Insights: Publications

Survey Methodologies to Overcome “Failure To Function” Refusals in the U.S. Patent and Trademark Office

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"Whether a word, design, or color scheme functions as a mark is an empirical question, based necessarily on how relevant consumers perceive it. As the United States Patent and Trademark Office (“USPTO”) continues to ratchet up the frequency of “failure to function” refusals, trademark owners have struggled to present evidence sufficiently compelling to convince examining attorneys to withdraw those refusals. And the stakes can be high: unlike mere descriptiveness refusals, a failure-to-function refusal cannot be overcome by amending the Supplemental Register or claiming acquired distinctiveness through length of use. This article thus offers practical advice on how to design surveys—including both tried-and-true methods and an entirely new approach—that can provide empirical evidence showing whether an applied-for term[1] functions as a mark."

Related People



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