



Trademark Advisory

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Trademark Letters of Protest: No Need to Wait, Protest Now!

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If you or your company own any trademarks or service marks, you may discover one day that a competitor has applied to register a confusingly similar mark, is seeking registration of a generic or descriptive word, or is attempting to register a term of art for goods or services that are the subject of your business. When this happens, you may feel that your hands are tied and the only option is to wait until the mark is published for opposition in order to take action and file a Notice of Opposition with the U.S. Trademark Trial and Appeal Board. While filing a Notice of Opposition can be an effective solution, it can also be costly and time consuming. Rather than waiting until the post-examination opposition period, another available option is to consider filing a Letter of Protest (LOP) with the United States Patent and Trademark Office (USPTO).

What Is an LOP?

An LOP is a letter to the USPTO requesting that the attorney in charge of reviewing and approving a specific trademark application (the examining attorney) be advised of certain information and evidence when considering the merits of a party's application.¹ Evidence relied upon by the "protesting" party must be included with the letter. If the USPTO grants the LOP, the evidence provided by the protestor (and not the cover letter itself) will be forwarded to the examining attorney for consideration in conjunction with the subject application. It is then up to the examining attorney to consider the protestor's evidence and make a determination whether to issue a refusal of the mark or an office action setting forth an additional requirement.

A party may file an LOP citing any basis for rejection generally available to the examining attorney under the established *ex parte* rules (as opposed to the different grounds generally available to third parties when filing an opposition or cancellation petition). The grounds most typically cited in LOPs are as follows:

- A likelihood of confusion between the new mark and the mark in the protestor's earlier-filed application or registration
- The descriptiveness of the proposed mark
- That the proposed mark is generic
- Pending litigation involving the mark that would adversely affect its registrability.

After choosing the proper basis for the LOP, the protesting party must then compile the evidence it believes best supports its ground for objecting to the registration of the mark. As you would suspect, the more factual and objective the evidence is, the more likely it is that the USPTO will grant the LOP. Conjecture, arguments, and conclusory statements will rarely, if ever, be sufficient for granting an LOP

and may be more suitable for formal opposition and cancellation proceedings.

Timing Is Everything

As with many things in life, timing is everything. If filing an LOP against another party's trademark or service mark application interests you, you should make every effort to file it *before* the subject mark is published for opposition purposes. By doing so, it is much more likely to be granted and the supporting evidence forwarded to the examining attorney for consideration in conjunction with the subject application. This is because the primary purpose of the LOP is to assist the USPTO in examining an application without causing undue delay or compromising the integrity and objectivity of the application examining process.² Once that examination has occurred, stopping the registration process and re-examining the subject application could generally cause undue delay and expense.

This preference for pre-publication LOPs manifests itself in the standard of review that the USPTO uses to review appeals from its decisions regarding whether or not to grant an LOP. The USPTO will uphold a decision to grant an LOP filed *before* publication if the evidence submitted by the protestor is simply "relevant" and supports any reasonable ground for denying registration. Any LOP that presents only adversarial arguments and not evidence will be denied.

If circumstances prevent you from filing an LOP before the publication of the mark, you can still file one if you do so within thirty (30) days after the publication date of the mark. An LOP that is filed after that date will likely be denied as untimely. Also, it should be noted that the USPTO's standard of review for post-publication LOPs is much more stringent than for pre-publication LOPs. Whereas a pre-publication LOP must simply include "relevant" evidence, a post-publication LOP must include evidence to support a *prima facie* case for refusal, thus demonstrating that publication of the mark, without considering the issue and evidence presented in the LOP, was a "clear error" by the USPTO.

Studies have shown that the different standards used by the USPTO when examining LOPs have a direct impact on a protestor's chance of success. LOPs filed pre-publication are granted at a much higher rate than LOPs filed post-publication. Moreover, LOPs that address the issue of a likelihood of confusion (the most popular ground for objection) are more likely to be approved if they are filed before the issuance of a first office action (i.e., before the examining attorney has even substantively reviewed the application).

How Can I File a Timely LOP?

Since life is hectic, you're probably wondering how you can possibly monitor new trademark application filings that are confusingly similar to your mark so that you will have enough notice to timely prepare and file an LOP. Fortunately, there are companies that specialize in monitoring trademark applications filed with the USPTO and forwarding the details to you. Some of the more reputable "trademark watch service" companies can do this for you at a reasonable cost.

Once you subscribe to the service, the watch company will closely monitor new application filings and the publication of marks by the USPTO and alert you to potentially conflicting trademark applications by giving you a summary of the relevant details, i.e., a clipping of the mark, the applicant's name, the application serial number, the goods and services identified in an application, and the deadline to oppose the application, if available. This early warning system will help you keep track of competitors and potential competition and allow you to evaluate whether to file an LOP with the USPTO or a Notice of Opposition with the USPTO's Trademark Trial and Appeal Board by the respective deadlines.

When used in conjunction with one another, trademark watch services and LOPs can help you protect your trademarks or service marks against infringement and dilution. These tools are a cost-effective way for alerting the USPTO about issues pertaining to the mark's registration and may eliminate the need to participate in a costly and time-consuming opposition proceeding. Filing an LOP can often trigger an examining attorney to consider an issue and deny registration of the mark on substantive grounds. This refusal can be the impetus for an applicant to simply abandon its application, which will

give you, the trademark owner, a great sense of satisfaction.

It is by effectively employing tools, such as LOPs, that Mintz Levin can help you grow and keep your IP portfolio protected and competitive. If you are interested in filing an LOP against another party's U.S. trademark application or implementing a trademark watch service, please contact any of our qualified trademark attorneys who will be happy to assist you.

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Click here to view Mintz Levin's Trademark attorneys.

Endnotes

- 1 Trademark Manual of Examining Procedure § 1715.
 - 2 See, *In re BPJ Enterprises, Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988); *In re Pohn*, 3 USPQ2d 1700 (Comm'r Pats. 1987).
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