is often used as collateral for securing loans from banks or other lenders. Trademark registrations are viewed as the embodiment of the goodwill symbolized by the trademarks. Lenders record the security interest (which should never be characterized as an “assignment”) with the Assignment Branch at the Patent and Trademark Office (PTO), and may also record the security interest with each state as provided by the Uniform Commercial Credit Act.

When a company’s stock or assets changes hands, the purchasers conduct due diligence investigations. Among the items thoroughly investigated are the

registration, maintenance and enforcement of the trademarks. Registering a company's key trademarks with the PTO adds to the value of the company; conversely, the failure to register the marks would demonstrate a lack of attention to the company's key assets, and might either discourage potential purchasers or cause the value of the company to decrease. Along the same line, a company hoping to enter into franchise or license agreements should register the main trademarks pertaining to the property or business with the PTO. In many instances, the franchisors or licensors are required to give "representations and warranties" regarding the validity of the trademarks, specifying that the trademarks are registered and that they do not infringe the rights of any third party.

## **II. State Trademark Registrations**

Despite the many benefits of a federal registration, there may be reasons to obtain a state registration (typically instead of a federal registration). First, a business may be purely local in nature; note that one of the requirements for a federal registration is that the mark be used in commerce, which may be regulated by Congress. Case law holds that virtually any service offering is "use in commerce," due to the application of federal laws (including industry-specific laws relating to alcohol, banking, telecommunications, and the like, as well as general laws such as antidiscrimination in accommodations). Moreover, businesses located near interstate highways or near the border of other states are also deemed to be "interstate" in nature. Nonetheless, a very small business in the middle of a large state might not meet the requirement for use in commerce, or even if the requirement can be met, the small scale of the business might not warrant a federal registration. Typically, radio stations operating in a limited geographical market (limited by the strength of its transmission signal), which do not offer syndicated programming, will obtain a state trademark registration, to enforce rights against local competitors.

Another reason one might obtain a state registration is that the standards for the granting of a registration generally are less rigorous than those in the PTO. The examination process may be cursory or nonexistent. A mark that would be deemed unregistrable, for example, a descriptive mark or a mark constituting a laudatory phrase or geographical term, can be registered at the state level. This registration serves the purpose of putting third parties on notice as to the use of the mark when a full search is conducted, achieving the prophylactic effect that a federal registration gives. State courts may give considerable weight to the state registration, and some state trademark acts provide for enhanced money damages in the event of infringement (whereas such damages are difficult to secure under the Trademark Act, in the absence of willful infringement or proven lost sales).

State trademark registrations are less expensive than federal registrations, costing generally in the range of \$20 to \$50 or \$100, and typically issue within a month or two. The forms are simple and can easily be filled out by the trademark owner, without assistance from a trademark professional. For a short-term or local project, a

state registration can provide a useful means of giving notice to those who conduct more than a cursory search of the federal database, and can provide sufficient firepower when trying to stop competitors or infringers from using confusingly similar marks. Forms for many states are available on-line, but if the particular state does not have downloadable trademark forms, the forms can be obtained by contacting the Secretary of State's office. State applications must be based upon actual use of the mark in that state prior to filing.

Finally, it should be noted that state trademark registrations do not carry a presumption of the validity of the registered mark, nor do they give constructive notice of the mark. They cannot be deposited with Customs, and they cannot be used as the basis for a seizure under the Anti-Counterfeiting Act. Lastly, state registrations are always subject to challenge in court on the basis of descriptiveness because there is no incontestability provision under the state trademark statutes. Nonetheless, as noted above, there are times when a state trademark registration is helpful.

### III. Tools of the Trade

There are many materials available to the trademark practitioner, some of which are virtually indispensable, while others are helpful but not essential. Trademark practitioners may disagree on the best places to find information needed to prosecute trademark applications in the best and most efficient manner. Following are some helpful sources.

Most important is the Trademark Act of 1946, as amended (known as the Trademark Act or Lanham Act), which is located at 15 U.S.C. section 1051 *et seq.*, as well as the governing regulations, found in 37 C.F.R. section 1, *et seq.* These materials are compiled in an International Trademark Association (INTA) publication, *U.S. Trademark Law: Rules of Practice, Forms, Federal Statutes and Regulations* (3d ed. 2000). These materials specify the basic statutory underpinnings of trademark applications, such as the bases for filing, the types of marks that can be registered, and the statutory bases for refusal to register a mark.

*The Trademark Manual of Examining Procedure* (TMEP) is truly the "bible" of the trademark prosecution practice, the guide to the PTO's interpretation of the statute and rules. This manual can be ordered from the Government Printing Office, or can be found on-line at [www.uspto.gov](http://www.uspto.gov). The Examining Attorneys in the PTO use the TMEP when they review trademark applications; the practitioner can anticipate potential problems that may arise during the prosecution of applications by becoming familiar with the TMEP. In addition to spelling out the basic rules and requirements for filing, the TMEP is a great practical source of information for responding to Office Actions, both in terms of inherent registrability issues and technical requirements. Case citations are provided in support of most of the issues that arise during examination. The appendix to the print version of the TMEP contains forms, an index of case and statutory citations, a copy of the Trademark Act and

regulations, a short-form listing of the International classification scheme, and a detailed topic index, as well as a listing of other federal regulations bearing on trademarks, such as the statutes protecting the Olympics insignia, Smokey the Bear, and the Red Cross, as well as the FDA, textile acts and others.

There are two sources of information on classification of goods and services: the USPTO Acceptable Identification of Goods and Services Manual, available from INTA, or the on-line version available on the USPTO web site, [www.uspto.gov](http://www.uspto.gov). Although the print version is easier to use, allowing the user to flip between goods and services organized by class or alphabetically, the web site has the most up-to-date information. Also, amendments to the classification scheme are made fairly regularly, particularly with respect to computer-related goods and services. Special note should be taken of the recent revisions to Class 42, which breaks this one class into four separate new classes (Classes 42, 43, 44 and 45). In addition, searching the PTO database can reveal the manner in which particular goods or services have been identified in marks already registered.

To use the USPTO web site, go to [www.uspto.gov](http://www.uspto.gov), and then click on “Trademarks.” The site contains several valuable resources, in addition to the latest available versions of and amendments (in the form of Examination Guides) to the TMEP and the Acceptable Identification of Goods and Services Manual. The Trademark Office strongly urges all applicants to file electronically through the USPTO web site, using the standardized forms.

The web site offers on-line searching of the PTO database of registered and pending marks through the TESS database. Although not as sophisticated as the search engines available through private companies, simple Boolean logic can be used with two different parameters or limitations to conduct on-line searches. Also useful is the on-line database TARR, which provides the latest available status on pending applications or registrations. The information is accessed by serial number or registration number, or by clicking the “check status” link in each TESS search result. Thus, it may be necessary to first go to TESS before linking to TARR. The TARR database is a substitute for the telephone status line (703-305-8747); the telephone status line permits only five look-ups per call, requires the caller to have either the registration number or the application serial number, and gives only the most recent status entry. In contrast, the TARR database provides the entire prosecution history up to the latest entry. It is important to keep in mind that some status entries, such as cancellation or expiration dates for registrations, are anywhere from six months to a year out of date. Moreover, the Trademark Law Treaty Implementation Act has modified the requirement for successful revival petitions so that marks abandoned by “inadvertence” can be revived where an office action was not timely answered or an Amendment to Allege Use was not timely filed or time extended. Thus, within six months of such an abandonment, a likely successful revival petition can be filed. For this reason, a mark listed in TARR as abandoned may be revived.

Several private companies offer enhanced desktop searching capabilities. The pricing of these services varies considerably, and can be based on a yearly flat fee, or on a

per-record printed or look-up basis. Among these services is the CCH-Corsearch Quatra (in online format) or TrademarkAccess CD-ROM; Dialog TrademarkScan; and Saegis online searching from Thomson & Thomson. The advantage of these services over the free on-line searching through TESS is that multiple variables can be searched at once. Also, the searching structure is much more user-friendly, and the results seem to be more comprehensive.

Aside from the USPTO web site, the Internet offers a wealth of information to assist in trademark filing and prosecution. The use of the Internet as a searching tool for trademark clearance purposes has been discussed previously, and will not be detailed here. One can research whether or not a mark is likely to be found to be descriptive or generic by using search engines to see third party uses of the term (the NEXIS database, available through LEXIS/NEXIS, also provides a good source of information on descriptiveness, by accessing numerous on-line publications). Viewing third party sites can be of assistance in formulating a description of the goods or services if the trademark owner is not yet doing business, and can identify competitors who have sites on-line. On-line dictionaries, both in English and foreign languages, are helpful in providing meanings for descriptiveness and searching purposes, and to allow foreign language words in the mark to be translated in the application. Possible geographical connotations can be identified through use of on-line atlases. Surname connotations can be checked through on-line telephone directories. This is the same kind of research that the Examining Attorney will do; many objections and requirements can be anticipated by these prefiling steps.

Trademark treatises are excellent sources of information, from basic concepts to detailed descriptions, and case citations on issues such as likelihood of confusion and descriptiveness. Among the most helpful treatises are Professor J. Thomas McCarthy's multivolume work, *Trademarks and Unfair Competition* (2000), and Jerome Gilson's multivolume work, *Trademark Protection and Practice* (2000). Another book that is sometimes useful is Pinckney, *Products Comparison Manual for Trademark Users* (1988 & Supp. 1998). This book lists various goods and services held by the Trademark Trial and Appeal Board (T.T.A.B.) to be related, or to be unrelated, and gives case citations as to the relevant decisions. These works are particularly useful tools for responding to Office Actions when more difficult issues are raised.

The *Official Gazette* (OG), published every Tuesday, contains the particulars of the trademarks published for opposition. In addition, the OG shows a short-form description of cases decided by the T.T.A.B., which can be helpful in seeing the types of marks found to be descriptive or confusingly similar, and also prints the latest updates on amendments to Trademark Rules and the pertinent chapters of the Code of Federal Regulations (C.F.R.). The USPTO web site also features these amendments to the rules and regulations.

## IV. Selecting a Mark

At the outset, the trademark owner should determine the purpose of a mark, and this dictates whether to choose a mark that can be registered federally, in the state system, or a descriptive mark where registration is not a relevant consideration. It is important that the trademark owner understands the requirements for creating a protectible trademark, in terms of inherent registrability. Section 2 of the Lanham Act sets forth the statutory bases for a trademark or service mark, and the negative criteria that preclude registration. As is explained in greater detail in the “Trademark Basics” section herein, under Lanham Act section 1, the trademark must at a *minimum* be descriptive for the goods or services; generic terms (i.e., the common name for the goods or services) are not registrable even on the Supplemental Register.<sup>13</sup> In addition, marks that are determined to be scandalous, deceptive or functional, or which comprise a coat of arms or flag of the U.S. or a foreign country, are never registrable.<sup>14</sup> Certain types of trademarks, such as surnames, geographical names, marks comprising a single color, product shapes, or marks comprising ornamental matter, are only registrable upon a showing of acquired distinctiveness, pursuant to section 2(f) of the Trademark Act.<sup>15</sup> To qualify for registration under section 2(f), the owner must show that the mark has acquired “secondary meaning” by virtue of being used for a period of five years, or that the sales, advertising, publicity and other evidence establishes that the mark is now recognized by the public as denoting the goods or services of the owner, or that the owner possesses another registration for the same mark for closely related goods or services.

Second, care should be taken to avoid choosing a mark that is confusingly similar to a mark of a third party. Full trademark searches are recommended, and the Internet and other available databases should be checked as well. The client’s marketing department frequently is aware of the products of competitors; the client should be encouraged to choose something not in use by competitors (often, the instinct is to select a similar mark, with the expectation that customers will be attracted to the new product by virtue of its already-established identity in the marketplace).

Third, the client should consider its objective in selecting the mark. For short-term use, it may be advantageous to select a mark that is descriptive—one that can be readily understood by the public and connected with the client’s product. Less advertising and promotion is required to educate consumers as to a new brand that is descriptive of the goods or services than one that is arbitrary or coined. Also, if the public’s primary access to the goods and services is the Internet, it may be preferable to select a descriptive mark that can be readily guessed or remembered. On the other hand, marks that are planned for long-term use are stronger and more protectible if they are suggestive, arbitrary or coined. These marks can be registered without proof of secondary meaning, and are enforceable immediately against infringers.

It is important to retain file documentation as to the selection of the mark, not only as to the mark ultimately selected, but other candidates as well. It is also important to retain copies of searches and opinion letters and to include notes regarding the inspiration for or derivation of the mark, market studies regarding the testing of the

mark, and sketches for any logos. Finally, notes of the marketing group in developing a product or service for the mark, and steps taken to bring the goods or services to market should be retained. This file will be helpful in the event any third party later challenges the good faith adoption or *bona fide* intent to use the mark, or alleges infringement.

## V. Filing Strategies

A trademark application should be filed for all commercially important or long-term marks. As noted above, the federal Trademark Act confers considerable advantages to registered marks, and even while pending, the application serves to put competitors on notice, and also to hold the applicant's place in line for use of the mark while the product is developed for the market.

The expected timing of the product launch is an issue in determining the filing basis. As will be discussed in greater detail below, an application can be filed on the basis of use in commerce, intent to use, a foreign registration, or a foreign application filed within the past six months (although the foreign application simply gives a priority date, and use in commerce or a foreign registration will ultimately be required). If the mark is in use, the application should be based on use in commerce. However, if the applicant is domiciled in a foreign country, the U.S. application might instead be based on a home country registration or an application filed within the past six months, if the coverage in the foreign registration or application is broader than the use currently being made, and use is expected to expand to a broader range of products in the future. If the applicant's home country application is not expected to issue for several years, this factor may weigh in favor of relying on use in commerce, so that the U.S. registration will issue more quickly.

If use is expected to commence within a month or so from when the mark is cleared, consideration might be given to waiting until use is made and then filing based on use in commerce. Filing based on use will save time and money because the filing of an Allegation of Use will be avoided. These cost savings must be balanced against the possibility that a third party will file for a confusingly similar mark in the interim. Therefore, if use will be delayed beyond perhaps four weeks at the most, an intent-to-use (ITU) application should be filed. If use is not expected to commence any time in the near future, an ITU application should be filed at the earliest date so as to lock in the constructive use date.

The legislative history to the Trademark Law Revision Act of 1988 makes clear that multiple alternative marks can be filed for the same product or service, and the applicant will still have a *bona fide* intent to use the mark. The *bona fide* intent can be conditioned on various factors, such as clearance through the application process, or acceptance by the FDA or other regulatory bodies, or strong results through marketing studies.<sup>16</sup> The applicant should be sure to retain all documentation on the *bona fide* intent to use the mark, in the event the intent is challenged.

Multiple forms of the mark may also be filed, including in plain block letters or with a logo. However, the broadest protection is gained from filing in plain block letters, which will support use of the mark in virtually any format, style, color, or typeface. There is little advantage in filing in stylized lettering format if the mark is only slightly stylized because filing in block letters will adequately cover this presentation, and the client has the freedom to change the design from time to time. Even if the application is filed for the mark in a particular logo style and the style changes over time, the registration may still be supported if the change in format is not a “material alteration.”

One reason to file in logo format is if the word portion of the mark is likely to be deemed to be merely descriptive of the goods or services. Although the word element of the mark may have to be disclaimed, the logo or design element, if sufficiently distinctive, will be enough to keep the mark on the Principal Register. This can be of great benefit to owners of arguably descriptive marks that do not qualify for registration on the Principal Register. Applications based solely on intent to use cannot be filed on the Supplemental Register, and a descriptive mark cannot be amended to the Supplemental Register until the mark is in use. This could result in a loss of the application altogether if use of the mark will not occur for several years because the amendment to the Supplemental Register must be filed during the prosecution stage, in response to an initial or final refusal to register under section 2(e). Moreover, amendment to the Supplemental Register results in the original filing date being lost; the date of amendment to the Supplemental Register becomes the new filing date.<sup>17</sup> This can pose a problem if there is an intervening user or filer. These potential problems can be avoided by filing a descriptive mark with a logo or design, or other distinctive matter that will not have to be disclaimed.

If the application is based on a home country application or registration, the mark must be identical to the mark in the home country filing. If color is claimed as a feature of the home country application or registration, it must likewise be claimed in the U.S. application. Lastly, bear in mind that to the extent the U.S. application is based solely on a home country registration, the listing of goods and services may not exceed the scope of the foreign registration but may be more limited. If the home country registration is not sufficiently broad, additional goods and services may be included in the U.S. application on the basis of intent to use.

When multiple goods or services are involved, one must consider whether to file a multiple-class application or separate applications for each class of goods or services. In addition, the Trademark Act permits combining use and intent-to-use bases in a single application. A single class of goods can even contain more than one basis. For example, for a mark in Class 9, one kind of computer program could be based on use, while another program (still under development) could be filed on an intent-to-use basis. If the search disclosed potential problems such as blocking citations that might be raised against one class of goods (or one item within a class) but not others, the potentially blocked classes should be filed separately so as not to delay the remaining goods and services. Barring any such anticipated problems, it usually is more efficient to file a multiclass application. Law firms typically charge for each application filed, so there may be a cost savings associated with filing a multiclass application.

Combining use and ITU bases is not recommended unless use for the ITU-based goods is expected to commence relatively soon during the prosecution of the application. This would enable the Allegation of Use to be filed early in the process, thereby allowing the entire application to proceed as if it were a use-based application, and sparing the expense and time of the normal cycle associated with the Notice of Allowance, Extensions, and Allegation of Use. In the alternative, if the application is otherwise ready to proceed to publication, the use-based goods may be divided from the application by filing a request to divide the application (with a filing fee of \$100 per class, and a fee of \$325 for splitting a class if some goods in the class are in use but not others). Otherwise, the entire application is delayed by the issuance of a Notice of Allowance as to all goods, to allow use to be proven for the rest of the goods.

Attention must be given to formulating the identification of goods and services, especially with service mark applications. Counsel should speak with the project managers and explore the full range of activities for which the mark will be used because once the application has been filed, the identification of goods and services only can be narrowed or clarified, but not expanded. Moreover, goods usually cannot be reclassified as services, or vice versa. The *Acceptable Identification of Goods and Services Manual* or the PTO web site should be consulted for correct terminology. If there is doubt about or difficulty in describing the specific goods or services for which the mark will be used (or in the case of an intent-to-use application, the specific goods are still undetermined), the best approach is to file as broadly as possible, for example, by filing for “clothing,” “pharmaceuticals,” or “computer software,” and then to narrow the description in response to an Office Action. However, care should be taken not to file so broadly that a third party could challenge the applicant’s *bona fide* intent to use the mark. Thus, although it is appropriate to file for “toiletries” and then specify the types of toiletries later, it is not appropriate to file for the Class 3 heading as set forth in the WIPO manual, which includes such diverse goods as perfumery, bleaching preparations, depilatories and dentifrices. It is highly unusual that any company would use a single mark for such a diverse listing of goods. Moreover, if the search reveals that there are many similar marks in the class or category, it is a good strategy not to file too broadly so as to avoid any unnecessary blocking citations.

## VI. Filing Bases and Forms

As noted above, there are four bases for filing under sections 1 and 44 of the Lanham Act. They are:

### ➤ *Use in Commerce*

*Section 1(a)*: the applicant is using the mark in commerce, either in interstate commerce or in commerce between the U.S. and a foreign country, or in a foreign territory owned by the U.S. (such as Puerto Rico or Saipan). “Use in commerce”

means any commerce that Congress can regulate. Thus, even local use, such as a restaurant located in the middle of a state, can be regulated by Congress as to nondiscrimination laws, which allows a local restaurant to qualify for a federal registration. Other examples of seemingly local activities that are regulated by Congress are radio stations, telecommunications, and retail operations (as to fair employment laws), and any business located on or near an interstate highway. The use, however, must be *bona fide* commercial use made in the ordinary course of business, and not merely to reserve rights in a mark. Token use, internal company use, or use solely among family members will not withstand scrutiny. There is no requirement that money be paid for a sale, or that large quantities of goods be sold. For expensive or unusual products, even a single sale may suffice. For pharmaceutical products, clinical testing (i.e., shipping the drug to doctors for human clinical trials) constitutes use in commerce, even if the product will not be available to the general public for years. Other examples of limited trademark usage that constitute use in commerce are displaying goods at a trade show, or making regional sales in a test market.

➤ ***Intent to Use***

*Section 1(b)*: the applicant has a *bona fide* intent to use the mark in commerce. The intent must be commercially realistic and based on concrete plans, not mere hypothetical desire. The Trademark Act prohibits the assignment of ITU applications to prevent trafficking in trademarks, except as part of the transfer of an ongoing business.<sup>18</sup>

➤ ***Convention/Treaty Priority***

*Section 44(d)*: the applicant has filed an application in a Paris Convention country within six months prior to the U.S. filing date. The U.S. filing date for determining priority purposes is the filing date in the foreign country. Even a company or person domiciled in the U.S. can file on the basis of a Convention priority filing; however, a U.S.-based applicant will need a separate basis for registration, specifically, use in commerce.<sup>19</sup> The Convention priority applies only to the first-filed application for that specific form of the mark for the goods or services listed.<sup>20</sup> Thus, if a foreign company files an application first in a Convention country where the applicant does not have a *bona fide* commercial establishment (i.e., an office or factory), it can rely on this filing for priority purposes, but it will need a separate basis for registration, such as use in commerce or a home country registration. Section 44(d) provides merely a priority of filing basis, but does not provide a basis for registration; a separate basis such as use or a home country registration is always required.<sup>21</sup> Regardless of the coverage of the Convention priority filing, the applicant must allege that it has a *bona fide* intent to use the mark in commerce in the U.S. for all goods and services listed in the application, although proof of use will *not* ultimately be required.<sup>22</sup>

➤ **Home Country Registration**

*Section 44(e)*: the applicant is a non-U.S. company or person who owns a foreign registration in a country where it has a *bona fide* commercial establishment. A photocopy of the home country registration must be produced as a prerequisite to registration, even though the application may be filed without the certificate of registration.<sup>23</sup> The registration certificate need not be certified or legalized; a simple photocopy will suffice. If the foreign registration is not in English, an English translation must be provided; it is customary for the translator to sign the translation.<sup>24</sup> As with the section 44(d) application, an application filed under section 44(e) must also allege a *bona fide* intent to use the mark for all goods and services listed in the application.

These bases can be combined in a single application. For example, the applicant can claim a home country registration for some classes of goods or services, and rely on intent to use or use for other goods and services. Not only can a different basis be asserted for different classes, a single class can have two different bases; in this case, a separate paragraph should set out the specific goods covered by each basis so that the data is entered properly by the PTO. The basis can be changed at any time during the prosecution of the application, so long as the requirements for the new basis are met, and the applicant has a continuing valid basis for the application. The most common example is that an ITU application, upon filing an Allegation of Use, can be amended to be based on use. If the application is based on section 44(d) and the home country application is rejected, the applicant can amend to section 1(b) and still maintain the priority filing date arising from the home country registration. An ITU application can be amended after the Notice of Allowance has issued to rely on a home country registration under section 44(e); however, in this instance, the amendment can be made only upon filing a petition with the Director for Trademarks and paying a \$100 petition fee. The petition will be granted as a matter of course (after a delay of up to six months while the petition awaits review). The current rules require that in this instance, the application must be republished to provide proper notice of the basis for the application.

There is no set form that must be used to file an application. The PTO is encouraging applicants to file electronically, using the downloadable form from the PTO web site. This method of filing has several benefits. Immediately upon filing, the PTO issues a receipt with the serial number and filing date. Furthermore, a filing date can be granted on Saturdays, Sundays and legal holidays (unlike forms mailed to the PTO, which are given a filing date of the next business day). Filing electronically avoids omission of key words in the declaration or claims that will support the application. Moreover, the data from such applications are entered directly into the PTO database, without the frequent typographical errors or transcription errors that might otherwise occur. The data in the filing receipt will be exactly as entered by the applicant or its attorney (filing receipts generated manually frequently contain errors that must then be corrected by telephone or fax). The filing fee can be charged either to a credit card (see the PTO web site for the form) or a deposit account established with the Finance Office of the PTO. However, practitioners may find it difficult to forward these forms to clients for approval because the format is unusual and there is

extraneous language or categories that may confuse clients, particularly clients in foreign countries.

The PTO developed scannable forms that were available on the web site until recently, when they were removed to encourage electronic filing. As with customized forms, these forms can be printed, sent to the client for signature, and then mailed to the PTO by Express Mail. The forms are designed in such a way so as to enable the data to be scanned electronically into the PTO database, thereby reducing transcription errors.

Lastly, the applicant can create its own form by using as a model the forms available on the web site, or those found in the TMEP or the INTA book containing the statute and rules. Although the PTO is less receptive to these forms, they are often cleaner, easier to use and understand by clients. Also, they allow for greater flexibility in adding information that will expedite the processing of the application. However, unless carefully reviewed, these forms can contain errors, and the PTO data clerks can make errors in transferring the data into the PTO database.

## **VII. Filing Requirements**

Trademark Rule 2.21 specifies the five minimum requirements to receive a filing date:

1. The name of the applicant;
2. The address of the applicant or filing correspondent;
3. A drawing (either typed or stylized) showing the mark; a separate drawing page is not required, but is recommended;
4. An identification of the goods or services; and
5. A fee (check, credit card or authorization to charge a deposit account), to cover at least one international class, in the amount of \$335. Fees are stated in Trademark Rule 2.6.

These are the bare essentials to receive a filing date. The filing date is the date on which the application containing these minimum requirements is received in the PTO.<sup>25</sup> Many requirements necessary for approval of the application can be submitted at a later date. These additional requirements are as follows:

1. The applicant's type of entity and state or country of incorporation or domicile (in the case of an individual, the applicant's national citizenship)
  - a. If the applicant is a partnership, a listing of the general partners and their citizenship or state/country of incorporation (if there are more than ten partners, a list of ten representative partners will suffice)

- b. If the applicant is a limited partnership, the general partners and their citizenship or state/country of incorporation must be identified
  - c. If the applicant is a joint venture, all parties to the joint venture must be identified
- 2. A complete address of the applicant (an attorney's or agent's office may be used for this purpose; but note that the address given will be printed on the certificate, and after the registration issues, this is the address to which notification will be sent in the event of a cancellation action)
- 3. An address and telephone number for contacting the applicant or the applicant's counsel during the prosecution of the application
- 4. If the applicant is domiciled in a foreign country, the applicant may designate a domestic (U.S.) representative (note that the PTO will mail Office Actions to Canada, but Canadian applicants must designate a domestic representative); in the absence of a designated domestic representative, notices affecting the mark will be published in the *Official Gazette*.
- 5. The basis or bases for the application
- 6. A specific listing of goods and services, in conformance with PTO practice, and the classes for such goods and services, if known (the PTO will assign the classes if they are not specified)
- 7. If the application is based on intent to use, a statement that the applicant has a *bona fide* intent to use the mark in commerce
- 8. If the application is based on use in commerce,
  - a. the date of first use anywhere, the date of first use in commerce, and a statement that the mark is now in use in commerce
  - b. one specimen showing use of the mark, in the form of photographs, digital photographs, photocopies or small, flat objects such as labels or "hangtags" (bulky specimens—those which are larger than 8.5" by 11" and thicker than lightweight cardboard—are not permitted)
  - c. if the mark is used by a licensee or other "related company," a statement for the record that the mark is used by a related company (the name of the licensee need not be identified, nor the terms of the license agreement)
- 9. If the application is based on section 44(d), the date and country of the foreign filing, and the application number (note that it is not necessary to provide a copy of the foreign application)
- 10. If the application is based on section 44(e), a photocopy of the foreign registration, and if the registration is printed in a foreign language, an English translation signed by the translator (it is not necessary to notarize or legalize the translation)

11. A drawing of the mark free of shading or blurred lines, preferably on a separate page, not greater than 4" x 4", with at least 1" clear margin all around the drawing
  - a. If the mark is a word mark, it must be shown in all upper-case letters in a standard typeface (such as Courier or Times New Roman) of at least 10 point type
  - b. A typed drawing may be used for marks containing diacritical marks (e.g., accents or umlauts) or punctuation (e.g., hyphens, apostrophes or commas)
  - c. If the mark is in stylized lettering or in upper and lower-case lettering, a formal drawing must be submitted
  - d. If a formal drawing of the mark is submitted, the drawing must be in black and white, with no shades of gray and no color
  - e. For marks depicted in color, the applicant may submit a color photocopy of the mark to show the location and shades of the colors, or a written description of the coloring of the mark, or the drawing may be lined for color using the former color lining system shown in Trademark Rule 2.52(e)
12. If color is claimed, a formal statement as to the colors claimed as a feature of the mark
13. If the drawing of the mark shows stippling or lines which could be interpreted as color coding, a statement that the lining and/or stippling is for purposes of shading or is a feature of the mark, and that it does not designate color
14. If there is foreign wording in the mark, an English translation of such foreign wording
15. If the mark (or any part thereof) has any significance, either in the relevant trade or industry, or as a surname or geographical indicator, this information must be disclosed
16. If the mark comprises descriptive terminology and is not unitary, the descriptive terminology must be disclaimed
17. A declaration signed by the applicant or its authorized representative
  - a. An officer, director or manager (person equivalent to an officer under the laws of a foreign country)
  - b. A person having color of authority pursuant to a power of attorney or other authorization, and having knowledge of the facts stated in the application
  - c. An attorney authorized to practice law in the U.S.
18. Funds by check, or authorization to charge a deposit account or credit card, to cover all classes of goods and services

If the application is filed by mail rather than electronically, the application should also have a self-addressed, stamped postcard attached to the top of the application papers. The PTO will return this postcard, stamped with the serial number and filing date, to confirm receipt of the application. Sometimes the serial number of the case is stamped on the front of the postcard while the date is affixed to the rear as an adhesive label.

## VIII. The Application Process

For applications filed by mail (Express Mail, private courier, hand delivery or regular mail), a filing receipt will usually issue within two to three months. This receipt should be checked very carefully for typographical errors, which are frequent. In the event of such errors, the corrections can be communicated to the clerk in Program Control. The corrections can be neatly marked directly on the filing receipt, and then faxed to the Pre-Examination Section at 703-872-9801. A revised filing receipt will then issue. Clients, particularly foreign clients, appreciate receiving the filing receipt; the filing receipt may be needed to provide particulars for Convention filings in other countries. Errors can also be corrected in a later Amendment or Response to an Office Action. Errors in classification should be corrected promptly.

An attorney in the PTO (a “trademark examining attorney,” or “examining attorney” for short) reviews the application within about six months of the filing date. The status of the application can be monitored by checking the TARR database on the PTO web site. However, the electronic database is frequently far behind in posting the assignment of files to examining attorneys. Once the application has been assigned to an examining attorney, the official review should occur in a matter of weeks. If everything is in order, the application is approved for publication. Approval for publication is noted on the TARR database, but not sent to the applicant. Once an ITU mark has been approved for publication, the applicant is precluded from filing an Allegation of Use until after issuance of a Notice of Allowance. The PTO Status Line or PTO web site should be consulted before filing an Allegation of Use, to prevent wasteful filing (and possible loss of documents and specimens) during the “blackout period.” After the appropriate review by a supervisory attorney, the application is put in line for publication, and a notice of publication will then issue in approximately eight weeks following final approval. Publication follows in thirty days. Because outside contractors are used for the publication of the Official Gazette, it is beyond the control of the PTO to expedite the schedule for publication.

There is a 30-day period following publication in which any party who feels it will be damaged if the mark proceeds to registration can file an opposition.<sup>26</sup> A potential opposer can secure extensions for up to 90 days without the consent of the applicant; thereafter, additional extensions of time to oppose can be secured upon consent of the applicant.<sup>27</sup> If no opposition or extension of time to oppose is filed, the certificate of registration issues in about three months in the case of applications

based on use under section 1(a) or on a home country registration under section 44(e), and there are no additional fees to be paid. For marks eligible for registration only on the Supplemental Register, the mark is not published for opposition, and the Certificate of Registration issues in about three months following approval by the examining attorney.<sup>28</sup> For intent-to-use applications, the Notice of Allowance issues in about three months following approval by the examining attorney.<sup>29</sup>

If the examining attorney finds problems with the application, such as information that is missing, an identification of goods or services that requires amendment, or inherent registrability problems (discussed in greater detail below), an Office Action will issue. The applicant has a nonextendable deadline of six months within which to reply completely to all issues raised. If no reply is filed, the application is abandoned approximately two months following the day the response is due. If the objections are not fully addressed to the satisfaction of the examining attorney, a final refusal to register the mark will issue. The applicant's attorney is permitted to call the examining attorney at any time to discuss the objections and requirements, and to better gauge the evidence or information that will satisfy the examining attorney's concerns. Following a final refusal, the applicant has six months to comply with the requirements or persuade the examining attorney to withdraw the refusal to register; any new evidence or arguments must be filed prior to the six-month deadline. For tactical reasons, it is best to file a response to a final refusal early in the six-month term so as to get the response reviewed before the deadline and to know whether an appeal will be necessary.

If the arguments are not successful, or if the response is filed near the deadline so that the examining attorney will not have time to review the response before the end of the six-month term, it is prudent to file a Notice of Appeal with the Trademark Trial and Appeal Board (T.T.A.B.). The filing fee is \$100 per class.<sup>30</sup> This will preserve the applicant's right to appeal from the final refusal to register. The deadline for filing the Notice of Appeal is nonextendable. However, the examining attorney has discretion to consider arguments and evidence filed in response to the final refusal (called a Request for Reconsideration), and reissue a final refusal based on the new evidence. Once the application is submitted to the T.T.A.B. on appeal, the record is closed, and no further evidence can be submitted. If a Request for Reconsideration has been filed, the Board will suspend the schedule for briefing, pending the examining attorney's final determination on the Request for Reconsideration.

Intent-to-use applications follow a similar path. However, a mark in an application based solely on intent to use cannot become registered until proof of use of the mark in commerce is filed and the \$100 filing fee per class is paid.<sup>31</sup> The Allegation of Use (AOU) can be filed either during the prosecution stage before the mark is approved for publication (formerly referred to as an Amendment to Allege Use), or subsequent to the issuance of the Notice of Allowance (formerly referred to as a Statement of Use). If the AOU is filed during the "blackout period," which exists between approval of the mark for publication and the issuance of the Notice of Allowance (NOA), the AOU will be returned to the applicant or its attorney.<sup>32</sup> If the AOU is timely filed but is not associated with the file promptly, and the mark is published for opposition, the

applicant is given the opportunity to have the AOU examined at that time. However, the mark will have to be republished.<sup>33</sup>

If use does not commence during the prosecution of the application, the application is approved (subject to further examination once the AOU is filed), and the NOA issues following the publication stage. The applicant is given up to six months from the mailing date on the NOA to file the AOU.<sup>34</sup> If use has not yet commenced, the applicant must file an extension request within the six-month deadline.<sup>35</sup> The extension request must be signed by an authorized signatory (meeting the same criteria as for the application), and accompanied by a fee in the amount of \$150 per class.<sup>36</sup> Subsequent extensions can be requested only in six-month increments, upon filing the request with a statement that the applicant has a continued *bona fide* intent to use the mark for the goods and services listed in the Notice of Allowance, and setting forth, in general terms, the steps being taken to commercialize the mark.<sup>37</sup> For example, the applicant can state that the products for which the mark is intended to be used are still in development, or are awaiting governmental approval, or that the applicant is seeking a distributor. The explanation can be very simple with little detail. If the AOU is not filed by the three-year anniversary date of the issuance of the NOA, the application will become abandoned.<sup>38</sup>

The requirements for filing an AOU are similar to those for filing a use-based application.<sup>39</sup> The applicant must submit, in a form with a signed declaration, the date of first use and date of first use in commerce, and state that the mark is now in use in commerce. One specimen of use per class must be submitted, and a fee of \$100 per class. The applicant must specify the goods or services for which the mark is currently in use.<sup>40</sup> If the mark is not yet in use for all of the goods or services listed in the application, the applicant has the choice of either dropping the remaining goods, or filing a request to divide the application as to the goods and services for which the AOU is being filed.<sup>41</sup> The fee for filing a request to divide is \$100 per class, but in addition, if a class is being split (i.e., the mark is not in use for all of the goods in a single class), a fee of \$335 per class for each split class must be paid. The “child” application is given a new serial number, the AOU is examined and, if approved, the certificate of registration issues for the child file; the original “parent” file continues to remain pending, subject to the filing of further extension requests, and ultimately the AOU.<sup>42</sup>

If the AOU is filed during the prosecution stage but is rejected as being deficient (for example, if the specimens do not show proper use of the mark), the applicant has the option of withdrawing the AOU and filing new specimens at a later time (if no suitable substitute specimens are available).<sup>43</sup> This option is not available if the AOU is filed after the Notice of Allowance issues.<sup>44</sup> If there is any doubt as to the suitability of the specimens when the AOU is filed after the NOA has issued, the applicant should file an extension request before the end of the six-month term, so as to secure another six months for filing the AOU. Even if time remains in the three-year term, only one extension can be taken following the filing of an AOU. Therefore, if there is uncertainty about the suitability of the specimens, the AOU should be filed early in the six-month term so that the examining attorney will provide input before the end of the six-month term. The applicant will then know if it is necessary to file a

further extension request, and this will also give the applicant the maximum time to develop substitute specimens. The applicant must provide a sworn declaration that the specimens were in use before the expiration of the time allowed to the applicant for filing its AOU, so the extension gives more options in terms of creating an acceptable specimen. The PTO issues a Notice of Acceptance when the AOU is accepted. If the AOU is filed after the NOA has issued, the certificate of registration will issue in approximately three months after approval.

The applicant should retain in its files all documentation relating to the development of the mark and the first use, including invoices for logo designs and package prototypes, and purchase orders, invoices and shipping documents relating to the first shipment. This may be necessary if a third party challenges the *bona fide* intent to use the mark, or the date of first use claimed in the application.

Section 10 of the Lanham Act specifies that pending ITU applications for which the AOU has not been filed cannot be assigned, except as part of an ongoing business. This is to prevent “trafficking” in trademarks—i.e., people reserving desirable trademarks and then selling them (as is currently the practice with domain names).

Section 44(d) and 44(e) applications are simpler than use-based applications because there are no specimens to examine, and these applications are less expensive than ITU applications because there are no fees for filing extension requests and the AOU. The applications are examined only as to inherent registrability and blocking marks. In the case of section 44(d) applications, the application will not be published until the home country registration is submitted, unless the basis is changed to use, ITU, or a home country registration for the same mark covering the goods and services listed. Meanwhile, following examination, the section 44(d) application is suspended, although periodic inquiry (once every six months or so) may be made as to the status of the issuance of the foreign registration. The failure to respond to the status inquiry will result in the abandonment of the application. Consequently, there are some additional costs and delays associated with section 44 applications.

Once the home country registration issues, the applicant submits a photocopy of it and, if the registration is not in English, a signed English translation of the certificate of registration. The home country registration is examined as to conformance of the mark and goods with the U.S. application, because the marks must be identical in both the home country registration and the U.S. application, and the goods no broader than those in the home country registration. The home country registration must be in effect at the time the U.S. registration will issue (if the home country registration expires during the pendency of the U.S. application, the examining attorney will request proof that the home country registration was renewed).

The examining attorney will not inquire whether the applicant truly has a *bona fide* intent to use the mark for all of the goods and services listed. Some foreign countries allow for very broad listings of goods and services, including the filing of complete class headings, or a statement that the applicant is registering the mark for all goods in the class. However, third parties can, and often do, challenge the *bona fides* of the applicant, as well as its statement under oath that it has a *bona fide* intent to use the

mark for all listed goods and services. Therefore, some judicious counseling of the client and editing of the listing of goods and services, rather than copying the list from the foreign registration wholesale, is prudent practice to avoid such a challenge.

## **IX. Prosecuting the Application**

Applications are assigned on a random basis to examining attorneys, although the examining attorneys are grouped in law offices and are generally responsible for examining certain classes of goods (in the case of a multiclass examination, the examining attorney may not have much familiarity with some of the classes, but will seek guidance from examining attorneys who usually examine those classes). All examining attorneys examine service mark applications, and there are now e-commerce law offices in the Trademark Office that will examine all classes of goods and services, but only for those applications that are filed electronically.

The same examining attorney will handle related applications by a single applicant that are filed together. Similarly, even if the related applications are not filed together but a later-filed application is filed for a variant of a mark that is currently pending, the application should be assigned to the same examining attorney who is reviewing the earlier filed mark. This practice promotes consistency in examination. Otherwise, the examining attorney assigned to a particular application is completely arbitrary.

Examining attorneys are charged with determining whether or not a mark should be registered. An examining attorney's goal is to register a mark whenever possible, so that the public will have notice of the marks that are in use and can thereby avoid those marks. With this goal in mind, most examining attorneys strive to be helpful in guiding applicants through the application process, suggesting amendments to the listing of goods and services or other technical objections. Examining attorneys tend to be less helpful in assisting applicants in overcoming substantive refusals, but in some instances, the examining attorneys do not feel strongly about a refusal raised in a first Office Action, and any reasonably persuasive response may be sufficient to allow an examining attorney to withdraw the refusal. As long as the response creates a record that justifies the change in position, the refusal may be withdrawn. For example, if there is a refusal based on a likelihood of confusion with a registered mark and the Register is quite crowded with other similar marks, the presentation of that argument (and official copies from the PTO web site) will likely make the point so that the refusal can be withdrawn.

Section 2(e) of the Trademark Act states that a mark is not eligible for registration on the Principal Register if it merely describes the goods or services, or a quality, characteristic, feature or function of the goods or services or is laudatory thereof.<sup>45</sup> Similarly, a mark that comprises a geographical term, and the goods or services come from that place, or that place is known for producing such goods or services, cannot be registered on the Principal Register.<sup>46</sup> Marks that are primarily merely surnames

are also precluded from registration.<sup>47</sup> Also, if only a portion of the mark is descriptive of the goods or services, or laudatory or geographically descriptive, that element of the mark may have to be disclaimed under section 6 of the Lanham Act, but the mark as a whole can still be registered on the Principal Register.<sup>48</sup> If the mark comprises a surname together with a first name or a surname together with a design element, the surname does not have to be disclaimed, and the entire mark may be registered on the Principal Register. However, a surname together with a first initial letter or two initials will still be considered to be primarily and merely a surname.<sup>49</sup>

It is possible to overcome any of these refusals made under section 2(e) by providing evidence or arguments to counter the examining attorney's position. Case law holds that any doubt on the issue of descriptiveness must be resolved in favor of the applicant. For example, a mark alleged to be merely descriptive of the goods or services will not be refused registration if the mark is "unitary," meaning that the descriptive terms are run together or hyphenated, or that they form a unitary phrase due to alliteration, such as the mark TUMBLE TOTS for gymnastic equipment. Marks that create a catchy "double entendre" are not considered descriptive, for example, SUPREME COURT for tennis court surfaces.<sup>50</sup> The mere fact that the words comprising the mark are in the dictionary does not doom the mark, if the context in which the words are used is not the ordinary dictionary sense. Moreover, if the mark describes the result of use of the goods, rather than any characteristic of the goods themselves, the applicant can overcome the descriptiveness refusal. One example of such a mark is TEE GREEN for golf course fertilizer.<sup>51</sup> There are examples and case citations for all of these scenarios in the TMEP, as well as in treatises such as Gilson's and McCarthy's.

For disclaimer requirements, it is useful to check the PTO database by doing a search on the identical term for the same category of products or services. If, for example, there are 75 marks that are registered containing the same term, and only three marks contain a disclaimer of that term, this is fairly persuasive evidence that a disclaimer should not be required. Although the examining attorneys frequently take the position that they are not "bound by the prior mistakes of other examining attorneys," a pervasive trend is likely to be compelling evidence, and not perceived as a "mistake."

To overcome a geographically descriptive objection, one must show that there is no goods/place association (i.e., that the place named in the mark is not known as a source of the goods covered by the application).<sup>52</sup> It has been held that NANTUCKET is not geographically descriptive of shirts,<sup>53</sup> and that RODEO DRIVE is not known for perfume.<sup>54</sup> If the place named in the mark is known for the goods and the goods are made elsewhere, the mark may be deceptively misdescriptive in a geographical sense, and not registrable at all, even on the Supplemental Register.<sup>55</sup> Certain appellations of origin, such as Champagne and Roquefort, are the subject of specific legislation, and these terms cannot be used in marks unless the goods come from the region named in the mark. There are additional restrictions related to geographical designations as applied to wine and spirits.<sup>56</sup> Generally, as to marks that incorporate geographical words, if the mark could have another meaning aside from

the geographical connotation, the mark may be registered because it is not primarily *merely* geographically descriptive.

This same type of reasoning may be used to counter a refusal on the basis that the mark is primarily and merely a surname. For example, FRANK can be a first name as well as a surname, and BIRD is an animal as well as a surname. While marks such as SEIDENBERG could only be perceived as surnames,<sup>57</sup> other names may be more ambiguous and subject to other interpretations or may appear to be coined, for example, GRAINGERS for grain-based crackers.<sup>58</sup>

The examining attorneys rely on PhoneDisc, which has 93 million names in its directory. If the examining attorney provides evidence that a mark that could be a surname has only a hundred or so listings in the PhoneDisc directory, this is good evidence that the surname is very rare and is likely not to be perceived as a surname. There is some case law that indicates that if a mark “looks and feels” like a surname, it is likely to be perceived as such by consumers and thus can be refused registration.<sup>59</sup> Marks that are primarily merely surnames can be registered after five years of use, with a claim of acquired distinctiveness. In the alternative, a surname can be coupled with a distinctive design, in which case it will be registrable on the Principal Register because it will not be *merely* a surname. Marks that comprise merely surnames may be registered on the Supplemental Register.

Another ground for refusal is that the mark does not function as a trademark at all—i.e., that it is merely ornamental or functional, or informational. Background designs on packaging, containers for goods, building designs, designs on apparel, and slogan marks are typically subject to this type of refusal, which is referred to as “failure to function” as a trademark. In addition, color marks, whether single colors or multiple combinations of colors, usually encounter a refusal under sections 1, 2 and 45 of the Trademark Act. Using “look for” advertising (“look for the red and green package as your sign of quality”), and submitting copies of such advertisements with the Response to Office Action, is often accepted as evidence to overcome the refusal, because it shows the color itself to be promoted as a mark.

If arguments against the section 2(e) or “failure to function” refusals are not accepted, the applicant has two options. The first option, amending the mark to the Supplemental Register, is available only for marks that are in use in commerce at the time the amendment is made, or that are based on section 44(e). Marks that originally are filed under section 1(b), but have an Allegation of Use filed during the prosecution of the application, may be amended to the Supplemental Register. The amendment causes the original filing date of the ITU application to be lost, and the date of the filing of the AOU becomes the new filing date (although the applicant will have effective priority as of the date of first use in commerce).

The other alternative is to show that the mark has become distinctive as to the goods or services through extensive use and promotion, as provided by section 2(f) of the Trademark Act. The regulations state that five years of use is presumptive evidence of distinctiveness, but even five years’ use may not suffice for highly descriptive marks. On the other hand, cases hold that in today’s world of huge advertising budgets

and immediate nationwide media access, a mark may acquire distinctiveness in a matter of months, depending on the circumstances. TMEP section 1212 gives some guidance as to the types of evidence that might be persuasive in showing acquired distinctiveness, such as a high volume of sales and advertising featuring the mark, letters from customers acknowledging recognition of the mark, unsolicited press write-ups, and the like. When preparing a section 2(f) filing in response to a final refusal, the applicant should make a statement for the record that if the evidence of acquired distinctiveness is not persuasive, the applicant authorizes amendment to the Supplemental Register (if the mark so qualifies). Additionally, such an amendment may be made without admitting that the mark has not acquired distinctiveness.<sup>60</sup> However (but only in response to an Office Action citing a descriptiveness refusal), filing an application under section 2(f) is an admission of descriptiveness, but constitutes a claim that the mark has acquired distinctiveness.<sup>61</sup>

Although section 2(f) is used primarily for use-based applications, it can be used to support registration of marks filed under section 1(b), if the essentially identical mark is already registered for closely related or ancillary goods or services. For example, if a mark is already registered under section 2(f) for apparel, the applicant should be able to “bootstrap” a new ITU application for footwear based on the prior registration.<sup>62</sup>

If a mark is determined to be generic, no amount of secondary meaning will permit the mark to be registered.<sup>63</sup> The burden of proof is on the examining attorney to show that the public perceives the mark as the common name of the product or service (i.e., the genus of the goods or services), and that the exact term sought to be registered would be used by the public to identify the type or category of product or service.<sup>64</sup> Survey evidence and customer letters are particularly helpful in countering genericness refusals. The one exception to this strict interpretation in favor of the applicant is with respect to magazine titles. If the magazine title describes the content of the magazine, the mark is generally deemed to be generic.

Other categories of marks for which registration is not permitted under section 2 of the Lanham Act are as follows:

1. marks deemed to be scandalous or immoral;
2. marks which comprise the flag or coat of arms of the U.S., a state or foreign country;
3. marks which comprise the name or likeness of a living person, unless the person gives consent;
4. marks which comprise the name or likeness of a deceased president of the U.S. whose spouse is still alive; and
5. marks as to which the applicant is not the owner (for example, a mere distributor of the goods, or the wrong entity named in the application).

There is considerable case law on the first category. In addition to “naughty words,” cases have arisen as to politically or culturally sensitive words applied to groups of

people such as minorities, American Indians, and religions, if the marks would be deemed to be disparaging to these people.<sup>65</sup>

Perhaps the most challenging refusals are those made under section 2(d), on the basis that the mark is deemed to be confusingly similar to a prior registered mark.<sup>66</sup> With section 2(d) refusals, unlike section 2(e) refusals, the applicant has the burden of persuading the examining attorney that there is no likelihood of confusion. The examining attorney may also reference a prior pending mark that has not yet registered; in this instance, further action on the applicant's mark will be suspended pending the disposition of the prior filed application, which in the case of a mark filed under 1(b) or 44(d), may take years to be registered or abandoned. Arguing against a blocking citation can be difficult if the goods or services recited in the registration are vague or overly broad. The examining attorney will only consider the terminology stated in the registration, without regard to any extraneous "real world" facts, such as limitations on the trade channels, or the fact that the blocking registrant's goods are cheap and the applicant's customers would never encounter them.<sup>67</sup> Even making reference to information contained on the specimens of record or statements made by the blocking registrant in the course of prosecuting its application may not be heeded by the examining attorney.

Before considering arguments against a blocking citation one should first check the date and status of the blocking mark. If the registration is more than six years old, it is advisable to check to see if a section 8 declaration was filed. It takes about a year for a canceled mark to be noted in the official PTO records, but one can check the file for the blocking registration and see if the section 8 declaration was submitted. If the blocking mark was registered many years ago, it is possible that the mark has been abandoned. The registrant can be contacted, either directly or through a trademark investigator, to determine whether or not the mark is still in use. If the registrant is no longer using the mark and does not intend to use it in the future, the registrant can be asked to voluntarily cancel the blocking registration.

If the registrant cannot be located or if the registrant will not cooperate but it is believed that the mark has been abandoned, the applicant can petition to cancel the blocking registration. It takes about two months for the cancellation petition to be instituted (with a filing fee of \$300 per class), and then the registrant is given 40 days to respond. Thus, it takes about three to four months before the applicant will know whether the blocking registrant will contest the cancellation petition. Meanwhile, the applicant must respond to the Office Action by addressing all other issues, and by notifying the examining attorney that the cancellation petition has been filed and by supplying a copy of it. Further action on the application will be suspended until the cancellation action is resolved.<sup>68</sup> This can take many more months, because if the registrant does not respond, the T.T.A.B. issues an order to show cause why default judgment should not be entered, and the registrant is given 30 days to respond. The T.T.A.B. waits a few more months to make sure that no correspondence has been delayed or misplaced, and ultimately, the blocking registration is cancelled. A full explanation of T.T.A.B. rules and procedures can be found in the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (1<sup>st</sup> ed. 1995) available on the PTO web site

Assuming that the registration is still valid and that the mark has not been abandoned, the applicant can, in the first instance, argue against a likelihood of confusion by referring to the *du Pont* factors cited in the leading case from the predecessor to the Federal U.S. Circuit Court of Appeals, *In re E.I. du Pont de Nemours & Co.*<sup>69</sup> Among these factors are the similarities of the marks, similarities of the goods, the strength of the mark, the likelihood that the registrant will “bridge the gap” and sell the same products as the applicant, the sophistication of the purchasers, the cost of the goods and the care with which they would be selected, and any instances of actual confusion. If the only element shared by the marks is a common, descriptive or highly suggestive term, it is helpful to submit such evidence in the form of numerous third-party registrations printed from the official PTO web site, or copies of the registrations obtained from the PTO. The fact that many marks already coexist with the same word or design element is often persuasive evidence that one more similar mark can likewise coexist.<sup>70</sup>

If the applicant believes that there will be no likelihood of confusion as a practical matter, or if the applicant is actually the prior user, it can approach the cited registrant for a coexistence agreement. This agreement must be signed by an officer of the registrant, indicating that the registrant consents to the use and registration of the applicant’s mark. The consent also must state the reasons why coexistence is believed to be possible—for example, the parties sell their respective goods through different channels of trade, or the parties’ goods have been coexisting in the marketplace for a number of years without any evidence of confusion. If the consent spells out these reasons, the examining attorney is essentially required to accept the determination of the parties directly involved that there will be no likelihood of confusion.<sup>71</sup> The examining attorney is not permitted to substitute his or her judgment for those who stand to be most affected by the decision. If money is paid to facilitate the coexistence agreement, it is best not to recite the consideration paid in the consent agreement. A side letter should be used for this purpose.

A consent agreement can also be useful when the blocking registration recites a very broad description of goods that would no longer be permitted today, such as “books” or “computer programs.” The applicant can first approach the cited registrant for its consent, but if the registrant refuses, the applicant can file a petition for partial cancellation under section 18. This proceeding will, if followed to its conclusion (but typically, the registrant decides to cooperate once the proceeding is instituted), result in a narrowing of the identification of goods, which may be all that is needed to sufficiently distinguish the marks. The examining attorney will not remove the blocking citation based merely on the assertion by the applicant that the listing of goods in the cited registration is impermissibly broad. Instead, a cancellation proceeding must be filed.

If the blocking citation pertains to only one class of goods or services, the remaining goods and services can be divided out using the above-described request to divide procedure, which will allow these goods and services to continue through the registration process. Only the remaining blocked goods in the parent application will be subject to the refusal, additional arguments and possible appeal. Alternatively, the goods blocked by a prior registration can simply be deleted (if the applicant does not

wish to contest the blocking citation), which will usually allow the application for the remaining goods to move forward to registration.

In addition to objections or issues regarding the inherent registrability of the mark, there are technical objections that may be raised during the examination process. Most commonly, the examining attorney may object on the basis that the identification of goods and services is not sufficiently specific, or that it is overly broad, or that the goods or services are misclassified.<sup>72</sup> For these objections, it is best to refer to the *Acceptable Identification of Goods and Services Manual* (“I.D. Manual”), available from INTA in print form, or on-line at the PTO web site, where current changes and amendments can be found. There are occasional updates, particularly in the computer and telecommunications-related categories, so it is helpful to check the PTO web site for the latest information even if referring to the printed manual. Examining attorneys will frequently make concrete suggestions regarding the amendment of the goods and services; these are merely suggestions based upon an educated guess of the activities of the applicant. The applicant is free to make alternative suggestions, and they will be accepted, provided that the revised listing does not exceed the scope of the original list of goods or services, and that the amended wording is more or less in conformance with the wording in the I.D. Manual. A new declaration may be required to support the addition of a class to the application or a new specimen submitted in the case of a use-based application.<sup>73</sup>

Examining attorneys may object that the specimen as filed does not show proper trademark use, or does not support the goods or services listed. Appropriate specimens for goods generally take the form of labels, tags or displays, or photographs or photocopies of the mark displayed directly on the goods or containers for the goods.<sup>74</sup> However, this is not an exclusive listing, and other types of specimens may be acceptable. For example, for computer programs that can be downloaded on-line, an appropriate specimen may comprise the first page of the program showing the title or trademark as it appears on the computer monitor. For goods sold by catalog, the catalog page (either in print or downloaded from the web site) showing the mark in close proximity to the goods will suffice, so long as the catalog shows how the goods may be ordered; case law states that such specimens constitute “displays.”<sup>75</sup> The PTO will accept a specimen printed from a web site so long as properly identified, even if there is no other “hard copy” rendition of the mark used in association with the goods or services. Goods sold in bulk, such as chemicals or grains, may use packing slips or other shipping data, where it is not feasible to place the mark on the goods in a more traditional manner.<sup>76</sup>

For services, specimens tend to be more varied depending on the nature of the services.<sup>77</sup> Advertising printed in newspapers, magazines, or client mail materials are excellent specimens. Retail stores may use signage or shopping bags, while restaurants may use either of these items, or menus, napkins or the like. Consulting services tend to use brochures, web site pages or presentation slides, but actual business proposals or letters to clients offering the services would also suffice. Letterhead or business cards will be accepted if they refer to the services, for example, in a tagline, or by an indication near the mark (e.g., “roofing specialists”). Care should be taken in

selecting specimens, particularly letterhead and business cards, as rejections based on improper specimens can result in unnecessary delay and expense for the applicant.

It is sometimes difficult to tell whether the applicant is offering goods or services, particularly with some of the newer technologies and on-line offerings. For example, computer programs offered on-line are currently considered to be “providing access to a computer program [requiring a specification of the function and field of use]” in Class 42, while the same program, if downloadable by the user, is considered to be “computer software [specify type and function or field of use]” in Class 9. The applicant will be permitted, in this limited instance, to switch the identification in the application from services to goods, or vice-versa. Generally, amendments from goods to services, or the reverse, are not permitted (for example, from clothing to retail store services featuring clothing), because it is considered beyond the scope of the original identification, of which there was notice at filing, even if the amendment is made prior to publication. The only amendments permitted to the listing of goods or services are those that serve to clarify or limit the listing.

Another common requirement is that the applicant disclaim descriptive wording or design elements in the mark. If the word or design element is, in fact, descriptive, the disclaimer should be given. In addition, words that have no source indicating function, such as “Inc.” are properly disclaimed. However, there are instances when a disclaimer is required, but the applicant believes that the term is not descriptive (e.g., because of the context in which it is used, or because the mark is unitary). The applicant should then present arguments to overcome the requirement, by explaining the reasons why a disclaimer is not required in this instance. Offering a disclaimer when the term is not truly descriptive may have negative effects in disputes with third parties, or when the applicant tries to enforce its rights in the mark in court. On the other hand, a disclaimer of a descriptive term may be of assistance in arguing against a section 2(d) blocking citation (by showing the inherent weakness in the cited registration) or in defending a claim of infringement brought by a third party.

The examining attorney may request clarification about the nature of the applicant’s business form or citizenship, or the signatory to the application. If the application was filed unsigned as is now permitted, a signed copy will have to be supplied. There may be issues in a section 44(e) application about the validity of the registration, or whether the scope of coverage, either as to the mark or the goods and services, exceeds the scope of the U.S. filing. Translations of foreign wording in a mark will be required. Statements for the record describing a design mark, or claims to color or stippling statements, may be required for design marks. TMEP section 800 provides a detailed explanation as to all of these requirements.

It is also common for the examining attorneys to require additional information pertaining to the applicant’s goods and services.<sup>78</sup> If the application is based on intent to use, the applicant must still provide a narrative explanation of the nature of the goods or services to meet this requirement. These technical requirements, like statutory refusals, prevent the application from moving forward to publication. They are requirements that must be addressed, either by compliance or argument, before the examining attorney can approve the mark.

Many of these issues can be addressed simply and quickly by telephone, and the examining attorneys encourage the use of the telephone to resolve technical objections whenever possible. Note that examining attorneys will speak only with attorneys regarding substantive issues or Office Action responses handled by telephone, except in the case of applicants who filed “*pro se*.” When responding to an Office Action, be sure to address every issue raised, if only to confirm the examining attorney’s assumption or statement. Failure to address any issue will result in a final refusal, and if a final refusal was already issued, in abandonment. There is no requirement to cite the statute, regulations, TMEP or case law when responding to an Office Action; simple explanations or arguments are often more effective than detailed, comprehensive briefs. Examining attorneys operate under a strict production requirement; lengthy arguments based on case law in the applicant’s response generally do not help to clarify the issues.

## X. Missed Deadlines

Although there is a nonextendable six-month deadline for responding to Office Actions, the application can be revived if the failure to timely respond was unintentional on the part of the applicant or the applicant’s attorney.<sup>79</sup> This same rule provides for revival where an Allegation of Use or a request for extension of time to file an Allegation of Use was not timely filed after issuance of a Notice of Allowance in an ITU application. “Unintentional” abandonment is a very flexible standard, and includes such explanations as the fact that the deadline was overlooked, or that the papers were lost in the mail, or that the applicant could not find an appropriate person to provide necessary information as the deadline arrived. Examination Guide 3-99, section XV, available on the PTO web site, provides a full explanation of the rules pertaining to abandonment, which are much more applicant-friendly than they were previously.

The application may be revived upon the filing of a petition to the Trademark Director’s Office, together with a fee of \$100, stating that the failure to respond was due to inadvertence. The PTO does not require a detailed explanation, nor does the petition need to be accompanied by an affidavit as to the circumstances causing the abandonment. However, the petition must be signed by a person with first-hand knowledge of the facts stated in the petition (i.e., that the abandonment was unintentional). The petition must be filed within two months of the date of the Notice of Abandonment, or if a Notice of Abandonment is not received, within two months of the applicant’s discovery of the abandonment. Because there is a specific duty to inquire about the status of an application within one year of filing, the applicant will have no more than one year and two months within which to file a petition. The petition must also be accompanied by a proposed Response to Office Action.<sup>80</sup>

The failure to file an Allegation of Use or an extension request following the issuance of the Notice of Allowance may also be rectified by filing a petition to revive as per

the requirements stated above, together with a copy of the missing document and the requisite fees (\$100 for filing the petition, plus \$100 per class for the AOU, or \$150 per class for the extension request).<sup>81</sup> There are two particular practice pointers in this instance. If the petition has not yet been granted and the next deadline is approaching for filing another extension request, this document must be filed within the six-month deadline of when the extension request would have been due, but for the abandonment. Failure to file the next extension request, even while the petition is pending, will again result in abandonment. Second, note that in no event can the time to file an AOU be extended beyond the three-year outside deadline from the date of the issuance of the Notice of Allowance. Thus, if the deadline is near, one must not wait to receive formal notification from the PTO that the petition has been granted; the petition will in almost every case be granted as a matter of course. It is best to file the AOU as soon as the applicant is in a position to do so—i.e., when use in commerce has been made.

There are some instances when a petition to revive cannot be filed. A petition cannot be used to file a section 44(d) priority claim after the six-month deadline following the home country filing date. Also, a petition cannot be used to revive a cancelled or expired registration if the document is not filed within the term or the six-month grace period (as explained more fully below). If the applicant wishes to appeal from the refusal to register, the deadline for filing the Notice of Appeal cannot be extended through a petition to revive; however, a petition to the Trademark Director, with a very compelling reason for having missed the deadline, may be successful.<sup>82</sup> Lastly, a petition to revive cannot be used to reinstate the time to oppose, if the notice of opposition or extension of time to oppose was not timely filed. The remedy in that case is to file a cancellation action once the registration issues.

## **XI. Ex Parte Appeals**

Within six months of the date of a final refusal to register, the applicant must file a Notice of Appeal, if it wishes to appeal the refusal to register to the T.T.A.B.<sup>83</sup> The notice, which is filed with the T.T.A.B., with a copy to the examining attorney, is a simple one-sentence document advising the T.T.A.B. that the applicant is appealing from the final refusal to register. The Notice of Appeal must be accompanied by the fee (or authorization to charge a deposit account) in the amount of \$100. This document must be filed within the six-month deadline of the date of the final refusal, even if a request for reconsideration (which is essentially a response to a Final Office Action) has been filed. Any evidence that should be made of record must be filed with the Request for Reconsideration to a Final Office Action so that it may be considered in the appellate process. No new evidence may be made of record during the appeal.

Once the Notice of Appeal has been filed, the T.T.A.B. clerk will issue a letter indicating that the appeal has been instituted. The applicant then has 60 days to submit a brief. The examining attorney will file a responsive brief within 60 days of

the mailing date of the applicant's brief. The applicant may file a reply brief within 20 days of the filing of the examining attorney's brief, although it is not necessary to do so.

The applicant may, at its option, request an oral argument before the T.T.A.B. Oral argument is often helpful in clarifying issues for the T.T.A.B. judges or answering their questions. This benefit must be weighed against the significant delay it causes and the expense of traveling to the PTO and attending the argument. If the applicant so elects, a mutually convenient date is assigned, and the applicant is given 20 minutes to present its case; the examining attorney will present his or her position, and the applicant, if it has reserved time from its allotted time, may present a reply. In due course (this may take up to a year or more), the T.T.A.B. will issue a written opinion. Under section 21 of the Lanham Act, the T.T.A.B.'s decision may be appealed within two months of the T.T.A.B. decision to either the Federal U.S. Circuit Court of Appeals, or in a civil action to the Federal District Court in the applicant's home district.<sup>84</sup>

## **XII. Post-Registration Maintenance**

### **A. Section 8 Declarations and Renewals**

The section 8 declaration attests to the fact that the mark is in use in commerce for the goods and services recited in the registration, or a lesser designated listing of goods and services.<sup>85</sup> It is due between the fifth and sixth year anniversary of the registration date, and between the ninth and tenth year anniversary date, and within one year of every tenth year anniversary thereafter. The section 8 declaration is sometimes called a section 8 affidavit; the form can be filed in either the form of a declaration or an affidavit, but a declaration is simpler because it is under oath, but no notarial attestation is required. The section 8 declaration is designed to remove "deadwood" from the Register by allowing unused marks to cancel automatically. Failure to file the section 8 declaration results in the cancellation of the registration. There is a six-month grace period during which the section 8 declaration may be filed, if accompanied by an *additional* fee of \$100 per class.

The section 8 declaration contains the following:

1. a statement that the mark is now in use in commerce;
2. a listing of the goods and services for which the mark is in use (this may be done by referring to "all goods and services set forth in the registration" or "all goods and services set forth in the registration, except . . .");
3. one specimen for each class of goods or services;

4. a declaration signed by an authorized signatory of the applicant (having the same qualifications as for signing an application, as explained in section VII of this paper);
5. a fee of \$100 per class.

If there are any deficiencies in the filing, these deficiencies may be cured by filing the necessary documentation or information; however, if the deficiencies are not cured until after the section 8 deadline (not counting the grace period), a fee of \$100 must be paid. The safest means of filing a section 8 declaration is to use the form set out at the PTO web site.

If the mark is not in use in commerce at the time the section 8 declaration is due, the applicant may be able to file a Declaration of Excusable Nonuse.<sup>86</sup> This document must set forth the date when the mark was last used, the commercial or business reason for nonuse, and the date when use in commerce is expected to resume. These filings are generally accepted if there is a compelling business reason for disruption in use, such as retooling a factory, switching product distributors, or reformulating the product. Even if the mark has never been in use (for registrations granted under section 44(e)), the Declaration of Excusable Nonuse may be granted if the applicant is awaiting regulatory approval to sell the product. The declaration is executed by the applicant as noted above, and all other requirements of the section 8 filing must be met, but for the statement that the mark is in use in commerce and submission of one specimen per class.

Registrations granted prior to November 16, 1989 have a 20-year term before a renewal application must be filed. Registrations granted on or after November 16, 1989 have a 10-year term. A renewal application is merely a request that the registration be renewed and signed by an authorized signatory, and that a fee of \$400 per class be filed with it.

However, a renewal application must be accompanied by a section 8 declaration which attests that the mark is in use in commerce (or a Declaration of Excusable Nonuse), with all of the requirements met as set forth above. A fee of \$100 per class for the section 8 declaration must be submitted, making the total fee for a renewal \$500. Under current law, owners of marks requiring renewal may file the renewal application and section 8 declaration at any time within the 12 months preceding the expiration of the then-existing term. If the renewal is filed in the six-month grace period following the 10-year anniversary (or any subsequent 10-year anniversary), an additional fee of \$100 per class must be paid. Furthermore, if there are any deficiencies, they may be cured after the expiration of the 10-year term by filing a \$100 fee. The complete requirements for renewal of trademark application can be found at section 1605 of the TMEP.

## B. Incontestable Status Under Section 15

A section 15 declaration may be filed at any time after the mark has been registered for five years, either with the initial section 8 filing or at any time thereafter.<sup>87</sup> Section 15 of the Lanham Act limits the grounds on which a registration can be challenged to abandonment, genericness, and fraud. It is also a powerful weapon in court—especially if injunctive relief is sought—and precludes the infringer from claiming that the mark is descriptive and not entitled to protection (although a court can take notice of the fact that a mark is weak, diluted, or suggestive, and thus entitled to a narrower scope of protection).<sup>88</sup> Functionality may still be advanced against an incontestable mark.

The requirements for filing a section 15 declaration are as follows:

1. a statement that the mark has been used substantially exclusively and continuously for the past five years;
2. a statement that the applicant is not aware of any challenge to the mark in a court or administrative proceeding;
3. a declaration signed by an authorized signatory;
4. a fee of \$200 per class.

Generally, if the mark qualifies for incontestability, it is considered to be good practice to obtain this additional level of protection. The section 15 declaration can be combined with a section 8 declaration. This “combined declaration” form is available on the PTO web site. Clients unfamiliar with these declarations should be advised that a combined declaration saves drafting time, but the filing fees remain the same.<sup>89</sup>

### Endnotes

□ © 2002 Susan Upton Douglass. The author appreciates the assistance of Diane B. Melnick, an associate with Fross Zelnick, and a former Examining Attorney with the PTO. The author wishes to thank Carol J. Ney, Senior Counsel Trademarks, Procter & Gamble, for assisting in updating this chapter.

<sup>1</sup> *Trademark Manual of Examining Procedure* (TMEP), § 707.

<sup>2</sup> TMEP § 708.02.

<sup>3</sup> 15 U.S.C. § 1117; Lanham Act § 35.

<sup>4</sup> 15 U.S.C. § 1072; Lanham Act § 22.

<sup>5</sup> 15 U.S.C. § 1065; Lanham Act § 15; TMEP § 1604.

- <sup>6</sup> 15 U.S.C. § 1115(b); Lanham Act § 33(b).
- <sup>7</sup> *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 83 L.Ed.2d 582, 105 S. Ct. 658, 224 U.S.P.Q. 327 (1985).
- <sup>8</sup> 15 U.S.C. § 1096, Lanham Act § 28.
- <sup>9</sup> 15 U.S.C. § 1114; Lanham Act § 32.
- <sup>10</sup> 15 U.S.C. § 1116(d); Lanham Act § 34(d).
- <sup>11</sup> 15 U.S.C. § 1125(d); Lanham Act § 43(d).
- <sup>12</sup> ICANN, Rules for Uniform Domain Name Dispute Resolution Policy, Section 3(b)(xv) (1999), available at [www.icann.org](http://www.icann.org).
- <sup>13</sup> 15 U.S.C. § 1091; Lanham Act § 23.
- <sup>14</sup> 15 U.S.C. § 1052; Lanham Act § 2.
- <sup>15</sup> *See also*, TMEP § 1212.
- <sup>16</sup> USTA, *The Trademark Law Revision Act of 1988*, Senate Report 100-515 at 176-77 (1989).
- <sup>17</sup> 15 U.S.C. § 1057(c); Lanham Act, § 7(c); TMEP § 1115.02 (*see* 15 U.S.C. § 1094, Lanham Act § 26, for this and other restrictions on applying the benefits of federal registration to marks registered on the Supplemental Register).
- <sup>18</sup> 15 U.S.C. § 1060; Lanham Act § 10.
- <sup>19</sup> TMEP § 1002.
- <sup>20</sup> TMEP § 1005.02.
- <sup>21</sup> TMEP § 1005.
- <sup>22</sup> TMEP §§ 1005.05 and 1009.03.
- <sup>23</sup> TMEP § 1004.
- <sup>24</sup> TMEP § 1004.05.
- <sup>25</sup> Trademark Rule 2.21(a).
- <sup>26</sup> TMEP § 1502.

- 27 TMEP § 1503.04.
- 28 TMEP § 1114.04.
- 29 TMEP § 1105.05(b).
- 30 Trademark Rule 2.6.
- 31 Trademark Rule 2.88, Trademark Rule 2.6.
- 32 TMEP § 1105.05(a)(i)(B).
- 33 TMEP § 1105.05(a)(i)(A).
- 34 Trademark Rule 2.88(a).
- 35 Trademark Rule 2.89(a).
- 36 Trademark Rule 2.6(a)(4).
- 37 Trademark Rule 2.89(b)-(d); TMEP § 1105.05(d).
- 38 Trademark Rule 2.89(c)(extensions may not aggregate more than 36 months).  
*See also* Trademark Rule 2.88(h). However, if the applicant continues to have a *bona fide* intent to use the mark, a new application can be filed for the same goods or services. Of course, the applicant then loses the original filing date and priority.
- 39 Trademark Rule 2.88(b)-(j).
- 40 TMEP § 1105.05(e).
- 41 Trademark Rule 2.87.
- 42 *See* TMEP § 1105.06 for the particulars of the divisional process.
- 43 Trademark Rule 2.88(f), (g); TMEP § 1105(a)(vi).
- 44 Trademark Rule 2.88(g)(final sentence); TMEP § 1105.05(f)(i)(C).
- 45 Section 2(e)(1).
- 46 Section 2(e)(2).
- 47 Section 2(e)(4).

- <sup>48</sup> See TMEP § 1213 for a thorough discussion of the disclaimer practice in the Trademark Office.
- <sup>49</sup> TMEP § 1211.01(b).
- <sup>50</sup> TMEP § 1209.01(b).
- <sup>51</sup> *In re Armour Agricultural Chemical Co.*, 155 U.S.P.Q. 175 (T.T.A.B. 1967).
- <sup>52</sup> TMEP § 1210.04.
- <sup>53</sup> *In re Nantucket Inc.*, 677 F.2d 95, 213 U.S.P.Q. 889 (C.C.P.A. 1982).
- <sup>54</sup> *Fred Hayman Beverly Hills v. Jacques Bernier Inc.*, 38 U.S.P.Q.2d 1691 (T.T.A.B. 1996).
- <sup>55</sup> TMEP § 1210.06.
- <sup>56</sup> TMEP § 1203.04.
- <sup>57</sup> *Ex parte Rivera Watch Corp.*, 106 U.S.P.Q. 145, 149 (Comm'r Pats. 1955).
- <sup>58</sup> *In re BDH Two Inc.*, 26 U.S.P.Q.2d 1556 (T.T.A.B. 1993).
- <sup>59</sup> *In re Industrie Pirelli*, 9 U.S.P.Q.2d 1564, 1566 (T.T.A.B. 1988) (PIRELLI held primarily merely a surname, despite rarity).
- <sup>60</sup> TMEP § 1114.05.
- <sup>61</sup> TMEP § 1212.02(b).
- <sup>62</sup> TMEP § 1212.09.
- <sup>63</sup> TMEP § 1212.02(i).
- <sup>64</sup> TMEP § 1209.01(c).
- <sup>65</sup> See e.g. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999)(petition to cancel trademarks of Washington Redskins football team granted on the basis of disparagement of native Americans by use of the word REDSKINS).
- <sup>66</sup> TMEP § 1207.01.
- <sup>67</sup> TMEP § 1207.01(a)(iii).

- 68 TMEP § 1108.01.
- 69 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).
- 70 TMEP § 1207.01(a)(i).
- 71 TMEP § 1207.01(c)(viii).
- 72 TMEP §§ 804, 805, 1301.05, and 1301.06.
- 73 TMEP § 905.10.
- 74 TMEP § 905.04.
- 75 *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 U.S.P.Q.2d 1314 (E.D. Va. 1992); TMEP § 905.06.
- 76 TMEP § 905.04.
- 77 TMEP § 1301.04.
- 78 Trademark Rule 2.61 (b).
- 79 Trademark Rule 2.66(b).
- 80 TMEP § 1704.
- 81 Trademark Rule 2.66(c).
- 82 Trademark Rule 2.146.
- 83 Lanham Act § 20; Trademark Rule 2.142.
- 84 Lanham Act § 21; Trademark Rule 2.145(d).
- 85 TMEP § 1603.
- 86 TMEP § 1603.09.
- 87 Trademark Rule 2.167; TMEP § 1604.
- 88 *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 224 U.S.P.Q. 327 (1985).
- 89 TMEP § 1604.04.