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## U.S. trademark prosecution: It's not rocket science, more like an art

The identification: What seems like an easy task is frequently difficult because the client and the USPTO speak different languages

Applying for a federal trademark registration seems straightforward. The elements of an application are the identity and address of the owner, the mark, a description of what the mark will be used for and the filing fee. If the owner has already used the mark, the dates of first use and an example or "specimen" of how the owner uses the mark are needed. As simple as it seems, The Office of the Chief Economist of the USPTO reported last year that at least one non-final office action issues against a majority of applications. This article focuses on one of the common stumbling blocks to registration: the identification of the goods or services. A flawed identification can delay or defeat an application.

What seems like an easy task is frequently difficult because the client and the USPTO speak different languages. Engineers are keen to emphasize the novel capabilities of the product. Marketers naturally want to include features that give them the competitive edge. The trademark lawyer seeks to describe the client's goods or services in the broadest way that is acceptable to the USPTO in order to expeditiously

achieve registration. The task requires translating the description provided by the client into "trademark talk." Internal clients may think the trademark lawyer doesn't understand the business and become frustrated. Rather than incur the client's ire and leave the impression that he or she is not compliant with the client's instructions, a prosecutor may be tempted to use the lay client's description in an application. This courtesy is not in the client's best interest. It can result in a refusal of the application, and while a description may be changed, it may not be broadened. Any amended description must be within the scope of the original.

The U.S. Acceptable Identifications of Goods and Services Manual includes a searchable database of descriptions that are acceptable to the Office. If an applicant uses one or more of the standard descriptions, it can save a bit on the application fee and should not have to defend the identification to an examining attorney. Offering a handful of these alternatives to the client can help focus the dialogue about the intended coverage of the mark. Often the identification will require modification, but sharing

the examples helps a client understand that the identification is not a marketing piece or a patent claim. Another helpful approach is to search out registrations owned by sellers of comparable goods and services. Showing a client the recitation of goods or services in a competitor's successful registration illustrates that the description is intended for a very different audience than the client's advertising.

Arriving at an appropriately broad and accurate description of goods and services in USPTO language gets the applicant part of the way to registration, but the journey is not complete until the applicant submits an acceptable "specimen" or example of how the mark is used in commerce to identify the stated goods or services. The USPTO will refuse registration if the specimen does not capture and illustrate the identified goods or services. In formulating the identification, then, it is important to think about what the evidence of use will look like.

While the description of goods or services is still in draft form, the client and lawyer should discuss how the mark will be used. In [a recent case](#),

for example, an application specified “precious and semi-precious crystal stones and beads for use in jewelry.” The specimen submitted by the applicant showed use on the jewelry, not beads for making the jewelry, and the Trademark Trial and Appeal Board upheld the refusal of the application. [Another applicant](#) applied to register its mark for “sleep products” such as mattresses. The specimen it filed was a photo of a mattress showroom with the mark on a sign suspended from the ceiling. Registration was refused because the specimen showed use for retail services rather than for the products themselves. The applicant in [In re Health Fusion Brands, Inc.](#) had the opposite problem: It applied to register its mark for distributorship services in the field of nutritional beverages, but its specimen showed use of the mark on advertisements for the beverages and did not demonstrate that the mark was used in rendering the services.

Choosing service mark specimens can be especially tricky because the concept of the service may be abstract and difficult to capture in a specimen

that meets the USPTO’s requirement that it “must show use of the mark in a manner that would be perceived by the relevant public as identifying the specified services and indicating their source.” In [In re Osmotica Holdings Corp.](#), an applicant sought registration of its mark for “consulting services” and submitted specimens that the examining attorney thought showed that the mark identified the applicant’s drug delivery technology instead. The applicant lost its appeal, even though the Board acknowledged that the webpage specimens showed the mark and referenced the named services. Similarly, in an application to register BEAR’S BEST in a design format for “golf course design and consulting services,” the examiner rejected a specimen showing use of the mark with golf courses designed by Jack Nicklaus because it did not demonstrate the design services themselves (*In re Nicklaus Co. LLC*).

In each of these instances, the applicant likely had good reasons for describing its intended product or service in a certain way, but in each

case the evidence of use ultimately supported a different product or service. If the applicant had used a description that matched its use, it could have avoided a refusal on this basis. Counseling regarding the technical requirements of the identification at the outset of the process helps avoid this significant trap for the unwary.

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