

# Beware the robots – moving away from formulaic registration processes

Too often, prosecution of a trademark application is seen as a mechanical task, but the careful practitioner can succeed in obtaining a strengthened position for an owner

In the United States, practitioners should be wary of a host of issues before filing a trademark application. As a baseline, in order to anticipate and head off problems during prosecution, it is prudent initially to conduct a full trademark search. Then, along with obtaining as much information as possible about the owner's use, inherent registrability issues should be considered, including the possibility that a proposed trademark will be unregistrable given the inclusion of geographical indicators and descriptive terms. With an understanding of these potential pitfalls, an application can be tailored to minimise the chances of rejection.

It is also valuable to keep in mind the varied types of property that are registrable in the United States. Apart from traditional word marks, the US Patent and Trademark Office (USPTO) formally recognises and allows for the registration of non-traditional trademarks, incorporating elements of packaging, product configuration, colour, sound, scent and motion. In some cases the owner will first need to demonstrate that the mark has acquired secondary meaning before a registration is granted.

The applicant has latitude in selecting the form of the mark to be registered. Depending on the importance of a property, budgetary constraints and other factors, it may be valuable to seek registration of a mark in varying levels of detail. For instance, in case of a word mark that incorporates stylisation, colour and design elements, a strategy may include filing an application for the 'block-letter' presentation – without regard to stylisation or any other features – and a separate application for the mark with all of the additional elements.

A block-letter registration will provide broad coverage for the word alone, no matter how it appears in use, and will remain viable even if the mark's

presentation is redesigned over time. A registration showing more detail could be useful in asserting claims against a party that co-opts the look and feel of the overall mark, including colour and stylisation. As can be recognised, the applicant will have available many additional permutations of coverage, which should be considered in view of individual circumstances.

Practitioners should consider the results of an initial trademark search and the goals of registration when developing the identification. The search can provide guidance on how to camouflage and minimise certain areas that may conflict and overlap with those of third parties. As far as general development of the identification, unlike most jurisdictions, US practice requires a high specificity of goods or services to be covered. As a starting point, a useful resource for developing the identification is the Acceptable Identification of Goods and Services Manual.

It is generally advantageous to define the goods and services broadly, while also focusing narrowly on specific products. The broad strategy stakes out a wide claim that can serve to quell an infringer's arguments about the relatedness of goods. Narrow descriptions broadcast clearly the precise nature of the goods or services. This is useful in offensive scenarios: where an infringer is selling the same or nearly identical goods, a plain identification will be useful when making a case of infringement.

As a practical matter, care should be taken not to cover self-serving services (eg, hotel bookings, unless you are a third-party online hotel Booker). The practitioner should generally avoid reciting part of the trademark in the identification to avoid a descriptiveness refusal.

The standard for determining fraud on

the USPTO has been a hotly debated issue in US practice in recent years. A practitioner must exercise caution when including goods or services in an identification that might not be in use or for which it is questionable whether there is a *bona fide* intent to use. The latest case law makes it more difficult to demonstrate fraud, having returned to a simple negligence standard (see *In re Bose Corp* (91 USPQ2d 1938, 1940 Fed Cir 2009)). Even so, US practitioners should continue to be wary of goods and services that are included in identifications for which there are questions about whether there is use or an intent to use.

In the United States, there is a choice of four bases for an application, which can be claimed alone or in combination:

- a use-in-commerce-based application;
- an intent-to-use-based application;
- a foreign-based application; and
- a Madrid-based application.

Because the US system is based on use, the gold standard of application bases is use. A use-based application must be accompanied by a specimen showing use in commerce. Appropriate specimens include labels or containers for goods, or marketing materials for services. All other bases require that the applicant have a *bona fide* intent to use the mark on all of the listed goods in US commerce. For an intent-to-use basis, the owner must prove use before a registration is granted, whereas for foreign-based applications and international registrations extending to the United States, the owner need not prove use before a registration is issued.

Registrations for which there is no demonstration of use are often viewed with initial scepticism, leading to questions about whether the registration could be cancelled on the basis of abandonment.

An examiner may require that certain

statements be included in an application during prosecution, including disclaimers, claims of secondary meaning, prior registrations, translations or transliterations and confirmation that the mark has no meaning in the field.

Any of these statements can be voluntarily offered at the outset, but given the limiting nature of most statements, a careful practitioner avoids this practice. However, in limited circumstances, it could be worthwhile to enter a statement voluntarily for strategic reasons. For example, a disclaimer may be entered from the start to communicate the applicant's position that a term is descriptive and cannot conflict with third-party uses.

The most common grounds for the USPTO's initial rejection of a trademark application are because there is a likelihood of confusion with a previously registered US trademark (15 USC Section 1052(d)) or the mark is merely descriptive of the goods or services for which registration is sought (15 USC Section 1052(e)).

Examiners act as gatekeepers for prior registrants and are incentivised to make refusals. Often, there is room for argument; it is paramount to craft a response accordingly. In assessing the likelihood of confusion between two marks, the examiner will determine the similarity or dissimilarity of the marks in their entirety in respect of their appearance, sound, meaning and commercial impression, as well as the similarity or dissimilarity and nature of the goods or services described in the application and in connection with which the prior mark is in use.

A side-by-side comparison of the two marks is improper and an examiner's subjective reaction to the marks is irrelevant to the analysis. Rather, an examiner must consider the two marks in their entirety.

An applicant faced with a likelihood of confusion refusal may try to obtain the consent of the owner of the prior registered mark for the registration of its mark. The decision to do so should be carefully considered because any such agreement can weaken an applicant's overall rights.

In order to persuade the examiner to withdraw a refusal, the consent must not be a mere consent to register or a conclusory statement of the absence of confusion. Instead, the agreement must set out specific reasons as to why the parties believe that no conflict between their marks exists and that the coexistence of their marks does not give rise to a likelihood of confusion.

As another option, an applicant may be in a position to cancel the registration of the



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third-party blocking citation if, for instance, an investigation demonstrates that the mark has been abandoned or that the registrant has committed fraud on the USPTO.

Inherently distinctive marks are entitled to registration on the principal register; merely descriptive marks are not. Inherently distinctive marks are arbitrary, fanciful and suggestive. A mark is merely descriptive and must be shown to have acquired secondary meaning if it directly conveys information concerning the function, characteristics, ingredients, qualities, purpose or use of the underlying goods or services. A suggestive mark can be registered on the principal register without proof of secondary meaning.

Practitioners should keep in mind that a secondary register, called the supplemental register, allows for the registration of marks that are considered insufficiently distinctive to qualify for registration on the principal register.

A registered mark on the supplemental register is nonetheless capable of potentially serving as a trademark and the owner of a supplemental registration can block a registration by a third party. Such a registration can also function as a step to seek later registration on the principal register, provided that the mark acquires distinctiveness.

After registration, from time to time an owner must demonstrate continued use of its trademark by submission of an affidavit or declaration, along with specimens. An owner will first need to demonstrate use between the fifth and sixth year after registration, and then at renewal, 10 years after registration and every 10 years thereafter.

Practitioners should recognise that in limited circumstances it is possible to maintain a registration by a showing of excusable non-use.

It is possible to amend a mark that has been registered so that the drawing in the registration conforms with changes in use, provided that the change is not a 'material alteration'. The rearrangement of elements and other changes may still allow for such an amendment and it is generally recognised that the standards for drawing amendments are more lax after registration. This could be a valuable way of maintaining the priority date of an old registration.

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