

IP LANDSCAPE™

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Best Practices for a Successful Letter of Protest

A letter of protest is an informal procedure that allows third parties to contest registration of a trademark before the official period of objection (TMEP 1715); 37 CFR 2.101(b). A letter of protest's purpose is to aid in the examination of a pending trademark application, without causing delay or compromising the integrity and objectivity of the process (TMEP 1715). A letter of protest is most often accepted when: there is a high likelihood of confusion with a registered mark or pending application; the proposed mark is generic and/or descriptive; or the proposed mark uses an already registered mark. *Id.* at 1715.01(a)(1-3). A letter of protest will not be accepted if it relates to: common-law prior use, ownership dispute, or mere disagreement with the examining attorney. *Id.* at 1715.01(b)(1-3). Most importantly, a letter of protest must be factual and objective. *Id.* at 1715.01(a)(1). Below are some of the best practices to produce a successful letter of protest.

A letter of protest should be filed as soon after the subject application is filed, and a letter of protest is much more successful when it is filed before publication. *Id.* at 1715.03(b). A letter of protest that is filed pre-publication is accepted when the evidence provided is both relevant and reasonable to support refusal; whereas after publication, a letter of protest will only be accepted if the provided evidence shows clear error on part of the USPTO. *Id.* at 1715.02(a); *Id.* at 1715.03(a). Also, letters of protest are generally denied if filed more than 30 days after publication. *Id.*; 37 CFR 2.101(c); See *In re BPJ Enter's. Ltd.*, 7 USPQ2d 1375, 1378 (Comm'r Pats. 1988).

If prior pending applications will help support refusal due to likelihood of confusion, submit a separate chart containing the applications and registrations of each, including the serial number(s), mark(s), and relevant goods and services (TMEP 1715.04). If the letter of protest exceeds 75 pages, an index of the evidence must be included, but an index is highly recommended for all submissions. *Id.* The index should contain succinct factual descriptions of each category included, and it should never contain arguments or the identity of the protestor. *Id.* If the letter of protest applies to multiple applications, then a separate letter of protest for each subject application should be filed. *Id.*; 37 CFR 2.104(b).

The evidence submitted in support of refusal should be concise, relevant, factual, and objective (TMEP 1715.04). Any arguments or irrelevant evidence will not be forwarded to the examining attorney. If the asserted issue is likelihood of confusion with a federally registered mark or prior pending applications and the goods/services are identical, then only the relevant registration or application serial number(s) need be submitted, but if the goods and services are not identical, then objective evidence should be provided showing relatedness of the goods/services. *Id.* If the issue is that the subject application is descriptive or generic and the evidence includes third-party registrations, copies of the registration certificates should be included. *Id.* A list of the registrations or copy of a search report will not be proper evidence. *Id.*

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