

Gotta get a message to you: a strategy for protesting at the USPTO

Letters of protest are an important tool for influencing decisions on problematic applications by third parties, but the wrong approach can have significant repercussions

Trademark owners and practitioners are far from powerless when it comes to influencing the USPTO's decisions to refuse problematic applications by third parties. Letters of protest provide an opportunity to introduce evidence into the record for a pending application. If a letter of protest is granted, the office will send the evidence to the examining attorney who will consider that evidence when deciding whether to issue or maintain a refusal. The TTAB may then rely on that evidence in an *ex parte* appeal. Letters of protest are often simple to prepare and cost-effective compared to demand letters, notices of opposition and their subsequent proceedings at the USPTO, the TTAB or in court. Nevertheless, letters of protest are not without their drawbacks and limitations. A careless letter can waste time, client money and USPTO resources. It can even create problems for a potential opposer. As such, there are specific considerations that practitioners should make before recommending or filing a letter of protest, and circumstances in which their value is often overlooked.

Purpose

Letters of protest are a unique creation of the USPTO. The office aims to maintain the "integrity and objectivity" of an examining attorney's consideration of applications. A trademark record is not an open forum and, generally, the only way for third parties to introduce arguments against a registration is through proceedings at the TTAB. However, the USPTO has recognised that interested third parties might be willing to help build a trademark record in ways that its examining attorneys could not do alone. As a result, the office created the letter of protest mechanism as an exception to the rule:

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[T]he Examination Operation did not have the same resources and expertise as those who worked in or were involved with the particular business in connection with which a trademark or service mark application might be filed. Accordingly, the Office created a procedure by which those in the trade could bring to the attention of the Office information which might be unavailable to the Examining Attorney but which would be useful in the examination of a particular application... However, Letters of Protest are not appropriate when the protestor's purpose is merely to delay the issuance of a registration, or to use it as a substitute for opposition. (In Re Pohn, 3 USPQ2d 1700 (Com'r Pat. & Trademarks 1987).)

With this in mind, letters of protest are ordinarily about communicating evidence to the examining attorney, not compelling a particular action or making a particular legal argument.

The letter of protest procedure is often confusingly described as 'informal'. This refers only to the fact that it was not created through the Trademark Act (15 USC 1051 *et seq*) or the Trademark Rules (37 CFR 2.1 *et seq*). Instead, it is considered part of the USPTO's examination procedures, existing solely for the office's benefit and at its discretion, to which no third party is entitled. This may change, however, with the Trademark Modernisation Act introduced on 11 March 2020 (HR 6196/S3449), which will create a statutory protest procedure if passed into law.

For now, parties should always take care to review the Trademark Manual of Examining Procedure (TMEP) for changes to the rules concerning letters of protest before

filing. Because they are informal, the USPTO can – and often does – issue new requirements and limitations without notice, comment or much special fanfare.

Procedure

Letters of protest are handled in three stages. First, the protestor submits the letter to the Office of the Deputy Commissioner for Trademark Examination Policy (the Deputy Commissioner’s Office). If the Deputy Commissioner’s Office grants the letter, it will enter an anonymous letter of protest memorandum in the application file. The examining attorney assigned to the file will then review the memorandum and determine whether the enclosed evidence or identified grounds merit a further refusal of the application or some other form of office action (see Figure 1).

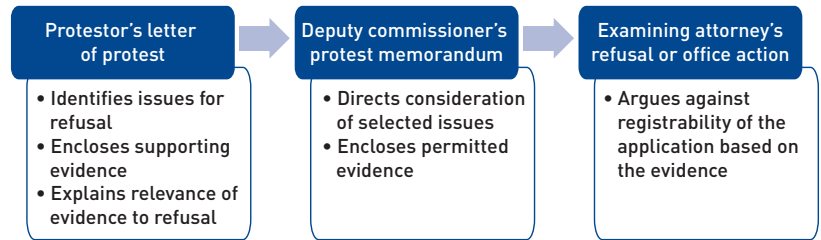
The Deputy Commissioner’s Office is the only place where the letter of protest will be reviewed in its entirety, including the Trademark Electronic Application System (TEAS) cover sheet identifying the refusal basis for which the evidence is being submitted, any letter or explanation that the protestor chooses to submit, and the accompanying evidence that the protestor would like to be reviewed by the examining attorney. The Deputy Commissioner’s Office ordinarily considers only whether the evidence is of the kind that might support a refusal for the identified basis, not how well the evidence does so. Once the office has made a decision, it will return a so-called ‘letter of protest decision’ to the protestor, explaining its disposition of the matter. If it does not grant the letter of protest, it will take no further action. If it does, the protest memorandum will direct the examining attorney to consider the accepted basis for refusal and enclose only that portion of the protestor’s evidence that the Deputy Commissioner’s Office has deemed relevant, if any.

Although examining attorneys are only supplied with a basis for refusing the application and, if applicable, accompanying evidence in the form of the memorandum, they ordinarily have far more flexibility in their response to a letter of protest. Examining attorneys usually need not issue a refusal as a result of the protest memorandum (post-publication memoranda being an important exception), nor must they limit their consideration to the grounds for refusal identified in the memorandum. Examining attorneys are also not obligated to submit a response to the protest memorandum if they do not choose to do so. However, an examining attorney must still generally follow the USPTO’s rules and guidelines for issuing refusals. For example, even if a protest memorandum identifies genericness as the issue and supplies ample supporting evidence, the examining attorney may still be required to first issue a mere descriptiveness refusal.

Content

The content of a letter of protest should be concise and to the point, but sufficiently fleshed out that the staff at the Deputy Commissioner’s Office can easily understand and evaluate the proposed issues and evidence. In some cases, an adequate filing may be as simple as the TEAS cover sheet itself or the TEAS cover sheet and a single piece of

FIGURE 1: Three stages of a letter of protest



clear evidence. Even so, it is best practice to include an actual letter explaining the submission.

The letter portion should be drafted to the Deputy Commissioner’s Office. Only actual evidence, not the letter, will be reviewed by the examining attorney, and then only if the letter is granted. The TMEP is emphatic that the USPTO denies letters of protest that merely present adversarial arguments, but the word ‘merely’ is a key component of that requirement. Letters of protest are denied for the absence of relevant evidence, not the presence of legal arguments. That said, any legal contentions should consider the audience and purpose of the submission. The Deputy Commissioner’s Office is staffed with experts in trademark examination procedure and policy who are well versed in the underlying law. Further, they are not considering whether the application should in fact be refused. Under ordinary circumstances, they can benefit from a succinct explanation of the kinds of evidence that pertain to the issue raised by the overall letter of protest, especially if it is an unusual ground for refusal, and a succinct description of how the submitted evidence is of one of those kinds, along with any aids or charts that might be a convenience to the Deputy Commissioner’s Office, such as an index of the submitted evidence (for guidance on the form of an index, see Section 1715.04(b) of the TMEP).

The evidence accompanying a letter of protest should be in an appropriate form for submission to the examining attorney. Ordinarily, the Deputy Commissioner’s Office will simply transmit those accepted pieces of evidence along with the protest memorandum in the form in which they were supplied by the protestor. With that in mind, and consistent with the USPTO’s objective of preserving the impartiality and integrity of examination, the evidence should not identify the protestor. Not only should the protestor refrain from adding identifying text to the evidence, it should also take care that identifying information is not inadvertently included in screenshots submitted as evidence. Similarly, the evidence should be kept separate from any legal argument that it may have submitted; these should be in different files and different pages. However, it is generally acceptable to include highlighting or other markings in the evidence to call out those most relevant portions. In fact, because the examining attorney will not receive an explanation of the evidence, it is often a good idea to do so.

It is important not to overdo a letter of protest. The USPTO recently implemented a 75-page limit on such letters, absent a detailed explanation for why more is

necessary (see Section 1715.04(b) of the TMPEP). Offending letters will be denied automatically. A protestor may be inclined to use an expanded submission where the USPTO bears a higher burden of proof (eg, on issues of genericness), but it is ordinarily better to supply only the best evidence within the 75-page limit and then allow the examining attorney to flesh out the record later. Only in the unlikely event that the nature or medium of important evidence requires a more voluminous submission may it be worth requesting an expanded submission. This request would be made in the letter portion of the letter of protest. Overall, though, a protestor should take pause if a letter of protest is becoming legally or factually complicated, because the Deputy Commissioner's Office may rightfully conclude that it is simply beyond the scope of examination or the letter of protest mechanism and decide instead that it is better suited to an *inter partes* dispute before the TTAB.

General timings

Letters of protest can be filed at any time after an application goes live in the Trademark Status and Document Retrieval (TSDR) system and should be filed before the application is published. Letters filed after publication and within 30 days thereafter can theoretically be granted, but in practice almost never are. Both letters of protest filed after publication but within 30 days and letters of protest regarding issues already considered by the examining attorney are theoretically subject to the same standard and must make a showing of clear error if they are to be granted. Under this standard, the protestor must generally establish to the Deputy Commissioner's Office that, if the issue raised by the letter is not remedied, the registration would violate the Trademark Act or an applicable rule. Anecdotally, that standard is applied much differently in the case of letters filed after an application has been published. In these cases, the USPTO generally considers it of overriding concern that *ex parte* examination of an application end within a finite amount of time. The Deputy Commissioner's Office will likely overlook any flaw short of a singularly egregious error by the examining attorney, even if it will substantially and materially interfere with a third party's rights.

Letters of protest in lieu of *inter partes* disputes

The USPTO discourages the use of letters of protest in lieu of an opposition or cancellation, but they may be granted on any ground for which the examining attorney may issue a refusal and many of these are also grounds that are available to third parties before the TTAB. The USPTO's purpose for making letters of protest available in this instance is, as discussed earlier, where the grounds would be clear only to those who have specialised knowledge or information not known to examining attorneys.

However, even facts that would ordinarily be unavailable to the examining attorney do not always provide suitable grounds for a letter of protest. In particular, submitting evidence that an applied-for mark is confusingly similar to an unregistered trademark, that an applicant does not actually own the mark, that it has

not made sufficient use to maintain its trademark rights, that it does not have a *bona fide* intent to use a mark or that it does not maintain a commercial presence in the country of origin for a Paris Convention application do not correspond to any grounds for refusal, even though claims based on these facts are available *inter partes* (see Section 1715.01(b) of the TMPEP).

It can be difficult to decide whether to submit a letter of protest, especially when the examining attorneys are likely to identify the underlying issues themselves. The difference in cost between a letter of protest and an opposition makes it appealing to attempt a letter anyway. Even so, if the evidence submitted is readily available and the issue is clear, the letter is likely to be superfluous. If the evidence is readily available but the issue is only an arguable defect in the application, it could cause problems in a subsequent dispute between the protestor and applicant. In particular, if a protest memorandum is entered into the record and does not result in a refusal or if the applicant ultimately overcomes that refusal, the applicant may latch on to the apparently official decision by the USPTO as dispositive of the protestor's subsequent position. Unsophisticated parties and those arguing in bad faith are unlikely to care that examination of an application is not preclusive of or binding on a subsequent opposition, cancellation or litigation, regardless of whether the plaintiff also filed the letter of protest. This can significantly interfere with realistic negotiations until the matter is escalated or substantially litigated. For this reason, it is bad practice to simply treat letters of protest as a cheaper alternative to oppositions in most circumstances.



A protestor should take pause if a letter of protest is becoming legally or factually complicated

In any case, it is best to submit a letter of protest to opposable issues as soon as possible after an application record goes live on the TSDR. Current trademark watching platforms should provide ample notice and late submissions are far less excusable than they may have been in the past. It is important to file promptly, because pendency before the Deputy Commissioner's Office is unpredictable and entering a protest memorandum into the record after it has been examined, rather than before, creates a tremendous rhetorical disadvantage. If examining attorneys are being asked to go back on a decision that they have already made, they are being asked to do otherwise unnecessary work and to implicitly admit that their examination was somehow incomplete. Under most circumstances, there is no requirement that they do either and ordinarily they will not.

Protesting confusingly similar marks under Section 2(d) of the Trademark Act

Of the letters of protest discussed above, based on issues that could also be grounds for *inter partes* disputes,



the most common are those protesting marks that are confusingly similar to a prior mark under Section 2(d) of the Trademark Act. There are several circumstances in which it is advisable to file such a letter, but these rarely apply. In fact, filing an ill-considered letter of protest for likely confusion can be a severe strategic error.

It is usually best to reserve letters of protest based on likely confusion to those instances where opposing counsel or the adverse party is reasonably sophisticated but likely to have limited resources or to place limited value on the application. These are the parties that will recognize the possibility of an opposition and be uninterested in dedicating the resources to it, if they are even motivated to respond to a refusal that results from the protest. In this regard, letters of protest serve much the same purpose as a demand letter, with the slight benefit of a small chance of encouraging a more robust refusal by the examining attorney.

In addition, parties should not use a letter of protest to assert likely confusion against a sophisticated party with extensive resources. Realistically, there will be little question that the owner of the referenced prior marks is the protestor, even though that information is not published in the memorandum. Further, a sophisticated

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party will know that the letter of protest has essentially no advantages over an opposition, other than the fact that it is less expensive. Therefore, the applicant will likely conclude from the protestor's parsimony that it does not have the means or the will to engage in a substantial contest, which will likely undercut any bold threats or representations that the protestor makes in a separate demand letter. In turn, this will only embolden the applicant in negotiations. Finally, the letter of protest will, similar to an early demand letter, likely create sufficient standing and greater motivation for the applicant to seek cancellation of any obstructing registrations if there are grounds to do so. This can be a dangerous scenario, because the applicant will also be able to use that cancellation as grounds to suspend the protested application indefinitely, potentially denying the protestor the opportunity to bring opposition counterclaims before the TTAB. If the applicant owns no other vulnerable applications or registrations, the only way to avoid a severely asymmetric discovery burden in the ensuing dispute may be to file a district court action seeking to enjoin actual use of the applied-for mark, which could be unfortunate if the entire purpose of using a letter of protest, instead of an opposition, was to reduce costs.

PICTURE: BY BILLION PHOTOS/ SHUTTERSTOCK.COM



rights in a supplemental registration, which could ultimately support a finding of acquired distinctiveness and the potential cost of otherwise seeking to cancel a registration.

Protesting generic use of trademarks in identifications

One of the officially accepted and most appropriate grounds for a letter of protest is that an application is using a trademark generically in an identification of goods and services. Because these generic uses could conceivably be used as evidence of genericness, it is particularly important that trademark owners, especially providers of novel or innovative goods and services, take care to monitor not just marks in new applications, but also their identifications. This can be vital, because generic use in an identification is ultimately not grounds for an *inter partes* action and this is a special case of an examination issue, discussed in more detail below.

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Letters of protest to examination errors filed before an opposition can have important strategic value

Protesting examination errors or examination issues

Examination issues or examination errors are a rare but potentially important instance in which letters of protest could be a decisive tool. These occur when an examining attorney fails to refuse an application on any of the several grounds that cannot be challenged in an *inter partes* proceeding. The TTAB only recently openly suggested that letters of protest could be used for this purpose in *VF Corp v Anthony Fisher* (Opp No 91/236,399 (19 September 2019)), but there are no known instances in which this has been done. Nevertheless, it creates the possibility of a potentially effective tactic for complicating the prosecution of problematic applications, establishing a better basis for subsequent oppositions or preventing a registration outright.

A wide variety of issues could result in an examination error, including:

- indefinite identifications of goods and services;
- improper classification of goods or services;
- expansion of the identification of goods and services by amendment after filing;
- inaccurate or indefinite descriptions of the mark;
- failure to file a copy of an underlying foreign registration, where necessary;
- improper specimens of use;
- failure to claim that the mark is used by a controlled licensee;
- failure to comply with signature requirements;
- the USPTO's failure to republish an application (eg, after an amendment);
- insufficient evidence of acquired distinctiveness; or

Protesting supplemental register applications

Letters of protest can sometimes be the only intervention available for those applications that are filed for – or amended to – the supplemental register. These applications cannot be opposed because they are not published. Time is often of the essence for these letters, as there can be a very small window between an amendment to the supplemental register or approval of a supplemental register application and registration. Parties should consider filing a letter of protest immediately, regardless of whether the application in question has been refused, consistent with the USPTO's recommendations in the TMEP, if they learn of an application that:

- covers a confusingly similar mark, is for a generic designation or is an otherwise defective application that may interfere with the protestor's marks or interests; and
- either has been filed for the supplemental register or will likely be found to lack distinctiveness and therefore amended to the supplemental register.

The value in doing this would be to avoid later interference by the applicant based on its limited

- incomplete responses to an examining attorney's information requests.

Letters protesting these issues should be filed as soon as possible and before the publication period. In principle, parties might file a letter as soon as they identify an issue with an application. In practice, however, examination errors are rare, and a pre-emptive letter is likely to be a waste of resources. Instead, it would usually make sense to file a letter of protest as soon as possible after the examining attorney's error and before the application is actually published.



The Trademark Modernisation Act includes a statutory provision for protests, presumably as a substitute for the USPTO's current informal system

Protestors to examination errors should anticipate needing to file a notice of opposition. Even if a letter is filed in a timely manner before publication, the Deputy Commissioner's Office may not grant the letter until afterwards. In that case, the restoration of jurisdiction to an examining attorney to rectify the error will not toll the time to file a notice or request an extension of time to do so. If the examining attorney issues an office action refusing the application after the publication date, the six-month deadline to respond to that refusal would necessarily fall after the maximum 180-day period in which to file notice, even if the opposer could show sufficient good cause for the final 60-day extension. However, if the opposer files its notice, along with an appropriate motion to the TTAB to suspend, it will have reserved its rights to challenge the application before the board indefinitely, even if the application is amended and republished. On the other hand, an opposer that fails to interpose a notice in a timely manner will only have another opportunity to oppose if the applicant's response to the refusal requires the application to be republished, which may be the case in some circumstances, but is not guaranteed.

Letters of protest to examination errors filed before an opposition can have important strategic value. Importantly, there is no mechanism whereby an opposer may address these issues through the TTAB, because examination errors do not support recognised claims and there is no procedure whereby an opposer may move the board to remand these issues back to the examining attorney. The errors may still interfere with TTAB claims. For instance, indefinite identifications can complicate an opposer's claims of descriptiveness, genericness and likely confusion.

Unlike ordinary letters of protest, a protest to an examination error should be drafted to meet the amplified 'clear error' standard discussed earlier. This is generally the standard that applies to any letter of protest to an issue that has already been considered by

the examining attorney. Clear error would ordinarily be implicit in a protest to examination error, but care should be taken in drafting the actual letter to explain in explicit terms the relationship of the error to the applicable portion of the statute or rules.

Protesting Madrid Protocol designations under Section 66(a) of the Trademark Act

Applications under Section 66(a) of the Trademark Act should receive special consideration when using letters of protest. Critically, the Madrid Protocol requires that any grounds for refusal be raised within 18 months of the International Bureau's request for an extension of protection to the United States. Once the International Bureau has been notified of those grounds within that window, whether in the first provisional refusal or in a subsequent timely office action, they may be maintained, even if the USPTO must remand jurisdiction to the examining attorney post-publication. However, if grounds are not raised under Article 5 in a timely manner, they cannot be the basis for a subsequent letter of protest. Consequently, a letter of protest might be prudent where:

- the application contains a defect;
- the grounds for the defect was not raised in a provisional refusal or subsequent office action; and
- it is unlikely that the application will be approved within sufficient time for a letter of protest to be filed, a memorandum to be entered and a refusal to be issued before the end of the 18-month window.

With this in mind, it is prudent to apply extra care in monitoring Section 66(a) applications that are of interest.

Possible changes under the Trademark Modernisation Act

The Trademark Modernisation Act introduced on 11 March 2020 includes a statutory provision for protests, presumably as a substitute for the USPTO's current informal system. It maintains the overall structure of the proceedings, makes some important changes and generally creates an opportunity for greater transparency and accountability throughout the entire process. Under the current draft of the legislation, protests no longer exist at the USPTO's discretion, but the office is now required to accept them and to either grant or deny a protest within two months. The office would also be required to issue regulations regarding how protests are examined. On the other hand, the statute would empower the USPTO to charge fees for protests, meaning that they may no longer be as cost-effective as they are today. Not addressed at all in the proposed statutory language is whether the identity of protestors will be disclosed under the new procedure, the proper timing for protests or the handling of examination errors. All of these things could be subject to change, depending on how the USPTO ultimately implements the statutory provision. **WTR**



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