



Trademark Procedure

Trademark & Unfair Competition
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Litigation procedure

Civil litigation procedure for trademark infringement: **Jurisdiction**

- Federal district courts have original jurisdiction over all claims arising under the Lanham Act. The regional federal courts of appeals have appellate jurisdiction. There's no amount in controversy or diversity requirement. 15 U.S.C. § 1121(a)
- Federal district court jurisdiction is not exclusive. State courts can hear Lanham Act claims as well. 28 U.S.C. § 1338(a)
 - (Federal district court jurisdiction is exclusive for patents and copyrights, but not trademarks. *Id.*)

Civil litigation procedure for trademark infringement: **Court-ordered cancellation**

- In an infringement case, if a defendant wins on the issue of invalidity of a registered mark, the court can then order the whole or partial cancellation of the registration by certifying an order to the Director of the USPTO, who then must abide by the order.
- Courts can also order the restoration of canceled registrations.

Registration procedure

Registration procedure

NOTE:
All of this
information
concerns
registration
on the
principal
register.

Before filing a registration application ...

- There's a whole world of marketing thought and research that might go into picking a name, slogan, logo, or other means of branding for which trademark registration could be sought. (That's generally a matter for the marketing / business-school folks we'll assume.)
- Conventional wisdom is to do a "trademark search" before filing. ...

Trademark searching

- The aim of a trademark search is to find out if a candidate mark is potentially confusingly similar to a mark already out there.
- That involves not just searching the USPTO's registers (easy for word marks), but also searching for the use of unregistered marks in the marketplace.
- Before the web, this largely involved consulting yellow pages from all places in the U.S.! Specialized firms had these books and would do searches for a fee.
- Today, you can do internet searching, which is easy for words, of course.
- But it's not necessarily as easy just seeing if a word is used on the internet. A sophisticated, analytical search will look for marks that aren't spelled the same but may be similar in spelling, similar in meaning or similar in pronunciation.
- Specialized firms still do trademark searches. It might cost below a thousand dollars.

Applying to the PTO for registration

- There are two kinds of applications, use and intent-to-use.

Applying to the PTO for registration

Regular Use Applications

- You provide the mark, the date of first use in commerce, a specimen (of the mark used in context), and you have to pick the categories of goods or services for which you wish to register the mark.
- You can pick multiple categories of goods or multiple categories of services, but lots of categories or registering for both goods and services will make for more in required fees.
- For non-word-marks, you may need to supply drawings or detailed descriptions.
- The PTO examiner will look for everything needed for trademark validity – more importantly either inherent distinctiveness or a mark susceptible of acquiring distinctiveness and proof of secondary meaning.
- If the PTO examiner is convinced the mark is entitled to registration, it is published in the PTO's Official Gazette. If after 30 days no oppositions are filed, the PTO will issue a certificate of registration.
- Applicants can appeal adverse decisions to the TTAB.

Applying to the PTO for registration

Intent-to-Use Applications

- ITU applications are similar to regular use applications, but they are broken into two filings.
- For the first filing, the applicant doesn't state a date of first use. Instead, the applicant states an intent to use.
- The examiner determines if the mark would be entitled to registration if used.
- If so, the mark is published in the Official Gazette. If after 30 days there's no opposition (or if any opposition is overcome), then the PTO issues a notice of allowance (as opposed to a certificate of registration).
- The applicant has six months to use the mark and submit a statement of use and a specimen. This period is extendable up to 30 months.
- The examiner examines the statement of use and for sufficiency with regard to use. Assuming that's fine, the mark will be registered on the principal register.

Oppositions

- A pending mark can be opposed by any entity who claims that registration of the pending mark would be likely to cause confusion or dilution.
- An opposition is resolved by an inter partes proceeding before the TTAB.

TTAB

- The TTAB is the Trademark Trial and Appeal Board.
- They have in-person hearings at the USPTO headquarters in Virginia. Sometimes they meet other places as well. And they do many hearings virtually.

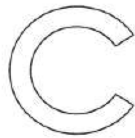
Oppositions

- Major League Baseball has filed multiple oppositions to businesses seeking to register marks incorporating a block W because the Cubs and Nationals have registered “W” marks.
- For instance, MLB/Cubs opposed a white-on-green W logo for WalletHub, a financial information website, and a W logo for a hotel chain, based on them causing confusion with the W on a flag that the Cubs use to denote having won a baseball game.



Oppositions

- The Cubs also go after “C”s.
- The Cubs won an opposition against CREATE, who sought to register a stylized “C” for “Hats; Headbands; Hoodies; Jackets; Shirts; Sweaters; Sweatpants” [Chicago Cubs Baseball Club, LLC v. The CREATE Inc., Opposition No. 91242453 \(TTAB July 19, 2022\)](#)



Cubs mark



CREATE mark

Some other proceedings

- interferences – two applicants for a same or similar mark
- concurrent use proceedings – where an applicant’s mark resembles an already-registered mark but confusion could be avoided if certain limitations or conditions are imposed
- cancellation – taking away a mark’s registration

Appeals from the PTO

- Applicants (and some other parties) can appeal (get judicial review of) an adverse decision of the Director of the USPTO or the TTAB in one of two ways.
- An appeal can be filed with the Federal Circuit.
- A civil action can be commenced in a federal district court.