

# AIPLA

American Intellectual Property Law Association

March 15, 2017

The Honorable Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of U.S. Patent and Trademark Office  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

*Attention: Jennifer Chicoski  
Office of the Deputy Commissioner for Trademark Examination Policy  
Via email: [TMFRNotices@uspto.gov](mailto:TMFRNotices@uspto.gov)*

**Re: Comments on Examination Guide Entitled “Incapable Informational Matter”**

Dear Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to present comments received from its constituent trademark committees in response to the Examination Guide entitled “Incapable Informational Matter” released for comment on January 25, 2017.

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA generally supports the USPTO’s development of an Examination Guide (“EG”) to clarify the USPTO’s policies and procedures when examining marks containing certain types of informational matter that do not indicate source and fail to function as a mark. However, we are concerned about the potential for inconsistent application of the examination guidelines, and the possibility that issues raised in the EG will create an additional burden (and corresponding attorneys’ fees) on applicants to overcome failure-to-function refusals generated under the EG. To alleviate these concerns, AIPLA recommends clarification to the EG as detailed below.

**(1) Matter Used in a Manner to Convey Information about the Goods/Services**

AIPLA recommends clarification of the EG to better address the distinction between an “incapable informational matter” refusal, a descriptiveness refusal, a genericness refusal, and a merely ornamental refusal. Because informational matter *can* be used as a trademark, and function as a trademark depending on the goods/services for which registration is sought, the EG should be clarified to better define when an “incapable informational matter” refusal is appropriate, especially as distinguished from generic and merely descriptive refusals.

AIPLA applauds the EG’s encouragement of consideration of a variety of evidence and recommends that the USPTO allow the examining attorney some latitude to make a fact-specific determination based upon the evidence presented by the applicant, or when alternative or substitute specimens are presented to address the issue or overcome the refusal.

The EG should also encourage examining attorneys to consider all evidence presented by an applicant to overcome an “incapable informational matter” refusal. AIPLA is concerned that examining attorneys may read the guidelines of Section IV of the EG in an overly restrictive manner - resulting in a lack of consideration of evidence presented by an applicant when attempting to overcome an “incapable informational matter” refusal. AIPLA recommends that Section IV of the EG be clarified to specify when an applicant can overcome a refusal based on “incapable informational matter.” As currently worded, page 11 of the EG, in the second paragraph under “Acquired Distinctiveness and Supplemental Register,” indicates that an incapable informational matter refusal “must” be maintained even if a “sufficient” claim of acquired distinctiveness is submitted in response to a refusal. This creates a discrepancy and incorrectly implies that no response can overcome such a refusal, so clarification of the EG is needed.

**(2) Matter That Is a Widely Used Message**

The EG permits (indeed, encourages) examining attorneys to refer to a variety of resources to determine the commonality of the wording at issue. Examination Guide, pp. 2, 6. The EG goes on to suggest that “the number of ‘likes’, page views, and message forwards on social media websites” can also be used for this purpose. Examination Guide, p. 6. AIPLA recommends clarification to ensure that mere quantity alone is not determinative of commonality. The timeframe during which a term trends over social media or other Internet sites should also be considered along with the qualitative value of the references. Widespread usage of a term, or the common appearance of a term on social media websites, sometimes trends only briefly, and a single snapshot in time does not necessarily forego a term’s ability to function as a trademark for certain goods or services. The EG also leaves open to individual examiner judgment whether a term has in fact become so “widely used” or “common” that it can no longer function as a mark. AIPLA suggests developing more routine or standard guidelines to enable examining attorneys and brand owners to more readily and consistently determine whether a term is no longer available for registration without a disclaimer.

AIPLA members were also concerned by the EG’s position that some widespread use does not require consideration of the particular goods and services at issue. While some messages are so widespread that virtually any good or service would support the same conclusion, that is not always true. AIPLA recommends that the EG direct examining attorneys to always

consider the particular goods and services at issue before issuing an “incapable informational matter” refusal based on the widespread use of a common phrase. To use an example in the EG, an application for the mark “DRIVE SAFELY” may be considered an unregistrable commonplace message for goods or services associated with driving, but the same may not be true for other goods and services (such as “DRIVE SAFELY” for cosmetics, where the phrase may be considered arbitrary).

AIPLA also recommends clarification of the statement on page 6 that using a mark in a “less prominent manner” than other clear source identifiers supports a determination that a mark is incapable of identifying a single source. Brand owners often have more than one mark on a product which may include a more prominent house mark and a secondary brand name or slogan displayed elsewhere on the product. The mere fact that the secondary brand name or slogan appears “less” prominently on a label should not foreclose registration or lead to a refusal based on incapable informational matter.

**(3) Matter That is Directly From a Religious Text**

Although AIPLA does not have substantive comments on the portion of the EG regarding religious texts or references, AIPLA notes that the examples provided in the EG and Appendix are strongly focused on Biblical and Christian references. AIPLA suggests that the USPTO consider including additional examples that are representative of other religions and religious texts to make the EG more inclusive and instructive.

We thank you for allowing AIPLA the opportunity to provide comments on the Examination Guide entitled “Incapable Informational Matter.” Please let us know if AIPLA can offer any additional comments or input.

Sincerely,



Mark L. Whitaker

President

American Intellectual Property Law Association