

Prosecuting a U.S. Trademark Application¹

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I. Introduction.

Prosecution of a U.S. trademark² application is the process by which an application moves through the United States Patent and Trademark Office (“USPTO”) after being filed. Prosecution is often a more lengthy and costly endeavor than preparing and filing the application. It culminates when an application either matures into a registration or is abandoned.

During prosecution, a trademark application is reviewed by a USPTO Examining Attorney (“EA”). The EA issues written communications, called Office Actions, to the applicant or the applicant’s attorney. An Office Action may include, among other things: (1) citations of federal trademark registrations or applications that predate the application’s filing date, and an argument that the mark in the application is confusingly similar to one or more of the senior registrations/applications; (2) an argument that the mark in the application is merely descriptive or geographically descriptive of the goods/services listed in the application, and/or (3) an objection to the goods/services description in the application. Many trademark applications are rejected in their entirety in the first Office Action, and often on multiple grounds.

After receiving an Office Action, the applicant or the applicant’s attorney file a “Response.” Normally, there are only one or two Office Actions and Responses during prosecution of a trademark application. But, do not be surprised if an appeal or one or more divisional applications may be required to obtain the full scope of available protection.

II. Selecting and Clearing the Mark Prior to Filing an Application.

A. Select a Strong Mark.

Begin by selecting an *inherently strong* mark. An inherently strong mark provides the broadest scope of legal protection and is usually inexpensive to register and enforce.

An inherently strong mark is unrelated to the attributes of the goods/services with which it is used and preferably one that is *fanciful* or *arbitrary*. A fanciful mark has no meaning. It is completely coined or invented and its only purpose is to function as a trademark. Examples are Clorox® for bleach, Exxon® for petroleum products, and Kodak® for photographic products. An arbitrary mark has a meaning, but the meaning is unrelated to the goods/services with which it is used. Examples are Blue Bonnet® for margarine, Shell® for petroleum products, and Sprite® for soda.

¹ This article is for educational purposes and does not constitute legal advice. It represents current, general opinions of the author, and not of his law firm or colleagues.

² “Trademark” or “mark” as used herein refers to trademarks and service marks, each of which includes trade dress.

B. Optional Clearance Search.

An optional clearance search and review can be conducted to generally determine whether a mark can be registered and used without conflict. Usually, only active common-law marks and active United States federal registrations/applications are relevant to a clearance search. A clearance search is often skipped because the cost of conducting a meaningful search and review can be prohibitive, especially if the mark is not yet being used and use is not contemplated within the next few years.

III. Prepare the Application.

A. Presentation of the Mark.

If possible, the mark should be presented in the application in “standard character” format. “Standard character” format means that the mark is presented in all (1) Latin-character letters or words, (2) Roman or Arabic numerals, (3) common forms of punctuation, (4) diacritical marks, or (5) combinations thereof. TMEP §§ 807.03(a)-(b). A standard character mark can be shown in the application in any font, in upper and lower case letters, in all upper case letters, in all lower case letters, or in italics or bold. Superscripts, subscripts, exponents, or underlining may not be used. *Id.* The application must specify that it is for a standard-character mark. *Id.* A standard-character registration is presumed to cover each representation of the mark, and is not limited to a particular font, size, color, or design. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed. Cir. 2010).

If the mark will be used in a highly-stylized manner, or if it includes a design, the safest course is to present it in the stylized manner or with the design, rather than in standard character format, so as to avoid a “material alteration” rejection. See TMEP § 807.14; 37 C.F.R. § 2.72. “Material alteration” means that the mark shown in the application creates a different commercial impression from the mark as actually used. *Id.* The standard for “material alteration” is subjective and, if the EA’s decision on material alteration is upheld on appeal, the only option to obtain a registration is to file a second application and lose the filing date of the earlier-filed, standard-character application.³

B. Goods/Services Description.

The goods/services description should include the common commercial definition of the goods/services with which the mark is being used and/or with which there is a good-faith intent to use the mark. See TMEP § 1402.01. Best to file with a broad goods/services description, because the application cannot be broadened to add additional goods/services, nor can it be broadened to include goods/services cancelled during prosecution. TMEP § 1402.06(a). Do not include the mark itself in

³ Alternatively, two applications for the same mark, one in standard-character format and one in stylized format, could be filed at the outset.

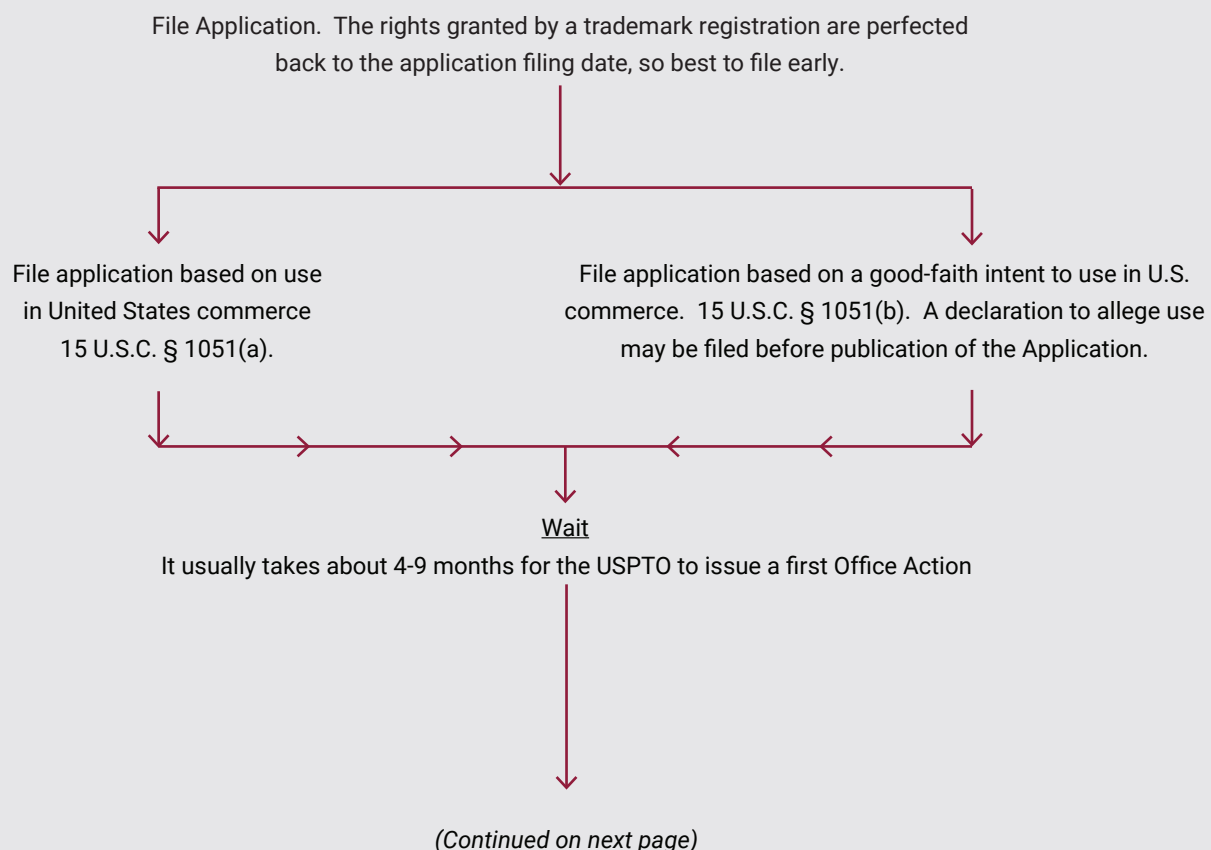
the goods/services description because that would likely draw a “merely descriptive” rejection from the USPTO.

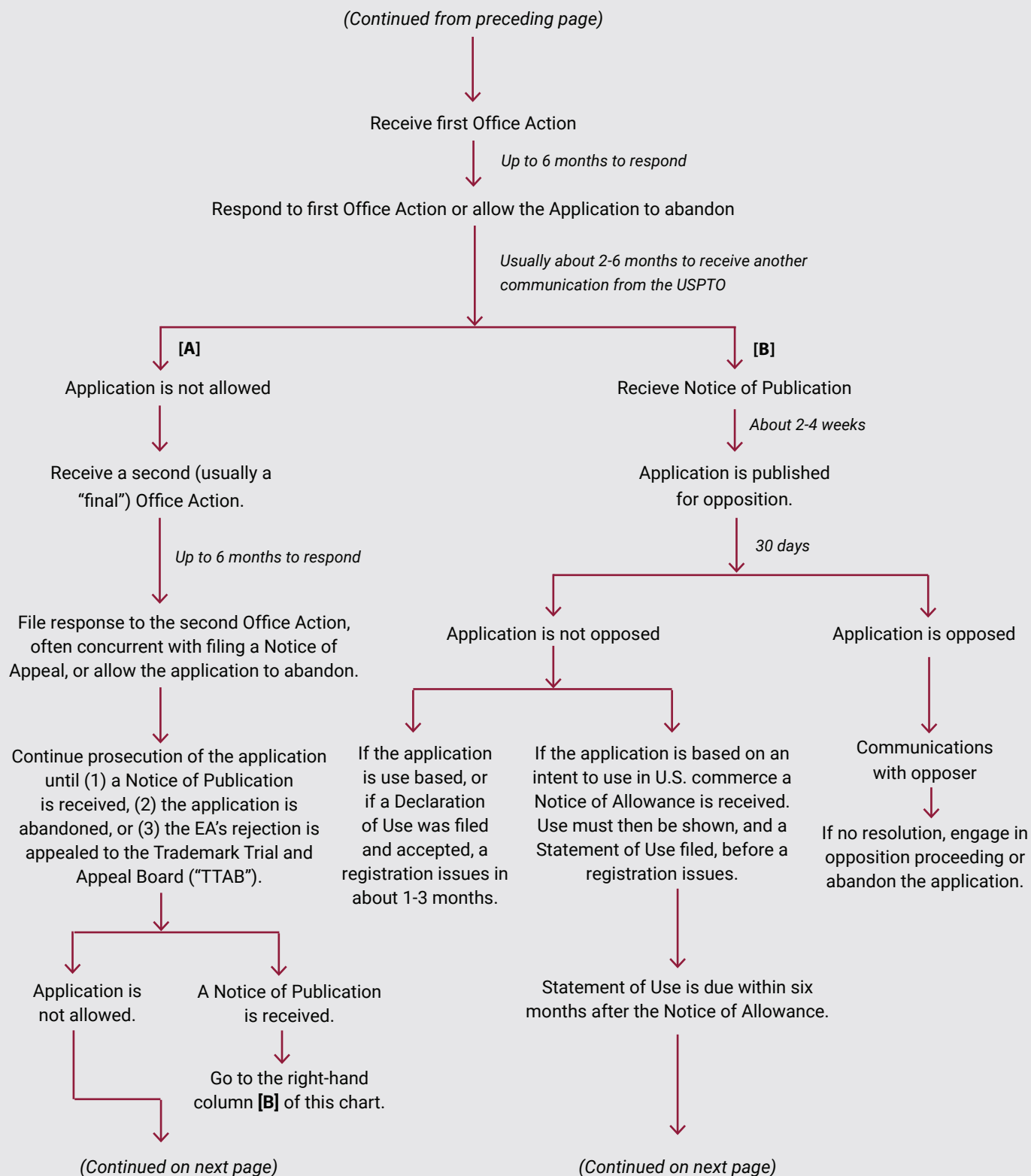
There is no need to designate a goods/services class(es) in an application. The EA will add the class(es), and even if you take the time to determine the class(es), the EA may disagree and change it.

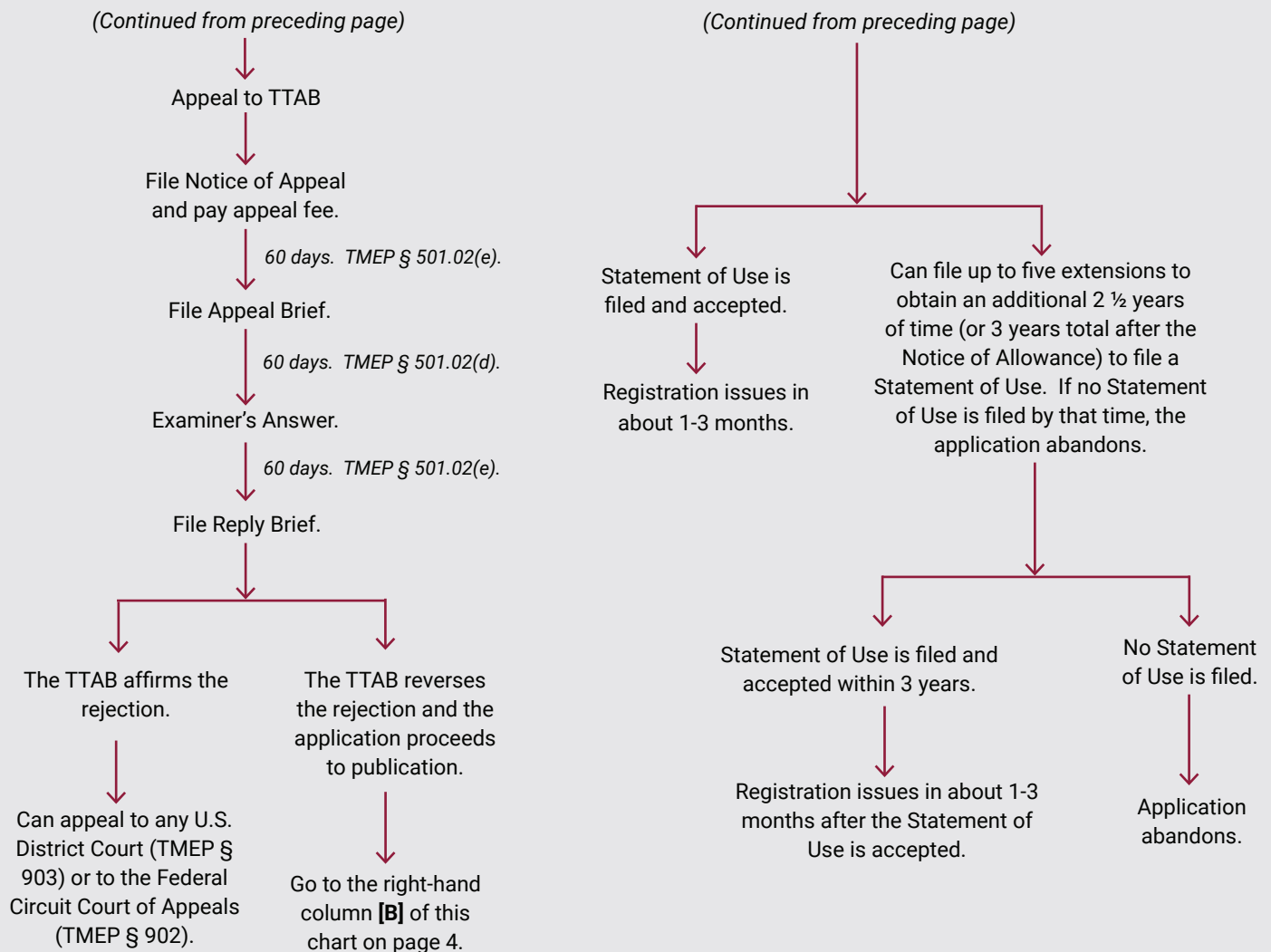
C. Select the Filing Basis.

The application must be based on either (1) actual use in commerce and include a first use date and specimen of use (15 U.S.C. § 1051(a)), or (2) a good-faith intent to use the mark in the future. 15 U.S.C. § 1051(b). If the mark is being used, but the first use date is unknown at the time of filing, file the application based on intent to use. TMEP § 806; 15 U.S.C. § 1051(b). The application can later be amended to claim a use date, even if that date is prior to the application filing date. TMEP § 903. If the mark is already being used on some goods, and there is a good-faith intent to use the mark on others, filing two applications – one based on use and another on intent to use – is usually the best strategy.

IV. The Basic U.S. Federal Trademark Prosecution Process.







V. Basic Trademark Prosecution Strategy.

A. Obtain the Broadest Scope.

Proper trademark prosecution takes experience, diligence, and care. Careless prosecution, or capitulation to an EA to merely obtain a registration, could unduly narrow the scope of a resulting registration, even to the extent of not covering the actual goods/services with which the mark is or will be used. Do not limit the goods/services description to what an EA suggests if the description is not accurate or does not capture the scope of the goods/services with which the mark is or will be used.

Sometimes obtaining proper goods/services scope is best done in steps, by taking selected goods/services, obtaining a registration for those, and then filing one or more divisional applications or new applications to pursue additional goods/services.

B. Some Basic Practice Tips for Responding to Office Actions.

Each response to an Office Action should be well organized with headings and sub-headings as appropriate, cite relevant case law, include relevant evidence, be simple to understand, and begin to place the application in condition for appeal, if appeal should become necessary. Some practice tips:

- (1) Address each argument raised in an Office Action.
- (2) For goods/services description rejections, do not automatically acquiesce to an EA's proposed description. Use common, commercial terms to define the goods/services, and not an inaccurate description proposed by an EA.
- (3) Likelihood of confusion in the USPTO is based on the marks as shown in, and the goods/services as listed in, the application and senior registrations/applications cited against the application. It is not based on actual use in commerce, although actual use may be relevant to clarifying the meaning of terms in a goods/services description or of the relevant trade channels for goods/services.
- (4) When responding to a likelihood of confusion rejection, address each relevant likelihood-of-confusion factor, whether or not raised in the Office Action, such as the anti-dissection rule, the dominant portions of respective marks, dissimilarity of the goods/services, and dissimilarity of the trade channels.
- (5) If relevant, submit evidence of third-party registrations and common-law marks to show that a senior registration/application is entitled to a narrow scope of protection.
- (6) Reproduce images of the respective marks side-by-side, or over/under, in Responses to Office Actions when arguing dissimilarities of the marks.
- (7) The goods/services description in an application can be amended to remove, or to explicitly disclaim, conflicting goods/services or to disclaim conflicting marketing channels.
- (8) Evidence of how a senior mark is actually used on goods/services cannot be used to eliminate or modify goods/services in a senior registration/application. Such elimination/modifying can only be done in a cancellation or restriction action.
- (9) If argument is unsuccessful in overcoming a likelihood of confusion rejection, consider obtaining written consent to register (often called a "coexistence agreement") from the owner of a conflicting senior registration/application.
- (10) Enter any necessary evidence in favor of registration in Responses to Office Actions. New evidence cannot normally be entered in an Appeal Brief.

- (11) Determine if the Section 8/15 or 9 fees have been paid for a conflicting senior registration. If not and the time for filing the Section 8/15 or 9 is close or has passed, consider delaying responding to an Office Action until determining if the senior registration has been abandoned.
- (12) If facing a “merely descriptive” rejection, consider arguing that the mark has acquired distinctiveness (also called “secondary meaning”). *Prima facie* evidence of acquired distinctiveness can be shown by, *inter alia*, (a) a claim of ownership to one or more active registrations on the USPTO Principal Register for goods/services that are substantially the same as those in the pending application, or (b) a declaration that establishes a period of continuous and substantially exclusive use of five years before the claim of acquired distinctiveness is made. 15 U.S.C. § 1052(f); 37 C.F.R. §§ 2.41(a)-(b); MPEP § 1212.
- (13) An application often includes goods/services with which the mark is not being used at the time use is alleged. When alleging use, either delete goods/services with which the mark is not yet being used, or file a divisional application to include those goods/services. See, e.g., *Medinal Ltd. V. Neuro Vasx, Inc.*, 67 U.S.P.Q. 1205, 1209 (T.T.A.B. 2003); *Hurley LLC v. Volta*, 82 U.S.P.Q. 2d 1339 (T.T.A.B. 2007); *L.C. Licensing, Inc. v. Berman*, 86 U.S.P.Q. 2d 1883, 1891-92 (T.T.A.B. 2008); *Commodore Electric Ltd. V. CBM Kabusshiki Kaisha*, 26 U.S.P.Q. 2d 1503, 1507 (T.T.A.B. 2003); MPEP § 1110.07.

VI. Conclusion.

Proper trademark prosecution takes experience, diligence, and care. Careless prosecution, or capitulation to an EA to merely obtain a registration, could unduly narrow the scope of a resulting registration, even to the extent of not covering the actual goods/services with which the mark is or will be used.



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