



Bulletin

The Voice of the International Trademark Association



January 15, 2009

Vol. 64, No. 2

UNITED STATES: USPTO Changes Standard of Review for Letters of Protest

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On November 21, 2008, the U.S. Patent and Trademark Office (USPTO) announced a new standard of review for letters of protest filed prior to publication of a trademark application. The change makes it easier for a third party to have the examining attorney consider evidence that the applied-for mark is not entitled to registration and gives the examining attorney greater discretion to act on this evidence.

A letter of protest is an informal and nonadversarial procedure that allows a third party to submit evidence about the eligibility of a trademark for registration. Letters of protest are evaluated by the Office of the Deputy Commissioner for Trademark Examination Policy. If the Deputy Commissioner grants a letter of protest, the evidence contained in the letter—but not the letter itself nor the protestor’s identity—is forwarded to the examining attorney.

Under the former standard, the Deputy Commissioner granted letters of protest only if they presented *prima facie* evidence for refusing registration, such that publication of the mark without consideration of the letter’s evidence would be clear error. If the Deputy Commissioner granted a letter of protest, the examining attorney was required to refuse registration based on the grounds presented in the letter.

Under the new, more lenient standard, described in USPTO Examination Guide No. 4-08, the Deputy Commissioner will grant letters of protest that are filed prior to the publication of an application if the evidence supports any reasonable ground for refusal. The examining attorney is no longer required to refuse registration. Instead, the examining attorney must merely consider the evidence and make an independent determination of registrability.

The Deputy Commissioner will now dismiss letters of protest that relate to issues that the examining attorney has already addressed unless the letter presents significant additional evidence or the Deputy Commissioner finds clear error on the issue.

As before, the Deputy Commissioner will grant a letter of protest that is filed up to 30 days after publication only if the evidence establishes a *prima facie* case for refusal, and will deny as untimely any letters of protest filed more than 30 days after publication.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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