

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# **2018 Trademark Update: A Discussion with a USPTO Policy Maker and a TTAB Decision Maker**

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# TOPICS

- Letters of Protest (LOPs)
- LOP Practice Tips
- Specimens – no actual use in commerce
- Website Highlights and Tips
- Resources



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# Letters of Protest



# Letters of Protest: Purpose & Intent

Letter of Protest (LOP) is an informal procedure created by, and existing at the discretion of, the USPTO

**Purpose** of LOP is to allow third parties to bring factual evidence relevant to determining whether a mark should be registered to the attention of the USPTO

USPTO's **intent** in offering LOP procedure is to achieve its purpose without causing unnecessary delay or compromising objectivity of *ex parte* examination



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# Letters of Protest: Subject Matter

**Must relate** to an issue that can be prosecuted to its legal conclusion by Examining Attorney during *ex parte* examination

- fraud, prior use, disputed ownership  
are not grounds for *ex parte* refusal
- actual evidence of confusion  
is not relevant in *ex parte* examination

**Should not be a substitution**

of examining attorney's judgment by that of protester

Majority of LOPs relate to likelihood of confusion  
or descriptive/generic issues



# Letters of Protest: Procedures

LOPs are docketed and assigned to petition staff attorneys **in order of receipt**

Reviewed and acted on by staff attorney *approximately* **14 to 21 days** from filing

LOP may be filed before or within **30 days** *after publication for opposition*

LOP does not extend time for filing opposition





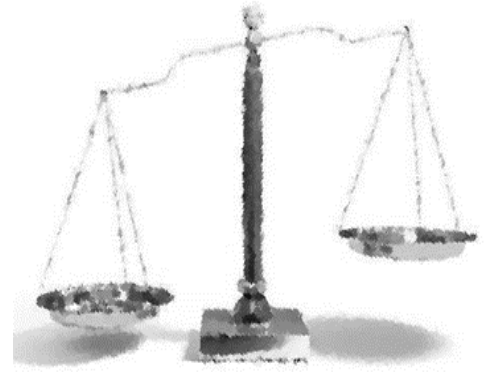


# Letters of Protest: Procedures

LOP will be **dismissed** if:

- Untimely – more than 30 days after publication
- Moot – issue already raised by Examining Attorney and LOP does not include additional useful evidence

Note: LOP may be granted if Examining Attorney previously issued refusal or requirement and LOP includes extensive evidence that Examining Attorney may have been unable to obtain





# Letters of Protest: Standard of Review

## If filed *prior* to Publication for Opposition

Accepted when submitted evidence is **relevant** and supports any reasonable ground for **refusal appropriate in *ex parte* examination**

## If filed *after* Publication for Opposition

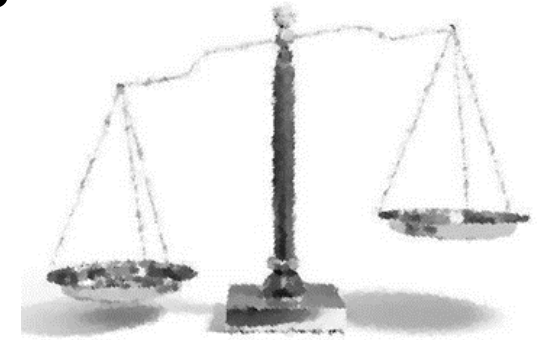
Accepted only when submitted evidence establishes publication of mark constituted clear error, because evidence included with letter of protest establishes *prima facie* case for refusal of registration



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# Letters of Protest: Procedures



If LOP is **accepted**, then:

- Letter of acceptance mailed to protestor
- Administrative memo is uploaded to public record with submitted evidence attached
- Prosecution history is updated to show "Letter of Protest Accepted"
- Examining attorney is notified



# Letters of Protest: Procedures

If accepted under **pre-publication**  
"relevant" standard:

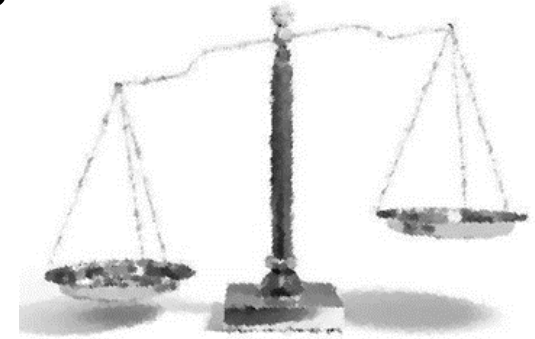
Examining attorney may either:

- (1) take action based on evidence and issue refusal/requirement, or
  - (2) exercise discretion and not issue any new refusal or requirement.
- If examining attorney declines letter, the prosecution history will be updated to show

"Letter of Protest Evidence Reviewed - No Further Action Taken."

If accepted under **post-publication** standard:

Jurisdiction is returned to examining attorney who is required to issue the refusal/requirement





# Letters of Protest: Reasons for Denial

- **Not relevant**

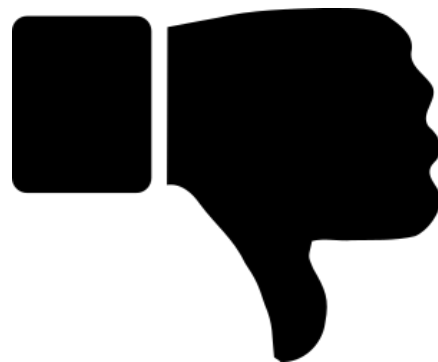
(e.g., likelihood of confusion: marks at issue do not support a reasonable ground of refusal; goods and/or services not related)

- **Evidence not provided**

- **Improper Subject matter**

(e.g. fraud, prior use, ownership disputes)

- **No prior application and/or registration**  
(common law mark)



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# Letters of Protest: Procedures



- If LOP is **denied**, then:
  - ✓ Letter explaining denial is sent to protestor
  - ✓ No indication in file or prosecution history that LOP was filed
- No provision for requesting reconsideration of denial of LOP  
Protestor may file a petition to Director for review of decision in Letter of Protest but new evidence may not be submitted
- Protestor may file opposition with TTAB at appropriate time

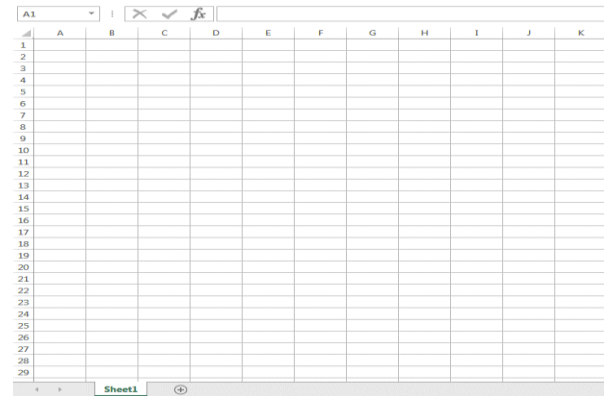




# Letters of Protest: Practice Tips



- ☐ Provide registration/application numbers of protestor's application(s)/registration(s), if any  
(Copies of registration certificates or printouts from USPTO database **not** needed)



- ☐ If there are multiple reg./app. numbers of protestor, then submit chart with numbers, mark, and relevant goods/services





# Letters of Protest: Practice Tips



- ☐ Submit objective *evidence* relative to examination
  - No arguments will be forwarded; only objective evidence
- ☐ Evidence
  - If more than 75 pages of evidence, LOP must include
    - (1) an explanation of why that amount of evidence is necessary and
    - (2) an itemized index of evidence;otherwise, LOP will be dismissed
  - Do not identify protestor in index
  - Actual evidence is required:  
website listings and URLs are *not sufficient*
  - Copies of third party registrations to show relatedness of goods/services are required  
Listing of registration numbers *is not sufficient*





# Letters of Protest: Practice Tips



- ☐ Submission of file record or prosecution history of protested application not necessary
- ☐ If goods/services are not identical, and likelihood of confusion is at issue, objective third-party evidence regarding relatedness/channels of trade should be included

Generally, **if no evidence is submitted** LOP will be **denied**.



# Letters of Protest: Practice Tips



- ☐ Separate letters of protest are required for multiple applications being protested; same evidence may be attached
- ☐ Evidence of fraud, prior use, or other non-*ex parte* grounds of refusal should not be included

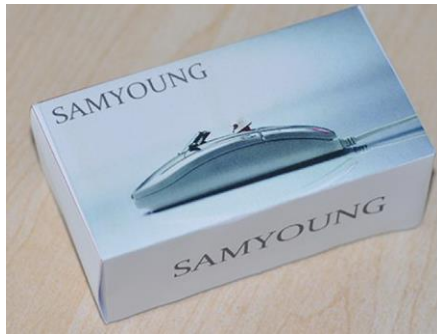
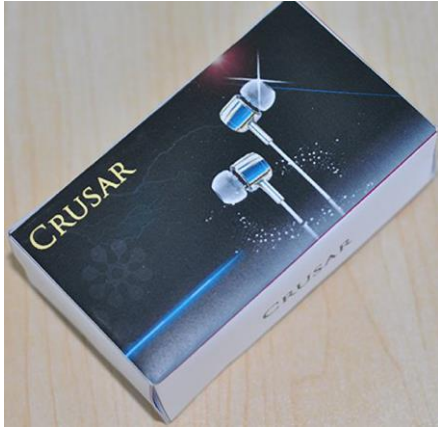
# Specimens- are these for real!?





Images on  
metal

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I think we've  
heard this  
one before



# How do we approach these?

- Refuse as not showing actual use in commerce per Trademark Act Sections 1 and 45
- Support refusals with images of other duplicates gathered from the internet and/or third-party registrations and pending applications
- Issue requests for information under Trademark Rule 2.61(b)

# Pilot Program: Trademark Specimen Protests Mailbox

The USPTO will establish a public facing email box to receive objective evidence of :

1) third party use of identical images to the specimen of record  
OR

2) the prior registration or application serial numbers of multiple cases with identical images of objects or websites featuring different marks





# Website Tips

- MYUSPTO- create an account, manage your website interface, and monitor marks
- Quick Links- use for navigation of USPTO website
- TM Alerts- sign up
- Ebiz page-check during outages



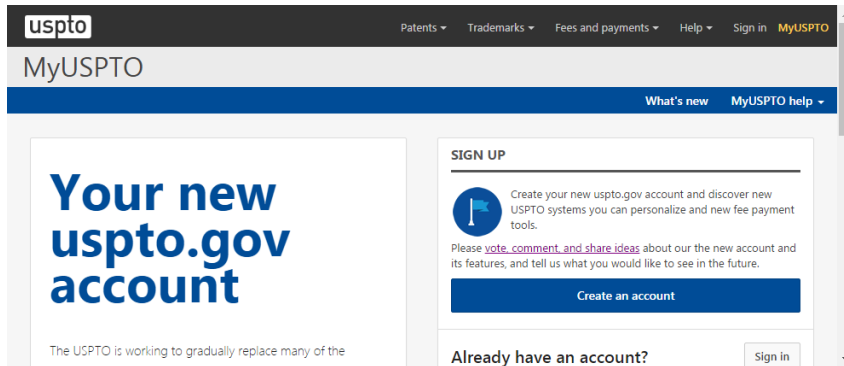
# MyUSPTO highlights



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# The uspto.gov user account



<https://account.uspto.gov>

- Users **register once** to set up a profile and establish the account credentials (login/password)
- Users can then **sign-in** using the credentials, **and access all USPTO systems** that have adopted the uspto.gov user accounts
  - MyUSPTO, Financial Manager, Patent Maintenance Fee storefront have already adopted the uspto.gov user accounts
  - Many more USPTO systems are moving to **adopt** the uspto.gov user accounts. Stay tuned!



# MyUSPTO

The screenshot displays the MyUSPTO interface with a dark header bar containing the 'uspto' logo and navigation links for Patents, Trademarks, Fees and payments, Help, and a user profile for 'meg Arthur'. Below the header, a light gray bar shows 'MyUSPTO' and a 'BETA' badge. A dark blue navigation bar at the top of the main content area includes 'What's new' and 'MyUSPTO help'. The main content area is divided into several panels:

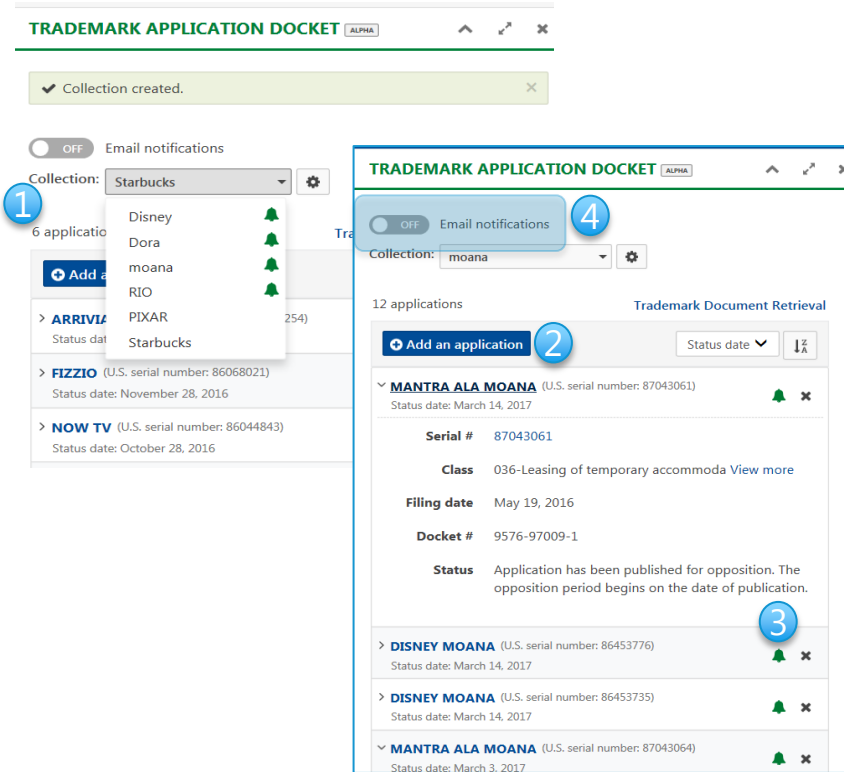
- TRADEMARK OFFICIAL GAZETTE WATCH** (ALPHA): Features a 'Collection' dropdown set to 'Starbucks', a 'Manage collection' button, and a list of watches: 'Coffee' (123), 'mermaid' (1), and 'star' (80).
- TRADEMARK APPLICATION DOCKET** (ALPHA): Includes a notification for status changes, an 'Email notifications' toggle (OFF), a 'Collections' section with a 'View a saved collection' dropdown, and a 'Create a new collection' button.
- TRADEMARK POST-REGISTRATION DOCKET** (ALPHA): Features an 'Email notifications' toggle (ON).
- TRADEMARK ALERTS**: Lists recent alerts such as 'USPTO Enhances Deposit Account Transaction Security for Paper Fee Payments and Authorizations' and 'Trademark Alert: Webinar on Trademarks and Quality'. A 'Get alerts via email' button is present.
- USPTO FEES** (BETA): A section for fee management.
- FAVORITES**: A section for favorite items, currently empty.
- USPTO FEES** (BETA) sub-panel: Contains tabs for 'Patent', 'PCT', 'Trademark', and 'General'. Under 'Trademark', it lists 'Processing', 'Madrid Protocol', 'Service', and 'Fastener Quality Act'.

A blue-bordered box at the bottom center of the interface contains the text:

**Personalized homepage for managing IP portfolios**

**Access it at: <https://MY.uspto.gov>**

# Spotlight: TM Docket widgets



- 1 Track TM applications or registrations in one or more named "Collections"
- 2 Add/delete items from collections at any time
- 3 See status changes
- 4 Subscribe/unsubscribe to email updates

# Spotlight: TM Official Gazette widget

**Add a watch**

Add a watch to your Starbucks collection.

You can save the searches you routinely perform in the Trademark Official Gazette as watches.

Search by \*

Keyword or phrase

Save one search term at a time. For instance, if you want to search for the phrase "West Point", enter "West Point" in the search box. If you want to search for the words "West" and "Point" individually, enter "West" and "Point" in separate search boxes.

Filter by

FIELDS TO SEARCH

You must select at least one field to search.

☒ Mark literal(s)

☒ Current owner(s)

☒ Mark description

☒ Goods and services

☒ Additional statements

**TRADEMARK OFFICIAL GAZETTE WATCH**

ALPHA

Collection: Starbucks Manage collection

4 watches Issue: Mar 14, 2017

Coffee	123	⋮
Green star	0	⋮
mermaid	1	⋮
star	80	⋮

1

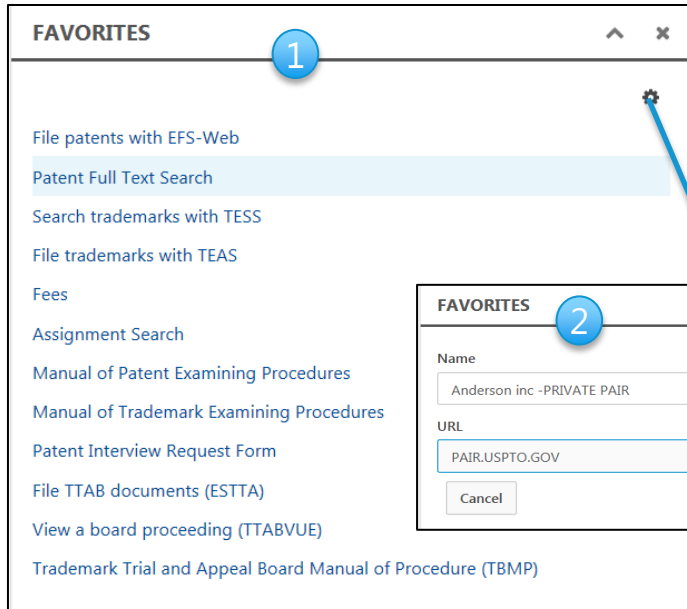
Save search queries ("Watch") in one or more named "Collections"

Add/delete watches from collections at any time

2

See search results of a search on the newest version of the OG

# Spotlight: Favorites widget



1

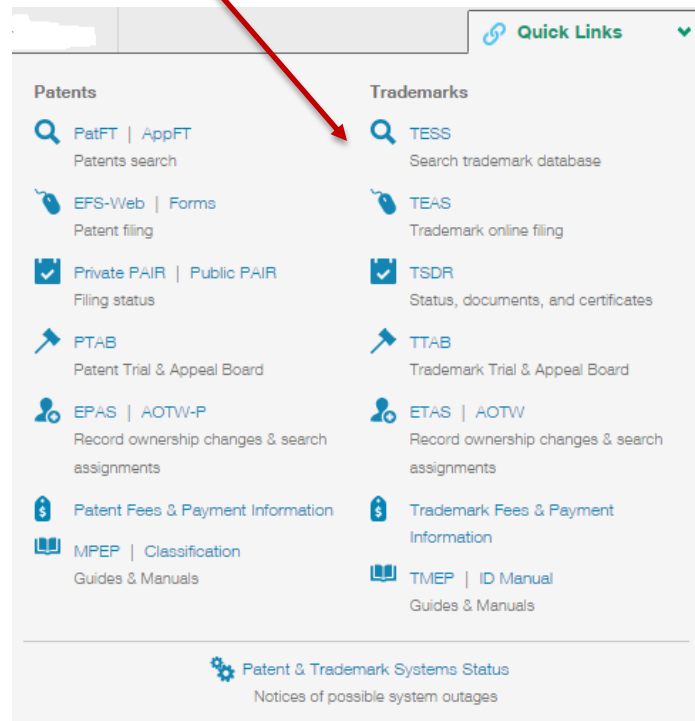
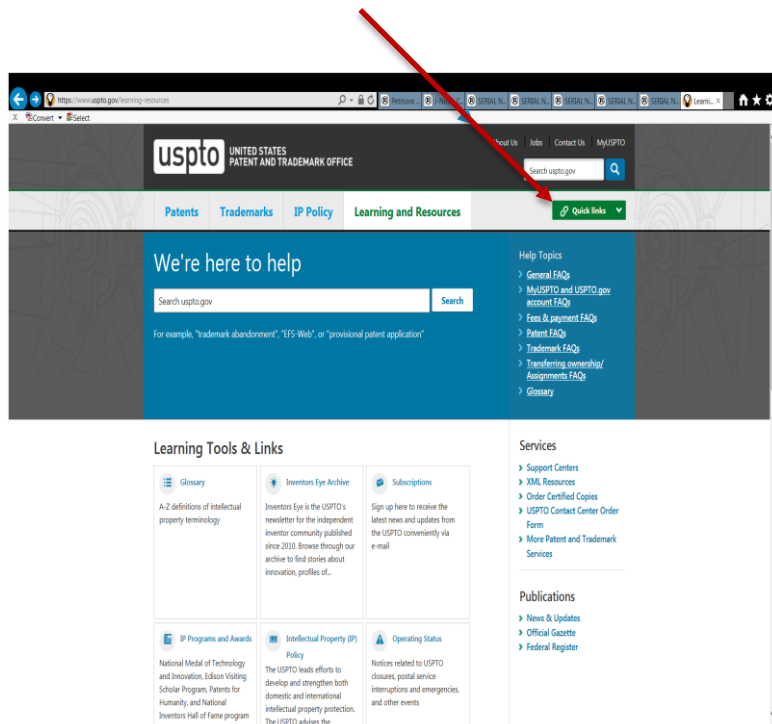
Get to bookmarked USPTO pages and systems with one click

2

Add/delete more bookmarks as needed

A screenshot of the 'FAVORITES' dialog box. It has a title bar with a close button (X) and a maximize button (^). Below the title bar are two input fields: 'Name' with the text 'Anderson inc -PRIVATE PAIR' and 'URL' with the text 'PAIR.USPTO.GOV'. There are 'Cancel' and 'Save' buttons at the bottom.

# Quick Links for Easy Navigation





# TM Alerts- stay informed!

The screenshot shows a web browser window with the URL <https://public.govdelivery.com/accounts/USPTO/subscriber/new>. The page header includes the USPTO logo and navigation links: About Us, Careers, and Contact Us. The main heading is "USPTO Subscription Center".

**Subscribe to our email newsletters or update your subscriptions**  
Provide your email address to get started with any of our newsletters or email alerts:

- USPTO Press Releases
- USPTO Director's Forum Blog
- USPTO Monthly Review
- FYI at the USPTO
- Inventors Eye
- Patents Alerts
- Trademarks Alerts
- Copyright Alerts
- Patent Trials and Appeal Board
- Intellectual Property for K-12 Educators
- USPTO Awards

Email address (required)

Your contact information is used to deliver requested updates or to access your subscriber preferences.

The footer contains the USPTO logo and the text "UNITED STATES PATENT AND TRADEMARK OFFICE". A large, semi-transparent "uspto" watermark is visible in the bottom right corner of the page.

# www.uspto.gov/blog/ebiz

The screenshot shows the USPTO Systems Status and Availability page. The header includes the USPTO logo, navigation links (About Us, Jobs, Contact Us, MyUSPTO), and a search bar. The main content area is titled "USPTO Systems Status and Availability" and includes a search box, RSS feeds, and links. The "Current Status" section indicates that there are no current events at this time. The "Planned Events" section lists multiple planned events, including Trademark Next Generation (TMNG) System Maintenance on Saturday, March 3, and Trademark Electronic Application System (TEAS) initial application forms not being available.

Home / About Us / USPTO Systems Status and Availability

**Search**

Search

**RSS Feeds**

- All
- /Current Status
- /Planned Events

**Links**

- [VIEW SYSTEM DESCRIPTIONS, OPERATING REQUIREMENTS, & HOURS](#)
- [TSDR and TESS System Usage](#)
- [View the current time at the USPTO in Alexandria, VA](#)

**Dec. 22nd, 2015 Outage Information**

[Past updates related to the outage](#)

## USPTO Systems Status and Availability

Check this page for the latest information on operating status and availability of Online Business Systems. For Standard Hours of Availability for Online Business Systems, System Descriptions, and Operating Requirements/Compatibilities, see the links at left.

### Current Status

Thursday Mar 01, 2018

There are no current events at this time.

There are no current events at this time.  
Posted at **05:40PM Mar 01, 2018** in Current Status |

### Planned Events

Friday Mar 02, 2018

#### Multiple Planned Events

#### Trademark Next Generation (TMNG) System Maintenance

The USPTO will perform maintenance on the Trademark TMNG systems beginning at 10 p.m., Saturday, March 3 and ending at 6 a.m., Sunday, March 4 ET.

The following systems will be impacted:

- **Trademark Electronic Application System (TEAS)** initial application forms will not be available.
- **Trademark Next Generation ID Manual (TMNG-IDM)** will not be available.
- **Trademark Official Gazette (TMOG)** will not be available. You can access recent PDF versions of the gazette on the [Trademark Official Gazette webpage](#). For archived PDF versions of gazettes dating back to 2001, visit the [archived editions page](#).
- **Trademark Status and Document Retrieval (TSDR)** will be available with reduced functionality.

# Resources

- Petitions Office, (517) 272-8950, staffed by a paralegal and a staff attorney on call M-F, 9am-5pm ET
- Trademark Electronic Application System (TEAS) mailbox, [TEAS@uspto.gov](mailto:TEAS@uspto.gov), staffed by technical analysts M-F, 8am-8pm ET
- Trademark Assistance Center, 800-786-9199, [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov), staffed by trademark specialists M-F, 8:30am- 8pm ET



# Thank you!

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*571-272-8278*

