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[Wanted: Experienced Trademark Attorney?](#)

Posted on September 5, 2010 by [Steve Baird](#)

[A couple of days ago](#), I promised to try and make the case for why the State of Minnesota ought to hire an experienced trademark attorney.

OK, so I'm a day late, but you can decide if I'm a dollar short too. By the way, it was the federal trademark registration record for the below mark that got me thinking about the need:



As it turns out, the State of Minnesota uses the Minnesota Attorney General's Office to register various trademarks owned by various Minnesota State entities, including the Minnesota State Agricultural Society, owner of the federal service mark registration for the above MINNESOTA STATE FAIR service mark.

One little problem with the federally-registered mark. The prosecution history for the registration discloses that the assigned Examining Attorney at the United States Patent and Trademark Office (PTO) required a disclaimer of the descriptive wording "Minnesota State Fair":

Applicant must disclaim the descriptive wording "MINNESOTA STATE FAIR" apart from the mark as shown because it merely describes the feature of the identified services. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).



The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A “disclaimer” is thus a written statement that an applicant adds to the application record that states that applicant does not have exclusive rights, separate and apart from the entire mark, to particular wording and/or to a design aspect. The appearance of the applied-for mark does not change.

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “MINNESOTA STATE FAIR” apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm’r Pats. 1983).

PTO Examining Attorneys will have a tendency to do that, and the Attorney General's Office respectfully complied with the well-supported request. What the PTO's Examining Attorney didn't volunteer (and they can have a tendency to do that too) -- even to the Minnesota Attorney General's Office -- is that a registration disclaimer could have been avoided by submitting a declaration claiming acquired distinctiveness in those words, which, according to the application, have been in use in that specific format since at least as early as January 1, 1981.

Moreover, [Wikipedia reports](#) that the Minnesota State Fair has been in existence since 1859 (missing only five years during that entire period of time), so exclusive rights in the words "Minnesota State Fair" easily could have been claimed under Section 2(f) of the Lanham Act, by way of acquired distinctiveness, long before the current stylized use in 1981.

As it currently stands, there are no federally-registered rights in the words "Minnesota State Fair," only the specific graphic depiction and artwork set forth above (without any limitations as to color) is covered by a federal registration, with exclusive rights in the words having been specifically disclaimed.

Had a simple declaration been put in the record during prosecution to support that the words "Minnesota State Fair" have been in "continuous" and "substantially exclusive" use for at least the five years immediately preceding the claim of acquired distinctiveness, the registration obtained also could carry the benefit of constituting *prima facie* evidence of the validity and registrant's exclusive rights in the entire mark, including the words. Moreover, upon incontestability, these federally-registered rights eventually could become *conclusive*, not just *prima facie* valid.



So, the point of the story is not to pick on the Attorney General's Office of the State of Minnesota, whose attorneys have far better things to do than worry about all the many nuances of federal trademark law. Besides, the point is, this kind of thing happens all the time, even in the commercial business world, when trademark registration and prosecution activities are conducted by those who don't do it day in and day out.



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