
USPTO: New Examination Standards for Repeating-Pattern Marks

On June 3, 2015, the United States Patent and Trademark Office (“USPTO”) issued a new examination guide that applies rigorous examination standards to repeating-pattern marks. A repeating-pattern mark is any mark composed of a single repeated element or a repeated combination of designs, numbers, letters, [More](#)

On June 3, 2015, the United States Patent and Trademark Office (“USPTO”) issued a new examination guide that applies rigorous examination standards to repeating-pattern marks. A repeating-pattern mark is any mark composed of a single repeated element or a repeated combination of designs, numbers, letters, or other characters, forming a pattern that is displayed on the surface of goods, on product packaging, or on materials associated with the advertising or provision of services. The repetition of the mark’s elements is a feature of the mark.

In the past, repeating-pattern marks typically were represented in trademark applications as a swatch-type drawing. A swatch-type drawing depicts a sample of the repeating pattern in a rectangle. In a departure from prior practice, the USPTO will now only rarely accept swatch-type drawings. Instead, the USPTO now requires the drawing to depict the pattern as it appears on the item or portion of the item to which it is applied. The shape of the item to which the pattern is applied must be depicted in broken lines. For example, the drawing might depict the shape of luggage in dotted lines, with the repeating-pattern mark corresponding to where the pattern appears on the product.

A swatch-type drawing will be accepted only if the applicant shows substantial evidence that (1) the applied-for mark is actually used, or will be used, in various ways or on a variety of different items, but (2) it will nonetheless be perceived as a source indicator and create the same commercial impression across all uses.

For applicants unable to meet the high standard for a swatch-type drawing, separate applications may be required to accurately depict the mark and the particular manner of display and placement of the repeating pattern. The drawing will be considered a substantially exact representation of the mark as used on all of the goods in the application only if the identified goods are similar in form and function, and the mark will appear in a similar manner on all of the goods. For example, if a repeating pattern is used in a similar manner on similarly-shaped purses of various sizes, a drawing showing the repeating pattern on one version of the purses (with the outline of the purse shown in broken lines) would be acceptable.

In cases in which a swatch-type drawing is submitted and the original description of the mark indicates that the pattern is used in a variety of ways, applications based on use or intent-to-use may be amended to conform to the new requirements, so long as such an amendment is not a material alteration. If the new drawing does not accurately depict the mark and the particular manner of display and placement of the repeating pattern on all of the goods identified in the original application, then the goods for which the depiction is not accurate must be deleted from the application. (It may be acceptable to divide such goods into a separate application, but the examination guide does not specifically state this.) Likewise, the drawing in these applications may be amended to depict a different placement of the pattern on a different type of item, so long as the change is not a material alteration of the mark.

However, applicants who do not file applications based on use or intent-to-use may not be able to amend an application that originally shows a swatch-like drawing to one that conforms to the new requirements. The reason is that the drawing in a U.S. application that is based on the applicant's home-country registration under Section 44(e) of the Lanham Act must be a "substantially exact representation" of the mark shown in the home-country registration. Thus, a drawing in a U.S. application that depicts the pattern as it actually appears on a product, with the shape of the item depicted in dotted lines, may not be considered a "substantially exact representation" of the swatch-type drawing depicted in the home-country registration. Similarly, in the case of International Registrations extended to the U.S., no changes to the mark for which registration is sought are permitted. It remains to be seen how the USPTO implements the new examination guide in cases where the home-country registration and International Registration depict a repeating-pattern mark with a swatch-type drawing.

The new examination guide also issues guidance on determining when a repeating-pattern mark is inherently distinctive versus when it must be refused on the basis that the repeating pattern is merely ornamental or otherwise unregistrable on the Principal Register. In the latter instance, applicants will be permitted to seek to establish that the mark has acquired distinctiveness. However, a simple claim that acquired distinctiveness exists due to substantially exclusive and continuous use of the mark for more than five years will not be accepted. Instead, the applicant always will be required to submit actual evidence to support a claim of acquired distinctiveness.

Examination Guide 1-15 (Repeating Patterns) can be downloaded at this link: [USPTO Exam Guide](#).

Primary Contacts

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