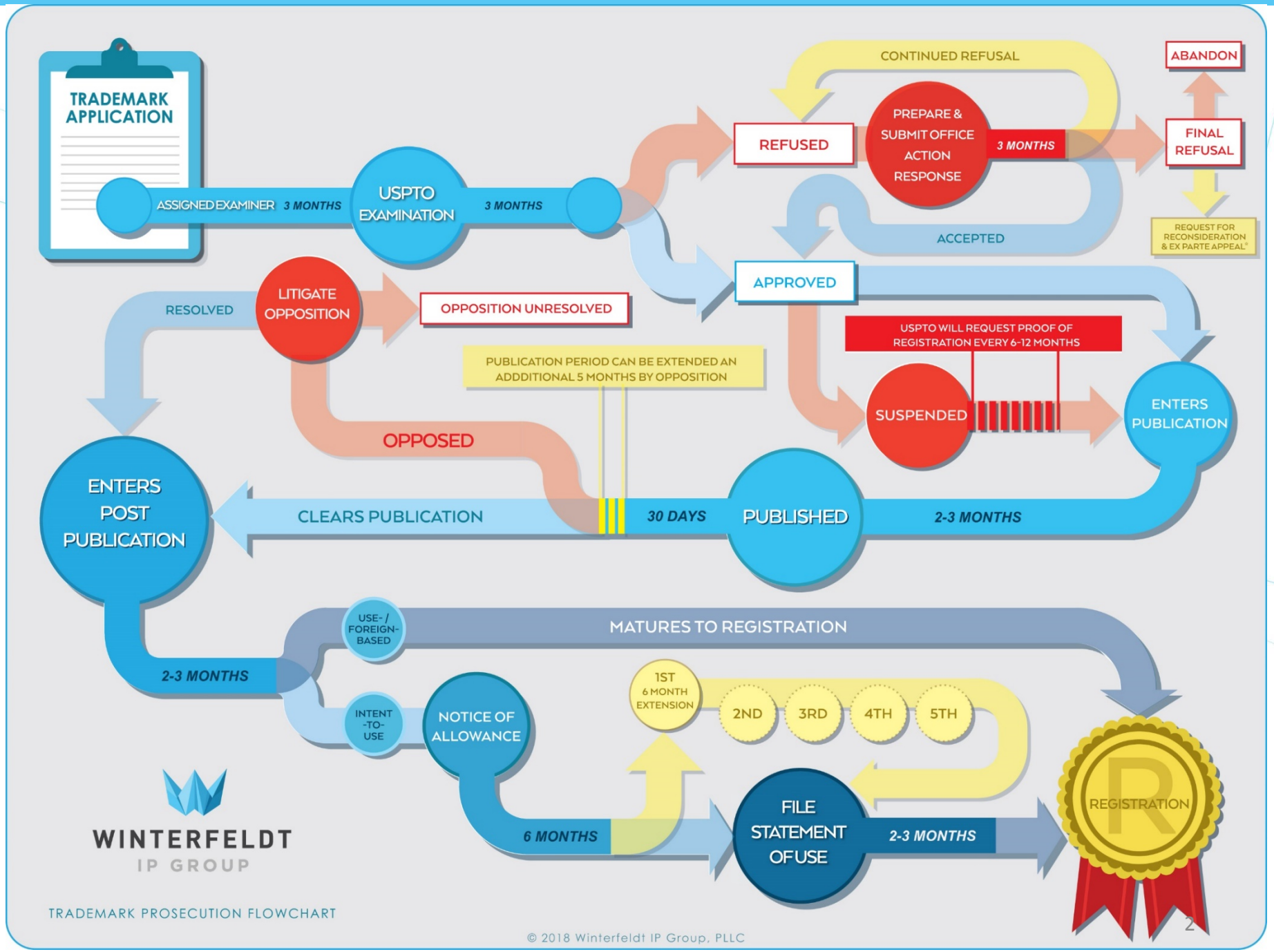
Advanced USPTO Practice

The Finer Points of Trademark Law and Office Procedure

August 2020

WINTERFELDT
IP GROUP


TRADEMARK APPLICATION
ASSIGNED EXAMINER
3 MONTHS
USPTO EXAMINATION
3 MONTHS
REFUSED
PREPARE & SUBMIT OFFICE ACTION RESPONSE
3 MONTHS
CONTINUED REFUSAL
ABANDON
FINAL REFUSAL
REQUEST FOR RECONSIDERATION & EX PARTE APPEAL
ACCEPTED
APPROVED
RESOLVED
LITIGATE OPPOSITION
OPPOSITION UNRESOLVED
PUBLICATION PERIOD CAN BE EXTENDED AN ADDDITIONAL 5 MONTHS BY OPPOSITION
USPTO WILL REQUEST PROOF OF REGISTRATION EVERY 6-12 MONTHS
SUSPENDED
ENTERS PUBLICATION
OPPOSED
ENTERS POST PUBLICATION
CLEARS PUBLICATION
30 DAYS
PUBLISHED
2-3 MONTHS
MATURES TO REGISTRATION
USE- / FOREIGN-BASED
2-3 MONTHS
INTENT -TO- USE
NOTICE OF ALLOWANCE
1ST 6 MONTH EXTENSION
2ND
3RD
4TH
5TH
6 MONTHS
FILE STATEMENT OF USE
2-3 MONTHS
REGISTRATION
WINTERFELDT IP GROUP
TRADEMARK PROSECUTION FLOWCHART
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Application Filing Dates

Minimum Requirements:

- A clear drawing or depiction of the mark
- Name of the Applicant
- Name, Address and email address of a Correspondent
- A list of **recognizable** goods or services; and
- Filing fee for at least one Class

Application Filing Dates

All else may be added later by amendment, including:

- Address, email address and place of domicile/incorporation
- Filing basis
- Allegations of use with specimens (for a fee)
- A list of **definite** goods and services
- Classifications of goods and services
- "Additional Statements" such as translations
- Signatures and Verifications

Volunteering or Conceding Additional Statements

[I]t has long been held that the <u>disclaimer of a term constitutes an admission</u> of the merely descriptive nature of that term, as applied to the goods or services in connection with which it is registered, and an acknowledgment of the lack of an exclusive right therein at the time of the disclaimer.

In re DNI Holdings Ltd., 77 USPQ2d 1435 (TTAB 2005) (precedential) (citing *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972)

Volunteering or Conceding Additional Statements

Where … an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact…. Similarly, in cases where registration was initially sought on the basis of distinctiveness, <u>subsequent reliance by the applicant on Section 2(f) assumes that the mark has been shown or conceded to be merely descriptive</u>.

Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 1577 (Fed. Cir. 1988)

Five Years' Use as Proof of Acquired Distinctiveness

[A] petitioner may carry its initial burden of showing *prima facie* invalidity by introducing evidence at trial that the mark is so highly descriptive that a mere declaration of five years continuous and substantially exclusive use is insufficient to establish acquired distinctiveness …. [U]pon petitioner meeting this initial burden, <u>the burden of proof then shifts to respondent</u> to defend its registration.

Alcatraz Media, Inc. v. Watermark Cruises, 107 USPQ2d 1750 (TTAB 2013) (precedential), *aff'd sub nom. Chesapeake Marine Tours, Inc. v. Alcatraz Media, Inc.*, 565 Fed. Appx. 900 (Fed. Cir. 2014)

Allegations and Statements of Use

Ex Parte Reexamination

- Applies to all registrations issued with a claim of use under Section 1 **within the first five years** of registration
- Cancellation for failure to use with the applicable goods or services on or before:
  - The filing date of a 1a application not amended to 1b; or
  - The filing date of an amendment to allege use or the expiration of the time to file a statement of use for an 1b application

Allegations and Statements of Use

Ex Parte Reexamination

"[A]ny person may file a petition to reexamine," which must include:

- Identification of the registration(s) at issue
- Identification of the categories of goods and services that are challenged
- A "verified statement that sets forth the elements of the reasonable investigation … conducted to determine that the mark was not used before the relevant date … and any additional facts that support the allegation …."
- Any supporting evidence; and
- Any prescribed fee

The petitioner need only make a *prima facie* case

Identifications of Goods & Services

Use-Based Obstacles to Registration:

- Board Cancellation for Non-Use / Lack of Bona Fide Intent to Use / Abandonment
- Declarations / Affidavits of Use to Maintain Registration
- Proof of Use Audit Program
- Ex Parte and Inter Partes Expungement for Failure to Commence Use

Specimens of Goods

Considerations for Digital Displays as Specimens for Goods:

- Suitability as specimens, generally:
  - Contains a picture or description of the goods;
  - Shows the mark appropriately associated with the goods
  - Provides a means of ordering the goods
- Requirements for web-page specimens:
  - Includes the appropriate URL
  - Shows the date accessed
- Additional scrutiny due to digitally altered specimens

Color Pattern Marks

Color Pattern Marks

Here, Forney is correct that its proposed mark is not just a "color mark," but also a "symbol." … Forney is not attempting to preempt the use of the colors red, yellow, and black, but instead <u>seeks to protect only the particular combination of these colors, arranged in a particular design</u>, as shown in the drawing submitted for its proposed mark. … The question the Board must answer is whether, as used on its product packaging, the combination of colors and the design those colors create are sufficiently indicative of the source of the goods contained in that packaging. And <u>the Board must assess that question based on the overall impression created by both the colors employed and the pattern created by those colors</u>.

In re Forney Indus., Inc., 955 F.3d 940, 947–48 (Fed. Cir. 2020)

Thank You

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