



# Trademark Office Procedural Practice

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## Registration procedure

## 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 be more expensive because it will involve additional 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 plus 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.
- Applicants can appeal adverse decisions to 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.

## Rejections on the basis of “failure to function”

- The PTO sometimes rejects marks on the basis of a “failure to function” as a trademark.
- Failure-to-function doctrine is something of a hot area at the moment. Despite its vitality at the PTO, there has been little development of the concept judicially.
- Many who believe trademarks have gotten out of control hope failure-to-function doctrine may bring the system more balance. That is, many have the view that key limiting doctrines have grown anemic and that new expansionist positions have been unwisely embraced in the courts. Failure-to-function doctrine has the potential, various commentators and scholars hope, to push back on that.
- The key question: Does the claimed mark actually function as a trademark – or does it fail to do so?

## Rejections on the basis of “failure to function”

- Grynberg’s book discussed this in a portion you read over pages 66–67 in an excerpt from the Trademark Manual of Examining Procedure, §1202.03(a) Commercial Impression, which notes, e.g., “The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (e.g., the peace symbol, ‘smiley face,’ or the phrase ‘Have a Nice Day’) are normally not perceived as marks”
- The failure-to-function doctrine as such hasn’t been fleshed out much by the courts. And we didn’t read a case that focused in on it by that name. But the concept is woven through out many cases. One example is Qualitex, where the court goes to some effort to explain that color can be a trademark precisely because it functions as a source identifier (in other words, does not fail to function).
- Note that “functions as a trademark” (the negation of which is “failure to function”) is a distinct concept from “functionality” (the negation of which is that mark is “nonfunctional”), which is a doctrine saliently represented by TrafFix. A mark must function as a trademark to be valid as a trademark. And a mark must be nonfunctional in a utilitarian/TrafFix sense to be valid as a trademark.

## 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.

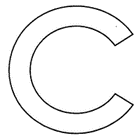
## Oppositions

- 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 supposedly causing confusion with the W on a flag that the Cubs use to denote having won a baseball game.

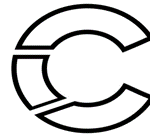


## Oppositions

- 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.**

## **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.**