

PRACTICE UPDATE FOR U.S. TRADEMARK APPLICATIONS AND REGISTRATIONS

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In the last 1-1/2 years, U.S. trademark practice has changed substantially. In October 1999, the Trademark Law Treaty Implementation Act (TLTIA) took effect. It changed a number of rules relating to filing and maintaining trademark applications and registrations. Many of those changes were a necessary precursor to an expansion of electronic filing of trademark - related documents in the PTO. As a result of these changes, and expanded PTO electronic capabilities, electronic filing of trademark applications has expanded dramatically. The information available from the PTO also has expanded dramatically as more resources are made available through the PTO website at <http://www.uspto.gov>.

This article looks at the changes brought about by TLTIA, and then discusses some of the current resources available thanks to the expanded electronic capabilities of the PTO.

FILING DATE REQUIREMENTS

With TLTIA, for the first time in many years, the basic requirements for obtaining a filing date for a trademark application were changed - and reduced - significantly. Prior to TLTIA, elements such as a signature by the applicant, a description of the basis for registration (e.g., intent to use, use in commerce, etc.), specimens if it was a use based application, and a certified copy of the foreign registration if it was a Section 44(e) application, were essential requirements for filing the application. If an essential filing date element was missing, the application would be refused a filing date. As a result of the TLTIA amendments, the

requirements for obtaining a *filing date* for a trademark application were limited to the following:

- (1) Name of the applicant;
- (2) Name and address for correspondence;
- (3) Clear drawing of the mark;
- (4) Listing of the goods and services; and
- (5) Filing fee for at least one class of goods or services.

The relaxation of the filing date requirements, particularly the omission of the requirement for a signature on the application, has made it easier to get an application on file so that the earliest possible filing date is obtained. It also has facilitated the electronic filing of trademark applications.

With the reduced filing date requirements, a simple word-mark application that has only the basic elements can now be prepared and filed electronically in a matter of minutes, with the filing receipt and a serial number sent by return E-mail almost immediately after filing in most instances. (Design mark applications or applications that elect to include specimens or a signature may take a little longer because the designs, specimens, and signatures have to be scanned.)

The changes in the rules do not eliminate most of the elements that previously were filing date requirements -- they simply enable one to submit that information later during the prosecution. Thus, for example, if an unsigned application is filed, a signed declaration still has to be filed later in the prosecution. Specimens for a “use-based” application also have to be submitted, with a declaration attesting that they were in use in commerce regulated by the U.S.

Congress at the time the application was filed, and certified copies of foreign registrations have to be submitted at some point during prosecution. Likewise, for intent to use and Section 44 (foreign based) applications, a verified statement that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application still must be filed. Therefore, to avoid additional prosecution costs later in the application process, whenever possible, complete information should be submitted with the original application.

PRACTICAL ASPECTS OF SOME TLTIA CHANGES

a. Changes in Signature Rules

The change in the rule to permit unsigned applications facilitates early filing of an application. However, the TLTIA changes in signature rules did not stop at allowing unsigned applications. TLTIA also expanded the class of persons who may sign application documents, including applications, statements of use and extensions of time, to include not only individual applicants and officers of corporate applicants, but persons with actual or implied authority to act on behalf of the applicant, or an attorney who has actual or implied written or verbal power of attorney from the applicant.

While the expansion of the class of persons who may sign an application and related documents is a welcome change, it must be remembered that the person signing the application documents is still signing under oath and verifying the statements in the application. That person potentially could become a fact witness if the validity of the statements in the application are challenged. Thus, it may be preferable not to have outside counsel sign application documents on behalf of the Applicant because that counsel later may be called as a witness to testify in proceedings involving the mark. Such a development could affect the availability of the

attorney-client privilege. Moreover, if outside counsel did not have a reasonable basis for attesting to the facts stated in the application, then the validity of the application also might be challenged.

One also must distinguish between those situations when a signature is required, and when it can be submitted at a later time. A signature is not required when an application is filed (it can be submitted later), but it *is* required when one is filing a statement of use or an extension of time.

b. Bases for Application

Applicants no longer have to state in the initial application whether it is based on actual use (Section 1(a)), intent to use (Section 1(b)), a foreign priority application (Section 44(d)), or a foreign registration (Section 44(e)). However, the minimum requirements for filing the application still must be met, and the basis identified during prosecution. The drawback to this change in the rule is that if one is searching the PTO records, one may not know whether an application is a “use-based” application or some other type of application. This can make it difficult to assess the risk of infringement of a mark.

Thanks to TLTIA, it is now possible to change from one basis to another more easily, and one may even assert both Section 1(a) (actual use) and Section 1(b) (intent to use) in the same application. This is particularly helpful if one starts out claiming actual use and it turns out that the specimens are not adequate. In the past, it was not possible to convert to an intent to use basis, but under the new rules, such a change is possible. When these changes are made, *the original filing date is maintained.*

Note, however, that a section 44(d) priority claim *must* be asserted during the six month priority period or it will be lost. Therefore, if a priority claim is to be asserted, it is best to assert it in the initial application to avoid inadvertently failing to assert it later during the priority period.

c. Drawing Changes

TLTIA eliminated the requirement for a separate drawing page, but the drawing must appear somewhere in the text of the application. However, it still is preferable to have the drawing page. For marks including color, a formal drawing with lining for color is no longer required, although it is permitted. If a black and white version of a mark in which color is claimed is submitted, the application must include a written description of the color(s) in the mark.

d. Specimen Changes

As a result of TLTIA, only one specimen per class need be submitted now, instead of three. This requirement is applicable to applications filed based on actual use and to amendments to allege use and statements of use filed later during prosecution.

POST REGISTRATION ISSUES

a. Section 8 Declarations

TLTIA did not eliminate the requirement that a Section 8 Declaration be filed between the fifth and sixth anniversary of the registration of a mark. However, a grace period for late filing up to six months after the sixth anniversary is now available. The changes in signature rules with respect to who can sign the document also are applicable to Section 8 Declarations.

A new requirement introduced by TLTIA is that a Section 8 Declaration also must be filed in conjunction with the renewal of a registration every tenth anniversary of the date of registration. The Section 8 Declaration either can be combined with the renewal, or it can be a separate document. The time frame for filing it is between the 9th and 10th year anniversary of the original registration or any renewal of the registration. A six month grace period for filing both the Section 8 Declaration and the renewal application is available upon payment of an additional fee. When filing the renewal application and the Section 8 Declaration, the fee for each must be paid, even if they are filed as a combined document.

b. Renewal Applications

As a result of TLTIA, renewal applications can now be filed between the ninth and tenth anniversary of the original date of registration, and between the ninth and tenth anniversary of each subsequent renewal period. (Previously, renewals could only be filed six months before the deadline, with a three-month grace period thereafter.) Renewal applications no longer have to state that the mark is in use in commerce. However, the accompanying Section 8 Declaration (see above) must include a statement that the mark is in use in commerce, and also include a specimen for each class. Thus, in practice, there has not really been any change in the requirements for maintaining a registration: the mark still must be in use in commerce, and a specimen must be submitted for each class of goods or services by the registration.

TLTIA expanded the grace period for late filing of renewal applications and Section 8 Declarations from three months to six months, provided a surcharge for late filing is paid.

A practical problem to be aware of as a result of the requirement for both a Section 8 Declaration and a renewal application is that if one fails to file the Section 8 Declaration, the

PTO records could show the registration as being both “canceled” and “renewed”. Cancellation for failure to file the Section 8 Declaration will result in a registration that is no longer in force, even if it is marked as “renewed.” Thus, one searching the PTO records will need to scrutinize renewal records carefully to make sure that all required documents have been filed.

OTHER CHANGES

The TLTIA legislation also included other changes that have impacted prosecution and maintenance of trademark registrations. For example, for applications that are inadvertently abandoned, it is now possible to revive the application through a petition to the commissioner. Previously, there was a very high standard of proof that the abandonment was unavoidable. Now the standard for reviving an application is simply that the abandonment was unintentional -- a much easier standard to meet.

The “Trademark” section of the PTO website has a very useful Examination Guide on Petitions to the Commissioner that sets forth these changes and explains the requirements for a Petition to the Commissioner. For example, if the application was inadvertently abandoned because a docketing error resulted in a response to an office action not being filed on time, the Petition should be accompanied by the response to the office action.

The relaxed rules relating to the filing of Petitions to the Commissioner mean, however, that when reviewing a trademark search, one must look carefully at the date when an application was abandoned. If it was very recently abandoned, then it is possible that the application may be revived through a Petition to the Commissioner. Therefore, when making an assessment of the availability of a mark, one must consider this additional factor of whether the application could be revived.

There also have been some changes in what amendments can be made to marks (i.e., what constitutes a “material alteration” that results in an impermissible amendment of a mark). However, for determination of whether a change is a material alteration, each change is evaluated on a case-by-case basis. The standard remains strict for granting such changes (i.e., only very minimal changes are permitted).

USING THE PTO WEBSITE AS A RESOURCE

The PTO website is updated frequently, and the PTO has implemented a number of changes that make it both an efficient research tool, and a means for promptly filing papers in the PTO electronically. Trademark practitioners can click on “Trademark” (currently in the upper left column of the PTO home page) to be transferred to the main library of trademark resources available.

On-line trademark searching is available using the TESS system, and status checks or applications and registrations can be made using the TARR system. The PTO puts out several Examination Guides each year that expand on particular topics (such as Petitions to the Commissioner), which are available through the website. Also, the TMEP, TBMP, Manual of Classification, and other reference tools are available for free online at this site.

Electronic filing of applications, statements of use, amendments to allege use, Section 8 Declarations, Section 15 Declarations and Renewal Applications can all be filed electronically through the PTO website. Step-by-step instructions are available online through the E-TEAS and PrinTEAS systems.

CONCLUSION

TLTIA and electronic filing have simplified our trademark practice, but the U.S. still has more formalities than most countries for registering trademarks. Thus, it is important to be cognizant of both the new and the old rules to ensure that trademark applications and registrations are properly maintained.

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