



# BNA's Patent, Trademark & Copyright Journal®

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## TRADEMARKS

### PTO Roundtable Weighs Future of Trademark Disclaimer Practice

By TONI Y. HICKEY

Pursuant to a notice posted on the Patent and Trademark Office's official website, the PTO hosted a roundtable June 21, titled: "A Dialogue About Trademark Disclaimer Practice." Director David J. Kappos introduced the subject by inviting seven panelists to comment on whether the current disclaimer practice should be maintained in its current form, limited, or eliminated entirely.

According to the Trademark Manual of Examination Procedure § 1213(a), the director "may require" an applicant to disclaim an unregistrable component of a mark if the mark is otherwise registrable. Thus, under current practice a disclaimer statement permits registration of a mark that is registrable as a whole, but contains descriptive, generic, or informational components that would not be registrable standing alone. Approximately 29 percent of office actions issued by the PTO contain a disclaimer requirement.

While the roundtable panelists did not universally agree that the office should maintain the status quo, they did agree that a consistently applied, coherent, and

predictable disclaimer practice would be useful and effective in helping to clarify the rights, or the extent of rights, that trademark owners have in their marks. A disclaimer statement may be particularly useful during the search and clearance stage because disclaimers help to define the scope of the matter protected, the relative strength of individual elements appearing in the mark, and the availability to use components of the mark in commerce.

In addressing whether the disclaimer practice should be limited in scope, for example, to no longer require disclaimers for purely generic matter like entity designations, some roundtable participants favored limiting the disclaimer requirement to abandon the current requirement at TMEP § 1213.03(d), that applicants disclaim trade names that designate the legal character of an entity, e.g. Corporation, Corp., Co., Inc., Ltd., etc. Most panelists, however, expressed strong reservations against a proposal to eliminate the "unitary mark" exception.

#### Unitary Mark Exception.

The unitary mark exception, which permits registration of unregistrable matter without a disclaimer where the matter is so merged together, or taken together that it cannot be divided, is often asserted in response to a trademark examining attorney's disclaimer requirement. Asserting that the mark falls into the unitary mark exception because it is a telescoped word, hyphenated term, slogan, double entendre, incongruous,

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or otherwise non-severable, often helps trademark holders overcome a disclaimer requirement. While the office did not provide any statistical evidence to support this assertion, one panelist opined that roughly 50 percent of disclaimer refusals may be overcome by asserting this exception.

The complete elimination of the disclaimer requirement was addressed. The roundtable participants considered whether the United States should follow the widespread practice of intellectual property offices around the world, including Australia, Canada, and the United Kingdom, by eliminating the disclaimer requirement and instead implementing a voluntary system. The PTO's Trademark Public Advisory Committee studied this question and found that the elimination of the disclaimer practice in other countries created an efficient, timely and less expensive examination process.

However, the absence of a disclaimer practice would cause uncertainty about the relative strength of certain components in a mark, thereby creating challenges during the search and clearance stage and in weighing potential likelihood of confusion conflicts. The TPAC representative noted that there appears to be strong sup-

port to have the disclaimer practice reintroduced in Australia and this should be taken into consideration before the PTO elects to propose changes to the current approach.

### **Abandonment Unlikely.**

It appears unlikely that the PTO's disclaimer practice will be wholly abandoned, so brand owners should remain diligent in keeping their trademark registrations up to date. Previously disclaimed matter, notwithstanding generic designations, is not forever barred from registration. If previously disclaimed matter has acquired distinctiveness, brand owners should consider seeking registration of the matter on the Principal Register.

Trademark owners should be on the lookout for further guidance from the PTO on the nuances of disclaimers, including information related to disclaimers involving pictorial representations.

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*A webcast of the roundtable and other information is at [http://www.uspto.gov/trademarks/notices/initiatives\\_events.jsp](http://www.uspto.gov/trademarks/notices/initiatives_events.jsp)*