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THE UNITED STATES SUPPLEMENTAL REGISTER: SOLACE, SUBSTANCE, OR JUST EXTINCT?*

*By Anne Gilson LaLonde** and Jerome Gilson****

I. INTRODUCTION

This was my last chance. I had missed the target too many times, and I was tired of being laughed at. I carefully pulled back the band on the slingshot. All I had to do was hit the small wooden structure in just the right place. Then it would collapse dramatically and I would finally have killed every last one of the—

Suddenly, there was a sharp knock on my door. I yanked open the top drawer of my desk, threw my iPhone inside, then slammed it shut just as the door was flung wide. Molly York, managing partner, paused in the doorway, twisting her pearl necklace and glaring at me, as usual. She raised an eyebrow.

“That isn’t the Angry Birds theme music, is it, Ben?”

“What? No, it’s just a . . . relaxation app. Very soothing.”

“Ben, I can hear the birds squawking. My husband plays that game incessantly. I know what it sounds like.”

“No, that’s the, uh, aviary relaxation sound. . . . But I guess it does sound a little like Angry Birds, now that you mention it. That’s strange.”

Molly sighed. “Sue Ellen Hooper is here, Ben. I sent her the Office Action that refused her registration but I didn’t read it. Here’s a copy.” She thrust some papers onto my desk. “Not sure why she showed up instead of calling. Practicing law would be so much

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easier without clients. I'll have her sent in." She gave an evil grin. "Oh, I suggest you turn off your, uh, relaxation music before she gets here." She turned and flounced away.

I opened my desk and flipped my iPhone to silent, restraining myself from shooting one last red bird, then shuffled through the papers and skimmed the Office Action. "Refused registration under Section 2(d) of the Trademark Act . . . likelihood of confusion with existing registration . . . the cited registration is attached. . . ."

I was flipping back to look at the cited registration when Tammy knocked on my open door. "Mrs. Hooper here to see you, Ben."

Mrs. Hooper, a gray-haired, kindly-looking woman, entered the room, assisted by a metal cane. Tammy closed the door behind her as we shook hands and sat down.

"Mrs. Hooper, nice to meet you. I'm Ben Warner, an associate here at York, Sandalow and Griffin. I've only just gotten your case, and I was hoping you could tell me a bit about your business and your trademark application. Then we'll figure out how to handle this Office Action."

"Well, dear, it's nice to meet you too. I had been working with that Molly York woman, but she's a bit expensive and also isn't really one for calling people back. So once I saw this Office Action, I came right over to the office and asked to see someone with a lower billing rate."

"That would definitely be me, ma'am."

"Excellent. You see, young man, for a few years, I've made tasty dog treats at home in my kitchen. I've sold them around the neighborhood, and I must say they're very popular. But I always wanted to do something big. Have a real business with business cards and a website and a Twitter account and, goodness, even a federal trademark registration. So I developed a specialty line of baked goods for dogs." She ticked them off on her fingers. "Scones, muffins, croissants, baklava, petit fours, cream puffs, kolaches, soft pretzels, cannoli and rugelach. Each with plenty of bacon."

"Sure, sure. That sounds, ah, really good." I nodded slowly at Mrs. Hooper. "So, what is your trademark?"

She smiled broadly at me. "The Doggy Baconry."

"Oh. Right. That's, uh, cute. Baconry, bakery. I get it."

"Isn't it adorable? I don't understand what the problem is with getting it registered, though."

"Not sure. Let's take a look at the Office Action," I said. "The examining attorney refused registration because of this earlier registration. It's for DOGGY BACON for edible dog treats shaped

like bacon strips. . . . Wait, it looks like this other registration is on the supplemental register. Huh." I sat, thinking for a minute.

"Huh? Is that the extent of your legal analysis?" said Mrs. Hooper rather sharply.

"What? No. It's just that . . . the supplemental register is reserved for marks that aren't really marks, that don't indicate source. All they do is describe the goods or services. I didn't realize they could block applications for valid trademarks."

"Wait, you're saying that something that isn't actually a trademark can stop me from achieving my dream—my very own federal trademark registration?"

"That's pretty much the bottom line, yes, ma'am."

"Well, why are people allowed to get a registration in the first place for something that isn't a real trademark?"

"Uh" My eyes scanned the room as if there were an answer hidden somewhere in my posters of famous Internet cats. "Maybe so the Patent and Trademark Office can make some extra money?"

Mrs. Hooper shook her head at me and frowned. "That's just silly, Ben. So what are we going to do about it?"

This put-upon young associate has reason to be confused about the ability of a United States supplemental registration to block a principal registration. These "marks" that aren't trademarks at all have influence in the registration area as well as elsewhere. While some applicants opt for a supplemental registration as a consolation prize when faced with a descriptiveness refusal, it turns out that it is more than a second-rate registration. There's some power behind the supplemental register. Why?

II. THE CONUNDRUM OF THE SUPPLEMENTAL REGISTER

The concept of the United States supplemental register is, frankly, bizarre. Surprisingly, the United States Patent and Trademark Office (USPTO) administers a federal database of material that admittedly does not serve the most basic function of a trademark.

This function is prominently explained in chapter one in hornbooks, treatises and casebooks on the subject. Professors typically discuss it the first day of class in trademark law. When a company or individual chooses a trademark, it appears as a major item on the yes-or-no checklist.

It is *distinctiveness*.¹

1. See Anne Gilson LaLonde, 1 Gilson on Trademarks § 1.03 (LexisNexis/Matthew Bender) for more on trademark functions and rationales for protection and § 2.01 for a discussion of distinctiveness.

A trademark identifies the products of the trademark owner and enables consumers to distinguish those products from the products of others. It designates a particular source in the marketplace. In other words, it is distinctive. Consumers choose a single item from an overwhelming array in a store aisle because they know the trademark and trust its source. They often enter a trademark into a search engine rather than looking for the more general “handbags” or “watches” or “pickup trucks.” It’s a hugely valuable commodity, and a fundamental role of trademark law is to protect against consumer confusion as to source based on trademark distinctiveness. The United States also protects famous trademarks from dilution of their distinctiveness.²

However, terms and configurations registered on the United States supplemental register are, by definition, *not* distinctive. Terms in supplemental registrations are descriptive of the goods or services for which they are registered, describing the uses, characteristics, size or other components of those goods or services.³ SPEEDY for a delivery service, for example, would be descriptive, as well as BOUNCY for a rubber ball or CRUNCHY for peanut butter with chunks of intact peanuts. Product configurations, which can never be inherently distinctive, may be registered on the supplemental register even though they have not acquired distinctiveness.⁴ These simply *cannot* be trademarks because they do not designate source.

Material can be registered on the United States supplemental register if it is “capable” of source designation, even if it does not currently designate source. On the one hand, entry onto the supplemental register creates *no* substantive rights whatsoever. On the other hand, a supplemental registration can block registrations on the principal register, permits the use of the ® registration symbol, and may stop identical domain names from being registered. Paradoxically, a supplemental registration is “a registration which cannot be the source of any substantive rights to its owner but which can circumscribe the rights of [another].”⁵

We note that it is a struggle for the authors to call such material a “mark.” More accurate terms include potential mark, contingent mark, non-mark, anti-mark, faux-mark or pseudo-mark. However, the Lanham Act,⁶ the Trademark Trial and Appeal Board (“Board”) and the courts have turned a blind eye and

2. 15 U.S.C. § 1125(c). *See generally* 2 Gilson on Trademarks Chapter 5A on dilution law.

3. *See* 1 Gilson on Trademarks § 2.03 for more on descriptiveness.

4. *See* 1 Gilson on Trademarks § 2A.03 for more on trade dress distinctiveness.

5. Alfred Lee, *Cancellation of Supplemental Register Marks and Burden of Proof*, 43 TMR 248, 249 (1953).

6. Whenever we mention “the Act,” we are referring to the Lanham Act unless the context clearly indicates otherwise.

referred to the subject matter of the supplemental register as a *mark*.⁷ Confusing as it is, for ease of reference we will too. For the sake of succinctness, we will also shorten “principal register registration” to “principal registration” and “supplemental register registration” to “supplemental registration.”

In an attempt to unravel the mysteries of the supplemental register, this article will explore what can and cannot be registered, what motivated the creation of this second-cousin register, and what advantages and disadvantages a supplemental registration brings its owner. We will look at how effectively such a registration can be used as both a sword and a shield, and will conclude with some proposals for change.

III. SUPPLEMENTAL REGISTER BASICS

The United States has two federal trademark databases: the principal register and the supplemental register. The principal register is for marks “by which the goods of the applicant may be distinguished from the goods of others,”⁸ while the supplemental register is for “[a]ll marks capable of distinguishing applicant’s goods or services, and not registrable on the principal register”⁹

As of this writing, registrations on the supplemental register account for 3.9% of all registrations with the USPTO. Though current access to statistics is incomplete, for the years we do know, supplemental registrations accounted for a high of 11.9% in fiscal year 1951 and a low of 3% in fiscal year 1993.¹⁰

A. What Can Be Registered on the Supplemental Register

Section 23 of the Act establishes the supplemental register, and provides for registration of marks “capable of distinguishing applicant’s goods or services” but that cannot be registered on the principal register.¹¹ A broad range of material can be registered on the supplemental register: “any trademark, symbol, label, package,

7. *E.g.*, *In re Southern Belle Frozen Foods, Inc.*, 48 U.S.P.Q.2d 1849 (T.T.A.B. 1998) (stating that “the Act itself, the Board and the courts have consistently referred to the subject matter of a Supplemental Register registration as a ‘mark’”). The Federal Circuit did, once, take issue with this terminology. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1321 n.3 (C.C.P.A. 1981) (“It is, of course, anomalous that the Lanham Act speaks of registering a ‘trademark’ unless it is ‘merely descriptive.’ For if it is ‘merely descriptive,’ it is not a trademark, and this is so even though the user intends it to be a trademark.”).

8. 15 U.S.C. § 1052.

9. 15 U.S.C. § 1091(a).

10. For references and more statistics, see Part X.A *infra*.

11. 15 U.S.C. § 1091(a).

configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing . . .”¹² Exceptions to registration will be discussed in the next section.

The most common matter on the supplemental register is descriptive terms that lack acquired distinctiveness.¹³ This includes marks that are primarily merely a surname, laudatory terms, geographic terms and grade or quality designations. Trade dress that is not inherently distinctive and has not acquired distinctiveness may also be registered on the supplemental register.

Deceptively misdescriptive terms can be registered on the supplemental register,¹⁴ as may terms that are primarily geographically descriptive,¹⁵ as long as they are otherwise capable of distinguishing goods and services.¹⁶ Marks that are primarily geographically deceptively misdescriptive may be registered on the supplemental register only if they have “been in lawful use in commerce by the owner” since before December 8, 1993, the date of enactment of the North American Free Trade Implementation Act.¹⁷

Matter that would otherwise be unregistrable because it is incapable of distinctiveness may be displayed in a unique enough manner to allow for registration on the supplemental register. The Board has held that it is “well-established that ‘for a term otherwise unregistrable to be capable of distinguishing an applicant’s goods, the presentation of the term must be sufficiently striking, unique or distinctive so as to overcome its inherent

12. 15 U.S.C. § 1091(c).

13. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 n.9 (Fed. Cir. 2010) (“A descriptive term lacking secondary meaning may not appear on the Principal Register, but may appear on the Supplemental Register.”).

14. USPTO Trademark Manual of Examining Procedure (TMEP) § 1209.04 (“Marks that have been refused registration pursuant to § 2(e)(1) on the ground of deceptive misdescriptiveness may be registrable under § 2(f) upon a showing of acquired distinctiveness, or on the Supplemental Register if appropriate.”). Deceptively misdescriptive terms are not in fact deceptive. They misdescribe goods and services in a way that consumers are likely to believe is true. *See* 1 Gilson on Trademarks § 2.03[5].

15. TMEP § 1210.07(a) (“A term that is primarily geographically descriptive of the goods/services under § 2(e)(2) may be registered on the Supplemental Register, if it is not barred by other section(s) of the Act.”). *See* 1 Gilson on Trademarks § 2.03[4][c][i].

16. *See, e.g., In re Bee Pollen from Eng. Ltd.*, 219 U.S.P.Q. 163 (T.T.A.B. 1983) (holding that BEE POLLEN FROM ENGLAND “merely constitutes the name of the goods as well as an indication as to where the pollen comes from” and finding it unregistrable).

17. 15 U.S.C. § 1091(a). A trademark is primarily geographically deceptively misdescriptive if its primary significance is a generally known geographic location; consumers are likely to believe, incorrectly, that the place identified in the mark is the origin of the goods; and the misrepresentation was a material factor in the decision of a substantial portion of relevant consumers. *See* 1 Gilson on Trademarks § 3.04[6][a][iv][B].

incapacity and render the mark capable of serving as a source indicator.”¹⁸

For example, the Court of Customs and Patent Appeals (CCPA) (predecessor to the Federal Circuit Court of Appeals) reversed a refusal of registration of the following mark for hair conditioner and shampoo on the supplemental register even though the word itself was disclaimed:¹⁹

balsam

The applicant had disclaimed the apparently descriptive term “balsam.” In another case, the Board found that TRAIL R VAN was “the phonetic equivalent of a term that may, per se, be unregistrable” for applicant’s goods, which were truck bodies.²⁰ The mark as applied for associated those words “with a geometric design [and] create[d] a mark which possesses a degree of originality and uniqueness which . . . renders the mark as a whole capable of distinguishing applicant’s goods and therefore registrable on the Supplemental Register”:



18. *In re Cenveo Corp.*, 2009 TTAB LEXIS 615 (T.T.A.B. 2009) (not citable as precedent), quoting *In re Cosmetic Factory, Inc.*, 220 U.S.P.Q. 1103 (T.T.A.B. 1983). *Cf. In re Dakota Natural Foods, Inc.*, 2009 TTAB LEXIS 646 (T.T.A.B. 2009) (not citable as precedent) (“The board has indicated that for the stylization of the words in an otherwise descriptive mark to be registrable on the Principal Register the stylization must be more than simply a little different or unusual.”). *Cf. TMEP* § 807.14(e)(ii) (“Generic terms are incapable of functioning as marks denoting source, and are not registrable on the Principal Register under § 2(f) or on the Supplemental Register. However, if the generic wording appears in color lettering, the color portion may be capable of functioning as a source indicator.”).

19. *In re Wella Corp.*, 565 F.2d 143, 144 (C.C.P.A. 1977) (citing the mark’s “unique style”).

20. *In re Trail-R-Van, Inc.*, 188 U.S.P.Q. 590 (T.T.A.B. 1975).

The Board also allowed registration on the supplemental register of the following mark for candy bars, with the words “yogurt bar” disclaimed, noting that “whatever registrable rights applicant may have insofar as these words are concerned reside solely in applicant’s particular style of display of the words, and applicant has no proprietary rights whatsoever in the words per se”:²¹



The Board found, by contrast, that the following mark for “paperboard cardkeys made of environmentally friendly materials” lacked “the degree of stylization that would warrant placement on the Supplemental Register”:²²



And the following mark was refused registration on the supplemental register for undergarments:²³



Cases allowing registration of an otherwise generic term on the supplemental register based on mark stylization are rare, and the Board is likely to require disclaimer of the verbal part of the mark, making any protection very narrow indeed.

B. What Cannot Be Registered on the Supplemental Register

Generic terms cannot be registered on either register because they are *incapable* of serving as source identifiers.²⁴ Similarly,

21. *In re Carolyn's Candies Inc.*, 206 U.S.P.Q. 356 (T.T.A.B. 1980).

22. *In re Cenveo Corp.*, 2009 TTAB LEXIS 615 (the word “green” is in the color green and the word “key” is in brown).

23. *In re Bonni Keller Collections Ltd.*, 6 U.S.P.Q.2d 1224 (T.T.A.B. 1987) (“[I]t is our view that the presentation of applicant’s mark simply does not possess the degree of stylization necessary to warrant allowance on the Supplemental Register.”).

24. TMEP § 1209.01(c) (“Generic terms . . . are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under § 2(f) or on the Supplemental Register.”). See generally 1 Gilson on Trademarks § 2.02 for a discussion of generic terms and see also *In re Bush Bros. & Co.*, 884 F.2d 569, 573 (Fed. Cir.

purely ornamental matter and informational matter do not identify source, and thus cannot be registered on either register.²⁵ As a rule, if something cannot be registered on the principal register for a reason other than a lack of distinctiveness, it likely cannot be registered on the supplemental register either.

For instance, functional matter may not be registered on the principal or supplemental registers.²⁶ The Act was amended in 1998 to add “any matter that as a whole is not functional” to the types of marks that can be registered on the supplemental register,²⁷ although the USPTO and its reviewing courts had refused to register functional matter on either register long before the amendment made it official.²⁸ The USPTO and Federal Circuit undertake the same analysis of functionality for marks seeking registration on either the principal or supplemental register.²⁹

1989) (Bissell, J., concurring) (“In reality, a determination refusing registration on the supplemental register means that no amount of public recognition can ever make the mark registrable on the principal register.”).

25. TMEP §§ 1202.03(a) (“Matter that is purely ornamental or decorative does not function as a trademark and is unregistrable on either the Principal Register or the Supplemental Register.”), 1202.04 (“The applicant cannot overcome a refusal of trademark registration issued on the ground that the matter is merely informational by attempting to amend the application to seek registration on the Supplemental Register or pursuant to § 2(f).”).

But see In re Smith & Mehaffey, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994) (finding that mark on supplemental register that had been cited against applied-for mark in Section 2(d) rejection was not descriptive, but had been placed on the supplemental register because it was ornamental).

26. 15 U.S.C. § 1091(c); TMEP § 1202.02(a)(iii)(A) (“The determination that a proposed mark is functional constitutes, for public policy reasons, an absolute bar to registration on either the Principal or the Supplemental Register, regardless of evidence showing that the proposed mark has acquired distinctiveness.”).

E.g., *In re Armament Systems & Procedures, Inc.*, 2005 TTAB LEXIS 384 (T.T.A.B. 2005) (not citable as precedent) (upholding final refusal of registration on supplemental register for color red for law enforcement training equipment; “[A]pplicant’s proposed mark is functional and is thus incapable of registration on the Supplemental Register.”); *In re Visual Communications Co.*, 51 U.S.P.Q.2d 1141 (T.T.A.B. 1999) (not citable as precedent) (“[I]f applicant’s product designs are de jure functional, the proposed marks cannot be registered on either the Principal or the Supplemental Register.”); *In re Controls Corp. of Am.*, 46 U.S.P.Q.2d 1308 (T.T.A.B. 1998) (rejecting applicant’s claim that “registration on the Supplemental Register of a de jure functional configuration is permissible if the design is ‘capable’ of distinguishing applicant’s goods”).

27. Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, amending 15 U.S.C. § 1091(c).

28. *Kistner Concrete Prods. v. Contech Arch Techs., Inc.*, 97 U.S.P.Q.2d 1912 (T.T.A.B. 2011) (“In the past (and prior to the amendment to the statute), applications for product configurations sought to be registered on the Supplemental Register have been denied on the basis of functionality. . . . The amendment to Section 23(c) codified this practice, specifically providing that functional shapes are not registrable on the Supplemental Register.”); TMEP § 1202.02(a)(i) (“These amendments codified case law and the long-standing USPTO practice of refusing registration of functional matter.”).

29. *ERBE Elektromedizin GmbH v. Canady Tech. LLC*, 629 F.3d 1278 (Fed. Cir. 2010) (same legal principles apply to a determination of functionality whether on the principal register or supplemental register); *Kistner Concrete Prods.*, 97 U.S.P.Q.2d at 1914 n.2 &

This particular bar to registration suggests a statutory inconsistency. The Act provides that “applications for and registrations on the supplemental register shall not be subject to or receive the advantages of” several sections, including Section 2(e).³⁰ Section 2(e)(5) mandates that “any matter that, as a whole, is functional” cannot be registered on the principal register.³¹ In fact, applications for the supplemental register *are* subject to this requirement. Thus, 15 U.S.C. § 1094 should refer to “2(e)(1) through (4) inclusive” rather than “2(e).”

Deceptive matter and matter that falsely suggests a connection also may not be registered on either register.³² Matter that is deemed scandalous by the USPTO may not be registered either,³³ along with marks that consist of a flag, coat of arms, or insignia³⁴ and marks that consist of the name, portrait or signature of a living individual without his or her consent.³⁵ Further, trade names may not be registered on the supplemental register.³⁶

Finally, marks that are likely to cause confusion with those registered on either the principal or supplemental register, or with a mark or trade name previously used in the United States and not abandoned, are not registrable on either register.³⁷

1918 (“[T]he analysis of functionality under Section 2(e)(5) is relevant to a decision about the functionality under Section 23(c) of marks on the Supplemental Register [I]t is clear that the same legal principles and analysis apply to a determination of functionality, whether on the Principal Register or Supplemental Register.”).

30. 15 U.S.C. § 1094.

31. 15 U.S.C. § 1051(e).

32. 15 U.S.C. § 1052(a); TMEP §§ 1203.02(f)(ii) (“[M]arks that are deceptive under § 2(a) are never registrable on . . . the Supplemental Register.”); 1210.07(a) (geographically deceptive marks not registrable on the supplemental register); *In re Juleigh Jeans Sportswear Inc.*, 24 U.S.P.Q.2d 1694 (T.T.A.B. 1992) (LONDON LONDON geographically deceptive for clothing not made in London and unregistrable on supplemental register) (“[A] mark which falls within the prohibition of Section 2(a) is no more registrable on the Supplemental Register than it is on the Principal Register.”). See generally 1 Gilson on Trademarks § 3.04[6][a][iv]; Anne Gilson LaLonde, *You Aren’t Going to Believe This! Deception, Misdescription and Materiality in Trademark Law*, 102 TMR 883 (2012).

33. 15 U.S.C. § 1052(a); TMEP § 1203.01. See generally 1 Gilson on Trademarks § 3.04[6][a][i]; Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TMR 1476 (2011).

34. 15 U.S.C. § 1052(b); TMEP § 1204.04(a) (“Because § 2(b) provides an absolute bar to registration, a disclaimer of the prohibited flag or insignia or an amendment to seek registration under § 2(f) or on the Supplemental Register will not overcome a refusal.”).

35. 15 U.S.C. § 1052(c); TMEP § 1206 (“Section 2(c) absolutely bars the registration of these marks on either the Principal Register or the Supplemental Register.”).

36. TMEP § 1202.01 (“If the examining attorney determines that matter for which registration is requested is merely a trade name, registration must be refused both on the Principal Register and on the Supplemental Register.”).

37. 15 U.S.C. § 1052(d). TMEP § 1207 (“Section 2(d) applies regardless of whether registration of the mark is sought on the Principal Register or the Supplemental Register.”).

C. “Lawful Use” Requirement for Registration

When enacted in 1946, Section 23 required that a mark had to have been “in lawful use for the year preceding the filing of the application” in order to qualify for supplemental registration.³⁸ At the same time, however, it also allowed for a waiver of the one-year use requirement if the applicant had begun using its mark in foreign commerce and could show that it needed a domestic registration in order to obtain a foreign registration.³⁹ In 1962, Congress eliminated the obligation in the waiver request to show use in foreign commerce, and in 1988, to facilitate registration, Congress eliminated the one-year use requirement altogether.⁴⁰ Today, in order to be registered on the supplemental register, a mark must simply be “in lawful use in commerce by the owner thereof.”⁴¹

But is it really so simple? Unfortunately, no. As we shall see, despite the clear language of the Act, there is more to “lawful use in commerce” and even “use in commerce” than simply using the mark in interstate commerce.⁴² There is a lack of clarity and consistency in interpretations of “lawful use” both in the supplemental register context and out of it.

1. Foreign Applicants Need Not Show Use

First, though, we must note that not all applicants for the supplemental register need to show use. Section 44(e) allows an eligible foreign entity to base its U.S. supplemental register application on a registration in its home country, and “use in commerce shall not be required prior to registration.”⁴³ A foreign applicant that applies for the supplemental register pursuant to Section 44(d) based on a home country application need only allege

38. 15 U.S.C. § 1091 (since eliminated from the statute).

39. “Upon a proper showing by the applicant that he has begun the lawful use of his mark in foreign commerce and that he requires domestic registration as a basis for foreign protection of his mark, the Commissioner may waive the requirement of a full year’s use and may grant registration forthwith.” 15 U.S.C. § 1091 (now eliminated from the statute).

40. Pub. L. 87-772 (1962); Pub. L. 100-667 (1988). See Sen. Rep. No. 100-515, 100th Cong., 2d Sess., at 36 (“Eliminating the 1-year use requirement will facilitate registration on the supplemental register . . .”).

41. 15 U.S.C. § 1091.

42. See Richard L. Kirkpatrick, *The Supplemental Register Under the Trademark Law Revision Act: Additions, Deletions and Omissions*, 79 TMR 248, 256 (1989) (“The hidden meaning of ‘lawful’ [in Section 23] is a trap for the unwary.”).

43. 15 U.S.C. § 1126(e). Applicants filing with a Section 44(e) basis must have a country of origin that is party to a treaty or agreement with the U.S. that provides for registration based on ownership of a foreign registration or that extends reciprocal registration rights to nationals of the U.S. The applicant must also own a valid registration in its country of origin. 15 U.S.C. § 1126(b); TMEP § 1002.01.

a bona fide intention to use the mark in commerce in the United States.⁴⁴

2. “Lawful Use” Is “Exclusive Use” in Supplemental Register Context

In the world of the supplemental register, courts and the Board have generally—though not always—held that lawful use means exclusive or substantially exclusive use of the mark.⁴⁵ But how can the phrase “lawful use” reasonably be interpreted to mean “exclusive use”? Requiring a showing of “exclusive use” of descriptive terms or marks makes no sense.

The Act of 1920 preceded the supplemental register in the United States, similarly allowing for federal registration of matter that was merely capable of distinguishing goods and services.⁴⁶ Under that statute, an applicant had to have made “bona fide” use of its mark for at least a year before filing its application.⁴⁷ That requirement was interpreted to mean “use to the exclusion of others for at least one year preceding the date of the filing of the application.”⁴⁸ Because the supplemental register is a continuation of the Act of 1920 register, the Board deduced that “the

44. 15 U.S.C. § 1126(d). Applicants invoking Section 44(d) can obtain a priority filing date, but must have a separate basis for registration, such as Sections 44(e), 1(a), 1(b) or 23 (the supplemental register). To be eligible for a priority filing date under Section 44(d), the applicant's country of origin must be party to a treaty or agreement with the U.S. that provides for a right of priority or that extends reciprocal registration rights to nationals of the U.S. In addition, the foreign application that is the basis for the priority claim must be filed in such a country. 15 U.S.C. § 1126(b), (d); TMEP § 1002.02.

45. *E.g.*, *Moore Business Forms, Inc. v. Continu-Forms, Inc.*, 9 U.S.P.Q.2d 1907 (T.T.A.B. 1988) (“[O]n its face, Section 23 of the Lanham Act speaks in terms of ‘lawful use in commerce . . . for the year preceding the filing of the application,’ and not in terms of ‘exclusive use.’ However, the term ‘lawful’ in Section 23 has been interpreted to mean ‘exclusive.’”).

See also Walter J. Derenberg, *The Third Year of Administration of the Lanham Trade-Mark Act of 1946*, 40 TMR 914, 923 (1950) (“I submit that the word ‘lawful’ in section 23 of the 1946 Act should be construed to mean ‘substantially exclusive’ and that upon any proposed revision of the Lanham Act, these words should be substituted for ‘lawful.’”).

46. *See* Part IV.A *infra* for a full discussion of the Act of 1920.

47. Act of Mar. 19, 1920, ch. 104, § 1(b), 41 Stat. 534.

48. *Kwik-Kopy Franchise Corp. v. Dimensional Lithographers, Inc.*, 173 U.S.P.Q. 378 (T.T.A.B. 1972). *See also* *Automatic Washer Co. v. Easy Washing Machine Corp.*, 98 F. Supp. 445, 451 (N.D.N.Y. 1951) (same); *Fortune Tobacco Co. v. Axton-Fisher Co.*, 22 U.S.P.Q. 366 (Comm’r Pats. 1934) (“The cases are uniform in holding that ‘bona fide use’ must be interpreted to mean ‘exclusive use’ and that if anyone else can show use during the crucial period, even though that one may be a wrongdoer, the right to registration does not exist.”); *Bosch v. American Bosch Corp.*, 2 U.S.P.Q. 15 (Comm’r Pats. 1929) (“It is only when such a word is not being used by anyone other than its adopter and the latter uses it exclusively for a year that any trade-mark right arises under the 1920 Act. This ‘bona fide use’ must continue for a year before any trade-mark right is established or any right to exclude others can be asserted.”); Derenberg, *supra* note 45, at 923 (“[U]nder the Act of 1920 the words ‘bona fide use for not less than one year’ were interpreted to mean ‘exclusive’ use during such one-year period.”).

corresponding provisions of the two statutes must be similarly construed. Since 'bona fide' has been consistently interpreted to mean 'exclusive,' the term 'lawful' in Section 23 of the Act of 1946 must similarly be construed. . . ."⁴⁹

The interpretation of "bona fide" use in the Act of 1920 to mean "exclusive" use is strained at best. There is at least some excuse for that understanding of the law, however, as the requirement of "exclusive use" actually appeared in another section of the Act of 1920. If "the registrant was not entitled to the exclusive use of the mark at or since the date of his application for registration thereof," the Commissioner was to cancel its registration.⁵⁰ But there is no excuse for perpetuating that erroneous interpretation in the Lanham Act by requiring a finding that "lawful" means "exclusive." There is no suggestion whatsoever on the face of the Act that exclusive use is a condition for supplemental registration, and definitely not in the "lawful use" requirement.⁵¹

Despite the lack of a basis in the statutory text, supplemental registrations have been found to be invalid where the registrant had not used its mark exclusively.⁵² The Board and courts have resisted arguments that "lawful use" means anything other than "exclusive use" in the supplemental register context. When one plaintiff argued that the requirement of lawful use "should be interpreted to mean use . . . which is not violative of the law," a federal district court in California concluded that the plaintiff had

49. *Kwik-Kopy Franchise Corp.*, 173 U.S.P.Q. at 381.

50. Act of 1920, § 2.

51. Kirkpatrick, *supra* note 42, at 255 ("While one might reasonably think that 'lawful' means 'legal' or 'warranted or authorized by law,' as the dictionary defines it, for many years, the Board and the courts have construed 'lawful' to mean 'exclusive.'").

52. *E.g.*, *Loctite Corp. v. Nat'l Starch & Chem. Corp.*, 516 F. Supp. 190 (S.D.N.Y. 1981) (cancelling a mark on the supplemental register for failure to have made exclusive use of the term for the year before application); *Professional Econs. Inc. v. Prof'l Econ. Servs., Inc.*, 205 U.S.P.Q. 368 (T.T.A.B. 1979) ("In view of petitioner's use of its trade name 'PROFESSIONAL ECONOMICS INC.' in connection with services identical in kind to those rendered by registrant both prior to and contemporaneously with registrant's use of 'PROFESSIONAL ECONOMIC SERVICES,' and the substantial identity between these designations, registrant's mark obviously was not in 'lawful use' at the time of the filing of the application to register on the Supplemental Register.") (supplemental registration cancelled); *Szyferblatt Optical Machinery Co. v. Universal Shellac & Supply Co.*, 198 U.S.P.Q. 115 (T.T.A.B. 1978) (finding that registrant had not exercised the exclusive right to use its mark, so its supplemental registration was invalid); *Bruce Foods Corp. v. B. F. Trappey's Sons, Inc.*, 192 U.S.P.Q. 725 (T.T.A.B. 1976) (cancelling supplemental registration for failure to make exclusive use of mark); *Kwik-Kopy Franchise Corp.*, 173 U.S.P.Q. at 381 (canceling supplemental registration because respondent did not have exclusive use of its mark for its services for a year before its filing date).

Compare Coca-Cola Co. v. Clay, 133 U.S.P.Q. 606 (T.T.A.B. 1962) (dismissing petition to cancel supplemental registration) ("Under such circumstances and considering that it has not been made to appear that respondent's use of [its mark] during this time was not exclusive, it is believed that the mark . . . was in lawful use in commerce as alleged by respondent in its application.").

“failed to justify a departure from the statutory construction of Section 23 announced by the Court of Customs and Patent Appeals.”⁵³ And a respondent before the Board unsuccessfully argued that “lawful use” was not intended to mean “exclusive use” but instead meant use that was not infringing or did not violate federal, state or local statutes.⁵⁴

What type of use can defeat a claim of exclusivity? Such evidence need not be use only by the cancellation petitioner; it can be use by a third party.⁵⁵ That third-party use need not even be *trademark* use to serve as evidence that the registrant’s use is non-exclusive. For example, descriptive usage for the same goods and services will defeat a claim of exclusivity.⁵⁶ To complicate matters, there is some dispute over whether the standard is “exclusive use” or “substantially exclusive use.”⁵⁷

Various public policy reasons have been advanced for what is typically treated as a *de facto* Lanham Act amendment requiring exclusive use for registration on the supplemental register. First, under the Act of 1920, the Commissioner reasoned that having a one-year requirement of exclusive use would “create a presumption of secondary meaning that can be rebutted only by showing that the use during the crucial period was not exclusive.”⁵⁸ Thus, under this opinion, the Act of 1920 provided that “a year’s exclusive use of a descriptive mark will raise a presumption of secondary meaning sufficient for purposes of registration.” Plainly, though, the U.S. trademark system now requires a showing of five years of substantially exclusive use for even just *prima facie* evidence of secondary meaning,⁵⁹ making the one-year exclusivity requirement obsolete.

53. *Ajax Hardware Corp. v. Packaging Techniques, Inc.*, 182 U.S.P.Q. 559 (C.D. Cal. 1974).

54. *Bruce Foods Corp.*, 192 U.S.P.Q. at 727-28.

55. *Moore Business Forms*, 9 U.S.P.Q.2d at 1910 (“[R]egistrant’s claim of exclusive use can . . . be defeated by a showing that the term was utilized in conjunction with the relevant goods and services by a third party during the one year period.”).

56. *Id.* at 1909 (“[T]he limited authority on this issue indicates that at the very least, usage by the petitioner or a third party of the term in a prominent, descriptive manner in connection with the relevant goods or services during the one year incubation period would defeat the exclusive use requirement for a registration on the Supplemental Register.”).

57. *Eldon Indus., Inc. v. Rubbermaid, Inc.*, 735 F. Supp. 786, 794 n.7 (N.D. Ill. 1990) (“‘[E]xclusive use,’ rather than ‘substantially exclusive use,’ was the proper inquiry before the 1988 Act. All of the applicable authority supports such a reading. . . . Some cases had referred to a ‘substantially exclusive use’ standard, but only in the context of finding that even if it were the appropriate standard, it had not been satisfied on the facts. . . . They did not adopt a ‘substantially exclusive use’ standard.”); *Loctite Corp.*, 516 F. Supp. at 212 (“‘Lawful use’ has been interpreted to mean exclusive use, with some authority also for a standard of exclusive or substantially exclusive use.”) (finding that plaintiffs had neither exclusive nor substantially exclusive use of their mark) (citations omitted).

58. *Fortune Tobacco Co.*, 22 U.S.P.Q. at 369.

59. 15 U.S.C. § 1052(f).

Second, the Board in 1984 suggested that the exclusive use requirement prevents “descriptive terms which are in common use” from being registered on the supplemental register.⁶⁰ Thus, terms that describe a product may be registered so long as such registrations do not prevent others from using the same terms descriptively.⁶¹ But the owner of a supplemental registration would not be able to stop descriptive use of its mark by a third party anyway, so the exclusive use requirement is a fruitless one.

Third, the most cited reason for the exclusivity requirement is avoiding a clash with Section 2(f) of the Act. That section provides that “proof of substantially exclusive and continuous use . . . of a mark” for five years constitutes prima facie evidence that a mark has become distinctive in connection with an applicant’s goods.⁶² Walter Derenberg declared that “lawful” *had* to mean “exclusive,” or else an allegation of “lawful” use by a supplemental register applicant “would invariably defeat a claim of five years ‘substantially exclusive’ use by a registrant relying on section 2(f), if such year should coincide with the five-year period.”⁶³ A company making non-exclusive use of a descriptive term could obstruct a principal registration of another company that had used its mark essentially exclusively for five years. Derenberg called this a “rather anomalous result.” A federal district court echoed this argument, noting the anomaly that a supplemental registration without exclusive use could block registration of a conflicting principal register application even though the applicant under Section 2(f) claimed five years of substantially exclusive use.⁶⁴

This view does not, though, require ignoring the clear language of Section 23. If a supplemental registration prevents or invalidates a principal registration,⁶⁵ that result is no more

60. *In re State of the Art, Inc.*, 1984 TTAB LEXIS 4 (T.T.A.B. 1984) (“[D]escriptive terms which are in common use are unregistrable even on the Supplemental Register, for the goods or services which they describe, [in part] because the Section 23 requirement that a term sought to be registered on the Supplemental Register must have been in ‘lawful use in commerce’ . . . has been construed by this Board and other tribunals as requiring ‘exclusive use.’”).

61. *See Kwik-Kopy Franchise Corp.*, 173 U.S.P.Q. at 381 (“It would seem to be contrary to law to grant an owner of a Supplemental Register registration the right to sue a person for infringement when the person had a lawful right to use the merely descriptive term at the time the application for such registration was filed.”).

62. 15 U.S.C. § 1052(f).

63. Derenberg, *supra* note 45, at 923.

Professor Derenberg was an icon in the trademark law world, teaching at New York University Law School, practicing law in New York, and producing the trademark treatise that preceded *Gilson on Trademarks*. It was titled *Trade-Mark Protection and Unfair Trading*, published in 1936 by Matthew Bender. *Gilson on Trademarks* was also published by Matthew Bender, in 1974, as *Trademark Protection and Practice*.

64. *Ajax Hardware Corp.*, 182 U.S.P.Q. at 561.

65. *See* Part V.G *infra*.

illogical if the supplemental registration was based on non-exclusive use. In addition, deciding whether there is a likelihood of confusion between a supplemental registration and an application for the principal register does not and should not depend on whether there was exclusive use underpinning the supplemental registration.⁶⁶

Finally, despite the precedent supporting an exclusivity requirement, the Trademark Manual of Examining Procedure (TMEP) does not direct examining attorneys to require an applicant for supplemental registration to show it has made exclusive use of its mark. Instead, it focuses on whether the applicant has submitted an intent-to-use application for the supplemental register and has not filed an acceptable allegation of use.⁶⁷ The examining attorney is to withdraw the refusal “if the applicant submits an acceptable allegation of use.”⁶⁸ In other words, the USPTO’s position is that lawful use is no more than use in commerce,⁶⁹ the logical interpretation of the plain language of the Act.

Along those lines, a 2009 opinion of the Federal Circuit affirmed cancellation of a service mark on the supplemental register because it had not been used in commerce.⁷⁰ As with the TMEP, there was no mention of the word “lawful” or of a requirement of exclusive use. An opinion from the Ninth Circuit and one from the Board have also found supplemental registrations to be invalid where the registrant’s use violated a

66. See Kirkpatrick, *supra* note 42, at 263-64 (arguing that “there is no inherent conflict in this situation between section 2(f) and sections 23 and 24”).

67. TMEP § 815.02.

68. *Id.* See also TMEP § 1102.03 (“If an intent-to-use applicant requests registration on the Supplemental Register before filing an acceptable allegation of use, the examining attorney will refuse registration under § 23 of the Trademark Act . . . on the ground that the mark is not in lawful use in commerce. . . . The examining attorney will withdraw the refusal if the applicant submits an acceptable allegation of use.”).

69. See also, e.g., *Novartis Consumer Health, Inc. v. McNeil-PPC, Inc.*, 53 U.S.P.Q.2d 1406 (D.N.J. 1999) (“[T]o be registered on the Supplemental Register, a mark must be ‘in lawful use in commerce. . . .’ A bona fide intent to use the mark in commerce does not satisfy the ‘use in commerce’ requirement for registration on the Supplemental Register.”); *Southland Coffee Co. v. Choc-Café Sales Co.*, 124 U.S.P.Q. 386 (T.T.A.B. 1960) (“To be registrable on the Supplemental Register, a mark must . . . have been in lawful use in commerce upon or in connection with the goods for the year preceding the filing of the application for registration on this register. This clearly contemplates actual use in commerce which may be regulated by Congress and since respondent made no such use for more than one year prior to its amendment, respondent was not entitled, ex parte, to register its mark on the Supplemental Register.”).

70. *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1360 (Fed. Cir. 2009) (holding that “an applicant’s preparations to use a mark in commerce are insufficient to constitute use in commerce”).

federal regulation, the use being “unlawful” in the sense of illegal, with no discussion of an exclusivity requirement.⁷¹

3. Meaning of “Lawful Use” Outside Context of Supplemental Register

The statutory phrase “lawful use” is not interpreted to mean “exclusive use” outside of the context of the supplemental register.

a. “Use in Commerce” Means “Lawful Use”

Those applying under Section 1(a) for a principal registration must show that the mark “is in use in commerce.”⁷² Courts and the USPTO have interpreted this to require “lawful use in commerce”⁷³ and have held that use in commerce creates trademark rights only when it is *lawful use*.⁷⁴

“Lawful use” of a mark means, in part, compliance with relevant statutes,⁷⁵ one case citing “the well-reasoned proposition

71. *CreAgri, Inc. v. USANA Health Sci., Inc.*, 474 F.3d 626, 628 (9th Cir. 2007) (cancelling supplemental registration for failure to make lawful use); *In re Pepcom Indus., Inc.*, 192 U.S.P.Q. 400 (T.T.A.B. 1976) (affirming refusal to register on the supplemental register where specimen labels did not comply with the Federal Food, Drug and Cosmetic Act).

72. 15 U.S.C. § 1051(a)(3)(C).

73. *E.g.*, *Dessert Beauty, Inc. v. Fox*, 617 F. Supp. 2d 185, 190 (S.D.N.Y. 2007) (“The unlawful use defense—which has its origins in the common law doctrine of ‘unclean hands’—is therefore a way of preventing the government from having to extend the benefits of trademark protection to a seller who violates that government’s laws.”) (citation omitted); *Clorox Co. v. Armour-Dial, Inc.*, 214 U.S.P.Q. 850, 851 (T.T.A.B. 1982) (holding that “‘use in commerce’ means a ‘lawful use in commerce’”).

See also Iver P. Cooper, ‘Unclean Hands’ and ‘Unlawful Use in Commerce’: *Trademarks Adrift on the Regulatory Tide*, 71 TMR 38, 54 (1981) (“Wherever the Lanham Act says ‘use in commerce,’ one must read ‘lawful use in commerce.’”).

74. *E.g.*, *CreAgri, Inc.*, 474 F.3d at 628 (“In a contest involving competing products claiming trademark priority, . . . in order to acquire priority, a ‘use in commerce’ means a lawful use—here, a use compliant with federal labeling requirements.”); *In re Midwest Tennis & Track Co.*, 29 U.S.P.Q.2d 1386, n.2 (T.T.A.B. 1993) (“It is settled that the Trademark Act’s requirement of ‘use in commerce,’ means a ‘lawful use in commerce,’ and [that the sale or] the shipment of goods in violation of [a] federal statute . . . may not be recognized as the basis for establishing trademark rights.”) (citation omitted); *Coahoma Chem. Co. v. Smith*, 113 U.S.P.Q. 413 (Comm’r Pats. 1957) (holding that “use of a mark in connection with unlawful shipments in interstate commerce is not use of a mark in commerce which the Patent Office may recognize” and ordering cancellation of registrations where shipments using the registered mark violated the Federal Economic Poisons Act), *aff’d*, 264 F.2d 916 (C.C.P.A. 1959).

75. *E.g.*, *Facial Aesthetic Ctr. of Excellence Grp., Inc. v. Stewart Wang, M.D., Inc.*, 2006 TTAB LEXIS 471 (T.T.A.B. 2006) (not citable as precedent) (interpreting “lawful use” of mark as use of the mark in compliance with the California Business & Professions Code); *Clorox Co.*, 214 U.S.P.Q. at 851 (holding that applicant’s affirmative defense against opposer was valid where it claimed opposer’s prior use was not a lawful use in commerce because it failed to label ingredients in violation of the Federal Food, Drug and Cosmetic Act); *In re Pepcom Indus.*, 192 U.S.P.Q. at 401 (affirming refusal to register on the supplemental register where specimen labels did not comply with the Federal Food, Drug

that shipping goods in violation of federal law cannot qualify as the ‘use in commerce’ necessary to establish trademark rights.”⁷⁶ The USPTO may refuse registration on either register when the federal government regulates the sale or transportation of a product for which registration is sought and the applicant is not in compliance. Trademark Rule of Practice 2.69 expressly provides: “When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.”⁷⁷ Where there is noncompliance in such a case, the commerce is seen as unlawful and the mark is therefore unregistrable.⁷⁸ Before 1992, the USPTO had “routinely made inquiries concerning compliance with certain federal laws, such as laws governing the labeling of foods, drugs and cosmetics,” but changed its policy that year to inquire only when there was a finding of noncompliance or there was a *per se* statutory violation.⁷⁹

and Cosmetic Act) (“In order for the application to have a valid basis that could properly result in a registration, the use of the mark had to be lawful, i.e., the sale or shipment of the product under the mark had to comply with all applicable laws and regulations. If this test is not met, the use of the mark fails to create any rights that can be recognized by a Federal registration.”).

76. *United Phosphorus, Ltd. v. Midland Fumigant, Inc.*, 205 F.3d 1219, 1225 (10th Cir. 2000) (holding that, in order to obtain rights in a mark, the mark owner needs to show that “the name was lawfully used in commerce”) (defendant failed to present evidence that plaintiff’s product was sold or distributed illegally).

77. 37 C.F.R. § 2.69.

78. TMEP § 907 (“Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark.”). *See also* *Institut National Des Appellations d’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875 (T.T.A.B. 1998) (“Trademark Rule 2.69 is not, in itself, a statutory ground of opposition. It merely authorizes the Trademark Examining Attorney to make inquiry, in certain circumstances, regarding the applicant’s compliance with other laws in order to determine whether applicant’s use of the mark is lawful use in commerce, under Trademark Act Section 1. . .”).

79. *General Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270 (T.T.A.B. 1992) (“The Office will discontinue making such inquiries on a routine basis.”). *See* TMEP § 907 (If a court or federal agency has found noncompliance with the federal statute or if there is a *per se* violation of the statute, the examining attorney has to inquire of the applicant about its compliance or refuse registration based on an absence of lawful use in commerce) (directing that, if the trademark is used in connection with the sale or transportation of a controlled substance such as drugs or drug paraphernalia, the examining attorney must inquire as to whether the use of the mark is lawful and refuse registration if it is not).

See also *ZAO Gruppa Predpriyatij Ost v. Vosk Int’l Co.*, 2011 TTAB LEXIS 240 (T.T.A.B. 2011) (not citable as precedent) (“Due to a proliferation of federal regulatory acts in recent years, there is now an almost endless number of such acts which the Board might in the future be compelled to interpret in order to determine whether a particular use in commerce is lawful. Inasmuch as we have little or no familiarity with most of these acts, there is a serious question as to the advisability of our attempting to adjudicate whether a party’s use in commerce is in compliance with the particular regulatory act or acts which may be applicable thereto.”); *Automedx, Inc. v. Artivent Corp.*, 95 U.S.P.Q.2d 1976 (T.T.A.B.

For the USPTO, “unlawful use” also signifies unauthorized use of material specifically covered by statute. Examining attorneys are directed to refuse registration “on the ground that the mark is not in lawful use in commerce” of applications to register the Red Crescent, the Third Protocol Emblem, matter related to the Olympics or the United States Olympic Committee, the Red Cross emblem and other such matter. Only parties authorized by statute may use such insignia.⁸⁰ The TMEP states that, “[b]ecause ‘use in commerce’ under the Trademark Act means ‘lawful use in commerce,’ any intended use of the mark serving as the basis for these types of applications must also be lawful.”⁸¹ In addition, the Federal Circuit found it unlawful use for a mark owner to use a mark that was the subject of an injunction from a federal district court.⁸²

Reading “lawful” into “use in commerce” is an interpretation not found in the Act, but instead has been developed by the courts and the USPTO.⁸³ As the Board stated in 1968:

It is true . . . that there is no reference to “lawful commerce” in Section 1 of the trademark statute which provides that the

2010) (“Determining whether the use of a mark is lawful under one or more of the myriad of regulatory acts involves two questions: (1) whether a court or government agency having competent jurisdiction under the statute involved has previously determined that party is not in compliance with the relevant statute; or (2) whether there is a per se violation of a statute regulating the sale of a party’s goods.”).

80. See generally TMEP §§ 1205 (“Refusal on Basis of Matter Protected by Statute or Convention”), 1205.01(a)(i) (Red Crescent and Third Protocol), 1205.01(b)(v) (Olympic-related matter), 1205.01(c)(1) (Red Cross), 1205(d)(1) (Swiss Confederation Coat of Arms or flag).

For a listing of the many federal statutes protecting names, characters and designs, see 6 Gilson on Trademarks Appendix 4.

See also *In re Kappa Alpha Order*, 2011 TTAB LEXIS 191 (T.T.A.B. 2011) (not citable as precedent) (determining that applied-for mark did not violate the Red Cross statute; “Applicant’s use of the mark therefore is not unlawful use.”); *United States Olympic Comm. v. O-M Bread, Inc.*, 29 U.S.P.Q.2d 1555 (T.T.A.B. 1993) (finding mark OLYMPIC KIDS to violate the Amateur Sports Act and “the use/constructive use of the mark is therefore not lawful use in commerce.”); *In re Midwest Tennis & Track Co.*, 29 U.S.P.Q.2d at 1386 (refusing registration on ground that applicant’s mark “may not be lawfully used in commerce for its goods because the use thereof constitutes a prohibited simulation of the word ‘Olympic’” and “the registration of applicant’s mark would be contrary to the lawful use in commerce requirement imposed by Sections 1 and 45 of the Trademark Act”).

81. TMEP § 1205.01(a)(iii) (“With respect to a mark containing the Red Crescent, the Third Protocol Emblem, or the designation ‘Red Crescent’ or ‘Third Protocol Emblem,’ actual lawful use in commerce is not possible and thus there can be no bona fide intent to lawfully use the mark in commerce.”).

82. *Ultracashmere House, Ltd. v. Springs Mills, Inc.*, 828 F.2d 1580 (Fed. Cir. 1987).

83. *ZAO Gruppa Predpriyatij Ost*, 2011 TTAB LEXIS 240 (“The lawful use doctrine is based on the USPTO’s own interpretation of the requirement that a mark be used in commerce . . .”); *W. Worldwide Enters. Gp. v. Qinqdao Brewery*, 17 U.S.P.Q.2d 1137 (T.T.A.B. 1990) (“The ‘lawful use’ in commerce doctrine is based solely upon the U.S. Patent and Trademark Office’s interpretation of the use in commerce requirement of the Act, as necessitating use in compliance with the other Acts of Congress.”).

owner of a trademark *used in commerce* may register his mark on the Principal Register It seems evident that the term “commerce” whenever and wherever used in the trademark statute must necessarily refer to “lawful commerce”; and that the statute was not intended to recognize under its registration provisions shipments in commerce in contravention of other regulatory acts promulgated under the “commerce clause” of the Constitution. To hold otherwise would be to place the Patent Office in the anomalous position of accepting as a basis for registration a shipment in commerce which is unlawful under a statute specifically controlling the flow of such goods in commerce.⁸⁴

In the case where the lawful use requirement appears to have originated, the Commissioner of Patents reasoned: “May property rights be acquired as a result of unlawful acts? The obvious answer to the question in its simplified form is in the negative.”⁸⁵

The “illegal use” bar is rarely invoked and only occasionally successful. The Board stated in 2011: “In sum, while the illegal use doctrine remains the law, it has been interpreted very narrowly, and in practice, it has not been successfully invoked in a reported (or, as near as we can tell, unreported) Board case for at least thirty years.”⁸⁶ However, federal courts have taken

84. *In re Stellar Int'l, Inc.*, 159 U.S.P.Q. 48, 51 (T.T.A.B. 1968) (emphasis in original). See also *CreAgri, Inc.*, 474 F.3d at 630 (“The rationale for this rule is twofold. First, as a logical matter, to hold otherwise would be to put the government in the ‘anomalous position’ of extending the benefits of trademark protection to a seller based upon actions the seller took in violation of that government’s own laws. . . . Second, as a policy matter, to give trademark priority to a seller who rushes to market without taking care to carefully comply with the relevant regulations would be to reward the hasty at the expense of the diligent.”).

85. *Coahoma Chem. Co.*, 113 U.S.P.Q. at 418.

The Board has recognized that “[a] very persuasive argument can be made for the proposition that there is in fact no statutory basis for refusing to grant a registration, or for cancelling a subsisting registration, on the ground of ‘unlawful use,’ i.e., use of the mark in connection with goods/services which may not lawfully be shipped/performed in commerce because they are not in compliance with some federal regulatory act pertaining thereto” *Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, 209 U.S.P.Q. 958 (T.T.A.B. 1981). It also noted that the term “lawful” is used in some sections of the Act but not in Section 1, thus “the suggestion that this term should be read into those sections where it is not used would appear to be a violation of the basic rules of statutory construction.” *Id.* Nevertheless, that opinion found that the Board has continued to follow the doctrine for public policy reasons and tacit approval of the doctrine by the CCPA, when it did not contradict a ruling canceling registrations based on unlawful use. *Coahoma Chem. Co.*, 113 U.S.P.Q. at 418.

86. *ZAO Gruppya Predpriyatij Ost*, 2011 TTAB LEXIS 240.

up the doctrine, cancelling registrations⁸⁷ and finding a lack of priority⁸⁸ on the basis of unlawful use.

b. Other Mentions of “Lawful Use” in the Lanham Act

The Act mentions “lawful use in commerce” in two contexts apart from the supplemental register. The first is in the concurrent use context. Typically, principal registration of a mark gives the registrant nationwide protection. As an exception, in concurrent use proceedings, the Board determines whether applicants and registrants are entitled to simultaneous registration of the same mark when their use will not result in confusion. This results in restricted registrations that co-exist with the rights of other parties.⁸⁹ (Applications for registration on the supplemental register are not subject to concurrent use proceedings.⁹⁰) The Act declares that concurrent registrations will be issued only to those who “have become entitled to use such marks as a result of their concurrent lawful use in commerce” before the earliest filing date of any other registrations or pending applications for the mark.⁹¹ While the resulting registration typically gives each party exclusive rights to use the mark in different geographic areas, “lawful use” is generally taken to mean innocent local use.⁹²

87. *E.g.*, *CreAgri, Inc.*, 474 F.3d at 628 (cancelling supplemental registration for labeling violation).

88. *GoClear LLC v. Target Corp.*, 2009 U.S. Dist. LEXIS 6649 (N.D. Cal. 2009) (counterclaim for cancellation dismissed where counterclaimant’s predecessor had sold its product in violation of the Federal Food, Drug and Cosmetic Act).

89. See 3 Gilson on Trademarks § 9.01[2][a][iii] for more on concurrent use proceedings.

90. 15 U.S.C. § 1094; 37 C.F.R. § 2.99(g).

91. 15 U.S.C. § 1052(d). *See, e.g.*, *Gray v. Daffy Dan’s Bargaintown*, 823 F.2d 522, 526 (Fed. Cir. 1987) (“A valid application cannot be filed at all for registration of a mark without ‘lawful use in commerce,’ and, where a claim is made of concurrent rights, such use must begin prior to the filing date of any application by a conflicting claimant to the mark.”).

92. *Action Temporary Servs., Inc. v. Labor Force, Inc.*, 870 F.2d 1563, 1566 (Fed. Cir. 1989) (adoption of a mark without notice of another party’s rights is lawful use); *Bright Beginnings, Inc. v. Care Comm, Inc.*, 30 U.S.P.Q.2d 1712 (C.D. Cal. 1994) (“In order to be entitled to concurrent registration, the junior user must be a good-faith remote junior user. 15 U.S.C.S. § 1052(d) permits concurrent registrations only for ‘lawful users.’ . . . [I]n order for a junior user to be a ‘lawful user,’ he must have adopted the mark in good faith in an area remote to the senior user.”); *Nutrition Care Sys., Inc. v. NCS HealthCare, Inc.*, 2002 TTAB LEXIS 403 (T.T.A.B. 2002) (not citable as precedent) (“We have no reason to assume that this was other than an innocent use without notice of registrant’s use and activity under the . . . marks. Thus, the jurisdictional requirement of ‘lawful use in commerce’ . . . is satisfied.”); *My Aching Back, Inc. v. Klugman*, 6 U.S.P.Q.2d 1892 (T.T.A.B. 1988) (holding that the applicant cannot be considered a lawful concurrent user because when it began use of the mark “it had constructive notice of use of the identical mark for virtually identical services by another party”).

See also Miles J. Alexander & James H. Coil III, *Geographic Rights in Trademarks and Service Marks*, 68 TMR 101, 115-16 (1978) (“Before a concurrent registration will issue, the junior user must satisfy several requirements[, including that] . . . the concurrent use in

Registration will be refused if the application indicates that the applicant “adopted and used the mark with knowledge of the superior rights of a person specified as an excepted user.”⁹³

Second, the Act provides a safe harbor in cyberspiracy cases, ensuring that a court cannot find bad faith intent if the domain name registrant “believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.”⁹⁴ There, “lawful” means having legitimate grounds for registration of the mark, negating a bad faith intention. Thus, for example where a defendant registered a domain name for use in its own legitimate business and was unaware of plaintiff’s mark, it was eligible for the safe harbor,⁹⁵ as was the owner of a parody web site who “could have reasonably believed that the use of the domain names was legal” under the Act.⁹⁶

D. Filing Date

The filing date of an application for the supplemental register is its actual filing date with the USPTO *except* where the applicant has amended an intent-to-use application to the supplemental register.⁹⁷ In that case, the effective filing date will be the date that the amendment to allege use or the statement of use was filed.⁹⁸ When this change in filing date occurs, the examining attorney must conduct a new search for potentially conflicting marks.⁹⁹

the period prior to the date of the senior user’s application was ‘lawful,’ which at the very least means in good faith and non-infringing. . . .”).

But see Fleming Cos. v. Thriftway, Inc., 809 F. Supp. 38, 42 (S.D. Ohio 1992) (“A ‘lawful use’ is the use of a mark in connection with goods or services in a territory not covered by another party’s registration.”).

93. TMEP § 1207.04(e).

94. 15 U.S.C. § 1125(d)(1)(B)(ii). *See* 2 Gilson on Trademarks § 7A.06[1][c][xi].

95. Pure Imagination, Inc. v. Pure Imagination Studios, Inc., 2004 U.S. Dist. LEXIS 23064 (N.D. Ill. 2004).

96. Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research, 527 F.3d 1045 (10th Cir. 2008).

97. TMEP § 201.01.

98. 37 C.F.R. § 2.75(b) (“An application under section 1(b) of the Act may be amended to change the application to a different register only after submission of an acceptable amendment to allege use under § 2.76 or statement of use under § 2.88. When such an application is changed from the Principal Register to the Supplemental Register, the effective filing date of the application is the date of the filing of the allegation of use under section 1(c) or 1(d) of the Act.”); TMEP §§ 206.01, 815.02, 816.02, 1102.03. *See In re Software Publishers Ass’n*, 69 U.S.P.Q.2d 2009 (T.T.A.B. 2003) (“Because of applicant’s amendment to the Supplemental Register, the effective filing date of this application becomes the date applicant amended to the Supplemental Register after filing an acceptable amendment to allege use.”).

99. TMEP § 1102.03.

IV. RATIONALE BEHIND THE SUPPLEMENTAL REGISTER

Now that we have gone over what can be registered on the supplemental register, we can ask the big question: Why did Congress bother creating one federal register for actual, functioning trademarks and another for terms, configurations and symbols that do not perform the main functions of a trademark? Why spend federal funds examining, registering and maintaining a list of “trademarks” that are not really trademarks at all?

The answer, nowhere to be found in the Act itself, is an anachronism. The intent was to enable U.S. companies in practically the dark ages to register their trademarks in other countries.

A. The Trade-Mark Act of 1920

Almost a century ago, Congress passed the law that was a forerunner of today’s supplemental register. The U.S. Trade-Mark Act of 1920¹⁰⁰ was that precursor.¹⁰¹ Section 23 of the Lanham Act harkens back, explicitly stating that today’s supplemental register is “a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920”¹⁰² In some foreign countries, as one authoritative commentator explained,

domestic registration was a condition precedent to local registration, and, in some of these, local registration was requisite to doing business. The Act of 1920 was passed to cure this problem for the users of marks not registrable under the 1905 Act due to that Act’s descriptiveness or name prohibitions. The 1920 Act afforded registrability for virtually anything that could be said to distinguish one’s goods if it had been used as such in commerce for one year¹⁰³

Thus, the Act of 1920 was intended to help U.S. companies obtain trademark protection internationally.¹⁰⁴

100. Act of Mar. 19, 1920, ch. 104, 41 Stat. 534.

101. See, e.g., *Clairol, Inc. v. Gillette Co.*, 389 F.2d 264, 267 (2d Cir. 1968) (“The Supplemental Register was established by Section 23 of the Lanham Act . . . as a continuation of the register provided for in section 1(b) of the Trademark Act of March 19, 1920.”).

102. 15 U.S.C. § 1091(a).

103. Beverly W. Pattishall, *Two Hundred Years of American Trademark Law*, 68 TMR 121, 136 (1978) (footnote omitted). See also Saul Lefkowitz, *I Remember It Well—I Think!* 79 TMR 395, 411 (1989) (“[G]eographic or descriptive marks, surnames, and other technically defective marks were registrable under this Act provided the one-year use requirement was met.”). Registration under the Act of 1920 required “bona fide use for not less than one year in interstate or foreign commerce.” Trade-Mark Act of 1920, § 1(b).

104. *Clairol, Inc.*, 389 F.2d at 267 (“The Act of 1920 was for the purpose of enabling persons in this country to register trademarks so that they might obtain registration under the laws of foreign countries.”). See also, e.g., Donald S. Chisum, *Trademark Acquisition*,

The legislative history for the Act of 1920 further explains the historical underpinnings from which the supplemental register has come unmoored:

This legislation has no effect on the domestic rights of any one. It is simply for the purpose of enabling manufacturers to register their trade-marks in this country for the purpose of complying with legislation in foreign countries, which necessitates registration in the United States as a necessary preliminary for such foreign registration. As the [pre-1920] law now stands, it enables trade-mark pirates in foreign countries to register as trade-marks the names and marks of the American manufacturers, and thus levy blackmail upon them.¹⁰⁵

Registration under that Act did not “create any substantive rights in the registrant.”¹⁰⁶ For example, it did not provide prima facie evidence of ownership.¹⁰⁷ Curiously, the 1920 law created federal jurisdiction to enforce such marks and provided for remedies for infringement.¹⁰⁸ The Act did not even require material to be

Registration and Maintenance: A Primer, 19 AIPLA Q.J. 123, 166 (1991) (“The ‘Supplemental Register’ is a continuation of the register the 1920 Trademark Act established to enable United States trademark owners to pursue protection in other countries.”); Russell L. Law & Philip D. Junkins, *Registrability of Packages and Configurations of Goods on the Supplemental Register: Design Patent vs. Trademark Protection*, 45 TMR 22, 29 (1955) (“[B]y its terms, Section 23 was to provide a continuation of certain provisions of the Act of 1920, whereby non-technical trade-marks were deemed registrable for the principal purpose of assisting citizen owners in enforcing their rights in foreign countries.”) (footnote omitted).

Cf. Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315, 323 (1938) (The Act of 1920 “was enacted to enable American and foreign users of trademarks to register them in accordance with the provisions of the convention for the protection of trade-marks and commercial names, signed at Buenos Aires in 1910.”).

105. Report No. 432, 66th Cong., 2d Sess. (1920), *quoted in* Charles Broadway Rouss, *Inc. v. Winchester Co.*, 300 F. 706, 714 (2d Cir. 1924).

106. *Armstrong Paint*, 305 U.S. at 322. *See also* Lefkowitz, *supra* note 103, at 411 (“A registration under the Act of 1920 received no respect. The registration did not bestow upon the registrant any presumption of ownership of the registered mark and, in effect, conferred no substantive rights.”); Pattishall, *supra* note 103, at 136 (“Act of 1920 registration provided little actual benefit, . . . other than access to the federal courts and the right to display notice of registration with the mark.”).

107. *Charles Broadway Rouss, Inc.*, 300 F. at 712 (“Whatever may be the rights of the plaintiff acquired by its registration of the words . . . under the act of 1920, we are satisfied that it did not obtain thereby even a prima facie title to the words as a trade-mark or trade-name.”).

108. Trade-Mark Act of 1920, § 2 (providing for cancellation of registrations); § 3 (liability for willful “false designation of origin”); § 4 (liability and damages for reproducing, counterfeiting or colorably imitating marks registered under the Act). *See also Armstrong Paint*, 305 U.S. at 324 (finding courts to have jurisdiction over marks registered under the Act of 1920 despite the potential invalidity of those marks) and at 333 (Registration of marks under the Act of 1920 did not confer substantive rights in those marks but it did “permit suits in the federal courts to protect rights otherwise acquired in the marks.”).

capable of distinguishing goods or services to be registered, though fortunately the USPTO did.¹⁰⁹

B. Lanham Act Legislative History

The legislative history of the Lanham Act and the Trademark Law Revision Act of 1988 echo the fact that the supplemental register was created to extend the ability of U.S. citizens to register their marks in foreign countries.¹¹⁰ However, not all legislators favored registration of such matter.

To be registered on the supplemental register, “a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing . . .”¹¹¹ Prominent Representative Edward Rogers, one of the architects of the Lanham Act, in the original hearings on the supplemental register noted that the extremely inclusive language “was used to embrace every kind of trademark subject matter in foreign countries. The primary purpose of this supplemental register is to get registration abroad and in countries where a domestic registration is required and configuration of goods is there regarded as trademark subject matter . . .”¹¹² The reason for including configuration of goods

109. Lefkowitz, *supra* note 103, at 411 (“There was no provision in the Act that the designation sought to be registered must be capable of distinguishing the goods, but this requirement was read into the Act by the USPTO.”). See, e.g., *Ex parte* Heir Brothers, Inc., 67 U.S.P.Q. 329 (Comm’r Pats. 1945) (“As the [proposed mark], standing alone, is obviously incapable of trade mark significance in relation to applicant’s goods, it is not registrable as a trade mark even under the Act of 1920.”).

110. *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1454-55 n.2 (9th Cir. 1985) (“The legislative history of the Lanham Act reveals that one of Congress’ major purposes was to aid in enforcement of trademark rights in foreign countries where statutory registration was a prerequisite for enforcement. . . . The supplemental register was created to fulfill this purpose.”); Derenberg, *supra* note 45, at 934-35 (The “main purpose” of the supplemental register “was to provide a basis for foreign registration in those countries in which registration cannot be obtained without proof of previous registration in the country of origin.”).

111. 15 U.S.C. § 1091(c).

By contrast, the Act defines “trademark” as “any word, name, symbol, or device, or any combination thereof” used to identify and distinguish goods. 15 U.S.C. § 1127. For interesting commentary on this difference in language, see Glynn S. Lunney, Jr., *The Trade Dress Emperor’s New Clothes: Why Trade Dress Does Not Belong on the Principal Register*, 51 *Hastings L.J.* 1131, 1134 (2000) (“Any legitimate and serious reading of the Trademark Act of 1946 and its accompanying legislative history will reveal that Congress intended to exclude trade dress from the principal register and relegate it exclusively to the supplemental register.”).

112. Hearings on H.R. 9041 Before the Subcommittee on Trademarks of the House Committee on Patents, 75th Cong., 3d Sess. 180 (1938), *reprinted in* 8 *Gilson on Trademarks* 23-4. Representative Rogers goes on to say that inclusion of the configuration of goods is “100 percent” “for the benefit of exporters carrying on foreign trade in foreign countries.”

explicitly in the supplemental register provision was that other countries “regard . . . as trade-mark subject-matter things that we consider designs. . . . We have carefully gone through foreign laws and have culled from these various statutes what they regard as trade-mark subject matter, to enable exporters to take advantage of and to get the needed protection in those countries.”¹¹³ Now that it is somewhat easier to obtain a principal registration for configuration marks, the role of the supplemental register is less important.¹¹⁴

Legislators expressed concern over the potential for these registrations to block another party’s domestic rights. Some companies had even reportedly stopped using their trademarks when threatened with suit by owners of registrations under the register of the Act of 1920, and legislators were alarmed.¹¹⁵ As one Representative said:

The difficulty, of course, is that the 1920 act has been used for the registration of many marks which are descriptive and geographical, and the parties have not bothered to cancel them But, in many cases, they do cause trouble, because notice is served that you are infringing some mark that is clearly descriptive and should never have been registered, . . . where the registration is made by domestic users of the marks just to get registration of them for the export trade.¹¹⁶

Another Representative declared, in a similar vein:

It seems to me that the 1920 act as carried out in this [then-proposed] supplemental register is benefiting a small class in a way which they really do not need and is causing a great deal of detriment to the general public. I think if you will look at the 1920 register, you will find that large numbers of the marks that have been registered have never been used in the foreign trade; they are registered solely for bluffing purposes at home.¹¹⁷

113. Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76th Cong., 1st Sess. 127 (1939) (Representative Rogers), *reprinted in* 8 *Gilson on Trademarks* 23-7.

114. Lucius Smejda, *The Supplemental Register: Does It Fulfill Its Function Internationally and Domestically?* 62 TMR 285, 290 n.29 (1972) (“The liberal trend in permitting packages, slogans, configurations of goods, etc., onto the Principal Register . . . may well further diminish the Supplemental Register’s role in international commerce by augmenting that of the Principal Register.”).

115. Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76th Cong., 1st Sess. 128-129 (1939) (Representative Byerly), *reprinted in* 8 *Gilson on Trademarks* 23-8 to 23-9.

116. *Id.* at 128 (8 *Gilson* at 23-8) (Representative Thomson).

117. *Id.* (Representative Byerly). *See also id.* at 129 (8 *Gilson* at 23-9) (“Undoubtedly there are cases where some exporters would like to use a purely descriptive term and use it only abroad, where, perhaps, because of the difference of language, it is not descriptive; so that I take it this supplemental register would be convenient to some exporters for that

Another objection made to the supplemental register was that it was “a perpetration of a little fraud or sharp practice on foreign governments.”¹¹⁸ Owners of supplemental registrations were allowed to pretend in foreign applications that these registrations were actually of valid trademarks, when in fact they were a legal fiction designed only to obtain foreign registration.

One Representative made the cogent suggestion that, because the “supplemental register is designed primarily to assist foreign commerce, it might be advisable to limit this register to marks used in foreign commerce between the United States and foreign nations.”¹¹⁹ However, no one took him up on this logical proposal.

Instead, the legislators found what they thought was an ingenious solution to the problem of domestic misuse of supplemental registrations. They decided that supplemental register certificates should differ in appearance from principal register certificates; this requirement remains in Section 25 of the Act.¹²⁰ The Representatives thought that this simple condition would promote foreign trade while avoiding possible domestic misinterpretation of the scope of a supplemental registration.¹²¹ The role of physical certificates of registration, whatever it may have been in 1929, is now so minimal that the appearance of a certificate could not possibly clarify the rights—or lack thereof—in a registration.

C. Is the Foreign Registration Rationale Still Valid?

Just four years after enactment of the Lanham Act, Walter Derenberg declared that, since its enactment, “the supplemental register has lost a good deal of the original justification and purpose which had led to the establishment of the predecessor register under the Act of 1920.”¹²² Even in 1950, Derenberg presciently noted that “proof of registration abroad is no longer a requirement for foreign applicants [T]he vast majority of foreign countries will probably soon accept applications by United States applicants based on the requirements of the foreign law

purpose. But it does not seem to me that justifies the thing becoming a real fraud and deceit in practice in the domestic trade by having this sort of registration”).

118. *Id.* at 129 (8 *Gilson* at 23-9).

119. *Id.* at 136 (8 *Gilson* at 23-16) (Representative Whitman).

120. 15 U.S.C. § 1093 (“The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.”).

121. “It seems to me that would be quite a simple remedy to be applied here to relieve the situation.” Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76th Cong., 1st Sess. 133 (1939) (Representative Rogers), reprinted in 8 *Gilson* on Trademarks 25-3.

122. Derenberg, *supra* note 45, at 934.

alone and regardless of any registration certificate in this country.”¹²³

However, in 1987, the Trademark Review Commission (TRC) Report of the then–United States (now International) Trademark Association declared: “Although the need is not as great as it once was, the [supplemental] register still facilitates the ability of American businesses to obtain trademark registrations in foreign countries.”¹²⁴ Without citation, the TRC declared its belief that “the supplemental register continues to facilitate foreign registration and to offer other benefits as well.”¹²⁵ It pointed out that Article 6 of the Paris Convention entitled the owner of a trademark registration in one signatory country to register the mark in all other signatory countries, and provided that each signatory country could require proof of domestic registration as a prerequisite for issuing its own registration. But the TRC also stated that fifteen years earlier a commentator had “noted that the role of the supplemental register in obtaining foreign trademark or service mark registrations was declining. Foreign subsidiaries had become available to obtain foreign registrations, and various other factors led to the decline.”¹²⁶

That commentator, writing in 1972, stated that while “a certified copy of home registration [is] required in several jurisdictions, . . . their number is declining in recent years and they are countries of limited commercial significance.”¹²⁷ The author cited only nine “home registration” countries,¹²⁸ and noted that “the trend is toward a complete elimination of these ‘home registration’ requirements.”¹²⁹ Moreover, he noted that other commentators were split as to whether a supplemental registration in fact sufficed to give rights in those countries.¹³⁰ While it is true, as discussed below, that supplemental registrations can facilitate foreign applications, other countries may still deny registration based on the matter’s lack of distinctiveness.

123. *Id.* at 935.

124. *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TMR 375, 413 (1987) (TRC Report). The TRC Report served as the basis for much of the Trademark Law Revision Act of 1988 (TLRA). See 1 Gilson on Trademarks § 1.04[2][d][i] for a full discussion of the history of the TLRA.

125. TRC Report, *supra* note 124, at 414.

126. *Id.* at 413–14, citing Smejda, *supra* note 114, at 286 n.7.

127. Smejda, *supra* note 114, at 289–90. See also *id.* at 293 (“The practical role of the Supplemental Register on the international scene is minimal and decreasing due to a complex of factors.”) (footnote omitted).

128. *Id.* at 290 n.25.

129. *Id.* at 290.

130. *Id.*

1. Paris Convention

Under Article 6(1) of the Paris Convention, “foreign nationals seeking to register in a Convention country may do so irrespective of whether they own a registration in their home country, and their application is to be subject to the same rules as those governing an application by a domestic applicant.”¹³¹ However, the owner of a U.S. registration (on the supplemental or principal register) may seek registration in countries that are Paris Convention signatories pursuant to the so-called “*telle quelle*” (“as is”) clause.¹³²

Article 6*quinquies*(A)(1) states in relevant part: “Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article.” But Article 6*quinquies*(B)(ii) provides that trademarks covered by that Article may be denied registration “when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, place of origin, or the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed.” The World Intellectual Property Organization, which administers the Paris Convention, states that the “*telle quelle*” principle does not require a member country “to register and extend protection to subject matter that does not fall within the meaning of a trademark as defined in the law of that country.”¹³³

2. Madrid Protocol

The Madrid Protocol, an international treaty of which the United States is a member, facilitates filing registrations in member countries when armed with a basic home country

131. Daniel R. Bereskin & Aaron Sawchuk, *Crocker Revisited: The Protection of Trademarks of Foreign Nationals in the United States*, 93 TMR 1199, 1211 (2003).

132. *Id.* (“Article 6*quinquies* . . . provides an alternative. It enables foreign nationals of Convention countries who have obtained registration of their mark in their country of origin or ‘home’ country, to register the mark ‘as is’ in other Convention countries.”).

133. See World Intellectual Property Organization, WIPO Intellectual Property Handbook: Policy, Law and Use, 5.103; International Treaties and Conventions on Intellectual Property, at <http://www.wipo.org/about-ip/en/iprm/pdf/ch5.pdf>. See also Smejda, *supra* note 114, at 291-92 (“[R]estrictions in the Paris Convention serve to limit the acceptability of supplemental registrations as a matter of statutory provision. . . . In general, . . . the restrictions of Article 6 *quinquies* B . . . act as practical restraints on the registrability of ‘*telle quelle*’ marks. The mere formalism granted by a home registration cannot overcome any objectionable qualities of the mark in the country of importation.”); *id.* at 294 (“[‘*Telle quelle*’ registrations are sparingly granted for supplemental registrations.”).

registration.¹³⁴ Beginning November 2, 2003, the implementation date in the United States, the owner of a federal registration in the United States can base certain foreign applications on that registration. A U.S. applicant can apply for trademark registration to eighty-seven signatories to the Protocol, as of March 2013, including the European Union, using a single application based on its U.S. registration.¹³⁵

A U.S. supplemental registration qualifies as a basic registration under the Madrid Protocol.¹³⁶ Therefore, a legal entity or individual with “a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of” the United States can base an international application on its supplemental registration.

But ownership of a U.S. supplemental registration does not guarantee registration via the Protocol. The trademark offices in the countries designated in the international application will examine the application just as they would examine a directly filed application, and may refuse registration.¹³⁷

V. ADVANTAGES OF SUPPLEMENTAL REGISTRATIONS

Courts and the Board have quite a low opinion of supplemental registrations. It is sometimes said that a supplemental registration “is not *prima facie* evidence of anything except that the registration issued,”¹³⁸ and that registration on the supplemental register “does nothing to enlarge the substantive

134. See generally 3 Gilson on Trademarks § 10.06[3] and <http://www.wipo.int/madrid/en/general/>.

135. For a list of members, see http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

136. TMEP § 1902.01 (“[A] qualified owner of a basic application for registration on the Principal or Supplemental Register pending in the USPTO or a qualified owner of a basic registration issued by the USPTO on the Principal or Supplemental Register may file an application for international registration through the USPTO.”).

137. 3 Gilson on Trademarks § 10.06[3][b][vi]; P. Jay Hines & Jordan S. Weinstein, *Using the Madrid Protocol After U.S. Accession*, 93 TMR 1003, 1011 (2003) (“The basic U.S. record relied upon in filing for protection through the Madrid Protocol process may be a Supplemental Register registration. However, the applicant must be aware that each request for extension of protection is subject to full national examination on absolute grounds in the designated countries.”).

138. *Copperweld Corp. v. Arcair Co.*, 200 U.S.P.Q. 470 (T.T.A.B. 1978). See also, e.g., *In re Federated Dep’t Stores*, 3 U.S.P.Q.2d 1541 (T.T.A.B. 1987) (“It is overwhelmingly agreed that a Supplemental Register registration is evidence of nothing more than the fact that the registration issued on the date printed thereon . . . [I]t is entitled to no presumptions of validity, ownership, or priority.”) (citations omitted); *In re Hester Indus.*, 230 U.S.P.Q. 797, n.1 (T.T.A.B. 1986) (“A registration on the Supplemental Register . . . is not evidence of anything except that the registration of the mark on the Supplemental Register issued.”); *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 U.S.P.Q. 246 (T.T.A.B. 1970) (holding that a supplemental registration “is evidence only of the fact that it issued”).

rights of the registrant.”¹³⁹ The Federal Circuit has said that registration on the supplemental register “confers considerably fewer advantages than principal registration.”¹⁴⁰ In fact, these views overstate the case, as the list of advantages is surprisingly long.¹⁴¹

A. Jurisdiction

Based on ownership of a supplemental registration, federal courts have jurisdiction in suits to enforce the registered mark.¹⁴² In fact, the Ninth Circuit found this to be “the principal advantage” of such a registration.¹⁴³

B. Standing

An opposer in a Board proceeding must show that it has a real interest in that proceeding in order to have standing to oppose.¹⁴⁴ A registration on the supplemental register establishes such an interest, because it may be used as a basis at the USPTO for refusing other registrations.¹⁴⁵ (Note that a potential opposer could

139. *Clairol*, 389 F.2d at 264. See also *Arkansas Trophy Hunters Ass’n v. Tex. Trophy Hunters Ass’n*, 506 F. Supp. 2d 277, 281 n.3 (W.D. Ark. 2007) (“Registration on the Supplemental Register does not convey substantive rights beyond those available at common law.”), citing *In re American Fertility Society*, 188 F.3d 1341 (Fed Cir. 1999).

140. *In re American Fertility Soc.*, 188 F.3d at 1343.

141. See B. Brett Heavner & Marcus H.H. Luepke, *Tips From Practitioner: Avoiding Trademark Pitfalls in the ‘Land of the Unlimited Possibilities’: The Top 15 Mistakes of Foreign Applicants in the U.S. Trademark Office*, 98 TMR 974, 988 (2008) (stating that one of the top fifteen mistakes of foreign applicants is a failure to take advantage of the supplemental register, “an important alternative register to the Principal Register,” and listing “valuable benefits”).

142. *E.g.*, *In re Bush Bros. & Co.*, 884 F.2d 569, 571 n.2 (Fed. Cir. 1989) (“Registration on the Supplemental Register . . . enables the registrant to sue for infringement in federal court.”); *Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340 (E.D.N.Y. 2006) (“While registration on the Supplemental Register is not evidence of ownership, validity, or the exclusive right to use, such registration enables the registrant, *inter alia*, to sue for infringement in federal court.”); *E.T. Browne Drug Co. v. Cococare Prods.*, 2006 U.S. Dist. LEXIS 66515, n.4 (D.N.J. 2006) (“Supplemental Registration allows for questions of validity, ownership and infringement to be governed by federal law.”), *aff’d in relevant part*, 538 F.3d 185 (3d Cir. 2008); *Novartis Consumer Health v. McNeil-PPC, Inc.*, 53 U.S.P.Q.2d 1406 (D.N.J. 1999) (“[O]ne benefit conferred by Supplemental Registration is that ‘questions of validity, ownership and infringement of Supplemental Registrations are governed by federal law,’ and a suit for the infringement of a mark registered on the Supplemental Register may be brought in federal court, ‘along with a related claim of unfair competition.’”) (citation omitted).

143. *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1454-55 n.2 (9th Cir. 1985) (“Indeed the principal advantage of registration on the supplemental list is to confer federal jurisdiction on the federal courts for enforcement of the mark.”).

144. See 3 Gilson on Trademarks, § 9.03[2].

145. *Otter Prods. LLC v. BaseOneLabs LLC*, 105 U.S.P.Q.2d 1252 (T.T.A.B. 2012) (“[W]e agree with opposer that its Supplemental Register Registration establishes its standing to oppose registration of applicant’s mark under Section 2(d).”).

instead establish standing by proving common law rights in a mark.¹⁴⁶) As for federal litigation, while court opinions have not discussed standing in this situation, several owners of supplemental registrations have brought suit without any difficulty showing standing.¹⁴⁷

C. Remedies

In theory, the owner of a supplemental registration is on a par with a principal registrant with injunctive relief and damages in an infringement action.¹⁴⁸ On its face, Section 34 of the Act applies to supplemental registrations: A court may “prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office.”¹⁴⁹ Similarly, Section 35 provides for profits, damages and costs for “a violation of any right of the registrant of a mark registered in the Patent and Trademark Office.”¹⁵⁰ Even though there are no underlying protectable trademark rights in a supplemental registration, the courts could still give effect to those remedial provisions. On the other hand, a supplemental registration cannot be registered with U.S. Customs and Border Protection to stop importation of counterfeit or infringing goods, so that remedy is out.¹⁵¹

D. Use of ® Registration Symbol

The owner of a supplemental registration may use the ® indication of federal registration, just as the owner of a principal registration may.¹⁵²

146. *E.g.*, *Krueger Int'l, Inc. v. Okamura Corp.*, 2010 TTAB LEXIS 270 (T.T.A.B. 2010) (not citable as precedent) (“Opposer’s registration of the mark BARRON on the Supplemental Register for ‘tables’ is sufficient to establish opposer’s direct commercial interest in its mark and its standing to oppose registration of applicant’s mark. . . . Opposer’s standing also is established . . . by its common law rights in the BARRON mark.”). *See also* Chisum, *supra* note 104, at 168 (A supplemental registration “does confer federal court jurisdiction, which is relatively unimportant because owners of unregistered marks can use Lanham Act Section 43(a) to obtain access to the federal courts.”).

147. *E.g.*, *Feathercombs, Inc. v. Solo Products Corp.*, 306 F.2d 251, 257 (2d Cir. 1962); *Jewish Sephardic Yellow Pages*, 478 F. Supp. 2d at 340; *E.T. Browne Drug Co.*, 2006 U.S. Dist. LEXIS 66515; *Novartis Consumer Health*, 53 U.S.P.Q.2d at 1406; *Eldon Indus. v. Rubbermaid, Inc.*, 735 F. Supp. 786, 786 (N.D. Ill. 1990).

148. *Feathercombs, Inc.*, 306 F.2d at 257 (“Registration in the supplemental register . . . entitles the owner of a mark to institute actions based upon it in the federal courts, . . . and to obtain the remedies provided in the Lanham Act”); *Eldon Indus.*, 735 F. Supp. at 832 (“Registrants on either the Principal or Supplemental Registers are entitled to institute actions based on the mark and to obtain the remedies provided in the Lanham Act.”).

149. 15 U.S.C. § 1116(a).

150. 15 U.S.C. § 1117(a).

151. *See* Part VII.G *infra* and 1 Gilson on Trademarks § 4.05.

152. 15 U.S.C. § 1111. It may also use the words “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” *Id.*

E. Appearance in USPTO Database Search

Supplemental registrations appear in the USPTO database and thus may deter someone from adopting a mark that resembles a supplemental register mark.¹⁵³

F. Possible Protection in the Domain Space

A registration on the supplemental register may—or may not—protect the registered mark from appearing in third parties' domain names.

1. Supplemental Registrations as Evidence of Trademark Rights Under the UDRP

Panels in proceedings under the Uniform Domain Name Dispute Resolution Policy (UDRP) are split over whether a supplemental registration establishes rights in a mark. Under the UDRP, a successful complainant must show that the domain name at issue is confusingly similar to “a trademark or service mark in which the Complainant has rights.”¹⁵⁴ The question is whether a supplemental registration is enough.

In general, panels from the World Intellectual Property Organization (WIPO) have found that a supplemental registration alone is *not* sufficient evidence of trademark rights.¹⁵⁵ Panels from the National Arbitration Foundation (NAF), another dispute resolution service provider for the UDRP, have also largely found that supplemental register evidence alone is insufficient.¹⁵⁶ WIPO

153. *In re Bush Bros.*, 884 F.2d at 571 n.2 (“Registration on the Supplemental Register . . . provides useful business information on a readily accessible, central register.”); Anthony L. Fletcher & David J. Kera, *The Forty-Third Year of Administration of the Lanham Trademark Act of 1946*, 80 TMR 591, 612-13 (1990) (“There is a general policy in favor of registration to enable a registrant to satisfy registration requirements in foreign countries that require home country registrations, to provide a jurisdictional basis for actions in federal court, and to provide useful business information on an accessible central register (which includes principal registrations as well as supplemental registrations).”).

154. UDRP ¶ 4(a)(i).

155. *E.g.*, *Tarheel Take-Out, LLC v. Versimedia, Inc.*, WIPO Case No. D2012-1668 (“It is well-settled that a Supplemental Registration in the U.S. is not sufficient in itself to establish that a Complainant has rights to a mark for the purposes of the Policy.”); *Advance News Service Inc. v. Vertical Axis, Inc.*, WIPO Case No. D2008-1475 (“[T]he fact of a Supplemental Registration is no evidence whatsoever the Complainant owns trademark rights in the phrase . . .”).

156. *E.g.*, *Parker Waichman Alonso LLP v. zany technology.com*, NAF Claim Number FA0904001255465 (2009) (holding that complainant cannot rely on a supplemental registration to show rights under ¶ 4(a)(i)); *Martha Stewart Living Omnimedia, Inc. v. Perez*, NAF Claim Number FA0904001259275 (2009) (“The Panel finds that Complainant lacks rights in the mark under Policy ¶ 4(a)(i) based solely on . . . the Supplemental registrations.”); *Blair v. Lane*, Claim Number FA0909001285345 (2009) (“Complainants have failed to establish any legal rights in the servicemark, as the only registration cited is to a Supplemental Register, which carries little, if any legal weight under federal law.”); *One Hour Funding & Plaintiff Funding Holding, Inc. v. Case Cash Now, Inc.*, NAF Claim

panels have required proof of acquired distinctiveness in addition to a supplemental registration in order to find trademark rights,¹⁵⁷ and NAF panels have followed this line of reasoning as well.¹⁵⁸ If the owner of a supplemental registration can independently prove acquired distinctiveness, it will demonstrate that it has protectable rights in the registered mark.¹⁵⁹

Still, not all panels have been as skeptical of supplemental registrations. Some have found them sufficient under the UDRP to establish trademark rights¹⁶⁰ and held that a complainant with

Number FA0805001195141 (2008) (“[T]his Panel determines that Complainants’ registration on the Supplemental Register with the USPTO is insufficient to establish rights for the purposes of Policy ¶ 4(a)(i).”).

157. *E.g.*, *West Coast University Inc. v. West Coast University Inc.*, WIPO Case No. D2009-0972 (“Registrations in the Supplemental Register have been regarded by panelists as of little value in establishing trade mark or service mark rights under paragraph 4(a)(i) of the Policy in the absence of evidence of acquired distinctiveness.”); *Mirabella Beauty Prods., LLC v. Mrs Jello, LLC*, WIPO Case No. D2009-0673 (“[A] complainant in a UDRP proceeding may adduce evidence demonstrating that . . . a mark registered on the USPTO’s Supplemental Register, has in fact acquired distinctiveness sufficient for common law protection in a relevant jurisdiction.”); *RUGGEDCOM, Inc. v. Krachenfels*, WIPO Case No. D2009-0130 (“[T]he Complainant’s two registrations of that mark are both on the Supplemental Register, and, at least in the absence of evidence of acquired distinctiveness, they do not provide evidence that the Complainant owns trademark or service mark rights in the expression.”); *J2 Global Communications, Inc. v. Ideas Plus, Inc.*, WIPO Case No. D2005-0792 (“As Complainant has produced no evidence as to the acquisition of secondary meaning, the Panel finds that Complainant has failed to establish that it has rights in the marks registered on the supplemental register.”).

158. *E.g.*, *Sukotai Corporation v. XtremeBoxing & Entertainment*, NAF Claim Number FA0811001235561 (2009) (“While trademarks and service marks registered on the Supplemental Register are not inherently incapable of distinguishing goods and services, a Complainant relying upon such mark must prove that its mark is distinctive.”); *Lodging Kit Co., Inc. v. Soffer*, Claim Number FA0909001283398 (2009) (“Without a showing of secondary meaning, Complainant’s registration on the Supplemental Register does not confer rights in the mark under Policy ¶ 4(a)(i).”); *King v. Cambria*, NAF Claim No. FA0712001118407 (2008) (supplemental registration insufficient to show rights in mark without independent showing of secondary meaning).

See also *Bryant v. Yerke*, eResolution Case No. AF-0315 (2000) (“The bare registration on the Supplemental Register cannot carry the day.”).

159. *E.g.*, *Betonsports Plc v. Tpcr Development SRL*, WIPO Case No. D2006-0634 (mark registered on supplemental register but complainant showed secondary meaning).

160. *E.g.*, *eLegalsupply.com, LLC v. Azeras LLC*, Claim Number FA1204001438796 (2012) (“The fact that the trademark is registered on the Supplemental Register and not on the Principal Register is not a factor to be considered under the Policy.”) (finding that complainant showed it had rights under ¶ 4(a)(i)); *Net2phone Inc v. Delta Three Inc.*, WIPO Case No. D2007-0644 (“Complainant clearly meets that test [of whether it has rights in a mark sufficient to invoke the policy] by means of its federally-registered United States of America trademark, even though it is on the Supplemental Register.”); *Action Sports Videos v. Reynolds*, WIPO Case No. D2001-1239 (complainant has registration on the supplemental register; “Nonetheless, the Panel still finds the Complainant has standing to initiate this proceeding because the Policy at paragraph 4a(i) requires only that the Complainant have (mark) ‘rights’ in the disputed domain name, strong or weak though they be.”).

such a registration has shown enough to overcome the trademark rights hurdle.¹⁶¹

A complainant must also show that the respondent registered the infringing domain name *after* the complainant acquired rights in its trademark. Supplemental registration is a disadvantage where panels find terms descriptive and lacking acquired distinctiveness as of the date of registration. In one case, for example, the panel found the timeline “of determinative interest” where the complainant’s supplemental registration issued in January 2003, the respondent registered its domain name in November 2005, and there was no indication that between those dates there was a “transition from descriptive to distinctive.”¹⁶²

2. Supplemental Registrations as “Rights” in Future Rights Protection Mechanisms in the New gTLDs

A supplemental registration may nonetheless be evidence of ownership of trademark rights and potentially prevent third parties from registering domain names consisting of those marks. The Trademark Clearinghouse is intended to streamline proof of registration ownership with a centralized database of trademark rights.¹⁶³ A trademark owner can submit proof of any valid national registration of a word mark from any jurisdiction

161. *E.g.*, Kahveci v. Soncu, WIPO Case No. D2011-0392 (“Although the rights conferred by registration on the Supplemental Register are not as robust as those conferred by other forms of trade mark registration, the Panel finds that such registration is sufficient to satisfy the requirement of a trade mark under the Policy.”); *J. R. Andorin, Inc. v. Natural Wellness Centers of America Inc.*, Claim Number FA1107001399143 (2011) (“The Panel finds that the question whether the mark was only registered in the Supplemental Register is of no significance in the matter at hand since the UDRP only requires that the domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. Complainant sufficiently presented evidence in support of its rights.”); *San Diego Private Bank v. PB Holdings LLC*, NAF Claim Number FA0903001250495 (2009) (finding supplemental registration shows that plaintiff has “some rights in the mark” dating back to the filing date of its application).

162. *Foundation Source Philanthropic Servs., Inc. v. Gibson*, WIPO Case No. D2007-0875.

See also, e.g., *National Ass’n of Competitive Soccer Clubs v. Binler*, WIPO Case No. D2009-0957 (“There is no obvious difference apparent in the provided record in the circumstances of Complainant today and the circumstances when its service mark application for the Principal Register was rejected in 2004.”); *The Generations Network, Inc. v. 6684874 Canada Inc.*, WIPO Case No. D2008-0606 (“[I]t would appear that by . . . the date upon which the mark was registered in the Supplemental Register . . . it had not acquired distinctiveness. No compelling evidence is brought forward to the effect that things may have changed since that date.”); *Oil Changer, Inc. v. Name Administration, Inc.*, WIPO Case No. D2005-0530 (finding supplemental registrations to be admissions that the marks had not yet acquired secondary meaning).

163. For more on the Trademark Clearinghouse, see 2 Gilson on Trademarks § 7A.02[1][b], <http://trademark-clearinghouse.com/>, and <http://newgtlds.icann.org/en/about/trademark-clearinghouse>.

(including a U.S. supplemental registration), and that registration will be added to the database.¹⁶⁴

The gTLD registries will have to consult the marks in the Clearinghouse database when administering their pre-launch or initial launch period rights protection mechanisms.¹⁶⁵ At a minimum, new gTLD registries must have a Trademark Claims Service and a sunrise process. How will these new procedures work in combination with the Clearinghouse?

The Trademark Claims Service will notify an applicant for domain name registration of potentially conflicting rights when the applicant attempts to register a domain name that is identical to a mark in the Clearinghouse database.¹⁶⁶ The applicant could still proceed with domain name registration, though it would have to affirm that it was not violating prior rights. For example, the applicant must acknowledge that it has been notified that the cited mark is included in the Clearinghouse and that to the best of its knowledge, its registration and use of the domain name “will not infringe on the rights that are the subject of the notice.”¹⁶⁷ At the same time, the applicant can access the Clearinghouse database “to enhance understanding of the Trademark rights being claimed by the trademark holder.”¹⁶⁸ Presumably there would be mention that a trademark was registered in the U.S. supplemental register, but it is doubtful that many domain name applicants would understand its significance. In anticipation of such a disadvantage, though, the notice cautions that “some of the trademark information below may exist in a national or regional registry which does not conduct a thorough or substantive review of trademark rights prior to registration,” and urges those with questions to consult an attorney or legal expert on trademarks.

Registries for the new gTLDs must offer a sunrise registration service that allows early domain name registration to owners of trademarks registered in the Clearinghouse.¹⁶⁹ Registries will have sunrise eligibility requirements that must include the somewhat vague “provision of data sufficient to document rights in the trademark.”¹⁷⁰

With a possible nod to U.S. supplemental registration, the document describing the Clearinghouse declares that “[i]nclusion

164. New Applicant Guidebook, Trademark Clearinghouse 3.2.1.

165. *Id.* at 6.

166. *Id.* at 6.1.2, 6.1.5.

167. *Id.* at 6.1.2.

168. *Id.* at 6.1.3.

169. *Id.* at 6.2.1.

170. *Id.* at 6.2.3.

in the Clearinghouse is not proof of any right, nor does it create any legal rights.”¹⁷¹

G. Blocking Subsequent Registrations

After a finding of likelihood of confusion under Section 2(d) of the Act, the USPTO will refuse to register a mark. It must refuse registration to “a mark which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.”¹⁷² It also has the authority to cancel an existing registration on either register on the ground of likely confusion with a mark registered on either.¹⁷³ The Act provides that “a mark registered in the Patent and Trademark Office” includes marks registered on the supplemental register.¹⁷⁴

Courts and the USPTO have found that existing supplemental registrations may block applications for registration on the principal register.¹⁷⁵ The following supplemental registrations, for example, caused the USPTO to refuse registration to other marks:

171. *Id.* at 1.6.


172. 15 U.S.C. § 1052(d).

173. *See, e.g.*, H2O TO GO, LLC v. Cook, 2008 TTAB LEXIS 511 (T.T.A.B. 2008) (not citable as precedent) (principal registration cancelled due to existing supplemental registration).

174. 15 U.S.C. § 1127 (“The term ‘registered mark’ means a mark registered in the United States Patent and Trademark Office under this Act or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase ‘marks registered in the Patent and Trademark Office’ means registered marks.”). *See also, e.g.*, *In re Clorox Co.*, 578 F.2d 305, 307 n.4 (C.C.P.A. 1978) (“The board has consistently concluded that a mark registered on the Supplemental Register is ‘a mark registered in the Patent and Trademark Office’ within the meaning of 15 USC 1052(d).”); *In re Cable Lock, Inc.*, 2012 TTAB LEXIS 418 (T.T.A.B. 2012) (not citable as precedent) (“[W]e note that a mark registered on the Supplemental Register is ‘a mark registered in the Patent and Trademark Office’ within the meaning of Section 2(d).”).

175. *See, e.g.*, *In re Clorox Co.*, 578 F.2d at 307-08; *Otter Prods. LLC, v. BaseOneLabs LLC*, 105 U.S.P.Q.2d 1252 (T.T.A.B. 2012); *In re National Real Estate Solutions LLC*, 2011 TTAB LEXIS 200 (T.T.A.B. 2011) (not citable as precedent) (“[M]arks on the Supplemental Register—which are typically descriptive and have not acquired secondary meaning—may be cited as a bar to registration of a mark under Trademark Act § 2(d).”); *In re Hunke & Jochleim*, 185 U.S.P.Q. 188 (T.T.A.B. 1975); *Ex parte Jacobson & Sons, Inc.*, 97 U.S.P.Q. 465 (Comm’r 1953).

See also TMEP § 1207.01(b)(ix) (supplemental registrations may be cited against another application under Section 2(d)).

Case	Supplemental Registration	Blocked Application
<i>In re</i> Clorox Co., 578 F.2d 305 (C.C.P.A. 1978)	STAIN ERASER for stain remover	ERASE for laundry stain remover
<i>In re</i> Research & Trading Corp., 793 F.2d 1276 (Fed. Cir. 1986)	ROPELOCK for releasable locking buckles for ropes, particularly for industrial purposes	ROPELOK for safety fall protection equipment for attachment to workers operating at elevated heights
<i>In re</i> Smith & Mehaffey, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994)	 <p>for t-shirts, sweatshirts and pullovers</p>	ROAD KILL CATERING for tee shirts, sweatshirts and aprons
<i>In re</i> Southern Belle Frozen Foods, Inc., 48 U.S.P.Q.2d 1849 (T.T.A.B. 1998)	SHRIMP ROYALE for a packaged cooked meal with shrimp, potatoes, sauce and a roll	SEAFOOD ROYALE for frozen seafood

Case	Supplemental Registration	Blocked Application
<i>In re</i> Gibson Guitar Corp., 2002 TTAB LEXIS 104 (T.T.A.B. 2002)	THE LEARN TO PLAY STORES for “retail outlets for organs, pianos, digital pianos, portable keyboards, string instruments, band instruments, amplifiers, combo equipment, sheet music and accessories for all instruments”	LEARN2PLAY for “providing on-line instruction lessons over a global computer network for playing musical instruments, namely—on-line one-on-one interactive lessons; and on-line group lessons”
<i>In re</i> Federal Express Corp., 2009 TTAB LEXIS 690 (T.T.A.B. 2009)	SURFACE EXPEDITE for pick-up, transportation, storage, tracking and delivery of documents, packages and freight by air	(1) FEDEX CUSTOM CRITICAL SURFACE EXPEDITE NETWORK; (2) FEDEX CUSTOM CRITICAL AIR EXPEDITE NETWORK; (3) FEDEX CUSTOM CRITICAL AIR EXPEDITE EXCLUSIVE USE; and (4) FEDEX CUSTOM CRITICAL SURFACE EXPEDITE EXCLUSIVE USE for pick-up, transportation, storage and delivery of documents, packages and freight by land and air
<i>In re</i> Modern Consulting Solutions, 2010 TTAB LEXIS 121 (T.T.A.B. 2010)	SEARCH ENGINE OPTIMIZATION ENGINE for providing online non-downloadable computer search engine software	SEARCH ENGINE OPTIMIZATION for “development of advertising campaigns for use on computers and related consulting”

Case	Supplemental Registration	Blocked Application
<i>In re</i> National Real Estate Solutions LLC, 2011 TTAB LEXIS 200 (T.T.A.B. 2011)	A QUICK SALE for “financial valuation of real property; arranging or facilitating the leasing or rental of real property; real estate agencies; real estate property brokerage”	NATIONAL QUICK SALE for “Mortgage foreclosure mitigation and loan default mitigation services, namely, providing a web-based database for purchasing and selling real estate for others; On-line real estate investment services in the nature of purchasing and selling real estate for others; Facilitating and arranging for real estate procurement for others”
<i>In re</i> Sams Watchmaker Jeweller Pty Ltd., 2012 TTAB LEXIS 337 (T.T.A.B. 2012)	CLASSIC for watches	 for watch bands and watches
<i>In re</i> Select Jewelry Inc., 2012 TTAB LEXIS 347 (T.T.A.B. 2012)	RADIANCE for several goods including bracelets, brooches, charms, gemstones, jewelry, anklets and rings	RADIANCE BY DIAMOND FASCINATION for “wedding bands, rings, bracelets, pendants, earrings, necklaces, brooches and pins composed of, in whole or in part, diamonds”

1. Ex Parte Cases vs. Inter Partes Cases

In ex parte cases, where the USPTO is examining the mark, the examining attorney may cite a mark in a supplemental

registration under Section 2(d) as a basis for refusal.¹⁷⁶ All the cases in the table above are *ex parte* cases. In that context, the USPTO does not question the validity of marks it cites against applied-for marks under Section 2(d).¹⁷⁷ The Federal Circuit explained:

Section 2(d) bars registration, or serves as a basis for cancellation, if there is a likelihood of confusion as to source. As to an unregistered term, such a likelihood of confusion results when there are trade identity rights in the prior user's term. Those trade identity rights arise when the term is distinctive, either inherently or through the acquisition of secondary meaning. To the extent there is a different result in an *ex parte* proceeding if the first term is registered on the Supplemental Register, such a result may be an added advantage of federal registration.¹⁷⁸

In *ex parte* proceedings, then, supplemental registrations may be cited under Section 2(d) without the USPTO having to make any showing of acquired distinctiveness.¹⁷⁹

In the *inter partes* context, however, the third-party opposer, cancellation petitioner or plaintiff in litigation seeking to show likelihood of confusion must independently establish the validity of a cited supplemental registration.¹⁸⁰ Without a principal registration and the attaching presumptions, "a party claiming to be aggrieved under Section 2(d) cannot prevail where he has not proved a prior and proprietary right in the term or designation on which it relies."¹⁸¹ Thus, in an *inter partes* case, evidence of the ownership of a supplemental registration fails to establish that the plaintiff "owns a proprietary interest in a mark."

When the party claiming likelihood of confusion lacks superior rights in an *inter partes* case, it lacks standing even to attempt to show confusion. An opposer claiming likelihood of confusion under Section 2(d) "must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source."¹⁸²

176. *In re Clorox Co.*, 578 F.2d at 308.

177. *Id.* (rejecting argument that USPTO had to show that supplemental registration had secondary meaning before it could reject application based on confusion with that registration); *Otter Prods.*, 105 U.S.P.Q.2d at 1256.

178. *Towers v. Advent Software, Inc.*, 913 F.2d 942, 946-47 (Fed. Cir. 1990).

179. *In re Research & Trading Corp.*, 793 F.2d 1276, 1278 (Fed. Cir. 1986) ("It is not material whether or not registration on the Supplemental Register implies that there is a degree of descriptiveness to that mark, as appellant argues. Such registration may be cited under section 2(d) in a determination of likelihood of confusion, an inquiry separate from that of descriptiveness.").

180. *Otter Prods.*, 105 U.S.P.Q.2d at 1256.

181. *Id.*, quoting *Fluid Energy Processing & Equip. Co. v. Fluid Energy, Inc.*, 212 U.S.P.Q. 28 (T.T.A.B. 1981).

182. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320 (C.C.P.A. 1981). *See also Jewelers Vigilance Cte., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 893 (Fed. Cir. 1988)

As the CCPA found, “if an opposer’s alleged means of trade designation is not distinctive . . . then there is no basis upon which to compare such a thing with the applicant’s mark to determine whether confusion as to source is likely.”¹⁸³ Thus, for example, the user of BRIE NOUVEAU for brie cheese, a merely descriptive and unregistered phrase, had no grounds to challenge the registration of ESPRIT NOUVEAU for brie cheese, a distinctive trademark.¹⁸⁴ Similarly, a cancellation petitioner relying on its own unregistered term to claim likelihood of confusion “cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning”¹⁸⁵

Opposers and cancellation petitioners in inter partes proceedings may rely on registered or unregistered marks when making claims under Section 2(d).¹⁸⁶ In inter partes proceedings, whether the mark is unregistered or registered on the supplemental register, the plaintiff must prove its distinctiveness.¹⁸⁷ This standard, given in a 2012 precedential opinion, makes clear the error in a 2008 non-precedential opinion, which stated that “where a Supplemental Registration is concerned, a plaintiff need not also establish distinctiveness of its mark prior to the defendant’s first use.”¹⁸⁸ The earlier opinion improperly relied on an ex parte decision, *In re Clorox*, in stating a rule for inter partes cases.

(“Where an opposer asserts likelihood of confusion because of its prior use of what appears to be a merely descriptive term, as in *Otto Roth*, the opposer must show that such term has come to identify the opposer as the source of goods or services.”).

183. *Otto Roth*, 640 F.2d at 1321.

184. *Id.*

185. *Towers*, 913 F.2d at 945-46 (“The *Otto Roth* rule is applicable to trademark registration cancellation proceedings as well.”).

186. 15 U.S.C. § 1052(d) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.”).

187. *Otter Prods.*, 105 U.S.P.Q.2d at 1255 (“Because the mark in Opposer’s Supplemental Register Registration is presumed to be merely descriptive, and opposer has introduced no evidence of use of its mark sufficient to prove that its alleged mark has acquired distinctiveness, it cannot prevail based solely on its ownership of this registration.”).

188. *H2O TO GO*, 2008 TTAB LEXIS 511 (principal registration cancelled under Section 2(d) based on supplemental registration).

2. Standard for Determining Likelihood of Confusion

Courts and the USPTO insist that they do not apply a different standard when a supplemental registration is cited under Section 2(d) from the standard they apply based on a principal registration.¹⁸⁹ The CCPA stated that “[t]he public is both unaware of, and distinctly disinterested in, whether a mark is registered on either register.”¹⁹⁰ Even a weak mark, says the USPTO, “is entitled to protection against the registration of a similar mark for closely related goods and services.”¹⁹¹ For purposes of registration, marks registered on the supplemental register need not have acquired distinctiveness in order to be likely to confuse consumers.¹⁹²

Nevertheless, the level of descriptiveness of the cited mark will affect the determination of likelihood of confusion.¹⁹³ Thus, a merely descriptive designation “may be entitled to a narrower scope of protection than an entirely arbitrary or coined word.”¹⁹⁴ As the CCPA stated in 1958:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.¹⁹⁵

189. *E.g.*, *In re Clorox Co.*, 578 F.2d at 308 (“Appellant . . . posits a requirement that citation of marks on the Supplemental Register under § 2(d) be limited to marks identical to that sought to be registered. No reason exists, however, for the application of different standards to registrations cited under § 2(d).”); *In re Cable Lock, Inc.*, 2012 TTAB LEXIS 418 (“No reason exists . . . for the application of different standards to registrations cited under § 2(d).”); *H2O TO GO*, 2008 TTAB LEXIS 511 (“The same standard applies regardless of the nature of the mark or the register on which it appears.”).

190. *In re Clorox Co.*, 578 F.2d at 308.

191. TMEP § 1207.01(b)(ix). *See also, e.g.*, *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 (C.C.P.A. 1974) (“Confusion is confusion. The likelihood thereof is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.”); *In re Filini Wine Co., LLC*, 2011 TTAB LEXIS 332 (T.T.A.B. 2011) (not citable as precedent) (“It is well established that even marks deemed ‘weak’ are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services.”); *In re Federal Express Corp.*, 2009 TTAB LEXIS 690 (T.T.A.B. 2009) (not citable as precedent) (“It is well settled, however, that even weak marks are entitled to protection against registration of similar marks for identical and/or closely related goods and services.”).

192. *In re Clorox Co.*, 578 F.2d at 308.

193. *E.g.*, *In re Cable Lock, Inc.*, 2012 TTAB LEXIS 418 (“The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely, . . . but that fact does not preclude citation under § 2(d) of marks on the Supplemental Register.”).

194. TMEP § 1207.01(b)(ix).

195. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160 (C.C.P.A. 1958).

Thus, a mark in a supplemental registration will in general be less likely to cause confusion with another mark.¹⁹⁶ In reality, because the scope of protection is narrow, likelihood of confusion between a supplemental registration and another mark is generally found only where the marks and goods are substantially similar.¹⁹⁷

Those faced with a likelihood of confusion claim based on a mark registered on the supplemental register have often argued that the marks must be identical or substantially identical in order for confusion to be found.¹⁹⁸ However, those arguments have been rejected.¹⁹⁹ The Board has reasoned:

[W]hen the registration cited as a bar in a Section 2(d) refusal is a Supplemental Register registration, likelihood of confusion has normally been found only where the applicant's and the registrant's marks and goods are substantially similar. This is not because a different likelihood of confusion standard or analysis is applied in cases involving cited Supplemental Register registrations, but rather because marks registered on

196. See *In re Shin*, 2009 TTAB LEXIS 139 (T.T.A.B. 2009) (not citable as precedent) (“[I]t is clear that the registered mark is merely descriptive. As a result, consumers are not likely to assume that all similar marks or permutations of registrant's mark indicate a common source.”).

197. E.g., *In re Select Jewelry Inc.*, 2012 TTAB LEXIS 347 (T.T.A.B. 2012) (“Even if the term ‘Radiance’ is deemed to be descriptive of jewelry, the evidence does not show that it is sufficiently weak so as to permit registration of applicant's mark which incorporates the entirety of registrant's mark for goods that are, in part, identical.”); *In re Modern Consulting Solutions*, 2010 TTAB LEXIS 121 (T.T.A.B. 2010) (not citable as precedent) (“[W]eak marks are entitled to protection against registration by a subsequent applicant of the same or similar mark for the same or closely related goods or services.”); *In re Ravensburger Aktiengesellschaft*, 2009 TTAB LEXIS 170 (T.T.A.B. 2009) (not citable as precedent) (“[T]he level of descriptiveness of a cited mark on the Supplemental Register may influence the conclusion that confusion is likely or unlikely. Indeed, in such cases, the scope of protection accorded to such a registration has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and goods are substantially similar.”); *In re Southern Belle Frozen Foods, Inc.*, 48 U.S.P.Q.2d 1849 (T.T.A.B. 1998) (“This Board has . . . accorded a very limited scope of protection to descriptive marks registered on the Supplemental Register.”); *In re Hunke & Jochleim*, 185 U.S.P.Q. 188 (T.T.A.B. 1975) (holding that “the scope of protection extended to [weak] marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods”).

198. E.g., *H2O TO GO*, 2008 TTAB LEXIS 511 (“[T]he standard for evaluating descriptive marks or marks on the Supplemental Register is not whether the marks are ‘substantially identical’ as respondent claims.”).

199. *In re Clorox Co.*, 578 F.2d at 308 (finding that supplemental register marks cited under Section 2(d) need not be identical to the marks sought to be registered); *In re Southern Belle Frozen Foods*, 48 U.S.P.Q.2d at 1851 (finding that, in earlier cases, “the Board was merely observing that, for [descriptive] marks, the scope of protection is, in the absence of other considerations, more limited than with arbitrary or coined marks,” rather than holding that protection is limited to substantially identical marks and goods).

Cf. *In re Gibson Guitar Corp.*, 2002 TTAB LEXIS 104 (T.T.A.B. 2002) (“The Federal Circuit has clearly rejected the argument that marks registered on the Supplemental Register are entitled to almost no scope of protection.”), citing *In re Research & Trading Corp.*, 793 F.2d 1276 (Fed. Cir. 1986).

the Supplemental Register are in most cases merely descriptive or otherwise weak, and thus are entitled to a quite narrow scope of protection.²⁰⁰

As seen from the table above in Section V.G, marks and goods need not as a rule be identical or substantially identical for the USPTO to find confusion, though they typically are.²⁰¹

Even if the marks are identical, a supplemental register mark may be so weak that a slight dissimilarity in goods may stop it from blocking another registration. In one case, a prior supplemental registration for HEALTH FACTS for a “periodically published news sheet” was the basis of a Section 2(d) rejection for HEALTH FACTS for “computer software for use by healthcare institutions and health care professionals in combining clinical data with claims based billing data and data from public sources.”²⁰² The Board concluded, in its likelihood of confusion analysis, that “the identity of the marks is essentially negated by the weakness of the registered mark HEALTH FACTS. Although a Supplemental Register registration may be a Section 2(d) bar to issuance of a subsequent Principal Register registration in appropriate cases, . . . we find that this is not such a case.”²⁰³

H. Cease and Desist Letters

The owner of a supplemental registration may refer to that registration in a cease and desist letter without mentioning the fact that it is on the supplemental register. If the receiving party is not sophisticated or well-advised enough to investigate the registration or understand its significance, then it may be bluffed into ceasing use of its mark unnecessarily.

There is a troubling ethical issue here. Does informing an unsophisticated party that it is infringing on a registered trademark constitute a misrepresentation where that trademark is registered on the supplemental register? The owner of a supplemental registration that does not specify which register its mark appears on can potentially harass unsuspecting trademark owners into believing they are violating rights where there are none. One commentator warned of this danger in 1948:

200. *In re Cerner Corp.*, 2001 TTAB LEXIS 87 (T.T.A.B. 2001).

201. *E.g.*, *In re Smith & Mehaffey*, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994) (“Because in most cases marks are registered on the Supplemental Register because they are descriptive, the scope of protection accorded to them has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and goods are substantially similar.”).

202. *In re Cerner Corp.*, 2001 TTAB LEXIS 87.

203. *See also In re Texas Instruments Inc.*, 193 U.S.P.Q. 678 (T.T.A.B. 1976) (COPPERCLAD and design for composite metal wire for use in electric conductors is not likely to cause confusion with COPPERCLAD, registered on the supplemental register, for copper-coated carbon electrodes for use in electric arc cutting and gouging).

Of course, registration on the Supplemental Register confers no new rights and creates not even a *prima facie* presumption of validity. . . . But registration has a psychological as well as legal effect, and the fact of registration may be improperly employed by the registrant as a club to induce respect for his claims. . . . [T]he possibilities for abuse must be recognized and the courts alerted against raids upon the common domain.²⁰⁴

Of more concern than such a case reaching the courts is the small business owner that stops using its mark after receiving a cease and desist letter based on a supplemental registration.

In discussions in the Subcommittee on Trademarks of the House Committee on Patents preceding passage of the Lanham Act, Representative Byerly expressed dismay that registrations under the Act of 1920 had “bluffed [businessmen] out of using things they have a perfect right to use.”²⁰⁵ While noting that such registrations would make foreign applications more convenient,²⁰⁶ Byerly emphatically continued, “it does not seem to me that justifies the thing becoming a real fraud and deceit in practice in the domestic trade by having this sort of registration.”²⁰⁷

It appears at present unlikely that such conduct would go so far as to violate the Model Rules of Professional Conduct. Model Rule 4.1 states that, in the course of representation, “a lawyer shall not knowingly (a) make a false statement of material fact or law to a third person; or (b) fail to disclose a material fact to a third person when disclosure is necessary to avoid assisting a . . . fraudulent act by a client. . . .” And Model Rule 1.0(d) defines “fraudulent” as “conduct that is fraudulent under the substantive or procedural law of the applicable jurisdiction and has a purpose to deceive.” Failure to mention that a registration is on the supplemental register may constitute failure to disclose a material fact, but disclosure in such a case is not “necessary to avoid assisting a . . . fraudulent act by a client.” Stating the existence of a federal registration while omitting the fact that it is on the supplemental register as the law stands now likely would not be “the equivalent of [an] affirmative false statement.”²⁰⁸

204. Milton Handler, *Trade-Marks and Anti-Trust Laws*, 88 TMR 440, 449 (1998), reprinted from 38 TMR 387 (1948).

205. Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76th Cong., 1st Sess. 128 (1939), reprinted in 8 Gilson on Trademarks 23-9.

206. See Part IV.B *supra*.

207. Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76th Cong., 1st Sess. 129 (1939), reprinted in 8 Gilson on Trademarks 23-9.

208. Model Rules of Professional Conduct 4.1, cmt. 1.

I. Use by Related Companies

A supplemental registration is eligible for the benefits of the “related company” doctrine in the Act.²⁰⁹ Under this doctrine, if a licensor of a registered or applied-for mark adequately controls its licensee’s quality, the licensee becomes a “related company” and the licensor can maintain ownership of rights through the licensee’s use alone.²¹⁰ This provision enables the licensor to rely on the licensee’s use for any purpose.

J. Advantages for Foreign Applicants

Foreign applicants seeking to register in the supplemental register under Section 44 need not allege use of their mark, merely a “bona fide intention to use the mark in commerce.”²¹¹ (This is true also for foreign applications for principal registrations.) Similarly, applicants under Section 44 may amend an application from the principal to the supplemental register without filing an allegation of use, and may retain their original filing date after amending to the supplemental register without use of the mark.²¹²

On the other hand, international applications filed pursuant to the Madrid Protocol seeking extension of protection in the United States may *not* obtain registration on the supplemental register.²¹³ Thus, marks filed in applications under Section 66(a) of the Act cannot be registered on the supplemental register.²¹⁴ Commentators have suggested that this is so because foreign

209. For more on this doctrine, see 2 Gilson on Trademarks § 6.04[2].

210. 15 U.S.C. § 1055.

211. 15 U.S.C. § 1126; TMEP §§ 1009, 1014. See Part III.C.1 *supra*.

212. TMEP § 1014.

213. 15 U.S.C. § 1141h(a)(4) (“Extension of protection shall be refused to any mark not registrable on the Principal Register.”); 37 C.F.R. § 2.47; TMEP § 1904.02(f) (“There is no provision in the Trademark Act for registration of a mark in a request for an extension of protection on the Supplemental Register.”).

214. TMEP § 801.02(b); 37 C.F.R. § 2.47(c). *In re Right-On Co.*, 87 U.S.P.Q.2d 1152, n.2 (T.T.A.B. 2008) (“Amendment to the Supplemental Register is not available for applications filed under Section 66(a) of the Trademark Act. Extension of protection shall be refused to any mark not registrable on the Principal Register.”).

See also Hines & Weinstein, *supra* note 137, at 1024-25 (“[O]ne wonders if there is any legal justification for the United States to deny Supplemental Register registration to Madrid applicants. . . . Due to the lesser benefits conferred by registration on the Supplemental Register, the issue may not be controversial. However, the practical effect is that Madrid applicants with descriptive marks, surname marks, ornamental marks, etc., may be wasting their time. If an amendment to the Supplemental Register is not available, and the applicant is not able to demonstrate acquired distinctiveness pursuant to Section 2(f) of the Act, then the applicant is out of luck. Foreign applicants with weak marks, but with long use in the United States, would be better advised to rely on that use rather than the Madrid Protocol. Other such foreign applicants, without prior use in the United States could file, or refile, on the basis of Section 44 in order to obtain registration on the Supplemental Register.”) (footnote omitted).

applicants filing with a Section 44 basis already have the advantage of obtaining supplemental registrations without a showing of use in commerce.²¹⁵

VI. THE PRIMARY DISADVANTAGE OF A SUPPLEMENTAL REGISTRATION: ADMISSION OF DESCRIPTIVENESS

Despite its several advantages, registration on the supplemental register has a distinct *dis*advantage: it constitutes an admission by the registrant that the registered matter was descriptive at the time of registration.²¹⁶ Even if the applicant continues to argue at the time of registration that its mark was distinctive, the decision to accept amendment to the supplemental register is still an admission that the mark is not inherently distinctive and had not acquired distinctiveness.²¹⁷ The fact that a term is registered on the supplemental register by a third party for goods or services similar to the applicant's is "probative evidence on the issue of descriptiveness."²¹⁸ Similarly, a claim of distinctiveness under Section 2(f) "may be construed as conceding that the matter to which it pertains is not inherently distinctive."²¹⁹

215. *Id.* at 1024 ("Rather than extending further advantage to foreign applicants, the implementing legislation is directed solely to the Principal Register.").

216. *E.g.*, *In re Future Ads LLC*, 103 U.S.P.Q.2d 1571 (T.T.A.B. 2012) ("[I]t is well-settled as a legal matter that a mark owner's acceptance of registration on the Supplemental Register constitutes an admission that the mark is descriptive at the time of registration."); *In re Select Jewelry Inc.*, 2012 TTAB LEXIS 347 (T.T.A.B. 2012) ("The fact that the cited . . . mark was registered on the Supplemental Register is *prima facie* evidence that, at least at the time of registration, the registered mark was merely descriptive."); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 U.S.P.Q.2d 1645 (T.T.A.B. 2010) ("Registration on the Supplemental Register is an admission by the registrant that the term was merely descriptive of its services, at least at the time of registration."); *Weeks Dye Works, Inc. v. Valdani, Inc.*, 2010 TTAB LEXIS 210 (T.T.A.B. 2010) (not citable as precedent) ("[B]y its amendment to the Supplemental Register respondent conceded that, at that time, its mark was merely descriptive and it is an implied admission that the registered term was descriptive at least at the time of the respondent's first use of the term."); *Perma Ceram Enters. v. Preco Indus.*, 23 U.S.P.Q.2d 1134 (T.T.A.B. 1992); *In re Hunke & Jochheim*, 185 U.S.P.Q. 188 (T.T.A.B. 1975).

See also Chisum, *supra* note 104, at 167-68 ("A disadvantage of accepting registration on the Supplemental Register is that it may create adverse inferences as to the mark's distinctiveness. Court decisions treat such registration as an admission that the mark is merely descriptive of its goods.").

217. *E.g.*, *In re Phase Dynamics, Inc.*, 2010 TTAB LEXIS 280 (T.T.A.B. 2010) (not citable as precedent); *In re Eddie Z's Blinds and Drapery Inc.*, 74 U.S.P.Q.2d 1037 (T.T.A.B. 2005) (holding that "applicant has, by its amendment [to the supplemental register], conceded that its proposed mark is merely descriptive").

218. *In re Freehailestimate.com*, 2012 TTAB LEXIS 486 (T.T.A.B. 2012) (not citable as precedent).

219. TMEP § 1202(b).

Still, the Board is not bound by that admission and may conclude that a mark registered on the supplemental register is, in fact, suggestive.²²⁰ Moreover, an applicant's earlier registration on the supplemental register does not stop it from showing that the mark in a later, similar application is inherently distinctive.²²¹

The Trademark Law Revision Act of 1988 amended the Lanham Act by providing that "[r]egistration of a mark on the Supplemental Register shall not constitute an admission that the mark has not acquired distinctiveness."²²² The TRC, on whose report the Act was largely based, recommended that the Act be amended to provide that "neither the filing of an application nor registration on the supplemental register constitutes an admission that the mark has not acquired secondary meaning."²²³ However, the amendment did not change existing case law that held that filing an application for registration on the supplemental register amounted to a concession that the mark had not acquired secondary meaning at the time the application was filed.²²⁴

In suggesting the amendment, the TRC stated explicitly that it was recommending codification of the *California Cooler* case.²²⁵ Plaintiff had registered CALIFORNIA COOLER for wine coolers on the supplemental register in February 1984, having begun use in 1981. Defendant began using CALIFORNIA SPECIAL COOLER for wine coolers in January 1984. Plaintiff filed an action in federal court seeking a preliminary injunction against defendant's use of

220. *In re Future Ads LLC*, 103 U.S.P.Q.2d 1571 ("Registration on the Supplemental Register is prima facie evidence that, at least at the time of registration, the registered mark was merely descriptive. However, prima facie evidence can be rebutted.") (citation omitted); *In re Hester Indus.*, 230 U.S.P.Q. 797 (T.T.A.B. 1986) ("It is true that a registration on the Supplemental Register is, in effect, an admission that the applicant believed the mark in question was merely descriptive when the application was filed or when it was amended to seek registration on the Supplemental Register. . . . However, we are not bound by the applicant's conclusions on this question . . .") (finding THIGHSTIX, registered on the supplemental register, suggestive of "shaped poultry thigh meat portions").

221. *In re Murad, Inc.*, 2010 TTAB LEXIS 31 (T.T.A.B. 2010) (not citable as precedent) ("Applicant's prior registration on the Supplemental Register does not prevent applicant from contending that its mark is inherently distinctive in this application.").

222. 15 U.S.C. § 1095; TMEP § 815.03. See Pub. L. 100-667.

223. TRC Report, *supra* note 124, at 414. See Kirkpatrick, *supra* note 42, at 249 ("This amendment removes some but not all of the evidentiary stigma which has attached to supplemental registrations.").

224. *Perma Ceram Enters.*, 23 U.S.P.Q.2d at 1137 n.11 ("We recognize that Section 27 was amended by the Trademark Law Revision Act of 1988 to include a provision that a Supplemental Register registration does not constitute an admission that the registered mark has not acquired distinctiveness. The general rule has not changed, however, that a registrant owner of a Supplemental Register registration impliedly admits that the registered term was descriptive (or deceptively misdescriptive) at least at the time of the registrant's first use of the term.").

225. TRC Report, *supra* note 124, at 414, citing *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451 (9th Cir. 1985).

its mark. The Ninth Circuit rejected defendant's argument that registration on the supplemental register constitutes a binding, conclusive admission "that at least up until the time of registration on the supplemental register, the mark lacked either sufficient distinctiveness or secondary identification, with the registrant's product to entitle it to any trademark protection." Defendant had claimed that plaintiff was barred from establishing acquired distinctiveness in later litigation against alleged infringers that had been using the mark when plaintiff obtained its supplemental registration.

The court reasoned that federal trademark registration "neither expands nor diminishes common law rights,"²²⁶ and thus that any deficiency in registration did not affect common law trademark rights. It stated: "Appellant asks us to hold that a manufacturer which registers on the supplemental register comes away with fewer rights than it would have had if it had not sought registration at all. This we decline to do." The court found "nothing [in the Lanham Act's legislative history] to indicate that it was intended to limit the scope of domestic litigation."²²⁷

Despite the above language in *California Cooler*, the owner of a supplemental registration actually does come away with an admission it would not have had to make without obtaining a registration. It has admitted that its mark was not distinctive at the time of registration. A party balancing whether to seek a supplemental registration, whether initially or by amendment, must weigh this disadvantage with the advantages of registration.

VII. PRINCIPAL REGISTER ADVANTAGES LOST BY REGISTRATION ON THE SUPPLEMENTAL REGISTER

A supplemental registration is the ninety-seven pound weakling of the Lanham Act. It simply lacks the muscle to defend itself. The many strengths of the *principal* register, on the other hand, make the choice clear: If at all possible, obtain registration on the principal register.

Under the Act, "applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1(b), 2(e), 2(f), 7(b), 7(c), 12(a), 13 to 18, inclusive, 22, 33, and 42 of this Act."²²⁸ This section describes the important advantages gained by having a registration on the

226. *California Cooler*, 774 F.2d at 1453, citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 117 n.3 (1938) ("It is well settled that registration under [the Trademark Act of 1920] has no effect on the domestic common-law rights of the person whose trade-mark is registered.").

227. *Id.* at 1453 n.2.

228. 15 U.S.C. § 1094.

principal register that do not attach to a registration on the supplemental register.²²⁹

***A. Not Prima Facie Evidence of Validity,
Ownership, or the Exclusive Right to Use the Mark***

The Act gives substantial evidentiary advantages to principal registrations that are specifically withheld from supplemental registrations. These are indeed potent in trademark enforcement proceedings.

Under Section 33(a), a principal registration “owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark . . . , of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration”²³⁰ Similarly, Section 7(b) provides that a certificate of principal registration “shall be prima facie evidence of the validity of the registered mark . . . , of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.”²³¹ Put bluntly by the Federal Circuit, a supplemental registration “is not evidence of ownership, validity, or the exclusive right to use.”²³²

**1. Not Prima Facie Evidence of Validity or
Non-Genericness**

A supplemental registration is not evidence that what is registered is a legitimate trademark. Supplemental registrations are not entitled to a presumption of validity either.²³³ In fact, they

229. See Chisum, *supra* note 104, at 168 (“Supplemental registration does not confer the most important Lanham Act registration benefits.”).

230. 15 U.S.C. § 1115(a).

231. 15 U.S.C. § 1057(b).

232. *In re Bush Bros. & Co.*, 884 F.2d 569, 571 n.2 (Fed. Cir. 1989). See also, e.g., *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353 n.9 (Fed. Cir. 2010) (“Supplemental registration is not prima facie evidence of the validity of the registered mark, of ownership of the mark, or of the registrant’s exclusive right to use the registered mark in commerce.”); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 704.03(b)(1)(A) (“[A] subsisting registration on the Supplemental Register, even when properly made of record by its owner, is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued.”).

233. E.g., *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 257 (2d Cir. 1962) (“[R]egistration cannot give validity to a mark, the use of which would be invalid at common law.”); *Humboldt Wholesale, Inc. v. Humboldt Nation Distrib., LLC*, 2011 U.S. Dist. LEXIS 141293 (N.D. Cal. 2011) (“Plaintiff’s trademark . . . on the supplemental register is not entitled to an evidentiary presumption of validity.”); *Allegheny Coupling Co. v. Betts Indus.*, 2011 U.S. Dist. LEXIS 34721 (W.D. Pa. 2011) (“When a mark has been federally registered on the USPTO Principal Register, there is a rebuttable presumption of validity . . . of the

are evidence that the registered subject matter was *not* valid at the time of registration.²³⁴ And a mark in a supplemental registration is presumed to be merely descriptive, so the party owning it must, in order to prove its validity, show that it has acquired distinctiveness.²³⁵

Owners of supplemental registrations have argued that their registrations are evidence that the registered marks are not generic. After all, if the USPTO had found the marks to be generic, it would not have permitted registration on the supplemental register in the first place.²³⁶ Some courts have been swayed by this argument, finding that the existence of a supplemental registration suggests that a mark is not generic.²³⁷

The USPTO, however, finds that a supplemental registration is not evidence of non-genericness. In one case, the applicant for LOCKBACK for a foldable utility knife had previously registered LOCK BACK on the supplemental register for a folding utility knife.²³⁸ The examining attorney refused registration to LOCKBACK as merely descriptive and then, after the applicant sought to register the mark under Section 2(f), found LOCKBACK

mark. In contrast, registration on the USPTO Supplemental Register confers no substantive trademark rights.”) (citation omitted).

234. See Part VI *supra*.

235. See, e.g., *Humboldt Wholesale, Inc.*, 2011 U.S. Dist. LEXIS 141293 (plaintiff supplemental registration owner survived motion to dismiss that was based on the invalidity of its marks given its evidence of acquired distinctiveness); *GamerModz, LLC v. Golubev*, 2011 U.S. Dist. LEXIS 116608, n.13 (M.D. Fla. 2011) (“A descriptive mark receives federal protection only if it has acquired a secondary meaning in the minds of the relevant consumers. . . . Registration of the plaintiff’s mark on the supplemental register does not affect this analysis.”); *Otter Prods. v. BaseOneLabs LLC*, 105 U.S.P.Q.2d 1252 (T.T.A.B. 2012).

236. A mark sought to be registered on the principal register may be refused registration as merely descriptive. TMEP § 1209. If the applicant then chooses to amend to the supplemental register, the examining attorney faces the new issue of whether the subject matter is even capable of distinctiveness. TMEP §§ 714.05(a)(i), 816.04.

237. *Express Diagnostics Int’l, Inc. v. Tydings*, 2009 U.S. Dist. LEXIS 5754 (N.D. Cal. 2009) (“Since the PTO has determined that DrugCheck is a descriptive mark, and has subsequently placed it on the Supplemental Register, the burden shifts to Defendants to demonstrate that DrugCheck is generic.”); *Munro & Assocs. v. Huthwaite Group*, 2006 U.S. Dist. LEXIS 29720, n.2 (E.D. Mich. 2006) (“Registration on the Supplemental Register is relevant to rebut the earlier opinion of the PTO that the . . . mark may be generic. However, . . . registration on the Supplemental Register does not give rise to any presumption that the mark is valid.”); *Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340, 365 (E.D.N.Y. 2006) (“A factor that militates against a finding of genericness is the PTO’s decision to grant [the] application to register [the mark] on the Supplemental Register, having found that the term was descriptive and capable of acquiring distinctiveness through secondary meaning. . . . The granting of the . . . application [amended to the supplemental register] suggests that the examiner determined the mark to be descriptive and capable of acquiring distinctiveness. Although the examiner’s conclusion obviously is not dispositive, courts ‘nevertheless “accord weight” to the initial conclusions of the Trademark Office.’”) (citations omitted).

238. *In re Great Neck Saw Mfrs., Inc.*, 2011 TTAB LEXIS 192 (T.T.A.B. 2011) (not citable as precedent).

to be generic for the goods. The applicant argued that the registration of its prior mark on the supplemental register “clearly proves that the Patent and Trademark Office has already decided that the mark is not generic and is capable of distinguishing applicant’s goods from those of others.” However, the USPTO explained that a supplemental registration is not *prima facie* evidence of the validity of the mark and in fact “is not *prima facie* evidence of anything except that the registration issued.” Thus, the ownership of the supplemental registration lacked any probative value whatsoever.²³⁹

2. Not Prima Facie Evidence of Ownership

A supplemental registration does not even provide *prima facie* evidence of ownership of the registered trademark,²⁴⁰ unlike the showing of ownership made by a principal registration.

3. Not Prima Facie Evidence of Exclusive Right to Use

No one has the exclusive right to use a descriptive term, so registration on the supplemental register is not *prima facie* evidence of an exclusive right to use the registered matter.²⁴¹ Registrations on the principal register, on the other hand, are *prima facie* evidence of “the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified,”²⁴² a powerful advantage.

239. See also *In re Federated Dep’t Stores*, 3 U.S.P.Q.2d 1541 (T.T.A.B. 1987) (finding that Board is free to consider the issue of whether matter is capable of being a mark even if it was previously registered on the supplemental register). Cf. *In re Entertainment Props. Trust*, 2008 TTAB LEXIS 293 (T.T.A.B. 2008) (not citable as precedent) (“[A] holding [of genericness] may appear to be at odds with applicant’s Supplemental Register registration However, it is well settled that neither the present examining attorney nor this Board is bound by the decisions as to registrability of prior examining attorneys.”).

240. *ERBE Elektromedizin GmbH v. Canady Tech. LLC*, 629 F.3d 1278 (Fed. Cir. 2010) (holding that ownership of a supplemental registration does not establish ownership of a valid mark); *Basel Action Network v. Int’l Ass’n of Elecs. Recyclers*, 793 F. Supp. 2d 1200, 1204 n.4 (W.D. Wash. 2011) (“Ownership of a registration on the supplemental register . . . is not evidence of ownership of a mark.”); *Allegheny Coupling Co.*, 2011 U.S. Dist. LEXIS 34721 (“When a mark has been federally registered on the USPTO Principal Register, there is a rebuttable presumption of . . . ownership of the mark. In contrast, registration on the USPTO Supplemental Register confers no substantive trademark rights.”) (citation omitted); *Otter Prods.*, 105 U.S.P.Q.2d at 1252 (finding that opposer’s introduction of supplemental registration into evidence “failed to introduce into evidence that that it has proprietary rights in its alleged mark”).

241. E.g., *McCormick & Co. v. Summers*, 354 F.2d 668, 674 (C.C.P.A. 1966) (“It must be remembered that registrations on the Supplemental Register do not receive the advantages of section 7(b) with regard to *prima facie* evidence of exclusive right to use.”); *Hi-Shear Corp. v. National Automotive Parts Ass’n*, 152 U.S.P.Q. 341 (T.T.A.B. 1966) (holding that a supplemental registration “manifestly . . . cannot be considered as evidence of a proprietary right in the registered mark”).

242. 15 U.S.C. § 1115(c).

B. Not Prima Facie Evidence of Priority of Use

Merely filing an application to register a mark on the principal register confers precious nationwide priority on the owner when the registration issues on the principal register.²⁴³ By contrast, a supplemental registration is not prima facie evidence of its owner's priority of use.²⁴⁴ And evidence of a supplemental registration does not prove the date of first use asserted in the registration in an inter partes case; that must be shown independently.²⁴⁵

C. Not Nationwide Constructive Notice of Registrant's Claim of Ownership

The Act also grants one of the most important attributes of a principal registration: Under Section 22, such a registration provides nationwide constructive notice of the registrant's claim of ownership of its mark.²⁴⁶ Similarly, Section 7(c) provides that a principal register application constitutes constructive notice of the mark when it matures to registration.²⁴⁷ Thus, a later user of a mark is deemed to have had knowledge of the registered mark from the time it was registered, unlike an unregistered mark that only has common law rights.²⁴⁸ Registrations on the supplemental register do not, of course, give constructive notice of a claim of ownership.²⁴⁹

243. 15 U.S.C. § 1115(c).

244. *E.g.*, *Deacy v. Kraft*, 2012 TTAB LEXIS 423 (T.T.A.B. 2012) (not citable as precedent) (“A Supplemental Register registration is incompetent as evidence to establish priority of use of defendant’s mark Thus, a later-filed application on the Principal Register could establish priority contingent upon registration of that application if there is no evidence of respondent’s prior use.”); *H20 TO GO, LLC v. Cook*, 2008 TTAB LEXIS 511 (T.T.A.B. 2008) (“[I]n the case of a registration on the Supplemental Register, a plaintiff is not entitled to rely on the underlying filing date as proof of priority. A registration issued on the Supplemental Register cannot be afforded any statutory presumptions under Section 7(b) of the Trademark Act and is therefore incompetent as evidence to establish priority of use.”).

245. *Otter Prods.*, 105 U.S.P.Q.2d at 1255 n.3; 37 C.F.R. § 2.122(b)(2).

246. 15 U.S.C. § 1072.

247. 15 U.S.C. § 1057(c).

248. *See* 1 Gilson on Trademarks § 4.02 on constructive notice.

249. *E.g.*, *McCormick & Co.*, 354 F.2d at 674 (finding that, because marks registered on the supplemental register do not have the benefit of constructive notice, opposer did not have constructive notice of applicant’s earlier-registered supplemental registration); *Loma Linda Food Co. v. Thomson & Taylor Spice Co.*, 279 F.2d 522, 525 (C.C.P.A. 1960) (“[T]he Lanham Act does not contemplate that . . . registrations on the supplemental register . . . shall constitute constructive notice of the registrant’s claim of ownership.”); *Plus Prods. v. Medical Modalities Assocs., Inc.*, 211 U.S.P.Q. 1199 (T.T.A.B. 1981) (holding that “a Supplemental Registration is not entitled to the constructive notice provision of Section 22 of the statute”).

D. Inability to Apply for Registration Based on an Intent to Use the Mark

What about the benefits of an intent-to-use application? An applicant filing with an intent to use its mark can establish constructive use, or nationwide priority, if its mark is eventually registered on the principal register.²⁵⁰ However, because a supplemental registration is not *prima facie* evidence of a right to use, the filing date of an application for the supplemental register does not constitute constructive use.²⁵¹ If an applicant files a Section 1(b) application requesting registration on the supplemental register, the examining attorney must refuse registration.²⁵² An applicant filing an intent-to-use application is not entitled to registration on the supplemental register unless and until it files an amendment to allege use or a statement of use.²⁵³ The mark must be “in lawful use in commerce” before the mark can be approved for registration.²⁵⁴

E. Not Prima Facie Evidence of Acquired Distinctiveness After Five Years

For applications to register marks on the principal register, five years of use in commerce is considered *prima facie* evidence of acquired distinctiveness under Section 2(f).²⁵⁵ Does this provision help owners of supplemental registrations? Hardly. Applications for the supplemental register “shall not be subject to or receive the advantages of section[] . . . 2(f).”²⁵⁶ It is true that, however, under

250. See 1 Gilson on Trademarks § 3.03[3].

251. TRC Report, *supra* note 124, at 404.

252. TMEP § 815.02.

253. 15 U.S.C. § 1051(b); 37 C.F.R. § 2.47(d); TMEP §§ 206.01, 815.02 (“[A]n intent-to-use applicant is not eligible for registration on the Supplemental Register until the applicant has filed an acceptable allegation of use.”), 1102.03 (“A mark in an intent-to-use application is not eligible for registration on the Supplemental Register until the applicant has submitted an acceptable allegation of use (i.e., either an amendment to allege use . . . or a statement of use . . .).”).

254. For more on “lawful use,” see Part III.C *supra*.

255. 15 U.S.C. § 1052(f).

256. 15 U.S.C. § 1094. See also *Humboldt Wholesale, Inc.*, 2011 U.S. Dist. LEXIS 141293, n.2 (finding that plaintiff failed to demonstrate that its mark, registered on the supplemental register, was entitled to any presumption of secondary meaning; “The statute does not suggest that a mark exclusively used in commerce for five years automatically gains a presumption of secondary meaning, regardless of registration.”).

Not all courts recognize that Section 2(f) is one of the sections that does not apply to supplemental registrations. See *In re Bush Bros. & Co.*, 884 F.2d 569, 570 (Fed. Cir. 1989) (“If the mark [on the supplemental register] later acquires distinctiveness through use in commerce, . . . (five years of substantially exclusive and continuous use as a mark may be deemed *prima facie* evidence of secondary meaning), the mark becomes eligible for registration on the Principal Register.”).

the Act, a mark in a supplemental registration is capable of being registered later on the principal register.²⁵⁷

F. Inability to Become Incontestable

A principal registration may become incontestable after five years pursuant to Section 33(b),²⁵⁸ but supplemental registrations are ineligible for incontestable status.²⁵⁹ Though incontestability is the strongest trademark protection under U.S. law, note that incontestable registrations are not, in fact, unassailable. They may be challenged, for example, on the ground that the registration was fraudulently obtained, that the mark was abandoned, that the mark is functional or generic, or that the mark is used to misrepresent the source of goods or services.²⁶⁰

G. Inability to Stop Importation of Counterfeit or Infringing Goods

The Act provides that a supplemental registration “shall not be filed in the Department of the Treasury or be used to stop importations.”²⁶¹ Thus, a registration on the supplemental register cannot be recorded with the U.S. Bureau of Customs and Border Protection to halt importations of counterfeit goods into the United States.²⁶²

H. Inability to File Through TEAS Plus

Applicants for registration on the supplemental register also cannot use the money-saving TEAS Plus system for filing, which is available only to principal register applicants.²⁶³ Online filing of a trademark application under TEAS on either register is \$325 per class, while TEAS Plus online filing for principal register

257. “Registration of a mark on the supplemental register . . . shall not preclude registration by the registrant on the principal register established by this Act.” 15 U.S.C. § 1095. *See also* *Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340, 347 (E.D.N.Y. 2006) (“If, through continuous use in commerce, the mark acquires ‘secondary meaning’—that is, the mark comes to be uniquely associated with its source—it becomes eligible for registration on the Principal Register.”).

258. 15 U.S.C. § 1115(b).

259. TMEP § 1605.01 (“Section 15 affidavits or declarations may not be filed for marks registered on the Supplemental Register of the Act of 1946”); *Hair Assocs. v. Nat’l Hair Replacement Servs.*, 987 F. Supp. 569, 583 (W.D. Mich. 1997) (“[T]hat mark is registered only on the supplemental register and, thus, cannot become incontestable.”).

260. *See generally* 1 Gilson on Trademarks § 4.03.

261. 15 U.S.C. § 1096.

262. *See* 1 Gilson on Trademarks § 4.05 for more on U.S. Customs enforcement.

263. 37 C.F.R. § 2.22(c)(4); TMEP § 819.01(a) (“Applications for certification marks, collective marks, and collective membership marks and applications for registration on the Supplemental Register cannot be filed using TEAS Plus.”).

applicants is \$275 per class.²⁶⁴ TEAS Plus filings must be made online, correspondence must be carried out online, and the application must include information beyond that which is minimally required to receive a filing date.²⁶⁵

VIII. COMMON MISTAKES IN AMENDING TO THE SUPPLEMENTAL REGISTER

The nearly universal path to the supplemental register comes not with filing an application directly, but after the USPTO rejects an application for the principal register. If the USPTO refuses registration on grounds of nondistinctiveness, the applicant may seek amendment to the supplemental register (or claim acquired distinctiveness under Section 2(f)).²⁶⁶ Such an amendment or claim generally presents a new issue for the examining attorney.²⁶⁷

If the USPTO refuses registration on a basis that could not be cured by amending to the supplemental register, such as Sections 2(a), 2(b) or 2(d), the examining attorney is not precluded from issuing a final refusal.²⁶⁸ Requesting an amendment to the supplemental register will also not cure a refusal based on functionality,²⁶⁹ and the USPTO will refuse registration if it finds,

264. 37 C.F.R. § 2.6(a)(1)(ii), (iii).

265. 37 C.F.R. § 2.22; TMEP § 819; 4 Gilson on Trademarks § 15.08[1].

266. 37 C.F.R. § 2.75(a) (“An application for registration on the Principal Register under section 1(a) or 44 of the Act may be changed to an application for registration on the Supplemental Register and vice versa by amending the application to comply with the rules relating to the appropriate register, as the case may be.”); TMEP § 816 (“Amending Application to Supplemental Register”), § 816.04 (“In an application under §1 or §44 of the Trademark Act, the applicant may amend to the Supplemental Register after a refusal to register, including a final refusal. If the final refusal was under §2(e)(1), §2(e)(2), or §2(e)(4) . . . or on grounds pertaining to other non-inherently distinctive subject matter, amendment to the Supplemental Register is procedurally an acceptable response.”).

267. TMEP § 714.05(a)(i).

268. TMEP §§ 714.05(a)(i), 1202.17(c)(ii)(B). See *In re Astilean*, 2008 TTAB LEXIS 146 (T.T.A.B. 2008) (not citable as precedent) (“[A]mendment to the Supplemental Register of an application for a mark that is otherwise capable of registration may overcome a refusal to register on the grounds that such mark is merely descriptive or deceptively misdescriptive, primarily geographically descriptive or primarily merely a surname, or on other grounds that such mark consists of matter that is not inherently distinctive, such as a configuration, color mark, or mark comprising matter that is purely ornamental.”); *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047 (T.T.A.B. 2002) (holding that “an amendment of the application to the Supplemental Register would not contravene the refusal under Section 2(a) of the statute that the term . . . is deceptive”); *In re Juleigh Jeans Sportswear Inc.*, 24 U.S.P.Q.2d 1694 (T.T.A.B. 1992) (amendment to the supplemental register responding to a refusal under Section 2(a) does not obviate basis for refusal).

269. TMEP § 1202.02(a)(iii)(A) (“[I]f an applicant responds to a functionality refusal under §2(e)(5) . . . by submitting an amendment seeking registration on the Supplemental Register, such an amendment does not introduce a new issue warranting a nonfinal Office action. . . . Instead, the §2(e)(5) refusal must be maintained and made final, if appropriate.”).

after an attempt to amend to the supplemental register, that the applied-for term is generic.²⁷⁰

However, there are exceptions to amending to the supplemental register. An applicant seeking an extension of protection to the United States under the Madrid Protocol, filing under Section 66(a), cannot amend to the register.²⁷¹ Applications filed under Section 1(b), claiming intent-to-use, may be amended to the supplemental register only after submission of an amendment to allege use or a statement of use. Supplemental registrations by themselves are not eligible for the intent-to-use procedure.²⁷²

An applicant facing a descriptiveness refusal may argue in the alternative that its mark has gained acquired distinctiveness under Section 2(f) or that its mark should be registered on the supplemental register.²⁷³ If the matter in the application cannot serve as a mark—say it is generic or ornamental—the examining attorney will refuse registration on both the principal and supplemental registers.²⁷⁴ But if it is capable of serving as a mark, the examining attorney will consider the Section 2(f) evidence.²⁷⁵

In order to preserve the right to amend to the supplemental register, the applicant should make its request to amend in the alternative in response to a final refusal of registration on the principal register.²⁷⁶ At that point, if the examining attorney finds the mark registrable on the supplemental register, the applicant may appeal the denial of principal registration to the Board.

270. See, e.g., *In re Sambado & Son Inc.*, 45 U.S.P.Q.2d 1312 (T.T.A.B. 1997) (affirming refusal of registration after applicant sought to amend to supplemental register because the term of FRUTTA FRESCA was generic for the goods, which were fresh fruit).

271. 37 C.F.R. § 2.75(c).

272. 37 C.F.R. § 2.75(b); TMEP § 1102.03. E.g., *In re Professional Capital Servs., LLC*, 2009 TTAB LEXIS 553 (T.T.A.B. 2009) (not citable as precedent) (where the proposed mark was not in use in commerce, the Board did “not have the authority to permit the entry of an amendment to the Supplemental Register”). See Part VII.D *supra*.

273. TMEP §§ 816.04, 1212.02(c). See *In re Reed Elsevier Properties Inc.*, 77 U.S.P.Q.2d 1649 (T.T.A.B. 2005) (“Pursuit of registration under Section 2(f) is a concession that the proposed mark is not inherently distinctive. A proposed amendment to seek registration on the Supplemental Register, however, is not an admission that the proposed mark has not acquired distinctiveness. Thus, an applicant may argue in the alternative that a non-distinctive designation has acquired distinctiveness and is registrable on the Principal Register or at least is capable of acquiring distinctiveness and is registrable on the Supplemental Register.”) (citations omitted).

274. TMEP § 1202.02(c).

275. TMEP § 1202.02(c).

276. *In re Costantine*, 2011 TTAB LEXIS 16 (T.T.A.B. 2011) (not citable as precedent) (“If applicant had wanted to preserve his right to amend the application to seek registration on the Supplemental Register, the proper procedure would have been to respond to the final refusal of Principal Register registration with a request to amend the application to one seeking registration on the Supplemental Register, while preserving his right to argue entitlement to registration on the Principal Register.”). See also TMEP § 715.02 (“[A]n amendment requesting registration on the Supplemental Register . . . may be a proper response to a final refusal of registration on the Principal Register in some circumstances.”).

Once the applicant has appealed such a denial and the Board has affirmed it, the applicant cannot then request an amendment to the supplemental register.²⁷⁷ Nor may the applicant request such an amendment in its reply brief.²⁷⁸ One reason for this is that an application to the supplemental register may raise the new issue of whether the matter the application is capable of distinguishing the applicant's goods and services.²⁷⁹ The applicant's only course of action at that point is to file a new application requesting supplemental registration.²⁸⁰

IX. CHALLENGING A SUPPLEMENTAL REGISTRATION

No one may oppose an application for supplemental registration. The Act prohibits it by not providing an opportunity to do so.²⁸¹ Marks approved for supplemental registration are not

277. 37 C.F.R. § 2.142(g) ("An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director"); TMEP § 816.05 ("An applicant may not amend to the Supplemental Register after the Trademark Trial and Appeal Board has affirmed a refusal of registration on the Principal Register."); § 1501.06 ("[T]he Director will deny a petition to reopen prosecution if granting the petition would require further examination (e.g., to consider a claim of acquired distinctiveness under 15 U.S.C. §1052(f) or an amendment to the Supplemental Register)."); TBMP § 1218 ("Once an application has been considered and decided by the Board on appeal, applicant's course of action normally is limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom. . . . An application may not be 'reopened,' that is, an applicant may not amend its application . . . at this stage").

See, e.g., In re Costantine, 2011 TTAB LEXIS 16 (holding that "applicant may not pursue the 'wholly different procedural alternative' of obtaining registration on the Supplemental Register after having elected to appeal the refusal as to the Principal Register under Trademark Act §§ 2(e)(1) and 2(f)") (citation omitted); *In re Legal Promotions, Inc.*, 2008 TTAB LEXIS 130 (T.T.A.B. 2008) (not citable as precedent); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 U.S.P.Q.2d 1748 (T.T.A.B. 2002); *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d at 1048 n.2 ("Finally, as to the request in applicant's brief that, 'even if these refusals are maintained, . . . its application be amended to the Supplemental Register,' it is pointed out that under Trademark Rule 2.142(g), 'an application which has been considered and decided on appeal will not be reopened' for such purpose."); *In re S. D. Fabrics, Inc.*, 223 U.S.P.Q. 56 (T.T.A.B. 1984) ("While the Board can and does accept disclaimers after appeal in appropriate cases . . . the Board cannot and will not accept a conversion to the Supplemental Register after a case has been decided on appeal Such an amendment may be accepted only by the Commissioner upon petition made for that purpose.").

278. *In re Costantine*, 2011 TTAB LEXIS 16 (holding that "applicant may not request amendment to the Supplemental Register for the first time in his reply brief" to the Board).

279. *In re S. D. Fabrics, Inc.*, 223 U.S.P.Q. at 57 ("[T]he conversion of an application to the Supplemental Register raises a new issue (e.g., whether the term sought to be registered is capable of functioning as a mark), the determination of which would require further examination. Thus, the Commissioner has in the past denied such petitions.").

280. TMEP § 816.05.

281. 15 U.S.C. § 1092 ("Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the

published for opposition,²⁸² but instead, solely to give notice of the registration, are printed in the *Official Gazette*.²⁸³ They are considered to be registered when they appear in the *Official Gazette*.²⁸⁴

In addition, no one can initiate an interference proceeding based on an application for a supplemental registration.²⁸⁵ This is a rarely used process whereby the USPTO decides who is entitled to registration as between two or more applicants for the same or confusingly similar marks.

The only way to attack a supplemental registration is through a petition for cancellation under Section 24.²⁸⁶ The Act provides for such a proceeding specifically for supplemental registrations, which may be brought by anyone who believes he or she would be damaged by such a registration.²⁸⁷ A cancellation proceeding may be filed “at any time” against a supplemental registration, unless it is based on a claim of dilution, which can be filed only if the effective filing date of the registration is after the date the petitioner’s mark became famous.²⁸⁸

The registration will be canceled if “the registrant is not entitled to registration” or “the mark has been abandoned.”²⁸⁹ A mark is entitled to registration on the supplemental register if it is capable of distinguishing the applicant’s goods or services, if it is in “lawful use in commerce,”²⁹⁰ “and is not prohibited from

Patent and Trademark Office.”); TMEP § 1502 (“Marks registered on the Supplemental Register cannot be opposed.”).

282. 37 C.F.R. § 2.82 (“In the case of an application for registration on the Supplemental Register the mark will not be published for opposition”); TMEP § 815 (“Marks on the supplemental register are not published for opposition”); TBMP §§ 205, 301.02.

283. TBMP § 205 (“Upon issuance of the registration, the mark appears in the *Official Gazette*, not for opposition, but rather to give notice of the registration’s issuance.”).

284. 37 C.F.R. § 2.82 (“The mark will be published in the *Official Gazette* when registered.”); TMEP § 815 (“Marks on the Supplemental Register . . . are issued as registered marks on the date that they are printed in the *Official Gazette*.”), § 1502 (“Marks that are found to be registrable on the Supplemental Register are registered when printed in the *Official Gazette*.”).

285. Interference proceedings are provided for at 15 U.S.C. § 1066, Section 16 of the Lanham Act. 15 U.S.C. § 1094 declares that “applications for . . . the supplemental register shall not be subject to . . . sections . . . 13 to 18, inclusive” For more on interference proceedings, see 3 Gilson on Trademarks § 9.01[2][iv].

286. 15 U.S.C. § 1092; TBMP §§ 205, 301.02 (“The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued.”). See *Novartis Consumer Health v. McNeil-PPC, Inc.*, 53 U.S.P.Q.2d 1406 (D.N.J. 1999) (dismissing counterclaim seeking to cancel a supplemental registration under Section 14 of the Lanham Act (15 U.S.C. § 1064) on the ground that Section 14 “applies only to the cancellation of marks on the Principal Register”).

287. 15 U.S.C. § 1092.

288. 15 U.S.C. § 1092. See Part III.D *supra*.

289. 15 U.S.C. § 1092.

290. See Part III.C *supra*.

registration by Section 2(a), (b), (c), (d) and (e)(3) of the . . . Act.”²⁹¹ Thus, if a mark has been abandoned or is not capable of distinguishing the applicant’s goods or services or is prohibited from registration under Section 2(a), (b), (c), (d) or (e)(3), the registration may be cancelled. Registrations may also be cancelled for noncompliance with Section 2(e)(5), providing that functional subject matter is not protectable, though the Board reasons that functional matter is incapable of distinguishing an applicant’s goods and services.²⁹²

The most common reason for cancellation of a supplemental registration is if the mark is found to be generic and incapable of distinguishing the registrant’s goods or services.²⁹³ However, a supplemental registration can also be cancelled on grounds of abandonment,²⁹⁴ lack of lawful use in commerce,²⁹⁵ likelihood of confusion,²⁹⁶ dilution and functionality.

Before 1988, the Act provided that a supplemental registration should be cancelled if the registrant “was not entitled to register the mark at the time of his application for registration thereof.”²⁹⁷ The Trademark Law Revision Act of 1988 changed this, so that if the Board finds “that the registrant is not entitled to registration,” its registration “shall be cancelled.”²⁹⁸

291. *Int’l Flora Techs., Ltd. v. Desert Whale Jojoba Co.*, 2010 TTAB LEXIS 304 (T.T.A.B. 2010) (not citable as precedent).

292. *Kistner Concrete Prods. v. Contech Arch Techs., Inc.*, 97 U.S.P.Q.2d 1912 (T.T.A.B. 2011) (“The Board has rejected the argument that a product configuration that is functional can still be capable of distinguishing one seller’s goods from those of another and therefore is registrable on the Supplemental Register.”).

293. *E.T. Browne Drug Co. v. Cococare Prods.*, 538 F.3d 185, 202 (3d Cir. 2008) (“If Cococare does prove ‘Cocoa Butter Formula’ to be generic, the District Court then could order the removal of that term from the supplemental register.”); *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892 (C.C.P.A. 1966) (affirming decision to cancel supplemental registration for TURBODIESEL for internal combustion engines on ground that the term was generic); *Int’l Flora Techs., Ltd.*, 2010 TTAB LEXIS 304 (“[A] Supplemental Registration may be cancelled if the ‘mark’ is or becomes a generic term, because such a term is not capable of distinguishing a party’s goods or services . . .”; ordering cancellation of supplemental registration on ground of genericness).

294. *E.g.*, *PBI Performance Prods., Inc. v. Norfab Corp.*, 2007 U.S. Dist. LEXIS 58689 (E.D. Pa. 2007) (ordering cancellation of supplemental registration on ground of abandonment).

295. *CreAgri, Inc. v. USANA Health Sci., Inc.*, 474 F.3d 626, 634 (9th Cir. 2007) (finding mark “properly cancelled” from the supplemental register where it was not lawfully used in commerce before the date it filed its supplemental registration); *Moore Business Forms, Inc. v. Continu-Forms, Inc.*, 9 U.S.P.Q.2d 1907 (T.T.A.B. 1988) (cancelling supplemental registration for failure to make lawful use in commerce).

296. *Kraft Inc. v. Country Club Food Indus., Inc.*, 230 U.S.P.Q. 549 (T.T.A.B. 1986) (granting petition to cancel supplemental registration based on likelihood of confusion with petitioner’s mark).

297. Pub. L. 100-667. *See* *Loctite Corp. v. Nat’l Starch & Chem. Corp.*, 516 F. Supp. 190 (S.D.N.Y. 1981) (cancelling supplemental registration on ground that registered mark had become generic before plaintiffs’ application to the supplemental register).

298. 15 U.S.C. § 1092.

X. PROPOSALS FOR CHANGE

A. Should the Supplemental Register Be Abolished?

The obvious question when contemplating this topic is whether the United States should continue to maintain the supplemental register or whether it should be eliminated altogether. Does it make sense for registrants to gain advantage for the price of a filing fee? Do the filing fees for registering non-trademarks warrant the USPTO expense of examination and its administrative overhead?

First, it is counterintuitive to the concept of trademarks and distinctiveness to give government recognition to material that does not serve as a trademark. It is at best irrational to allow federal registration of such material, and at worst potentially damaging to those with conflicting and valid trademark rights, as well as deceptive to the public encountering the ® masquerading as notice of actual rights. One might argue in favor of the supplemental register that it “provides an important vehicle for owners of marks capable of distinguishing to put the world on notice of their rights.”²⁹⁹ But these are not *rights* at all. They are uses of descriptive terms or nondistinctive configurations, not trademark rights.

Second, consider whether the supplemental register currently fulfills the function it was created to perform: enabling United States citizens to obtain foreign registrations.³⁰⁰ The USTA TRC concluded in 1987 that the supplemental register should be retained because it “still facilitates the ability of American businesses to obtain trademark registrations in foreign countries.”³⁰¹ Is this premise valid a quarter century later? Only in small part. We have seen that it continues to be somewhat helpful for a U.S. citizen to have a home registration in order to obtain another in a foreign country, though it is surely not necessary and also carries no guarantee of success.³⁰²

Only supplemental registrations owned by U.S. citizens can possibly be used to apply for foreign registrations. That number is currently 67,205, a total of just 3.6% of all registrations³⁰³ and 92%

299. TRC Report, *supra* note 124, at 413. See also *In re Bush Bros. & Co.*, 884 F.2d 569, 570 (Fed. Cir. 1989) (“Judicial focus on the Supplemental Register has been sparse, perhaps because of the ease of registration thereon, coupled with the general policy favoring registration as a matter of public information and for other benefits.”).

300. See Part IV *supra*.

301. TRC Report, *supra* note 124, at 413.

302. See Part IV.C *supra*.

303. In order to find the supplemental registrations owned by U.S. registrants, at <http://tess2.uspto.gov/>, in the free form section, input SUPPLEMENTAL[RG] and LIVE[LD] and `RN > “0”, along with “united states” and a list of U.S. states separated by “and” and ending with [OW].

of all supplemental registrations. How many of these have foreign counterparts? It is doubtful today that many of these registrations were obtained with the goal of foreign protection.

Third, we know that registrations on the supplemental register are, simply, rare. As of this writing, registrations on the supplemental register account for 3.9% of all registrations with the USPTO, with 72,899 live supplemental registrations and 1,864,807 total live registrations.³⁰⁴ This chart shows the total numbers of principal registrations and supplemental registrations, along with the percentage of the whole made up by supplemental registrations, over several years:³⁰⁵

	FY 1951	FY 1955	FY 1959	FY 1963	FY 1967	FY 1970	FY 1987	FY 1988
Certificates of Registration Issued for Principal Register	15,337	14,575	16,803	17,253	19,183	21,018	45,600	45,090
Certificates of Registration Issued for Supplemental Register	2,068	1,523	874	1,013	1,420	956	1,922	1,614
Percentage of Registrations on Supplemental Register	11.9%	9.5%	4.9%	5.5%	6.9%	4.4%	4.0%	3.5%

	FY 1989	FY 1990	FY 1991	FY 1992	FY 1993	FY 1994	FY 1995	FY 1996
Certificates of Registration Issued for Principal Register	49,744	54,178	41,795	59,749	72,111	57,801	63,044	75,705

304. To find the number of current, live supplemental registrations, go to <http://tess2.uspto.gov/>, and in the free form search, input SUPPLEMENTAL[RG] AND LIVE[LD] AND `RN > "0".

305. See <http://www.uspto.gov/about/stratplan/ar/index.jsp> for links to the USPTO's Performance and Accountability Reports from fiscal year 1993 to fiscal year 2012. These statistics are found in the USPTO's Workload Tables under Summary of Trademark Examining Activities. Statistics for earlier years are from Smejda, *supra* note 114, at 286 n.7.

	FY 1989	FY 1990	FY 1991	FY 1992	FY 1993	FY 1994	FY 1995	FY 1996
Certificates of Registration Issued for Supplemental Register	2,058	2,337	1,357	2,318	2,238	1,996	2,618	2,969
Percentage of Registrations on Supplemental Register	4.0%	4.1%	3.1%	3.7%	3.0%	3.3%	4.0%	3.8%

	FY 1997	FY 1998	FY 1999	FY 2000	FY 2001	FY 2002	FY 2003	FY 2004
Certificates of Registration Issued for Principal Register	93,547	86,017	83,856	101,058	97,340	126,160	137,068	115,276
Certificates of Registration Issued for Supplemental Register	3,747	3,617	3,918	5,325	4,974	7,065	6,356	4,780
Percentage of Registrations on Supplemental Register	3.9%	4.0%	4.5%	5.0%	4.9%	5.3%	4.4%	4.0%

	FY 2005	FY 2006	FY 2007	FY 2008	FY 2009	FY 2010	FY 2011	FY 2012
Certificates of Registration Issued for Principal Register	107,018	140,908	142,672	201,560	172,527	157,324	170,029	174,057
Certificates of Registration Issued for Supplemental Register	5,477	6,210	7,392	8,344	7,993	7,006	7,632	8,704
Percentage of Registrations on Supplemental Register	4.9%	4.2%	5.0%	4.0%	4.4%	4.3%	4.3%	4.8%

This paucity suggests that the supplemental register is not a vital part of the American trademark system.

If we were drafting a United States trademark law right now from scratch, we would exclude a supplemental register. Without the current register, it would never occur to legislators—and properly so—to have a database of non-trademarks.

However, it is difficult to imagine what impetus owners and potential owners of supplemental registrations would have to eliminate the system, as it benefits them in several ways.³⁰⁶ Even if current registrants were grandfathered in and allowed to keep their registrations, Congress would be unlikely to bother eliminating future registrations. Ultimately, a call for elimination of the supplemental register would surely fall on deaf ears. There is no groundswell for eliminating it, and amending the Act to do so would present a daunting challenge on legislative, trade association and business grounds. Perhaps it could be added to the list if there is ever a Trademark Review Commission II. . . .³⁰⁷ Still, there is certainly room for improvement under the present system.

B. Should Supplemental Registrations Be Able to Block Principal Registrations on Likelihood of Confusion Grounds?

For example, one needed amendment would prohibit the USPTO from citing supplemental registrations against principal register applications under Section 2(d).³⁰⁸ This would be a sensible and welcome change, given that, from a public policy standpoint, these non-marks should not prevent registration of actual trademarks. Because the USPTO persists in maintaining the fiction that it cannot question the validity of a supplemental registration in ex parte proceedings,³⁰⁹ then the time has come to amend the Act so that the USPTO can see things as they are.

C. Should the Act Allow for Oppositions of Supplemental Register Applications?

The reason for omitting an opposition proceeding for supplemental registrations appears to have been a desire to register those marks more quickly so that registrants could obtain foreign registrations sooner.³¹⁰ That reason is antiquated and no

306. See Part V *supra*.

307. Jerome Gilson & Anne Gilson LaLonde, *The Lanham Act: Time for a Face-Lift?* 92 TMR 1013, 1039-40 (2002) (calling for the establishment of Trademark Review Commission II).

308. See Part V.G *supra*.

309. See Part V.G.1 *supra*.

310. *In re Serv-A-Portion, Inc.*, 1 U.S.P.Q.2d 1915 (T.T.A.B. 1996) ("The owners of the Supplemental Register registrations may have requested registration on that register

longer applicable. As long as supplemental registrations can block principal register applications, the Act should provide for opposition proceedings against supplemental registrations.

D. Should Owners of Supplemental Registrations Be Allowed to Use the ® Symbol?

The use of this symbol misleads the public in communicating the existence of trademark rights where there are none. Accordingly, those who own supplemental registrations should no longer be allowed to use the ® symbol.³¹¹

Could there possibly be any rational reason to allow this public deception to take place? The TRC weighed in on this issue in 1987, contemplating the possibility of “a different type of notice symbol for supplemental register marks.”³¹² Its report concluded, though, that eliminating or changing the ® for supplemental registrations “would be counterproductive and confusing to trademark owners and the public. The symbol is designed to notify the public of federal registration. Members of the public can then inspect the PTO records to determine whether the registration is principal or supplemental and whether it has any limitations.”³¹³

Is it realistic to expect a consumer or potential trademark owner to see the symbol on goods or services, log on to the USPTO electronic search system, locate a registration status, and understand that it is not evidence of any trademark rights at all? With due respect to the TRC, the expectation today of the public investigating the USPTO’s records is preposterous.³¹⁴

XI. CONCLUSION

“So you see, Mrs. Hooper, it is possible for someone with one of these supplemental registrations to prevent you from getting your principal registration,” I said, rubbing my eyes from exhaustion.

“My real registration, you mean.”

merely to secure issuance of the United States registration more quickly, in order to use them in support of applications to register the marks in foreign countries which require as a condition that an applicant prove prior registration in its country of origin. . . . Applications for registration on the Supplemental Register are not published for opposition purposes under Section 12(c) of the Act which reduces their average pendency.”).

See Part IV supra.

311. *See Part V.D supra.*

312. TRC Report, *supra* note 124, at 414.

313. *Id.* at 414-15.

314. *In re Clorox Co.*, 578 F.2d at 308 (“The public is both unaware of, and distinctly disinterested in, whether a mark is registered on either register.”); *In re Southern Belle Frozen Foods*, 48 U.S.P.Q.2d at 1851 n.2 (“[T]he general public is, obviously, unaware of the register on which a mark they encounter is registered.”).

I glanced at my desk drawer, itching to open it and finish off those arrogant pigs. “Well, they’re both real. Whether or not they should be is another question. But I think in your case we can argue to the PTO that the marks are different enough that there’s no likelihood of confusion, especially given that this other mark, DOGGY BACON, is pretty weak. Your double entendre with BACONRY should go a long way to convincing the examining attorney that consumers won’t be confused.”

Mrs. Hooper leaned back, crossed her arms and sighed contentedly. “Very clever, I thought.”

“It sure is, ma’am.” I scribbled some notes on my pad.

“Do you think, young man,” interrupted Mrs. Hooper, tapping on my desk with her cane, “that I should try to get my own supplemental registration?”

“Are you crazy?” I asked. She growled at me. “Sorry, but no one just applies for the supplemental register. You try for the principal register then amend to the supplemental if you get a 2(e)(3) refusal.”

“Why waste my time and money waiting for a refusal?” Mrs. Hooper responded. “I use REAL MEAT TASTY TREAT on my labels—that probably isn’t a real trademark, but maybe that could go on the supplemental register. What do you think, Ben? I could use the R in a circle, the Trademark Office would stop people from using the same thing, people would see it in a search and decide not to use it. And just maybe . . . maybe someday it would grow up and become an actual trademark.” Mrs. Hooper sniffed and reached for a tissue from the box on my desk. “Wouldn’t I be proud? Oh my.”

Oh my, indeed.
