



Pro Se Trademark Applications

A new Stanford University Law School study confirms that those who seek an attorney's help in registering a trademark are more likely to obtain a registration than those who go it alone. After compiling 25 years' worth of trademark application/registration data from the United States Patent & Trademark Office, Stanford confirmed that 60% of applicants utilizing the services of a trademark attorney were successfully granted a registration, while only 40% of those going it alone obtained registrations.

While the USPTO electronic filing system tends to seemingly simplify the process of filing a trademark application, it does little to educate the applicant as to the legalities involved. Those legalities directly affect the success of the application. Disclose the wrong or inaccurate information during the application process and you may fatally and irretrievably doom your application. Provide too much information, or fail to provide enough, and you can needlessly limit the scope and breadth of your protection, even if you are granted a registration.

And perhaps one step worse than "Do It Yourself" is using an online, non-legal service to apply for your trademark. Services that advertise their ability to "file trademarks" but do not provide legal advice and counsel are doing nothing more than taking your money to type in your information into the USPTO application website.

The trademark registration process is fraught with numerous bits and pieces of legal protocol, procedure, and concepts of law, any of which can trip-up a trademark application. Frequently trademark attorneys are approached by the "do-it-yourselfers" who were lured in by the apparent ease of the USPTO website filing process, or by the aforementioned non-legal trademark filing services, only to later find there are technical and legal questions, revisions and amendments that are required to be answered and submitted before a registration can be issued. At that point it typically costs the applicant more for an attorney to take over a pending file than it would have, had the applicant simply hired an attorney to start, (and finish), the process from the beginning.

And then there are the real-world, practical realities regarding disclosures to the Trademark Office in an application that are either incomplete, disclose too much information, or are factually inaccurate. For example, submit a description of services or goods that is inaccurate or overly inclusive, and you risk losing your entire registration through an invalidity challenge and being accused of fraud on the Patent Office. Such was the case when an apparel manufacturer was challenged by Toyota over the mark "TUNDRA." The apparel manufacturer over-disclosed items in its description of goods associated with their trademark. Upon challenge from Toyota, the trademark registrations were invalidated based on a theory that the registrations were fraudulently obtained because information disclosed in the applications were either overly-broad or inaccurate. (*see Standard Knitting, Ltd v. Toyota Jidosha Kabushiki Kaisha* 77 USPQ2d 1917 (TTAB 2006)).

The main benefit sought by trademark owners is legal protection for their marks. If the occasion ever arises where the trademark registration must be used in a legal challenge either as either a "shield" defensively, or a "sword" offensively, it is imperative that the trademark registration survive scrutiny, as the first thing that will happen in litigation, (prosecuting or defending), is to attempt to invalidate the registration. Sometimes a simple inaccuracy in a disclosure in a trademark application is enough to call the entire registration into question. This is where it becomes critical that every step in the trademark application process was done properly.

The Stanford study may demonstrate that a trademark applicant is 60% better off with an attorney than without one if considering only the odds of successfully registering a trademark. However, the critical issues raised in this article but not reflected in the Stanford study clearly call into question the validity of the 40% that went it alone. Those questions won't be answered until those registrations are challenged.

The Stanford study is revealing and, in the words of John Adams, "facts are very stubborn things."

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