

Most trademark law casebooks focus on legal doctrine without paying much attention to the guidelines, rules, and procedures for practicing before the United States Patent and Trademark Office (USPTO). This book combines theory and practice into one text. With a detailed overview of non-litigation trademark doctrine and relevant practical applications, it provides a foundational text for students studying substantive law as well as a guidebook for practicing before the USPTO.

The primary focus of this book is how to enhance trademark rights through federal registration. We discuss the process for registering a trademark with the U.S. government with occasional reference to common law use where necessary to draw distinctions between the benefit of federal registration.

The book also reprints selected sections of the Trademark Manual of Examining Procedure (TMEP), which is used by the USPTO to examine applications seeking federal registration of trademarks, as well as to facilitate learning and application of USPTO Rules and Guidelines.

To obtain an in-depth understanding of the requirements for practicing before the USPTO, an instructor may want to use this book in conjunction with or as a supplement to the TMEP.

In addition to relevant case law analysis that demonstrates law principles and how the rules of practice are applied, this book includes “Legal Practice Notes” that highlight key case law doctrines; “Test Your Knowledge” questions; and “Application” exercises that give students the opportunity to apply the law, rules, and guidelines to hypothetical problems.

### ***HYPOTHETICAL***

To better understand how the book’s structure has been laid out to allow a logical progression from theory to practice, the following hypothetical demonstrates the book’s organization.

Jewel, an apparel manufacturer, conceived of the mark “DIVA DIGS” for a new line of athletic wear. The clothing line is slated to include leggings, stretch pants, shorts, t-shirts, camisoles, blouses, shirts, and jackets. On May 16, 2021, after screening several possible titles for its new line, the company adopted the mark “DIVA DIGS.”

How would Jewel protect its investment in the trademark “DIVA DIGS”?

The following process map lays out a typical procedure:

**Step 1: Understand the law**

What is a trademark? (see Chapter 1)

Understand the function of a trademark (see Chapter 2)

Establishing rights in a trademark (see Chapter 3)

**Step 2: Conduct a preliminary assessment of the mark for compliance with §2 of the Trademark Act**

Determine the strength of the mark: The mark “DIVA DIGS” would fall on the arbitrary portion of the spectrum because the words “DIVA” and “DIGS” are existing terms that are being used in an arbitrary context (see Chapter 2)

Assess the mark under Trademark §§2(a), 2(b), 2(c)

- Section 2(a): The mark “DIVA DIGS” does not comprise any immoral, deceptive, or scandalous matter. It does not consist of information that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits.
- Section 2(b): The mark does not consist of or comprise the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof (see Chapter 12).
- Section 2(c): The mark does not consist of or comprise a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow (see Chapters 2, 12)

Assess the mark under Trademark §2(e): The mark is not descriptive of the goods, as it does not describe a feature, function, purpose, quality, use, ingredient, etc. associated with the goods (see Chapter 2)

Assess the meaning of the mark in translation or for colloquial use: The mark “DIVA DIGS” is not comprised of any foreign terms, and, therefore, does not include a translation that describes features of the goods (see Chapter 2)

If the mark is being used, evaluate the mark for proper use: In the proposed hypothetical, the company has not begun use of the mark in commerce, but it has a bona fide intent to use the mark in commerce (see Chapter 3)

Determine if the mark will be used in commerce regulated by Congress: The company plans to use the “DIVA DIGS” mark in commerce between one or more states and on the internet. This is the type of commerce regulated by Congress (see Chapter 3)

Review any specimens of use for marks in use for compliance with USPTO regulations (see Chapter 4): Since the application will be based on an intent to use the mark in commerce, no specimen is needed at the time of filing. However, at some point prior to registration, the applicant will need to file

an Amendment to Allege Use (Chapter 14)\* or a Statement of Use (Chapter 14)\* that includes a specimen show how the mark is used in commerce. For use-based applications, specimens must be filed at the time of filing.

**Step 3: Conduct a search**

At a minimum a search of the USPTO database should be conducted and found marks assessed to determine the risks associated with the use and registration of the proposed mark (see Chapter 5)

**Step 4: Commission full search, if necessary**

If a client decides to go forward after a knock-out search, recommend conducting a full search by searching various databases designed to provide a broader assessment of the trademarks in use or for which registration has been granted. Alternatively, recommend using a professional search company to conduct a “full” U.S. or other territorial search as needed (see Chapter 5)

**Step 5: Evaluate the results of the full search**

The results of the trademark search should be reviewed to determine the risks associated with the registration and use of the proposed mark. The assessment should consider whether the proposed mark raises a potential for likelihood of confusion in view of other marks used for similar or related goods or services. This assessment will most likely be based on the references found during the trademark search of the USPTO database, as well as third-party use of unregistered marks in the marketplace. This assessment implicates §2(d) of the Trademark Acts 15 U.S.C. §1052(d) of the Trademark Act (see Chapter 6)

**Step 6: Prepare a written opinion of findings (optional)**

In many cases, a written opinion setting forth the likelihood of confusion analysis is prepared for the client. Clients may rely on the written opinion as proof that it did not willfully infringe another’s trademark, provided the analysis is sound and well-reasoned (see Chapter 6)

**Step 7: If the mark clears the full search, prepare registration application**

An intent to use application may be filed if the client has not used the mark in commerce but has a bona fide intent to use the mark in commerce, which can be supported by documents such as a business plan, marketing materials, market research, etc., showing how the proposed mark would be used (see Chapter 14)\*

Use-based applications may be filed if the client has begun use of the mark in a type of commerce regulated by Congress or in a manner that impacts Congressionally regulated commerce (see Chapter 14)\*

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\* In light of the USPTO’s recent announcement regarding the retirement of the Trademark Electronic Application System (TEAS) for filing trademark applications, we will provide a supplementary update that outlines the trademark application filing process under the new Trademark Center.

**Step 8: Responding to refusals to register**

Nonsubstantive refusals (see Chapter 7)

Failure to function (see Chapter 7)

Likelihood of Confusion (see Chapter 8)

Descriptiveness under

Section 2(e) (1) and 2(f) (see Chapter 10)

Section 2(e) (2–4) (see Chapter 11)

Section 2(e) (5) (see Chapter 11)

Section 2(a–c) (see Chapter 12 – supplemental chapter provided online)

Trademark Modernization Act Procedures (see Chapter 13—supplemental chapter provided online)

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