



"WE THE PEOPLE" Should Avoid Trashing Our Own Trademarks

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One of the most common reasons trademark applications are refused registration is that the applied-for marks are confusingly similar to other marks that are already registered. There may be a great temptation to argue that the applicant's and registrant's marks are not confusing because they are among many similar marks. Therefore, the argument goes, consumers are likely to be able to make fine distinctions among these marks in a "crowded field."

Such arguments are risky. They may significantly diminish the value of any resulting registration. *In re Bernstein*, 2011 WL 6012206 (TTAB, Nov. 17, 2011 (non-precedential)) illustrates. There, the Trademark Trial and Appeal Board ("TTAB") refused to register applicant's mark WE THE PEOPLE PLAN, for "information about political elections; providing an internet website featuring news and information in the field of national and international politics; providing information regarding political issues, knowing how to vote and knowing how to register to vote." The TTAB found the mark confusingly similar to a prior registration for WE THE PEOPLE for "promotion of public awareness of the need for political reform."

Arguing against the refusal, Applicant, who represented himself, stated:

... [I]t can only be that which follows that can distinguish one mark from another, ... It [is] beyond the scope of this letter to even begin to argue against the initial trademark of the sole expression "We The People", all universal expressions, be it We The People, The Declaration of Independence, LIFE, LIBERTY, and The PURSUIT OF HAPPINESS, ... should be required to ADD a follow-on qualifier (as in our case, the word PLAN). To my mind, it's akin to someone simply registering "United States" ... it should be forbidden. It should ONLY be allowed WITH a qualifier "United States X". ... As stated, the weighted emphasis shouldn't simply be on the WE THE PEOPLE, because it is common to both, ... it is vital to look at the next word or series of words keeping in mind that we make NO claim to the expression "we



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the people” by itself (and as I stated previously, I’m surprised that ANYONE was allowed to because this is one [of] those few expressions that I think belongs to all of us, as Americans ... what comes after “we the people” it’s the first phrase in The U.S. Constitution; it’s the expression that identifies ALL Americans AS Americans ... the fact, that we are having difficulty being We The People PLAN because someone was allowed to be “we the people” seems strange....

Applicant also submitted a long list of federal registrations including "We the people" as evidence of extensive third party use. The TTAB refused to consider these for a variety of reasons, including that the marks covered different goods from those of Applicant and Registrant.

Applicant's arguments were unavailing, and the TTAB affirmed the Trademark Examining Attorney's refusal to register WE THE PEOPLE PLAN.

Had applicant been successful, its arguments in the record of the prosecution of its registration would have severely limited its ability to enforce its mark against third parties. Applicant had itself argued that WE THE PEOPLE was such a common phrase that only "PLAN" could distinguish it from other marks. It would be easy for anyone Applicant accused of trademark infringement to quote Applicant's own statements, and hence to make a strong showing of no likelihood of confusion. Thus, while Applicant presumably wanted to register his mark to have a weapon against infringing use, he substantially undercut the value of any registration.

Federal registrations are valuable tools to use in attacking infringement. However, one must be cognizant in prosecuting a trademark application to protect the value of the resulting registration. While there is sometimes no alternative to arguing that a crowded field of similar marks allows room for one more, namely the one in the application, where this argument can be avoided, it is often wise to do so.

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