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## LETTERS OF PROTEST: AN ATTRACTIVE ALTERNATIVE TO A U.S. OPPOSITION

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A Letter of Protest (LOP) is an informal mechanism that a trademark owner may use to prevent another party from registering its mark at the U.S. Patent and Trademark Office (USPTO) or to impose some requirement (such as a disclaimer or a change to a description of goods or services) on the resulting registration. With only a brief letter and attached evidence, a trademark owner may cause the substantive refusal of an application, such as on the basis of descriptiveness, genericness or likelihood of confusion. Although the applicant may respond to a substantive refusal that may issue from an LOP, the arguments in support of registrability may not succeed. Thus, filing an LOP can accomplish the same result as a formal trademark opposition before the Trademark Trial and Appeal Board (TTAB) at a very small fraction of the time and expense.

The USPTO formerly decided LOPs under a strict “clear error” standard, which means that the USPTO will not change an early action unless it is necessary to do so to prevent the issuance of a registration that would violate the Trademark Act or applicable rules. In November 2008, however, the USPTO changed the standard applicable to most LOPs to a more generous “relevance” standard, which means that the evidence in the LOP may support any reasonable ground for refusal appropriate in *ex parte* examination. Given the more attractive standard of review, the LOP should be an important component of a well-rounded trademark enforcement strategy. Understanding the benefits and the limitations of an LOP is critical to its success.

### Process for Filing an LOP

The LOP process is straightforward and explained in detail in Section 1715 of the USPTO’s Trademark Manual of Examining Procedure (7th ed. 2010) (TMEP). The interested party sends a letter to the Office of the Deputy Commissioner for Trademark Examination Policy, accompanied by relevant evidence, explaining why registration should not occur or why a requirement is needed with respect to the application. The Deputy Commissioner typically decides an LOP within 60 days of its submission and often within three to four weeks.

If the LOP is filed before the relevant application is published for opposition, the Deputy Commissioner will grant the LOP if “the evidence is relevant and supports any reasonable ground for refusal appropriate in *ex parte* examination.” TMEP § 1715.02(a). If granted, the relevant evidence will be sent to the examining attorney, who will make an independent determination of whether the evidence supports a refusal or requirement. (Under the previous clear error standard, the examining attorney had to issue the refusal.) The USPTO estimates that, in fiscal year 2009, approximately 40 percent of the time that a pre-publication LOP was granted, the examining attorney took some action as a result of the LOP.

If the LOP is filed within 30 days after the relevant application is published for opposition, the Deputy Commissioner will grant the LOP only if it would be clear error not to consider the evidence. If it is granted, the relevant evidence is sent to the examining attorney and he or she must issue the refusal or the requirement. TMEP § 1715.03.

### When to File and Not to File an LOP

Although an LOP may be filed with respect to any ground on which the USPTO could refuse to register an application, TMEP Section 1715.01(a) specifically mentions four such grounds:

1. Descriptiveness or genericness;
2. Likelihood of confusion with one or more prior U.S. trademark registrations or prior pending trademark applications;
3. The facts of the second ground plus the existence of pending infringement litigation between the trademark

owner and the applicant concerning the applied-for mark;

4. The trademark owner's registered mark has been included within the description of goods and services of the applied-for mark.

While not specifically mentioned in the TMEP, the USPTO also encourages LOPs to be filed by foreign applicants whose Section 44(d) priority claims give their applications priority over earlier-filed non-priority applications. The most common ground is the second, likelihood of confusion.

If the interested party can establish one of these grounds, that party should strongly consider filing an LOP as part of its trademark enforcement strategy. The LOP is an additional remedy; a trademark owner may still oppose the application if its LOP is denied or if the applicant successfully overcomes a refusal based on the LOP. It is also important to remember that the decision makers for an LOP and an opposition are different, so the denial of an LOP will not taint the opposer in the eyes of the TTAB. Even if the LOP is denied or is granted but not acted upon by the examining attorney or the applicant overcomes a refusal based on the LOP, the evidence gathered will be needed in the trademark opposition.

The flip side of knowing when to file an LOP is knowing when not to file an LOP. Broadly speaking, to succeed with an LOP, an interested party must have credible third-party objective evidence to submit, not merely its own opinion or arguments. This evidence should be the same type that the examining attorney would attach to a substantive refusal.

For example, a successful LOP filed on the ground of descriptiveness should contain third-party evidence of descriptiveness such as copies of dictionary definitions, scientific literature, trade journal articles and competitor advertising, in each case showing descriptive use of the term or terms that the applicant seeks to register. If the only evidence available is the trademark owner's firm (but unsupportable) belief that the term ought to be descriptive, that owner should expect its LOP to be denied.

In the case of an LOP based on likelihood of confusion, a trademark owner should submit evidence of its ownership of one or more federal registrations or prior pending applications. Just as an examining attorney will not refuse a trademark application based on common-law trademark use, ownership of foreign and U.S. state trademark registrations, corporate name registrations or domain name registrations. Similarly, the Deputy Commissioner will not grant an LOP based on such evidence. TMEP § 1715.01(b).

If the basis for an LOP is a subjective dispute with another trademark owner, those arguments should be saved for an opposition. Just as an examining attorney will not, during his or her examination of an application, decide claims of fraud or other misconduct by an applicant, disputes over ownership of a mark or challenges to the priority of a mark, the Deputy Commissioner will never grant an LOP based on such claims. See *id.*

If a trademark owner's LOP is denied, that owner should focus its energies on preparing the notice of opposition. While it is theoretically possible to file a petition to the Director challenging such a denial, in practice the Deputy Commissioner has broad discretion over LOPs and such petitions are "rare and not likely to be granted," counsels Jennifer Chicoski, staff attorney in the Trademark Commissioner's Office.

### **What Constitutes a Well-Drafted LOP?**

The LOP should not be confused with a TTAB brief. When asked what constitutes a well-drafted LOP, Ms. Chicoski responded, "To be blunt, the wording of an LOP itself is irrelevant beyond stating the nature of the grounds for objection. The shorter the LOP the better. The most important component is the evidence submitted. If accepted, only the evidence will be forwarded to the examining attorney."

Ms. Chicoski advises that "in the case of descriptiveness, genericness, functionality or any other evidence-heavy substantive issue, the quality of the evidence is critical." Because the examining attorney will not receive the LOP, the interested party should select evidence that can be understood on its face without extensive explanation. It is far better to submit a representative sample from highly regarded public sources than to include cumulative evidence from sources of unknown or questionable quality.

When the basis for the LOP is one or more registrations or prior pending applications, the trademark owner need not attach copies of registrations or printouts from the USPTO website, but instead can simply reference each registration or serial number, mark and goods and/or services. If there are numerous relevant marks, the USPTO suggests that the trademark owner create a separate chart containing this information but excluding the identity of the owner and the owner's counsel.

## Timing for Filing an LOP

The decision as to when to file an LOP is almost as important as whether to file an LOP. In fiscal year 2010, approximately 1,060 LOPs were filed. The grant rate for pre-publication LOPs was 69 percent, while the grant rate for post-publication LOPs was less than half that, or 29 percent. Given the tougher standard that applies after an application is published for opposition, a trademark owner should file a post-publication LOP only if the ground for the LOP did not arise until then, or only if it has overwhelmingly favorable facts. For example, under the clear error standard, a trademark owner will likely need to have the legally same mark and the legally same goods or services to have a likelihood of confusion LOP granted, Ms. Chicowski warns. If a trademark owner does decide to file a post-publication LOP, it should simultaneously request a 90-day extension of time to oppose the subject application, because the filing of an LOP does not stay or automatically extend the opposition deadline. TMEP § 1715.03(e).

The ideal time to file an LOP is after the first office action in which the examining attorney has failed to refuse the registration or impose the restriction the trademark owner wants. Filing an LOP before the first office action may be premature, because it may not be needed. For example, perhaps the examining attorney for the application for registration of the mark CHOCHINE for candy would have found the prior registration of the trademark CHOKOFINE for chocolate and issued a refusal based on that registration even without an LOP. Of course, the examining attorney might not issue a first office action, and therefore, it may be risky to wait for an office action that may never materialize. If the interested party owner waits until after publication to file a LOP, the chances of success of that LOP will plummet because the Deputy Commissioner will apply the tougher clear error standard to that LOP.

How does a trademark owner maximize its opportunity to file an LOP without filing an unnecessary LOP? First, for each of its key marks, the owner should subscribe to a watch service that tracks when applications for potentially infringing marks are filed. (Tracking when they are published is too late.) Second, when a watch notice issues for a potentially troublesome application, review the underlying application to see if it is likely that an office action will be issued on procedural grounds, such as a request to clarify the identification of products or services, to disclaim a blatantly descriptive word or to substitute a new specimen. If one or more procedural issues will need to be addressed, it is fairly safe to wait until the issuance of the first office action to see if the examining attorney covers the trademark owner's issue. If, however, this review yields no obvious grounds for a procedural refusal, the trademark owner should strongly consider filing an LOP right away.

If the first office action does not mention the trademark owner's LOP ground, that owner should plan on filing the LOP as soon as possible. This will make it more likely that the examining attorney will issue a superseding office action adding the requested substantive refusal or restriction. The USPTO's general rule of thumb is that if an LOP is filed within the first four months after the office action, the examining attorney should issue a new office action, but if it is filed within the final two months, the examining attorney may wait until the applicant's response is filed and then issue a further office action with the new refusal or requirement.

If the trademark owner submits an LOP but an intervening office action issues refusing the application on the same grounds raised in the LOP, the Deputy Commissioner will still consider the LOP. If the application is granted, the examining attorney will receive the evidence from the LOP and will have the discretion as to whether to issue a new refusal (on the same grounds, but bolstered by the new evidence). For example, the examining attorney could add three prior registrations to a likelihood-of-confusion refusal or more evidence of genericness to a genericness refusal.

By following this strategy, an interested party can minimize the need to file an LOP but maximize the chances of success for any LOP it does file.

## Summary

Given the relatively low cost of an LOP and the fairly generous standard of review a pre-publication LOP receives, the LOP should be a standard weapon in every trademark owner's enforcement arsenal.

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