February 23, 2015

Mary Denison
Commissioner for Trademarks
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Request for Comments Concerning a Draft Examination Guide on Repeating-Pattern Marks

Dear Commissioner Denison:

I write on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) in response to the United States Patent and Trademark Office’s (the “USPTO”) request for comments concerning a draft examination guide on repeating-pattern marks. The American Bar Association is the largest voluntary professional association in the world, and its IPL Section is the largest intellectual property association with approximately 23,000 members. The views expressed in this letter are presented on behalf of the ABA-IPL Section. These comments have not been approved by the House of Delegates or Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the views of the Association.

The Section appreciates the USPTO’s invitation to provide constructive input on the draft of the examination guide on repeating-pattern marks. The Section is pleased that the Trademark Manual of Examining Procedure (the “TMEP”) will soon have a section dedicated exclusively to repeating-pattern marks, which have unique characteristics that warrant independent consideration.

The Section supports the USPTO’s draft version of the examination guide and provides the following comments to clarify and highlight a few important issues.

Refusals

The Section recommends adding to footnote 34 of Part III.A.1 a citation to Bd. of Trs. of the Univ. of AL v. Potts, 107 U.S.P.Q.2d 2001, 2025 (T.T.A.B. 2013) (finding the use of houndstooth fabric by opposer to be “nominal ornamental” and not used in a “distinctive manner” that would create a source association).
Part III.A.3 cites to TMEP § 1212.05(a) but appears to omit important language from that section. Specifically, Part III.A.3 states that for repeating-pattern marks that are not inherently distinctive, “evidence of five years’ use, by itself, is insufficient to show acquired distinctiveness. Instead, actual evidence is required to establish acquired distinctiveness.” The use of the word “instead” could erroneously suggest that the five-year period of substantially exclusive and continuous use referenced by Section 2(f) of the Lanham Act, § 1052(f), no longer applies and has been replaced by simply providing actual evidence to establish acquired distinctiveness. In addition, the proposed wording does not explain the type of actual evidence that the applicant must provide. To clarify the rule and comport with the language of TMEP § 1212.05(a), as well as with 15 U.S.C. § 1052(f), the Section suggests revising the wording to, “evidence of substantially exclusive and continuous use of a mark for five years, by itself, is insufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would also be required to establish distinctiveness.”

Examples

In Part V, example No. 4 (U.S. Registration No. 4100365 on the Supplemental Register), the “Note” is unclear as to whether the broken lines as reflected in the example were acceptable or not acceptable. The “Note” does not reference the particular mark shown. Instead, the wording within the note makes generalized statements about the rule, without referencing how it applies to the particular example. The USPTO may wish to clarify the “Note” provided in the example or select another example.

General Comment

The draft uses “repeating-pattern mark” (hyphenated) and “repeating pattern mark” (no hyphen) interchangeably throughout the draft. Four examples appear within the text of the phrase “repeating-pattern mark” without a hyphen. These four instances occur in Parts I.B, II.A.1.c, II.A.2, and II.D. The Section suggests using “repeating-pattern mark” uniformly throughout the examination guide when “repeating pattern” is used as an adjective.

Conclusion

The Section appreciates the opportunity to provide the above comments. If you have any questions or would like to discuss any of these comments please feel free to contact me. Either I or another member of the leadership of the Section will gladly respond to any inquiry.

Very truly yours,

Lisa A. Dunner
Section Chair
American Bar Association
Section of Intellectual Property Law