

How to Expedite Your U.S. Trademark Application with a Petition to Make Special

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by Elizabeth C. Buckingham



Are you a trademark owner with an infringer to sue but you do not have U.S. registration? Do you need a U.S. registration to record with U.S. Customs to have counterfeit shipments seized? If so, you may be able to go to the head of the application line. While the U.S. Patent and Trademark Office (USPTO) typically reviews applications in the order in which they are received, applicants can circumvent the normal process and receive expedited review of their applications by filing a Petition to Make Special (petition).

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

Why File a Petition

The reason to file a petition is to expedite the application process. Given current processing rates, it takes roughly three and a half months from the time of filing an application to when that application is either approved for publication or an office action is issued. According to the Office of the Deputy Commissioner for Examination Policy, the petition will be reviewed by the Deputy Commissioner's Office within several weeks of its filing. If granted, the underlying application will then be examined within a few weeks. Once examined, however, the application goes back in the normal processing queue and receives no faster publication or post-publication approval for registration. By filing a petition, you can save roughly two and a half months in the examination process.

When to File a Petition

According to Section 1710.01 of the *Trademark Manual of Examining Procedure*, because a petition is an "extraordinary remedy," an applicant must demonstrate very special circumstances that typically involve the potential loss of substantive trademark rights. TMEP § 1710.01 (Oct. 2018). The most commonly granted petitions involve (1)

actual or threatened infringement; (2) pending litigation; or (3) the need for registration for securing foreign registration. *Id.* According to the Deputy Commissioner's Office, other common circumstances include (1) the need to record a trademark registration with U.S. Customs to stop counterfeiting; (2) the need to file a UDRP (Uniform Domain-Name Dispute-Resolution Policy) to stop cybersquatting; and (3) the need to take down infringing online content or an infringing mobile app.

Example of a Successful Petition

A successful petition was filed by Olukai, LLC regarding its trade dress application for registration of a heelstay design in its footwear. *Petition to Make Special*, U.S. Trademark Application Serial No. 85/862,083 (filed Feb. 27, 2013). Olukai submitted a short petition alleging that five companies were infringing on its proprietary design and included exhibits of each alleged infringement and its design. *Id.* The Deputy Commissioner's Office granted this petition and expedited review of the application. *Petition to Director Granted*, U.S. Trademark Application Serial No. 85862083.

When Not to File a Petition

A petition will be denied if the alleged extraordinary circumstances could be claimed by many applicants. *Trademark Manual of Examining Procedure* Section 1710.01 identifies an applicant embarking on an advertising campaign as an insufficient basis for a petition. The Deputy Commissioner's Office noted that other circumstances commonly denied include a short-term advertising campaign, a new product launch, and a desire to include a mark in the Amazon Brand Registry.

Example of an Unsuccessful Petition

As an example of a rejected basis for a petition, negative publicity that results from applying to register a mark is insufficient justification for expediting review. *Petition Decision*, U.S. Trademark Application Serial No. 85/578,962 (filed Mar. 23, 2012). In that application, Marcus Singletary requested registration of the JUSTICE FOR TRAYVON mark after police officers shot Trayvon Martin. U.S. Trademark Application Serial No. 85578962. Mr. Singletary submitted a petition after news outlets accused him of attempting to profit from Trayvon Martin's death by registering the mark for use on hooded sweatshirts he planned to sell. *See id.*; *Petition to Make Special*, U.S. Trademark Application Serial No. 85578962. The Deputy Commissioner's Office disagreed with Mr. Singletary's assertion that proving his right to register the mark to combat negative publicity could support "advancement of an application out of the normal order of examination" and denied his petition. *See Petition Decision*, U.S. Trademark Application Serial No. 85578962.

How to File a Petition

After filing the underlying trademark application, the related petition should be submitted to the Office of the Deputy Commissioner for Trademark Examination Policy containing (1) the serial number for the application; (2) "an explanation of why special action is

requested”; (3) “a statement of facts that shows that special action is justified”; and (4) a declaration made under 37 C.F.R. Section 2.20, acknowledging that false statements may affect the validity of the petition and that all statements from personal knowledge and believed to be true should accompany the statement of facts. TMEP § 1710. While these requirements may sound like a lengthy filing is required, as a practical matter, the Deputy Commissioner’s Office indicates that a filing need only consist of an introduction and three to five paragraphs of facts accompanied by the declaration.

Finally, the petition must come with the appropriate fee as designated under 37 C.F.R. Section 2.6. TMEP § 1710. The fee is US\$ 100 per application if filed electronically and US\$ 200 per application if filed by facsimile or on paper.

Tips for Filing a Petition

- To maximize the benefits of expedited processing, an applicant should submit both its underlying application and its petition electronically via the Trademark Electronic Application System (TEAS).
- As a further means of expediting processing, an applicant should file its petition immediately after receiving its serial number. While Trademark Rule of Practice Section 2.146(d)(1) gives applicants two months from filing to submit a petition, delaying the filing only reduces the benefits to be had from its filing.
- To minimize the costs of expedited processing, an applicant should file a multiclass application rather than submit separate single class applications. This will save on filing fees for the petition and the attorney fees for preparing multiple petitions.
- If it would streamline the filing, an applicant should submit supporting exhibits as part of the petition. These can be useful when trying to show that the petition falls into a commonly granted category like actual or threatened infringement. However, because petitions are publicly accessible, applicants should avoid including confidential or proprietary information in their filings.

Tips on What to Avoid When Filing a Petition

- Make sure to file the right document. The petition’s full name, the “Petition to Make Special,” is similar to the name of another filing, the “Request to Make Similar” (request).
- In the course of making the filing, there is a box that asks if the filer would like to bypass the declaration. Do not check this box! Doing so will result in the automatic denial of the petition.

By understanding their benefits and limitations, trademark practitioners can make effective and efficient use of Petitions to Make Special to obtain expedited review of trademark applications.

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