

Trademarks & Docketing

**Why are those dates even
important?**

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ATTORNEYS AT LAW

What is a trademark?

- **One judge long ago: Isn't that something that you get in Washington?**
- **Statutory definition (paraphrased): Any feature that acts to identify and distinguish your goods or services from the goods or services of others**
- **What does that mean?**

Preliminary Clarification: Two Systems

- **Common law / Use-based systems**
e.g. UK; United States; Canada
- **First-To-File Systems**
e.g. China, Much of Europe
- **The immediately following remarks relate to a use-based jurisdiction**

A Little History

- **Trademark law was arguably the first consumer protection law.**
- **A merchant “marked” wares so that consumers could know that the product bearing that mark was genuine and of the expected quality.**
- **Protection of that “mark” avoided confusion of consumers who knew of the mark and the usual quality.**

A Trademark Is Goodwill

- **Consumer recognition, consumer acceptance, consumer awareness**
- **Has to exist for there to be even a possibility of confusion**
- **In turn, there has to be some use to consumers before any consumer awareness (consumer goodwill) can exist**

Use Based System

- **The first to adopt and use a protectable mark owns the mark in the geographical area of use.**
- **To protect consumer expectations, prior (and continuous) use often “trumps” a later registration.**
- **So why waste money on a registration?**

Problems Of A Pure Use-Based System

- Each entity that adopts a mark in “good faith” in geographically remote area from the area of use by another of the same or a similar mark owns the mark in that area
- Multiple owners of the same or similar mark across the country (Think “First National.”)
- What is “good faith?”

Registration System (United States)

- **Provide A System For Nationwide Uniformity and Predictability**
- **Provide A "Notice" System Regarding Claims of Rights**
- **Rights Are Not Created By The Registration - - The Registration Is Evidence Of Existing Rights And Creates Presumptions**

Registration Advantages (United States)

- **Constructive Notice of registrant's claim of rights upon issuance of registration (i.e. no later territorial "good faith" adoption) 15 USC §1072**
- **Constructive nationwide use as of filing date if registration issues. 15 USC §1057(b)**

Registration Advantages

- Registration is *prima facie evidence* of (i) the validity of the registered mark and of the registration of the mark, (ii) the owner's ownership of the mark, and (iii) the owner's exclusive right to use the registered mark on or in connection with the goods or services specified in the certificate. 15 USC §1057(b)

Registration Advantages

- **If the registered mark is “incontestable,” the presumptions become “conclusive” (subject to certain defenses) rather than prima facie. 15 USC §§1065 and 1115(b).**
- **Potential for enhanced monetary relief. 15 USC §1117.**

Registration Advantages

- **However, a registration does not cut off valid pre-existing common law rights. See, e.g., 15 USC §§1065 and 1115(b)(5).**

Intent-To-Use Why Have It?

- **Situations in which implementation of use takes time**
- **Businesses Under Construction (e.g. Hotels)**
- **Products Under Development**
- **Drugs and other products seeking government clearance**

Trademarks Can Be Forever

- **Unlike patents and copyrights which, under the Constitution, must be for a “limited time,” goodwill can endure forever if the mark remains in use.**
- **Not a “monopoly” - - only protected against likely confusion if protectable at all.**
- **So what dates should be docketed?**

Some Relevant Dates United States

- **Declaration of Continued Use – Within the year prior to the sixth anniversary of the issuance of the registration, with a six month grace period upon payment of fee. 15 USC §§1058(a)(1) and (a)(3).**
- **Clear the Deadwood with regard to businesses that fail in the first five years.**

Some Relevant Dates

- **Declaration of Continued Use (Renewal) – Within the year prior to the tenth anniversary, and then within the year prior to each succeeding ten year anniversary. 15 USC §1058(a)(2)**
- **Six month grace period upon payment of fee 15 USC §1058(a)(3)**

Some Relevant Dates

- **Incontestability – After the fifth anniversary of the registration provided that the mark has been in continuous use and the other conditions of 15 USC §1065 are met.**
- **Cancellation – Before the fifth anniversary 15 USC §1064 except on grounds specified in 15 USC §1064(3) for which there is no time limitation.**

Some Relevant Dates

- **Opposition – Within thirty (30) days after publication, with extensions available (if timely and properly requested) as provided by statute and regulations. 15 USC §1063**
- **Response to Office Action – six months from date of mailing of office action**

Some Relevant Dates

- **Statement of Use – Six months after issuance of Notice of Allowance, with possibility of up to five six month extensions if properly requested and fees are paid. 15 USC §1051(d).**
- **Statute Of Limitations – None, but courts may consider applicable state statute of limitations for certain purposes when considering laches**

Some Relevant Dates

- **See the regulations (37 C.F.R.), the Trademark Manual of Examining Procedure (TMEP), and the Trademark Trial and Appeal Board Manual of Procedure (TBMP) for other deadlines, especially deadlines relating to appeals, inter partes proceedings, and ex parte proceedings.(e.g. application revival)**

First To File Jurisdictions

- **The first to file and obtain a registration owns the mark for the listed goods/services in the jurisdiction.**
- **Cottage industry of pirates in some jurisdictions**
- **Law varies from jurisdiction to jurisdiction**

First To File Jurisdictions

- **Some jurisdictions protect marks that became “famous” or “well-known” before the filing of an application for an infringing mark**
- **Generally, registrations in first-to-file countries can be cancelled for non-use for a prescribed period of time**
- **According, docket at least the use deadline and renewal deadline.**

First To File Jurisdictions

- **Some countries protect against applications filed in bad faith.**
- **Investigate, retain and rely upon competent local counsel who is authorized to practice in the given jurisdiction - - do not assume that it is like the United States**

Trademark Docketing Systems

- **Many Excellent Options Available**
- **Should have a database that covers all relevant countries of the world with forms with fields that automatically fill in the relevant deadlines**
- **Should provide timely updates that are responsive to changes in the laws**

Trademarks and Docketing

- **Questions?**
- **Thank you!**
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