

2007

OCTOBER 4TH - 6TH

**23RD ANNUAL INSTITUTE ON
INTELLECTUAL PROPERTY LAW**

**THE MOODY GARDENS
GALVESTON, TEXAS**

NUTS AND BOLTS OF TRADEMARK PROSECUTION

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I. WHAT IS A TRADEMARK?

A trademark can be anything that identifies and distinguishes the source of a product or service of one party from those of others in the marketplace. Trademarks can be words, phrases, symbols or designs, fragrances, sounds (NBC chimes), colors (UPS's characteristic brown) or the shape of a container (The Coca-Cola Company's contour bottle). A trademark serves as shorthand for the goodwill associated with a company's product or service.

A. **How Are Trademark Rights Secured?**

Trademark rights must be secured on a jurisdiction-by-jurisdiction basis. The basis for trademark rights in some jurisdictions, including the United States, is at common law; trademark rights are secured by using the mark in connection with a particular set of goods or services. In these jurisdictions, appropriate trademark use is achieved by physically affixing the mark to the good with which the mark is associated or on packaging or sales displays associated with the good or, in the case of services, affixing the mark to advertising, marketing materials, or brochures describing the services associated with the mark. These rights are territorial in nature and can expand or decrease over time depending on the volume of use and consumers' perceptions of the mark. In other foreign jurisdictions, trademark rights are obtained solely through the registration process. Trademark laws, while often valuable to businesses, ultimately exist to benefit consumers.

1. Federal Law. In the United States, trademarks can be protected through state statutory and common laws and by federal statute via the Lanham Trademark Act of 1946, 15 U.S.C. §§ 1051–1127. The Lanham Act provides nationwide protection to marks used in interstate commerce. Under the Lanham Act, a mark's owner applies to register a trademark with the U.S. Patent and Trademark Office (U.S. PTO). The mark can already be in use or be one that will be used in the future, but the mark must be used—and the use must be proven to the U.S. PTO—before the registration can be finalized.
2. State Law. State common law originally provided the main source of protection for trademarks until the late 1800s when Congress enacted the first federal trademark law. Although federal law provides the main source of trademark protection, state common law actions are still available. The Lanham Act does not preempt state trademark laws, which have been enacted by each state to provide protection for trademarks. Protection of a mark under state statutes extends to infringements occurring within the state.
3. Foreign Jurisdiction. Each individual country where a trademark registration can be obtained has adopted its own trademark laws. Many jurisdictions utilize a first-to-file based trademark system, meaning registration is absolutely necessary in order to secure rights. Some regional filing trademark systems exist, such as the Community Trade Mark (Europe), OAPI (Africa) and the Madrid Protocol (an international filing system that depends on national stage approval), however.

II. SELECTION / CLEARANCE

A. **Strength of Mark.** When analyzing the availability of a prospective mark, one has to evaluate its strength by gauging where it falls on the spectrum of trademark distinctiveness. A more distinctive mark is stronger and will better distinguish its owner's goods and services and will thus better protect against infringement by other marks. Prospective marks fall within one of the following five classifications:

1. **Fanciful:** Fanciful marks offer the strongest protection of all marks on the continuum of trademark distinctiveness. Fanciful marks are made-up words not found in any dictionary that are created solely to serve as trademarks. Examples include KODAK[®] cameras, EXXON[®] gasoline and XEROX[®] copiers. Fanciful marks are particularly appealing to trademark attorneys, since they are inherently distinctive, but are less appealing to clients, since substantial amounts of advertising dollars must be spent in order to create a connection in a consumer's mind between the goods or services and the mark.
2. **Arbitrary:** Like fanciful marks, arbitrary marks offer strong protection. Arbitrary marks are normal words with ordinary definitions that have nothing to do with the way they are used as trademarks. Examples of arbitrary marks include APPLE[®] computers and CAMEL[®] cigarettes.
3. **Suggestive:** Suggestive marks hint at, but do not directly describe, characteristics or qualities of the goods or services of the products with which they are associated. Suggestive marks are protectable, but are weaker than fanciful or arbitrary marks. Examples of suggestive marks include GREYHOUND[®] bus lines and COPPERTONE[®] suntan oil.
4. **Descriptive:** Descriptive terms describe rather than suggest the characteristics or qualities of the products or services in connection with which they are used. They are generally not protectable as trademarks unless they acquire secondary meaning to consumers through substantial expenditures on advertising or extensive, long-term use. Surnames and geographic terms are typically considered descriptive, as are laudatory terms such as "QUALITY" or "SUPERIOR."
5. **Generic:** Generic terms cannot function as trademarks as they have become synonymous with the common name of the relevant product or service. Examples of generic words that at one time were registered trademarks but are now incapable of functioning as marks include escalator or aspirin.

B. **Types of Marks.** Seeking registration of a pure word or slogan does not raise as many issues as to "choice" of mark as does a composite mark -- that which typically encompasses a word/slogan with a design mark. It is recommended that searching be conducted on the composite, the design alone and the word/slogan alone to ensure all aspects of the mark are being searched properly.

Word marks should also be chosen carefully, and clearance and filing should mirror the appropriate form of use (i.e., foreign script, translations). Though more of a marketing than legal issue, it is important to know if the mark in English has a meaning in the language of the jurisdiction in which protection is being sought that may be offensive to or inconsistent with the marketing message. One of the most famous examples is the mark NOVA for automobiles. In English, the word NOVA means a star that suddenly increases in light and then fades away. In Spanish, the word NOVA, or “no va”, means it does not go -- not a desirable characteristic of an automobile.

C. **Clearance.** Once a prospective mark has been chosen, it is necessary to determine whether the mark is available for use and registration. Even if a mark is highly distinctive, if it—or marks similar to it—are already being used by others with respect to similar goods or services, then it will have a limited scope of protection. Thus, before beginning use of a mark or filing a trademark application, it is recommended that a trademark search be conducted. Because searching can be very expensive and time consuming, it is imperative that the exact use of the mark and the goods/services for which it will be used be determined at the outset. Typically, searches are conducted in each primary class of goods or services for which the mark might be used.

1. Knock-Out Searches. Before conducting a full formal search, it is prudent to conduct initial screening or “knockout” searches. This can be accomplished by searching various free and fee-based databases such as the U.S. PTO’s free website, www.uspto.gov; the United Kingdom’s free website, www.ipo.gov.uk; Australia’s free website, www.ipaustralia.gov.au; fee-based SAEGIS (www.saegis.com) or fee-based CT Corsearch’s (www.ctcorsearch.com) to identify potential third-party conflicting registered or pending marks. Using a search engine such as Google may also bring to light evidence that the mark is already being used by a third party or that the mark has a heretofore unknown meaning in a given industry and may therefore be descriptive.
2. Formal Searches. If no serious conflicts are identified during the initial knock-out search, a formal, comprehensive search may be obtained from a professional search firm such as Thomson Compumark (www.thomson-thomson.com), CT Corsearch (www.corsearch.com), or Corporation Service Company (www.cscprotectsbrands.com), to name a few. A comprehensive search will typically examine both federal and state registrations, business names, common-law usage, and domain name listings to determine if the mark is already registered or in use. In foreign jurisdiction, full searches are usually conducted by contacting local counsel in that jurisdiction who will conduct similar-type searches at its local trademark registry and utilize any other similarly available searching mechanisms.
3. Results. Depending on the search results, a mark may be available for use and not for registration due to various registerability issues (i.e., lack of

distinctiveness, functionality). If the mark is available for use only, the trademark owner can use the mark on its goods or services, but will not necessarily be able to prevent other trademark owners from using the same or similar marks.

4. Clearing a Third-Party Obstacle. If a third-party pending or registered mark raises concerns in the selection of the mark for use and/or registration, there are numerous avenues to pursue to help clear this path, including: use-investigations into the third-party mark to determine depth and breadth of usage; filing an opposition or cancellation action; or pursuing concurrent use agreements or licensing arrangements.

It is important to remember that even properly conducted searches can fall prey to “blind spots”. For example, in the United States once an application has been filed at the PTO, there can be up to a six-week delay until that application’s information will be publicly available. Additionally, an entity can file an application in any of the Paris Convention member countries and within six months file an application in the United States that claims priority from the original foreign application. A Madrid application filed at the end of the six-month priority period may take as long as eight months from the date the base application is filed before information on the application extending coverage to the United States is made public. In many foreign jurisdictions, it is many months if not years before trademark applications or registrations are made publicly available.

III. U.S. REGISTRATION PROCESS / BENEFITS TO FEDERAL REGISTRATION

A. **State Registrations.** Registering a trademark at the state level can be done in addition to, or in lieu of, federal registration. Registering a mark at the state level may be accomplished if the mark *is primarily to be used in a single state and there is no use in interstate commerce*. Obtaining state registrations is a quick and inexpensive process, and serves to provide prima facie evidence of a mark’s ownership in that state and ensures that the registration will be found if a potential competitor searches the state records.

B. **Federal Registrations.** The U.S. PTO maintains two separate registers on which a mark may be registered: the Principal Register and the Supplemental Register. Registration on the Supplemental Register is available to marks that do not qualify for registration on the Principal Register because they are not inherently distinctive and have not yet acquired secondary meaning, but are still capable of distinguishing the owner’s goods or services.

Registration on both registers provides the following benefits:

1. the right to use the ® symbol, “Registered in the Patent and Trademark Office”, or “Reg. U.S. Pat. & Tm. Off.”, and
2. the right to bring suit in federal court for trademark infringement, regardless of diversity of citizenship.

Registering a mark on the Principal Register rather than the Supplemental Register is preferable as it offers certain important advantages, including:

1. Prima facie evidence of exclusive right to use. According to Section 7(b) of the Lanham Act, registration on the Principal Register provides evidence of the validity of the registered mark and of the mark's registration, the registrant's ownership of the mark, and the registrant's exclusive right to use the mark in connection with the goods or services covered by the registration (§ 1057(b));
2. Incontestability. Once a mark registered on the Principal Register has been used exclusively and continuously for five years and an affidavit attesting to that continuing use has been filed, the mark becomes incontestable. An incontestable registration can no longer be cancelled because of descriptiveness or prior use, though it can be cancelled if it becomes generic or if use is abandoned.
3. Constructive nationwide use and notice of ownership. Registration on the Principal Register provides constructive notice of a trademark owner's claim of ownership of the mark and nationwide rights in the mark. This eliminates an infringer's defense of good faith adoption and use made after the registration date. Under common law, the mark is only protected in the particular geographical area where the mark is used in commerce. Marks registered under state law only provide protection in the particular state where they are registered.
4. Extension of Rights. A federal trademark application or registration on the Principal Register is more useful in obtaining registrations in foreign countries. For instance, a registration on the Supplemental Register cannot be used as the basis for a Madrid Protocol application.
5. Protection from Illegal Importation. By depositing registrations with U.S. Customs, owners are also able to bar the importation of infringing goods.

IV. FILING A U.S. TRADEMARK APPLICATION

A. **Description of Goods/Services.** Registration of a trademark is secured by filing an application with the U.S. PTO for a specific description of goods and/or services. For organizational purposes, goods and services are divided into 45 classes. The trademark being used on a product and/or service will fall into at least one of these classes. The U.S. PTO provides references to help aid in the selection of the classes for one's particular goods and/or services (www.tess2.uspto.gov/netahtml/tidm.html). For each class in which the mark is used, a specimen, or real-world example of how the mark is displayed to consumers, must be submitted to the U.S. PTO to secure a registration. Pictures of the goods with the mark affixed to them, or labels, tags, or containers for the goods are considered to be acceptable specimens of use for a trademark. For a service mark, specimens may include examples of advertising, such as magazine advertisements or brochures. Web sites also are common sources of service mark specimens.

B. **Intent-to-Use Applications.** While trademark rights are generally accorded to those who first use a mark, it is possible to secure rights without use by filing an 'intent to use' application at the PTO. An applicant places the public on notice of its intent to use the mark in interstate commerce from the date of filing such an application. This can be beneficial by

providing businesses time to develop marketing plans prior to using a mark while preserving rights in the mark. Although registration is encouraged, as seen by the many benefits previously listed, registration does not guarantee that a senior user will not object to use of your mark.

C. **Online Filing with the U.S. PTO.** The U.S. PTO has made filing new applications even easier with its online system, located at <http://www.uspto.gov/teas/index.html>. From here you can file an application to register your mark on either the Principal or Supplemental Registers. When applying to register a mark on the Principal Register, the TEAS system provides two form options. The first, called the TEAS Plus Form, requires that applicants select descriptions of goods directly from the USPTO's Acceptable Identification of Goods and Services Manual. The filing fee is reduced to \$275 per class if an applicant utilizes the TEAS Plus Form. The less restrictive TEAS form allows an applicant to customize its description of goods in a free-text format. The filing fee for using this form is \$325 per class.

Other types of marks that can be registered include:

1. Certification Mark: designates a mark that is used or will be used by authorized persons on designated goods and/or services to indicate, for example, a particular regional origin of the goods, a characteristic of the goods or services, or that labor was performed by a particular group.
2. Collective Membership Mark: used to indicate a membership in a specific organization; e.g., a social club or labor union. An example would be the Knights of Columbus.
3. Collective Trademark/Service mark: designates that the mark will be controlled by its members by a specified method of control. The National Association of Realtors is an example of a collective trademark.

Below is a check-list of the most critical information you will need to obtain from a client before an application can be filed:

- Name of applicant.
- Address of applicant.
- Jurisdiction of applicant's organization (if a business); citizenship, if an individual
- The mark. (Standard character word mark, Design, Word & Design, slogan, etc.)
- Description of goods and/or services in connection with which mark will be used or is intended to be used.
- Date of first use anywhere and date of first use in commerce (if mark is in use).
- Specimen of mark as used on the recited goods/services (if mark is in use).
- Name and title of signatory.

D. **Examination**

From the time an application is filed, an applicant can expect examination of the application to take place in about five to seven months. At that time, the examining attorney may issue an office action raising any objections to the application and requesting a response from the applicant. A significant majority (greater than 80%) of all trademark applications will receive some type of office action. The deadline for responding to an office action is six months. A response to an office action may be resolved in several ways depending on the nature of the objection and the complexity of the response, including filing an online response, submitting a paper response, or telephoning the examining attorney.

If the examining attorney determines the response or amendments to the application have resolved all of the outstanding issues, the application will then be approved for publication. If not, the examining attorney will issue a second and final office action, for which the applicant will have another six months to respond. The applicant may file a Notice of Appeal to the Trademark Trial and Appeal Board (TTAB) if the dispute is substantive in nature. If the dispute is procedural in nature, the next step is to file a petition to the Commissioner.

Below is a list of some of the more common objections issued in an office action and the corresponding TMEP sections:

1. The proposed mark is confusingly similar to a prior filed or registered mark at the PTO (TMEP §1207). To overcome such an objection an applicant typically argues that cited marks are distinguishable in sight, sound, or overall commercial impression, that the goods/services are dissimilar, or that the marks appear in unrelated channels of trade.
2. The proposed mark merely describes or deceptively misdescribes a characteristic or quality of the applicant's goods or services (TMEP §1209). Overcoming this objection can be a challenge, however applicants generally argue that the mark is suggestive of the goods or services for which registration is sought, rather than being descriptive. Applicants can demonstrate suggestiveness by showing that imagination or thought is required for consumers to make the connection between the mark and the goods or service for which it is used.
3. The proposed mark is generic (TMEP §1209.01(c)). To overcome an objection on the grounds of genericness an applicant must show that the alleged mark is capable of indicating a source or origin of the goods or services.
4. The description of goods or services is too broad and is rejected as being indefinite. An applicant will be required to amend the description to provide more specificity (TMEP § 1402).
5. The proposed mark is primarily geographically descriptive or geographically deceptively misdescriptive of applicant's goods or services (TMEP § 1210). An applicant may argue that the goods or services do not originate or purport to originate from a specific geographic location, or that primary significance of the term is not known as geographic location.
6. The proposed mark is primarily merely a surname (TMEP § 1211). Factors to consider include the commonality of the surname, whether the

term has the “look and feel” of a surname, and if the term has any recognized meaning other than a surname.

7. The proposed mark, as a whole, is functional because it is essential to the use or purpose of the product (TMEP § 1202.02(a)). A feature is functional as a matter of law if it is “essential to the use or purpose of the product or if it affects the cost or quality of the product.” *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001).
8. The U.S. PTO will request a disclaimer of a portion of a mark that by itself would be descriptive of or generic in connection with the goods or services for which the mark has been applied. If the applicant grants the disclaimer, it gives up the exclusive right to that term apart from the mark as shown. For example, if the applied-for mark were SPECTRA BUILDING in connection with construction services, the U.S. PTO likely would require a disclaimer of the term BUILDING but allow the mark as a whole to register.

V. Filing an International Trademark Application

A U.S. trademark application or registration does not automatically protect your trademark abroad. It is not necessary to have a U.S. registered trademark before you can file for your trademark in another country.

As mentioned above, each foreign jurisdiction has its own trademark laws with which an applicant must comply. Power of Attorneys, certified and legalized documents, and specimens of the marks are just some of the requirements that one may encounter in foreign jurisdiction filings. In addition, not all countries are signatories to the Paris Convention, thus priority filings may not be able to be obtained in all jurisdictions. Further, many countries allow for a description of goods and services to be as broad as “all goods/services in class” or all goods/services under the class heading. Every country has local counsel that can provide specialized trademark representation. It is recommended that you engage an attorney in the United States who has good contacts with international trademark specialists.

VI. TTAB

Pursuant to 15 U.S.C. § 1068, the Trademark Trial and Appeal Board (“TTAB” or “Board”) is the administrative body responsible for presiding over substantive appeals by applicants concerning objections raised by examining attorneys. The Board is also responsible for presiding over disputes between parties opposing the registration of a mark or the cancellation of a registered mark. Significantly, the Board retains no power to award monetary damages or attorney fees or to issue injunctions. Furthermore, the Board has no power to determine use rights, to hear infringement claims, or to consider issues outside of registrability.

The TTAB has a useful web site with a significant amount of accessible information online. All filings can be executed online through the TTABVUE filing system. There you can also view the entire record of your proceedings. This site is located at

<http://www.uspto.gov/web/offices/dcom/ttab/>. The TTAB also has a searchable database for past decisions which can be searched by issue (descriptiveness, likelihood of confusion, etc.) located at <http://des.uspto.gov/Foia/TTABReadingRoom.jsp>.

A. **Ex Parte Appeals** are appeals to the TTAB based on substantive grounds to register a mark and are initiated by filing a Notice of Appeal. If an applicant has not filed a request for reconsideration and has not requested suspension of the appeal pending reconsideration, the applicant will have 60 days to file a brief in support of its appeal. The examining attorney is then given 60 days to file a response and the applicant is allotted an additional 20 days to file a reply brief. Oral hearings are available, but must be requested by the applicant. The Board will then issue a decision on whether to affirm the refusal of the examining attorney or allow the mark to register. Of all the Ex Parte Appeals filed, 70 to 80 percent are decisions affirming the Examining attorney's refusals to register the mark.

B. **Inter-partes Proceedings:** The following TTAB proceedings are referred to as inter-partes proceedings because they involve two or more parties. These administrative litigation proceedings are similar to a District Court proceeding with discovery and testimony.

1. **Notices of Opposition:** Pursuant to 15 U.S.C. § 1063, notices of opposition may be filed within 30 days of the date an application is published for opposition. The grounds for challenging an application in opposition are the same that an examining attorney could raise during the examination phase. Based on the current statistics, less than five percent of applications are opposed.
2. **Petitions to Cancel:** Under 15 U.S.C. § 1064, may be filed anytime, but after five years a registration becomes incontestable and a petitioner may not then argue that the mark is invalid because it is descriptive.
3. **Appeals from the TTAB:** Following a final decision, a party may file an appeal to the Federal Circuit or may initiate a civil action in a U.S. District Court. Any appeal to the Federal Circuit will use the same record from the TTAB proceeding. An action in U.S. District Court will be *de novo*. District Court actions also provide a party the opportunity to add new claims such as unfair competition or infringement.

The TTAB has recently effectuated some new procedural rules. Notably, the TTAB previously considered only decisions designated as precedential. The TTAB will now take into consideration any published decision when ruling in a case. Updates to TTAB rules can be found at http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf.

VII. **POST-REGISTRATION ISSUES**

A U.S. trademark application that matures to registration is registered for a period of ten years, and can be renewed indefinitely so long as the owner can continue to demonstrate that the mark is being used in interstate commerce in connection with the goods or services covered by the registration. Between the fifth and sixth year after registration, and again at the end of ten years from registration, the registrant must file a sworn affidavit, known as a Section 8 Declaration, with the Patent and Trademark Office that shows either that the mark is still in use or that the mark's non-use is excusable. If the mark is in use, the Section 8 Declaration must include specimens showing the mark in use in connection with the goods or services covered by

the registration. If the mark is registered on the Principal Register and has been continuously used for five years since registration, a Section 15 Affidavit can also be filed between the fifth and sixth year after registration. This sworn statement claims incontestable rights in the mark in connection with the particular goods or services covered by the registration, and once accepted, serves to eliminate certain defenses an opponent might otherwise be able to raise in a trademark infringement proceeding involving the mark.

Foreign registrations typically expire between ten and fifteen years either after the date of registration or filing, depending upon the jurisdiction. Typically, no continued use needs to be shown to renew the mark. Although one may have to show continued use if the mark is being challenged by a third-party.