TRADEMARK PROSECUTION  
SUMMER 2012

Instructor: Stacey J. Watson  
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Class Hours: M/W 6pm – 8pm  
Classroom: 222

Required Textbook: None.

Course Material: Selected cases and TMEP Sections throughout the term. The list will be supplemented throughout the term.

Guest lecturers will be invited for many topics to help illustrate the topics. This course will illustrate the practical aspects of trademark search, clearance, strategy, counseling, prosecution and enforcement. We will discuss the law, USPTO rules and procedures, pleadings and forms, and client counseling.

**Week 1 (2 classes)**

- **May 21st - Class 1: Overview of trademark law.** We will discuss the spectrum of distinctiveness, descriptiveness, likelihood of confusion, geographic terms, surnames, adoption and use, priority.
  - Reading: None

- **May 23rd - Class 2: Overview the U.S. trademark application.** We will discuss each element and its importance; proper drafting skills and how they impact the prosecution process.
  - Reading:
    - TMEP Section 103
    - TMEP Section 800

**Week 2 (1 class)**

- **May 30th - Class 3: Search/Clearance/Identification of Goods/Services.** We will discuss the strategy behind clearing a mark; weakness and strength; logos; trade dress; inherent distinctiveness; color.
  - Assignment after class – to search 10 marks (will be discussed in next class)
  - Reading:
    - TMEP Section 104
    - TMEP Sections 901, 903, 904
    - TMEP Sections 1207-1211
    - TMEP Section 1401, 1402

**Week 3 (2 classes)**

- **June 4th - Class 4: Search/Clearance/Identification of Goods/Services.** We will have a further discussion about clearance and specific application.
  - Assignment
    - Discuss the 10 marks assigned in the last class; bring search strategies and “relevant” marks to class.
  - Reading:
    - None.

- **June 6th - Class 5: Filing Strategy/Counseling.** Jackie Patt (Venable LLP) – to discuss counseling and strategy.
  - READING:
    - To Come
Week 4 (2 classes)

- **June 11th - Class 6: Filing Strategy/Counseling.** We will discuss counseling with clients and the tendency to pick descriptive marks, the pros and cons of descriptive marks, domain names and how they relate, social media and how they relate.
  - **Reading:**
    - In re Reynolds Metals Co., 480 F.2d 902 (CCPA 1973)
    - International Kennel club of Chicago, Inc. v. Mighty Star, Inc., 846 F.2d 1079 (7th Cir. 1988)
    - Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863 (8th Cir. 1994)
    - Bayer Co. v. United Drug Co., 227 F. 505 (SDNY 1921)
    - DuPont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2nd Cir. 1936)
    - Blinded Veterans Association v. Blinded American Veterans Foundation, 872 F.2d 1035 (DC Cir. 1989)
    - Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2nd Cir), cert denied, 368 U.S. 820 (1961)

- **June 13th - Class 7: Office Actions.** Michael Levy (USPTO) will discuss how examination takes place from the PTO perspective.
  - **Assignment after class** – to review 10 prosecution histories (will be discussed in the next class)
  - **READING:**
    - To Come

Week 5 (2 classes)

- **June 18th - Class 8: Office Actions.** We will discuss how to handle all types of office actions from substantive (likelihood of confusion/descriptiveness) to procedural (identifications and specimens); we will also discuss appeals from Final Refusals.
  - **Assignment:**
    - Discuss the prosecution histories handed out in previous class.
  - **Reading:**
    - None.

- **June 20th - Class 9: International Strategy.** We will discuss how marks are rolled out internationally; the thinking behind clearance internationally; subclasses; translation into other languages; prioritization and budgets; filing options – e.g., Madrid.
  - **READING:**
    - Review OHIM website
    - Review WIPO – Madrid Protocol Website

Week 6 (2 classes)

- **June 25th - Class 10: International Strategy:** Nancy Lutz (Kelley Drye) will discuss different real world scenarios.
  - **Reading:**
    - To Come
- **June 27th - Class 11: Trademark Enforcement:** We will discuss Oppositions/Cancellation proceedings and cease and desist letters and drafting of all.
  - Reading:
    - Review Polaroid and Gallo cases
    - Wal-Mart v. Samara Brothers

**Week 7 (1 class)**
- **July 2nd - Class 12: Trademark Enforcement:** Julia Matheson (Finnegan) will discuss what works and what doesn’t work in terms of PTO filings – both ex parte and inter partes.
  - Reading:
    - To Come

**Week 8 (2 classes)**
- **July 9th - Class 13: Trademark Licenses and Assignments.** We will discuss the different types of trademark licenses and assignments and how they are included in divestitures and acquisitions.
  - Reading:
    - To Come

- **July 10th - Class 14: Wrap up and Summary.** We will discuss how prosecution practice ties in to civil litigation and unfair competition. We will do a review of the course to help to prepare for the Final.
  - Reading:
    - None – last day

FINAL EXAM – Open note/book.