Trademark Prosecution Simulation

Syllabus

Compressed Course - Spring 2022

**Course Information**

**Course Instructor**

Joel Feldman

(678) 553-4778

joel@gtlaw.com

**Office Hours**

1:00 PM - 3:00 PM M, T, W, Th or by appointment

In-office (if feasible) or by phone, video conference, or e-mail

**Prerequisite**

Trademark Law (may be waived by course instructor on a case-by-case basis)

**Course Description and Objectives**

This compressed course will provide students the opportunity to engage in educational simulated hands-on trademark prosecution tasks, including researching trademark availability, preparing freedom-to-use and registrability opinions, preparing trademark applications, preparing use affidavits, evaluating and responding to USPTO office actions, and responding to oppositions. The course will simulate the lifecycle of a trademark application, from clearance through publication for opposition.

**Learning Outcomes**

After completing this course, students should have an introductory-level understanding of how to:

* Identify and evaluate prior rights that affect a newcomer’s right to use a proposed brand name;
* Evaluate whether a trademark is eligible for registration on absolute grounds;
* Evaluate whether a trademark application is likely or unlikely to be approved by the U.S. Trademark Office;
* Prepare a trademark application;
* Evaluate whether a trademark is in use and prepare a use affidavit;
* Evaluate and respond to office actions issued against pending trademark applications; and
* Evaluate and respond to oppositions filed against pending trademark applications.

Work product from this course may be suitable as a writing sample.

**Class Schedule and Assignments**

*\*\*Students should expect to spend at least two hours outside of class completing writing assignments applying class discussion and instruction..\*\**

Monday, January 10, 2022 | 9:30 AM - 12:30 PM - Trademark Clearance

Pre-class reading: James E. Hawes & Amanda V. Dwight, *Trademark Registration Practice*, Ch. 2 [Selecting and Evaluating a Mark] (2021), available on Westlaw.

During Monday’s class session, we will discuss how to evaluate the availability and registrability of a proposed trademark. We will discuss the different searching tools used by trademark practitioners and the different types of information evaluated by trademark practitioners to prepare opinions, including federal applications and registrations, state applications and registrations, and various common-law uses.

Post-class assignment (4-6 hours): During Monday’s class session, each student will select a trademark to shepherd through the trademark application process. At the conclusion of the class session, each student will receive a CompuMark research report for the student’s selected trademark. The student will analyze the research report and prepare a simulated written opinion regarding the freedom to use the trademark and the likelihood of success for registering the trademark.

Tuesday, January 11, 2022 | 9:30 AM - 12:30 PM - Trademark Applications

Pre-class reading: James E. Hawes & Amanda V. Dwight, *Trademark Registration Practice*, Ch. 3 [Preparing and Filing a Trademark Application] (2021), available on Westlaw.

During Tuesday’s class session, we will discuss the technical requirements of a U.S. trademark application, including mark description, the identification of goods or services, filing basis, owner information, disclaimers, and required declarations. Each student will prepare and submit (to the instructor) a simulated electronic trademark application.

Post-class assignment (4-6 hours): At the conclusion of the class session, each student will receive a simulated office action issued against the student’s simulated trademark application. The student will review and evaluate the office action, relevant portions of the Trademark Manual of Examining Procedure, and a closed-universe of citable decisions (based on the refusal type) and prepare a simulated client communication reporting and explaining the office action, the client’s response options, and the likelihood of success.

Wednesday, January 13, 2022 | 9:30 AM - 12:30 PM - Office Actions

Pre-class reading: James E. Hawes & Amanda V. Dwight, *Trademark Registration Practice*, Ch. 5-8 [Responding to Formal Rejections; Responding to Confusion Rejections; Responding to “Descriptive” Rejections; Responding to Other Substantive Rejections] (2021), available on Westlaw.

During Wednesday’s class session, we will discuss how trademark examiners examine trademark applications and the common objections they raise, including likelihood of confusion, descriptiveness, deceptive misdescriptiveness, geographic descriptiveness, geographic deceptive misdescriptiveness, functionality, and surnames.

Post-class assignment (4-6 hours): After Wednesday’s class session, each student will prepare a 5-8 page response to the office action issued at the conclusion of Tuesday’s class.

Thursday, January 14, 2022 | 9:30 AM - 12:30 PM - Ex Parte Appeals and Oppositions

Pre-class reading: James E. Hawes & Amanda V. Dwight, *Trademark Registration Practice*, Ch. 14-15 [Appellate Process; Introduction to Inter Partes Proceedings] (2021), available on Westlaw.

During Thursday’s class session, we will discuss the Trademark Trial and Appeal Board, which oversees both *ex parte* appeals when an applicant is dissatisfied with a refusal to register and *inter partes* proceedings when a third party wishes to oppose registration of a trademark.

Post-class assignment (2-4 hours): After Thursday’s class session, each student will receive a simulated notice of opposition filed against the student’s trademark application. The student will evaluate the merits of the notice of opposition and prepare a simulated client communication explaining and evaluating the merits of the opposition.

Friday, January 15, 2022 | 10:00 AM - 12:00 PM - Use in Commerce

Pre-class reading: *Trademark Manual of Examining Procedure* (TMEP) § 900.

During Friday’s class session, we will discuss the prerequisite of use for the issuance of a U.S. trademark registration. We will discuss how use is proven, how trademark examiners evaluate proof of use, and common specimen-related refusals issued, including mere ornamentation, failure-to-function, digitally-created or altered specimen, merely advertising material (for goods), failure to show mark-goods or mark-services association, and non-matching drawing and specimen.

**Reference Materials for Writing Assignments:**

*Trademark Manual of Examining Procedure*, Oct. 2018 ed. (downloadable at <https://www.uspto.gov/sites/default/files/documents/TMEP_PDF-201810.zip>)

*Trademark Trial and Appeal Board Manual of Procedure*, June 2020 (downloadable at <http://www.uspto.gov/sites/default/files/documents/mastertbmp-Jun2020.pdf>)

15 U.S.C. §§ 1051 - 1072 (available online at <https://tmep.uspto.gov/RDMS/TFSR/current#/current/c-8a14bcea-2baf-424f-834e-60e116cf3d86.html>)

**Citable Decisions for Writing Assignments:**

*Important note: The below decisions are the “closed universe” of decisions that all students will use in writing assignments across all refusal types. Each student will have writing assignments related only to one, two, or three refusal types and will use only decisions addressing those refusal types.*

Likelihood of confusion decisions

*In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)

*In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988)

*In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993)

*In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003)

*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005)

*In re Hartz Hotel Services, Inc.*, 102 USPQ2d 1150 (TTAB 2012)

*In re St. Helena Hosp.*, 113 USPQ2d 1082 (Fed. Cir. 2014)

*Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015)

*Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015)

Merely descriptive decisions

*In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968)

*In re Tennis in the Round Inc.*, 199 USPQ 496 (TTAB 1978)

*In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983)

*In Re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)

*In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)

*In re Bayer A.G.*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007)

*In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008)

*In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574 (Fed. Cir. 2015)

Deceptively misdescriptive decisions

*In re Robert Simmons, Inc.*, 192 USPQ 331 (TTAB 1976)

*In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988)

*In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989)

*In re Shniberg*, 79 USPQ2d 1309 (TTAB 2006)

*In re White Jasmine LLC*, 106 USPQ2d 1385 (TTAB 2013)

*In re Tapco International Corp.*, 122 USPQ2d 1369 (TTAB 2017)

*In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590 (TTAB 2018)

*In re Hinton*, 116 USPQ2d 1051 (TTAB 2015)

Primarily geographically descriptive decisions

*In re Dixie Ins. Co.*, 223 USPQ 514, 516 (TTAB 1984)

*In re Int'l Taste Inc.*, 53 USPQ2d 1604 (TTAB 2000)

*In re Joint Stock Company "Baik"*, 80 USPQ2d 1305 (TTAB 2006)

*In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820 (TTAB 2006)

*In re Roy J. Mankovitz*, 90 USPQ2d 1246 (TTAB 2009)

*In re Hollywood Lawyers Online*, 110 USPQ2d 1852 (TTAB 2014)

*In re The Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445 (Fed. Cir. 2015)

*In re Broken Arrow Beef and Provision, LLC*, 129 USPQ2d 1431 (TTAB 2019)

Primarily geographically deceptively misdescriptive decisions

*Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990)

*In re Sharky’s Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992)

*In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003)

*In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003)

*Corporación Habanos, S.A. v. Anncas, Inc.*, 88 USPQ2d 1785 (TTAB 2008)

*In re Spirits Int’l N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009)

*Corporación Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085 (TTAB 2012)

*In re Miracle Tuesday LLC*, 695 F3d 1339, 104 USPQ2d 1330 (Fed. Cir. 2012)

Failure-to-function/mere ornamentation decisions

*In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982)

*In re Melville Corp.*, 228 USPQ 970 (TTAB 1986)

*In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455 (TTAB 1998)

*In re Supply Guys, Inc.*, 86 USPQ2d 1488 (TTAB 2008)

*In re wTe Corp.*, 87 USPQ2d 1536 (TTAB 2008)

*In re DSM Pharms., Inc.*, 87 USPQ2d 1623 (TTAB 2008)

*In re Osmotica Holdings Corp.*, 95 USPQ2d 1666 (TTAB 2010)

*In re HSB Solomon Assoc.*, 102 USPQ2d 1269 (TTAB 2012)

*In re Lululemon Athletica Can. Inc.*, 105 USPQ2d 1684 (TTAB 2013)

*In re Ocean Technology, Inc.*, 2019 USPQ2d 450686 (TTAB 2019)

*In re Rodeowave Entertainment, LLC*, Serial No. 87801076 (November 13, 2020) [not precedential]

*In re Vox Populi Registry Ltd.*, 2020 USPQ2d 11289 (TTAB 2020)

*In re Texas With Love, LLC*, 2020 USPQ2d 11290 (TTAB 2020)

Functionality decisions

*Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994)

*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995)

*In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279 (TTAB 2000)

*TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001)

*In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001)

*In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372 (Fed. Cir. 2012)

*In re Florists’ Transworld Delivery, Inc.*, 106 USPQ2d 1784 (TTAB 2013)

*In re Mars, Inc.*, 105 USPQ2d 1859 (TTAB 2013)

*In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882 (TTAB 2020)

Primarily merely surname decisions

*In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985)

*In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332 (TTAB 1995)

*In re Isabella Fiore, LLC*, 75 USPQ2d 1564 (TTAB 2005)

*In re Piano Factory Group, Inc.*, 85 USPQ2d (TTAB 2006)

*In re Yeley*, 85 USPQ2d 1150 (TTAB 2007)

*In re Thermo LabSystems Inc.*, 85 USPQ2d 1285 (2007)

*In re Jack B. Binion*, 93 USPQ2d 1531 (TTAB 2009)

*In re P.J. Fitzpatrick, Inc.*, 95 USPQ2d 1412 (TTAB 2010)

*Miller v. Miller*, 105 USPQ2d 1615 (TTAB 2013)

*In re Colors in Optics, Ltd.*, 2020 USPQ2d 48321 (TTAB 2020)

**Course Policies**

**Student Evaluation/Grading**

There will be five writing assignments testing students’ understanding of trademark law principles, application of trademark prosecution principles, and advocacy skills. Each of these writing assignments will be graded. A student’s final grade for the course will be calculated using the following percentages:

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| --- | --- |
| **Assignment** | **Percentage of Grade** |
| Written clearance opinion | 25% |
| Client communication reg. office action | 10% |
| Office action response | 40% |
| Client communication reg. opposition | 10% |
| Opposition answer and affirmative defenses | 15% |

The distribution of grades and the value of grade points for this course will comply with the Levin College of Law’s Grading and Examinations guidelines, as set forth in the *UF Law Student Handbook & Academic Policies*, available online at <https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current%20students/academic-policies>. Letter grades and their point equivalents are: A = 4.0; A- = 3.67; B+ = 3.33; B = 3.0; B- = 2.67; C+ = 2.33; C = 2.0; C- = 1.67; D+ = 1.33; D = 1.0; D- = 0.67; E (failure) = 0.0.

**Class Attendance**

ABA standards require regular and punctual class attendance. Attendance is an essential function of legal education and a primary obligation of each student. Attendance will be taken during each class period. Because of the compressed nature of this course, anticipated absences must be approved in advance by the instructor. Unexcused absences may result in a reduction of the student’s grade.

**Exam Delays and Accomodations**

The law school’s policy on exam delays and accommodations: <https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/forms-applications/exam-delays-accommodations-form>.

**Accommodations for Students with Disabilities**

Students with disabilities who experience learning barriers and would like to request academic accommodations should contact the Disability Resource Center at

<https://disability.ufl.edu/students/get-started/>. It is important for students with disabilities to share their accommodation letters with the course instructor and discuss their access needs on the first day of the compressed course.

**Online Course Evaluation**

Students are expected to provide professional and respectful feedback on the quality of course instruction by completing course evaluations online via GatorEvals. Students will be notified when the evaluation period opens and may complete evaluations through the email they receive from GatorEvals, in their Canvas course menu under GatorEvals, or via ufl.bluera.com/ufl/. Summaries of course evaluation results are available to students at <https://gatorevals.aa.ufl.edu/public-results/>.

**COVID-19 Safety**

During in-person class sessions, faculty and students must follow any prevailing safety precautions with respect to COVID-19.

**Class Recording**

Class sessions may be recorded for personal use.