

NEW U.S. TRADEMARK RULES AFFECT ALL U.S. TRADEMARKS

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The United States Patent and Trademark Office (“USPTO”) has released new rules that impact all U.S. trademarks as of November 2, 2003.

The main topic of these new rules is the Madrid Protocol, an international trademark treaty that provides a streamlined method for U.S. trademark owners to file foreign trademark applications, and maintain foreign trademark registrations, in the Protocol’s member countries. Even trademark owners without foreign ambitions should take note of the Protocol because it also will make it easier for foreign trademark owners in member countries to file trademark applications, and maintain registrations, here in the U.S.

However, in addition to the myriad rules regarding the implementation of the Madrid Protocol, the USPTO’s final rules also set forth some important changes relating to all U.S. trademarks – even those unrelated to the Protocol. Such “universal” changes include the following:

1) Reviving Abandoned Trademark Applications or Registrations.

As many trademark practitioners and owners know, the USPTO sometimes declares trademark applications and registrations to be “abandoned” for procedural reasons even though the owner did not intentionally abandon the application or registration. In such instances, the USPTO issues a Notice of Abandonment which the owner is supposed to (but sometimes does not) receive so that the owner can file a Petition to Revive in hope of returning the application or registration to active status.

Under the USPTO’s new rules, in cases where the owner did not receive the Notice of Abandonment, the owner is no longer permitted to revive abandoned applications or registrations after two months from the date of the Notice of Abandonment unless a stricter due diligence standard is met.

Specifically, to revive an abandoned application after two months from the date of the Notice of Abandonment, the applicant must show that it (1) did not receive the Notice of Abandonment and (2) had been checking the status of its application at least every six months after filing the application.

Similarly, to revive an abandoned registration after two months from the date of the Notice of Abandonment, the registrant must show that it (1) did not receive the Notice of Abandonment and (2) had been checking the status of its registration every six months after filing the Declaration of Use or the Renewal until the Notice of Acceptance of that Declaration of Use or Renewal was received.

It is crucial to note that even if the petition to revive is successful, delayed revival will likely permanently terminate any related International Registration (i.e., a registration obtained through the Madrid Protocol based on that application or registration in the U.S.). This is a result of the Madrid Protocol's "dependency" principle under which the International Registration is dependent on the underlying application or registration for five years from the International Registration date.

The USPTO cautions that if U.S. application or registration becomes abandoned, any related International Registration will likely be permanently abandoned if a petition to revive the U.S. application or registration is not filed within two months of the issuance of a Notice of Abandonment. Furthermore, a cancelled International Registration cannot be revived even if the underlying U.S. application or registration is revived.

2) Requests for extension of time to oppose a trademark application.

Under the new rules, parties will no longer be permitted to extend the time for filing an opposition beyond 180 days from the date the application was published, even if the parties want to stipulate to a further extension. This restriction applies to all requests for extension of time to oppose a trademark application, unless the first extension request was filed before November 2, 2003.

In addition to setting the new 180 day maximum, the new rules also dictate that the extension requests must be structured in one of two ways:

- A potential opposer can request an extension of 30 days (granted upon request), followed by a second request for a further extension of 60 days (upon a showing of good cause), followed by a final further extension of 60 days (upon stipulation or written consent of the applicant); or
- A potential opposer can request an extension 90 days (upon a showing of good cause), followed by a final further extension of 60 days (upon stipulation or written consent of the applicant).

Additionally, the Trademark Trial and Appeal Board will no longer suspend the time to oppose when a letter of protest or an amendment to an application is filed. Instead, parties are encouraged to extend the time for filing an opposition up to 180 days from the date of publication, then to file the opposition, and then to suspend the opposition if further time is needed for settlement.

3) Filing Oppositions.

Under the new rules, an opposition against a Section 1 or Section 44 application can still be filed on paper or electronically. However, an opposition to a Section 66(a) application (i.e., an application generated by a foreign entity's request for registration in the U.S. under the Madrid Protocol) must be filed electronically.

4) Color Marks.

Under the new rules, if the applicant wants to protect color as a feature of the mark, then the applicant must submit the mark in color together with a claim that the color is to be protected. An applicant may no longer file a black-and-white drawing with such a color claim or a black-and-white drawing that is lined for color.

While this new rule should make things easier for owners seeking to register color marks, it may cause problems for some applicants. If an application presents a mark with gray tones, the mark will be processed as a color drawing. If a color claim is not included in the application, the Examiner will issue an office action requiring either a color claim or a new black and white drawing.

It should also be noted that the new rules permit owners to voluntarily amend their applications and registrations in order to submit a color drawing (to replace the existing black-and-white drawing) for a mark which includes color.

5) Partial Abandonment.

The new rules provide for the concept of “partial abandonment”. If a USPTO Examiner’s refusal or requirement is limited to certain goods/services in an application or registration, and the applicant or registrant fails to timely respond regarding that refusal or requirement, then the application or registration will be abandoned only as to those goods/services. Under the prior rules, a failure to respond would have resulted in an abandonment of the entire application or registration even though only certain goods/services were at issue.

6) Size requirements for electronic images of trademarks.

The new rules set forth very specific requirements regarding the electronic imaging of marks. The image of the mark must be in .jpeg format, and it must be between 300 and 350 dpi, and its length and width must be between 250 and 944 pixels. Such requirements are important given the USPTO’s ever-increasing emphasis on electronic filing.

For related materials and further discussion, please visit Pillsbury Winthrop’s free online Madrid Protocol Resource Center at http://www.pillsburywinthrop.com/madrid/madrid_main.asp.

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