



GOLAN | CHRISTIE | TAGLIA

YOUR SUCCESS. OUR FOCUS.

TRADEMARK CHALLENGES: SWORDS AND SHIELDS

MAY 16, 2024

**BEVERLY A. BERNEMAN
KIMBERLEE M. JONES
SARAH K. DUNKLEY
ANTHONY J. WENN**



Introduction to Trademarks and Trademark Protection

- Patents
- Copyrights

➤ Trademarks

- Trade Secrets





What Are Trademarks?

- Names
- Symbols
- Phrases
- Designs

McDonalds



Because You're Worth It





Acquiring Rights In Trademarks

- **Distinctiveness**
 - Fanciful
 - Arbitrary
 - Suggestive
 - Descriptive
 - Merely Descriptive
 - Capable of Secondary Meaning
- **Adoption and Use**
- **Registration**
- **Duration of Protection**



Trademark Trial and Appeal Board

- Administrative Body that Handles Trademark Disputes
 - Appeals from decisions by the USPTO
 - Opposition to Registration
 - Cancellation of Registered Marks
- The TTAB does not handle
 - Infringement claims
 - Unfair competition claims
 - An award of money damages
 - An award of attorneys' fees



Ex Parte Proceedings

Any person can file a submission or petition requesting the USPTO to institute a proceeding to cancel an application or registration of a mark in whole or in part.

FOR

➤ APPLICATIONS

- Letters of Protest

FOR

➤ REGISTRATIONS

New under the

Trademark Modernization Act

In effect as of December 18, 2020

- Expungement
- Reexamination



Ex Parte Challenge to Applications

➤ LETTERS OF PROTEST (37 CFR §2.149)

- What is a Letter of Protest? Why file?
- When to file?
- Appropriate grounds (ruled by TMEP 1715.01)
- Evidence to Include
- Where to file? Is there a fee?
- Outcome



Ex Parte Challenge to Registrations

EXPUNGEMENT

(37 CFR § 2.91 – §2.98)

- Eligible registrations
- When to file?
- Who can file?
- How to File?
- What to include?
 - Must establish a prima facie case
 - Director's decision is final and non-reviewable

REEXAMINATION

(37 CFR § 2.91 – §2.98)

- Relevant Date
- When to file?
- Who can file?
- How to File?
- What to Include
 - Must establish a prima facie case
 - Director's decision is final and non-reviewable



Ex Parte Submission Tips

- Document your searches — provide screenshots, search strategies, multiple sources of nonuse
- Submit relevant, effective evidence — no data dumps and identify the relevant goods or services to which it pertains
- Use of Trademark registrations — provide use specific and relevant documents; screenshots of TSDR screens do not suffice



Cease & desist letters

- Why send a cease & desist letter?
- What do they look like? What to include?
- What to do if you receive one?
- Be wary of trademark trolls!
- “The Upside Down” of cease & desist letters





"Danny and Doug,

My walkie talkie is busted so I had to write this note instead. I heard you launched a Stranger Things pop-up bar at your Logan Square location. Look, I don't want you to think I'm a total wastoid, and I love how much you guys love the show. (Just wait until you see Season 2!) But unless I'm living in the Upside Down, I don't think we did a deal with you for this pop-up. You're obviously creative types, so I'm sure you can appreciate that it's important to us to have a say in how our fans encounter the worlds we build.

We're not going to go full Dr. Brenner on you, but we ask that you please (1) not extend the pop-up beyond its 6 week run ending in September, and (2) reach out to us for permission if you plan to do something like this again. Let me know as soon as possible that you agree to these requests.

We love our fans more than anything, but you should know the Demogorgon is not always as forgiving. So please don't make us call your mom."



Office Actions

➤ What is an Office Action?

- Other Types: Examiner's Amendment, Priority Action, Suspension letter or Inquiry, Notice of incomplete response

➤ Requirements vs Refusals

➤ How to Resolve?

➤ Time to Respond

➤ Non-Final vs Final

- Second refusal → Same Grounds → Final → Appeal

➤ Avoid Abandonment



Appeals / Petitions / Requests for Reconsideration

- Upon receipt of any final substantive refusal to register by an examining attorney, an applicant can file:
 - A Request for Reconsideration
 - An Appeal to the TTAB (Trademark Trial and Appeal Board) upon payment of the fee

- Upon Receipt of a final action, no substantive issues, but maintains any outstanding requirement, an applicant can file:
 - A Request for Reconsideration
 - An appeal to the TTAB with payment of fees
 - A petition to the Director under §2.146 to review the requirement, and if procedural then appropriate for petition

- Filing a Request for Reconsideration Only: Caution



FILING APPEALS AND PETITIONS

FILING AN APPEAL	FILING A PETITION
WHAT TO FILE?	WHAT TO FILE?
HOW TO FILE? <ul style="list-style-type: none">- PROCEDURAL REQUIREMENTS (§2.126)- EVIDENTIARY REQUIREMENTS	HOW TO FILE?
WHEN TO FILE?	WHEN TO FILE?
Oral Hearing?	ORAL HEARINGS?
DURING REVIEW, NEW GROUNDS FOR REFUSAL?	EXISTING DEADLINE AFFECTS?
TTAB DECISIONS ARE FINAL UNLESS: <ul style="list-style-type: none">- FILING A DISCLAIMER OR- BY ORDER OF THE DIRECTOR	DENIED PETITION?



TTAB Proceedings: Oppositions

- Publication for Opposition
- Basis for Opposition
- Time frame to file an Opposition
- Proceeding:
 - Notice of Opposition
 - Answer
 - Discovery
 - Dispositive Motions
 - Trial Phase
 - Decision
 - Post Trial Proceedings
 - Appeal



TTAB Proceedings: Cancellation

- **What is it?** The opportunity to attack and ultimately cancel a parties' trademark rights.
- **Purpose:** to allow a new trademark applicant to register a trademark which would otherwise be owned by a different party.
- **How is it different from an opposition proceeding?**
 - It happens after a trademark has been registered with the relevant trademark office.
 - Any interested party can petition for the cancellation or invalidation of an existing trademark registration. This includes a competitor or the public.
 - Basis for cancellation can include: 1) non-use of the trademark; 2) abandonment; 3) fraud in the application process; 4) genericness; 5) or other factors that render the trademark registration invalid.
 - Cancellation proceedings seek to remove the registered trademark from the official registry.
- **Damages:** there are no damages in a TTAB cancellation proceeding. It is strictly concerned with stripping a party of their trademark rights.



***Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999)**

- Appealed in *Pro-Football, Inc. v. Harjo*, Civil Action No. 99-1385 (CKK), 3 (D.D.C. 2003)





What We Need



Photo by CoWomen on Unsplash



GOLAN | CHRISTIE | TAGLIA

YOUR SUCCESS. OUR FOCUS.

Questions/Discussion



Photo by Jamie Street on Unsplash



Beverly A. Berneman
BABerneman@gct.law
312.696.1221



Sarah K. Dunkley
SKDunkley@gct.law
312.696.1365



Kimberlee M. Jones
KMJones@gct.law
312.696.1369



Anthony J. Wenn
AJWenn@gct.law
312.696.1368