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The Letter of Protest: An Underutilized Enforcement Tool

DOCUMENT OFFERS ADDITIONAL WAY TO EXPRESS OPPOSITION TO TRADEMARK

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A Letter of Protest is an informal tool that allows third parties an opportunity to submit evidence to the Office of the Deputy Commissioner of the U.S. Patent and Trademark Office regarding the registrability of a trademark or service mark (hereinafter collectively “trademark”). The Letter of Protest is a succinct recitation of the facts with supporting evidence citing the basis upon which a trademark should not be registered. Appropriate bases of protest include genericness, descriptiveness, likelihood of confusion with a federally registered trademark or prior-pending application therefor, and the suspension of prosecution of a trademark because of a pending claim of infringement based on the use of the applied-for trademark.

Stacy Stewart, counsel to the Hartford office of Cantor Colburn, concentrates her practice in the areas of trademark and copyright counseling and litigation. She represents brand owners across a broad spectrum of industries including entertainment, intimate apparel, consumer products and social media. She frequently prosecutes trademark applications before the U.S. Patent and Trademark Office.

The Letter of Protest can be as effective as filing an opposition. The standard of review for a Letter of Protest is a “relevance” standard. Upon receiving the Letter of Protest, the Deputy Commissioner reviews it and any supporting evidence to determine whether the evidence is relevant and supports an appropriate ground for refusal. If so, jurisdiction is restored to the examining attorney, who reviews the evidence, and may issue a refusal based upon the evidence provided. If the applicant is unable to overcome the examining attorney’s refusal, then, in essence, the Letter of Protest would produce the same result as a formal and successful opposition.

The Letter of Protest is not a substitute to filing an opposition. Common law trademark owners who do not have a federal registration or previously-filed trademark application cannot successfully use the Letter of Protest as an enforcement tool. The common law trademark owner will



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have to utilize the opposition proceeding to contest the registrability of a trademark. In addition to common law trademarks, the Letter of Protest is not appropriate to contest ownership of a trademark, or to allege fraud in the application.

How To Draft

When drafting a Letter of Protest, one should be direct, succinct and respectful. Evidence supporting the ground(s) of refusal is critical as a Letter of Protest void of supporting relevant evidence will be denied. Addressed to the Office of the Deputy Commissioner, it should be titled “Letter of Protest” and should identify the trademark application being challenged and the grounds of the challenge.

Next, if a likelihood of confusion is the basis for the Letter of Protest, the registration or prior-pending application that creates “standing” to file such a Letter of Protest should be stated. It is satisfactory to cite the registration or serial number in identifying the registration or prior-pending application and provide some context of the continued use of the mark in commerce, the strength of the mark, and the value of the mark to the protestor.

The nature of grounds for objection should be a direct and concise statement. For example, “The ground for objection

is Likelihood of Confusion.” A brief argument as to why the applied-for trademark will cause confusion, is generic, or is descriptive should follow. The Letter of Protest should not be drafted as a brief. The examining attorney will not have an opportunity to review the Letter of Protest and the arguments submitted therein. The role of the arguments in the Letter of Protest is to provide the Deputy Commissioner with sufficient relevant evidence to support the ground(s) of refusal. While the Letter of Protest will not become a part of the official record, a memorandum from the Deputy Commissioner to the examining attorney stating that the Letter of Protest has been granted and all relevant evidence submitted by the protestor, will become a part of the official record.

In circumstances where likelihood of confusion is being alleged, citing the registration or serial number is sufficient when the goods and/or services are identical. In instances where the goods and/or services are not identical, but related, evidence of relatedness is allowed. On the other hand, copies of registration certificates versus search reports or a list of registrations are appropriate when evidence is submitted to allege that the applied-for trademark is descriptive or generic.

When To File

When to file a Letter of Protest is an extremely important decision. If the examining attorney's first refusal fails to mention the protestor's registration or earlier-filed application, then a Letter of Protest should be immediately filed. The Letter of Protest can be filed before publication or after publication of the applied-for trademark. Also, there is no requirement that the examining attorney take first action before the Deputy Commissioner can consider, review and

grant a Letter of Protest. As a pre-emptive strike mechanism, the Letter of Protest, if granted and a refusal subsequently issued can prevent the registration of a trademark if the applicant is unable to provide sufficient arguments to overcome the refusal.

The Letter of Protest is a succinct recitation of the facts with supporting evidence citing the basis upon which a trademark should not be registered.

Prior to publication, the examining attorney, however, is not required to issue a refusal based on the Deputy Commissioner's acceptance of a Letter of Protest. The examining attorney is required to make an independent determination as to whether the evidence provided is relevant to the registrability of the applied-for trademark. Letters of Protest submitted before publication, but reviewed after publication, are reviewed under the pre-publication standard. The examining attorney, as in pre-publication reviews, is not required to issue a refusal but must consult with his superior as to whether a refusal is warranted.

To minimize delays and increase the likelihood of acceptance, the Letter of Protest should be filed within the first three months from the date of issuance of the office action, if the protestor's grounds of refusal are not provided for in the office action. If filing the Letter of Protest is delayed more than 30 days after publication, the Letter of Protest will be denied as untimely because it may unduly delay the registration process. An extension of the

opposition period should be requested as a post-publication Letter of Protest does not stay or automatically extend the opposition period.

How To File

The Letter of Protest can be filed electronically through a form in the Trademark Electronic Application System. The Letter of Protest can also be faxed to the attention of the Deputy Commissioner for Trademark Examination Policy. If the Letter of Protest includes a substantial volume of evidence, it can be submitted in writing via first class mail to the attention of the Deputy Commissioner for Trademark Examination Policy.

It is inappropriate to contact directly, either in writing or orally, the examining attorney assigned to review the applied-for application. Any contact with the examining attorney initiated by the protestor will violate and compromise the integrity of the ex parte examination procedure.

Cost To File

At a time where corporations are seeking to reduce costs and expenses, the value of the Letter of Protest mechanism is underscored by the fact that there are no official USPTO fees associated with filing the Letter of Protest. The Letter of Protest, if granted and if the applicant is unable to overcome the refusal, can have the same effect as an opposition and can potentially save the client tens of thousands of dollars. It is therefore worth placing the Letter of Protest in the trademark enforcement toolbox. ■