

USPTO TRADEMARK “CONSISTENCY INITIATIVE” SHOULD SOON BE COMPLETED

By: Alex Butterman

The U.S. Patent and Trademark Office (USPTO) announced a one-year pilot program on September 29, 2008 called the “Consistency Initiative,” which is a centralized, informal process by which an Applicant “may bring to the attention of the Trademark Office situations where, in applicant’s opinion, the Office has acted inconsistently in its treatment of applicant’s pending applications/recent registration(s).” The program specifically targets substantive and more significant procedural issues, excluding identifications of goods and services issues.

The process begins by an applicant or its legal representative submitting an e-mail to tmconsistency@uspto.gov requesting a “Consistency Review” by a small committee of the Trademark Examination Corps for allegedly inconsistently handled pending application(s) and/or recently issued registration(s). Applicants are expected to discuss the issues with the assigned examining attorney first. Requests from third parties to the application are not accepted. The request can only be based on “co-pending” -- owned by the same legal entity or a successor in interest -- applications or registrations; a registration cannot be more than one year old; at least one of the applications in the request must be in a pre-publication status at the time of the request; and the allegedly inconsistent treatment must have already occurred. If the USPTO determines that further action is warranted, the USPTO will usually act within about 4-6 weeks. The USPTO will not notify the applicant that changes were made but the applicant can check the application status on the available USPTO web site databases. The requested review must involve a pending unpublished application. Any modifications to examination outcomes can occur only in the pending, unpublished application because the USPTO will not reverse or act against a registered mark. A published application is generally beyond the jurisdiction of an examiner.

The “consistency initiative” was designed to respond to frequent criticisms about the lack of consistency of application examination at the trademark office by gauging the nature and quantity of examination inconsistencies. Initial reports on the program indicate relatively limited use by the public. No reports on the outcome of the program have issued to date. We expect to receive a report on the program results by the next S&H E-Newsletter.