Enclosed is Release #45 (September 2019) of *Trademark Registration Practice*. *Trademark Registration Practice* guides the reader through all aspects of the federal trademark registration process, from selection and evaluation of a mark, to all facets of preparing, filing and prosecuting the application before the United States Patent and Trademark Office. It also covers related matters such as the state and foreign trademark registration process. Please note that, for ease of handling, the materials in this shipment may ship in more than one box.

**Highlights**

Among the more notable changes and additions included in this update are those regarding the following topics:

- § 2:13 The Federal Circuit’s decision in *Converse, Inc. v. ITC*, regarding the factors to be considered in determining whether trade dress has acquired secondary meaning.
- § 2:19.50 New Section: Initiating use of a mark and the regulations affecting labeling and usage under the Controlled Substances Act.
- § 3:26 The Federal Circuit’s decision in *In re Siny Corp.*, addressing how to determine whether a web page is a point of sale.
- § 3:30 Proposed amendments to the Rules of Practice requiring foreign applicants be represented by an attorney licensed in the U.S.
- § 6:10 Recent decisions by the TTAB evaluating fame of the prior mark.
- §§ 6:14, 6:22 The TTAB’s findings on “clothed” consent agreements in *In re American Cruise Lines, Inc.*
§ 7:3 Recent TTAB decisions addressing criteria for determining “descriptiveness,” including In re Hikari Sales USA, Inc. and In re Virtual Independent Paralegals, LLC.

§ 16:22.50 New Section: TTAB Operations, describing how cases are processed.

§ 17:8 In motion practice, motions to compel must be filed before the deadline for plaintiff’s pretrial disclosures, the TTAB found in Asustek Computer Incorporation v. Chengdu Westhouse Interactive Entertainment Co., Ltd.

§ 17:12 The TTAB’s decision in The Coffee Studio LLC v. Reign LLC dba Coffee Studio.

§ 18:1 The Accelerated Case Resolution (ACR) Process, including the TTAB’s decision in TV Azteca, S.A.B. de C.V. v. Jeffrey E. Martin.

§ 27:10 Contractual estoppel, including the TTAB’s decision in Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC.

New Appendix U: Tips from the Trademark Trial and Appeals Board

The authors welcome comments and suggestions. Please send them to Amanda Dwight at ADwight@dwightlawgroup.com.

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Trademark Registration Practice
Volume 1
Second Edition
by James E. Hawes
Amanda V. Dwight
Acknowledgments

The updates prepared in the fall of 1999 and spring of 2000 were almost entirely the effort of Jeffrey M. Samuels. Mr. Samuels was the Assistant Commissioner for Trademarks at the PTO from November 1987 to January 1993. He is now a Professor at the University of Akron Law School. The scope and depth of those updates well exemplifies Mr. Samuels’ considerable and current knowledge of trademark law and practice, both as addressed from within the PTO as well as by trademark owners. His efforts are very much appreciated.

James E. Hawes
Palm Springs, CA

My introduction to the world of trademarks was a thorough reading of Trademark Registration Practice. Subsequently, I was introduced to Practitioner’s Trademark Manual of Examining Procedure. These two books form the foundation of my understanding of trademark prosecution practice. I am therefore very honored to now be a contributor and co-author of both of these books.

I want to acknowledge my parents, Nhuan and Phuong Vu. They taught me the value of hard work and perseverance and instilled in me confidence to pursue my aspirations. I also want to thank my husband, Ryan Dwight, for his enthusiastic support, inspiration and encouragement in everything I do.

Amanda Vu Dwight
Dwight Law Group
Costa Mesa, CA
May 2003
Proviso

The authors assume that readers consult this treatise to solve a specific problem. For example, they might go to the index, then to the section referenced for that problem, read it and stop there. Accordingly, various cautions and case discussions are repeated at all relevant places.
### Some Common Abbreviations Used in Trademark Practice

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<thead>
<tr>
<th>Abbreviation</th>
<th>Full Form</th>
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<tbody>
<tr>
<td>APLA</td>
<td>American Patent Law Association</td>
</tr>
<tr>
<td>BISX</td>
<td>the TTAB information system</td>
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<tr>
<td>CCPA</td>
<td>Court of Customs and Patent Appeals, now the Court of Appeals for the Federal Circuit (CAFC)</td>
</tr>
<tr>
<td>CD</td>
<td>Commissioner’s Decisions (decisions of the Commissioner of Patents and Trademarks)</td>
</tr>
<tr>
<td>CFR</td>
<td>Code of Federal Regulations (Chapter 37 includes the Rules of Practice in Trademark Cases)</td>
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<tr>
<td>Comm. Pats</td>
<td>Commissioner of Patents (since 1975, the Comm. PT)</td>
</tr>
<tr>
<td>Comm. PT</td>
<td>Commissioner of Patents and Trademarks</td>
</tr>
<tr>
<td>ESTTA</td>
<td>the Electronic System for Trademark Trials and Appeals used by the TTAB - see <a href="http://estta.uspto.gov">http://estta.uspto.gov</a></td>
</tr>
<tr>
<td>ETAS</td>
<td>the Electronic Trademark Assignment System which provides for on-line recordation of trademark assignments.</td>
</tr>
<tr>
<td>E-TEAS</td>
<td>the electronic TEAS; the version of TEAS that receives and provides access to documents filed electronically with the Office.</td>
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<tr>
<td>Abbreviation</td>
<td>Description</td>
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<tr>
<td>Fed. Cir.</td>
<td>Another abbreviation for the Court of Appeals for the Federal Circuit</td>
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<td>IB</td>
<td>the International Bureau at WIPO which handles Madrid Protocol applications; for information - <a href="http://www.wipo.int/madrid/en/">www.wipo.int/madrid/en/</a></td>
</tr>
<tr>
<td>INTA</td>
<td>International Trademark Association, headquartered in New York City (formerly the United States Trademark Association)</td>
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<tr>
<td>International application</td>
<td>a term used in the Madrid Protocol and PTO rules to designate the application for international registration of a mark that is forwarded to the IB seeking extension of protection in named Madrid Protocol countries.</td>
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<tr>
<td>ITU</td>
<td>Intent to Use</td>
</tr>
<tr>
<td>JPTOS</td>
<td>Journal of the Patent and Trademark Office Society</td>
</tr>
<tr>
<td>MPU</td>
<td>the Madrid Processing Unit at the Office</td>
</tr>
<tr>
<td>Office</td>
<td>The Patent and Trademark Office</td>
</tr>
<tr>
<td>Office Action</td>
<td>Communication from the Office’s examining attorney setting forth the legal status of a trademark application. The different types of office actions include: examiner’s amendments, priority actions, non-final office actions, final office actions, and suspension letters.</td>
</tr>
<tr>
<td>Abbreviation</td>
<td>Description</td>
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<tr>
<td>OG .......... Official Gazette, a publication of the PTO available from the Superintendent of Documents and now issued weekly in two volumes, one concerning patents, the other concerning trademarks</td>
<td></td>
</tr>
<tr>
<td>OG(Tm) .......... Trademark volume of the Official Gazette, issued weekly</td>
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<tr>
<td>Paris Convention application .......... an application filed with the PTO that seeks registration of a mark pursuant to sec. 44 of the Lanham Act.</td>
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<tr>
<td>PTO .......... Patent and Trademark Office</td>
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<tr>
<td>REP or Section 66(a) application .......... Request for Extension of Protection - the Madrid Protocol application filed with the Office under Section 66(a) of the Trademark Act.</td>
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<tr>
<td>Section 66(a) .......... the section of the Lanham Act - 15 U.S.C. - that provides for registration of Madrid Protocol marks in the U.S.</td>
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<tr>
<td>TAC .......... the Trademark Assistance Center at the Office. See Appendix A for the phone number.</td>
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<tr>
<td>TARR .......... the Office’s Trademark Applications and Registrations Retrieval system which provides information about pending and registered trademarks obtained from the Office’s internal database by entering either the serial number or registration number.</td>
<td></td>
</tr>
<tr>
<td>TBMP .......... Trademark Trial and Appeal Board Manual of Procedure</td>
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<tr>
<td>TDR .......... Trademark Document Retrieval system for viewing trademark applications files on-line.</td>
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</table>
TEAS ....................... the Trademark Electronic Application System for receiving and processing applications electronically to register trademarks before the Office.

TICRS ....................... Trademark Image Capture and Retrieval System, a system used at the Office to scan and provide on demand images of marks.

TMEP* ....................... Trademark Manual of Examining Procedure, published by the PTO and available from the Superintendent of Documents

TMR ....................... Trademark Reporter, a publication of the INTA

TMSL ....................... the Trademark Search Library at the Office for use by the public.

TRAM ....................... the Trademark Reporting and Monitoring System used at the Office.

TTAB ....................... Trademark Trial and Appeal Board (part of the PTO)

TTABIS ..................... the Trademark Trial and Appeal Board’s Information System, an automated system which the public can use to access TTAB records

TTABVUE .................... provides for online filings before the TTAB; see http://ttabvue.uspto.gov

UPWS ....................... the Universal Public Work Stations provided at the Office for use by the public to access electronic records.

USTA ....................... United States Trademark Association, headquartered in New York City (now the International Trademark Association)

* An annotated copy of the TMEP, entitled Practitioner’s Trademark Manual of Examining Procedure, is available from West.
WIPO .......................... World Intellectual Property Organization, headquartered in Geneva, Switzerland

Trademark practitioners will find it helpful to have available for reference a copy of the Lanham Act, Chapter 37 CFR, the TMEP, and Kramer and Brufsky, *Trademark Law Practice Forms* (West Group).
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