

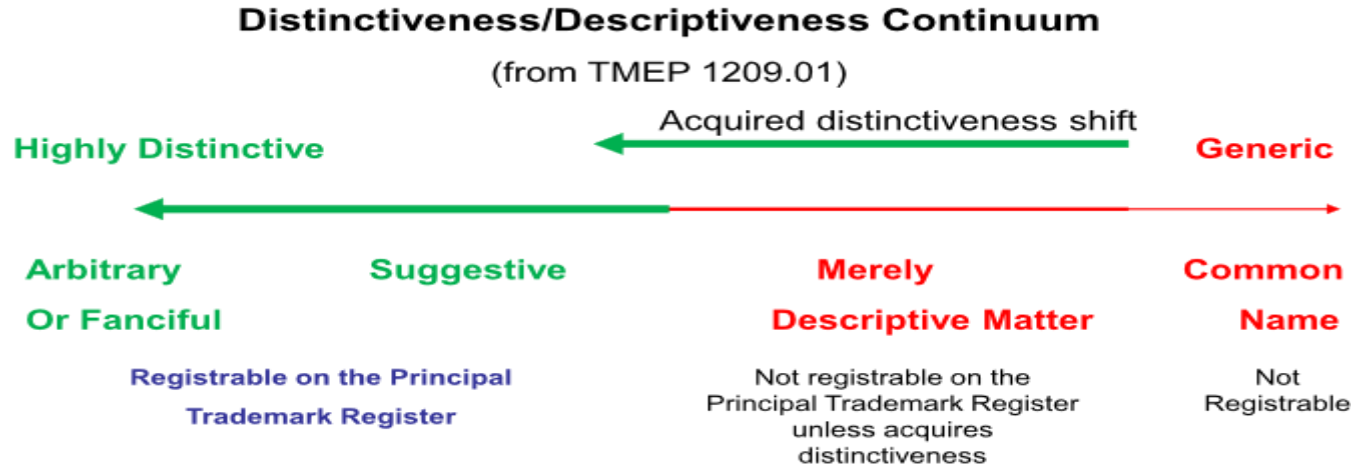
Proving Secondary Meaning at the USPTO

Judge Lorelei Ritchie

EUIPO/IPCLC

May 5, 2016

Descriptiveness/Distinctiveness Continuum



Is it merely descriptive?

- View mark together with goods/services.
 - Not out of context.
- Does it immediately convey idea of characteristic, function, feature, purpose, or use?
- Any imagination needed?
- Incongruous?

Acquired Distinctiveness: How?

- Statute: 5 years substantially exclusive use “may” be acceptable.
- Prior registrations.
- Sales and advertising.
 - Industry context.
- Declarations (not attorney argument).
- Probative survey.
- Prove it (how descriptive?).

Other Issues

- Same mark.
- Third party use (substantially exclusive).
- ITU (2f on prior reg and use on related g/s).
- Section 44 and 66(a) based on use in commerce (U.S. use).
- **Tip: Claim 2(f) in alternative, or descriptiveness is conceded.**