

Trademark Examiner Teleconferences and Communications Strategies: Preparing for and Conducting Examiner Communications to Advance Trademark Prosecution

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Today's faculty features:

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Trademark Prosecution: Anything You Say Can and Will Be Used in a Court of Law

Brian M. Taillon

Trademark practitioners need to remember that the trademark they seek to register for the client may someday need to be enforced. Statements made during prosecution, including direct communications with Examiners, are part of the record and may be used against the client in litigation.

Even though some Examiners may be less formal, the TMEP requires that they note the file on any communications. Proceed with caution!

A. Communications with the Examiner are On the Record

1. TMEP 709 – Interviews

“A discussion between the applicant or applicant’s qualified practitioner and the examining attorney in which the applicant presents matters for the examining attorney’s consideration is considered an interview. An interview can be conducted in person, by telephone, or by e-mail.” TMEP § 709 (emphasis added).

2. TMEP § 709.01 – Personal Interviews

A “personal interview” is a formal meeting scheduled with the examiner. It must be arranged in advance, to ensure that the examiner will be available and have time to review the record. Unexpected appearances by an applicant or practitioner are inappropriate.

The interview should only be conducted to develop and clarify specific issues and lead to an understanding with the examiner. It should not extend beyond a reasonable time.

The examiner may conclude the interview when it appears no agreement can be reached. When an agreement is reached as to some but not all issues through an examiner’s amendment, the examiner should enter a Note to the File concerning the agreement, and ask the applicant to incorporate the agreement into its response.

3. TMEP § 709.03 – Making Substance of Interview of Record:

“The substance of an interview must always be made of record in the application, since the action of the USPTO is based exclusively on the written record.”

If possible, agreements reached in the interview should be incorporated in an examiner’s amendment or priority action. Otherwise, to ensure that any agreements will be implemented and to avoid misunderstandings, the examiner should include, in a Note to the File, a list of issues discussed and indicate whether any agreement was reached.

The applicant or practitioner may also make the substance of the interview part of the record by incorporating a summary of the interview in a response to the Office Action. If there is any disagreement with the examiner as to the substance of the interview, the written record governs.

4. TMEP § 709.04 – Telephone & E-mail Communications

The TMEP encourages examiners to initiate telephone calls or e-mails to expedite prosecution of the application. It also states that practitioners may telephone or e-mail examiners if they feel it will advance prosecution. *However*, even informal communications are to be included in the written record:

“The action of the USPTO is based exclusively on the written record and all relevant communications, including informal communications, must be made part of the record.”

5. TMEP § 709.05 – Informal Communications

The TMEP states that informal communications should be conducted only to develop and clarify specific issues and lead to an understanding with the examiner. They are not to be used to request advisory opinions as to overcoming a substantive refusal. In any event, “[r]elevant e-mail and phone communications must be made part of the record, because the USPTO uses them in decision making, and anything used in decision making must be made of record.” Therefore, the examiner must upload all relevant e-mail communications and must enter a Note to the File regarding issues discussed by telephone.

The substance of formal communications such as in-person interviews, and of informal communications such as telephone calls and e-mails, are to be part of the record for a trademark application. If the mark that is the subject of that application is someday enforced, the potential for file wrapper estoppel against the trademark owner arises.

B. File Wrapper Estoppel – Not the Same as Patents, but Still Relevant

Many practitioners who prosecute trademark applications also prosecute patent applications. Though issues of file wrapper estoppel may not be as critical in enforcing trademarks as in enforcing patents, they are still important to consider.

1. Patent Law – File Wrapper Estoppel

In patent law, the doctrine of “file wrapper” or “prosecution history” estoppel precludes a patent owner in an infringement suit from obtaining a claim construction that would in effect resurrect subject matter surrendered during the course of prosecution. See *5A-18 Chisum on Patents § 18.05*. The estoppel applies most frequently when an applicant amends or cancels claims rejected by an examiner as unpatentable in light of the prior art, though it has also been extended to other amendments, and has been extended to arguments by an applicant even when the argument is not accompanied by an amendment.

Broadly stated, statements made by the patentee to obtain patentability may give rise to file wrapper estoppel. Estoppel prevents the patentee from claiming subject matter for purposes of patent enforcement that he/she surrendered for purposes of obtaining the patent. The facts behind a file wrapper estoppel typically include the following:

- A patent application claims a device having certain features.
- The examiner rejects the claims based on prior art having those features.
- The applicant argues that one or more features of his/her device is different from the prior art, and perhaps amends the patent claims accordingly.
- The examiner allows the claims based on these arguments and amendments.
- The patent issues.
- A competitor appears with a device having features similar to the cited prior art. The patentee alleges infringement.

- The patentee is estopped from claiming that the patent covers the prior art features, and the patent is construed more narrowly based at least in part on the arguments and amendments raised during prosecution.

The word “estoppel” suggests that file wrapper estoppel is an affirmative defense, but in fact it is an essential tool for claim construction. Patent law requires the court to construe the patent claims asserted in the litigation. The construed claims are then compared not only to the accused infringing device or process, but also to any asserted invalidating prior art. File wrapper estoppel is therefore a powerful tool in patent litigation because it serves to limit the scope of a patent’s claims, and therefore limit the breadth of enforcement of the patent against potentially infringing products in the marketplace, as well as the potential for invalidating the patent based on asserted prior art.

2. Trademark Law – No File Wrapper Estoppel per se, but Still Relevant

The patent law rule of “file wrapper estoppel” is not an absolute rule of evidence in trademark proceedings. A statement made by an applicant to the Trademark Office does not necessarily estop the applicant from later claiming to the contrary. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015). However, the statement could have significance. *Id.*

The *Juice Generation* decision from the Federal Circuit is instructive. Juice Generation applied to register the mark “PEACE LOVE AND JUICE” for its juice bar services. GS Enterprises opposed the application on the ground that the mark was likely to cause confusion with its own family of marks containing the phrase “PEACE & LOVE” for restaurant services. 794 F.3d at 1336. The TTAB sustained the opposition and refused registration of Juice Generation’s mark.

The Federal Circuit found that the Board did not adequately assess the weakness of GS’s marks and did not properly consider the three-word combination of Juice Generation’s mark as a whole in comparing it to the two-word combination in GS’s marks, and remanded. In particular, the Court found GS’s statements during prosecution of its “PEACE & LOVE” mark significant to the determination of the mark’s strength. The examiner had initially denied registration of the “PEACE & LOVE” mark due to a likelihood of confusion with Chick-fil-A’s mark “PEECE LUV CHIKIN.” GS responded that its mark conveyed a different overall impression because its mark reflected a theme and atmosphere of the counterculture prevalent in the 1960’s and 1970’s. The Court found these statements relevant to determining GS’s own belief as to the strength of the words “PEACE” and “LOVE” in connection with restaurant services. *Id.* at 1340.

The Court noted that file wrapper estoppel has played a more limited role for trademarks than for patents, but recognized that such comments by an applicant have significance “as facts ‘illuminative of shade and tone in the total picture confronting the decision maker.’” *Id.* The Court also noted that other courts have afforded greater weight to such statements. See, e.g., *Freedom Card, Inc. v. JPMorgan Chase & Co.*, 432 F.3d 463, 476 (3d Cir. 2005), *infra*. In remanding the matter, the Federal Circuit did not find that an estoppel had necessarily been created, but rather found that the Board should have considered GS’s statements as relevant toward determining the strength of its mark.

In the *Freedom Card* case, the Third Circuit noted that infringement plaintiff Urban Television Network (“UTN”) overcame objections to additional “FREEDOM” marks it applied for by submitting a one-inch thick exhibit of numerous other “FREEDOM” marks at the USPTO. UTN argued that those marks, together with third-party marks cited by the USPTO, were “all existing together in the marketplace” and as a result, “no one has the exclusive right to use the word ‘FREEDOM’ alone.” 432 F.3d at 476. The court found that UTN’s own statements, together with Chase’s undisputed evidence of

the widespread and common use of “FREEDOM,” undermined UTN’s attempt to establish likelihood of confusion.

The Trademark Trial & Appeal Board has given varying degrees of weight to prior inconsistent statements made in ex parte applications, but generally holds that while they do not create an estoppel, they are considered as evidence, “albeit not conclusive evidence, of the truth of the assertions.” *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 U.S.P.Q. 597 (TTAB 1982), aff’d, 706 F.2d 1213 (Fed. Cir. 1983). In *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1552 (TTAB 2010), the Board found that a registrant’s arguments to an examiner that the design part of the word-design mark was dominant did not prevent the Board from finding to the contrary that the word part was dominant.

While there is no file wrapper estoppel in trademark litigation *per se*, an applicant’s arguments during prosecution still constitute a factor to consider. Though some courts appear more willing than others to hold a trademark owner to the positions it had taken during prosecution, the potential remains that an applicant’s statements and arguments made during trademark prosecution will become evidence in subsequent litigation. It therefore stands to reason that if a position taken by an applicant in communications outside of a response to Office Action can be made part of the record, that position may be used against that applicant in subsequent enforcement of the subject mark.

C. You Have the Right to Remain Silent!

The substance of communications between an applicant or practitioner and an examiner are likely to become part of the record. The applicant or practitioner’s statements, arguments and positions taken during these communications may be used against the applicant in a subsequent enforcement action, be it before the Board or in court.

It is important to remember, however, that the potential for estoppel can be avoided to an extent. As discussed above, the TMEP encourages examiners to initiate telephone or e-mail communications whenever possible to expedite prosecution of the application. When this occurs, the temptation is to immediately respond to the examiner. In that sense, an informal communication from the examiner can be akin to a “pop quiz” Office Action which the practitioner is put into the position of having to answer on the spot. Remember, though, that you do not have to take a position at that time. Rather, you can inform the examiner that you want to take time to consider the matter before you get back to them. The examiner will typically give you a couple of days before they have to issue an Office Action. You may also simply request that an Office Action be issued at the outset and take advantage of your six-month response period.

For example, I once had an examiner call me in connection with an application Carl was prosecuting but he was out of the office that day. The examiner informed me that we needed to take a Disclaimer against the wording in the mark. I found the requirement questionable and did not feel comfortable stating anything to the examiner, so I indicated that I would prefer to receive a Priority Action setting forth the requirement. Months later, I prepared a written argument against the requirement. The requirement was withdrawn, and the mark ultimately registered on the Principal Register without entry of a disclaimer.

Carl, Laurie and I have plenty of informative “war stories” such as this in discussing the finer points of communicating with examiners, and I would now like to turn over the discussion for the full panel to share. Thank you.