Exam #_____

Federal Trademark Registration
Spring, 2007
Final Examination
May 5, 2007

Instructions:

- You have 2 hours to complete this examination. Please write your answers in a blue book.
- This examination counts as 50% of your grade. I have assigned 100 points to this examination. The number of points applicable to each question is listed alongside the question numbers.
- Use an exam number; do not use your name anywhere. Please return your exam to the proctor in the blue book. Please place your exam number on the exam and on your TEAS form in the event they get separated from the blue book.
- This is a closed book exam. "Lanham Act §2 Rejection Bases" is attached.
- Unless otherwise specified, all questions pertain to the United States federal trademark registration system under the Lanham Act.
- Point distribution is as follows:

Question Number		Points
1		20
2		17
3		17
4		14
5		12
6		8
7		6
8		4
9		2
	Total:	100

1. (20 points) As PTO examining attorney, you receive a trademark application for CLINTON LUBE STATION (standard character) for an automobile mechanic shop that performs oil changes (also known as "lube jobs," although that phrase sometimes has a disreputable alternate connotation). The applicant supplied one "additional statement," a disclaimer of "LUBE STATION." There is no likelihood of confusion. There are 5,637 telephone directory listings nationwide for the last name Clinton; the applicant's name is George Flint. What do you do about this application?

2. (17 points) A trademark application for CAN-PAGNE for canned champagne is attached. You are the examining attorney and the applicant informs you the product will be produced in California. You locate the following information about champagne/Champagne: "To be champagne, a wine must do more than sparkle. It must come from the Champagne region in northeast France. This is the basic tenet of wine law in France… Part of Champagne's secret lies in its combination of latitude and precise position." The World Atlas of Wine. French law designates certain regions as "Appellation Contrôlée," which designates the region as well as the grape varieties grown and the wine-making method. Champagne is an Appellation Controôlée. Id.

What do you do about this application?

3. A registration certificate is attached for SEXY BELLY MATERNITY (plus design). Please write out:

a. (2 points) The dates for the next two maintenance windows;

b. (6 points) Name what filings must and what filings may be submitted at those times;

c. (7 points) Describe what is contained in those filings (please be specific to this particular registration);

d. (2 points) Will you recommend that the client purchase a monitoring service? Why?

4. On behalf of your client, you filed an application for registration of TOURMAX (standard character) for "tires for highway use on land passenger vehicles." The examining attorney refused registration based on a likelihood of confusion with an existing registration for MAXTOUR (standard character) for "pneumatic tires for vehicles" (pneumatic just means "filled with air"). The examining attorney has now issued a final office action. Your client does not want to abandon the application. The MAXTOUR tires are in actuality only used on golf carts, whereas the TOURMAX tires are only sold for use on highway-rated vehicles. Although you have not previously, you intend to introduce this evidence to argue your point.

a. (8 points) What must you file during the six month period following the date of the final office action?

b. (2 points) What are your approximate chances of success (not an analysis of the above facts, but the overall statistic for all such filings)?

c. (4 points) Now pretend the MAXTOUR registration does not exist. Instead, the examining attorney issues a final office action on her requirement that MAX be disclaimed. Does this change your procedural options for filing during the six month period following the date of the final office action? How?

5. (12 points) Attached is a copyright registration application and cover letter (read both) left on your desk today, filled out by another lawyer in your firm, who plans to mail in the application when he returns from vacation on May 14, 2007. Identify what he did right and what he did wrong based on the cover letter and Sections 2 and 6 of the application only (do not answer as to other issues); if he did something wrong, please write what was the appropriate way to fill out the form and/or submit the application. Also state whether he used the correct form. I am not looking for any answers pertaining to the filing fee, any addresses used, or any dates of birth/nationality/alternate name of the authors.

The work is a movie entitled "Lawyerly Love," released on DVD. The plot (voluntary reading) is listed in this footnote.[1]

Leonard Legal:	wrote the book ("Oppressive Obsession") upon which the movie is derived (Leonard gave a license to use the work)
Kimberly Kind:	wrote the screenplay for and filmed the movie
Melody Munch:	wrote and performed the sound track for the movie (love songs, tragic-sounding music for the death scenes, etc.)

6. (8 points) You are prosecuting an ITU (intent-to-use) trademark application for which a notice of allowance was issued on July 1, 2006. Your client contracted malaria and failed to respond to your letters about the deadline to file a statement of use until after the deadline passed. No filing was made, a notice of abandonment issued on April 5, 2007, and you forwarded it to your client. At that point, he recovered from malaria and informed you he did not intend to abandon the application, even though he has not yet begun using the mark (the malaria set him back). What are your next steps and what will be the PTO's response?

7. You represent Company B, who gives you a signed assignment of a registered trademark from Company A to Company B, dated May 5, 2007 (the ink is still wet).

a. (2 points) First, you review the assignment to see if it is valid. There is no issue as to the validity of Company A's actions or the signature. What language are you looking for in the assignment document?

[1] Two lawyers fall in love but cannot resist writing contracts between each other about every tiny aspect of their lives (who takes out the trash, who washes the cars, the month and day in which they will give birth to their only planned child, etc., etc., etc.). It drives them apart and in a very sad ending the husband, who, on the day he left his legal career to become a landscaper to save the marriage, dies in a tragic tractor accident. In her anguish, the wife mishandles a criminal defense case and her client retaliates by murdering her.

b. (2 points) You determine it is valid. You suspect Company A (dishonestly) may try to assign the trademark to Company C. What do you do to protect Company B's interest?

c. (2 points) You find out that a security interest is recorded at the PTO against the trademark registration, but no UCC-1 (financing statement) was filed in the appropriate state office. What do you advise Company B about this?

8. Describe

a. (2 points) What it means to be listed as the "correspondent" on the trademark application

b. (2 points) What it means to be listed as the "attorney of record" on the trademark application

9. (2 points) True or False. When a change is made to an application from registration on the Principal Register to a registration on the Supplemental Register, a fee applies.

Lanham Act § 2 Rejection Bases

§ 1052. Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of Title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which when used would cause dilution under section 1125(c) of this title may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which when used would cause dilution under section 1125(c) of this title may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

Trademark/Service Mark Application, Principal Register, with Declaration

Serial Number: 78259098
Filing Date: 06/06/2003

To the Commissioner for Trademarks:

MARK: CAN-PAGNE

The applicant, Christine Green a partnership organized under the laws of California, having as partner(s) Christopher Manalis, USA Christine Green USA, residing at 244 Ave Loberro #4, San Clemente, CA USA 92672, requests registration on the trademark/service mark shown on the drawing page in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U S C Section 1051 et seq), as amended

Intent to Use. The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services (15 U.S.C Section 1051(b))

International Class - CANNED CHAMPAGNE AND OR SPARKLING WINE

A fee payment in the amount of $335 will be submitted with the application, representing payment for 1 class(es)

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant, he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she *believes applicant to be entitled to use such mark in commerce*, to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake or to deceive, and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: Christine L Green Date: 06/05/2003
Signatory's Name: Christine Green
Signatory's Position: Co-Founder

Mailing Address:
Christine Green
244 Ave. Loberro #4
San Clemente, CA 92672

RAM Sale Number: 508
RAM Accounting Date: 06/06/2003

Serial Number: 78259098
Internet Transmission Date: Fri Jun 06 00:48:38 EDT 2003
TEAS Stamp: USPTO/BAS-68513913 2-20030606004838056556-78259098-200fe58f559ad339602a69ffcc729432e3-CC-508-20030606004545138432

Int. Cl.: 25

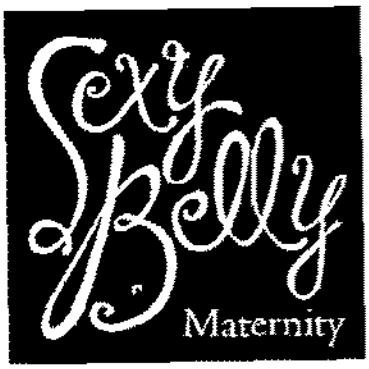
Prior U.S. Cls.: 22 and 39

Reg. No. 3,236,838

Registered May 1, 2007

United States Patent and Trademark Office

TRADEMARK
PRINCIPAL REGISTER



N & J KHAN LLC (NEW JERSEY LTD LIAB CO)
ONE INDEPENDENCE COURT - APT. 316NJ
HOBOKEN, NJ 07030

FOR: MATERNITY CLOTHING, NAMELY, TOPS, PANTS, DRESSES, LINGERIE, SKIRTS, AND SHOES, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 3-1-2006; IN COMMERCE 4-1-2006.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MATERNITY", APART FROM THE MARK AS SHOWN.

SER. NO. 78-900,410, FILED 6-5-2006.

NAAKWAMA ANKRAH, EXAMINING ATTORNEY

The Copyright Law Firm, P.A.
111 Main Street
Anytown, NH 03301
(603) 555-5555

May 14, 2007

Library of Congress
Copyright Office
101 Independence Avenue SE
Washington, DC 20559-6000

Dear Sir or Madam:

Enclosed for filing please find the following:

1. Copyright application (form PA);

2. Check in the amount of $45 payable to Register of Copyrights; and,

3. One deposit in the form of a VHS tape of the video only of the movie sought to be registered (the sound track will be submitted separately under an SR (sound recording) form.

Thank you,

Aspiring Associate, Esq.

Encls.

cc: LKM Partnership

Form PA

For a Work of Performing Arts
UNITED STATES COPYRIGHT OFFICE

REGISTRATION NUMBER

PA PAU

EFFECTIVE DATE OF REGISTRATION

Month Day Year

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

TITLE OF THIS WORK ▼

Lawyerly Love

PREVIOUS OR ALTERNATIVE TITLES ▼

NATURE OF THIS WORK ▼ See instructions

motion picture

NOTE

Under the law, the "author" of a "work made for hire" is generally the employer, not the employee (see instructions). For any part of this work that was "made for hire" check "Yes" in the space provided, give the employer (or other person for whom the work was prepared) as "Author" of that part, and leave the space for dates of birth and death blank.

NAME OF AUTHOR ▼

Leonard Legal

DATES OF BIRTH AND DEATH
Year Born ▼ Year Died ▼
1960

Was this contribution to the work a "work made for hire"?
☐ Yes
☑ No

AUTHOR'S NATIONALITY OR DOMICILE
Name of Country
OR { Citizen of: U.S
Domiciled in:

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
If the answer to either of these questions is "Yes," see detailed instructions.
Anonymous? ☐ Yes ☑ No
Pseudonymous? ☐ Yes ☑ No

NATURE OF AUTHORSHIP Briefly describe nature of material created by this author in which copyright is claimed ▼
wrote book upon which movie was based

NAME OF AUTHOR ▼

Kimberly Kind

DATES OF BIRTH AND DEATH
Year Born ▼ Year Died ▼
1975

Was this contribution to the work a "work made for hire"?
☐ Yes
☑ No

AUTHOR'S NATIONALITY OR DOMICILE
Name of Country
OR { Citizen of: U.S
Domiciled in:

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
If the answer to either of these questions is "Yes," see detailed instructions.
Anonymous? ☐ Yes ☑ No
Pseudonymous? ☐ Yes ☑ No

NATURE OF AUTHORSHIP Briefly describe nature of material created by this author in which copyright is claimed ▼
as to screenplay

NAME OF AUTHOR ▼

DATES OF BIRTH AND DEATH
Year Born ▼ Year Died ▼

Was this contribution to the work a "work made for hire"?
☐ Yes
☐ No

AUTHOR'S NATIONALITY OR DOMICILE
Name of Country
OR { Citizen of:
Domiciled in:

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
If the answer to either of these questions is "Yes," see detailed instructions.
Anonymous? ☐ Yes ☐ No
Pseudonymous? ☐ Yes ☐ No

NATURE OF AUTHORSHIP Briefly describe nature of material created by this author in which copyright is claimed ▼

YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED
2006
Year
This information must be given in all cases.

DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK
Complete this information ONLY if this work has been published.
Month February Day 8 Year 2007
United States
Nation

COPYRIGHT CLAIMANT(S) Name and address must be given even if the claimant is the same as the author given in space 2 ▼

LKM Partnership
123 Main Street, Anytown, NH 03301

See instructions before completing this space

TRANSFER If the claimant(s) named here in space 4 is (are) different from the author(s) named in space 2, give a brief statement of how the claimant(s) obtained ownership of the copyright ▼

by assignment dated January 1, 2007

DO NOT WRITE HERE
OFFICE USE ONLY

APPLICATION RECEIVED

ONE DEPOSIT RECEIVED

TWO DEPOSITS RECEIVED

FUNDS RECEIVED

MORE ON BACK ▶ • Complete all applicable spaces (numbers 5-9) on the reverse side of this page
• See detailed instructions • Sign the form at line 8

DO NOT WRITE HERE

EXAMINED BY _____ FORM PA

CHECKED BY _____

CORRESPONDENCE
Yes

FOR COPYRIGHT OFFICE USE ONLY

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

PREVIOUS REGISTRATION Has registration for this work, or for an earlier version of this work, already been made in the Copyright Office?
Yes ☑ No If your answer is "Yes," why is another registration being sought? (Check appropriate box.) ▼ If your answer is "No," do not check box A, B, or C.

a. ☐ This is the first published edition of a work previously registered in unpublished form.
b. ☐ This is the first application submitted by this author as copyright claimant.
c. ☐ This is a changed version of the work, as shown by space 6 on this application.

If your answer is "Yes," give: **Previous Registration Number** ▼ **Year of Registration** ▼

DERIVATIVE WORK OR COMPILATION Complete both space 6a and 6b for a derivative work; complete only 6b for a compilation.
Preexisting Material Identify any preexisting work or works that this work is based on or incorporates. ▼

See instructions before completing this space.

Material Added to This Work Give a brief, general statement of the material that has been added to this work and in which copyright is claimed. ▼

DEPOSIT ACCOUNT If the registration fee is to be charged to a Deposit Account established in the Copyright Office, give name and number of Account.
Name ▼ **Account Number** ▼

CORRESPONDENCE Give name and address to which correspondence about this application should be sent. Name/Address/Apt/City/State/Zip ▼

Aspiring Associate, Esq.
The Copyright Law Firm, P.A.
111 Main Street, Anytown, NH 03301

Area code and daytime telephone number (603) 555-5555 Fax number (603) 555-5556

Email

CERTIFICATION* I, the undersigned, hereby certify that I am the

Check only one ▶
- ☐ author
- ☐ other copyright claimant
- ☐ owner of exclusive right(s)
- ☑ authorized agent of LKM Partnership

Name of author or other copyright claimant, or owner of exclusive right(s) ▲

of the work identified in this application and that the statements made by me in this application are correct to the best of my knowledge.

Typed or printed name and date ▼ If this application gives a date of publication in space 3, do not sign and submit it before that date.

Leonard Legal, Partner of LKM Partnership Date May 5, 2007

Handwritten signature (X) ▼

X _____

Certificate will be mailed in window envelope to this address:

Name ▼
Aspiring Associate, Esq., The Copyright Law Firm, P.A.

Number/Street/Apt ▼
111 Main Street

City/State/Zip ▼
Anytown, NH 03301

YOU MUST:
- Complete all necessary spaces
- Sign your application in space 8

SEND ALL 3 ELEMENTS IN THE SAME PACKAGE:
1. Application form
2. Nonrefundable filing fee in check or money order payable to *Register of Copyrights*
3. Deposit material

MAIL TO:
Library of Congress
Copyright Office
101 Independence Avenue SE
Washington, DC 20559-6000

*17 USC §506(e): Any person who knowingly makes a false representation of a material fact in the application for copyright registration provided for by section 409, or in any written statement filed in connection with the application, shall be fined not more than $2,500.