March 16, 2017

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 Incapable Informational Matter

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 incapable informational matter (the “Guide”).

These views have not been approved by the House of Delegates or the Board of Governors of the American Bar Association, and, accordingly, should not be considered as representing the position of the Association.

The Section appreciates the USPTO’s invitation to provide constructive input on the Guide. The Section is pleased that the Trademark Manual of Examining Procedure (the “TMEP”) will soon have a section dedicated exclusively to incapable informational matter, which have unique characteristics that warrant independent consideration.

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

I. BACKGROUND

The Section suggests the adoption of the following language and case law citation at the end of the first paragraph of the section entitled “Background”. The Section believes that this new language will clarify that the burden of proof lies with the applicant to prove the mark is registrable.
An applicant, seeking to register a mark, has the burden of proving that the mark is registrable.

[footnote to the following citation: MNI Mgmt., Inc. v. Wine King, LLC, 542 F. Supp. 2d 389, 404 (D.N.J. 2008) (citation omitted) (“Unregistered marks have no presumption of validity . . . . Thus, a plaintiff must prove that an unregistered mark is valid and protectable.”)]

In the Guide, the terminology “prima facie case” is used frequently before there is an explanation of what it means in the context of this analysis. The Section recommends adding the following sentence at the end of the paragraph on page 2 that begins with, “These types of incapable informational matter do not function as marks because…”:

“If a prima facie case establishes that the matter is incapable and fails to function as an indicator of the origin of the identified goods/service, then a refusal is appropriate. The burden then shifts to the applicant to show that the wording would be perceived as a mark.”

For greater clarity, the Section recommends that the underlined sentence on page 2, shown below be inserted as follows:

“A request for information from the applicant may also be issued pursuant to Trademark Rule 2.61(b). This request typically accompanies a refusal. In the rare case where the requirement is issued without a refusal, the basis for the inquiry must be explained in the Office action.”

The Section further recommends that the following paragraph on page 2 be amended as follows:

“If, after review of the available evidence, the examining attorney determines that no refusal should issue due to the inability to establish a prima facie case, “then a Note to the File should be entered that indicates which sources were checked.”

II. REFUSALS

In Part A.1., the Section recommends breaking up the long sentences and adding additional information to distinguish failure-to-function refusals from descriptiveness refusals. In particular, the Section recommends the following revision to the paragraph that begins, “Though this failure-to-function refusal is similar to the descriptiveness refusal...” on page 3:

“Though this failure-to-function refusal is similar to the descriptiveness refusal, the two refusals differ regarding the focus of analysis. In the failure-to-function refusal, the focus is primarily on whether the use of the wording by the applicant and third-parties will be perceived as an indicator of a single source of origin. The type of information conveyed can vary, e.g., the
environmentally friendly manufacturing process for the goods, the certification process for the goods, or the superior qualities of the goods. So long as the use of the wording conveys information about the goods/services rather than indicates source, this refusal likely applies. Another distinguishing characteristic of the failure-to-function refusal is that unlike a descriptiveness refusal, the matter cannot gain secondary meaning or acquire distinctiveness. The following examples from case law illustrate this point:

Additionally, the Section respectfully suggests that the USPTO add actual examples of merely descriptive marks from decided cases. For example, in the text immediately following examples of matter that fails to function as marks, the USPTO could include the following (using examples provided in TMEP §1209.01(b), Merely Descriptive Marks, Jan. 2017 Ed.):

By contrast, the following are examples of marks that have been held to be merely descriptive:

The mark APPLE PIE for potpourri was refused because it is merely descriptive since it “conveys the key characteristic of the potpourri, its scent.” In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The mark BED & BREAKFAST REGISTRY for “making lodging reservations for others in private homes” was refused because it is merely descriptive as applied to its services. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986).

The mark PATENTS.COM for “computer software for managing a database of records and for tracking the status of the records by means of the Internet” was refused because it is merely descriptive of “patent-related goods in connection with the Internet.” In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). “It is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property.” TMEP 1209.01(b) Merely Descriptive Marks, Jan. 2017 Ed.

In Part A.3.a., the Section recommends as the following revision to the first sentence under “Evidence” on page 7:

“To support the refusal or disclaimer requirement, the evidence of record must be reviewed to ascertain the religious origin of the wording, if any exists.”

In Part A.3.b., the Section recommends in the following revision to the second sentence of the first paragraph on page 8:
“Based on the examining attorney’s research, if the evidence indicates that the wording in question has become part of common, everyday language such that the average consumer would be unlikely to perceive the wording as conveying the applicant’s religious affiliation or endorsement, a refusal must not issue merely based on the wording being from a religious text.”

In Part A.4, the Section recommends the following revision to the second sentence in the paragraph on page 9:

“And, if the evidence of record and/or the results of the evidence searches yield a determination that the mark fails to function as a source indicator, then the failure-to-function refusal should be issued for applications based on Section 1(b), 44, or 66(a).”

III. DISCLAIMER AND DELETION WHERE MARK HAS REGISTRABLE MATTER

Under the subheading “Disclaimer”, the second sentence includes a typographical error (“mater” should read “matter”):

Acquired distinctiveness in part as to the incapable matter must not be suggested.

IV. APPLICANT’S RESPONSE OPTIONS

Under the subheading “Arguments Against Refusal”, the second paragraph on page 11 omits that an applicant can seek protection for a design as a mark. Therefore, the Section recommends the addition of the word “design” as follows:

“The more commonplace and widely used the wording or design is…”

FOOTNOTES

In footnote 14, there is an additional parenthesis that should be deleted from the following case:

In re Melville Corp., 228 USPQ 970 ((BRAND

APPENDIX A

In the chart marked A-2, the Section recommends clarifying the last box in the diagram that says that no refusal or disclaimer should be issued. Additional information should be added to mention that, “a Note to the File should be entered that indicates which sources were checked.”
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.

Very truly yours,

[Signature]

Donna P. Suchy
Section Chair
American Bar Association
Section of Intellectual Property Law