

The Dos and Don'ts of Letters of Protest

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We often file letters of protest in an attempt to persuade the U.S. Patent and Trademark Office to refuse registration of third-party trademark applications. Such letters can help delay or even avoid having to file costly oppositions – if you follow the rules, that is. Some highlights of the rules are as follows.

Despite its adversarial title, a letter of protest should contain only factual evidence so that it doesn't compromise the objectivity of the USPTO's examination process. To that end, the evidence attached to a letter of protest should not identify the trademark owner who filed the letter of protest. (To be clear, the owner's name is included in the letter itself. Generally, however, only the attached evidence is forwarded to the USPTO Examining Attorney for his or her consideration.) The USPTO also considers irrelevant prior use of a mark, actual instances of consumer confusion, and ownership of unregistered marks – this evidence is better suited for an opposition proceeding.

One of the most common types of letters of protest asks the USPTO to refuse registration on the ground of likelihood of confusion with an existing registration or earlier-filed application.

Let's say a trademark owner notices that a mark in a recently-filed application is confusingly similar to the owner's previously-applied-for or registered mark. If both parties' applications/registrations cover *identical* products or services, your letter of protest evidence could consist of the serial or registration number of the earlier application or registration. Easy as that!

If the parties' applications/registrations cover *related* products or services, the USPTO requires the trademark owner to show that the products or services are indeed related. One way to show relatedness is to attach copies of third-party registrations based on "use in commerce" that encompass both parties' products and services within the same registration.

Finally, when it comes to letters of protest, less is more. We mean it: the USPTO may deny a letter if it's too long! Include only the most relevant evidence, i.e., no more than 10 to 15 examples. In rare cases when there is a good reason to submit more than 75 pages of evidence, the USPTO requires trademark owners to include an index to help the USPTO parse the evidence.

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