

Trademark Law

Prof. Madison

Today: The trademark registration process

Key concepts from Class 9:

Use in commerce as a prerequisite for obtaining rights in a mark.

Actual use and “constructive” use (ITU, surrogate use, analogous use, tacking).

Advantages of registration: the symbol

- [1] **Nationwide priority.** Date of filing of registration establishes constructive use priority *nationwide* [as opposed to actual use priority in relevant area, at common law and under Section 43 for unregistered marks]. Lanham Act § 7(c).
- [2] **Presumption of validity.** Registration certification is prima facie evidence of validity, ownership, and registrant's exclusive rights. Lanham Act § 7(b).
- [3] **Possibility of incontestability.** Registration starts clock running for purposes of incontestability (Lanham Act §§ 15 and 33) and limits on cancellation. Lanham Act § 14.
- [4] **Statutory damages, importation remedy.** Other miscellaneous advantages, including eligibility for an award of statutory damages in an infringement lawsuit and reliance on registration to bar importation of infringing articles.

Prosecuting and opposing an application to register

- No lawyers needed, but they're often a good idea
- TMEP
- TM practice as part of a general business practice
- Applications and negotiating with the TM examiner
- Publication, monitoring the Official Gazette
- Opposition and the TTAB
- Settlements

Initial Filing

- Filing basis (§ 1(a) (use); § 1(b) (ITU); § 44(d) (based on a foreign application); § 44(e) (based on a foreign registration)
- Drawing or specimen (§ 1(a))
- Description and classes of goods/services ("Nice")
- Fee (\$250 per class, on up)

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What you get:



The mark

The Registration Number

The registration date

The owner

The description of the
goods and services

The application filing date

The USPTO seal

Maintaining a Registration

- Calendaring
- Professional responsibility
- Lawyers supervising other lawyers, paralegals, clerks
- Robots are coming

Later Filing Requirements

Various declarations and applications with the Trademark Office

- § 8 Declaration of Continuing Use
- § 15 Declaration of Incontestability
- § 9 Renewal Application

Updating

During **6th year** from date of registration:

- Registrant must file § 8 Declaration *and* registrant may also file § 15 Declaration

During every **10th year** from date of registration:

- Registrant must file § 8 Declaration and § 9 Renewal Application

Why did the University of Pittsburgh (and the NFL) oppose registration of “PANTHERADE” for sports drinks?

- Who were the parties?
- Why did the registrant want the registrations?
- What did Pitt show – or try to show?
- What ultimately happened?

PANTHERADE

For sports drinks and performance drinks

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Portfolios and the uses of registrations:

Pitt on the mark owner's end



The uses of registrations: Pitt on the receiving end



WALT DISNEY'S
MICKEY MOUSE

**THE
END**



MICKEY MOUSE



MINNIE MOUSE

COLUMBIA PICTURES CORP