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For more information on the U.S. Trademark Industry please visit www.rmclegal.com

J.J. Burchman, Attorney

Phone: 517.999.5414

Burchman@rmclegal.com

Blaine R. DeGracia, Attorney

Phone: 517.507.3857

DeGracia@rmclegal.com

If you are interested in discussing how trademark and/or copyright protection might help your business profitability, please contact us.

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Regulatory Management Counselors, P.C.

Asher Court
321 W. Lake Lansing Rd.
East Lansing, MI 48823
Phone: 517.507.3860
Fax: 517.908.0235
www.rmclegal.com

RMC TRADEMARK & COPYRIGHT

BUSINESS BRIEF

TRADEMARK CLASSIFICATIONS CHANGE 1/1/17

When registering a trademark, an applicant must identify the class into which the goods or services fall. There are 45 different classes of goods and services. In order to properly protect your trademark, it is imperative to be able to describe and classify which class(es) apply.

Effective January 1, 2017, the Eleventh Edition of the Nice Classification for trademarks went into effect. The Eleventh Edition reflects changes to the classes of thirteen different goods and services in varied products such as cosmetics, soaps, pipe fittings, kitchen utensils and hand-operated apparatus, ski wax and security services. The current version of the classifications, including class headings and remarks, can be found [here](#).

PROPOSED BILL TO END ADMINISTRATIVE DEFERENCE MAY OPEN CHALLENGES TO THE USPTO'S RULES AND REGULATIONS

On January 11, 2017, the House of Representatives passed a bill (The Regulatory Accountability Act of 2017) by a 238-183 vote. Of importance to trademark owners and applicants, the Act includes a provision that would repeal the 1984 U.S. Supreme Court's decision in the Chevron USA, Inc. v. Natural Resources Defense Council case. The bill would require that courts apply a "de novo" standard when reviewing questions of law decided by executive agencies.

In Chevron, the Supreme Court held that if there is ambiguity in statutes, any judicial inquiry must defer to an agency's interpretations of the statutes so long as they are reasonable interpretations. Historically, this



has meant that it is much more difficult to successfully bring suit against an executive agency that has ruled against an aggrieved party. Recently, the Supreme Court upheld the Patent Trial and Appeal Board's construction of the appropriate standard for inter partes review, concluding that the PTAB's interpretation of the applicable law was reasonable and entitled to deference.

If the proposed legislation is passed and eliminated the Chevron deference, it would raise the possibility of many more legal challenges to USPTO's and/or the Trademark Trial and Appeal Board's interpretation of either administrative rules or statutes. The "de novo" standard means a court would take a much more in-depth and comprehensive look at the relevant administrative decisions and interpretations.

USPTO DENIES APPLICATION FOR THE NHL'S NEWEST TEAM

The NHL's newest franchise will be located in Las Vegas, NV. The Las Vegas Golden Knights recently filed four trademark applications with the USPTO for the "Las Vegas Golden Knights" and "Vegas Golden Knights". The USPTO denied the application, citing the likelihood of confusion with the existing Golden Knights of the College of Saint Rose, a small college in New York, who applied for and received a trademark for Golden Knights in

2004. While not cited in the denial, the University of Central Florida also has a trademark for "Golden Knights". The applicant has until June 7, 2017 to file a response to the USPTO's denial. The NHL has indicated that there are no plans to change the name or logo and a legal response is pending. The Golden Knights begin play in October 2017.

SIXTH CIRCUIT RULES LACK OF INTENT CAN INVALIDATE TRADEMARK APPLICATION

For the first time, the Sixth Circuit has ruled that a lack of bona fide intent is a proper ground to oppose an intent to use trademark application. In a trademark dispute between two parties, both parties filed an intent-to-use application for "Workwire." The defendant filed its application the same day and minutes before the plaintiff's application. The defendant claimed an intent to use the mark in 36 different goods and services in its application. Under trademark law, an applicant seeking registration based upon an intent to use must show it has a "bona fide intention" to use the trademark. The court noted that proof of intent to use must be based on objective evidence, not merely subjective evidence.

In reviewing the deposition testimony of the



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defendant, the Sixth Circuit upheld the district court's ruling that "bona fide intent" requires firm plans: "[defendant] was not permitted to claim the Mark for uses that might only materialize after some unspecified 'future exploration'—it was required to have firm plans to use the Mark at the time the Applications were filed." See pg. 13 of the opinion. Based upon this finding, the Sixth Circuit ruled that the defendant did not have a "bona fide intent" to use the trademark on all 36 goods and services. Accordingly, it remanded the case to the district court to make a determination as to which goods and services showed a "bona fide intent" to use, and to excise the application to remove all speculative uses of goods and services.

The full opinion can be found at:

http://www.michbar.org/file/opinions/us_appeals/2017/012317/64467.pdf

