

## Trademark Law Alert--The Letter of Protest Can Be a Cost-Effective Tool

04.05.2022 By [Allison R. Furnari](#) and [Justin I. Karasick](#)



### General Information

The United States Patent and Trademark Office (“USPTO”) employs a multi-layered system for ensuring the integrity of the trademark register and preventing the registration of marks which are confusingly similar to marks already on the register. The Letter of Protest can be one effective way to stop an objectionable trademark application from being approved.

The first layer of protection for the register is **Examination**: USPTO Examining Attorneys review newly-filed trademark applications, search the USPTO database for confusingly similar marks, and may conduct some Internet research to evaluate descriptiveness or other considerations.

If an application passes the Examination phase, then the next layer of protection is an **Opposition**, wherein third parties can object to registration of a mark on various bases, including that the mark is confusingly similar to a prior registered or unregistered mark to which the Opposer has rights.

But there is also an intermediate procedure which allows a third-party to bring evidence to the Examining Attorney’s attention at the examination phase, and hopefully avoid the need for a potentially time-consuming and expensive opposition. This is the **Letter of Protest**.

### Letter of Protest Filing and Examination Procedure

A Letter of Protest can generally be filed against a pending trademark application at any time between when the application is filed and on or before 30 days after the date the application is

published for opposition in the USPTO *Official Gazette*. However, a Letter of Protest filed after publication does not stay or extend the opposition period. It is therefore advisable, if possible, to file a Letter of Protest before an application publishes for opposition.

The procedure allows for the Protestor to submit specific objective evidence which sets forth a reason why the USPTO Examining Attorney should refuse registration of the pending application. Appropriate subjects include:

- the term sought to be registered is generic or merely descriptive;
- the term is likely to be confused with a mark in another existing registration or pending application;
- the mark is the subject of a pending infringement litigation;
- the application inappropriately uses another party's name in the identification of goods or services;
- the specimens of use are deficient; or
- a subsequently filed pending application has a proper basis for international priority.

The Letter of Protest, and accompanying evidence, is first reviewed at the Office of the USPTO Deputy Commissioner for Trademark Examination Policy. Because Letters of Protest are meant to convey specific objective evidence to the Examining Attorney, legal arguments as to why an application should be refused are highly disfavored and may lead to the Deputy Commissioner to deny the Letter of Protest and refuse to transmit the evidence to the Examining Attorney.

If the Letter is found to meet the formal requirements and contain relevant evidence, then the evidence submitted with the Letter (but not the Letter itself) is forwarded to the Examining Attorney, and is made publicly available in the official application record. The Examining Attorney is required to consider that evidence when examining the application, but it is at the discretion of the Examining Attorney whether to actually issue a refusal or other Office Action based on this evidence.

### **Changes Under Trademark Modernization Act**

The USPTO has long considered Letters of Protest under an informal procedure, but this procedure has recently been formalized and modified as part of the Trademark Modernization Act, as codified in Trademark Rule 2.149, [37 CFR § 2.149](#), effective December 27, 2021.

The new procedure continued a \$50 filing fee for each application being protested, and gives the USPTO Deputy Commissioner's Office a two-month period to review Letter of Protest filings and decide whether to forward the evidence to the Examining Attorney.

If the Deputy Commissioner's Office refuses to transmit the Letter of Protest to the Examining Attorney, then this decision is final and non-reviewable. However, if the application has not yet been published for opposition then the Protestor can file another Letter of Protest which addresses any defects noted by the Deputy Commissioner's Office in denying the originally submitted letter.

For completeness, we note that the Trademark Modernization Act also introduced new procedures for objecting to a registration even after it has been issued. See our article "[Regulations Implement the Trademark Modernization Act of 2020.](#)"

## Benefits of Filing a Letter of Protest

There are many advantages to filing a Letter of Protest including the low cost, the avoidance of having to file an opposition, the lack of a requirement for standing, and no issue preclusion.

### a. Low Cost

The \$50 fee per protested application is significantly less costly than having to file a Notice of Opposition, which involves a \$600 filing fee per International Class.

### b. Avoidance of Filing Opposition

A major benefit of a Letter of Protest is that the USPTO can refuse to register a mark before the application even gets to the opposition stage. This can result in the same outcome as a successful opposition proceeding, but at a much lower cost and at an earlier stage in the trademark application process.

Further, a Letter of Protest keeps the Protestor's identity hidden. It alerts the Examiner to a potential likelihood of confusion issue without the Protestor having to file a Notice of Opposition, which could generate press interest or label the Protestor as contentious or a "trademark bully." A Letter of Protest can therefore be a way to get an infringing or problematic mark denied while flying under the radar.

### c. No Standing Required

Unlike filing a Notice of Opposition, the Protestor does not need to have a reasonable basis to believe that it would suffer some kind of damage if the mark were registered in order to file a Letter of Protest.

### d. No Preclusion

Filing a Letter of Protest is not a substitute to filing an opposition and it does not preclude subsequent filing of an opposition. Further, filing a Letter of Protest does not stay or extend the time for filing a Notice of Opposition. Instead, it can be used as a strategic enforcement tool to get a first attempt at preventing a mark from registering.

## Potential Risks of Filing a Letter of Protest

There are a few potential risks involved with filing a Letter of Protest. First, the Protestor may lose out on the \$50 filing fee. Second, if the Letter of Protest doesn't lead to the Examining Attorney issuing a refusal, the applicant can assert this as an indication that the Trademark Office did not consider the respective marks to be similar.

### a. Indication that Marks Not Considered Similar

When a Letter of Protest is filed, the public cannot see who filed it or what the content of the Letter of Protest was. The public can, however, see if the Examiner deemed the marks to be similar or not by viewing the publicly accessible USPTO TSDR database. If the Letter of Protest is acted on by the Examining Attorney, then the database will show the entry of evidence

submitted with the Letter of Protest and a memorandum attaching all relevant evidence and identifying the grounds for refusal and/or requirements to which the evidence relates.

But if the Examining Attorney decides against issuing the refusal or requirement, the database will include a notation indicating “LETTER OF PROTEST EVIDENCE REVIEWED – NO FURTHER ACTION TAKEN.” The applicant may try to use this as evidence that the marks are not similar, should Protestor bring an opposition or other enforcement measure. Although this evidence is not binding on the Trademark Trial and Appeal Board or any court, the potential persuasive effects cannot be discounted.

#### **b. Filing Fee**

The Deputy Commissioner may determine that the Letter of Protest does not comply with the requirements of Trademark Rule 2.149, such that the evidence submitted should not be included in the application record. Even if the Deputy Commissioner does include the evidence in the application record, the Examining Attorney is not required to issue a refusal. If either occurs, the Protestor will have paid the filing fee without reaping any benefits.

### **Conclusion**

Letters of Protest can be a great tool that trademark owners use to enforce their marks. However, given that there is a limited timeframe of acceptance and specific requirements as to formalities and evidence that can be presented, you should understand all of the rules and implications involved with a Letter of Protest prior to filing.

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