

## U.S. TRADEMARK PRACTICE

FICPI 12<sup>th</sup> Open Forum  
September 10, 2010  
Munich, Germany  
Gary D. Krugman, Sughrue Mion, PLLC  
Washington, DC

---

### I. Classification and Identification of Goods/Services In U.S. Trademark Applications

#### A. Classification of Goods/Services

- Prior to September 1, 1973, the U.S. used its own system of classification of goods and services.
- For all applications filed on or after September 1, 1973, and their resulting registrations, the international classification of goods and services is utilized in the United States.
- The filing fee for a U.S. application depends on the number of classes (\$325/class).
- If the goods/services fall in more than one class and a fee for only one class has been paid, applicant must either restrict the goods/services to one class or pay the additional fees in order to proceed with a multi-class application.
- The applicant should designate the international class number(s) that are appropriate for the identified goods/services. If no class number(s) is designated, the PTO will classify the goods/services.
- If the applicant indicates a class number(s) that is clearly wrong (e.g., goods are classified in a service class), the PTO's pre-examination section will correct the classification.
- If, during examination, the PTO examiner determines that the class number(s) is incorrect, the class number(s) must be amended.

#### Exception

- If the U.S. application is one filed pursuant to the Madrid Protocol, the International Bureau of WIPO (IB) controls the classification of the goods/services and the classification of goods/services in such an application cannot be changed from the classification given by the IB. In addition, classes cannot be added.

#### B. Identification of Goods/Services

- Every U.S. application must specifically identify the particular goods/services with which applicant uses, or has a *bona fide* intention to use, the mark in commerce.
- Each product/service must be named by its common commercial name, using terminology that is understood by the average person and should not require an in-depth knowledge of the relevant field. For products/services that do not have common names, the applicant should describe the item by its function and/or intended use. An applicant may not utilize class headings in lieu of specifically describing the products/services.

- The PTO examiner will often require an amendment to the description of goods/services in order to ensure each item is clearly and accurately identified. The PTO examiner may also require applicant to provide information and exhibits if necessary to ascertain the nature of the goods/services.
- Goods/services set forth in an application may be amended only to narrow or limit the scope of the original description. No amendment is permitted to add goods/services or to broaden the scope of the goods/services originally set forth in the application. In addition, once certain goods/services are deleted by amendment, those deleted items cannot later be reinstated in the application.

#### Example

- Application covers “clothing, namely, shirts, pants and sweaters.”
- Acceptable amendment: “clothing, namely, children’s shirts, pants and sweaters.”
- Unacceptable amendment: “clothing, namely, shirts, pants, sweaters and skirts.”
- With respect to U.S. applications based on the applicant’s home registration, the description of goods/services must be specific, even if the home registration includes an overly broad description. In addition, the description of goods/services in the U.S. application may not exceed the scope of the goods/services identified in the foreign registration.

#### Advantages of U.S. System

- Requirement for specificity regarding the description of goods/services in an application ensures accuracy and definiteness with respect to the nature of the goods/services. This results in fewer frivolous or unnecessary oppositions since the prospective opposer can more easily determine the true scope and nature of the goods/services in the application.
- PTO examiners are better able to accurately determine when a refusal of registration should be made in view of a prior registration of a confusingly similar mark since the Examiner can better determine the true scope and nature of the goods/services in the potentially conflicting registration.

#### Disadvantages of U.S. System

- Requirement for specificity leads to more complicated and more numerous office actions. Objections to descriptions of goods/services by PTO examiners are common and there are often multiple office actions issued until the description of goods/services is amended to the examiner’s satisfaction. This can result in lengthy and expensive prosecution of applications prior to publication.

#### II. Requirements For Most Trademark Owners To Use Mark in Commerce Prior to Obtaining U.S. Registration

- U.S. applications may be filed using one or more of the following filing bases:
  1. Use in commerce
  2. *Bona fide* intent to use
  3. Convention priority based on previously filed foreign application
  4. Reliance on registration granted by applicant’s country of origin
  5. Extension of protection of an international registration to the United States pursuant to the Madrid Protocol.

- With respect to an application filed based on use in commerce, the mark must be in use in commerce on or in connection with all the goods/services described in the application at the time the application is filed. Evidence of use must be submitted showing use for at least one product/service in each class applied for.
- With respect to an application filed based on applicant's *bona fide* intent to use the mark in commerce, no use is required prior to publication. Once the mark is published for opposition and the opposition period is closed, the PTO issues a notice of allowance listing all the goods/services in the application. The applicant then is allowed six months to file a statement of use or, alternatively, to request an extension of time to file a statement of use. Extensions of time can be obtained in six month increments totaling three years from the date of the notice of allowance.
- The statement of use must state that the mark is in use on or in connection with all the goods/services set forth in the notice of allowance. Evidence of use must be submitted showing use for at least one product/service in each class applied for. If the mark is not used on all of the goods/services, the goods/services not in use should be deleted at the time the statement of use is filed.
- With respect to an application claiming convention priority based on an earlier filed foreign application, such a priority claim is proper only where the U.S. application is filed within six months from the filing date of the earlier filed foreign application. While such a priority filing date is granted, an applicant must establish a basis for publication either under use in commerce, intent to use, or reliance on applicant's home registration. Registration will only be allowed if the applicant fulfills the requirements of one of those bases.
- With respect to an application filed based on a registration granted by applicant's country of origin, and with respect to an application filed pursuant to the Madrid Protocol, no use is needed prior to the applicant obtaining its U.S. registration. Once the U.S. registration issues, however, use in commerce is required in order to maintain the registration through its entire ten year term and in order to renew the registration for additional ten year terms.
- Maintenance of all U.S. registrations require the filing of a declaration of continued use between the fifth and sixth years following issuance of the registration. The declaration must be accompanied by evidence showing current use of the mark for at least one product/service in each class, failing which the registration will be cancelled.
- A declaration of continued use is also required to be filed in connection with all U.S. registrations at the expiration of each ten year term in order to renew the registration for an additional ten year term. The declaration must be accompanied by evidence of current use of the mark for at least one product/service in each class, failing which the registration will be allowed to expire.
- A registration can be cancelled at any time on the grounds of abandonment if an interested party files a petition to cancel. Abandonment may be proved by demonstrating that the registered mark is not used for the goods/services in the registration and that the registrant has no intent to resume such use. Three consecutive years of non-use creates a presumption of abandonment, shifting the burden of proof to the registration owner who must then show that he does intend to resume use of the mark.

### III. Substantive Examination of U.S. Trademark Applications

- Every U.S. application, regardless of the filing basis, is given a thorough and substantive examination by a PTO Examiner to determine if there are any defects in the application which necessitate the issuance of one or more requirements by the Examiner and, also, whether there are any substantive grounds for refusal.

Formal Requirements For Application

- Name/address/citizenship/legal entity of applicant
- Filing basis
- Declaration verifying facts in the application
- Identification/classification of goods/services
- Drawing of mark
- Description of mark (if it includes non-literal components which the Examiner decides are unclear or not easily identifiable)
- Translation of non-English words in the mark
- Specimen of use for use based application

Common Substantive Grounds For Refusal of Registration

- Likelihood of confusion with previously registered mark (PTO Examiner conducts a search of the PTO records in connection with the examination of every application)
  - Descriptiveness
  - Surname
  - Geographical Designation
  - Genericness
  - Deceptiveness
  - Functionality (configuration of goods or of packaging for goods)
  - Ownership of Mark
  - Conflicting mark in prior pending application
  - Disclaimer of unregistrable component
- PTO Examiner will issue office action raising one or more requirements and/or one or more substantive grounds of refusal.
- Applicant is allowed six months to respond to the office action. This six month response period is not extendible.
- If, after considering applicant's response to an initial office action, the Examiner maintains one or more requirements and/or one or more substantive grounds for refusal, the Examiner will typically issue a second office action, making final the requirement(s) and/or refusal(s).
- Applicant is allowed six months to respond to the second final office action. This six month response period is not extendible.
- Applicant may, within the six month response period from the issuance of the final office action, request reconsideration of the Examiner's requirements/refusals and/or file an appeal to the Administrative Trademark Court of the PTO (Trademark Trial and Appeal Board or TTAB).
- An appeal to the TTAB is taken by filing a notice of appeal together with the appeal fee (\$100 per class). Applicant is then allowed time (60 days from the date of the notice of appeal) to file its brief on appeal. The Examiner then is allowed time to file an answering brief and the applicant is then allowed time to file an optional reply brief, if it believes one is necessary.
- If applicant wishes to appear in person before the three TTAB judges who will decide the appeal, an oral hearing may be requested by applicant. Such requests are always granted.

- Oral hearings are held in the TTAB hearing room at the U.S. PTO (Alexandria, Virginia). Applicants usually attend such hearings in person although it can be done via video conferencing if applicant or applicant's attorney does not wish to travel to the PTO.
- Applicant is allowed twenty minutes to present its arguments before a panel of three TTAB judges and applicant may reserve any unused time for rebuttal argument. The PTO examiner will then be allowed ten minutes to present his/her arguments following which applicant may present any arguments to rebut the examiner, if applicant has any time remaining.
- The three TTAB judges will issue a written decision affirming or reversing the examiner's refusal(s). Such a decision usually issues within three to four months following the oral hearing, or within three or four months following the last brief submitted, if applicant does not request an oral hearing.

#### IV. U.S. Opposition and Cancellation Practice and Procedure

##### A. Oppositions

- Timing - An opposition must be filed within 30 days from the date of publication or within any extension of time requested and granted.
- Fee - \$300 per class
- Nature of Opposition - Short plain statement setting forth opposer's real interest in opposing registration of the mark (standing) and setting forth the grounds for opposition.
- An opposer must plead and later prove that it has some real commercial interest in preventing the registration from being allowed (*e.g.*, competitor)
- Grounds for Opposition - The most common ground for opposition is likelihood of confusion with opposer's previously used and/or registered mark.

##### Opposition Procedure

- Opposer files the opposition with the TTAB and serves a copy on applicant or, if applicant is represented by an attorney, on applicant's attorney of record.
- Applicant is allowed time to file its answer - an admission or denial of each of the allegations in the opposition.
- The parties or their attorneys are required to participate in a mandatory discovery/settlement conference to outline what each party expects and wants from the other party regarding the discovery of relevant information. Such a conference almost always is done by telephone and the TTAB encourages the parties to discuss the possibility of settlement during the conference.
- The parties are required to exchange initial disclosures, providing the adverse party with the identity of probable witnesses, and the identity and location of relevant documents.
- Following the exchange of initial disclosures, the parties are free to engage in formal discovery - interrogatories, document requests, requests for admission and discovery depositions.
- Following the close of the discovery period, the case moves to the evidentiary/trial stage. Opposer is allowed time to take testimony and present evidence in support of its claims. Applicant is then allowed time to take testimony and present evidence in support of

its defenses to opposer's claims. Opposer is then allowed time to take testimony and present evidence to rebut any testimony or evidence submitted by applicant.

- Following the close of the last testimony period, opposer is allowed time to file its written brief on the case. Applicant is then allowed time to file its answering brief and opposer is then allowed time to file a reply brief.
- If one or both parties request an oral hearing, such a request is always granted. Oral hearings are held at the TTAB hearing room at the U.S. PTO (Alexandria, Virginia). The parties usually attend the hearings in person although it can be done via video conferencing if one or both parties (or their attorneys) do not wish to travel to the PTO.
- Opposer is allowed thirty minutes to present its arguments before a panel of three TTAB judges and opposer may reserve any unused time for rebuttal argument. Applicant is then allowed thirty minutes to present its arguments following which opposer may present any arguments to rebut the applicant, if opposer has any time remaining.

### Decision

- The TTAB will issue a written decision on the opposition within three or four months following the oral argument or within three or four months following the last written brief, if no oral argument is requested.
- The losing party may appeal the TTAB decision to either the U.S. Court of Appeals for the Federal Circuit or may, in the alternative, request review of the TTAB decision by way of filing a civil action in a U.S. District Court.

### B. Petitions for Cancellation

- Timing - a cancellation action may be filed any time except that a registration may not be cancelled on certain grounds unless the cancellation action is brought within five years from the date of issuance of the registration.
- A cancellation action against a registration based on priority/likelihood of confusion may only be brought within five years following issuance of the registration. By contrast, a cancellation action against a registration based on abandonment may be brought at any time.
- Fee - \$300 per class
- Nature of a Cancellation Petition - short plain statement setting forth petitioner's real interest in seeking cancellation of the registration (standing) and setting forth the grounds for the cancellation petition.
- A petitioner must plead and later prove that it has some real commercial interest in cancelling the registration (e.g., competitor).
- Grounds for Cancellation - The most common ground for cancelling a registration is likelihood of confusion with a previously used mark. This ground, as noted above, must be raised within five years from the issue date of the registration.

### Cancellation Procedure

- The procedure for cancellation actions are the same as with oppositions, with respect to filing and serving the petition to cancel, filing the answer, the mandatory discovery/settlement conference, initial disclosures, discovery, testimony and evidence, briefs, oral argument, decision and appeal.

# U.S. TRADEMARK PRACTICE

FICPI 12<sup>th</sup> Open Forum  
September 10, 2010  
Munich, Germany

Gary D. Krugman  
SUGHRUE MION, PLLC  
Washington, D.C.



# Classification of Goods and Services in U.S. Trademark Applications

- Utilizes International classification system (for all applications filed on or after September 1, 1973)
- Filing fee depends on number of classes (\$325/class)
- Classes may be added, deleted or changed (except for Madrid applications where classes can be deleted, but not added or changed)

## Identification of Goods/Services In U.S. Trademark Applications

- Goods/services must be described with specificity – Must use common commercial name or, if no common commercial name, must describe goods/services by function and/or intended use
- Goods/services in application may be deleted or limited but no amendment is permitted to add or broaden scope of goods/services originally set forth in application

# Identification of Goods/Services In U.S. Trademark Applications

If U.S. application is based on home registration of applicant, goods/services in U.S. application must be the same as, or more limited than the goods/services in the home registration



Sughrue

SUGHRUE MION, PLLC

# Identification of Goods/Services in U.S. Trademark Applications

## Advantages

- Accuracy of description of goods results in fewer unnecessary refusals of registration and fewer unnecessary oppositions

## Disadvantages

- Lengthy/expensive prosecution of applications



## Requirement To Use Mark In Commerce With United States

- Applications based on home registration or filed under Madrid Protocol need not use mark in U.S. prior to obtaining U.S. registration
- All trademark owners must use mark in commerce with the U.S. in order to maintain the U.S. registration

## Requirement To Use Mark In Commerce With United States

- Declaration of Continued Use (with evidence of use) required between 5<sup>th</sup> & 6<sup>th</sup> years following issuance of the registration
- Declaration of Continued Use (with evidence of use) required to renew the registration every 10 years

## Requirement To Use Mark In Commerce With United States

- Registration may be cancelled on abandonment grounds at any time by filing of a petition to cancel
- Three consecutive years of non-use constitutes a presumption of abandonment

# Substantive Examination of U.S. Trademark Applications

- Formal requirements for each application
- Substantive grounds for refusal of registration
- Procedure re: Office Actions
- Procedure re: appeal from final refusal of U.S. Trademark Examiner

# U.S. Opposition and Cancellation Practice and Procedure

## Oppositions

- Timing – 30 days from the date of publication or within any extension of time
- Fee - \$300/class
- Grounds – Likelihood of confusion with Opposer's previously used and/or registered mark is the most common ground for opposition

# U.S. Opposition and Cancellation Practice and Procedure

- Procedure
  - Opposition
  - Answer
  - Mandatory Discovery/Settlement Conference
  - Initial Disclosures
  - Discovery
  - Testimony/Evidence
  - Briefs
  - Oral Hearing
  - Decision
  - Appeal from Unfavorable Decision

# U.S. Opposition and Cancellation Practice and Procedure

## Cancellation

- Timing – Within 5 years following issuance of registration on any ground which could have been raised in an opposition
- Timing – Anytime on certain limited grounds (*e.g.*, abandonment, fraud)
- Fee - \$300/class
- Grounds – Likelihood of confusion with Petitioner's previously used mark is the most common ground for cancellation
  - Procedure
    - Same as opposition

