

From: [Jeff Baker](#)
To: [TM FR Notices](#)
Cc: [Cain, Catherine](#); [Fee.Setting](#)
Subject: Proposed Letter of Protest Filing Fee
Date: Monday, September 30, 2019 6:41:59 PM

To Whom It May Concern,

On the USPTO.gov website the guidelines for filing trademarks are outlined in great detail. However, the guidelines on the USPTO.gov website are not at all what is actually occurring in the trademark world with regard to class 025 specifically. This is of grave concern, not only to those operating a business within class 025, but to the very integrity of the USPTO as a governing body tasked with the protection of small and large businesses alike.

The Trademark Manual of Examining Procedure (TMEP) provides the constitutional basis for Trademarks and pulls together citations from the United States Code (U.S.C) as well as the Code of Federal Regulations (C.F.R.). This manual sets forth the guidelines and procedures that examining attorneys at the USPTO are required to follow, however there are several current practices at the USPTO that are inconsistent with the laws and regulations in place.

The following is a list of inconsistencies in regulations versus current USPTO practices which, unaddressed, will inevitably result in the erosion of the integrity of trademark law, and the USPTO as an organization.

TMEP 704 Initial Examination > 704.01

The initial examination of an application by the examining attorney must be a complete examination. A complete examination includes a search for conflicting marks and an examination of the written application, any voluntary amendment(s) or other documents filed by applicant before an initial Office action is issued (see TMEP §702.01), the drawing, and any specimen(s) or foreign registration(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid. The examining attorney's first Office action must be complete, so the applicant will be advised of all requirements for amendment and all grounds for refusal, with the exception of use-related issues that are considered for the first time in the examination of an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) in an intent-to-use application.

The key language above is a "complete examination", which, in an overwhelming number of applications, is simply not occurring. Many applicants are not fully complying with the following guidelines and this is being overlooked by the USPTO examining attorneys.

15 U.S.C. §1051(a)(3)(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall— (i) state exceptions to the claim of exclusive use; and (ii) shall specify, to the extent of the verifier's knowledge— (I) any concurrent use by others; (II) the goods on or in connection with which and the areas in which each concurrent use exists; (III) the periods of each use; and (IV) the goods and area for which the applicant desires registration.

An excellent example of failure to verify this information is evident for the recently registered trademark for the word “Dogs” (Registration Number 5843989; Serial Number 88299285; Registration Date August 27, 2019; Goods and Services IC 025 US 022 039).

A simple Amazon.com search for just apparel shows that the word “Dogs” is being concurrently used by tens of thousands of others. I could cite several other registered trademarks where this is evident, but this is the most recent and one of the most ludicrous examples of what is occurring with regard to a supposed “complete examination” of trademark applications. If I were the Commissioner of Trademarks, I would feel personally responsible that my organization permitted the registration of a trademark on the word “Dogs”, and that my office unequivocally failed in their responsibility of ensuring that the statues regulating the registration of trademarks be upheld in the United States.

The examining attorney is also responsible for verifying the “specimen” that the applicant submits meets the regulations outlined in both TEMP 806.01(a) Use in Commerce - §1(a) and TMEP 904.

Upon review of the submitted specimen for the same example above “Dogs” (Registration Number 5843989; Serial Number 88299285; Registration Date August 27, 2019; Goods and Services IC 025 US 022 039) you will clearly see that the specimen did not meet the guidelines and should have been refused at that point, but this was also overlooked by the examining attorney.

Though, the previously cited steps that should have caused a refusal of this mark by the examining attorney were missed, certainly the review of whether the word “Dogs” would function as a trademark would be a basis for refusal since this word functions as common English language.

TMEP 904.07(b) Whether the Specimen Shows the Applied-for Mark Functioning as a Mark In a §1(a) application for registration or an allegation of use submitted in a §1(b) application for a trademark or service mark, the examining attorney must also evaluate the specimen to determine whether the applied-for mark is used in a way that shows that: (1) the applied-for mark identifies the goods/services of the applicant and distinguishes them from the goods/services of others; and (2) the applied-for mark indicates the source of those goods/services. See 15 U.S.C. §1127. If use on the specimen fails in either regard, the record lacks the requisite evidence that the applied-for mark functions as a mark. The following non-exhaustive list reflects examples where review of the specimen would indicate a failure to function as a mark: Applied-for mark is used solely as a trade name (see TMEP §1202.01); Applied-for mark is mere ornamentation (see TMEP §1202.03); Applied-for mark is merely informational matter (see TMEP §§1202.04, 1301.02(a)); Applied-for mark identifies the name or pseudonym of a performing artist or author (see TMEP §1202.09(a)); Applied-for mark identifies the title of a single creative work (see TMEP §1202.08); Applied-for mark identifies a model number or grade designation (see TMEP §1202.16); Applied-for mark is merely a background design or shape that does not create a commercial impression separable from the entire mark (see TMEP §1202.11); Applied-for mark identifies a process, system, or method (see TMEP §1301.02(e)); Applied-for mark is used to refer to activities that are not considered "services" (see TMEP §§1301.01 et seq.); Applied-for mark is used solely as a domain name (see TMEP §1215.02); Applied-for mark is used solely to identify a character (see TMEP §1301.02(b)).

Hence, the trademark for the word “Dogs” could have certainly been refused based on ornamentation as outlined in the regulations below:

Applied-for mark is mere ornamentation (see TMEP §1202.03); 1202.03 Refusal on Basis of Ornamentation Subject matter that is merely a decorative feature does not identify and distinguish the applicant’s goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans, or trade dress. This matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark, as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127. For a mark for services, if the applied-for matter would be perceived only as decoration or ornamentation when used in connection with the identified services, a refusal as nondistinctive trade dress must issue under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127. See TMEP §§1202.02 and 1202.02(b)-1202.02(b)(ii) regarding trade dress and TMEP §§1301.02–1301.02(f) regarding matter that does not function as a service mark.

Moreover, “Dogs” is a textbook example of an applied for mark that is “merely informational” per the following TMEP regulations which also include extensive case law for examples far less absurd than “Dogs”.

Applied-for mark is merely informational matter (see TMEP §§1202.04, 1301.02(a)); 1202.04(b) Widely Used Messages "Widely used messages" include slogans, terms, and phrases used by various parties to convey ordinary or familiar concepts or sentiments, as well as social, political, religious, or similar informational messages that are in common use or are otherwise generally understood. The more commonly a term or phrase is used in everyday speech or in an associational or affinitive manner by various sources, the less likely consumers will perceive the matter as a trademark or service mark for any goods and services. In re Eagle Crest, Inc., 96 USPQ2d 1227, 1229-30 (TTAB 2010); cf. In re Peace Love World Live, LLC, 127 USPQ2d 1400, 1403 (TTAB 2018) (I LOVE YOU, appearing on bracelets, would be seen as a term of endearment rather than a sourceidentifying trademark). Messages that merely convey ordinary, familiar concepts or sentiments that are used by a variety of sources in the marketplace are considered commonplace and will be understood as conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function. See, e.g., D.C. One Wholesaler, Inc. v. Chien, 120 USPQ2d 1710, 1716 (TTAB 2016) (I ♥ DC was found not to function as a mark for clothing items because it would be perceived merely as an expression of enthusiasm for the city); In re Volvo Cars of N. Am. Inc., 46 USPQ2d 1455, 1460 (TTAB 1998) (DRIVE SAFELY was found not to function as a mark when used in connection with automobiles and structural parts therefor because it would be perceived as an everyday, commonplace safety admonition); In re Manco, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN for products advertised to be recyclable and to promote energy conservation was found not to function as a mark because it merely conveys a message of environmental awareness or ecological consciousness). Messages that are used by a variety of sources to convey social, political, religious, or similar sentiments or ideas are likely to be perceived as an expression of support for, or affiliation or affinity with, the ideas embodied in the message rather than as a mark that indicates a single source of the goods or services. Furthermore, goods that feature such messages are typically purchased because of the expressive sentiment conveyed by the message and not because they serve as a means for the consumer to identify and distinguish the applicant’s goods or services from those of others. For example, the proposed mark ONCE A MARINE, ALWAYS A MARINE, for clothing, was found not to function as a mark because the evidence showed that it is a common motto

used by, and in support of, the U.S. Marines. In re Eagle Crest, Inc., 96 USPQ2d at 1232. Similarly, the proposed mark NO MORE RINOS! for various goods, including bumper stickers, signs, and t-shirts, was found not to function as a mark because the evidence showed that consumers were accustomed to seeing this well-known political slogan on these types of goods from a variety of different sources. In re Hulting, 107 USPQ2d 1175, 1179 (TTAB 2013). Derivatives or variations of widely used messages also fail to function as marks if they convey the same or similar type of information or sentiment as the original wording. See In re Melville Corp., 228 USPQ 970, 971 (TTAB 1986) (finding BRAND NAMES FOR LESS failed to function as a mark based evidence of widespread use of similar marketing phrases, noting that "[t]he fact that applicant may convey similar information in a slightly different way than others is not determinative."); In re Remington Prods., Inc., 3 USPQ2d 1714, 1715 (TTAB 1987) (finding PROUDLY MADE IN THE USA informational in nature; the addition of "Proudly" before the common phrase "Made in USA" merely added "further information about the state of mind of the manufacturer and/or its employees in connection with the production of the goods"); see also D.C. One Wholesaler, Inc. v. Chien, 120 USPQ2d 1710, 1716 (TTAB 2016) (noting that the informational significance of I ♥ DC was "reinforced by the fact that similar expressions in the form of 'I ♥ ___' have also been widely used to express such enthusiasms with respect to other places and things"). Any evidence demonstrating that the public would perceive the wording merely as conveying the ordinary meaning of the message, or enthusiasm for, affinity with, or endorsement of the message, supports this refusal. In addition to dictionary or encyclopedia entries showing the meaning or significance of wording, supporting evidence may include materials (e.g., website pages, Internet search results lists if sufficient surrounding text is included, social-media pages, product fact sheets, and other promotional materials) showing the applicant's manner of use and the manner of use by third parties. See, e.g., D.C. One Wholesaler, Inc., 120 USPQ2d at 1716 (finding that I ♥ DC failed to function as a mark for clothing items, stating that the evidence shows that the wording "has been widely used, over a long period of time and by a large number of merchandisers as an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C."). The size, location, dominance, and significance of the wording as it is used in connection with the goods or services should also be considered to determine if any of these elements further support the perception of the wording merely as an informational message rather than as indicating the source of goods or services. 1301.02(a) Matter that Does Not Function as a Service Mark To function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application. See In re Keep A Breast Found., 123 USPQ2d 1869, 1882 (TTAB 2017) (finding that three-dimensional cast of female breast and torso would be perceived as something that applicant assists in making as part of applicant's associational and educational services, rather than as a mark designating the source of the services). Use of a designation or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. See In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960) (GUARANTEED STARTING found to be ordinary words that convey information about the services, not a service mark for the services of "winterizing" motor vehicles); In re Melville Corp., 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services); In re Brock Residence Inns, Inc., 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE so highly descriptive and informational in nature that purchasers would be unlikely to perceive it as an indicator of the source of hotel services); In re Wakefern Food Corp., 222 USPQ 76 (TTAB 1984) (WHY PAY MORE found to be a common commercial phrase that does not serve to identify grocery store services); In re Gilbert Eiseman, P.C., 220 USPQ 89 (TTAB 1983) (IN ONE DAY not used as source

identifier but merely as a component of advertising matter that conveyed a characteristic of applicant's plastic surgery services); In re European-American Bank & Trust Co., 201 USPQ 788 (TTAB 1979) (slogan THINK ABOUT IT found to be an informational or instructional phrase that would not be perceived as a mark for banking services); In re Restonic Corp., 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not serve to identify franchising services). Cf. In re Post Props., Inc., 227 USPQ 334 (TTAB 1985) (finding QUALITY SHOWS, set off from text of advertising copy in extremely large typeface and reiterated at the conclusion of the narrative portion of the ad, to be a registrable service mark for applicant's real estate management and leasing services, because it was used in a way that made a commercial impression separate from that of the other elements of advertising material upon which it was used, such that the designation would be recognized by prospective customers as a source identifier). See TMEP §1202.04 regarding informational matter that does not function as a trademark. A term that is used only to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. See In re Moody's Investors Serv. Inc., 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimen, found to identify the applicant's ratings instead of its rating services); In re Niagara Frontier Servs., Inc., 221 USPQ 284 (TTAB 1983) (WE MAKE IT, YOU BAKE IT only identifies pizza, and does not function as a service mark to identify grocery store services); In re British Caledonian Airways Ltd., 218 USPQ 737 (TTAB 1983) (term that identifies a seat in the first-class section of an airplane does not function as mark for air transportation services); In re Editel Prods., Inc., 189 USPQ 111 (TTAB 1975) (MINI-MOBILE identifies only a vehicle used in rendering services and does not serve to identify the production of television videotapes for others); In re Oscar Mayer & Co., 171 USPQ 571 (TTAB 1971) (WIENERMOBILE does not function as mark for advertising and promoting the sale of wieners, where it is used only to identify a vehicle used in rendering claimed services). Similarly, a term that only identifies a process, style, method, or system used in rendering the services is not registrable as a service mark, unless it is also used to identify and distinguish the service. See TMEP §1301.02(e).

I could go on citing more regulations, but instead I'll offer additional examples that show blatant disregard of the "complete examination" clause of the TMEP on the next page for several trademarks in class IC 025. Each of these frivolous trademarks has a registration number meaning that, at a minimum, they made it past the examining attorney's "complete examination" and certainly all of them should have received a "failure-tofunction" refusal on the grounds does not function as a trademark or service mark according to TMEP 904.07(b).

Trademarked Phrase Registration & Registration Number
MERMAID 5650588
GREETINGS FROM 5381513
WHERE'S THE BEAST 5650472
HEART OF A WARRIOR 5349939
YOUR SALIVA IS DELICIOUS, HOW'S MINE 5645629
THE BEST KIND OF DAD 5313209
NORMAL HOUR 5645269
MEGALODON 5306714
MAGICAL SEASON 5645245
#MOMLIFE 5293736
DANK YOU 5645134
WORLD'S GREATEST FUTBALL PLAYER 5292649

SEND ME. 5644146
THE ORIGINAL, THE REMIX, AND THE ENCORE 5290114
ALL MY FRIENDS ARE ANIMALS 5641978
GREATEST GUITARIST EVER 5287747
WASHED UP 5633615
YOUNG WILD AND THREE 5279680
OWL NIGHT LONG 5619113
BUSY MOM 5250857
HIPPIE VIBE 5613418
NOT TODAY 5247946
YES WEED CAN 5612526
CHRISTIAN BABY 5225086
BIG HAIR DON'T CARE 5608267
BASKETBALL'S GREATEST 5224537
TIME TO BE 5585786
THE LITTLE EMBRYO THAT COULD 5216757
OH SHIP! 5580170
SLEEP AROUND 5181561
SOMBUNNY IS PREGNANT 5579855
VOLLEYBALL LIFE 5180887
STARTUPPRENEUR 5578576
BRAND SPARKLING NEW 5159016
I ONLY MAKE BOYS 5576414
MOMMY TO BE 5133777
WHEN LIFE 5571376
INDEPENDENCE DAY 5100615
DUMPSTER DIVER 5571028
BRIDE'S MAID 5097568
WE ALL HAVE OUR MOMENTS 5570168
PEOPLE ARE AWESOME 4975441
EXCEED YOUR QUIT 5570051
4th OF JULY 4872453
BEARDIFUL 5568770
THIS GIRL US 4796171
DO GOOD BE KIND 5563924
YOU'RE KILLING ME!! SMALLS 4784191
PARK SLOPE 5563011
FOOTBALL MOM 4783661
WAKE UP BE HAPPY 5562958
BASEBALL MOM 4783660
WORKING ON THE ALBUM 5561056
SOFTBALL MOM 4783658
COUNTRYHOLIC 5561038
I LOVE MY BIG SISTER 4749476
GET YOUR BEER ON 5560890
I WORK HARD 4686987
WOAH 5560872
I'D RATHER BE WITH MY DOG 4680605
BROKEN ENGLISH 5560624
VERSE OF THE WEEK 4571784

PROUDLY BORN 5560591
I LOVE MY WIFE 4541673
EARN YOUR SLEEP 5560547
THIS GUY 4369954
TSTARS 5559415
WHAT'S YOUR SUPERPOWER? 4169154
EVERYTHING OFFENDS ME 5555286
NO SLEEP 3812057
JAWLLY CHRISTMAS 5553553
DON'T TREAD ON ME 2959755
ADULTING & SCREAMING 5553248
I'M THE BIG BROTHER 2166736
TV DAD 5550878
I'M THE BIG SISTER 2153621
DOGS 5843989
HOWDY AMERICA 564967

So as a small business owner, what is my recourse when the government agency responsible for ensuring frivolous trademarks won't be registered is negligent in their duties in upholding trademark laws?

My main recourse is to file a letter of protest (LOP) according to the USPTO.gov site and the TMEP 1715 Letters of Protest in Pending Application. Countless other small business owners and I have to take important time away from running our businesses in order to file LOP's for pending trademarks that somehow incorrectly made it through the "complete examination" of the USPTO.

So, I'm sure you can understand my frustration when I discovered that the USPTO is proposing to begin charging a fee of \$100-\$200 for each LOP submitted by small business owners like me, which we have to file in order to prevent trademarks from being registered that clearly violate the guidelines set forth in the TMEP, U.S.C. and the C.F.R.

Perhaps, addressing the actual problem; failure on the part of the examining attorneys, would be a better solution than to charge small business owners for catching these failures before they effect every business owner in perpetuity. I would also suggest charging an additional fee to any applicant found to have submitted a trademark application deemed to be frivolous, and outside the legal bounds set by trademark law. This solution would address the underlying cause of the influx of Letters Of Protest, and help to fund the accompanying increase in workload, while maintaining the integrity of Trademark law and the USPTO as a governing body.

To be clear, I'm pleading that the Commissioner for Trademarks or someone on their team take a close look at the evidence I have submitted and create a system of checks and balances to ensure that Examining Attorneys are indeed conducting a "complete examination" according to your guidelines.

I'm also asking that you remove any consideration of charging a fee for LOP's until changes have been made at the USPTO ensuring that the constitutional basis for trademarks is being followed.

Please feel free to reach out to me with any further questions.

A Deeply Concerned Small Business Owner,
Jeff Baker