Sweeping Examiners Off Their Feet: Overcoming Objections To Trademarks

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Speakers

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AA Thornton
Speakers

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Lott & Fischer, PL
### Major Objections

<table>
<thead>
<tr>
<th>Objection</th>
<th>China</th>
<th>EU</th>
<th>UK</th>
<th>USA</th>
<th>Canada</th>
</tr>
</thead>
<tbody>
<tr>
<td>Goods/Services</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Confusion</td>
<td>✓</td>
<td>✗</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Descriptiveness</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Distinctiveness</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
<td>✓</td>
</tr>
<tr>
<td>Name/Surname</td>
<td>✗</td>
<td>✗</td>
<td>✗</td>
<td>✓</td>
<td>✓</td>
</tr>
</tbody>
</table>
Nice Classification

- Classification mandatory for all applications and registrations
- Some differences in how different jurisdictions treat classification
  - US – detailed description
  - Canada - describe in ordinary commercial terms
  - China - subclasses
  - EU/UK – class headings acceptable
- Overcome through:
  - amending description of goods and/or services or reclassifying as needed
  - arguing against the objection – appeal?
  - deleting goods and services at issue
Confusion

• Review of the register for confusingly similar pending and registered marks not owned by the same person
  • First to file v. first to use
  • Public interest v. brand owner interest
  • Notification process

• Overcome through:
  o arguments against the objection
    o sound, appearance, meaning, commercial impression
    o goods and services
  o opposition to prior pending application
  o cancellation for non-use or invalidation of a cited registration
  o consent from owner of cited mark → binding?
Major Objections

LIKELIHOOD OF CONFUSION

- Sound
  - T. MARKEY
  - TEE MARQEE

- Appearance
  - T. MARKEY
  - T. Markey

- Meaning
  - LUPO
  - WOLF
### Major Objections

#### Likelihood of Confusion

<table>
<thead>
<tr>
<th>Goods</th>
<th>Services</th>
<th>Goods/Services</th>
</tr>
</thead>
<tbody>
<tr>
<td>T-shirts and pants</td>
<td>Banking services</td>
<td>T-shirts and pants</td>
</tr>
<tr>
<td>Hats</td>
<td>Mortgage lending services</td>
<td>Online retail store services featuring clothing</td>
</tr>
</tbody>
</table>
### Examples

<table>
<thead>
<tr>
<th>Trademark Objected</th>
<th>Class</th>
<th>Prior Registration</th>
<th>Third party’s registration in between</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>KO-KO</strong></td>
<td>30</td>
<td><img src="image1" alt="KO-KO Image" /></td>
<td><img src="image2" alt="KOKO KRUNCH Image" /></td>
</tr>
<tr>
<td><strong>AGC</strong></td>
<td>12 19</td>
<td><img src="image3" alt="AGC Image" /></td>
<td><img src="image4" alt="AGGC Image" /></td>
</tr>
<tr>
<td><strong>Alcon</strong></td>
<td>9</td>
<td>No. G1058618</td>
<td>No. 4875585</td>
</tr>
<tr>
<td><strong>（福建七匹狼公司）</strong></td>
<td>18</td>
<td>No. 16328033</td>
<td>No. G1289376</td>
</tr>
</tbody>
</table>
Descriptiveness

• Clearly/Merely Descriptiveness v. Deceptively Misdescriptive
  • Character or quality of the goods
  • Geographic origin of the goods

Overcoming the objection
  o arguments against descriptiveness
  o evidence of acquired distinctiveness
    ▪ when required?
    ▪ what kind of evidence?
    ▪ how long should use be?
• Distinctiveness expressly assessed during examination for registrability
  o refuse any trademark that lacks distinctiveness
  o separate and apart from descriptiveness in Canada
  o Examples:
    o single letter/number marks, esp commonly used in specific industries (e.g. GT or LE in auto industry);
    o combination of surnames that are not inherently distinctive (e.g. SMITH JOHNSON)
    o designs common to the trade (e.g. ordinary representation of grapes for wine)
Not Inherently Distinctive

- Threshold for objection:
  - No inherent distinctiveness (not registrable) vs.
  - Low degree of inherent distinctiveness (registrable)

- Overcome objection through:
  - Arguments against non-distinctiveness
  - State of the register
  - Evidence of acquired distinctiveness
    - When required?
    - What kind of evidence?
    - How long should use be?
Case Studies

BOOKING.COM

#makeitright

BABY SHARK
Some Well-Known Slogans

FINGER LICKIN’ GOOD (KFC)

THE WORLD’S LOCAL BANK (HSBC)

DON’T LEAVE HOME WITHOUT IT (American Express)

THE ULTIMATE DRIVING EXPERIENCE (BMW)

WHAT’S IN YOUR WALLET (Capital One)
### Extreme Examples

<table>
<thead>
<tr>
<th>Number</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>1912648</td>
<td>Miracles don't just happen. They are created every day, through the daily ritual of self-care. We connect with our inner strength and create the miracles we want to see.</td>
</tr>
<tr>
<td>1885280</td>
<td>When we approach each day with purity, we see life with fresh eyes. We focus on what can be, instead of what is. We trust our instincts, and balance is found. We embrace the purity of our intentions and the simplicity of being our true selves.</td>
</tr>
<tr>
<td>1824523</td>
<td>½ c. warm milk, ½ c. sugar, 1 tsp. salt, 1 tbsp. cinnamon, 4 tbsp. softened butter, 2 eggs, 1 pkg. dry yeast, 1/4 c. warm water, 2 1/2 c. flour. Mix all ingredients except yeast, water and flour and let it cool. Stir and dissolve yeast in warm water. Add yeast to first mixture. Beat until mixed. Add 1 1/2 c. flour. Cover and let rise for 1 hr. Add remaining flour. Blend well. Knead until smooth. Put dough in greased bowl. Cover and let rise until double in size. Punch down, shape rolls and let rise for 1 hr. Bake at 400°F for 18 min.</td>
</tr>
</tbody>
</table>
Name/ Surname Objection

- Impact on applications for registering famous names for trademarks (e.g. celebrity names, etc.)

- How to avoid / respond to objection:
  - Filing for a more distinctive mark (additional distinctive word or design elements)
  - Overcome objection with written submissions
  - Evidence of acquired distinctiveness (or specific region if registration to be limited in scope)
Questions?

Ask using the ‘Q&A’ function at the bottom of your screen
Thank you for attending