

Trademark Practice Before the US Patent and Trademark Office

Syllabus

Text – Trademark Manual of Examining Procedure (TMEP) (available at www.uspto.gov)

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1. TMEP is a guideline for Examining Attorneys. It outlines the procedures and to the extent relative the law, which Examining Attorneys are required or authorized to follow in the examination of trademark applications. It does not have the force of law. It is a policy statement of the USPTO only.

You need to read TMEP completely. Not all sections have the same importance, but to be competent you need to be at least knowledgeable regarding PTO trademark practice as the Examiner or at least to have been exposed to all the same issues. In the clinic you will be working with actual PTO Trademark attorneys and you need to be on the same playing field.

Completion of a course in trademark law is very helpful, but not required. The clinical course in trademark prosecution before the PTO will not teach you trademark litigation practices nor trademark transactional law or practices. There will be a brief introduction to inter parte practice before the Trademark Trial and Appeals Board (TTAB), but no comprehensive discussion or clinical practice before the TTAB will be provided.

We will discuss the following issues. To the extent possible the USPTO website will be accessed to illustrate the use of the site for information, trademark searches, and electronic filing of applications and amendments. The object is to have a working theoretical knowledge of trademark principles as they affect trademark prosecution and a working knowledge of electronic practice before the USPTO.

2. Introduction

- Trademark Statute and Rules
- United States Patent and Trademark Office Website
- Trademark Forms
- Trademark Searching
- General Information Booklet Concerning Trademarks
- The Official Gazette
- Trademark Manuals
- Status Inquiries
- Access to Records
- Decisions Available to the Public
- Requests for Copies of Trademark Documents

- Patent and Trademark Resource Centers
3. Application Filing Date
 - What Constitutes Filing Date
 - Requirements for Receiving a Filing Date
 - Review for Compliance With Minimum Requirements
 - Defective or Informal Applications
 - Filing Date Is Not Normally Changed
 - Effective Filing Date
 4. Filing and Receipt of Documents
 - Electronic Filing
 - Trademark Correspondence and Signature Requirements - In General
 - Receipt of Documents by the Office
 - Electronic Mail
 - Mailing Documents to the Office
 - Facsimile Transmission (Fax)
 - Hand Delivery
 - Period Ending on Saturday, Sunday, or Federal Holiday
 - Unscheduled Closings of the United States Patent and Trademark Office
 - Computing Period for Response
 5. Processing of Documents in PTO and Fees
 6. Change of Ownership
 - Assignment of Marks
 - Establishing Ownership of Applications or Registrations
 - Recording with Assignment Recordation Branch
 - Automatic Updating of Ownership of Trademark Applications and Registrations in Trademark Database
 - Notifying Trademark Operation
 7. Attorney and Representatives before the PTO
 8. Procedure for Examining Applications
 - Statutory Authority for Examination
 - Order of Work
 - USPTO Does Not Issue Duplicate Registrations
 - Initial Examination
 - The Examining Attorney's Letter or Action

- New Matter Raised by Examining Attorney After First Action
- Examiner's Amendment
- Priority Action
- Interviews
- Evidence
- Deadline for Response to Office Action
- Signature on Response to Office Action
- Examination of Amendments and Responses to Office Actions
- Final Action
- Action After Issuance of Final Action
- Suspension of Action by USPTO
- Reissuing an Office Action
- Abandonment
- Non-Responsive Communications
- Fraud Upon the USPTO

9. Application Requirements

- Types of Applications
- Application Form
- Applicant
- Verification and Signature
- Identification and Classification of Goods and Services
- Filing Basis
- Drawing
- Description of Mark
- Translation and Transliteration of Non-English Wording in Mark
- Filing Fee
- Designation of Domestic Representative
- Identification of Prior Registrations of Applicant
- Consent to Register by Particular Living Individual Whose Name or Likeness Appears in the Mark
- Requesting Additional Information
- Application Filed on Supplemental Register
- Amending Application to Supplemental Register
- Preparation of Application for Publication or Registration
- Application Checklist
- TEAS Plus

10. Use in Commerce

- Use in Commerce
- Allegations of Use for §1(b) Applications
- Dates of Use
- Specimens
- Method of Use
- Federal Registration Notice

- Compliance with Other Statutes

11. Applications under Section 44

12. Intent-to-Use Applications and Requests to Divide

- Bona Fide Intention To Use the Mark In Commerce
- Initial Examination of Intent-to-Use Applications
- Allegations of Use
- Amendment to Allege Use Under §1(c) of the Act
- Publication of Intent-to-Use Applications for Opposition
- Notice of Allowance
- Amendment After Issuance of the Notice of Allowance and Before Filing of the Statement of Use
- Requests for Extensions of Time to File the Statement of Use
- Statement of Use Under §1(d) of the Trademark Act
- Request to Divide an Application

13. Substantive Examination of Applications

- Ownership of Mark
- Use of Subject Matter as Trademark
- Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute
- Refusal on Basis of Flag, Coat of Arms, or Other Insignia of United States, State or Municipality, or Foreign Nation
- Refusal on Basis of Matter Protected by Statute or Convention
- Refusal on Basis of Name, Portrait, or Signature of Particular Living Individual or Deceased U.S. President Without Consent
- Refusal on Basis of Likelihood of Confusion, Mistake, or Deception
- Conflicting Marks in Pending Applications
- Refusal on Basis of Descriptiveness
- Refusal on Basis of Geographic Significance
- Refusal on Basis of Surname
- Acquired Distinctiveness or Secondary Meaning
- Disclaimer of Elements in Marks
- “Phantom” Elements in Marks
- Marks Composed, in Whole or in Part, of Domain Names
- Effect of Applicant’s Prior Registrations
- Res Judicata, Collateral

14. Service Marks, Collective Marks, and Certification Marks

- Service Marks
- Collective Marks Generally

- Collective Trademarks and Collective Service Marks
- Collective Membership Marks
- Trademarks and Service Marks Used by Collective Organizations
- Certification Marks
- Registration as Correct Type of Mark

15. Classification and Identification of Goods and Services

16. Post-Examination Procedures

17. Registration and Post Registration Procedures

- Types of Registrations
- Duration and Maintenance of Registrations
- Bringing Prior Act Registrations Under 1946 Act, §12(c)
- Affidavit or Declaration of Use or Excusable Nonuse of Mark in Commerce under §8 of the Trademark Act
- Affidavit or Declaration of Incontestability Under §15 of the Trademark Act
- Renewal of Registration Under §9 of the Trademark Act
- Cancellation of Registrations Under §§14 and 37 of the Trademark Act
- Surrender of Registration for Cancellation
- Amendment and Correction of Registrations
- Court Orders Concerning Registrations
- Updating Automated Records to Show the Status of Registrations
- Powers of Attorney and Designations of Domestic Representative Filed After Registration
- Affidavit or Declaration of Use in Commerce or Excusable Nonuse Under §71 of the Trademark Act
- Renewal of Registered Extension of Protection
- Division of Registrations
- Replacement

18, Petitions, Requests for Reinstatement, and Other Matters Submitted to Director

19. Public Inquiries About Applications and Registrations

20. Madrid Protocol

- Overview of the Madrid System of International Registration
- International Application Originating from the United States
- Payment of Fees

- Request for Extension of Protection of International Registration to the United States
- Renewal of International Registrations
- Communications with International Bureau Regarding International Registrations

21. A Brief Introduction to the Trademark Trial and Appeals Board (TTAB) and Practices Before the Same

Examinations

There will be weekly open-book question sheets to allow you to test your comprehension and track your reading. Your performance in the clinic will be assessed based on your responses to these question sheets and your clinical performance. Other examinations as may be required to meet school standards may be presented.