

March 16, 2015

The Honorable Mary Boney Denison
Commissioner for Trademarks
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

via email: TMPolicy@uspto.gov

**Re: AIPLA Comments in Response to the USPTO Repeating-Pattern
Marks Examination Guide**

Dear Commissioner Denison:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the Repeating-Pattern Marks Examination Guide promulgated by the United States Patent and Trademark Office (USPTO) and published on the web at www.uspto.gov/trademarks/notices/RptdPatternsExamGuide_draft_public_comment.doc.

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA's members represent a wide and diverse spectrum of individuals, companies, and institutions, and are involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

The Examination Guide clearly reflects the extensive time and effort expended by the USPTO in its preparation. The comments below are provided in the spirit of making the final version as beneficial and efficient to the users as possible.

INTRODUCTION

As indicated in the Examination Guide, a repeating-pattern mark is any mark composed of a single repeated element or a repeated combination of elements such as designs, numbers, letters, or other characters, forming a pattern that is displayed on the surface of goods, on product packaging, or on materials associated with the advertising or provision of services. The Guide addresses requirements for mark descriptions, specimens of use and drawings for this type of mark. It also addresses whether such marks can be inherently distinctive, explains requirements for identifications of goods and services, and sets forth potential refusals and relevant response options. The Guide provides many examples to clarify these requirements.

This response is organized into three sections. The first addresses whether these marks can be inherently distinctive; the second, the requirements concerning drawings of such marks; and the third, the specimens and related evidentiary submissions needed to support registration.

COMMENTS

Inherent Distinctiveness of Repeating-Pattern Marks

The determination whether repeating-pattern marks are inherently distinctive should be based on a case-by-case analysis. We do not believe there should be a per se rule that such marks are not inherently distinctive. If that were the rule, in all cases extensive evidence and argument would be needed to overcome the characterization of these marks as being non-distinctive. To that end, we encourage the USPTO to omit from the final version of the Examination Guide the text at Section III.A.1 that says repeating-pattern marks “are usually not inherently distinctive when applied to goods packaging, or materials associated with services.” The Guide does not give legal support for this statement, but it could be misconstrued as legal precedent that must be considered the starting point in the analysis for all applications concerning repeating-pattern marks. AIPLA further believes that the USPTO lacks authority for substantive rule-making of this type.

Further, Section III.A.1.e states that “when repeating patterns appear on items such as ... fashion accessories ... the patterns are likely to be perceived as decoration because those types of goods are typically purchased or used, at least in part for their aesthetic appeal.” We do not believe this statement is accurate as applied to fashion accessories. These patterns are used to emphasize the brand so that consumers will know that the purchaser’s bag is by X designer, not as an aesthetic element. The fact that luxury bags bearing repeating-pattern marks are often subject to widespread counterfeiting supports the notion that the repeating pattern is functioning as a brand identifier rather than an aesthetic element, and that it is the mark function of the repeating pattern that drives people to buy the bags.

Drawings

Section II.A.1.c imposes a rather stringent requirement for the mark drawing. It indicates that “swatch” type drawings will not be accepted if they could encompass multiple versions of the mark. It appears that there may be a great many refusals of applications for registration of these marks, many of which are submitted under a Section 44(e) or Section 66(a) basis. Such refusals could put foreign applicants at a significant disadvantage in the application process, counter to the intent of those sections of the Lanham Act that were intended to put foreign applicants on a more equal footing with domestic applicants. The disadvantage is due to the requirement that the drawing in the U.S. application and the drawing in the home country registration must be close to identical. As a result, the applicant is not able to make changes in the mark drawing to overcome a refusal that a “swatch” type drawing, which is frequently used and accepted outside of the U.S., is not acceptable in the U.S. *See* Section II.C.5 of the Examination Guide.

Another factor concerning filings under Sections 44(e) and 66(a) is the reference to providing a showing or further evidence of how a repeating-pattern mark is used or will be used, to support the submission of a “swatch” type drawing. AIPLA suggests that the USPTO add some illustrations of the evidence required, especially in a non-use based application. These should demonstrate both acceptable and unacceptable examples.

Evidence in Support of Specimens

The requirements for evidence in support of specimens seem substantial, but they are perhaps not very clear concerning the kind of evidence needed to establish the various points. One specific example of the increased evidentiary burden is that specimens may be required for all of the goods in the applications. Section II.D states that “Examining Attorneys may require additional specimens to determine whether the applied-for mark functions as a trademark or a service mark for all of the identified goods or services.” (Emphasis added). It would be helpful if the final Guide could justify this higher level of evidence, and point to examples from the Trademark Register of cases in which applicants were required to submit evidence that would satisfy the requirements outlined in the Guide. Otherwise, it may be difficult for practitioners to advise their clients as to what type of specimens will be accepted to support registration, how much evidence is necessary for such acceptance, what the nature of that supporting evidence should be, etc.

Additional Comment

AIPLA offers an additional comment as to whether repeating-pattern marks which appear on product packaging should be treated differently than repeating-pattern marks which appear on the product surface itself. The Guide suggests that these two types of repeating-pattern marks should be treated differently. For example, in the case of marks that appear on the packaging, the Guide requires specimens showing the packaging in its entirety, not just the affixed repeating pattern, even though in both cases it is the repeating pattern itself that is being claimed. This requirement seems more appropriate to trade dress protection, rather than a trademark application. In our opinion, a repeating-pattern mark that appears on packaging should be treated the same as a repeating-pattern mark that appears on the product itself, without additional specimen or evidentiary requirements.

CONCLUSION

AIPLA appreciates the opportunity to provide comments on this important initiative. We look forward to further dialogue with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO’s mission.

Sincerely,



Sharon A. Israel

President

American Intellectual Property Law Association