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Do Trademark Lawyers Matter?

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INTRODUCTION

Trademarks are the symbols that embody the story of an organization. If an entrepreneur wants to create a distinct impression in launching a business, school or non-profit, federal trademark protection helps to achieve that objective by securing the right to claim national exclusivity to use the mark within the owner's business sector.[1] Like many administrative tasks, trademark registration may be accomplished without legal counsel. When resources are limited, does it make sense to hire a lawyer for federal trademark prosecution? To begin answering this question, this Article empirically analyzes whether trademark applicants benefit from having an attorney assist in the registration process. Our analysis proceeds in four sections. Part I sets the stage for our study by describing the trademark registration process.

In Part II, we explain our methodology and the data we used. In 2012, the United States Patent and Trademark Office ("USPTO") released a wealth of information about trademark applications filed since 1870.[2] Despite the size and practical significance of this dataset, relatively little attention has been devoted to it by the scholarly community.[3] This Article is the first to examine the extent to which it matters to have a lawyer in prosecuting a trademark application.

In Part III, we set forth empirical findings on how much it matters to have counsel at various stages in the trademark registration process. First, we report baseline values for overall publication and registration rates. We then examine how these rates differ depending on the basis for the application and whether the process was handled by an attorney. We hypothesize that attorney filings generally will have higher publication and

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[1] 15 U.S.C. § 1057(b).

[2] Stuart Graham, Galen Hancock, Alan Marco, Amanda Fila Myers, The USPTO Trademark Case Files Dataset: Descriptions, Lessons and Insights (2013)(available at http://ssrn.com/abstract=2188621).

[3] Notable exceptions include Barton Beebe, *Is the Trademark Office a Rubber Stamp?* 48 HOUSTON L. REV. 751 (2011) and Graham *supra* note 2.

registration rates than non-attorney filings, but that the difference may vary among types of applications.

We then analyze whether, during the life of a trademark application, an attorney increases the likelihood that the application will proceed to the next stage. We expected to see that the presence of a lawyer would matter more when the applicant faced an obstacle in the application process. For example, if a trademark examiner perceives a defect in the application, it may issue an office action that creates a barrier to registration unless the applicant responds effectively enough to overcome the objection. Many office actions can be easily resolved with minor corrections to the application. We test the extent to which the presence of legal counsel matters in overcoming this obstacle as well as objections asserted by third parties who may claim to have prior superior rights in the mark or other reasons for objecting to its registration.

We expected to find that trademark lawyers would succeed at registering marks more frequently than those without a law degree. Assuming our instincts were correct (as they were), we were particularly interested to learn whether this higher registration rate was a function of holding a law degree or having experience with the federal trademark application process. To explore this question, this Article also examines whether experience prosecuting trademark applications matters as much—or more—than having a law degree. Our hypothesis is that both a law degree and experience matter, and that the combination of both has the highest likelihood that a trademark application will mature to registration.

In the final section of Part III, we look at how publication and registration rates have changed over time. One of the issues we examine is whether the registration process became friendlier to pro se applicants once the USPTO began accepting online trademark applications in 1998. In addition to this more accessible filing option, the USPTO provided resources explaining the registration process that were available to anyone with an internet connection. The data are analyzed to determine the extent to which having counsel affected publication and registration rates once the easier filing format and electronic FAQs were made publicly available. Part IV summarizes our conclusions.

I. TRADEMARKS AND THE FEDERAL REGISTRATION PROCESS

A trademark is a symbol that represents the reputation of a person (or organization) who provides goods or services. It reflects the story of an enterprise. If it becomes distinctive and meaningful, a brand can be the asset the drives the success or failure of any organization. Local use is often not enough for a brand to become meaningful. Only national or international recognition can propel a brand into the kind of shared symbol that has narrative and economic value. The symbol itself means nothing until consumers invest it with specific meaning.[4] This phenomenon may be seen in the difference

[4] Deborah Gerhardt, *Consumer Investment In Trademarks*, 88 N.C.L. Rev 427, 500 (2010).

between the meaning of the names "Ray's" and "Wendy's." Only "Wendy's" prompts widely shared thoughts of a specific menu, price point, restaurant décor, and character because its brand managers created a distinctive national presence. Hearing "Wendy's" evokes visual images of the name in thick primary red letters and the happy cartoon of Dave Thomas's daughter.[5] None of these specific meanings are as accessible for "Ray's" due to a more relaxed (or nonexistent) brand strategy that permitted use of the name for many different restaurants. A first step in creating a strong recognizable brand like "Wendy's" is federal registration, as it creates a presumption of the "owner's exclusive right to use the registered mark in commerce on or in connection with the good or services specified in the certificate."[6]

A trademark may be registered in a particular state or nationally through the United States Patent and Trademark Office ("USPTO"). Federal registration provides many potential advantages. At common law, trademarks arose from the businesses to which they were connected, and the right to exclude others from using the mark was limited by both market sector and geography.[7] Limiting exclusive use to a business sector permitted symbols to be used in multiple situations if they were different enough that consumers would not be confused that one was associated with another. A symbol, such as the name "YALE," could be advertised by one company for locks and by another for higher education.[8] Alternatively, a symbol could be used in a particular place, while someone else could use it in another town without confusion. The Saffron restaurant in Apex, North Carolina, is not likely to be confused with restaurants of the same name in Beachwood, Ohio, Las Vegas, Nevada, Westmont, Illinois or Jupiter, Florida. Of course, if all these restaurants share the name, none can ever use it to make the same kind of distinct commercial impression as a nationally famous restaurant brand with a unique name like Nobu or Applebee's.

Federal trademark registration provides important advantages to brand owners who want to create a unique national impression with their marks. One of the primary advantages of federal registration is that it provides a business with the opportunity to secure exclusive rights nationally in a particular market sector.[9] Even if a brand owner is not using a brand in every state, federal registration creates the opportunity to require later adopters to choose another name.[10] The registration certificate also constitutes

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[5] http://en.wikipedia.org/wiki/Wendy's.

[6] 15 U.S.C. § 1057(b).

[7] United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918).

[8] "Yale" has been used since 1875, was registered by Yale & Towne Mfg. Co. in Stamford, Connecticut, and has appeared on the principal register since 1909, and remains registered in the name of its current owner, Yale Security Inc. of Monroe, North Carolina. http://tess2.uspto.gov/bin/showfield?f=doc&state=4001:l6t9td.2.173.
Yale University began using its mark in 1718, but did not register the name for educational services until 1983. http://tess2.uspto.gov/bin/showfield?f=doc&state=4001:l6t9td.2.131

[9] *Id.*

[10] Dawn Donut v. Hart's Food, 267 F.2d 358 (2nd Cir. 1959).

prima facie evidence that the mark is valid and owned by the applicant.[11] Marks that were submitted for registration—whether they succeeded or not—may by searched using the Trademark Electronic Search System ("TESS").[12] A new organization searching for a new distinctive brand may eliminate words that have already been registered by other similar organizations. In this way, a mark's appearance on the Principal Register provides important deterrent value.

The USPTO maintains two trademark registries: the Principal Register and the Supplemental Register. The Principal Register confers many statutory benefits, including all of those identified above.[13] A mark that fails to qualify for the Principal Register may be placed on the Supplemental Register until it acquires the qualities of a distinctive mark. For example, a mark—such as Triangle Yoga for a yoga studio in the North Carolina's Research Triangle area—will likely be challenged as merely descriptive because other studios in the same region may use the words "yoga" and "triangle" to describe their services and location. If so, it may be placed on the Supplemental Register.[14] If the mark acquires distinctiveness so that consumers identify the words "Triangle Yoga" with a particular yoga studio, the applicant may reapply for acceptance on the Principal Register.[15]

Supplemental registration does confer some additional benefits. It allows the mark owner to use the symbol "®" on its brand to notify the world that it is registered with the USPTO. This notice, as well as the appearance of being a live mark in TESS, provides some deterrent value. Nevertheless, supplemental registration does not confer the exclusive right to nationwide use of the mark, and in fact, may be viewed as evidence that the PTO does not view the mark as sufficiently distinctive to merit protection as a mark. Third parties may view supplemental registration as evidence the mark is available since the right to exclusive use was denied. Accordingly, supplemental registration is not the goal of the application process. It is at best a consolation prize, and at worst, evidence that the symbol is not yet valid as a mark. Because of the many benefits associated with the Principal Register, we equate registration for purposes of this Article with publication on the Principal Register.

Obtaining a federal registration is not difficult or particularly expensive. The USPTO has created the Trademark Electronic Application System with considerable content such as FAQ's and trademark information videos. For each class of services, the 2012 registration fee is either $275 or $325, depending on which form is used.[16] The application requests information such as the owner of the proposed mark, identification of the goods or services the applicant uses (or plans to use) in connection with the mark,

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[11] 15 U.S.C. § 1057(b).
[12] *Id*.
[13] 15 U.S.C. § 1094.
[14] 15 U.S.C. § 1091.
[15] 15 U.S.C. § 1095.
[16] http://www.uspto.gov/trademarks/teas/teas_faq.jsp#TEASrefund.

and the date on which the mark was first used in interstate commerce.[17] A specimen illustrating the mark as used must also be attached. For those who have this information at hand, the USPTO's online federal trademark application can be completed in an hour.[18]

The application process includes two opportunities to defeat an application before it ripens to registration: one for the USPTO, and one for third parties. USPTO approval is the first hurdle an applicant must overcome. Once the application is submitted, the USPTO randomly assigns a trademark examiner to review it.[19] The trademark examiner may conclude that the application has a defect. Federal law provides some absolute bars to trademark registration. For example, registration will be denied if the mark is deceptive, scandalous, disparaging or the name of a living U.S. President.[20] An example of a deceptive mark would be "Florida" for Oranges that are not from Florida. Because such a mark would deceive consumers about a material product feature (here, the geographic origin), it would be barred from registration. Likelihood of confusion and descriptiveness are the most common grounds for refusing registration.[21] If a man named McDonald attempted to register his name for a hamburger joint, the USPTO would deny the application on the ground that consumers may confuse his restaurant with the famous McDonald's fast food chain.[22] If a proposed mark is descriptive— like Triangle Yoga— it will also be barred from registration unless the applicant can demonstrate that the public views the mark as an identifier for a particular studio.[23] A famous example of a descriptive mark whose counsel was able to prove that the mark had become sufficiently distinctive to merit registration is "Park 'N Fly."[24] If the mark has not had sufficient exposure to acquire distinctiveness (known as "secondary meaning"), the Examiner will deny registration on the Principal Register but may permit the mark to be published on the Supplemental Register.

If the examiner finds a defect in the trademark application, the examiner may issue an office action in the form of a written letter identifying the problem. To respond, the applicant may amend the application to fix the defect or submit written evidence and argument that the Examiner erred in its analysis. If the objection is not overcome, registration may be denied. If the defect is resolved and the trademark examiner approves the application, the mark will be published in the Official Gazette. This moment marks success in overcoming all USPTO objections, and is therefore used as our first win for the applicant in the registration process.

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[17] 15 U.S.C. § 1051.
[18] http://www.uspto.gov/trademarks/teas/index.jsp.
[19] Graham *supra* note 2, at 18
[20] 15 U.S.C. § 1052(a).
[21] Graham, *supra* note 2.
[22] 15 U.S.C. § 1052(d).
[23] 15 U.S.C. § 1052(e).
[24] http://tess2.uspto.gov/bin/showfield?f=doc&state=4001:um8mlt.4.6.

However, publication also opens a second window of vulnerability. Once a mark is published in the Official Gazette, third parties (such as another company using a similar mark) have thirty days in which to object.[25] A third party who believes it may be harmed by registration of the proposed symbol may initiate an opposition proceeding.[26] If no opposition is filed (or if the applicant responds, and the USPTO agrees with the applicant), the application proceeds to the next step in the process. If the mark has already been used in commerce, it will be included in the Principal Register, and the applicant will receive a glossy registration certificate in the mail. If the mark has not yet been used in commerce, the applicant will receive a "Notice of Allowance" and registration will occur after the applicant demonstrates that it has begun using the mark in commerce.[27] These tasks—submitting applications, responding to office actions, filing statements of use and responding to opposition proceedings—may all be accomplished without legal counsel.

The option of proceeding pro se raises the central question of this Article: do lawyers make a difference? The recent release of the USPTO data creates an opportunity to explore this fundamentally important question in a new context. In the United States, state laws prohibit practicing law without a license.[28] Faced with a matter requiring legal analysis, an inexperienced person is often confronted with the choice of hiring a lawyer or slogging through the matter alone.[29] For individuals, hiring an experienced lay person is not an option. However, corporations often have that option. While lawyers may manage their trademark portfolios, experienced non-lawyers such as trademark paralegals sometimes file applications on behalf of their employers.

This article contributes to the growing literature on whether legal counsel makes a difference and whether experienced counsel may have an especially significant impact. Some scholars have found non-lawyers to be as effective as lawyers in some advocacy situations,[30] especially when the non-lawyers had substantive and procedural expertise.[31] The quality of all lawyering is not the same. Because one possible measure of quality is experience, some scholars have examined the extent to which experience may affect

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[25] 15 U.S.C. § 1063(a).
[26] *Id*.
[27] 15 U.S.C. § 1051(d).
[28] *See, e.g.,* N.C. Gen. Stat. § 84-4 -- 84-5 (2011).
[29] HERBERT M. KRITZER, LEGAL ADVOCACY LAWYERS AND NON-LAWYERS AT WORK 2-3 (1998). There are of course exceptions. Advice and assistance in obtaining a patent may be given by a non lawyer who has taken a test and been admitted to practice before the Patent and Trademark Office. Outside the U.S., legal assistance outside the courtroom may be provided by non-lawyers.
[30] D. James Greiner & Cassandra Wolos Pattanayak, *Randomized Evaluation in Legal Assistance: What Difference does Representation (Offer and Actual Use) Make?* 121YALE LAW JOURNAL 2118, 2214 (2011).
[31] Kritzer, *supra* note 29, at 193-195. ("Non-lawyers are effective in three of the four disparate settings I considered.")

litigation success. Looking at advocacy before the Supreme Court, Kevin McGuire demonstrated that retaining an experienced lawyer increases the probability that a party will win.[32] The USPTO data provide a perfect opportunity to test whether retaining a lawyer at all, and particularly an experienced lawyer, may affect outcomes in the trademark registration process as well.

It is not necessary to hire counsel to prosecute a trademark application, but most do so anyway.[33] For many reasons, hiring experienced trademark counsel in the initial stages of selecting a mark may be an excellent idea. A trademark lawyer can provide meaningful feedback on selecting a mark by identifying symbols that are likely to overcome statutory barriers and are capable of becoming strong and unique identifiers. They will also be knowledgeable about how to navigate the application process smoothly and will likely have docketing software to remind them of periodic deadlines for filings that must be completed in order to keep applications and registrations from expiring. But faced with scarce resources, some choose to navigate the selection and application process alone. This Article quantifies the difference it makes in having a lawyer involved in the trademark application process, given that the USPTO has tried to create a process in which the lack of legal representation should not be a barrier to registration.

II. METHODOLOGY

Until recently, little was known about the success rates for trademark applications on an aggregate basis. The USPTO only offered its bulk trademark application data for a fee, and the data were not available online.[34] Fortunately, in June 2010, the USPTO entered into a two-year partnership with Google Inc. to make its patent and trademark data freely available for download from the Google servers.[35] Among the data that may be downloaded are the application contents and registration images, information about trademark assignments, and the details of opposition proceedings.[36] Trademark data are available for applications dating back to 1870.[37] This Article examines applications filed between 1984-2012, and publication and registration rates for applications filed between 1984-2010. We started with applications filed in 1984 because information on the

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[32] Kevin T. McGuire, *Repeat Players in the Supreme Court: The Role of Experienced Lawyers in Litigation Success* 57 (1) THE JOURNAL OF POLITICS 187-196 (1995).
[33] *See infra*, Figure 3.
[34] *See* http://www.uspto.gov/news/pr/2010/10_22.jsp (describing the origins of the partnership between the USPTO and Google to offer bulk data to the public).
[35] *Id.*
[36] *See* http://www.google.com/googlebooks/uspto-trademarks.html.
[37] Graham, *supra* note 2, at 31-32. *See also* Beebe, *supra* note 3 (noting that trademark application data before 1982 is likely incomplete, due to the extremely high registration rates and suggesting that the files do not contain a large proportion of applications that did not proceed to registration.)

presence of counsel is incomplete for pre-1984 filings.[38] We included the most recent data available for our end dates, given the natural constraints of the filing process. At the time of this writing, application data was available through 2012. Because many applications are delayed by office actions, requests for extensions of time and opposition proceedings, many do not register for months or even years after the application is filed. Therefore, we examined publication and registration rates for applications filed between 1984-2010.[39]

The trademark data are stored in a series of forty multi-gigabit extensible markup language ("XML") files, with each file containing a similar structure.[40] There are 170 types of variables. Because single variables may capture a variety of different information throughout the life cycle of an application, the dataset actually contains approximately 1500 possible data points. The sections that follow will identify the data and discuss how each type was compiled.

A. General Trademark Application Data

Much of the trademark application data have been aggregated by serial number, which serves as a unique identifier for every trademark application. Each application contains, among other variables, information about the type of mark (e.g. trademark, certification mark), the filing basis (e.g. use, intent to use), whether the trademark was published in the Official Gazette, and whether the trademark was eventually placed on the Principal or Supplemental Register. Each application also contains a current status code, which indicates whether a trademark is currently registered and, if not, the code provides some insight into why the proposed mark failed to register.[41]

Unlike other empirical studies of trademarks in which researchers have analyzed a sample of the population of interest,[42] this study includes all viable trademark applications filed during the time periods of interest. Before analyzing the data, however, we excluded those applications having incomplete or highly suspect records. For example, we excluded from consideration a small number of applications whose final status code was "Misassigned serial number," as those records contained little substantive

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[38] For example, the rates of attorney filings from 1980-1982 were 78%, 68%, and 65%, respectively. By contrast, the rates of attorney filings were above 80% until 1999. Also, applications that did not mature to registration appear to be missing from the data preceding 1980. *See* Beebe, *supra* note 3 (noting that registration rates prior to 1980 were 99%, suggesting that non-successful applications were not included in the dataset).

[39] *See id*. Indeed, the registration rates for 2011 and 2012 were significantly lower than the rates in the immediately preceding years.

[40] For more information about the data structure and variables, see generally http://www.uspto.gov/products/tmdailyapp-documentation.pdf.

[41] *See* Beebe, *supra* note 3, at 771-74.

[42] *See*, e.g. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 95 CAL. L. REV. 1581 (2006).

information and the status code itself suggested that the records had been subject to a coding error.[43]

B. Attorney and Pro Se Applications

The primary focus of this study is to measure the impact of attorneys on the trademark registration process, by comparing applications filed by lawyers and those filed without the assistance of counsel. While the dataset does not explicitly include a flag denoting whether an action was filed by an attorney, it does contain a field for the name of the attorney who is associated with an application. Unfortunately, this field is not standardized; names may be in upper or lower-case, some fields include middle names or initials, and entries are subject to human typographical error.[44] Nevertheless, the presence of information in this field indicates that an attorney filed the trademark application, and it is from the presence of data in this field that we categorize an application as being filed by an "attorney" or "non attorney."

Another goal of this project is to understand the impact of experience on success in navigating the registration process. Identifying the level of experience associated with an application is another challenging task. For attorney applications, we relied on the non-standardized attorney name field; however, the data were recoded in several ways before they were aggregated, including recoding all names so that they were formatted consistently and removing all non-alphanumeric characters and spaces from the fields. After summing the number of applications associated with a particular attorney, that number was assigned to those applications as a proxy for attorney experience.

The level of experience was calculated in a slightly different manner for non attorney applications, because the relevant data have been collected in a different format. Unlike the attorney name, which comprises a single field for a particular application, the dataset structure permits multiple owners to be associated with one application. Furthermore, ownership may change throughout the life cycle of an application. For purposes of this Article, we considered ownership at the time that an application was filed. Even then, a small percentage of the filings were associated with more than one owner.[45] Thus, in addition to standardizing the owner names in a similar manner as was done for attorney names, we calculated the experience level for an application based on

[43] Also excluded from consideration were applications that had a current status code of "969," which corresponds to "Non Registration Data." Records were also excluded in particular aspects of the analysis where appropriate. For example, when analyzing registration rates by filing basis, records without a basis were excluded.

[44] Indeed, a visual inspection of the data reveal misspellings in attorney names and inconsistencies in how a single name appears in the dataset. For example, the name "Avital Tally Eitan" also appears as "Avital (Tally) Eitan," "AVITAL (TALLY) EITAN," "AVITAL(TALLY) EITAN," "AVITAL EITAN," and "Avital Eitan."

[45] Among all applications, 1.3% were associated with more than one owner at the time of filing.

the owner who was the most experienced with the trademark process, i.e. the owner who had filed the most trademark applications.

C. Trademark Life Cycle and Barriers to Publication and Registration

Although general application data are useful for understanding how the attributes of an application are related to publication and registration rates, they provide no insight into how trademark applications proceed through the trademark life cycle. Before beginning this project, we hypothesized that there are two primary barriers to registration: first, when there is an office action from a trademark examiner prior to publication; and second, when there is an opposition to the application filed by a third party following publication. In order to quantify the impact of these barriers, we compiled the prosecution history for all applications to create a timeline of all events in the life cycle of a trademark application.

Once the timeline was constructed, we identified whether an application faced a barrier and whether that application ultimately proceeded to the next stage of the process. For this part of the project, we limited our analysis to the initial trademark registration process and omitted post registration events, such as cancellation proceedings or abandonment, which could cause a mark to lose its place on the Principal Register.[46]

The USPTO data include codes for 532 events that may be associated with the life cycle of an application. We first identified those that were most strongly correlated with not proceeding to publication or registration.[47] As expected, receiving an office action was strongly correlated with not proceeding to publication.[48] The institution of an opposition proceeding was likewise correlated with the failure to register a published mark;[49] however, among intent to use filings, an applicant's failure to file a statement of use was the event most highly correlated with not registering a mark.[50]

To identify applications that were subject to an office action prior to publication, we first isolated all applications in which a non-final office action was mailed or emailed, and we compared the date of the earliest office action to the date of publication.[51]

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[46] Examining whether the initial presence of counsel has an impact on the duration of a trademark registration would be fertile found for additional research.

[47] Although all events were initially examined, we excluded events that did not actually represent a barrier to registration. For example, the dataset includes an event code for final office actions, which would necessarily be highly negatively correlated with publication in the Official Gazette.

[48] Pearson Correlation coefficient equals -.32 (significant at .01 level).

[49] Pearson Correlation coefficient equals -.15 (significant at .01 level) for all published marks. When intent-to-use applications are excluded from consideration, however, the correlation coefficient increases to -.53.

[50] Pearson Correlation coefficient equals -.84 (significant at .01 level).

[51] If the USPTO codes indicated that an application prompted issuance of an office action prior to publication or, if an application received an office action but did not proceed to publication, that application was assumed to have faced this barrier.

Applications were then coded according to whether the trademark was published in the Official Gazette during the initial registration process. We used these two variables, publication and whether an application had received an office action prior to publication, to determine the frequency of office actions and their impact on filings.

We adopted a similar procedure for identifying applications in which an opposition had been instituted. If an application faced an opposition proceeding prior to initial registration, it was coded as having faced this second barrier. All applications were then coded according to whether they had been registered on the Principal Register. Since a large percentage of intent to use applications did not proceed to registration because no statement of use was filed,[52] we flagged applications that did not proceed to registration and contained a current status code of "Abandoned—No Statement of Use Filed." In this manner, we distinguished between applications that were not registered for failure to overcome an opposition from those that the applicant abandoned for business or practical reasons.

III. IMPACT OF LEGAL COUNSEL AND EXPERIENCE ON TRADEMARK REGISTRATION RATES

To assess whether hiring a lawyer makes a difference in registering a trademark, we use advances in various stages of the registration process as our measures of success. Publication in the Official Gazette is the first victory in the process because, at that point, the applicant has overcome objections asserted by the USPTO. After publication and before registration, third parties may object to registration of a mark. Overcoming that interim period is the second success. A third category of potential barriers may present themselves through third party cancellation proceedings after a mark has registered. Because pre-publication and pre-registration obstacles occur most frequently, we assess success in the registration process by examining how often applications advance first to publication and then to registration.

We begin with the theory that legal counsel provides measurable value. We predict that attorneys who file trademark applications will have higher success rates than non-lawyers at prosecuting marks that will be accepted on the Principal Register. From our academic and practice experience, we have observed that students gain valuable analytic skills through law school that will help them understand and follow the online form. Also, knowledge of legal barriers to registration may cause attorneys to be more discriminating in the applications they file. We predict that having counsel will be especially beneficial at moments where the application faces an obstacle, such as an office action from the USPTO or an opposition filed by a third party.

Even if the data indicate that lawyers have a higher success rate, it will be interesting to determine whether this difference can be better understood by accounting for experience. A law degree does not necessarily confer expertise. Therefore, we

[52] Indeed, 80% of all published marks fail to register for this reason.

thought it important to question whether having any lawyer improves the odds of registration, or whether it is more important to hire a lawyer who has considerable experience filing trademark applications.

Furthermore, if experience with the trademark application process is indeed significant, it may be the case that experienced non-lawyers have success rates that are equivalent to lawyers who have prosecuted a similar number of applications. In-house marketing employees or trademark paralegals may have acquired significant expertise registering marks for their corporate employers. Some savvy brand owners may rely on these non-lawyers to manage much of their trademark portfolios, and call in counsel only when a mark confronts a barrier in the registration process. For example, the following iconic mark— according to USPTO records—was filed by a corporate employee and not a lawyer.[53]

Given these circumstances, we explore whether experience in filing applications makes a meaningful difference in obtaining registration. We do so by comparing publication and registration rates of applications filed by lawyers and non-lawyers to determine whether experience matters. We expect to see that experience matters, and that non-lawyer publication rates may be lower, but not as low for repeat players.[54]

To set the stage for our examination of a lawyer's role in prosecuting trademark applications, the first charts provide a general overview of the trademark application process over time.[55] Next, we examine the data to determine the extent to which it matters to have a lawyer when applying for federal trademark registration.

As Figure 1 demonstrates, trademark applications have steadily increased over time.[56] Barton Beebe observed that the increase reflects general economic trends, such as the expansion of United States GDP over the entire time period.[57] Beebe observes that

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[53] Trademark Registration No. 3742438 http://tess2.uspto.gov/bin/showfield?f=doc&state=4005:n6ll43.4.1.

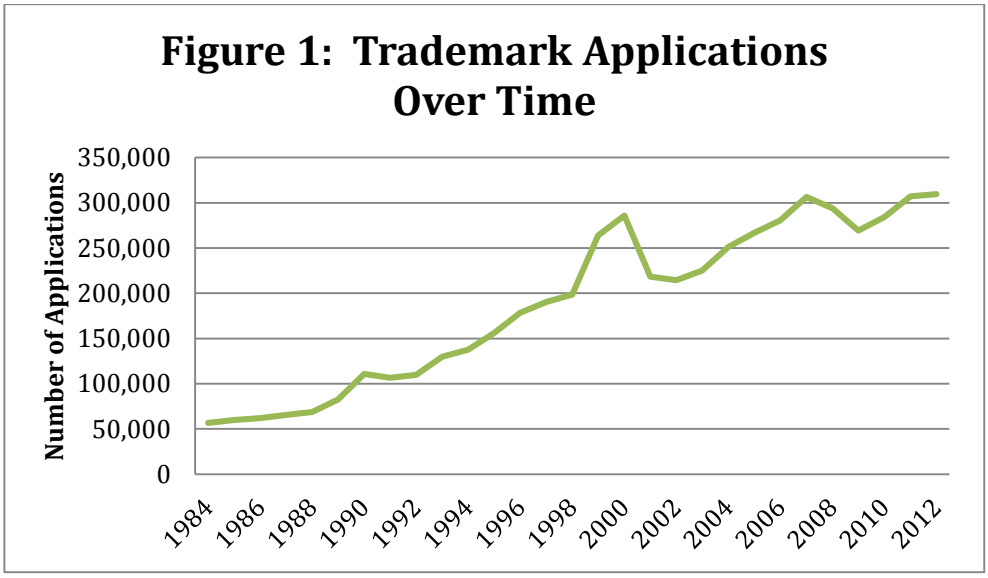
[54] Marc Galanter, *Why the Haves Come Out Ahead*, 9 LAW AND SOCIETY REVIEW 95,160 (1974) (known for coining the term "repeat players").

[55] For an excellent article devoted in its entirety to this issue, see Beebe, *supra* note 3.

[56] Figure 1 and Figure 2 include applications that ultimately were placed on the Supplemental Register. Those applications will not be included in the rest of the analysis, unless otherwise noted. During the years 1984 through 2010, .27% of all applications were placed on the Supplemental Register (132394 of 4872622).

[57] Beebe, *supra* note 3, at 761.

the Internet bubble in 1999 and 2000 may account for the "dramatic spike in total applications" for those years.[58]



While Figure 1 shows that all applications increased over time, Figure 2 illustrates how this trend is related to representation by counsel. The entire set of all applications is represented by the green bar. The lower two bars divide the universe into two subsets: the red bar represents applications filed by lawyers, and the blue bar represents pro se applications. The number of pro se applications tripled between 1998 and 2012. Figure 2 shows that the dramatic increase in pro se applications may be another explanation for the increase in applications generally.

[58] *Id.*

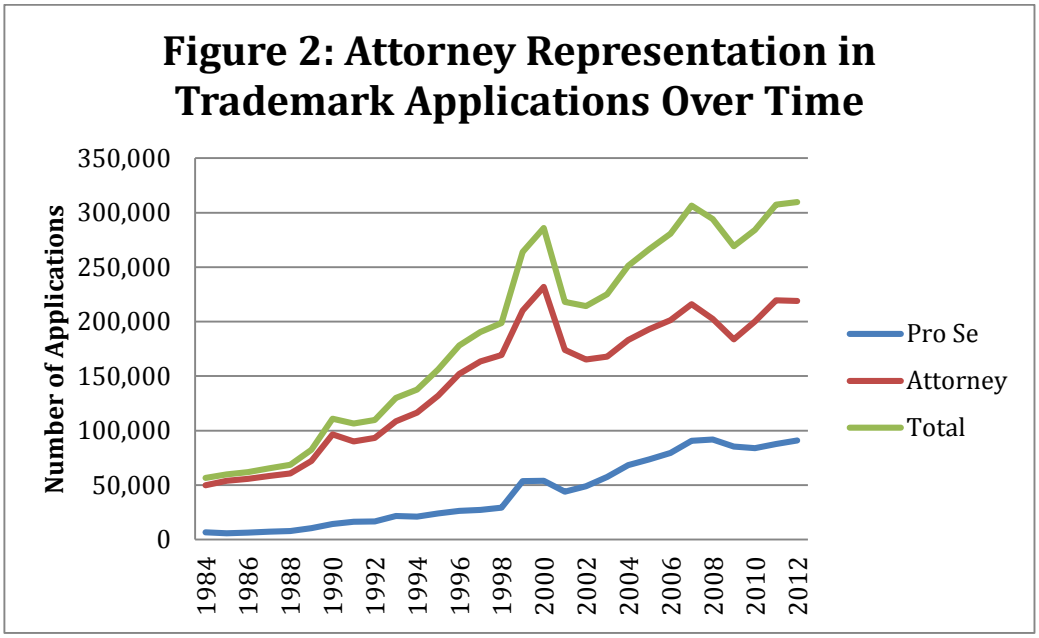


Table 1 more specifically sets forth the data depicted in Figure 2, identifying both the numeric and percentage increases of attorney and non-attorney trademark applications. Both the total number of trademark applications and the percentage filed by non-attorneys have increased steadily since 1984.

TABLE I

Year	Pro Se Applications	Attorney Applications	Total Applications	Percent of Pro Se Applications
1984	6,700	49,935	56,635	12%
1985	5,847	53,956	59,803	10%
1986	6,238	55,614	61,852	10%
1987	7,099	58,384	65,483	11%
1988	7,911	60,623	68,534	12%
1989	10,431	71,995	82,426	13%
1990	14,312	96,499	110,811	13%
1991	16,398	90,178	106,576	15%
1992	16,490	93,230	109,720	15%
1993	21,508	108,428	129,936	17%

1994	21,099	116,503	137,602	15%
1995	24,038	132,006	156,044	15%
1996	26,321	151,926	178,247	15%
1997	27,084	163,411	190,495	14%
1998	29,354	169,292	198,646	15%
1999	53,579	210,245	263,824	20%
2000	53,983	231,816	285,799	19%
2001	44,018	174,155	218,173	20%
2002	49,044	165,227	214,271	23%
2003	57,355	167,777	225,132	25%
2004	68,159	183,160	251,319	27%
2005	73,464	193,221	266,685	28%
2006	79,340	201,339	280,679	28%
2007	90,607	215,883	306,490	30%
2008	91,680	202,513	294,193	31%
2009	85,406	183,791	269,197	32%
2010	83,873	200,177	284,050	30%
2011	87,679	219,567	307,246	29%
2012	90,851	218,867	309,718	29%
Total	**1,249,868**	**4,239,718**	**5,489,586**	**23%**

The data in Figure 2 and Table I suggest two explanations related to changes in the application process that may account for fluctuations in the general application growth rate. First, a notable increase in applications is apparent after 1989, the year when federal law changed to permit trademark applications to be based on the intent to use a mark. Figure 2 graphically illustrates how this change resulted in an immediate increase that never ebbed. The annual increase of less than 5,000 total applications per year (compared to the previous year) suddenly jumps to 13,892 in 1989 and 28,385 in 1990. Steady increases continue afterwards. Table II shows that most of the new applications were filed by lawyers. However, the percentage of applications filed by lawyers and non-lawyers remained relatively stable.

The availability of ITU filings is likely to be a factor explaining the increase. Before 1989, a viable trademark application required proof that the applicant was already using it mark in interstate commerce. The Lanham Act still requires use before

registration.[59] However, since November 16, 1989, it has been possible to file an application for a mark if an enterprise has good faith intent to use ("ITU") it.[60] The mark will not actually register until the mark has been used, but an ITU application gives the mark owner a constructive first use date corresponding to the day on which the application was filed. For purposes of establishing priority over other uses, this change in the law made it possible to preserve national protection from a time that preceded actual use.[61]

If a business is deciding among several marks, instead of choosing one and beginning use before beginning the application process, a business may file applications for all and then abandon the applications for the marks it decides not to use. Therefore, after the ITU filing basis became available, one would expect to see application rates rise and registration rates drop.

A second dramatic spike may be seen a decade later between 1997 and 1999. Again, economic trends provide one explanation, but there is an equally plausible trademark reason. This upward trend may have been stimulated by substantial efforts to improve the online application process. The USPTO considers trademark applicants to be "customers," and accordingly, it strives to make its services increasingly easy to use.[62] In November 1997, the USPTO launched an online trademark application system it called "TEAS," coined to be an acronym for "trademark electronic application system."[63] A pilot electronic filing program began with fifty selected participants who established USPTO deposit accounts.[64] On October 1, 1998, the service became publicly available so that anyone could apply for trademark registration online and pay by credit card.[65]

The spike in all applications is apparent in 1999, after the USPTO launched the online filing system publicly. Interestingly, that same year had the greatest increase in the percentage of applications filed by non-attorneys. As shown in Table I, before 1999,

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[59] U.S.C. § 1057(b).
[60] *Id.*
[61] *See* 15 U.S.C. § 1057(c).
[62] USPTO 1989 Annual Report, available at http://www.uspto.gov/about/stratplan/ar/1998/a98r-3.jsp.
[63] *Id.*
[64] *Id.*
[65] Initially, the TEAS system offered two filing options, only one of which was truly electronic. The first, eTeas permitted genuine electronic filing application would be completed and submitted online. The second option, PrinTeas, made it possible for an applicant to prepare the application online, and then print it as a hard copy for mailing to the USPTO. In 1999, the PrinTeas option was eliminated. Since then, the USPTO has repeatedly solicited feedback and made additional changes to improve the system. In July 2005, a second electronic filing form, called TEAS Plus, was launched. The TEAS Plus form was designed to be an attractive option for pro se applicants or less experienced lawyers. It was offered for a discounted filing fee. The primary substantive difference was that instead of permitting an applicant to write out the goods and services, it permitted only use of goods and services descriptions that already appeared in the USPTO's Acceptable Identification of Goods and Services Manual.

non-attorney applications generally remained between 12% and 15% (with the exception of 17% pro se applications in 1993). Suddenly, in 1999, there was a 5% point increase in applications filed by non-lawyers. This dramatic increase corresponds with the first year that it was possible to apply for a trademark online through the USPTO's website. These data confirm that the USPTO has succeeded in making its application process more widely available to pro se applicants.

Against this backdrop, the next figures demonstrate success rates at two pivotal moments in the application process: publication and registration. Figure 3 provides an overview of both rates over time and reveals a possible reason why many marks do not register.

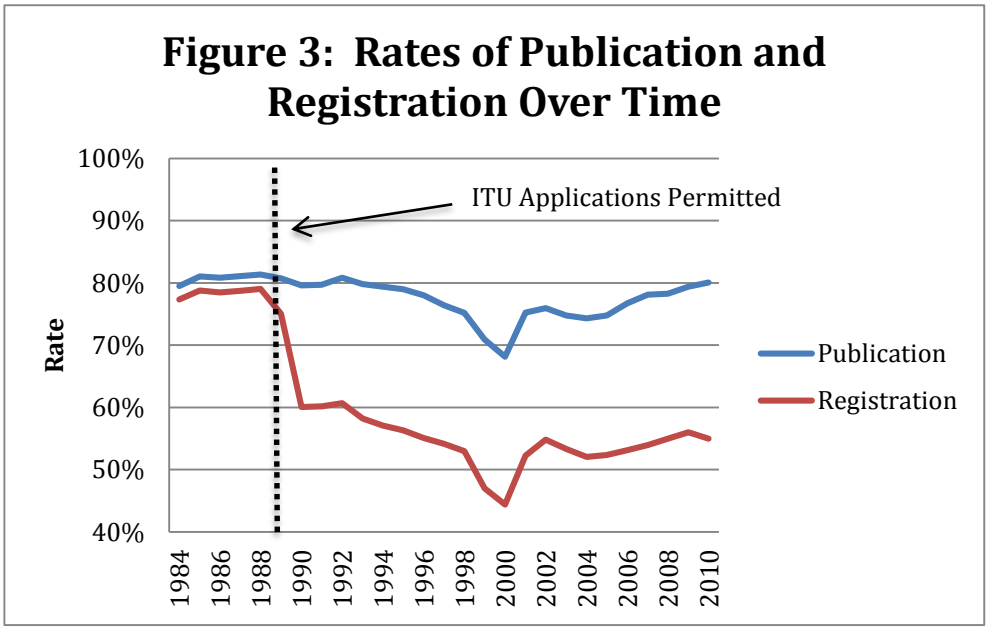


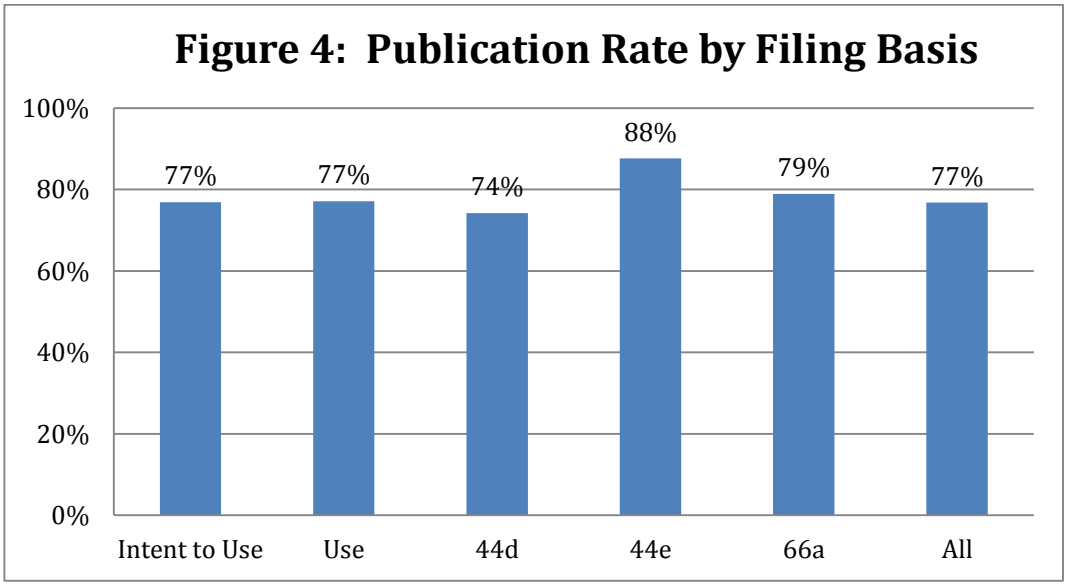
Figure 3 reveals a dramatic difference between publication (blue line) and registration (red line) rates. While publication rates hover fairly close to the 80% mark over the 26-year time period, registration rates mirror that pattern until 1989 and then drop at least 20 percentage points. These relative patterns may be explained by the presence of intent to use applications. Before ITU applications could be filed, the publication and registration rates were virtually identical—as can be seen by the closely-matched red and blue bars between 1984 and 1989. When ITU filing first became available in 1989, registration rates took a sharp dip from 80% to 60%. All eligible marks (whether based on use or ITU) may publish, but only those that are actually used may advance to registration. Publication represents the USPTO's stamp of approval. After publication, ITU applications cannot mature to registration unless the applicant files evidence of use within a prescribed time period. The general dip in registration rates may indicate that many applicants decided not to use marks they once thought they

might, or they did not get themselves sufficiently organized to demonstrate use before the application time expired.

Compared to this general drop in rates, publication and registration rates show a greater than normal downward spike in the 1999-2000 time period. This drop corresponds with an unusually high number of applications around the same time, as seen above in Figures 1 and 2. This anomaly will provide a fertile path for additional research. It may indicate less care in filing trademark applications during economically strong years. However, other plausible, trademark-related reasons could be explored.

Figures 4 and 5 provide some support for the theory that the declining registration rate is due to the presence of ITU applications.[66] Figure 4 illustrates how likely it is that a mark will be approved by the USPTO for publication. It also analyzes the universe of applications by filing basis. Trademark applications may be based on use of a mark (1(a)),[67] intent to use (1(b)),[68] foreign ITU application 44(d),[69] foreign registration 44(e),[70] or an international registration 66(a).[71] Figure 4 shows that the publication rate remains relatively stable irrespective of the basis on which the application is filed. The first two bars indicate that the applications filed on the basis of use or ITU are equally likely to achieve publication. Comparing Figure 4 and Figure 5, however, the relative success rates of use and ITU applications change dramatically.

[66] In order to understand how some filing bases (primarily intent to use) affect registration rates, it was necessary to classify applications by filing basis. Therefore, for Figures 4 and 5 we considered only those applications having a single filing basis for analyzing their effects; multi-basis applications were excluded here, but not from other measures.
[67] 15 U.S.C § 1051(a).
[68] 15 U.S.C § 1051(b).
[69] 15 U.S.C § 1126(d).
[70] 15 U.S.C § 1126(e).
[71] 15 U.S.C § 1141(f).



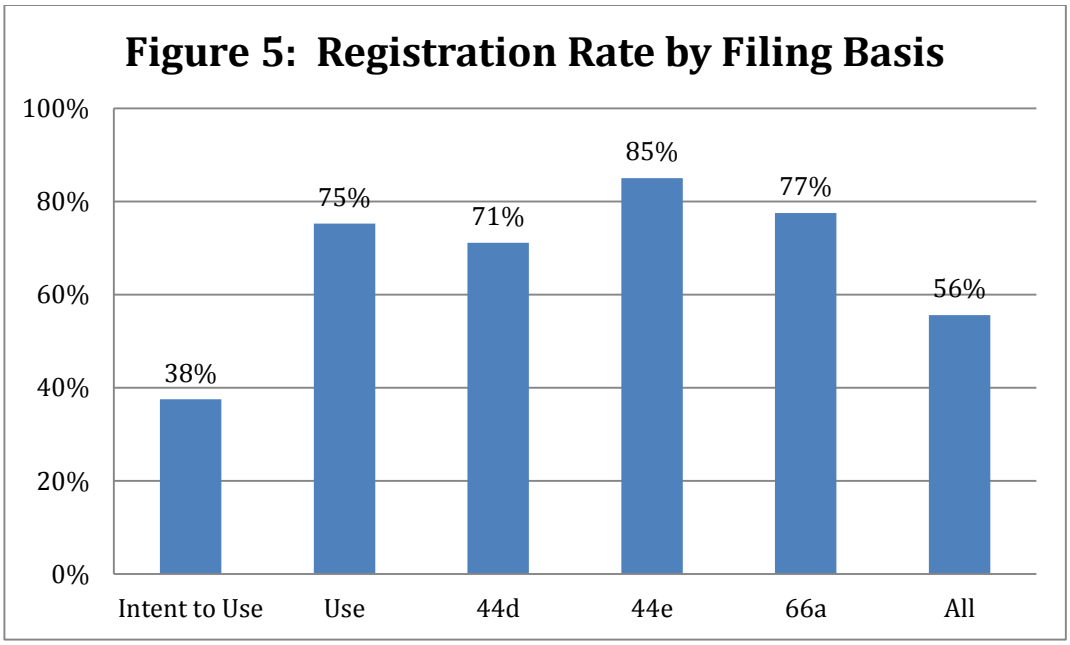
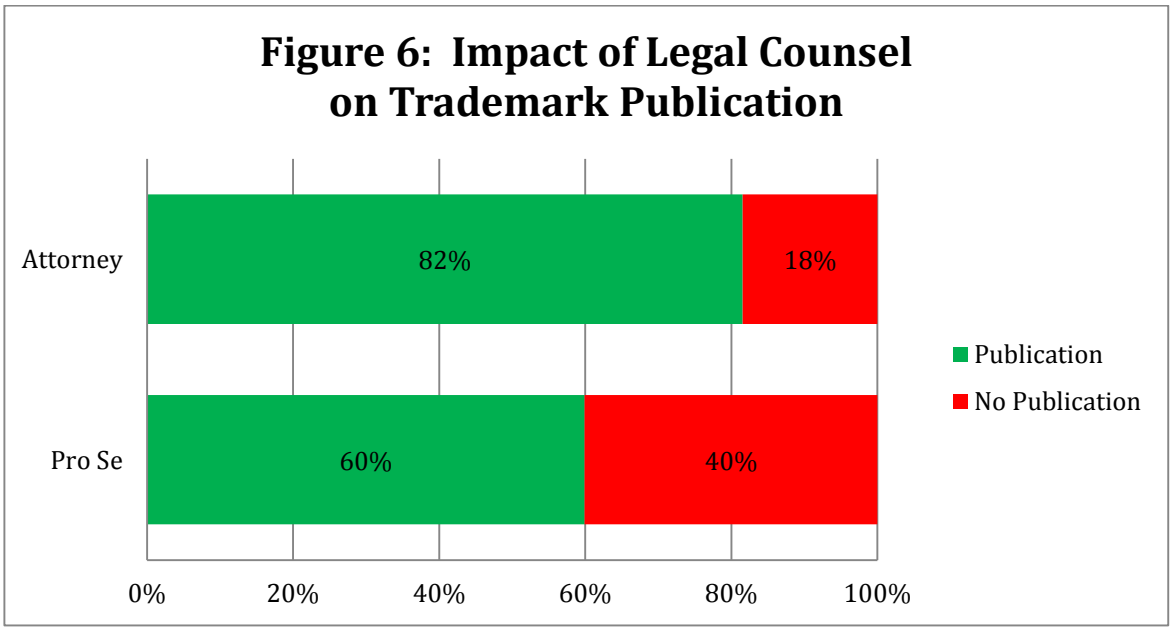


Figure 5 shows that fluctuations in registration rates are sometimes related to the filing basis. As we saw in figure 4, for most bases, the publication rates are relatively constant. In stark contrast, the first two bars in Figure 5 display a dramatic difference. Recall that both ITU and use applications proceeded past a trademark examiner to publication 77% of the time. The first two bars of figure 5 show that use applications registered 75% of the time, while ITU applications registered only 38% of the time. The

much lower registration rate for ITU applications is one explanation for the decline in overall registration rates since 1989.

The next two figures display the impact of legal representation on publication (Figure 6) and registration (Figure 7) rates. Publication of a mark in the Official Gazette means that all obstacles initially identified in office actions have been overcome, and a trademark examiner approved the application. Other obstacles may still prevent ultimate registration—such as failure to show use of the mark or an opposition proceeding—but these obstacles are created by the applicant's abandonment of the mark, failure to prosecute the application, or third party opposition. Therefore, Figure 6 shows the difference it makes to have a lawyer present in the first phase of an application's life when it is subject to approval by the USPTO. The green segments on the left reflect the percentage of applications that succeed in getting USPTO approval and advance to publication. The red segments on the right represent those that fail. The top bar reflects the percentages when a lawyer is involved, and the bottom indicates how these percentages change when the applicant is not represented by counsel. Together, they show that while 82% of applications prosecuted by attorneys were published in the Official Gazette, only 60% of applications filed by non-attorneys were published. These data suggest that the presence of a lawyer made a meaningful difference,[72] as an applicant was 37% more likely to likely to succeed in this first stage of the process and obtain USPTO approval of its mark if represented by counsel.[73]



[72] This finding is significant, particularly because publication rates were not affected by the type of filing.

[73] This 37% value represents the percentage increase in the success rate over the pro se publication rate of 60% (60% + 37% increase = 82%).

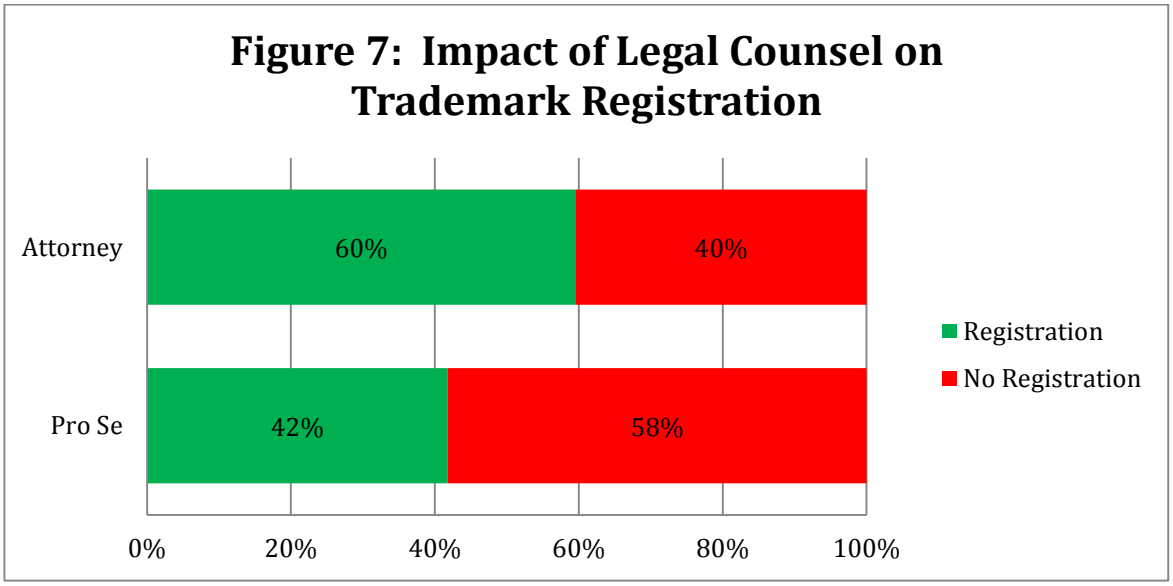
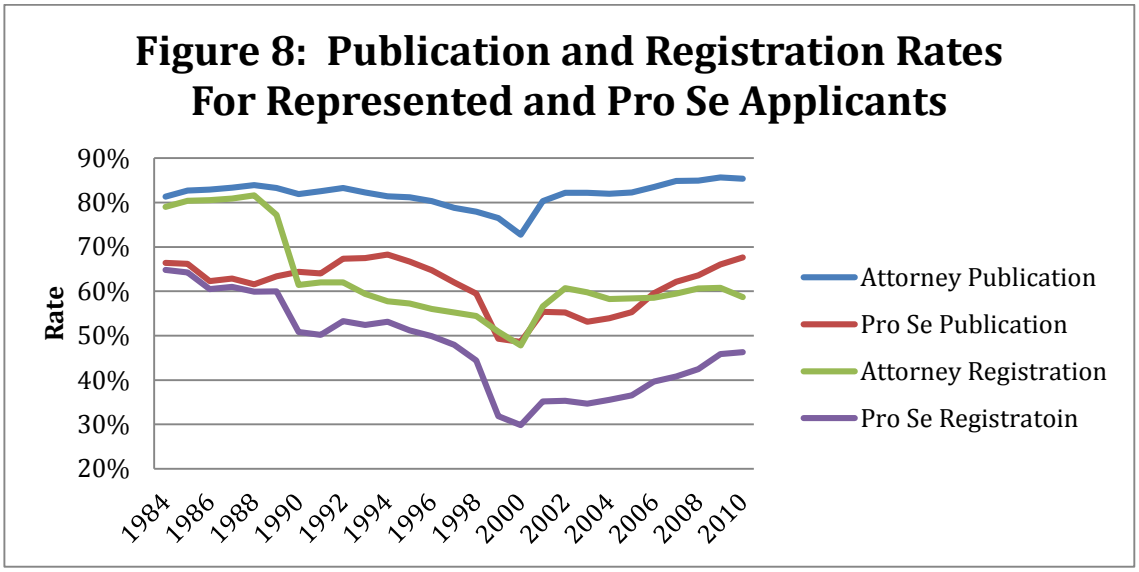


Figure 7 displays similar information for registration rates. The success rates in Figure 7 (the green segments) are significantly lower than those in Figure 6. This difference is not surprising, because as indicated above in Figure 2, since 1989 when intent to use became a viable filing basis, registration rates have been consistently lower than publication rates. Also, as we saw in Figures 4 and 5, the lower rates may be explained by a high percentage of abandoned ITU applications. In fact, a higher percentage of ITU applications are prosecuted by attorneys than other types of filings.[74] Therefore, one might expect a lower registration rate for applications filed by attorneys, if all other circumstances were equal. Despite this handicap of carrying more ITU's, many of which did not mature from publication to registration, applications prosecuted by lawyers were significantly more likely to register than those handled pro se. An applicant was 43% more likely to succeed in registering a mark if represented by counsel.

Figure 8 shows registration and publication rates for lawyers and non-lawyers over time. Over the entire period, lawyers have consistently had higher success rates at both points in the trademark life cycle. In the pre-ITU years, both the publication and registration bars for each group track almost identically. Attorney publication rates (blue bar) virtually match their registration rates (green bar) until 1989, when ITU applications become available and registration rates drop. The same pattern holds true at a lower level for the pro se publication (red bar) and registration (purple bar) rates.

[74] For example, whereas 80% of ITU applications were filed by lawyers, 76% of use applications were filed by lawyers.



Now that it appears clear that having a lawyer is associated with success in application process, the next important question is whether it makes a difference to work with an experienced trademark lawyer. Would an applicant have an advantage if represented by experienced counsel, or would anyone with a JD and a license to practice achieve the same results? We also were intrigued to learn how much practical experience makes a difference for non-lawyers, and if such practical experience was as beneficial as having a law degree.[75]

To explore these questions, the next several figures illustrate whether it is experience, a law degree, or some combination of both that impact the likelihood of succeeding in the trademark registration process. The USPTO data identifies the name of the lawyer that prosecuted each application. The lawyer identification data are by no means a perfect measure of experience, competence, expertise or even the presence of legal counsel, but they do provide a measure of whether the application was prosecuted by a lawyer and how much exposure the applicant has had to the trademark application process.[76] As explained in the methodology section, we base the following findings on

[75] Assessing experience in a dataset with thousands of observations is by necessity a quantitative question that ignores differences in the quality of lawyering that may make an even more significant impact than experience.

[76] Although trademark applications are signed under penalty of perjury, we cannot be certain that the information in them is accurate. For example, a non-attorney filing an application may have an attorney sitting with him or her, giving advice on completing the application form even thought the lawyer does not formally appear as counsel on the application. Also, in assessing attorney experience, our measure may be under inclusive because some lawyers may change their names or use a different spelling (such as the inclusion of a middle name or initial) that might result in their being counted twice for fewer applications than they actually prosecuted. It also may be over inclusive, as there are likely multiple instances of intellectual property lawyers who

the assumption that the number of trademark applications filed by an individual reflects some degree of experience with trademark prosecution. Accordingly, in the charts below, we use the number of applications prosecuted as our measure of experience.

Figure 9 displays how experience affects the likelihood that a mark will be approved by the USPTO and published in the Official Gazette. As displayed earlier in Figure 4, if one does not take experience into account, the average publication rate is 77%. This average figure may lead one to believe that the trademark office is a "rubber stamp." [77] Figure 9 undercuts that theory, showing that experience is meaningfully associated whether an application will advance past the gatekeepers at the USPTO.

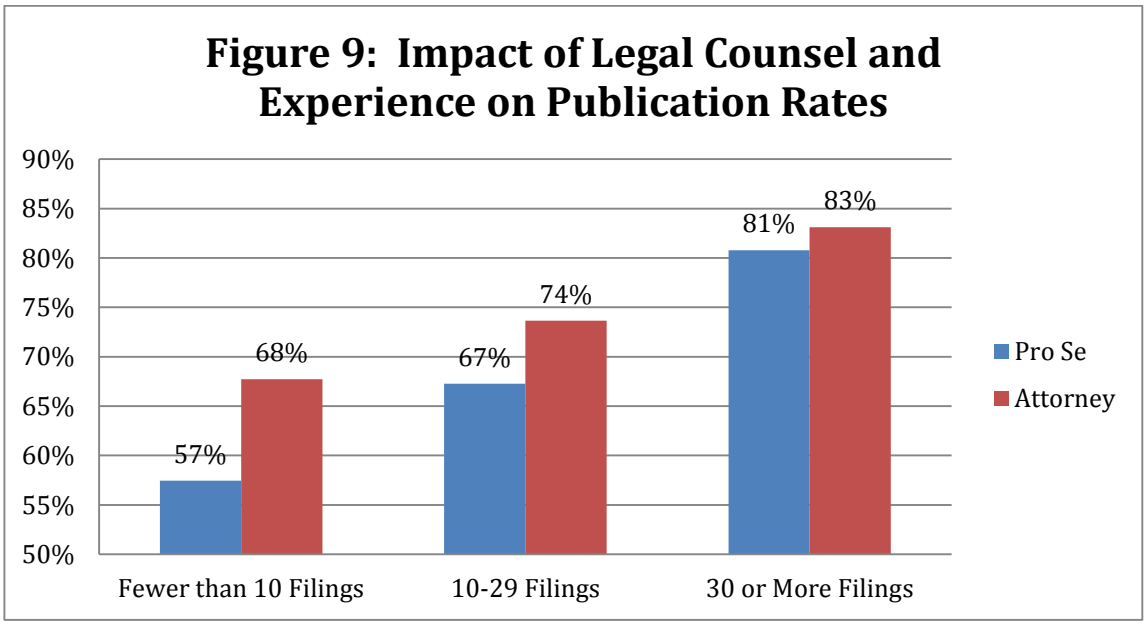


Figure 9 displays three sets of bars. Each set includes a blue bar for the percentage of pro se applications that succeeded to publication and a red bar for applications filed by attorneys. Each set represents an experience level. The first set displays publication rates for those whom we classify as the most inexperienced because their names appear in less than 10 applications. The second set represents moderately experienced trademark applicants who filed between 10 and 29 applications. The third set represents experienced persons who filed 30 or more trademark applications with the USPTO.

Perhaps the greatest practical significance of Figure 9 is the difference in publication rates between inexperienced non-lawyers and experienced lawyers. A lay person without much experience filing trademark applications has a 57% chance of

share the same name, and therefore, in our rough measures two such individuals may be counted as one doubly experienced lawyer.

[77] Beebe, *supra* note 3.

succeeding. Assuming that publication (generally leading to registration unless the applicant abandons the mark) is some measure of success, this statistic alone should be heartening to a pro se applicant with limited resources. Nearly 6 out of 10 of them succeed in obtaining USPTO approval. Still, having an experienced trademark lawyer increased the success rate by 26 percentage points, a 46% increase over the rate for inexperienced pro se applicants. Even having a moderately experienced lawyer improved the likelihood of publication by 30% (17 percentage points), and anyone with a JD and license to practice increased the likelihood of publication, but only by 19% (11 percentage points).

Table 2 shows the numbers and percentages of attorney and non-attorney applications, categorized according to three levels of experience.

TABLE II: EXPERIENCE CATEGORIES

Number of Applications Filed	**Attorney Applications**	**% of All Attorney Applications**	**Pro Se Applications**	**% of All Pro Se Applications**
Fewer than 10	250,729	7%	895,202	85%
10-29	204,212	6%	73,057	7%
30 or more	3,236,007	88%	81,021	8%

The vast majority of applications where counsel was present were filed by experienced attorneys. In stark contrast, pro se applications were most often filed by applicants with relatively little experience before the USPTO.[78] While 81% of applications with counsel were backed by lawyers who had filed more than 30 applications, only 7% of pro se applicants had that much experience. Similarly, while only 10% of attorney applications had experience with less than 10 filings, 87% of pro se applicants fell into this most inexperienced category.

But the fact that the vast majority of pro se filings were made by inexperienced owners does not mean that owners who file relatively few applications will invariably have lower success rates. Indeed, when inexperienced owners (those with nine or fewer filings) were analyzed separately, the pro se applications still fared far worse than attorney-assisted applications, both in regard to rates of publication (56% versus 77%) and rates of registration (40% versus 62%).

Moreover, a closer look at the most experienced pro se applicants reveals that the applicants are dominated by corporations with significant resources to hire outside

[78] The mean and median applications for attorney filers are 599.8 and 236, respectively. By contrast, the mean and median applications for non attorney filers are 17.6 and 1, respectively.

counsel when needed, or perhaps have in-house counsel down the hall available to assist with trademark applications informally without appearing as counsel of record. The chart below contains the top 20 pro se filers and their 2011 revenue figures:

TABLE III: TOP 20 PRO SE APPLICANTS

Rank	Applicant	2011 Revenue
1	American Greetings Corp.	$1.6 Billion
2	Twentieth Century Fox Film Corp.	$750 million
3	Hasbro, Inc.	$4.3 billion
4	Bally Gaming, Inc.	$758 million
5	International Data Group, Inc.	$3.2 billion
6	Conair Corp.	$2.0 billion
7	Avon Products, Inc.	$11.3 billion
8	Hershey Chocolate & Confectionary Corp.	$6.08 billion
9	Homer TLC, Inc. (The Home Depot)	$70.4 billion
10	Aristocrat Technologies	$470 million
11	American Express Marketing & Development Corp.	$30.2 billion
12	Nestle	$41.9 billion
13	HEB Grocery Company, LP	$15.6 billion
14	Victoria's Secret Stores Brand Management, Inc.	$6.1 billion
15	The Wine Group, LLC	$30 million
16	XEROX Corp.	$22.6 billion
17	Bristol Myers Quibb Company	$19.5 billion
18	E. I. du Pont de Nemours and Company (Dupont)	$32.7 billion
19	Ainsworth Gaming Technology, LTD	$98 million
20	McDonald's Corp.	$24.0 billion

These pro se filers likely had greater access to resources and legal counsel. Nonetheless, an important theme apparent in Figure 9 is that experience matters at this stage in the application process. As seen in Figure 6, lawyers succeed in getting marks published 82% of the time, compared to a 60% success rate for non-lawyers, but those data hide important variation that is driven by experience. Figure 9 shows how experience is related to those average numbers. Among those with the greatest experience, the significance of a license to practice law is reduced almost to its vanishing point. In the highest experience category of 30 or more applications, applications filed by lawyers published 83% of the time, compared to 81% of pro se applications. As experience declines, the success rate declines for both lawyers and non-lawyers, and the

difference between the two groups increases. Marks prosecuted by people who filed less than 30 applications published 74% of the time if the person was a lawyer, and 67% of the time if prosecuted by a non-lawyer. In the set with the least experience, lawyers succeeded in getting marks published 68% of the time, while non-lawyers succeeded only 57% of the time. Therefore, the data show that experience matters, especially if the person drafting the application is pro se. There are many possible explanations for these differences, some of which are explored below as we report what happens to lawyer and non-lawyer applications when they confront an obstacle in the application process.[79]

The next two charts illustrate the impact of counsel when the applicant confronts an obstacle from the USPTO before publication. The data confirm our hypothesis. The presence of a lawyer made an especially important difference if the trademark examiner issued an office action indicating that the application was defective. Trademark applications drafted by lawyers—especially experienced intellectual property lawyers—may be less likely to prompt the USPTO to issue an office action because they understand how to avoid common problems.[80] Of course, they may also take more chances, knowing that if an office action is issued, they will know how to correct the defect. These suppositions cannot be tested with the data currently available because applications are treated as prosecuted by counsel if a lawyer became involved at any time before registration. Also, the data do not show the grounds on which office actions are issued. However, they do show that most applications prompt at least one office action.[81] Office actions issued in 73% of applications that remained pro se throughout the process and 64% of applications in which an attorney appears. If an office action is issued, a lawyer may have more familiarity with trademark doctrine or more comfort conducting legal research to understand the trademark examiner's objections. Also, an office action

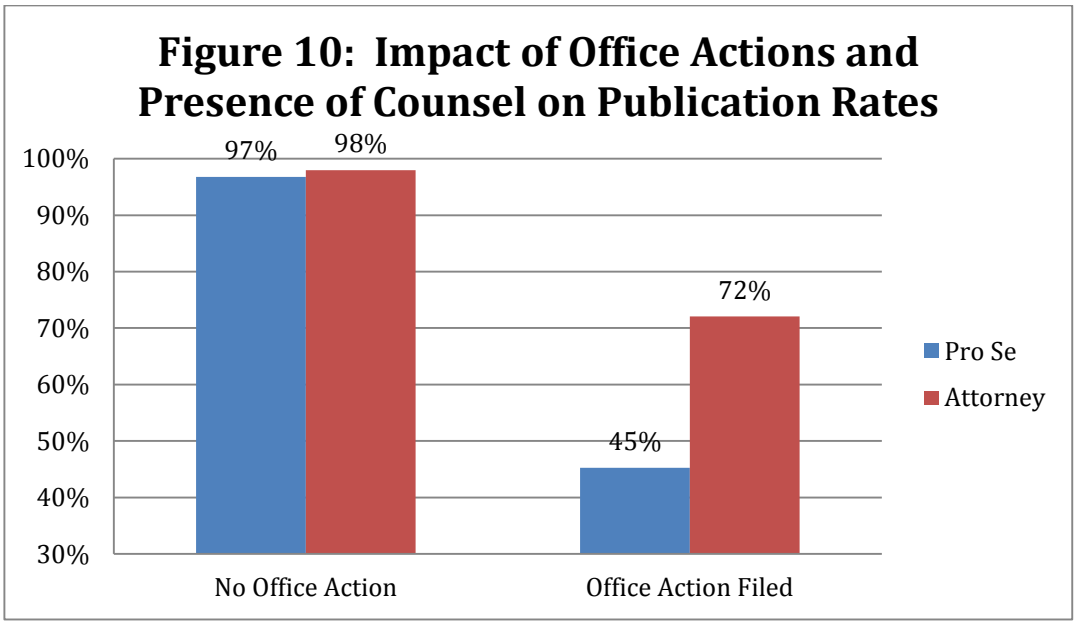
[79] To the extent the data available to us provide insights into these reasons, they are discussed below. However, we recognize that there may be many other reasons that are beyond the scope of this Article. For example, lawyers may have academic and practical training that make them especially well equipped to assist clients in selecting marks that are more likely to register. Because lawyers have ethical duties of competency to their clients, they may have a vested interest in making sure that they do the best they can to recommend filing only if it is likely to succeed and advocate for registration even when confronting a barrier. Once an application has been filed, a lawyer's training and professional obligations may create greater facility and incentives to confront barriers in the application process and see marks through to publication. For these reasons, a novice lawyer may have a better chance of success than a novice applicant. Also, lawyers often have greater experience with bureaucratic and administrative work, and therefore may be less conflict averse in dealing with office actions or opposition proceedings.

[80] Federal law prohibits registration of marks for a variety of reasons. 15 U.S.C. § 2. The prohibited categories include symbols that are immoral, deceptive, scandalous, functional or false geographic designations. Id. Marks also may not be registered if they are descriptive unless the applicant can demonstrate that the mark has "become distinctive of the applicant's goods in commerce." Id.

[81] Graham, *supra* note 2.

may stimulate a greater perceived need for legal counsel. Many applicants may be conflict averse, preferring not to fight or have someone else fight for them.

Figure 10 shows how hiring counsel affects the publication rates when an office action presents a potential barrier to registration. The first important finding in Figure 10 is that office actions create significant barriers.[82]



As discussed in the methodology section, presence of an office action is negatively correlated with publication in the Official Gazette. When the USPTO issued an office action objecting to something in the application, the applicant overcame the barrier 72% of the time if represented by counsel, but had only a 45% success rate if the applicant was pro se. Therefore, the data suggest the presence of a lawyer in responding to an office action made a significant difference in overcoming this obstacle.

Figure 11 illustrates how experience affects publication rates for applications that prompted the USPTO to issue an office action.

[82] No office actions are filed in 297,594 of pro se applications and 1,337,159 attorney applications. By contrast, office actions are filed in 751,686 pro se applications and 2,353,789 attorney applications.

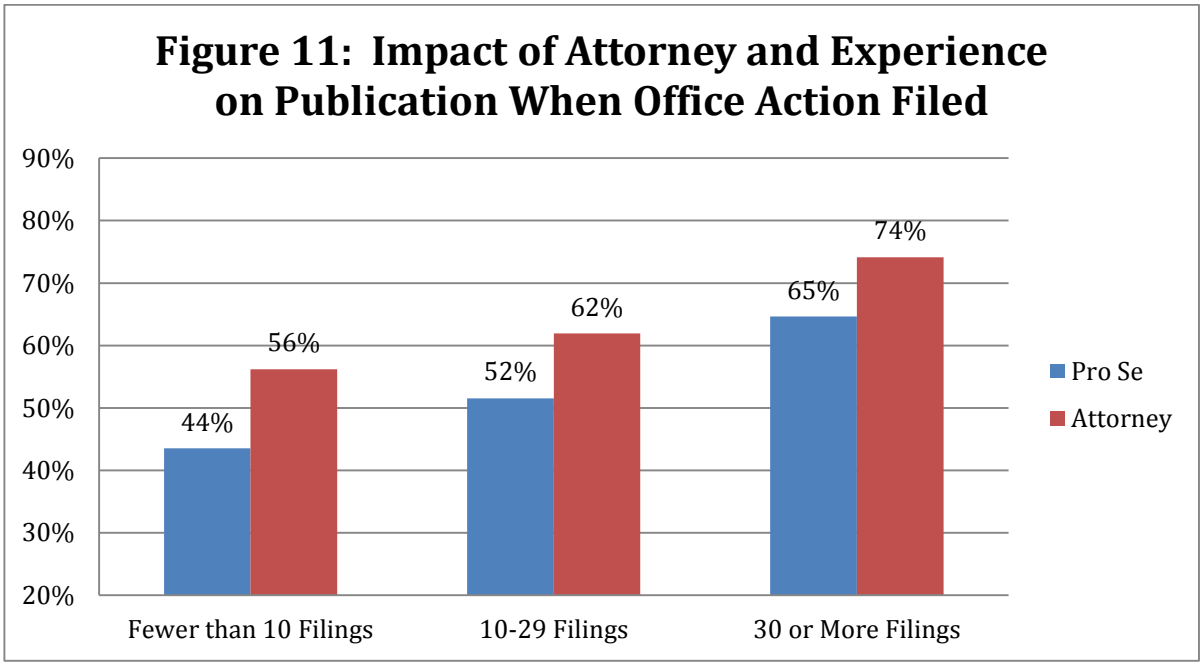
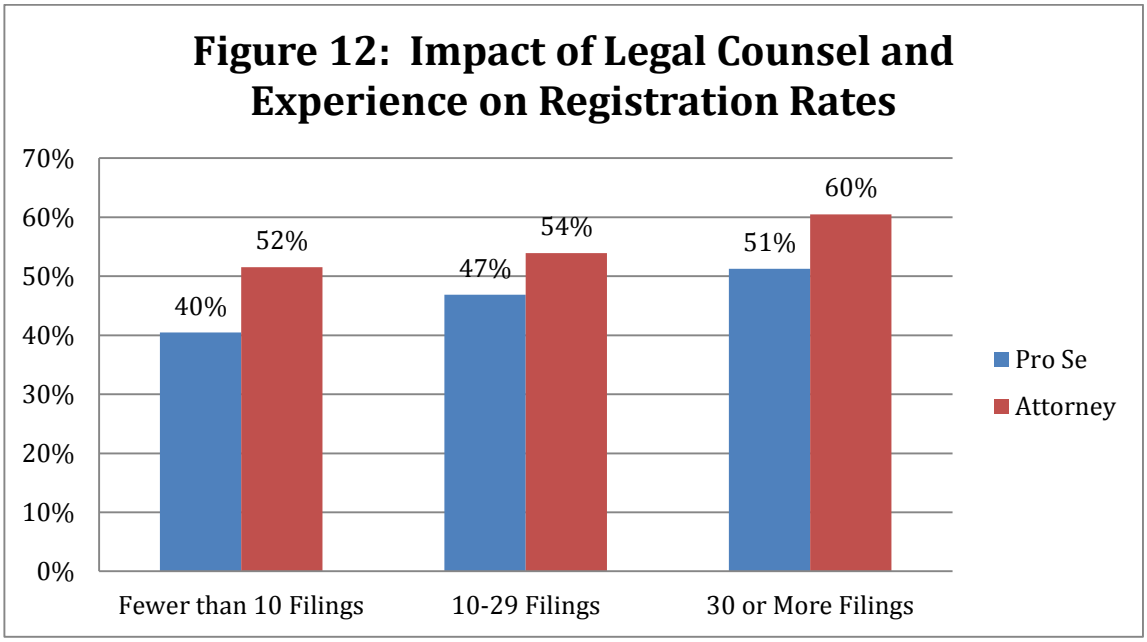


Figure 11 shows that the presence of experienced counsel is especially helpful when the USPTO issues an office action.[83] Compared to Figure 9, showing similar values for all applications, Figure 11 illustrates that the differential in publication rate between lawyers and non-lawyers expands at every experience level.

Figure 12 displays the likelihood that a mark will be registered, broken out by experience level and whether an applicant is represented by counsel.

[83] The number of applications in each group is as follows: pro se applicants with fewer than 10 filings, 661,618; attorney applicants with fewer than 10 filings, 180740; pro se applicants with 10-29 filings, 48,041; attorney applicants with 10-29 filings, 137,780; pro se applicants with 30 or more filings, 42,027; attorney applicants with 30 or more filings, 2,035,269.



These results reflect success in one important respect because registration is the ultimate goal of a trademark application. However, this data reflects less about the value of legal counsel than that portrayed in the previous figures related to publication. Many published marks fail to register simply because the applicant began with a good faith intent to use the mark but then decided not to proceed within the time allotted by the USPTO. Without a specimen showing actual use of the mark in commerce, the mark will not be registered.[84] Many applications fail between publication and registration, not because of any lack of expertise, but because a business decision was made not to continue seeking protection for the brand. Nonetheless, similar, albeit less dramatic, patterns to those we saw in Figures 9 through 11 are apparent.

The data show that experienced lawyers are more likely to succeed in getting marks registered than pro se applicants. By hiring even an inexperienced lawyer, a pro se applicant can improve the likelihood of obtaining registration by 30% (12 percentage points). If the lawyer is moderately experienced, the chance of registration increases by 35% (14 percentage points), and if the lawyer is very experienced, the success rate increases by 50% (20 percentage points). However, these data should be viewed with some caution because the success rate differential is skewed by the presence of abandoned intent to use applications. By contrast, these effects did not skew the data in Figures 9 through 11 because statements of use for ITU applications are filed after publication. Accordingly, one important lesson to draw from Figure 12 is that

[84] 15 U.S.C. § 1051.

effectiveness of experienced counsel may be better measured by looking at publication rates than registration rates.

Figure 13 illustrates our basis for concluding that the lower success rates in Figure 12 are due to the presence of ITU applications.

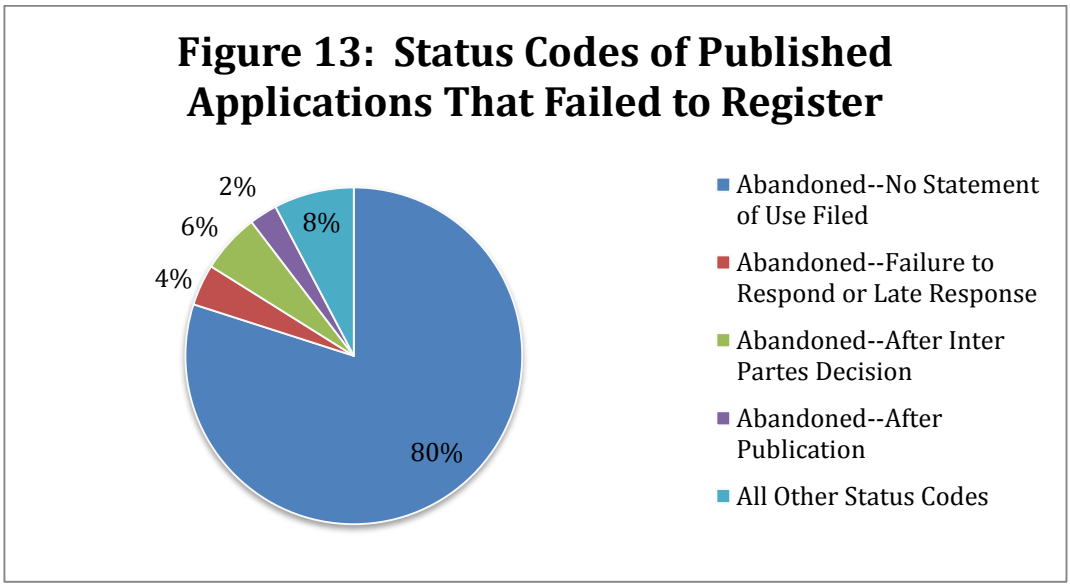


Figure 13 shows the reasons why published marks do not mature to registration. The vast majority (80%) fail to register because the applicant never filed a simple statement indicating that it began using the mark with the goods or services identified in the application.

The next two charts illustrate the impact of hiring trademark counsel when the barrier to registration is asserted by a third party. After the USPTO approves the application and publishes the mark in the Official Gazette, a 30-day window of time opens in which third parties (perhaps a competitor using a similar brand) may object to the registration. While office actions issued by the USPTO before publication are fairly common obstacles, private opposition proceedings are filed much less frequently. Of applications containing complete prosecution history, 66% had an office action filed prior to publication, while only 3% had an opposition instituted prior to registration.[85]

Although less common than office actions, opposition proceedings are generally more difficult to surmount. Figure 14 illustrates the impact of oppositions on registration rates and then breaks down these results into attorney and non attorney categories. For all trademark applications, an opposition poses a formidable barrier. In order to isolate the effects of opposition proceedings, we excluded ITU applications so that the results would not be affected by applications abandoned by failing to file a statement of use. In Figure

[85] Oppositions are filed in 8,048 of 313,673 published pro se applications and 35,671 of 1,321,011 published attorney applications.

14, the set of bars on the left indicates that when no opposition is filed, an application registers 99% of the time when counsel is present and 98% of the time when the applicant is pro se. Most applications follow this path. However, if an opposition proceeding is filed, the mark is substantially less likely to register. Only 47% of all applicants that faced an opposition proceeding ended up registering their marks; if the applicant was represented by counsel, the registration rate was 49%, but if the applicant was pro se, the registration rate was only 34%.

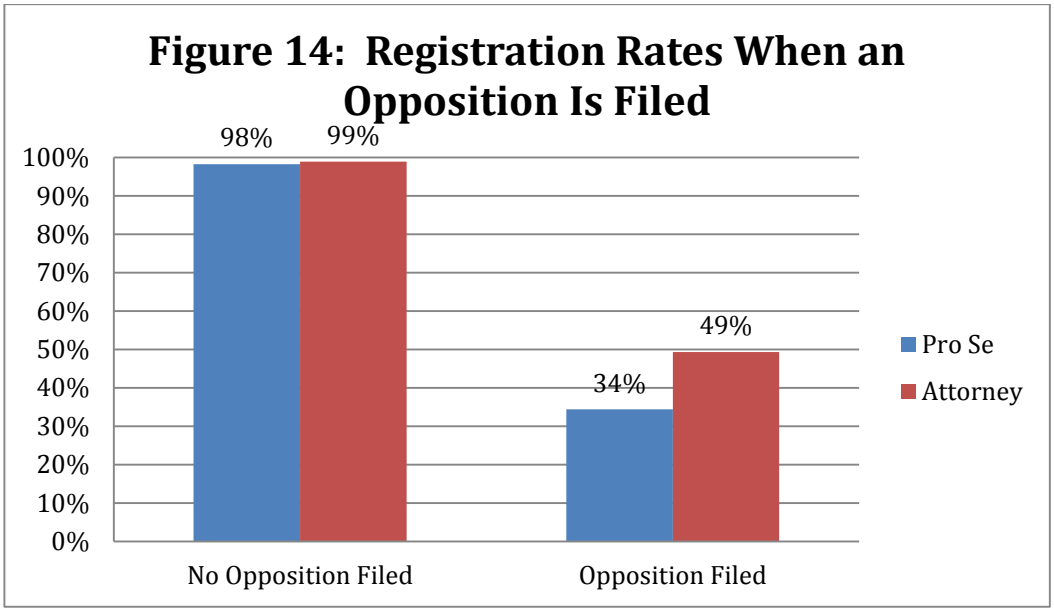
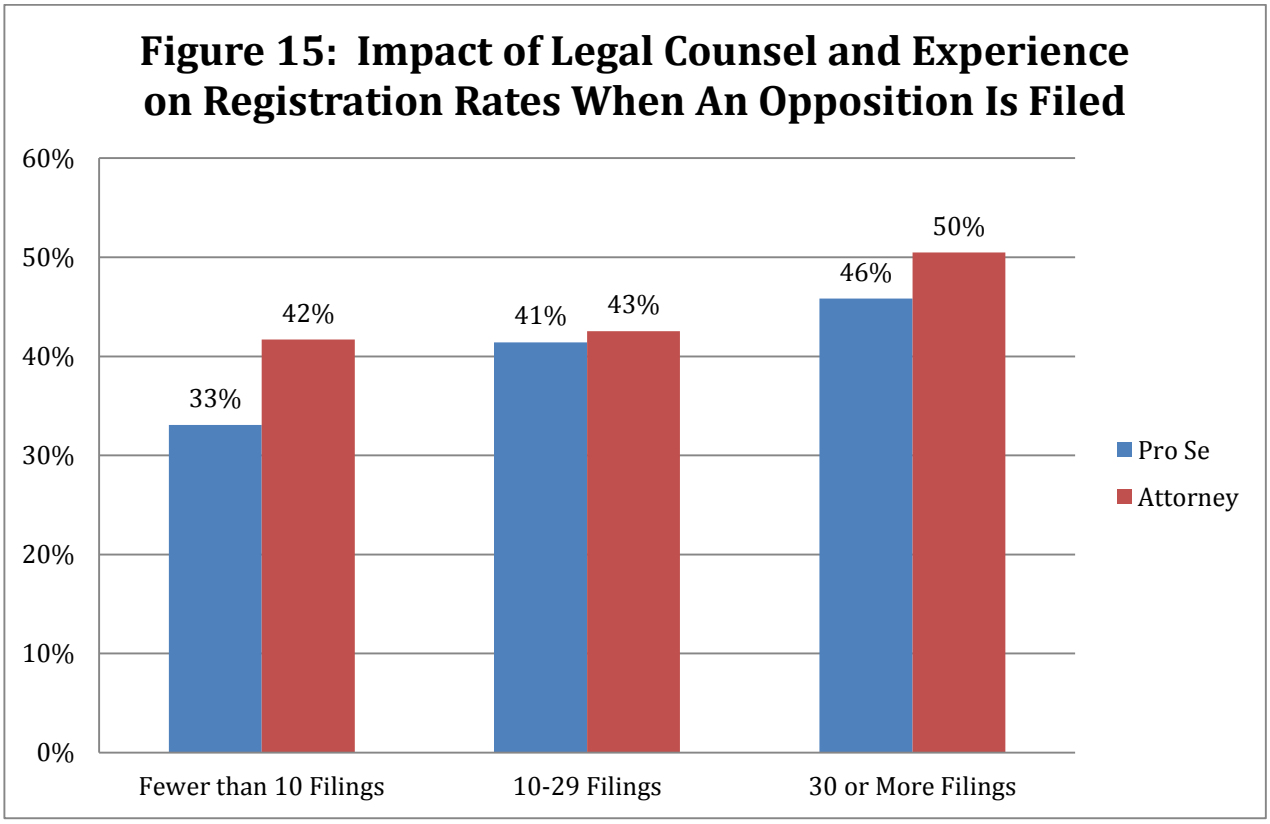


Figure 15 shows the data from Figure 14 in greater detail by displaying how experience and the presence of legal counsel affect registration rates in cases where an opposition is filed.



Opposition proceedings have a significant impact in reducing the likelihood that a mark will be registered. Again, we excluded data from ITU applications to illustrate the effect of opposition proceedings when the most frequent reason (not filing a statement of use) is not at issue.[86] Figure 15 illustrates another variation on themes observed earlier. Both experience and a law degree matter, and the data indicate that they matter more (as we saw earlier with office actions) in situations like opposition proceedings in which the application faces a barrier. Although they are not filed frequently, an opposition proceeding filed by a third party is often fatal to a trademark application—but having an experienced attorney defending the proceeding will increase the likelihood that the defense will be successful.

[86] The number of applications in each group is as follows: pro se applicants with fewer than 10 filings, 7,043; attorney applicants with fewer than 10 filings, 2,925; pro se applicants with 10-29 filings, 577; attorney applicants with 10-29 filings, 2,219; pro se applicants with 30 or more filings, 443; attorney applicants with 30 or more filings, 30,563.

IV. CONCLUSION

Trademark lawyers are not essential to prosecuting a successful trademark application, but they add value by significantly increasing the likelihood of success. On average, 42% of trademark applications filed by pro se applicants ultimately succeeded in admission to the Principal Register. The average attorney success rate is 60%. Publication rates provide a better measure of the effects of counsel, because they exclude the large number of abandoned intent to use marks. An application was 82% likely to publish if prosecuted by a lawyer, and 60% likely to publish if the applicant was pro se.

Another important conclusion is that experience correlates with success. One of the most significant and interesting findings in this study is that highly experienced pro se applicants provide equally satisfactory overall results. However, there are not many of them in the applicant pool, and given where they work, the extent to which they are genuinely pro se is an open question. Also, the typical trademark applicant is not likely to become an experienced pro se filer. That category is dominated by employees of large corporations with substantial resources (and probably lawyers) available to them. Most pro se applicants, by contrast, file no more than a handful of applications. Therefore, the small experienced pro se applicant pool tells us something about the potential for success but not the true story of how most pro se applications fare before the USPTO.

Most applicants fell into two categories: experienced lawyers and inexperienced pro se applicants. Overall, inexperienced pro se applicants were 50% more likely to succeed in registering their marks if they hired counsel. If an applicant confronted an obstacle in the registration process, hiring counsel made an even more significant difference. Most applicants had to overcome at least one office action before advancing to registration. When an office action was issued, inexperienced pro se applicants increased their chances of publication by 68% (30 percentage points) if they hired an experienced trademark lawyer. On rare occasions when an opposition proceeding was filed after publication, an inexperienced applicant who hired counsel increased its chances of registration by 52% (17 percentage points). When a proposed trademark is important to an inexperienced pro se applicant, hiring an attorney may significantly increase the likelihood of overcoming barriers in the process and obtaining a certificate of registration.