

Intellectual Property Group Prevails in Trademark Dispute Before the U.S. Patent and Trademark Office

October 20, 2010

On October 20, 2010, attorneys from the firm's Intellectual Property Group prevailed on behalf of one of the firm's clients in a trademark dispute before the U.S. Trademark Office. Our work resulted in the termination of an opposing party's trademark application for a mark that infringed on the client's previously registered mark.

The case involved a dispute over a trademark application filed with the Trademark Office for the mark "ETF Trend Trading." The application was filed by DMET, LLC, a California based financial advisory firm that sells investment training materials on exchange traded funds. The trademark examiner approved the mark for registration on the supplemental register despite the fact the mark appeared confusingly similar to several previously registered marks, including "ETF Trends," a mark owned by one of the firm's clients. The client sought initially to persuade the company to cease all uses of the "ETF Trend Trading" mark in commerce because it infringed on the "ETF Trends" mark. The client also requested the company to withdraw its trademark application because of the strong likelihood the examiner would ultimately find the mark confusingly similar to the previously registered "ETF Trends" mark. The applicant refused both requests. The client asked us to intervene to prevent the Trademark Office from registering the mark on either the principal or supplemental registers.

The firm's attorneys quickly reviewed the application and supporting materials, and evaluated the examiner's analysis to determine if a legal basis existed to challenge the initial decision to approve the application. We discovered the examiner failed to identify several previously registered marks with which the "ETF Trend Trading" mark was confusingly similar. Typically, to challenge an examiner's decision a person must file an opposition or cancellation proceeding before the Trademark Trial and Appeal Board. Such a filing, in effect, commences a law suit before an administrative law judge.

The procedure is lengthy, expensive and unpredictable, and if you fail to accomplish your client's goals in that forum the only option is to file suit in federal court in Washington, D.C. to enjoin the Office's action. In this instance, instead of commencing expensive litigation, the firm's attorneys prepared and filed a letter of protest with the Deputy Commissioner for Trademark Examination Policy. The filing began an internal review of the application that allowed the client to bring to the Trademark Office's attention evidence bearing on the registrability of the mark without commencing litigation.

Before the Trademark Office, the firm's attorneys put forth several arguments as to why the "ETF Trend Trading" mark was confusingly similar to the "ETF Trends" mark.

- First, the goods offered under "ETF Trend Trading" are so closely related to the services offered under "ETF Trends" that there is a strong likelihood the public will be confused about whether the good and services come from the same source.
- Second, to the average consumer, the two marks appear the same, sound the same, share virtually identical meanings, and create the same overall commercial impression when viewed in their entirety on the respective goods and services to which they are affixed in the market place.
- Third, the trade channels used to market and sell the goods and services under the two marks – which include the Internet and television – are long standing, on-going and virtually identical. This increases the likelihood consumers will become confused about the source of the goods and services sold under the two marks.

- Fourth, the conditions under which sales are made, and the buyers to whom sales are directed, are virtually identical under both marks. Navigating from website to website takes little effort on the Internet, and frequently is as easy as clicking on a link from a search engine. The strong similarity of the two domain names make it is easy for even a sophisticated investor seeking information from “ETF Trends” to find her way to “ETF Trend Trading.” Amateur and novice investors are almost certain to become confused by the two marks, and the goods and services offered under each.
- Fifth, no valid consent agreement exists between the owner of the registered “ETF Trends” mark and the infringing “ETF Trend Trading” mark, which would allow the latter mark to be used for limited purposes.

The Deputy Commissioner agreed with our attorney’s arguments and granted the letter of protest. In doing so, she instructed the examiner to review her initial decision in light of the factual and legal arguments put forward by our protest letter. On April 20, 2010, as a result of our attorneys’ efforts, the examiner issued a new office action refusing to register the application on the grounds the proposed mark is confusingly similar to the “ETF Trends” mark. On October 20, 2010, the time to file a response to the Office’s refusal expired, and the application, for all intents and purposes, terminated. We accomplished our client’s objective of preventing registration of the mark.

To protect the trademarks your company uses to market and sell its goods and services nationwide, keep three things in mind: (1) secure federal trademark rights by registering your mark with the U.S. Trademark Office; (2) regularly police the uses of your mark – and similar marks – through all media, particularly the Internet; and (3) if you find a third party infringing on your mark, request in writing that they stop the infringing behaviour. If they do not comply with your request, contact our offices for assistance.

When your company needs insightful, effective, conscientious, and affordable legal counsel in the area of intellectual property law, please contact our offices to discuss your matter. You can reach us at (925) 274-9600 or info@finkellawgroup.com.

To learn more about the [Intellectual Property Law Group](#) please click here.