



FICPI VIRTUAL OPEN FORUM

Sweeping Examiners Off Their Feet: Overcoming Objections To Trademarks

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Moderator



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Speakers



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Speakers



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AA Thornton



Speakers



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Major Objections

Objection	China	EU	UK	USA	Canada
Goods/Services	√	√	√	√	√
Confusion	√	X	X	√	√
Descriptiveness	√	√	√	√	√
Distinctiveness	√	√	√		√
Name/Surname	X	X	X	√	√



Nice Classification

- Classification mandatory for all applications and registrations
- Some differences in how different jurisdictions treat classification
 - US – detailed description
 - Canada - describe in ordinary commercial terms
 - China - subclasses
 - EU/UK – class headings acceptable
- Overcome through:
 - amending description of goods and/or services or reclassifying as needed
 - arguing against the objection – appeal?
 - deleting goods and services at issue



Confusion

- Review of the register for confusingly similar pending and registered marks not owned by the same person
 - First to file v. first to use
 - Public interest v. brand owner interest
 - Notification process
- Overcome through:
 - arguments against the objection
 - sound, appearance, meaning, commercial impression
 - goods and services
 - opposition to prior pending application
 - cancellation for non-use or invalidation of a cited registration
 - consent from owner of cited mark → binding?



Major Objections

LIKELIHOOD OF CONFUSION



- **Sound**

T. MARKEY	TEE MARQEE
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- **Appearance**

T. MARKEY	T.Markey
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- **Meaning**

LUPO	WOLF
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Major Objections

LIKELIHOOD OF CONFUSION
Goods/Services



- Goods
 - T-shirts and pants
 - Hats
- Services
 - Banking services
 - Mortgage lending services
- Goods/Services
 - T-shirts and pants
 - Online retail store services featuring clothing

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Examples

	Trademark Objected	Classes	Prior Registration	Third party's registration in between														
1		30																
2		12 19		<table border="1"> <tr> <td>引证商标 1 (第 4223476 号)</td> <td>引证商标 2 (第 4223486 号)</td> <td>引证商标 3 (第 4223481 号)</td> <td>引证商标 4 (第 22210749 号)</td> </tr> <tr> <td></td> <td></td> <td></td> <td>AGG</td> </tr> </table> <table border="1"> <tr> <td>引证商标 5 (第 G1065491 号)</td> <td>引证商标 6 (第 16424642 号)</td> <td>引证商标 7 (第 41259158 号)</td> </tr> <tr> <td>ACC</td> <td>ACC</td> <td></td> </tr> </table>	引证商标 1 (第 4223476 号)	引证商标 2 (第 4223486 号)	引证商标 3 (第 4223481 号)	引证商标 4 (第 22210749 号)				AGG	引证商标 5 (第 G1065491 号)	引证商标 6 (第 16424642 号)	引证商标 7 (第 41259158 号)	ACC	ACC	
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引证商标 5 (第 G1065491 号)	引证商标 6 (第 16424642 号)	引证商标 7 (第 41259158 号)																
ACC	ACC																	
4		9	No. G1088618	No. 4875585														
5	 (福建七匹狼公司)	18	No. 16328033 	No. G1289376 														



Descriptiveness

- Clearly/Merely Descriptiveness v. Deceptively Misdescriptive
 - Character or quality of the goods
 - Geographic origin of the goods

Overcoming the objection

- arguments against descriptiveness
- evidence of acquired distinctiveness
 - when required?
 - what kind of evidence?
 - how long should use be?



Distinctiveness

- Distinctiveness expressly assessed during examination for registrability
 - refuse any trademark that lacks distinctiveness
 - separate and apart from descriptiveness in Canada
 - Examples:
 - single letter/number marks, esp commonly used in specific industries (e.g. GT or LE in auto industry);
 - combination of surnames that are not inherently distinctive (e.g. SMITH JOHNSON)
 - designs common to the trade (e.g. ordinary representation of grapes for wine)



Not Inherently Distinctive

- Threshold for objection:
 - No inherent distinctiveness (not registrable) vs.
 - Low degree of inherent distinctiveness (registrable)
- Overcome objection through:
 - arguments against non-distinctiveness
 - state of the register
 - evidence of acquired distinctiveness
 - when required?
 - what kind of evidence?
 - how long should use be?



Case Studies

BOOKING.COM



#makeitright

BABY SHARK



Some Well-Known Slogans

FINGER LICKIN' GOOD (KFC)

THE WORLD'S LOCAL BANK (HSBC)

DON'T LEAVE HOME WITHOUT IT (American Express)

THE ULTIMATE DRIVING EXPERIENCE (BMW)

WHAT'S IN YOUR WALLET (Capital One)



Extreme Examples

1912648	MIRACLES DON'T JUST HAPPEN. THEY ARE CREATED EVERY DAY. THROUGH THE DAILY RITUAL OF SELF-CARE, WE CONNECT WITH OUR INNER STRENGTH AND CREATE THE MIRACLES WE WANT TO SEE.	Word	APPROVED	3
1885280	when we approach each day with purity, we see life with fresh eyes. we focus on what can be, instead of what is. we trust our instincts, and balance is found. we embrace the purity of our intentions and the simplicity of being our true selves.	Word	ADVERTISED	3
1824523	1/4 c. warm milk, 1/2 c. sugar, 1 tsp. salt, 1 tbsp. cinnamon, 4 tbsp. softened butter, 2 eggs, 1 pkg. dry yeast, 1/4 c. warm water, 2 1/2 c. flour. Mix all ingredients except yeast, water and flour, and let it cool. Stir and dissolve yeast in warm water. Add yeast to first mixture, beat until mixed. Add 1 1/2 c. flour. Cover and let rise for 1 hr. Add remaining flour; blend well. Knead until smooth. Put dough in greased bowl, cover and let rise until double in size. Punch down, shape rolls and let rise for 1 hr. Bake at 400°f for 18 min.	Word	REGISTERED	3



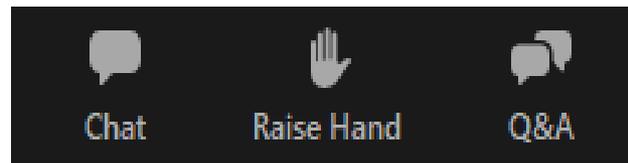
Name/ Surname Objection

- Impact on applications for registering famous names for trademarks (e.g. celebrity names, etc.)
- How to avoid / respond to objection:
 - Filing for a more distinctive mark (additional distinctive word or design elements)
 - Overcome objection with written submissions
 - Evidence of acquired distinctiveness (or specific region if registration to be limited in scope)



Questions?

*Ask using the 'Q&A' function
at the bottom of your screen*





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