Course Description
Trademark Practice is a three-credit course that provides students with the fundamental skills necessary to represent clients in transactional trademark matters. Emphasis is placed on the practice of trademark law within the framework of specific business and strategic objectives. Students will be exposed to a variety of practical trademark topics, including the process of developing a trademark strategy, developing and protecting marks, the federal trademark registration process, trademark enforcement, and registration maintenance. Throughout the semester, students will prepare a variety of documents and filings in the course of representing a hypothetical client on various trademark matters. Student performance will be evaluated based upon the written work product as well as participation in class discussions.

Prerequisites
The course is open to all second and third year students who have completed a basic doctrinal course in trademark law and a course in legal writing.

Objectives
After completing the course, students will:

1. Understand the interplay between clients' business and strategic objectives and the practice of transactional trademark practice.

2. Understand the process of trademark identification, selection, protection, and registration, including federal trademark registration prosecution.

3. Recognize the importance of enforcing trademark rights and understand the remedies available to prevent or stop infringement or improper use of a trademark.

Grading
The final grade will be comprised of the following components:

Trademark Audit Memo	15%
Search Strategy & Applications for Federal Registration	25%
Response to an Office Action	25%
Cease & Desist Letter & Opposition Filing	20%
Trademark Usage Guidelines & License Agreement	15%

Case File
Throughout the semester, students will represent a hypothetical company in a variety of trademark matters. Such representation will require that students draft various documents, including materials for the client (e.g., letters, memoranda), legal filings (e.g., application for federal registration, infringement pleadings), and materials directed

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towards third parties (e.g., cease and desist letters). The specific issues will be raised in a series of scenarios and supporting documents that will be distributed periodically throughout the semester; these materials are analogous to what a practicing trademark attorney might receive from a client. Although each student will be working from the same set of facts and materials, the range of legitimate responses is diverse and varied. While the case files will be the subject of some class discussion, each student is expected to work independently on the case file project. Students are permitted to discuss the issues and the project with classmates, but each student must submit work that is entirely original.

Attendance and Deadline Policy
Absent prior arrangements, students are expected to attend every class and participate fully. Deadlines for written work submission are firm and extensions are only available under extraordinary circumstances. Such circumstances include, but are not limited to, serious illness (subject to verification), or extraordinary personal issues, such as a death in the family. Late work may be accepted at the discretion of the instructor, but subject to a reduction in the grade.

Resources
A set of required reading materials is available from the bookstore. In addition, students should have in-class access to a current version of the Lanham Act either in print or online. One particularly useful and comprehensive print resource is the current edition of SELECTED INTELLECTUAL PROPERTY AND UNFAIR COMPETITION STATUTES, REGULATIONS & TREATIES published by Thomson/West. Additional materials will be distributed from time to time either in class or via the course web site.

In addition to the assigned materials, students may find the following resources helpful:

<u>Branding & The Role of Trademarks in a Business Context</u>

Douglas B. Holt, *How Brands Become Icons* (Harvard Business School Press 2004).

Al Ries & Jack Trout, *Positioning: The Battle for Your Mind* (Warner Books 1981).

<u>Trademark Practice</u>

Kent Auberry, James Simmons & Elizabeth Wang, *Preparing U.S. Trademark Applications* (INTA 2002).

Glenn Spencer Bacal, Howard B. Barnaby, Thomas J. Hoffman, Harold D. Jastram, W. Mack Webner, *Trademark Administration* (INTA 1999).

Glenn A. Gundersen, *Trademark Searching* (INTA 2000).

James E. Hawes & Amanda V. Dwight, *Trademark Registration Practice* (West). Also available on Westlaw.

International Trademark Association, *State Trademark and Unfair Competition Law* (INTA 2005).

United States Patent and Trademark Office, *Trademark Manual of Examining Procedure*, available online at http://www.uspto.gov/web/offices/tac/tmep/. The book is also available from a variety of commercial publishers, but because it is updated so frequently, the online version is recommended.

Blogs:

Bridging the Gap, http://trademark-blawg.com/

The Trademark Blog, http://trademark.blog.us/blog/

The TTABlog, http://thettablog.blogspot.com/

WEEK	TOPICS	ASSIGNMENT
INTRODUCTION & REVIEW		
1	• Subject matter of trademark law • Role of trademarks in a competitive marketplace • Federal vs. state protections • Prerequisites for protection (distinctiveness and use) • Losing protection (abandonment and genericism)	*Quality Inns Int'l v. McDonald's Corp.*, 695 F.Supp 198 (D. Md. 1988). *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976). *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260 (5th Cir. 1975). *Thrifty Rent-A-Car System v. Thrift Cars, Inc.*, 831 F.2d 1177 (1st Cir. 1987). *California Cedar Products Co. v. Pine Mountain Corp.*, 724 F.2d 827 (9th Cir. 1984). *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y 1921). *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577 (2d Cir. 1963). *Microsoft Corp. v. Lindows.com, Inc.*, 2002 WL 32153471, 2002 U.S. Dist. LEXIS 26307 (W.D. Wash. May 13, 2002). *Hasbro, Inc. v. Goldman*, 2005 WL 2295194, 2005 TTAB LEXIS 378 (TTAB 2005).
UNDERSTANDING THE BUSINESS CONTEXT & MARK SELECTION		
2	• The role of branding in the enterprise	Randall S. Rozin, *Editorial: The branding iron: From cowboys to corporations*, BRAND MANAGEMENT, Sept. 2002, at 7. Hayes, Roth, *Wielding a Brand Name*, LATINCEO, Aug. 2001, at 64. Interbrand, *What Makes Brands Great: A Chapter from* Brands and Branding, Apr. 2004. Tim Leberecht, *True Blue: Internal Branding as a Strategic Corporate Communications Tool: A Case Study of JetBlue Airways*, BRANDCHANNEL.COM BRAND PAPERS (2004).

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WEEK	TOPICS	ASSIGNMENT
3	• Nontraditional branding • Brands as trademarks • Leveraging and exploiting trademarks • Brand valuation	Harvest Consulting Group, LLC, *BrandSense™: Building Brands with Sensory Experiences* (2001). Peter Philippe Weiss, *Not Just a Jingle*, BRANDCHANNEL.COM BRAND PAPERS (2004). Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TMR 773 (2005). Chiranjeev Kohli & Lance Leuthesser, *Brand Equity: Capitalizing on Intellectual Capital*, Mar. 2005. David D. Mouery, Student Author, *Trademark Law and the Bottom Line: Coke Is It!*, 2 BARRY L. REV. 107 (2001). Benjamin A. Goldberger, *How the "Summer of the Spinoff" Came to be: The Branding of Characters in American Mass Media*, 23 LOY. L.A. ENT. L. REV. 301 (2003). *Brand Valuation: A Chapter from* Brands and Branding, Apr. 2004.
4	• Developing a trademark strategy through client objectives.	Martin Jelsema, *Performing the Brand Audit*. Design Management Institute, Case Study, *Caterpillar: Working to Establish "One Voice."*
MARK SEARCHING		
5	• Mark search strategies • Search planning and execution • Searching drawings and nontraditional marks	Glenn A. Gundersen, *Trademark Searching*, Chapter 3. *Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666 (7th Cir. 1982). *International Star Class Yacht Racing v. Tommy Hilfiger, Inc.*, 146 F.3d 66 (2d Cir. 1998). *In re American Safety Razor Co.*, 2 US.P.Q.2d 1459 (TTAB 1987). *Jockey International, Inc. v. Butler*, 3 U.S.P.Q.2d 1607 (TTAB 1987).

WEEK	TOPICS	ASSIGNMENT
FEDERAL REGISTRATION PROCESS		
6	• Benefits of federal registration • Principal vs. supplemental register • Filing basis • Basic filing requirements	*Zirco Corp. v. American Telephone & Telegraph Co.*, 21 U.S.P.Q.2d 1542 (TTAB 1991). Alan C. Atchison, WHAT TO FILE: A PRACTITIONER'S GUIDE FOR CHOOSING THE PROPER TRADEMARK FOR FEDERAL REGISTRATION, 88 TMR 289 (1998). Lanham Act §§ 1, 2, 3, 4 TMEP Chapters 100, 200, 300, 400 (skim for general familiarity)
7	• Navigating the PTO's online services • Drafting goods and services descriptions • Disclaimer language	ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL, available online at http://tess2.uspto.gov/netahtml/tidm.html (skim for general familiarity). Peruse PTO online filing mechanisms and associated instructions. Lanham Act §§ 5, 6, 30 TMEP Chapter 800, 900 (skim for general familiarity)
8	• Range of responses from the PTO.	Sample materials. Lanham Act §§ 7, 12, 13, 16, 17, 20, 21 TMEP Chapter 700, 1200, 1300 (skim for general familiarity)
9	• Substantive rejections: immoral, scandalous, deceptive, disparaging; flags, symbols, or other insignia, names; portraits, or signatures that identify a living individual.	*In re Budge*, 857 F.2d 773 (Fed. Cir. 1988) *Harjo v. Pro-Football, Inc.*, 1999 WL 375907 (TTAB 1999), *rev'd*, *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96 (D.D.C. 2003). *In re Love Bottling Co.*, Serial 78/171,270 (TTAB 2005). File Wrapper & TTAB Briefs for Application Serial Number 78/281,746 (DIKES ON BIKES) *University of Southern California v. University of South Carolina*, 2003 TTAB LEXIS 367 (TTAB 2003). *In re VITAFLEX Dr. Walter Mauch GmbH*, 2002 TTAB LEXIS 443 (TTAB 2002).

WEEK	TOPICS	ASSIGNMENT
		Fanta v. Coca-Cola, 140 USPQ 674 (TTAB 1964). *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (TTAB 1950). *In re McKee Baking*, 218 USPQ 287 (TTAB 1983). *In re Masucci*, 179 USPQ 829 (TTAB 1973). Lanham Act §§ 2(a), (b), (c)
10	• Substantive rejections: likelihood of confusion	*In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). *In re BCPbank, N.A.*, Serial No. 76/513,504 (TTAB Sept. 7, 2005). *In re Wicked Fashions, Inc.*, Serial No. 78/145,261 (TTAB Aug. 12, 2005). *Zanella Ltd. V. Saroyan Lumber Co.*, Opposition No. 91153249. *In re Elegant Headwear Co.,* Serial No. 76/536,426 (TTAB Aug. 10, 2005). *Rivercat Foods, Inc. v. Sacramento River Cats Baseball Club, LLC*, Opposition No. 91150539 (on reconsideration) (TTAB Aug. 26, 2005). *Miguel Torres, S.A. v. Bodegas Muga S.A.*, Opposition No. 91112586 (TTAB June 10, 2005). Lanham Act § 2(d)
11	• Substantive rejections: merely descriptive, deceptively misdescriptive, geographic indicators, surnames, functionality; acquired distinctiveness.	*In re Pet Food Centers, LLC*, Serial No. 78/975330 (TTAB Sept. 9, 2005). *In re JPI Colorworkshop, Inc.*, Serial No. 78/107577 (TTAB July 26, 2005). *In re Bristol-Myers Squibb Co.*, Serial No. 78/222,332 (TTAB July 15, 2005). *In re California Innovations, Inc.*, 66 U.S.P.Q.2d 1853 (Fed. Cir. 2003). *Donya, Ltd. v. Donya Michigan Co.*, Cancellation No. 92033012 (Sept. 6, 2005).

WEEK	TOPICS	ASSIGNMENT
		In re Messrs. Picchiotti S.r.l., Serial No. 76/476489 (TTAB June 24, 2005). *In re Isabella Fiore, LLC*, U.S.P.Q.2d 1564 (TTAB 2004). *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (CCPA 1977). *In re Armament Systems and Procedures, Inc.*, Serial No. 75/107678 (TTAB Sept. 12, 2005). *In re Sullivan*, Serial No. 76/202254 (TTAB Aug. 18, 2005). Lanham Act §§ 2(e), (f)
POST-REGISTRATION: MAINTAINING & ENFORCING THE MARK		
12	• Post-registration maintenance • Avoiding genericism; developing trademark usage guidelines • Types of trademark infringement • Monitoring and policing the mark.	Sample trademark usage guidelines: Rollerblade, ABC Television, Turner Networks, Microsoft, Adobe. Harvest Communications, LLC, *Fwd: This Made me Laugh: How Viral Ad Parodies Impact Your Brand* (2001). Sample cease & desist letters and responses: Attrezzi and Maytag. Coexistence agreement between EMI Christian Music Group, Inc. and CSR Media, LLC. Sample Complaint: *Bohn & Associates Media, Inc. v. Bonneville International Corp.*, Case No. 05C-2677 (N.D. Ill. June 8, 2005). Lanham Act §§ 8, 9, 14, 15 TMEP Chapter 1600 (skim for general familiarity)
13	• Trademark licensing	Sample license agreements Lanham Act § 10
14	• Future of trademark law and the registration process.	Jerome Gilson & Anne Gilson LaLonde, THE LANHAM ACT: TIME FOR A FACELIFT?, 92 TMR 1013 (2002).

I. Trademark Basics Review

A. Basic Concepts

1. Review case – *Quality Inns International, Inc. v. McDonald's Corporation*, 695 F. Supp 198 (D. Md. 1988).
2. Primary purpose of trademark protection
    i. To protect names, titles, and slogans that serve as source identifiers for goods and services.
    ii. To protect the goodwill and reputation attributed to a particular company (source) with respect to their goods or services.
    iii. Reduce consumer confusion by providing a system by which one and only one user is permitted to use a mark on a particular class of goods or services.
3. The fundamental right of a trademark is to prevent others from using the same or a similar mark on identical or related goods.
4. Source of Protection
    i. The goals of trademark do not fit well with the goals and objectives of the "intellectual property clause" of the Constitution.
        a. No authors or inventors; no discoveries or writings!
    ii. Congress found authority under the Commerce Clause of the Constitution which allows them to regulate "Commerce…among the several States"
        a. Thus, for federal trademark law to apply, the trademark must be used in *interstate commerce* or such that it *affects* interstate commerce.
    iii. Federal trademark law codified in Title 15 of the United States Code, § 1051 *et. seq.* (all references herein refer to original Lanham Act sections rather than codified section numbers).

B. Distinctiveness

1. A word, name, or symbol must be distinctive in order to function as a trademark; it must create a distinct commercial impression
2. Spectrum of distinctiveness – *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).
    i. Generic
        a. Not capable of functioning as a trademark; not registerable
        b. Example: using the word "car" to sell automobiles
    ii. Descriptive
        a. Describes, in a direct manner, the nature, character, quality, or uses of a particular good or service.

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b. Capable of functioning as a trademark if it acquires secondary meaning
c. Example: "Honey Baked Ham" for baked ham, glazed with honey

iii. Suggestive
a. Vague description of the goods or services but requires some thought on behalf of the consumer to make the association
b. Example: "Rollerblade" for roller-skates that have the wheels in a straight line, like a blade

iv. Arbitrary
a. Words in common usage but applied to goods or services arbitrarily
b. Example: "Apple" for computers

v. Fanciful ("coined words")
a. Words that are made-up
b. May also be words that are part of the language but are not commonly used
c. Example: "Kodak"
d. Example: "Flivver" (real word that refers to an inexpensive, cheap car, but not widely known or used)

C. Acquiring Trademark Rights
1. Trademark rights arise from use – first in time, first in right
2. Registration not required, but confers additional rights
i. Nationwide rights; ability to secure a nationwide injunction
ii. Enhanced damages
iii. Prevent importation of infringing goods
3. Priority Use – *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260 (5th Cir. 1975) (dispute between two users of the identical mark on identical goods resolved in favor of the first party to use the mark legitimately in commerce).
4. Concurrent Use – *Thrifty Rent-A-Car System v. Thrift Cars, Inc.*, 831 F.2d 1177 (1st Cir. 1987) (registrant's nationwide rights subject to prior senior, though unregistered, user's remote use on identical services).

D. Losing Trademark Rights
1. Abandonment – 15 U.SC. §§ 1127, 1227 (abandonment generally); *California Cedar Products Co. v. Pine Mountain Corp.*, 724 F.2d 827 (9th Cir. 1984) (express abandonment).
i. Must have intent not to resume use
ii. resumption of use must be imminent
2. Genericism

i. The term used as a trademark is no longer distinctive as applied to the relevant goods and services.
ii. Genericized trademark examples:
    a. *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y 1921) (ASPIRIN).
    b. *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577 (2d Cir. 1963) (THERMOS).
    c. ESCALATOR
    d. NYLON
    e. KEROSENE
iii. Examples of current trademarks that are frequently used generically:
    a. XEROX (photocopiers)
    b. KLEENEX (facial tissues)
    c. ROLLERBLADE (inline skates)
    d. BAND-AID (plastic adhesive bandages)
    e. *Microsoft Corp. v. Lindows.com, Inc.*, 2002 WL 32153471, 2002 U.S. Dist. LEXIS 26307 (W.D. Wash. May 13, 2002) ("Windows" distinctiveness unsuccessfully challenged by Linux distributor).
iv. Trademark owner *can* "reclaim" a mark, but the expense of re-educating the public can be enormous.

3. Acts of Omission and Commission
    i. Improper use or failure to use – *Hasbro, Inc. v. Goldman*, 2005 WL 2295194, 2005 TTAB LEXIS 378 (TTAB 2005).
    ii. Assignment in gross
    iii. Naked licensing
    iv. Failure to police the mark
        a. No trademark symbol requirement (TM, SM, ®)
        b. Allowing use as a verb (e.g. "let's go Rollerblade")
        c. Allowing use as a possessive
    v. Express abandonment
        a. Sometimes done for various business or tax reasons

II. Business Considerations & Mark Selection

A. Role of Branding in the Enterprise
1. History & Purpose of Branding
    i. Randall S. Rozin, *Editorial: The branding iron: From cowboys to corporations*, BRAND MANAGEMENT, Sept. 2002, at 7.
    ii. Hayes, Roth, *Wielding a Brand Name*, LATINCEO, Aug. 2001, at 64.
    iii. Interbrand, *What Makes Brands Great: A Chapter from* Brands and Branding, Apr. 2004.

2. Brands Inside the Enterprise
    i. Tim Leberecht, *True Blue: Internal Branding as a Strategic Corporate Communications Tool: A Case Study of JetBlue Airways*, BRANDCHANNEL.COM BRAND PAPERS (2004).
3. Nontraditional branding techniques
    i. Harvest Consulting Group, LLC, *BrandSense™: Building Brands with Sensory Experiences* (2001).
    ii. Peter Philippe Weiss, *Not Just a Jingle*, BRANDCHANNEL.COM BRAND PAPERS (2004).
    iii. Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TMR 773 (2005).
4. Brands as Assets and Exploitation of Trademark Rights
    i. Chiranjeev Kohli & Lance Leuthesser, *Brand Equity: Capitalizing on Intellectual Capital*, Mar. 2005.
    ii. David D. Mouery, Student Author, *Trademark Law and the Bottom Line: Coke Is It!*, 2 BARRY L. REV. 107 (2001).
    iii. Benjamin A. Goldberger, *How the "Summer of the Spinoff" Came to be: The Branding of Characters in American Mass Media*, 23 LOY. L.A. ENT. L. REV. 301 (2003).
5. Brand Valuation
    i. *Brand Valuation: A Chapter from* Brands and Branding, Apr. 2004.

B. Developing a Trademark Strategy through Client Objectives
    1. Martin Jelsema, *Performing the Brand Audit*
    2. Design Management Institute, Case Study, *Caterpillar: Working to Establish "One Voice"*

III. Mark Searching (this portion of the course based largely upon the structure, information, and advice set forth in Glenn A. Gunderson, TRADEMARK SEARCHING (INTA 2002)).

A. Why search?
    1. No "duty to search" – *Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666 (7th Cir. 1982)
    2. Failure to search as bad faith – *International Star Class Yacht Racing v. Tommy Hilfiger, Inc.*, 146 F.3d 66 (2d Cir. 1998).

B. Search Planning (Gunderson, chapter 3)
    1. Strategy: file then search; search then file
    2. Basic information needed to search (marks, goods/services classes, geographic information, channels of trade, etc)
    3. Preliminary searches vs. full searches

C. Preliminary Search Resources
    1. PTO web site (federal registrations)
    2. State web sites (state registrations)
    3. Dictionaries
    4. Atlases and geographic dictionaries
    5. Telephone directories
    6. Industry trade publications
    7. General business directories
    8. Domain name registrations

D. Conducting the Search
    1. Database selection
    2. Prefix and suffix
    3. Irregular plural constructions
    4. Corrupted spellings
    5. Phonetic similarities
    6. Names
    7. Abbreviations
    8. Punctuation
    9. Synonyms
    10. Alternate spellings
    11. Doctrine of foreign equivalents – *In re American Safety Razor Co.*, 2 US.P.Q.2d 1459 (TTAB 1987).
    12. Visual equivalents – *Jockey International, Inc. v. Butler*, 3 U.S.P.Q.2d 1607 (TTAB 1987).

E. Searching for Designs and Nontraditional Marks
    1. Designs
        i. Design phrases
        ii. Design codes
    2. Trade dress
    3. Colors
    4. Animations
    5. Sounds
    6. Scents

F. Full Searches
    1. Commercial search services and databases
    2. Reviewing search reports
        i. Identifying and evaluating conflicting marks
            a. In use vs. abandoned
            b. Geographic considerations
            c. Goods/services class considerations
            d. Ownership considerations
            e. Famous Mark factors

IV. Federal Registration Process and Registration Maintenance

A. Benefits of Federal Registration (from Jane C. Ginsburg, Jessica Litman, & Mary L. Kelvin, TRADEMARK AND UNFAIR COMPETITION LAW: CASES AND MATERIALS 221-22 (Foundation Press 2001).
    1. Nationwide protection
    2. Incontestability
    3. Notice system
    4. Importation protection
    5. Counterfeit protection
    6. Evidentiary advantages
    7. Trademark notice (circle-R symbol)
    8. Confirmation of ownership and validity

B. Principal vs. Supplemental Register
    1. Principal
        i. Offers the most benefit
            a. Ability to secure a nationwide injunction
            b. Access to federal court without a minimum amount in controversy
            c. Enhanced damages (attorney's fees, treble damages)
            d. Prevent importation of infringing goods
    2. Supplemental
        i. Created in response to international law and to comply with various treaties
        ii. Typically filled with marks that fail to meet requirements for the principal register.
        iii. Typically descriptive marks
        iv. Wait here to "grow up" – within 5 years (usually) the mark may acquire secondary meaning and qualify for the principal register.
        v. Cannot file intent to use applications on the supplemental register
        vi. "Capable of functioning as a trademark" – typical language used to describe something on the supplemental register.

C. Filing Basis
    1. Use in Commerce – § 1(a)
    2. Intent to Use – § 1(b)
        i. Registration relates back to date of filing; constructive use date.
        ii. *Zirco Corp. v. American Telephone & Telegraph Co.*, 21 U.S.P.Q.2d 1542 (TTAB 1991).

D. Requirements for a Filing Date ("Magic 5")
    1. Name of the applicant
    2. Name and address for correspondence
    3. Clear drawing of the mark

4. Listing or description of the goods and services
5. Filing fee for at least one class ($335 per class, currently)

E. Alan C. Atchison, WHAT TO FILE: A PRACTITIONER'S GUIDE FOR CHOOSING THE PROPER TRADEMARK FOR FEDERAL REGISTRATION, 88 TMR 289 (1998).

F. Using the ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL.
   1. How *not* to use the Manual: TARR record for Serial Number 78/652,545.

G. Online Filing Mechanisms
   1. Trademark Electronic Application System (TEAS)
      i. Launches form wizard to create form for you
         a. Can bypass the wizard and use the Standard Form, but it's not recommended.
      ii. 60 minute timeout
      iii. Hyperlinks launch help pages and necessary definitions and explanations for virtually every question on the application.
      iv. Can submit an unsigned application (signature is not one of the magic 5) but must provide a signature later.
      v. Do not authorize e-mail communication with both the mark owner and the attorney – designate one to receive the communication.
   2. TEAS Plus
      i. Same requirements as TEAS, plus:
         a. Goods/service description must come directly from the ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL; and
         b. All required images, sound files, etc., must be included with the initial application; and
         c. Must pay the fees for *all classes* at the time of the filing; and
         d. Agree to file certain later communication (e.g., responses to office actions) electronically; and
         e. Agree to receive correspondence via e-mail.

H. Trademark Specimens

I. Responses from the PTO
   1. Examiner's Amendment – confirmation of changes made by the examiner, usually after a phone discussion with the applicant.
   2. Priority Actions – similar to office actions; 6 month response window, but if applicant replies within 2 months, the response receives priority attention.

3. Office actions – serve as an update on the legal status of the application. 6 month response time required to avoid abandonment.
    i. Formal – technical issues with the registration application; usually fixed easily.
    ii. Substantive – more difficult to overcome; require legal arguments, briefs, etc. See *infra*.
4. Suspension Letters – issued when the applicant's mark is confusingly similar to a prior applicant's mark. Junior applicant's application is suspended until status of senior applicant's mark is known.
5. Notice of Publication – issued after the examiner approves of the application; provides the date on which the mark will appear in the Official Gazette. Opposition period lasts 30 days.
    i. If no opposition is filed, or if no request for an extension is filed within the 30 day window, the registration process proceeds.
6. Notice of Allowance – issued in the case of an intent-to-use application after a mark's opposition period closes but before applicant files an Allegation of Use. Must file within 6 months or application will be declared abandoned.
    i. Can get extensions of the 6 month period; first is as of right, subsequent extensions require a legitimate business reason.
7. Certificate of Registration – issued upon conclusion of the opposition period, provided specimens of use are filed with the application. In the case of an intent-to-use application for which a notice of allowance has been filed
8. Notice of Abandonment – issued when applicant fails to respond to communication from the PTO within the prescribed time frame.
    i. Can "revive" an abandoned application upon payment of the appropriate fee and a declaration that the abandonment was unintentional.

J. Substantive Rejections
    1. Sec 2(a) -- immoral/scandalous, deceptive, disparaging
        i. Immoral or scandalous
            a. Virtually no legislative history
            b. Courts/TTAB tends to avoid the "immoral" language and focus instead on whether the mark is "scandalous"
                1. Considers the population as a whole and not just the market in which the mark is used.
                2. Applies contemporary values/opinion on what is scandalous (similar to the *Miller* standard for obscenity).

c. If there are two possible meanings (one scandalous; one not), the mark will typically be registerable.
d. Nudity and drug references are never registerable.
e. The burden is on the examiner to "prove" that the mark is scandalous to a substantial portion of the population.

ii. Deceptive
a. Deceptive marks are never registerable
b. Note difference between "deceptive" and "deceptively misdescriptive"
c. *In re Budge*, 857 F.2d 773 (Fed. Cir. 1988) – three part test:
1. Is the term misdescriptive of the character, quality, function, composition, or use of the goods?
2. If so, are prospective buyers likely to believe the misdiscription actually describes the goods?
3. If so, is the misdiscription likely to affect the decision to purchase?
d. Burden is on the examiner to show misdiscription causes the product to be more appealing or desirable to prospective purchasers.

iii. Disparaging/false implication of connection
a. *Harjo v. Pro-Football, Inc.*, 1999 WL 375907 (TTAB 1999), *rev'd*, *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96 (D.D.C. 2003).
b. *In re Love Bottling Co.*, Serial 78/171,270 (TTAB 2005).
c. File Wrapper & TTAB Briefs for Application Serial Number 78/281,746 (DIKES ON BIKES)
d. Cannot register a mark that disparages, falsely suggests a connection, brings someone into contempt or disrepute.
1. People
- Natural people (living or dead); someone must be alive to assert proprietary rights and bring an action.
- Juristic people (entity capable of suing and being sued)
- Different than registration bar under § 2(c) which only covers living beings.
2. Institutions – governments; similar to juristic persons

3. Beliefs
4. National Symbols
    - Subject matter that is of unique and special significance that, because of it meaning, appearance, or sound immediately suggests or refers to the country for which it stands.
        - ◊ Yes: Bald eagle, Statue of Liberty, Uncle Sam
        - ◊ No: Space Shuttle, Boston Tea Party
    - Not like § 2(b) which is a pure ban on coats of arms, flags, or other insignia. Here, *can* use national symbols, but cannot disparage them.

e. Four-part test for false connection
    1. Proposed mark is the same as or a close approximation of the name or identity of the person or institution; and
    2. The mark would be recognized as such in that it points uniquely and unmistakably to that person or institution; and
    3. The person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and
    4. The fame or reputation of the person or institution is such that when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

f. Two-part test for disparagement
    1. The mark must reasonably be understood as referring to the plaintiff; and
    2. The mark is disparaging – that is, it would be considered offensive or objectionable by a reasonable person of ordinary sensibility.

2. Sec 2(b) – flags, symbols, or other insignia (or simulations thereof)
    i. *University of Southern California v. University of South Carolina*, 2003 TTAB LEXIS 367 (TTAB 2003)
    ii. Includes marks where flags, symbols or insignia form the entire mark or a partial mark. Does not require contempt or disrepute; 2(b) serves as an absolute ban.
    iii. "Other insignia" has been narrowly interpreted as being various U.S. government seals (e.g., presidential, military),

or anything that represents the authority of the U.S. government.
    a. Things like the Statue of Liberty or the National Park Service logo have been held to not be insignia.
iv. What constitutes a "simulation"
    a. Must be an exact copy or nearly an exact copy (narrowly interpreted) – something that gives the appearance or effect, or demonstrates the characteristics of the original item.
    b. Mere inclusion of individual elements (e.g., stars from the flag), distorted images, or merely suggestive uses are not considered simulations.

3. Sec 2(c) – names, portraits, or signatures that identify a particular living individual, or deceased presidents during lifetime of widow without consent.
    i. "Name" interpreted very broad; can be any name or combination thereof (first, first + last, first + middle, etc)
    ii. "Particular Living Individual"
        a. *In re VITAFLEX Dr. Walter Mauch GmbH*, 2002 TTAB LEXIS 443 (TTAB 2002) – consent
        b. *Fanta v. Coca-Cola*, 140 USPQ 674 (TTAB 1964) – Robert Fanta claimed he worked at a soda fountain as a child and had developed the idea of tobacco flavored soda. He believed this made him so well-known in the industry that Coke's use of "Fanta" was unlawful; court disagreed.
        c. *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (TTAB 1950) – Well-known lawyer named Arnold Brand; same name being used on tomatoes. Court found use lawful because industries were different.
    iii. Portraits follow same rules.
        a. *In re McKee Baking*, 218 USPQ 287 (TTAB 1983)
        b. *In re Masucci*, 179 USPQ 829 (TTAB 1973)
    iv. Consent must be *to register* not merely *to use* the mark, must be in writing, and must be submitted with the application. Consent is implied if the applicant seeks to use his or her own name.
4. Sec 2(d) – confusingly similarity to a prior registration or application
    i. Examiners usually willing to work with applicants to approve the mark for registration; often requires crafting the goods & services language to narrow the class to avoid infringement.
    ii. PTO looks to the general *commercial impression* that is made by particular marks. Accordingly, small differences between marks are largely irrelevant.

iii. Application of the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973):
   a. Similarity or dissimilarity of the marks, in their entireties, as to appearance, sound, connotation, and commercial impression ("SAM test")
      1. Sound
         - Seyco/Seiko
         - Entelec/Intelec
         - Commcash/Communicash
         - Trucool/Turcool
      2. Appearance – minor additions or deletions will not overcome a 2(d) rejection.
      3. Meaning (in relation to goods/services)
         - City Woman vs. City Girl
         - AquaCare vs. WaterCare
         - Foreign words will be translated (doctrine of foreign equivalents)
         - Will look at marks in their entirety (anti-dissection rule)
         - Design marks can sometimes equal words (e.g. picture of a golden eagle and GOLD EAGLE mark)
      4. *In re BCPbank, N.A.*, Serial No. 76/513,504 (TTAB Sept. 7, 2005) (BEYOND THE EXPECTED not confusingly similar to BANKING BEYOND YOUR EXPECTATIONS)
      5. *In re Wicked Fashions, Inc.*, Serial No. 78/145,261 (TTAB Aug. 12, 2005) (LOT29 confusingly similar to LOT 53)
   b. Similarity or dissimilarity and nature of the goods and services as described in the application or registration or in connection with which a prior mark is in use ("SUM test")
      1. Similarity (purses and luggage)
      2. Used together (pancake syrup and pancake mix; beer and potato chips)
      3. Marketed together (wheelchairs and crutches)
      4. Evidence of relatedness:
         - Articles/press clippings demonstrating relationships between goods
         - Prior registrations in similar goods/services classes that

demonstrate connection between goods

5. Goods and services can be confused (Seiler for catering services and Seiler's smoked meats)
6. *Zanella Ltd. V. Saroyan Lumber Co.*, Opposition No. 91153249 (TTAB June 23, 2005) (no confusion for ZANELLA used on clothing and wood flooring)
7. *In re Elegant Headwear Co.,* Serial No. 76/536,426 (TTAB Aug. 10, 2005) (confusion likely between BABY'S FIRST used on bibs and infant footwear).

c. The similarity or dissimilarity of established, likely to continue trade channels.
   1. *Rivercat Foods, Inc. v. Sacramento River Cats Baseball Club, LLC*, Opposition No. 91150539 (on reconsideration) (TTAB Aug. 26, 2005) (two uses of RIVERCAT not confusingly similar because channels of trade are different).
d. The conditions under which, and buyers to whom, sales are made ("impulse" vs. "sophisticated" purchasing)
e. The fame of the prior mark (sales, advertising, length of use)
f. The number of nature of similar marks in use on similar goods (third party use).
   1. *Miguel Torres, S.A. v. Bodegas Muga S.A.*, Opposition No. 91112586 (TTAB June 10, 2005) (TORRE MUGA and design for wine weak because of, *inter alia*, extensive third party use)
g. The nature and extent of any actual confusion.
h. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion
i. The variety of goods on which the mark is or is not used (house mark, family mark, product mark)
j. The market interface between applicant and owner of the prior mark (prior consent, agreements, etc)
k. The extent of potential confusion (*de minimus* or substantial)

5. Sec 2(e) – merely descriptive, deceptively misdescriptive, geographic indicators, surnames, funcationality

i. 2(e)(1) – merely descriptive – cannot be registered until it acquires secondary meaning under 2(f) which is accomplished by either 5 years of use or using sales figures, marketing, etc., to show secondary meaning.
    a. A mark is merely descriptive if it directly describes an ingredient, quality, characteristic, function, feature, purpose, use, or intended users. (BED AND BREAKFAST REGISTRY for providing bed & breakfast services)
    b. If a mark is generic, a 2(e) office action is issued, but along with an advisory statement noting that the mark is generic.
    c. Can sometimes amend to the supplemental register, but must be actually using in commerce; no intent-to-use filings on the supplemental register.
    d. Combined words – can sometimes combine 2 or more descriptive terms to create a protectible mark provided the combination creates a distinct commercial impression.
    e. Laudatory terms (best, biggest, fastest, first) are considered to be descriptive.
    f. Phone numbers are generic (888-PATENTS for an IP firm; 800-FLOWERS for flower delivery service)
    g. *In re Pet Food Centers, LLC*, Serial No. 78/975330 (TTAB Sept. 9, 2005) (PLAY THINGS merely descriptive of "pet treats").
    h. *In re JPI Colorworkshop, Inc.*, Serial No. 78/107577 (TTAB July 26, 2005) (STRIPE WRITER not merely descriptive of pens with striped ink).
ii. Deceptively misdescriptive – a mark that immediately conveys an idea of an ingredient, quality, characteristic, function, or feature, but the idea is false but plausible.
    a. Can be registered if mark achieves secondary meaning, unlike a mark rejected under 2(a).
iii. 2(e)(2) – primarily geographically descriptive – marks where the primary association is geographic.
    a. Three-factor test
        1. Primary significance of the mark is geographic
            - Westpoint – city or military academy?
            - Cooperstown – city or Baseball Hall of Fame?
            - Hollywod – place or culture?

- Manhattan – borough or alcoholic drink?

2. Purchasers are likely to make a goods/place association
    - Must be a reasonable basis for concluding that the public is likely to believe the mark identifies the place in which the goods originate (manufactured, produced, sold)
    - Does not necessarily need to be a noted or famous location
3. Mark identifies the geographic origin of the goods or services.

b. *In re Bristol-Myers Squibb Co.*, Serial No. 78/222,332 (TTAB July 15, 2005) (PRINCETON PHARMACEUTICAL PRODUCTS found geographically descriptive).

iv. 2(e)(3) – primarily geographically deceptively misdescriptive

a. *In re California Innovations, Inc.*, 66 U.S.P.Q.2d 1853 (Fed. Cir. 2003)
    1. The primary significance of the mark is a generally known geographic location;
    2. The consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place; and
    3. The misrepresentation was a material factor in the consumer's decision.

b. Cannot be registered on the principal register unless they acquired secondary meaning before December 8, 1993.

c. Disclaimers ineffective; examiners and TTAB look only to the mark itself.

d. *Donya, Ltd. v. Donya Michigan Co.*, Cancellation No. 92033012 (Sept. 6, 2005) (ZHIGULY found deceptively misdescriptive for beer)

v. 2(e)(4) – surnames

a. Words that are more than just a surname are exempt; if a name has other meanings, it is less likely to be rejected on these grounds.

b. Factors
    1. Is the surname rare?; or
    2. The mark in question has the "look and feel" of a surname; or

3. Whether the term is a surname of anyone in the business

c. Combination of multiple surnames may be registerable due to the anti-dissection rule.
d. Marks like R.J. SMITH make a surname rejection more likely because the "R.J" (or comparable terms, like Mr. or Mrs.) makes it seem like more of a surname.
e. Burden is on the examiner to show mark is a primary surname. Examiners use phone books, newspaper/magazine articles about people with said surname, dictionaries (some with surname section), and use of the mark on a specimen.
f. *In re Messrs. Picchiotti S.r.l.*, Serial No. 76/476489 (TTAB June 24, 2005) (PICCHIOTTI held to be primarily a surname)
g. *In re Isabella Fiore, LLC*, U.S.P.Q.2d 1564 (TTAB 2004) (FIORE held to not be primarily a surname)

vi. 2(e)(5) – functionality (trade dress)
a. Usually argument comes down to whether its packaging or design; if it's a close call the examiners and courts will consider it design and require secondary meaning
b. Product design
1. Never inherently descriptive; qualifies only for the supplemental register and no intent-to-use filing available.
2. Never registrible if deemed functional; functionality can include ease or reduced costs to manufacture, easier to use, aesthetic functionality, non-reputational advantage.
c. Product packaging
1. Can be inherently distinctive
2. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (CCPA 1977).
- A common, basic shape or design?
- Unique or unusual in the field in which it is used?
- A mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods (as recognized by the public)?
- Is the design capable of creating a commercial impression distinct from the accompanying words?

d. *In re Armament Systems and Procedures, Inc.*, Serial No. 75/107678 (TTAB Sept. 12, 2005) (the color red held to be functional as to fake weapons).

6. 2(f) – acquired distinctiveness
    i. *In re Sullivan*, Serial No. 76/202254 (TTAB Aug. 18, 2005) (TRAFFIC LAW CENTER had achieved secondary meaning as to "legal services").

K. Post-Registration Maintenance
1. Section 8 (required; between fifth and sixth year of registration)
    i. Excusable nonuse
2. Section 15 (optional; after five years of continuous use)
3. Section 9 (required; between ninth and tenth year of registration)

L. Appealing to the Trademark Trial and Appeals Board

V. Maintaining, Enforcing, Using & Protecting the Mark

A. Avoiding Genericism
    i. Trademark standards manuals, graphic standards manuals
        a. Rollerblade, *Why It's Important to Use Trademarks Properly*
        b. ABC Television Logo Usage Guidelines
        c. Turner Networks Logo Usage Guidelines
        d. General Microsoft Trademark Guidelines
        e. Adobe Certified Program: Guidelines for Logos and Credentials
    ii. Trade advertising

B. Trademark "Torts" (limited treatment; covered in doctrinal trademark courses)
1. Infringement
    i. Different test for each circuit; know your circuit
    ii. INTA's *Annual Review* – good source for most recent developments in each jurisdiction.
2. Unfair competition/false designation of origin
3. Dilution
    i. Senior user's mark must be famous.
4. Cyberpiracy

C. Monitoring & Policing the Mark
1. Commercial Watch Services
    i. Receiving and evaluating watch reports (consideration of confusion factors set forth in relevant circuit test).
2. Registration with U.S. Customs

D. Dealing with Parody & Objectionable Publicity – Harvest Communications, LLC, *Fwd: This Made me Laugh: How Viral Ad Parodies Impact Your Brand* (2001).

E. Dispute Resolution
    1. Cease & desist demands
        i. Evaluate the likelihood of adverse responses
        ii. Prepare for declaratory judgment action
        iii. Sample letters and responses – Attrezzi, LLC and Maytag Corporation
    2. Letters of Protest
        i. Sent to the PTO by anyone with information that may prevent the registration of a mark.
        ii. Usually sent before the opposition period opens
        iii. Sent to the Administrator for Trademark Classification and Practice who will decide whether it should go to the examining attorney.
    3. Oppositions and Cancellations
        i. Oppositions – formal filings made during the public opposition period; opposer must believe it will be damaged by the registration of the mark. Legal arguments generally based on § 2 of the Lanham Act.
        ii. Cancellations – similar to oppositions, except cancellations relate to marks that are already registered
        iii. Proceedings take place before the TTAB and operate somewhat like trials, but testimony is entered through depositions. Oral arguments are granted upon request.
        iv. TTAB appeals
            a. U.S. Court of Appeals for the Federal Circuit; or
            b. Appropriate District Court
    4. Coexistence and Concurrent Use Agreements
        i. Coexistence agreements – marks that may appear confusingly similar but owners agree that such confusion will not occur and consent to each other's use and/or registration of their respective marks.
            a. Coexistence agreement between EMI Christian Music Group, Inc. and CSR Media, LLC
        ii. Concurrent use agreements – marks that are identical but owners believe that no confusion will ensue if both are used or registered.
        iii. Entering into such agreements allow both parties to use their marks within the parameters of the contract, but may be interpreted by courts to have weakened the strength of a particular mark.

5. Licensing – senior user of a potentially confusingly similar mark may be willing to allow junior user to license the mark within certain parameters.
6. Litigation
    i. Sample complaint – *Bohn & Associates Media, Inc. v. Bonneville International Corp.*, Case No. 05C-2677 (N.D. Ill. June 8, 2005).

F. Trademark Licensing
1. Types of licensing (based on list found in INTA's TRADEMARK LAW BASICS, conference materials from the Basics of Trademark Law Forum, Feb. 6-7, 2001, Washington, D.C.)
    i. Traditional licensing – marks used outside their normal market spaces (e.g., NFL team logos on clothing and apparel).
    ii. Promotional licensing – increased brand exposure in different market spaces and encourages consumer transfer from one space to another (e.g., McDonald's and the Olympics; Domino's Pizza and *The Apprentice*/NBC).
    iii. Brand extension licensing – mark used on closely related goods produced by someone other than the mark owner to expand the market position of a particular brand (e.g., United Airlines and United Express; Kodak on digital cameras).
    iv. Co-branding and endorsement licensing (affinity licensing) – marks used as components or otherwise closely intertwined with another product or service (e.g., "Intel Inside" or JetBlue Airways branded American Express credit cards)
2. Naked Licensing & Assignments in Gross – licensing without being associated with the underlying goodwill or reputation; invalid transfer and renders the mark virtually worthless.
3. Drafting Considerations – key terms to be considered:
    i. Definitions
    ii. Grant clause
        a. Specificity of the mark(s) to be licensed
        b. Exclusivity
        c. Territory
        d. Term
    iii. Royalty clause
        a. Lump sum (paid up license)
        b. Running royalty
        c. Complexities of royalty rate setting
    iv. Limitations on use of the mark
        a. Advertising and promotion guidelines
        b. Quality control provisions

v. Sublicensing issues
vi. Audit rights
vii. Infringement responsibility (who sues infringers?)
viii. Indemnity/hold harmless clauses
ix. Choice of venue, forum, and law
x. Insurance requirements
xi. Trademark attribution requirements (e.g., "CBS is a registered trademark of Viacom, Inc.")
xii. Most favored licensee clause
xiii. Notice, force majeure, transferability, no waiver, Voluntariness, integration, and counterparts clauses

G. Future of Trademark Law and the Registration System – Jerome Gilson & Anne Gilson LaLonde, THE LANHAM ACT: TIME FOR A FACELIFT?, 92 TMR 1013 (2002).

VOXSOFT SYSTEMS, INC.
PART 1: TRADEMARK AUDIT MEMO

TO: Able Associate

FROM: Pretentious Partner

RE: VS06-TM: VoxSoft Systems, Inc.
Trademark Audit

Congratulations! As a result of your hard work and dedication to the firm, along with your superior background in trademark law, you have been selected to work on the trademark matters for one of our biggest and most promising new clients. VoxSoft Systems, Inc., is a small but fast-growing software company that develops, distributes, and supports highly specialized and sophisticated production, editing, and playback software for broadcast operations, such as radio and television stations, cable networks, Internet broadcasters, mobile disc jockeys, and the like. The company was founded several years ago after two students wrote a small program to help automate their weekly radio show on the college radio station. After discussions with numerous radio industry executives, the duo recognized the commercial applications of their software and founded VoxSoft. The company recently incorporated under the laws of the State of Delaware. Today the company holds numerous patents on their software developments and has developed a suite of modular software packages, support services, and training programs aimed at audio industry professionals.

VoxSoft's ultimate goal is to become the world leader in professional software for the audio production and distribution industries. In support of this goal, its strategic plan calls for a long-term aggressive marketing and branding campaign to help develop the company's market position within the minds of key decision makers. At the heart of the new branding campaign will be a core "umbrella" identity that will have various branches corresponding to the various market sectors and job functions to which VoxSoft's products and services are targeted. In essence, the company desires to occupy the "top of mind" position in the field of professional audio production and distribution software.

As the company positions itself for rapid future growth, VoxSoft's in-house counsel is interested in evaluating the intellectual property landscape of its products, services, and the emerging branding campaign. The copyright and patent issues related to its software are already being handled by your colleagues. You have been assigned to handle all of the trademark issues relating to VoxSoft, which have been assigned the internal docket code VS06-TM.

Attached please find a brief memo that outlines the company's products and services and its traditional sales channels. Based upon this information, please prepare a brief memo (five to ten (5-10), single-spaced pages) that outlines your thoughts on VoxSoft's

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protectible trademark assets and the best way, in your opinion, to protect and exploit those assets.

VoxSoft Systems, Inc.

33 Regional Drive – Concord, New Hampshire 03301 – 603/555-1234 – 603/555-1255 (fax)

TO: Able Associate

FROM: VoxSoft General Counsel

RE: VoxSoft Products & Services Overview

VoxSoft Systems, Inc. offers a variety of products and services for the professional audio production and distribution industries. Our products are used in over 100 radio and television stations worldwide, in addition to numerous other companies, including digital music services and mobile disc jockeys. The following describes the company's product and services.

PRODUCT OFFERINGS

The heart of all VoxSoft installations is a network operating system known as Vox6, which resides on a central server and serves as the central nerve system for all other VoxSoft product offerings actually used by end-users. Unlike its other programs, Vox6 is only "used" by information technology professionals to drive enterprise-wide audio systems. End users of VoxSoft's other products (described more fully below) never know of Vox6 except for a unique 3-note chime that is heard every time the user boots up a client computer.

The entire package of Vox6-based offerings is marketed under the VoxSuite banner. Once a customer installs the core Vox6 operating system, the system is entirely modular and scalable – customers may buy as much or as little of the system as they desire, installing only those modules that are needed for a particular application. VoxSoft recently hired a graphic design firm to create a visual identity for its software offerings, the center of which is the VoxSuite logo (see Attachment 1).

VoxStudio is the software component used in radio and TV studios for rapid playback of audio content. The program features a very distinctive layout that is easy to learn and use on the fly – perfect for broadcast installations where employee turnover is often quite high and where speed and accuracy is of paramount importance. The company is also contemplating a consumer-grade version of VoxStudio to compete with Apple's iTunes or Nullsoft's Winamp. The consumer-grade version would likely be made available, free of charge, to those who visit the VoxSoft web site.

VoxLive is very similar to VoxStudio except it contains additional features that are of particular use for live operations, such as television newscasts, or mobile disc jockeys. Its layout looks quite similar to that of its studio-based counterpart except with less emphasis on timing and scheduling mechanisms that are central to VoxStudio.

VoxScript is a programming and sequencing module that is used by broadcast programmers to setup playlists and programming sequences for future use. This program allows the programmers to structure programming elements (music blocks) and commercials and then send a master log to studio (for display and playback in VoxStudio).

VoxEdit is the audio editing component of the software suite, which provides basic audio manipulation capability. VoxEdit is used by producers, directors, and other behind-the-scenes crewmembers to prepare material that will eventually be broadcast or otherwise presented to audiences. As with VoxStudio, the company is contemplating a consumer-grade release of VoxEdit which would provide basic audio editing functionality for amateur and hobbyist producers.

Currently, all of the software herein discussed is sold directly to end users by VoxSoft. As the company positions itself for future growth, however, VoxSoft is contemplating the development of a network of licensed dealers throughout the world. Such dealers would be authorized and licensed to perform the pre-installation consultation, the software and systems installation, and post-installation support services (discussed below). The consumer-grade offerings would be distributed through conventional retail sales channels, including bricks and mortar stores (e.g., Best Buy, Circuit City), catalog retailers, and online retail partners.

SERVICE OFFERINGS

Before selling or installing anything at a client's site, VoxSoft's team of consultants visits the customer's site and determines which products and services will be of most value to the end users. In addition to the pre-installation services, the company also offers ongoing on-call support and system management services marked as VoxAssurance. For an annual fee, customers are able to call a dedicated 24/7 customer service hotline to receive immediate responses to issues with mission-critical systems. In addition, customers with VoxAssurance service contracts receive the latest updates and service patches for the various software programs that the customer has in service.

Because the software is highly sophisticated, a secondary market has developed over the years in offering training services for various aspects of the programs. To capitalize on this trend, VoxSoft developed a certification program that includes a structured curriculum and testing program. There are three certification levels: VoxSoft Certified Professional, VoxSoft Certified Expert, VoxSoft Certified Trainer. Together, the certification program is marketed simply as VoxSoft Training Services. Individuals who successfully complete the training programs receive a certificate, the right to call themselves VoxSoft Certified (at the appropriate level of certification) and access to a variety of proprietary support and marketing materials, including use of the VoxSoft certification seal.

ATTACHMENT 1:
VOXSUITE LOGO



TO: Able Associate

FROM: Pretentious Partner

RE: VS06-TM: VoxSoft Systems, Inc.
Trademark Search & Registration

VoxSoft's General Counsel was very impressed by the memo that you prepared outlining the potentially trademarkable subject matter that exists within their enterprise and the way those assets might best be protected and exploited. After thorough review of your memo, the company's strategic goals as well as their current financial picture, VoxSoft has decided to pursue federal registration on two of its marks. We have received approval from VoxSoft general counsel to begin the application process for federal registration. Because VoxSoft does not have in-house trademark counsel, our firm has been authorized to handle all aspects of the registration process.

For the purposes of this assignment, you are to prepare a search strategy and report as well as applications for federal registration for (1) the VoxSuite logo presented in Part 1 of the VoxSoft Systems, Inc. case file; and (2) any one additional mark of your choosing that was discussed in your memo from Part 1.

In your search strategy and report, please list the databases that you would use and the rationale behind each (only a brief explanation is necessary). Also list the search terms and design codes that you would use to ensure a complete review of each mark. The search strategy and associated explanatory remarks should be no longer than five (5) pages for each mark; there is no minimum number of pages.

You have been authorized to file electronic applications for federal registration on the principal register, but VoxSoft wants to keep the option of filing future documents relating to these applications on paper. Accordingly, please use the appropriate form on the Patent and Trademark Office (PTO) web site (http://www.uspto.gov). For this assignment, you are to complete the application in its entirety, based upon the information provided in the Case File; your application must have more than merely the minimum filing requirements discussed in class. You should consult the Acceptable Identification of Goods and Services Manual, available online at http://tess2.uspto.gov/netahtml/tidm.html, when drafting your goods/services descriptions.

After completing an application, you must validate the form. After validating the form (and remedying any issues that may have arisen), click on the input link in the "Application Data" box; the resulting application input page for each application should be submitted with your search strategies.

Should you find yourself in need of any additional information from the client to successfully complete this assignment, please state the information that you require and/or your assumption(s) and how such information or assumptions would affect your mark search strategy or application process. Cite to the Trademark Manual of Examining Procedure, available at http://tess2.uspto.gov/tmdb/tmep/, where appropriate.

TO: Able Associate

FROM: Pretentious Partner

RE: VS06-TM: VoxSoft Systems, Inc.
Response to a Trademark Office Action

Thank you for your hard work on those trademark applications. I am confident they will sail through the Office with no problems. Unfortunately the same cannot be said for an application filed by your predecessor, Lazy Lester. We just received an Office Action on serial number 99123456 for the mark VOXSTUDIO. It seems Lester missed a few things when preparing the application. Worse, it appears that the examiner believes there is a confusingly similar mark that is already registered. I am not exactly sure what the precise issues are, but I know that with your strong background in trademark law, you will be able to keep our client happy by pushing the registration through the Office.

Please prepare a response to this Office Action; your response may be no more than ten (10) double-spaced pages, though you should not feel compelled to fill all ten pages. Although we will likely submit the response via the Office's web-based system, you need not concern yourself with the details of such submission. Please prepare your response consistent with the requirements set forth on the Office Action itself and the *Trademark Manual of Examining Procedure*. You may also want to consult responses to Office Actions that we have reviewed in class or that you find on your own using the Trademark Document Retrieval system on the Office's web site. To prepare an effective argument to the examiner, you will need to look beyond the cases and authorities we have read for and discussed in class.

Attached to this memo you will find a copy of the application input page for the application filed by Lazy Lester and the Office Action, which includes a copy of the registration information for the mark that is, allegedly, confusingly similar to our application. Please do not look beyond these materials for information regarding the marks; any resemblance to real registered marks is purely coincidental.

PTO Form 1478 (Rev 4/93)
OMB Control #0651-0009 (Exp. 09/30/2008)

Trademark/Service Mark Application, Principal Register

The table below represents the data as entered.

Input Field	Entered
MARK SECTION	
MARK	VOXSTUDIO
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	VOXSTUDIO
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
OWNER SECTION	
NAME	VoxSoft Systems, Inc.
STREET	33 Regional Drive
CITY	Concord
STATE	NH
ZIP/POSTAL CODE	03301
COUNTRY	United States
PHONE	603-555-1234
FAX	603-555-1255
AUTHORIZED EMAIL COMMUNICATION	No
LEGAL ENTITY SECTION	
TYPE	APPLICANT ENTERED NO DATA
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	009
DESCRIPTION	Apparatus for programming, editing, scheduling, and automating the operations of radio stations by means of computer technology.
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	06/10/2004
FIRST USE IN COMMERCE DATE	07/01/2004
SIGNATURE SECTION	
SIGNATURE	/ll/
SIGNATORY NAME	Lazy Lester
SIGNATORY DATE	10/22/2005

SIGNATORY POSITION	Attorney
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	325
TOTAL AMOUNT	325
ATTORNEY	
NAME	Lazy Lester
FIRM NAME	Pierce & Associates, LP
STREET	2 White Street
CITY	Concord
STATE	New Hampshire
ZIP/POSTAL CODE	03301
COUNTRY	United States
PHONE	603-228-1541
FAX	603-228-1074
EMAIL	trademarks@pierceassociates.com
AUTHORIZED EMAIL COMMUNICATION	Yes
ATTORNEY DOCKET NUMBER	VS06-TM
CORRESPONDENCE SECTION	
NAME	Lazy Lester
FIRM NAME	Pierce & Associates, LP
STREET	2 White Street
CITY	Concord
STATE	New Hampshire
ZIP/POSTAL CODE	03301
COUNTRY	United States
PHONE	603-228-1541
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AUTHORIZED EMAIL COMMUNICATION	Yes

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 99/123,456

APPLICANT: VOXSOFT SYSTEMS, INC.

99123456

CORRESPONDENT ADDRESS:
PIERCE & ASSOCIATES, LP
2 WHITE STREET
CONCORD, NH 03301

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: VOXSTUDIO

CORRESPONDENT'S REFERENCE/DOCKET NO:
VS06-TM

CORRESPONDENT EMAIL ADDRESS:
trademarks@pierceassociates.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTH OF OUR MAILING OR E-MAILING DATE.

Serial Number 99/123456

The assigned trademark attorney has reviewed the referenced application and determined the following.

Likelihood of Confusion

The examining attorney refuses registration under Trademark Act § 2(d), 15 U.S.C. § 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration No. 9215212 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP § 1207. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E.I. DuPont de Nemours & Co*., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second the examining attorney

must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp*., 197 UPQ 910 (TTAB 1978); *Guardian Products Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The Latin term VOX is translated and defined as "voice."

The marks of the parties are very similar. The applicant applied to register the mark VOXSTUDIO for computer technology that facilitates the operation of radio stations. When translated into its English equivalent, pursuant to the foreign equivalents doctrine, the applicant's mark reads VOICESOFT. The registered mark is THE STUDIO VOICE. The overall commercial impression of both marks is highly similar since both marks utilize the same words "voice" and "studio," but merely transposed from one another. The presence of the word "the" in the registered mark, and its absence in the applicant's mark is *de minimis*. Accordingly, the marks are confusingly similar.

The goods of the parties are very related. The applicant is providing an "apparatus for programming, editing, scheduling, and automating the operations of radio stations by means of computer technology. The registrant is providing a "digital audio system comprising of hardware and software intended to play music for use with radio broadcasting applications." Both are providing software to radio professionals. The goods of both parties are likely to be encountered by the same consumers. The marketing of both goods might also be such that consumers would be likely to believe that both goods came from the same source. Since the marks of the parties are very similar, and the goods are highly related, registration must be refused on the Principal Register under § 2(d) of the Trademark Act.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

State of Incorporation

Applicant must state its state of incorporation. 37 C.F.R. § 2.32(a)(3)(ii); TMEP §§ 803.03(c) and 803.04.

Identification of Goods – Unacceptable

The identification is indefinite because the applicant uses the wording "apparatus" and "by means of computer technology." The identification of goods must be specific. The applicant must amend the identification to specify the common commercial name of the goods or to indicate their nature. The identification must be all-inclusive. The applicant should amend the application to replace this wording with "namely." Also, the identification of goods is too broad because it could include goods in other classes.

Specimens

The applicant must submit specimens showing use of the mark for the goods specified. 37 C.F.R. §§ 2.56, 2.58. Appropriate specimens for the goods include specimens that show the mark on labels for the goods, packaging for the goods, or on the goods themselves. The applicant must verify, with an affidavit or declaration under 37 C.F.R. § 2.20, that the substitute specimens were in use in commerce at least as early as the filing date of the application. 37 C.F.R. § 2.59(a); TMEP § 904.09.

If the applicant has any questions or needs assistance in responding to this Office Action, please telephone the assigned examining attorney.

Thank you,
/Eric T. Examiner/

Eric T. Examiner
United States Patent & Trademark Office
Trademark Examiner
Law Office 120
703-555-1234-21

How to respond to this Office Action:

You may respond using the Office's Trademark Electronic Application System (TEAS) (visit http://www.uspto.gov/teas/index.html and follow the instructions therein), but you **must** wait until at least **72 hours** after receipt of the e-mailed office action. ***PLEASE NOTE:*** *For those with applications filed pursuant to Section 66(a) of the Trademark Act, all responses to Office Actions that include amendments to the identifications of goods and/or services must be filed on paper, using regular mail (or hand delivery) to submit such response. TEAS cannot be used under these circumstances. If the response does* ***not*** *include an amendment to the goods and/or services, then TEAS can be used to respond to the Office Action.*

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at **http://www.uspto.gov/main/trademarks.htm**

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Thank you for your request. Hear are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-10-20 15:17:26 ET

Serial Number: 99582592

Registration Number: 9215212

Mark:

THE STUDIO VOICE

(words only): THE STUDIO VOICE

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-04-12

Filing Date: 2004-03-25

Transformed into a National Application: No

Registration Date: 2005-04-12

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 – File Repository (Franconia)

Date In Location: 2005-07-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Radio Software Company, LLC

Address:

Radio Software Company, LLC
219 Computational Drive
Chicago, IL 60652
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009
digital audio system comprising of hardware and software intended to play music for use with radio broadcasting applications.
First Use Date: 1998-06-01
First Use in Commerce Date: 1998-06-01

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-04-12 - Registered - Principal Register

2005-01-18 - Published for opposition

2004-12-29 - Notice of publication

2004-11-08 - Law Office Publication Review Completed

2004-11-08 - Assigned To LIE

2004-10-29 - Assigned To LIE

2004-10-26 - Approved for Pub - Principal Register (Initial exam)

2004-10-22 - Teas/Email Correspondence Entered

2004-10-11 - Communication received from applicant

2004-10-11 - TEAS Response to Office Action Received

2004-10-09 - Non-final action e-mailed

2004-10-09 - Non-Final Action Written

2004-10-09 - Case file assigned to examining attorney

2004-04-05 - TEAS Preliminary Amendment Received

2004-04-01 - New Application Entered In Tram

CORRESPONDENCE INFOMRATION

Correspondent:
Office of General Counsel
RADIO SOFTWARE COMPANY, INC.
219 COMPUTATIONAL DRIVE
CHICAGO, IL 60652

Phone Number: 312-555-1632
Fax Number: 312-555-9521

TO: Able Associate

FROM: Pretentious Partner

RE: VS06-TM: VoxSoft Systems, Inc.
Cease & Desist Letter & Preparation of Opposition Filing

Thanks for cleaning up that messy Office Action – I trust that after your response, the PTO will register the mark in due course. Right now, though, it looks like we may have another problem on our hands. One of the paralegals has just stumbled upon a mark that raises some issues with respect to one of VoxSoft's recently registered marks. I have attached the Watch Notice for your review. I will talk to VoxSoft's general counsel sometime within the next couple of weeks to get a sense of how they would like to proceed. In the meantime, I think we should be prepared for a fight.

Can you please prepare a cease & desist letter to the applicant of the new mark? The letter should be no more than two full pages and explain the basis of the request to cease and desist and lay out the basics of our legal arguments against the applicant.

Also, though I don't know if we will go down this road or not, please prepare an opposition filing to the PTO. Your opposition should be consistent with PTO standards, including the rules set forth in the Trademark Manual of Examining Procedure § 1503. Please limit your opposition filing to six double-spaced pages.

In both the letter and opposition, please be sure to cite to appropriate authority to support your propositions.

DIGIWATCH

Digiwatch Services Group
123 Main Street
Methuen, MA 01844

Your Ref: VS06-TM

PIERCE & ASSOCIATES, LP
2 WHITE ST
CONCORD NH 03301-7850
UNITED STATES

WATCH NOTICE

Mark Watched	*Mark Reported*
VOX 6	SIXTH VOICE
Watched registers: United States	Register: United States Intl. Classes: 41 Goods/services: Consulting services, namely installation, maintenance, and support of computer networks, hardware, and software related to electronic media distribution.
	Applicant: Computer Data Networks 201 Central Processor Drive Overland Park, KS 66062 Attorney of Record: Robert Stilton, Esq.
	Filing No: 99/638,332 Filing Date: 14 Oct 2005 Publication Date: 07 Mar 2006 Publication Page: 12102
	OPPOSITION PERIOD CLOSE DATE: 07 APR 2006

VOXSOFT SYSTEMS, INC.
PART 5: LICENSE AGREEMENT

TO: Able Associate

FROM: Pretentious Partner

RE: VS06-TM: VoxSoft Systems, Inc.
Trademark Usage Guidelines & License Agreement

You may remember from VoxSoft's initial memo to you at the beginning of the semester that one of the company's offerings is a certification program that allows radio information technology professionals that attest to their competencies with certain VoxSoft products. After taking certain training courses and associated standardized tests, participants earn the right to call themselves either a VoxSoft Certified Professional, Certified Expert, and Certified Trainer, depending on the level of achievement that is accomplished.

Although the program has been underway for several months now, VoxSoft has not been formally marketing it. In preparation for expanding the program and promoting it through more mainstream channels, VoxSoft wants to take steps to ensure that the trademarks related to its certification are used properly. Specifically, VoxSoft's general counsel has asked us to draft trademark usage guidelines for the marks as well as a trademark license agreement that successful candidates will be asked to sign as a prerequisite to their certification. For simplicity, VoxSoft would like one set of guidelines and one agreement that cover the use of all three marks. Despite the desire for a uniform agreement, the language must be crafted in such a way that only individuals properly certified at a particular level will be allowed to use the mark for that certification (e.g., Certified Professionals may not use the Certified Trainer mark).

Please annotate your agreement with a short explanation of each clause and the reasons you chose to draft it the way you did. While you are welcome to use formbooks, sample agreements, and any other resources you desire in drafting the usage guidelines and associated agreement, the work you submit must be substantially original. In cases where you reasonably believe that a formbook or sample agreement provides the best way of drafting a particular clause, you may use it, provided, however, that you justify your use of such clauses in the annotations.

Students seeking a discussion of the basic principles of contract drafting are urged to obtain Kenneth A. Adams, A MANUAL OF STYLE FOR CONTRACT DRAFTING (ABA Pub. 2004).

Your agreement must be no more than five (5) single-spaced pages, including annotations; your trademark usage guidelines should be in the form of an attachment and no more than one (1) single spaced page.