

REPORT

CHANGES IN THE REQUIREMENT FOR DESCRIPTION OF THE MARK IN TRADEMARK AND SERVICE MARK APPLICATIONS

March 20, 2008

Effective May 13, 2008, the United States Patent and Trademark Office (USPTO) is amending the Rules of Practice in Trademark Cases (37 C.F.R. §§2.32, 2.37 and 2.52). The revised rules will apply to all new U.S. applications to register a trademark or service mark that is not in standard characters. According to the revised rules, any new U.S. trademark or service mark application filed on or after May 13, 2008 that does not contain a standard character claim must contain a description of the mark. As to International Applications being extended to the United States under the Madrid Protocol, a description of the mark is mandatory only if there is a description in the basic application or registration, and a description is not permitted when there is no description in the basic application or registration.

Background

A mark in standard characters is a word mark that contains no design elements. A standard character claim is a statement in a trademark or service mark application that such a mark is in standard characters and that no claim is made to any particular font, style, size or color. The resultant registration covers any presentation of the word mark, regardless of font, style, size or color.

The newly revised rules will not apply to applications containing a standard character claim. However, they will apply to all other new U.S. applications (but not Madrid Protocol U.S. extensions).

The USPTO's stated reason for implementing this rule change is that the more expansive description requirement will enhance the capability of USPTO

examining attorneys and the public to conduct an accurate and comprehensive search of marks in the USPTO database.

The Required Description

In order for a description to be accepted, the description should state accurately what the mark comprises. For marks containing designs, the description should succinctly refer to each separate element of the design. For marks containing stylized lettering, it is not necessary to set forth the specific font in which the lettering appears; it is sufficient simply to reference what characters are featured and state that they appear in a stylized format.

Failure to comply with the description requirement will not affect the filing date of an application. However, if a USPTO Examining Attorney determines that the description is missing, inaccurate or incomplete, the Examining Attorney will generally issue an Office Action requiring presentation or amendment of the description. However, the Examining Attorney may enter a description by Examiner's Amendment, without authorization from the applicant, where the mark consists only of words in a stylized font, with no other design element. Such a requirement or Examiner's Amendment could be challenged on appeal.

Despite this new requirement, the descriptions will be printed in the Registration Certificate and Official Gazette only when the Examining Attorney has made an express determination that the description is necessary to clarify the nature of the mark. However, the description will always be included in the file of the application.

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Recommendation

In order to comply with this new rule, we recommend that, when sending us instructions to file a new U.S. trademark or service mark application for a mark not in standard characters, you provide a brief description of the mark. When such a description is not provided, where time permits, we will propose a suggested description for approval before filing the application. Otherwise, we will submit the application with a concise description of the mark, identifying all of the mark's relevant elements, to try to avoid the expense of an unnecessary Office Action or delay in registration, and will amend the description thereafter if requested.

The USPTO has announced that guidelines regarding descriptions will be posted on its website at <http://www.uspto.gov/web/offices/tac/notices/notices.htm>; however, those guidelines are not yet available as of the date of this Special Report. Please do not hesitate to contact us if you have any questions regarding this new description requirement.

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This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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