Exam Number _____

Federal Trademark Registration
Spring, 2008
FINAL EXAMINATION
May 5, 2008

- This is a **3 hour** exam.
- It is worth 50% of your grade.
- 100 points are assigned to this exam. Point distribution is as follows:

Question Number	Total Possible Points
1	6
2	10
3	25
4	7
5	7
6	7
7	7
8	25
9	6

- This is a closed book exam. However, attached is § 2 of the Lanham Act for your reference.
- Use your exam number on your blue book (or on Electronic Blue Book). Do not use your name anywhere. Please return your exam to the proctor upon leaving the examination. Write all answers in your blue book (or Electronic Blue Book).
- "PTO" = United States Patent and Trademark Office
- Good Luck!

Questions

1. Fill in the blank (in your blue book or electronic blue book): When I am making an electronic filing with the PTO, I know that the filing was submitted when a _____ screen pops up on my computer.

2. Your client is a teacher. She developed instruction materials that she would like to, essentially, franchise. She launched her "franchisee opportunity" and the related materials for the first time at a trade show on May 1, 2008. She even had some teachers "sign on" at the trade show. Someone at the trade show told her to see a lawyer or else any of these teachers could just steal her novel set of instructions for teaching "new math." So, it's May 5, 2008 and she has come to see YOU. What do you advise her to do?

3. Congratulations. You are a judge on the Trademark Trial and Appeal Board. A PTO examiner rejected the following mark based on Lanham Act § 2(d):



Under this mark, the Applicant, Empower Technologies, Inc., produces software and hardware ("Digital Appliances") and embeds its own Linux-based operating system in the Digital Appliances. The Applicant disclaimed "EMBEDDED" in its Application. The PTO examiner cited Registration Number 1916230, for the mark LINUX for "computer operating system software," owned by Linus Torvalds, and licensed through the Linux Mark Institute. The evidence of record consists of (1) Applicant's specimen, which says this on the packaging:

> *© 2003 Empower Technologies, Inc. All rights reserved. PowerPlay and LinuxDA are trademarks of Empower Technologies, Inc.*

The registered trademark Linux® is used pursuant to a license from Linux Mark Institute, authorized licensor of Linus Torvalds, owner of Linux trademark on a worldwide basis.

and (2) Google search results for "linux software," without any web pages, but showing many hits from many sources. In its TTAB appeal brief, the Applicant attached a copy of the license agreement with the Linux Mark Institute, signed 2 years prior to the application filing date, and stated it constituted consent to register.

Please write out a miniature version of your TTAB opinion, including how you would address the evidence, whether the license constitutes consent, whether consent is required, and, finally, whether you would affirm the examining attorney's 2(d) rejection.

4. What did the applicant's attorney in question 3 do right? wrong?

5. A client came to you to register her mark ("Client's Mark"), you recommended that a trademark search be conducted, and ran a search of the PTO database, two Internet search engines, domain names, state trademark registrations, and a nationwide telephone directory. Your search of the PTO and state trademark registrations was clear, but you found a close mark with related goods in use in Idaho ("Idaho Mark") through the Internet and domain name search. You followed up this search by checking the Idaho Secretary of State's Office and found that the Idaho Mark owner's business is not registered there. Your likelihood of confusion analysis, given the information you have (the Idaho Mark is on a web site that has a static home page with all the other pages (including ordering) being "under construction"), however, is that, while it is a close call, a reasonable person could conclude there is no likelihood of confusion. What is your advice to your client? How do you frame it in your report and/or opinion letter? Will you write an opinion letter? Why or why not?

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6. A registration just issued for your client's mark:

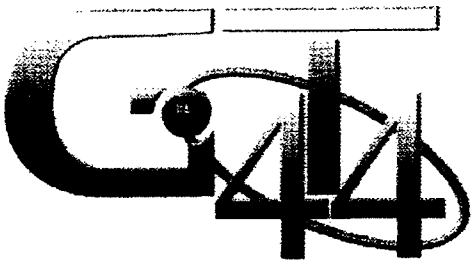
Int. Cl.: 45

Prior U.S. Cls.: 100 and 101

Reg. No. 3,417,182

United States Patent and Trademark Office **Registered Apr. 29, 2008**

SERVICE MARK
PRINCIPAL REGISTER



BACKLAND OUTDOORS, LLC (MINNESOTA LTD LIAB CO)
17128 240TH STREET
HUTCHINSON, MN 55350

FOR: LICENSING OF COPYRIGHTED AND TRADEMARKED CAMOUFLAGE PATTERNS FOR USE BY OTHERS IN THE MANUFACTURE OF HUNTING PRODUCTS, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 1-12-1006; IN COMMERCE 1-12-2006.

THE MARK CONSISTS OF GT-44 AND DESIGN.

SER. NO. 77-181,466, FILED 5-15-2007.

CAROLYN CATALDO, EXAMINING ATTORNEY

You agreed to maintain the mark. What dates do you put into your calendaring system to make sure no deadlines are missed? Identify the filings, their purpose, and what they entail.

7. What is the Madrid Protocol good for?

8. On behalf of your client, you applied to register the mark GREENSHOPPER.COM (standard character) under Lanham Act Section 1A and disclaimed "GREENSHOPHER." It is for a web site that directs shoppers to "green" (environmentally friendly) sellers.

When you receive your first office action, you find out (because it is cited as a rejection basis) that an ITU is filed for "GREENSHOPPER" (standard character). What will happen? What is your strategy (or are our plan A, plan B, etc. strategies) to obtain a registration for your client?

9. What is the difference between a petition to the director and an appeal to the Trademark Trial and Appeal Board? Can you give examples of each?

by striking, "and the mode or manner in which the mark is used on or in connection with such goods or services" as the probable intent of Congress.

§ 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 would be likely to cause dilution by blurring or dilution by tarnishment 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 would be likely to cause dilution by blurring or dilution by tarnishment 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.