STANFORD TECHNOLOGY LAW REVIEW
VOLUME 16, NUMBER 3 SPRING 2013

DO TRADEMARK LAWYERS MATTER?

Deborah R. Gerhardt & Jon P. McClanahan*

CITE AS: 16 STAN. TECH. L. REV. 583 (2013)
http://stlr.stanford.edu/pdf/dotrademarklawyersmatter.pdf

ABSTRACT

This Article empirically examines whether lawyers make a difference in prosecuting federal trademark applications and, if so, how much. Working from a wealth of data the USPTO released in 2012, we examine 5,489,586 federal trademark applications filed since 1984 to determine how much legal representation correlates with success rates in various stages of the trademark application process. First, we show how trademark publication and registration rates have changed over time. Against that background, we examine how these rates differ if the applicant had legal counsel. By illustrating these differences over time, we assess whether trademark registration has become more accessible to pro se applicants.

Next, the Article identifies common reasons why trademark applications fail and how the presence of legal counsel affects registration outcomes. While attorneys may make a significant difference for some types of applications and under certain circumstances, the impact is not uniform. Accordingly, we uncover circumstances in which an attorney has the greatest impact. For example, trademark applications encounter barriers to registration in the form of office actions by examining attorneys or oppositions filed by third parties. We show how much the presence of counsel is associated with overcoming these obstacles.

Finally, this Article examines whether experience with the trademark application process affects publication and registration rates. We categorize

---

* Deborah R. Gerhardt is an Assistant Professor of Law at the University of North Carolina School of Law. Jon P. McClanahan is a Clinical Associate Professor of Law at the University of North Carolina School of Law. For their many thoughtful comments, we are grateful to Lawrence Baum, Pamela Chestek, John M. Conley, Victor B. Flatt, Michael J. Gerhardt, Kevin T. McGuire, Mark P. McKenna, Susan Barbieri Montgomery, Richard E. Myers II, Gregg D. Polsky, Richard S. Saver, Jordan Weinstein, and to workshop participants at the UNC School of Law and the 2013 International Trademark Association Academic Day. We are also grateful to Kenley A. Eaglestone for excellent research assistance.

attorney and pro se applicant pools into three experience levels to measure whether experience affects outcomes as much as the presence of counsel. The two largest subpopulations are experienced lawyers and inexperienced pro se applicants. The Article concludes by comparing the publication and registration success rates of these two groups.

INTRODUCTION

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

In Part II, we explain our methodology and the data we used. In 2010, the United States Patent and Trademark Office ("USPTO") released a wealth of information about trademark applications filed since 1884, and it has updated the data annually.[2] Despite the size and practical significance of this dataset, relatively little attention has been devoted to it by the scholarly community.[3]

1. 15 U.S.C. § 1057(b) (2013).

2. The data used for this study may be downloaded online. *USPTO Bulk Downloads: Trademark Application Text*, GOOGLE, http://www.google.com/googlebooks/uspto-trademarks-recent-applications.html (last visited May 21, 2013); *see also* STUART GRAHAM ET AL., U.S. PATENT & TRADEMARK OFFICE, THE USPTO TRADEMARK CASE FILES DATASET: DESCRIPTIONS, LESSONS, AND INSIGHTS (2013), *available at* http://ssrn.com/abstract=2188621 (describing and examining several aspects of the trademark application data).

3. Notable exceptions include GRAHAM ET AL., *supra* note 2, and Barton Beebe, *Is the Trademark Office a Rubber Stamp?*, 48 HOUS. L. REV. 751 (2011) (analyzing the original

This Article is the first to examine the extent to which having a lawyer matters in prosecuting a trademark application.[4]

In Part III, we analyze how much having counsel matters at various stages in the trademark registration process. First, we report baseline values for overall publication and registration rates. We then look at how publication and registration rates differ depending on the basis for the application and how rates have changed over time. One of the issues we examine is whether the registration process became friendlier to pro se applicants once the USPTO began accepting online trademark applications from the general public in late 1998. In addition to this more accessible filing option, the USPTO began providing resources about the registration process that were available to anyone with an Internet connection.

We next explore how publication and registration rates differ depending on whether an attorney was involved in prosecuting the application. After confirming our initial hypothesis that attorney applications would have higher publication and registration rates than pro se applications, we analyze whether the presence of a lawyer has a greater impact when the applicant faces an obstacle in the application process. For example, if an examining attorney perceives a defect in the application, he or she may issue an office action that creates a barrier to publication unless the applicant responds effectively enough to overcome the objection. Many office actions can be easily resolved with minor corrections to the application. We determine the extent to which the presence of legal counsel matters both in overcoming this hurdle and objections asserted by third parties who claim to have prior superior rights in the mark or other reasons for objecting to its registration.

In Part III, we also consider whether experience with the trademark application process matters as much as the presence of counsel. To address this question, we categorize trademark applications according to the amount of experience the lawyer or pro se applicant had in prosecuting applications, and we analyze success rates based on the level of experience. Both a law degree and experience impacted success rates, and the combination of both was associated with the highest publication and registration rates. The final section summarizes our conclusions.

---

dataset released in 2010).

4. As with any retrospective empirical study, we cannot ascertain whether hiring an attorney causes a trademark application to succeed. Different attorneys provide different qualitative value. Legal expertise may provide value to prospective applicants in selecting a mark. Furthermore, attorney publication and registration rates may be higher because attorneys can effectively pre-screen marks and application information for fatal flaws. A counterbalancing possibility is that lawyers may take risks with subject matter less likely to register because they know how to submit evidence to support such applications. These questions are not the subject of this study. Nor in asking whether it matters if a lawyer prosecutes a trademark application are we making assertions about causation. Our purpose is to examine whether the presence of counsel correlates with success in both the publication and registration of marks.

I. TRADEMARKS AND THE FEDERAL REGISTRATION PROCESS

A trademark is a symbol that represents the reputation of a person (or organization) who provides goods or services to others. It reflects the story of an enterprise. If it becomes distinctive and meaningful, a brand can be the asset that drives an organization's success or failure. Local exposure is often not enough for a brand to become meaningful. Recognition beyond a brand's geographic home can propel it into the kind of shared symbol that has great narrative and economic value. The symbol itself means little until consumers invest it with specific meaning.[5] This phenomenon may be seen in the difference between the meanings of the names "Ray's" and "Wendy's." Only "Wendy's" prompts widely shared thoughts of a specific menu, price point, restaurant décor, and character because its brand managers created a distinctive national symbol. Hearing "Wendy's" evokes visual images of the name in thick primary red letters and the happy cartoon image of Dave Thomas's daughter.[6] Similar specific meanings are not identifiable with a ubiquitous restaurant name like "Ray's" due to a more relaxed (or nonexistent) brand strategy that has permitted use of the name for many different businesses. A key element in creating a strong recognizable brand like "Wendy's" is federal trademark registration, as it creates a presumption of the "owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate."[7]

A trademark may be registered in a particular state or nationally through the USPTO. Federal registration provides many advantages. At common law, trademarks arose from the businesses with which they were connected, and the right to exclude others from using the mark was limited by both market sector and geography.[8] Limiting exclusive use to a business sector permitted symbols to be used in multiple situations if they were different enough that consumers would not be confused that one was associated with the other. A symbol, such as the name "YALE," could be advertised by one company for locks and by another for higher education.[9] Alternatively, a symbol could be used

5. Deborah Gerhardt, *Consumer Investment in Trademarks*, 88 N.C. L. REV. 427, 499 (2010).

6. *Wendy's*, WIKIPEDIA, http://en.wikipedia.org/wiki/Wendy's (last visited May 21, 2013). Wendy's updated its logo in February 2013, *Wendy's Embraces Contemporary Look*, WENDY'S (Feb. 21, 2013), http://ir.wendys.com/mobile.view?c=67548&v=203&d=1&id=1787519, but notably it retained the features for which it has become known, *see The Transformation of Wendy's Brand*, WENDY'S, http://www.aboutwendys.com/uploadedFiles/Content/News/Brand-Transformation-Infographic-WENDYS.pdf (last visited May 21, 2013) (illustrating the evolution of the Wendy's logo over time).

7. 15 U.S.C. § 1057(b) (2013).

8. *See, e.g.*, United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918).

9. "Yale" has been used since 1875, was registered by Yale & Towne Manufacturing Co. in Stamford, Connecticut, has appeared on the Principal Register since 1909, and remains registered in the name of its current owner, Yale Security Inc. of Monroe, North Carolina. YALE, Registration No. 0063654. Yale University began using its mark in 1718, but it did not register the name for educational services until 1983. YALE, Registration No.

simultaneously by different companies for the same service in distant towns without confusion. The Saffron restaurant in Morrisville, North Carolina,[10] is not likely to be confused with restaurants of the same name in Shaker Heights, Ohio,[11] Las Vegas, Nevada,[12] Westmont, Illinois,[13] or Jupiter, Florida.[14] Of course, if all these restaurants share the name, none can ever use it to make the same kind of distinct commercial impression as a nationally famous restaurant brand with a unique name like Nobu[15] or Applebee's.[16]

Federal trademark registration provides important advantages to a brand owner who wants to create a unique national impression. It supplies a business with the opportunity to secure nationwide exclusive rights.[17] Even if a brand is not being used in every state, federal registration gives a brand owner the power to seek a court injunction requiring later adopters to select another name if the brand owner expands into the junior user's geographic territory.[18] The registration certificate also constitutes prima facie evidence that the mark is valid and owned by the applicant.[19] Marks submitted for registration—whether they succeed or not—may by searched using the Trademark Electronic Search System ("TESS").[20] A new organization searching for a distinctive brand may eliminate words that have already been registered by other similar organizations. In this way, a mark's appearance on the Principal Register provides important deterrent value.

The USPTO maintains two trademark registries: the Principal Register and the Supplemental Register. The Principal Register confers many statutory

---

1391903.

10. SAFFRON REST. & LOUNGE, http://www.saffronnc.com (last visited May 25, 2013).

11. SAFFRON PATCH REST., http://www.thesaffronpatch.com (last visited May 25, 2013).

12. SAFFRON, http://www.saffronlv.com (last visited May 25, 2013).

13. SAFFRON, http://www.saffrondining.com (last visited May 25, 2013).

14. SAFFRON, http://www.saffronjupiter.com (last visited May 25, 2013).

15. NOBU, http://www.noburestaurants.com (last visited May 25, 2013).

16. APPLEBEE'S, http://www.applebees.com (last visited May 25, 2013).

17. *See generally* 15 U.S.C. § 1057(c) (2013) ("[T]he filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration.").

18. *See, e.g.*, Dawn Donut Co. v. Hart's Food Stores, Inc., 267 F.2d 358, 365 (2d Cir. 1959) (denying injunctive relief after finding no likelihood of confusion but clarifying that "the plaintiff may later, upon a proper showing of an intent to use the mark at the retail level in defendant's market area, be entitled to enjoin defendant's use of the mark.").

19. 15 U.S.C. § 1057(b).

20. *Search Trademark Database*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/process/search (last visited May 25, 2013); *see also TESS Tips*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/process/search/Tess_tips.jsp (last visited May 25, 2013) (explaining how to use TESS to determine whether a proposed mark could be subject to refusal due to the existence of a prior application or registration).

benefits, including all of those identified above.[21] A mark that fails to qualify for the Principal Register may be placed on the Supplemental Register until it acquires the qualities of a distinctive mark. For example, a mark—such as Ye Olde Waffle Shop for a diner serving waffles—will likely be challenged as merely descriptive because other diners may want to use the same words to describe their services. For this reason, the mark may be placed on the Supplemental Register.[22] If the mark acquires distinctiveness so that consumers identify the words with a particular diner or chain of diners (like Waffle House),[23] the applicant may reapply for acceptance on the Principal Register.[24]

Supplemental registration does confer some benefits. It allows the mark owner to use the symbol "®" (the same symbol used by marks on the Principal Register) on its brand to show that it is registered with the USPTO.[25] This notice, as well as the appearance of being a live mark in TESS, provides some deterrent value. Nevertheless, supplemental registration does not confer the exclusive right to nationwide use of the mark.[26] Supplemental registration may be viewed as evidence that the USPTO does not consider the mark sufficiently distinctive to merit federal trademark protection. Third parties may view supplemental registration as evidence that the mark is available because the right to exclusive use was denied. Accordingly, supplemental registration is generally not the goal of the application process. It is at best a consolation prize and, at worst, evidence that the symbol is not yet valid as a mark. Because of the many benefits associated with the Principal Register, we equate registration for purposes of this Article with placement on the Principal Register.

Obtaining a federal registration is not difficult or particularly expensive. The USPTO has created a Trademark Information Network with lots of explanatory content such as FAQs[27] and trademark informational videos.[28] For each class of goods or services, the 2013 registration fee is either $275 or $325, depending on which electronic form is used.[29] In 2013, the USPTO is still

21. 15 U.S.C. § 1094.

22. *Id.* § 1091.

23. WAFFLE HOUSE, Registration No. 2,965,520.

24. 15 U.S.C. § 1095.

25. *See U.S. Trademark Registrations: Principal Register vs. Supplemental Register*, INT'L TRADEMARK ASS'N, http://www.inta.org/TrademarkBasics/FactSheets/Pages/PrincipalvsSupplementalRegister.aspx (last visited May 25, 2013) (explaining the benefits of placement on the Supplemental Register, and contrasting those with the benefits of placement on the Principal Register).

26. *Id.*

27. *Trademark FAQs*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/faq/trademarks.jsp (last visited May 25, 2013).

28. *Trademark Information Network (TMIN) Videos*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/process/TMIN.jsp (last visited May 25, 2013).

29. *Trademark Electronic Application System: Frequently Asked Questions*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/teas/teas_faq.jsp#TEASrefund (last visited May 25, 2013).

accepting paper applications but charges a $375 filing fee.[30] The application requests information such as the owner of the proposed mark, identification of the goods or services the applicant uses (or plans to use) in connection with the mark, and the date on which the mark was first used in interstate commerce.[31] A specimen illustrating the mark as used must also be attached prior to registration.[32] For those who have this information at hand, the USPTO's online federal trademark application can be completed in an hour.[33]

The process includes two opportunities to defeat an application before it ripens to registration: one for the USPTO and another for third parties. USPTO approval is the first hurdle an applicant must overcome. Once the application is submitted, the USPTO randomly assigns an examining attorney to review it.[34] The examining attorney may refuse to let the application proceed due to a perceived defect. Federal law provides some absolute bars to trademark registration. For example, registration will be denied if the mark is deceptive, scandalous, disparaging, or the name of a living U.S. President.[35] An example of a deceptive mark would be "Florida" for Oranges that are not from Florida. Because such a mark would deceive consumers about a material product feature (here, the geographic origin), it would be barred from registration.

Likelihood of confusion and descriptiveness are the most common grounds for refusing registration.[36] The first of these two grounds may be especially difficult to surmount. For example, if a man named McDonald attempted to register his name for a hamburger joint, the USPTO would deny the application on the ground that consumers may confuse his restaurant with the famous McDonald's fast food chain.[37] The other common ground for refusing registration, descriptiveness, may be overcome with evidence that consumers view the symbol as a distinctive mark. If a proposed mark is descriptive—like "Waffle House"—it may be barred from registration unless the applicant can demonstrate that the public views the mark as an identifier for a particular diner or restaurant chain.[38] Another famous example of a descriptive mark deemed

---

30. *Id*.

31. 15 U.S.C. § 1051 (2013).

32. Use-based applications must be filed with a specimen. *Id.* § 1051(a). For marks based on intent to use, the specimen is not required until after publication, but must accompany the statement of use before the mark will register. *Id.* § 1051(d)(1).

33. *See generally Online Filing: Trademark Electronic Application System*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/teas/index.jsp (last visited May 25, 2013).

34. GRAHAM ET AL., *supra* note 2, at 18.

35. 15 U.S.C. § 1052(a).

36. GRAHAM ET AL., *supra* note 2 at 18.

37. *See* 15 U.S.C. § 1052(d) (providing that a mark may not be registered if it "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.").

38. *See id.* § 1052(e)-(f) (providing that a mark may not be registered if "(1) when

sufficiently distinctive to merit registration is "Park 'N Fly."[39] If the mark has not had sufficient exposure to acquire distinctiveness (known as "secondary meaning"), the examining attorney will deny registration on the Principal Register but may permit the mark to be published on the Supplemental Register.[40]

If the examining attorney finds a defect in the trademark application, he or she may issue an office action in the form of a written letter or email identifying the problem.[41] To respond, the applicant may amend the application to fix the defect or submit written evidence and argument that the examining attorney erred in the analysis. If the objection is not overcome, publication will be denied. If the defect is resolved and the examining attorney approves the application, the mark will be published in the Official Gazette.[42] Publication marks success in overcoming all USPTO objections, and therefore we treat it as the applicant's first win in the registration process.

Publication also opens a second window of vulnerability. Once a mark publishes in the Official Gazette, third parties (such as another company using a similar mark) have thirty days to object.[43] A third party who believes it may be harmed by registration of the proposed symbol may initiate an opposition proceeding.[44] If no opposition is filed (or if the applicant responds to the opposition and, after an administrative hearing, the appeal board agrees with the applicant), the application proceeds to the next step in the process. If the mark has already been used in commerce, it will be included on the Principal Register, and the applicant will receive in the mail a registration certificate with a gold seal. If the mark has not yet been used in commerce, the applicant will receive a "Notice of Allowance" and registration will occur after the applicant demonstrates that he or she has begun using the mark in commerce.[45] We treat registration on the Principal Register as the second win in the registration process. All of the tasks required for registering a trademark—submitting applications, responding to office actions, responding to opposition proceedings, and filing statements of use—may be accomplished without legal counsel.

The option of proceeding pro se raises the central question of this Article: do lawyers make a difference? The recent release of the USPTO data creates an

---

used on or in connection with the goods of the applicant is merely descriptive or . . . primarily geographically descriptive of them" unless the mark "has become distinctive of the applicant's goods in commerce.").

39. PARK 'N FLY, Registration No. 1,111,956.

40. INT'L TRADEMARK ASS'N, *supra* note 25 (explaining circumstances in which a proposed mark may be included on the Supplemental Register).

41. *Trademark Process*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/process/ (last visited May 25, 2013).

42. *Id.*

43. 15 U.S.C. § 1063(a).

44. *Id*.

45. *Id.* § 1051(d).

opportunity to explore this fundamentally important question in a new context. In the United States, state laws prohibit practicing law without a license.[46] Faced with a matter requiring legal analysis, an inexperienced person is often confronted with the choice of hiring a lawyer or slogging through the matter alone.[47] For individuals, hiring an experienced layperson is often not an option. However, corporations often have that option. While lawyers may manage their trademark portfolios, experienced non-lawyers such as trademark paralegals sometimes file applications on behalf of their employers.[48]

This Article contributes to the growing literature on whether legal counsel makes a difference and whether experienced counsel may have an especially significant impact. Scholars have found non-lawyers to be as effective as lawyers in some advocacy situations, especially when the non-lawyers had substantive and procedural expertise.[49] But the quality of all lawyering is not uniform. Because one measure of quality is experience, some scholars have examined the extent to which experience may affect success in legal proceedings.[50] Looking at advocacy before the Supreme Court of the United States, Kevin McGuire demonstrated that retaining an experienced lawyer increases the probability that a party will win.[51] The USPTO data provide a perfect opportunity to test whether retaining a lawyer at all, and particularly an experienced lawyer, correlates with success in the trademark registration process.

---

46. *See, e.g.*, N.C. GEN. STAT. § 84-4, 84-5 (2011).

47. HERBERT M. KRITZER, LEGAL ADVOCACY LAWYERS AND NON-LAWYERS AT WORK 2-3 (1998). There are of course exceptions. Advice and assistance in obtaining a patent may be given by a non-lawyer who passed a test qualifying him or her for admission to practice before the Patent and Trademark Office. 37 C.F.R. § 11.7(a)-(b) (2013).

48. Indeed, the International Trademark Association website has a section explaining the work of "trademark administrators." *See Career Related Articles: The Trademark Administrator*, INT'L TRADEMARK ASS'N, http://www.inta.org/CareerArticles/Pages/TheTrademarkAdministrator.aspx (last visited May 25, 2013). According to the website, "'trademark administrators' hold positions such as a senior manager in a Fortune 500 company, a general manager in a legal department or a trademark administrator for a company with an international portfolio of marks." *Id.*

49. *See, e.g.,* KRITZER, *supra* note 47, at 193-95 ("Non-lawyers are effective in three of the four disparate settings I considered."); D. James Greiner & Cassandra Wolos Pattanayak, *Randomized Evaluation in Legal Assistance: What Difference Does Representation (Offer and Actual Use) Make?*, 121 YALE L.J. 2118, 2209-10 (2011) (finding that representation by a law school clinic did not improve the likelihood of receiving unemployment benefits, when compared to pro se applicants).

50. Kate S. Gaudry, *The Lone Inventor: Low Success Rates and Common Errors Associated with Pro-Se Patent Applications*, PLOS ONE 7(3): e33141 (2012), http://www.plosone.org/article/info%3Adoi%2F10.1371%2Fjournal.pone.0033141 (finding that 76% of the pro se patent applications were abandoned compared to 35% of applications in which the inventors were represented by patent agents or legal counsel).

51. *See* Kevin T. McGuire, *Repeat Players in the Supreme Court: The Role of Experienced Lawyers in Litigation Success*, 57 J. POL. 187, 188 (1995) (concluding that veteran lawyers who appear before the Supreme Court "prevail substantially more often" than less experienced advocates).

It is not necessary to hire counsel to prosecute a trademark application, but most do so anyway.[52] For many reasons, hiring experienced trademark counsel may be an excellent idea.[53] A trademark lawyer can provide meaningful feedback on selecting a mark by identifying symbols that are likely to overcome statutory barriers and are capable of becoming strong and unique identifiers.[54] They will also be knowledgeable about how to navigate the application process smoothly and will likely have docketing software to remind them of periodic deadlines that must be met in order to keep applications and registrations from expiring.[55] But faced with scarce resources, some choose to navigate the selection and application process alone. This Article quantifies the difference it makes in having a lawyer involved in the trademark application process, given that the USPTO has tried to create a process in which the lack of legal representation should not be a barrier to registration.[56]

II. METHODOLOGY

Until recently, little was known about the success rates for trademark applications on an aggregate basis. The USPTO only offered its bulk trademark application data for a fee, and the data were not available online.[57] Fortunately, in June 2010, the USPTO entered into a two-year partnership with Google, Inc. to make its patent and trademark data freely available for download from Google servers.[58] Among the data that may be downloaded are the application contents and registration images, information about trademark assignments, and whether office actions or opposition proceedings were filed.[59] Trademark data

52. *See infra*, Figure 3.

53. The USPTO acknowledges that applicants may benefit from a lawyer's expertise and identifies some advantages of retaining a lawyer. *What a Private Attorney Could Do to Help Avoid Potential Pitfalls*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/basics/private_attorney.jsp (last visited May 25, 2013).

54. *See id.* (noting that "trademark lawyers can help you during the application process with several things that could seriously impact your trademark rights, such as determining the best way to describe your goods and services and preparing responses to refusals to register that an examining attorney may issue.").

55. For example, the 2013 International Trademark Association Conference featured eleven companies exhibiting software designed to assist trademark attorneys with docketing and other administrative tasks. *See 2013 Exhibitor Descriptions*, INT'L TRADEMARK ASS'N, http://www.inta.org/2013AM/Exhibit/Pages/2013AMExhibitorsDescriptions.aspx (last visited May 25, 2013).

56. *See infra* notes 89-94 and accompanying text.

57. *See USPTO Teams with Google to Provide Bulk Patent and Trademark Data to the Public* (Press Release 10-22, June 2, 2010), U.S. PATENT & TRADEMARK OFFICE, *available at* http://www.uspto.gov/news/pr/2010/10_22.jsp (describing the partnership between the USPTO and Google to offer bulk data to the public).

58. *Id.*

59. *See USPTO Bulk Downloads: Trademarks*, GOOGLE, http://www.google.com/googlebooks/uspto-trademarks.html (last visited May 25, 2013).

are available for applications dating back to 1884.[60]

This Article examines the 5,489,586 viable federal trademark applications filed between 1984 and 2012, and publication and registration rates for applications filed between 1984 and 2010. We began with applications filed in 1984 because information on the presence of counsel is incomplete for pre-1984 applications.[61] We included the most recent data available for our end dates, given the natural constraints of the filing process. At the time of this writing, annual application data are available through 2012.[62] Because many applications are delayed by office actions, requests for extensions of time and opposition proceedings, some do not register for months or even years after the application is filed.[63] Therefore, we examined publication and registration rates for applications filed between 1984 and 2010.

The trademark data are stored in a series of forty multi-gigabit extensible markup language ("XML") files, each containing a similar structure.[64] There are over 170 types of variables. Because single variables may capture a variety of information throughout the life cycle of an application, the dataset contains approximately 1,500 possible data points. The sections that follow identify the data and discuss how each type was compiled.

A. *General Trademark Application Data*

Each trademark application is assigned a serial number that serves as a unique identifier for that application. Variables within each application include information about the type of mark (e.g. trademark, certification mark), the filing basis (e.g. use, intent to use), whether the trademark was published in the Official Gazette, and whether the trademark was eventually placed on the Principal or Supplemental Register. Each application also contains a current status code, indicating whether a trademark is currently registered and, if not, some insight into why registration was denied.[65]

Unlike other empirical studies of trademarks in which researchers have

---

60. *Id.*

61. The rates of attorney applications from 1980-1982 were 78%, 68%, and 65%, respectively. By contrast, the rates of attorney applications were above 80% from 1984-1999. Furthermore, applications that did not mature to registration before 1980 appear to be missing from the data. *See* Beebe, *supra* note 3, at 760 (noting that registration rates prior to 1980 were 99%, suggesting that unsuccessful applications were generally excluded from the dataset).

62. *See USPTO Bulk Downloads: Trademarks*, GOOGLE, http://www.google.com/googlebooks/uspto-trademarks.html (last visited May 25, 2013).

63. Indeed, the registration rates for 2011 (45%) and 2012 (10%) were much lower than the rates in the immediately preceding years (e.g., 2010 registration rate was 55%). *Id.*

64. For more information about the data structure and variables, see generally U.S. PATENT & TRADEMARK OFFICE, TRADEMARKS APPLICATION DAILY XML V2.0 DOCUMENTATION, *available at* http://www.uspto.gov/products/tmdailyapp-documentation.pdf (last visited May 25, 2013).

65. *See* Beebe, *supra* note 3, at 771-74.

analyzed a sample of the population,[66] this study includes all viable trademark applications filed during the time periods of interest.[67] Before analyzing the data, however, we excluded those applications having incomplete or highly suspect records. For example, we excluded a small number of applications whose final status code was "Misassigned serial number," as those records contained no substantive information and the status code itself suggested that the records had been subject to a coding error.[68]

B. *Attorney and Pro Se Applications*

The primary focus of this study is to measure the impact of attorneys on the trademark registration process, by comparing applications filed by lawyers to those filed without the assistance of counsel. While the USPTO dataset does not explicitly indicate whether an application was filed by a lawyer, it does contain a field indicating whether an attorney entered an appearance at some point during the application process. If an application is filed pro se, and a lawyer steps in to assist with the prosecution at any point prior to registration, the lawyer's name may appear in the "attorney-name" field in the dataset. The presence of any information in this field indicates that an attorney appeared at some point during the application process, and it is from the presence of data in this field that we categorize an application as being prosecuted by an "attorney" or "pro se." We treat applications as "pro se" only when the "attorney-name" field contained no information.

Another goal of this study is to understand the impact of experience on success in navigating the registration process. Identifying the level of experience associated with an application is another challenging task. For attorney applications, we relied on the non-standardized "attorney-name" field;[69] however, the data were manipulated in several ways before they were

66. *See*, *e.g.*, Paul J. Heald & Robert Brauneis, *The Myth of Buick Aspirin: An Empirical Study of Trademark Dilution by Product and Trade Names*, 32 CARDOZO L. REV. 2533 (2011) (analyzing a sample of thirty-three famous trademarks to measure trademark dilution over time).

67. For this reason, the traditional measures of statistical significance are generally inapplicable to this Article, as they assess the level of confidence that the differences measured in the sample are present in the population. Furthermore, given the extraordinary number of observations in this dataset (5,489,586 applications), all noted differences were tested and would have been statistically significant had such measures been applicable. Unless otherwise noted, the term "significance" in this Article denotes the practical significance of findings.

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

69. Because this field is not standardized, names may be in upper or lower case letters, some entries include middle names or initials, and entries are subject to human typographical error. Indeed, a visual inspection of the data revealed misspellings in attorney names and inconsistencies in how a single name appeared in the dataset. For example, the name "Avital

aggregated, including recoding all names so that they were formatted consistently and removing all non-alphanumeric characters and spaces. After summing the number of applications associated with a particular attorney, that number was assigned to those applications as a proxy for attorney experience.

Although trademark applications are signed under penalty of perjury, we cannot be certain that the attorney information in them is always accurate. For example, a non-attorney filing an application may have an attorney sitting with him or her, giving advice on completing the application form even though the lawyer does not formally appear as counsel on the application. Another reason our measure may be under inclusive in assessing attorney experience is that some lawyers may change their names or use a different spelling (such as the inclusion of a middle name or initial). A lawyer who filed under two names (or two variations of the same name) would be counted twice for fewer applications than he or she actually prosecuted. Our method also may be over inclusive, because if multiple trademark lawyers share the same name, they would be counted as one relatively more experienced lawyer. For all of these reasons, our method is not perfect. However, this noise comprises a small percentage of the applications and is not systematically in one direction. Because applications are signed under penalty of perjury, the "attorney-name" field still should provide reasonably reliable information and, therefore, a suitable approximation of whether an application was pro se.

The level of experience was calculated in a slightly different manner for pro se applications because the relevant data have been stored in a different format. Unlike the attorney name, which comprises a single field for a particular application, the dataset structure permits multiple owners to be associated with one application. Furthermore, ownership may change throughout the life cycle of an application. For purposes of this Article, we considered ownership at the time that an application was filed. Even then, a small percentage of applications were associated with more than one owner.[70] Therefore, in addition to standardizing the owner names as we did for attorney names, we calculated the experience level for an application based on the owner who had filed the most trademark applications.

C. *Barriers to Publication and Registration*

Although general application data are useful for understanding how the attributes of an application are related to publication and registration rates, they

---

Tally Eitan" also appeared as "Avital (Tally) Eitan"; "AVITAL (TALLY) EITAN"; "AVITAL(TALLY) EITAN"; "AVITAL EITAN"; and "Avital Eitan." We erred on the side of underestimating experience levels by treating "Avital Tally Eitan" and "Avital Eitan" as two different attorneys. If another entry had been the same as either of these names but included a middle initial (e.g., "Avital T. Eitan" or "Avital S. Eitan"), the name would have been counted as a third attorney.

70. Among all applications, only 1.3% were associated with more than one owner at the time of filing.

provide no insight into how trademark applications proceed through the trademark life cycle. Before beginning this study, we hypothesized that there are two primary barriers to registration: first, when an examining attorney issues an office action prior to publication; and second, when a third party files an opposition proceeding after publication. In order to quantify the impact of these barriers, we compiled the prosecution history to create a timeline of events in the trademark life cycle.

Once the timeline for each application was constructed, we identified whether an application faced an obstacle and, if so, whether the applicant overcame it and proceeded to the next stage of the process. For this part of the study, we limited our analysis to the initial trademark registration process and omitted post registration events, such as cancellation proceedings or abandonment, which could cause a mark to lose its place on the Principal Register.[71]

The USPTO data include codes for more than 500 events that may be associated with the life cycle of an application. We first identified those that were most strongly correlated with failing to publish or register.[72] There were three. First, as expected, office actions were strongly correlated with not proceeding to publication.[73] Second, when they were filed, opposition proceedings frequently thwarted registration of a published mark.[74] Finally, among intent to use applications, failure to file a statement of use was most strongly correlated with not registering a mark.[75]

To identify applications that were subject to an office action prior to publication, we first isolated all applications in which a non-final office action was mailed or emailed, and we compared the date of the earliest office action to the date of publication. Applications were then coded according to whether the trademark was published in the Official Gazette during the initial registration process. We used these two variables—publication and whether an application had received an office action prior to publication—to determine the frequency of office actions and their impact on publication success rates.

We adopted a similar procedure for identifying applications in which an opposition had been instituted. If an application faced an opposition proceeding prior to initial registration, it was coded as having faced this second obstacle.

---

71. Examining whether the initial presence of counsel has an impact on the duration of a trademark registration would be fertile ground for additional research, but would require compiling additional data.

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

73. Pearson Correlation coefficient equaled -.36 (significant at .01 level).

74. Pearson Correlation coefficient equaled -.15 (significant at .01 level) for all published marks. When intent to use applications were excluded from consideration, however, the correlation coefficient was -.53.

75. Pearson Correlation coefficient equaled -.84 (significant at .01 level).

All applications were then coded according to whether they had been placed on the Principal Register. Since a large percentage of intent to use applications did not proceed to registration because no statement of use was filed,[76] we excluded intent to use applications from the analysis when analyzing the impact of opposition proceedings. In this way, we isolated applications that faced opposition proceedings from those that the applicant abandoned for business or practical reasons.

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

To assess whether having a lawyer makes a difference in registering a trademark, we use advances in two stages of the registration process—publication and registration—as our measures of success. Filing an application opens a window of time when the USPTO examines the information to determine if the mark may qualify for registration. Publication in the Official Gazette is the first victory in the process because, at that point, the USPTO has approved the mark.[77] Marks publish only if an applicant has overcome any prior objections asserted by the USPTO. Publication then opens a thirty-day window in which third parties may object to registration of a mark. Surviving that time period and complying with any additional requirements necessary for registration is the second success. A third category of potential barriers may present themselves through third party cancellation proceedings after a mark has registered. Because pre-publication and pre-registration obstacles occur most frequently, we assess success in the registration process by examining how often applications advance first to publication and then to registration.

We begin with the theory that legal counsel provides measurable value. We predict that attorneys will have higher success rates than non-lawyers in federal trademark prosecution. From our academic and practice experience, we have observed that students gain valuable analytic skills through law school that may help them to understand and follow the online form. Knowledge of trademark law may cause attorneys to be more discriminating in the applications they file. Also, comfort in navigating conflict through legal procedures and professional obligations to advocate for one's client may cause lawyers to continue prosecuting applications even when they must respond to a legal challenge.[78]

---

76. Indeed, 80% of all published marks failed to register for this reason. *See infra* Figure 13.

77. Some USPTO objections may be asserted later. For applications based on an intent to use the mark, a statement of use and specimen showing use must be filed after publication. 15 U.S.C. § 1051(d)(1) (2013). If either item contains a defect, the examining attorney may refuse registration. However, most objections raised by examining attorneys are handled before publication.

78. MODEL RULES OF PROF'L CONDUCT R. 1.3 cmt. 1 (2012) ("A lawyer must . . . act with commitment and dedication to the interests of the client and zeal in advocacy upon the client's behalf.").

Therefore, we predict that having counsel will be especially beneficial if the application confronts a potential barrier, such as an office action from the USPTO or an opposition filed by a third party.

Even if the data indicate that lawyers have a higher success rate, it will be interesting to determine whether this difference can be better understood by accounting for experience. A law degree does not necessarily confer expertise. Therefore, we consider whether hiring any lawyer improved the odds of registration, or if lawyers with considerable experience were more successful in prosecuting trademark applications.

Furthermore, if experience with the trademark application process is indeed significant, it may be the case that experienced non-lawyers have success rates that are equivalent to the success rates of lawyers who have prosecuted a similar number of applications. In-house marketing employees or trademark paralegals may acquire significant expertise registering marks for their corporate employers. Some savvy brand owners may rely on these non-lawyers to manage much of their trademark portfolios and call in counsel only when a mark confronts a barrier in the registration process.[79]

For example, the following iconic mark—according to the USPTO records—was filed by a corporate employee rather than a lawyer.[80]

Given these circumstances, we explore whether experience in filing applications makes a meaningful difference in obtaining registration. We do so by comparing publication and registration rates of applications filed by lawyers and non-lawyers having comparable levels of experience. We expect to see that experience matters, and that pro se publication rates may be lower, but not as low for "repeat players."[81]

A. *Publication and Registration Rates Over Time*

To set the stage for our examination of a lawyer's role in prosecuting trademark applications, the first charts provide a general overview of the trademark application process over time[82] and the impact of counsel. As Figure

79. *See supra* note 48 and accompanying text.

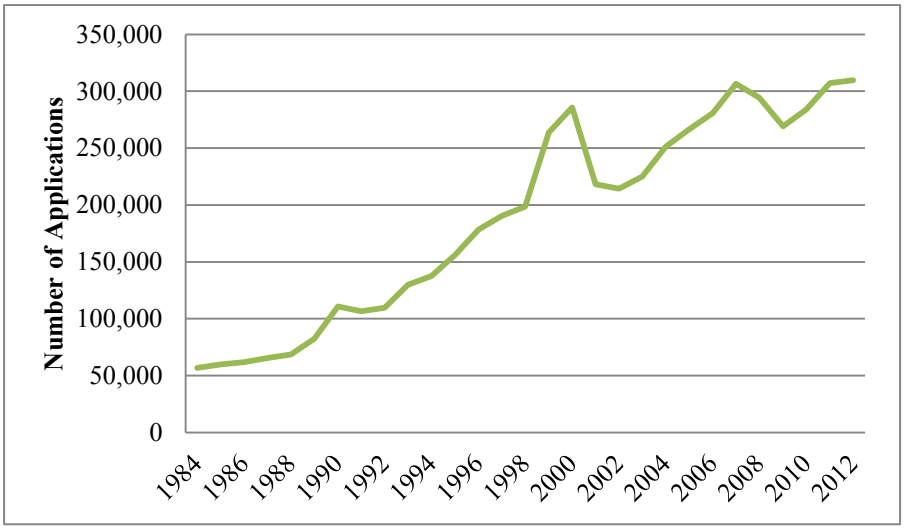
80. HERSHEY'S, Registration No. 3,742,438.

81. Marc Galanter, *Why the Haves Come Out Ahead*, 9 LAW & SOC'Y REV 95, 97 (1974) (coining the term "repeat players").

82. For an excellent article entirely devoted to this issue, see Beebe, *supra* note 3.

1 demonstrates, the number of trademark applications filed in the USPTO has steadily increased over time.[83] Barton Beebe observed that the increase reflects general economic trends, such as the expansion of the United States GDP over the entire time period.[84] Beebe further suggested that the Internet bubble in 1999 and 2000 may account for the "dramatic spike in total applications" for those years.[85]

FIGURE 1: USPTO TRADEMARK APPLICATIONS OVER TIME



While Figure 1 shows that the total number of applications increased over time, Figure 2 illustrates how this trend is related to representation by counsel. The green bar in both graphs represents the entire set of applications. The lower two bars in Figure 2 divide the universe into two subsets: the red bar represents applications prosecuted by lawyers, and the blue bar depicts pro se applications. All reflect increases over time, but in the past decade the increase in the pro se population is especially striking. The number of pro se applications tripled between 1998 and 2012. The dramatic increase in pro se applications may be one explanation for the increase in applications generally.

83. Figures 1 and 2 include applications that ultimately were placed on the Supplemental Register. Those applications were not included in the rest of the analysis, unless otherwise noted. During the years 1984-2010, 2.7% of all applications were placed on the Supplemental Register (132,394 of 4,872,622).

84. Beebe, *supra* note 3, at 761.

85. *Id.*

FIGURE 2: ATTORNEY REPRESENTATION IN USPTO TRADEMARK APPLICATIONS OVER TIME

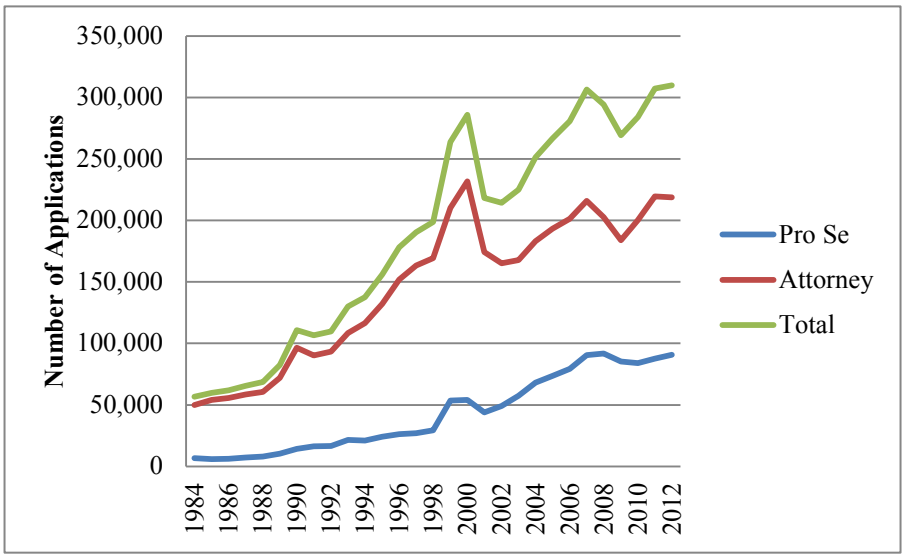


Table I, below, more specifically sets forth the data depicted in Figure 2, identifying both the numeric and percentage increases of attorney and pro se trademark applications. Both the total number of trademark applications and the percentage filed by non-attorneys have increased considerably since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

TABLE I: PERCENTAGE OF PRO SE USPTO TRADEMARK APPLICATIONS OVER TIME

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

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

Two changes in the trademark application process may account for the general application growth rate depicted in Figures 1 and 2 and Table I. First, a notable increase in applications is apparent after 1989, the year when federal law changed to permit trademark applications to be based on the intent to use a mark. Figure 2 graphically illustrates how this change resulted in an immediate increase that never ebbed. The annual increase of less than 5,000 total applications per year (compared to the previous year) suddenly jumped to 13,892 in 1989 and 28,385 in 1990. Steady increases generally continued afterwards. Table I demonstrates that lawyers filed most of the new applications. However, the percentage of applications filed by lawyers and non-lawyers remained relatively stable.

The availability of intent to use as a filing basis likely contributed to the increase. Before 1989, a viable trademark application required proof that the applicant was already using the mark in interstate commerce.[86] The Lanham

86. 15 U.S.C. § 1051(a) (1982).

Act still requires use before registration for domestic applications.[87] However, since November 16, 1989, it has been possible to file an application for a mark if an enterprise has a good faith intent to use ("ITU") it.[88] The mark will not actually register until it has been used, but an ITU application gives the mark owner a constructive first use date corresponding to the day on which the application was filed. For purposes of establishing priority over other uses, this change in the law made it possible to preserve national protection from a time that preceded actual use.[89]

Under the new intent to use regime, a business could file a handful of marks and decide which to use later without sacrificing an early priority date. Instead of following the past practice of choosing one mark and using it before beginning the application process, a business could file applications for all potential marks and then abandon the applications for the marks it decided not to use.[90] Therefore, after the ITU filing basis became available, one would expect application rates to rise and registration rates to drop. Publication rates would not be expected to change because the statement of use is filed after publication in the Official Gazette but before registration is granted.

A second dramatic spike is evident a decade later between 1998 and 2000. Again, economic trends provide one explanation, but there is an equally plausible trademark reason. This upward trend may have been stimulated by substantial efforts to improve the online application process. The USPTO considers trademark applicants to be "customers," and accordingly it strives to make its services increasingly easy to use.[91] In November 1997, the USPTO launched an online trademark application system it called "TEAS," coined to be an acronym for "trademark electronic application system."[92] A pilot electronic filing program began with fifty selected participants who established USPTO deposit accounts.[93] On October 1, 1998, the service became publicly available so that anyone could apply for trademark registration online and pay by credit card.[94]

---

87. 15 U.S.C. § 1057(b) (2013).

88. *Id.* § 1051(b)(1) ("A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register.").

89. *Id.* § 1057(c) ("Contingent on the registration of a mark on the principal register . . . , the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect . . . .").

90. *See* David J. Franklyn, *Owning Words in Cyberspace: The Accidental Trademark Regime*, 2001 WIS. L. REV. 1251, 1252 (2001) (noting the "proliferation" of intent to use applications as contributing to the "propertization" of trademark protection).

91. U.S. PATENT AND TRADEMARK OFFICE, ANNUAL REPORT: TRADEMARKS (1998), *available at* http://www.uspto.gov/about/stratplan/ar/1998/a98r-3.jsp.

92. *Id.*

93. *Id.*

94. Initially the TEAS system offered two filing options, only one of which was truly electronic. The first, eTeas, permitted applications to be completed and submitted wholly online. The second option, PrinTeas, made it possible to prepare the application online and

Applications spiked in 1999, after the USPTO publicly launched the online filing system. Notably, that same year had the greatest increase in the percentage of applications filed by non-attorneys. As shown in Table I, before 1999, pro se applications generally remained between 12% and 15% (with the exception of 17% pro se applications in 1993). Suddenly, in 1999, there was a 5 percentage point increase in applications filed by non-lawyers. This dramatic increase corresponds with the first full year that it was possible to apply for a trademark online through the USPTO website. These data support the proposition that the USPTO had succeeded in making its application process more widely available to pro se applicants. Indeed, 35% of online applications were filed pro se between 2000 and 2012, while only 24% of paper applications were filed pro se during that same time period.

Against this backdrop, the next figures demonstrate success rates at two pivotal moments in the application process: publication and registration. Figure 3 provides an overview of both rates over time.

---

then print it as a hard copy for mailing to the USPTO. In 1999, the PrinTeas option was eliminated. Since then, the USPTO has repeatedly solicited feedback and made additional changes to improve the system. In July 2005, a second electronic filing form, called TEAS Plus, was launched. The TEAS Plus form was designed to be an attractive option for pro se applicants or less experienced lawyers. It was offered for a discounted filing fee. The primary substantive difference was that instead of permitting an applicant to write out the goods and services, it permitted only the goods and services descriptions most likely to be approved because they already appeared in the USPTO's Acceptable Identification of Goods and Services Manual. *See generally supra* note 33 (explaining the online filing process and providing links to TEAS filing FAQs).

FIGURE 3: RATES OF PUBLICATION AND REGISTRATION OVER TIME

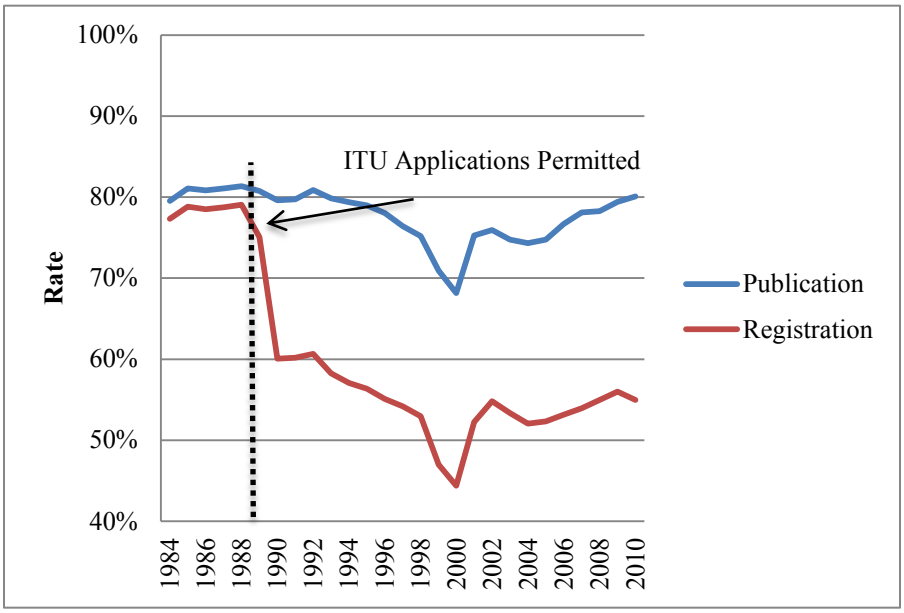


Figure 3 reveals a dramatic difference between publication (blue line) and registration (red line) rates. While publication rates hover fairly close to the 80% mark over the 26-year time period, registration rates mirror that pattern until 1989 and then drop at least 20 percentage points. These relative patterns may be explained by the presence of intent to use applications. Before ITU applications could be filed, the publication and registration rates were virtually identical—as can be seen by the closely-matched red and blue bars between 1984 and 1989. When ITU based filing first became available in 1989, registration rates took a sharp dip from 80% to 60%. All eligible marks (whether based on use or ITU) may publish, but only those that are actually used may advance to registration. Publication represents the USPTO's preliminary stamp of approval. After publication, ITU applications cannot mature to registration unless the applicant files evidence of use within a prescribed period.[95] The general dip in registration rates may indicate that many applicants decided not to use marks they once thought they might, or they did not get sufficiently organized to demonstrate use before the application time expired.

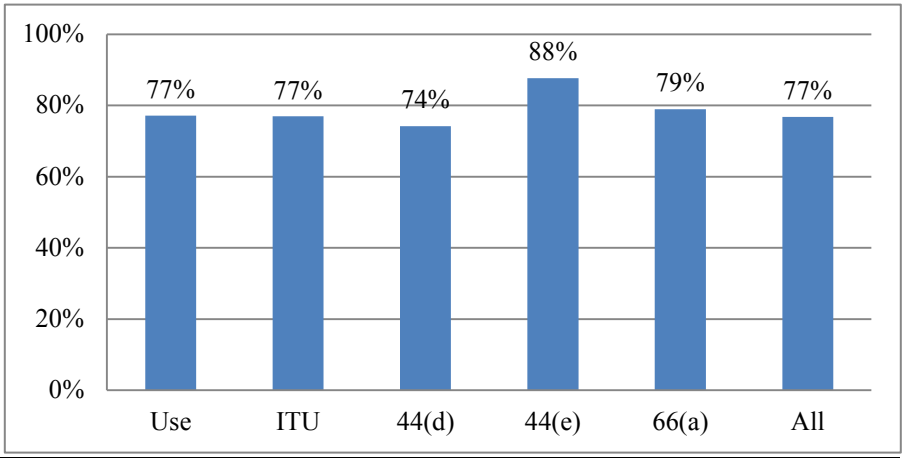
Compared to this general drop in rates, the publication and registration rates show an unusual downward spike in the 1999-2000 years. This drop corresponds with an unusually high number of applications around the same time, as seen above in Figures 1 and 2. This anomaly will provide a fertile path for additional research. It may indicate less care in filing trademark applications

95. *See supra* notes 86-89 and accompanying text.

during economically strong years.[96] However, other plausible trademark-related reasons could be explored.[97]

Figures 4 and 5 provide strong support for the theory that the declining registration rate after 1988 was due to the presence of ITU applications.[98] Figure 4 illustrates the percentage of applications approved by the USPTO for publication, and it divides the universe of applications by filing basis. Trademark applications may be based on use of a mark, 1(a);[99] intent to use, 1(b);[100] foreign ITU application, 44(d);[101] foreign registration, 44(e);[102] or an international registration, 66(a).[103] Figure 4 shows that the publication rates remained relatively constant irrespective of the basis on which the application was filed.[104] The first two bars indicate that the applications filed based on use or ITU were almost equally likely to achieve publication.[105] Comparing Figures 4 and 5, however, the relative success rates of use and ITU applications change dramatically.

FIGURE 4: PUBLICATION RATE BY INITIAL FILING BASIS



96. *See* Beebe, *supra* note 3, at 763 & n.64.

97. For example, changes in USPTO filing requirements, such as changes to class designations, specimen requirements or acceptable goods and services descriptions, may take time to learn once instituted, and therefore may account for some fluctuations in publication and registration rates.

98. In order to show how some filing bases (primarily "intent to use") were related to registration rates, it was necessary to differentiate between applications by basis. Therefore, for Figures 4 and 5 we considered only those applications having a single filing basis. Multi-basis applications were excluded from this analysis but not from other measures.

99. 15 U.S.C. § 1051(a) (2013).

100. *Id.* § 1051(b).

101. *Id.* § 1126(d).

102. *Id.* § 1126(e).

103. *Id.* § 1141(f).

104. The number of applications of each type was the following: use, 1,964,659; intent to use, 2,390,636; 44(d), 44,087; 44(e), 35,325; and 66(a), 94,641.

105. In fact, the publication rates for use and ITU applications were 77.1% and 77.0%, respectively.

FIGURE 5: REGISTRATION RATE BY INITIAL FILING BASIS

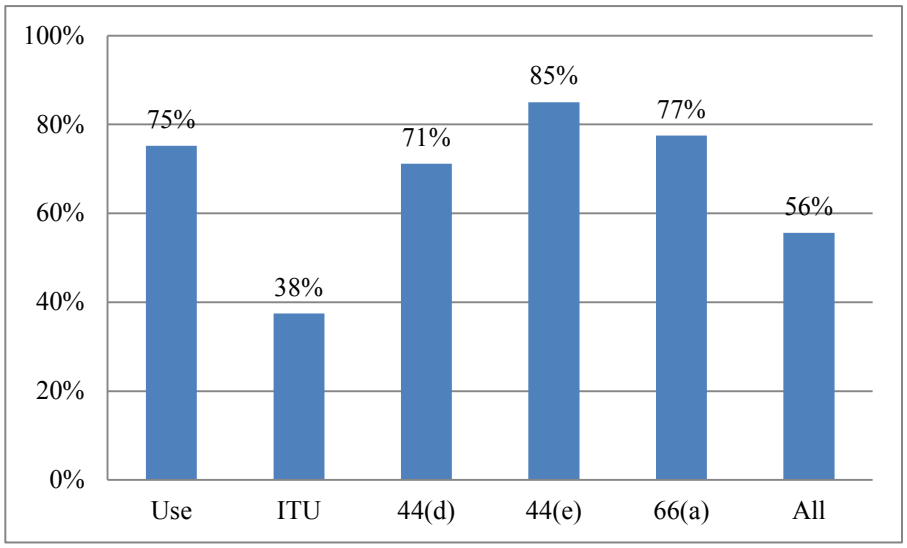


Figure 5 shows that fluctuations in registration rates were sometimes related to the filing basis. As seen in Figure 4, for most bases, the publication rates were relatively constant. In stark contrast, the first two bases in Figure 5 display a dramatic difference. Recall that both ITU and use applications proceeded past an examining attorney to publication 77% of the time. The first two bars of Figure 5 show that use applications registered 75% of the time, while ITU applications registered only 38% of the time. The much lower registration rate for ITU applications is one explanation for the decline in overall registration rates since 1989.

B. *Impact of Legal Representation*

The next two figures display the impact of legal representation on publication (Figure 6) and registration rates (Figure 7). Publication of a mark in the Official Gazette means that any obstacles initially identified in office actions have been overcome, and an examining attorney approved the application. Other events may still prevent ultimate registration—such as failure to show use of the mark or an opposition proceeding—but these are created by the applicant's abandonment of the mark, failure to prosecute the application, submit a valid specimen, or third party opposition. Therefore, Figure 6 demonstrates the difference that it makes to have a lawyer present in the first phase of an application's life when the mark is subject to approval by the USPTO. The green segments on the left reflect the percentage of applications that succeed in getting USPTO approval and advance to publication. The red segments on the right represent those that fail. The top bar reflects the percentages when a lawyer is involved, and the bottom indicates

how these percentages change when counsel does not represent the applicant. Together, they show that while 82% of applications prosecuted by attorneys were published in the Official Gazette, only 60% of applications filed by non-attorneys were published. These data suggest that the presence of a lawyer made a meaningful difference, increasing publication rates by 22 percentage points. Trademark applicants were 37% more likely to succeed in this first stage of the process and obtain USPTO approval of their marks when represented by counsel.[106]

FIGURE 6: IMPACT OF LEGAL COUNSEL ON TRADEMARK PUBLICATION

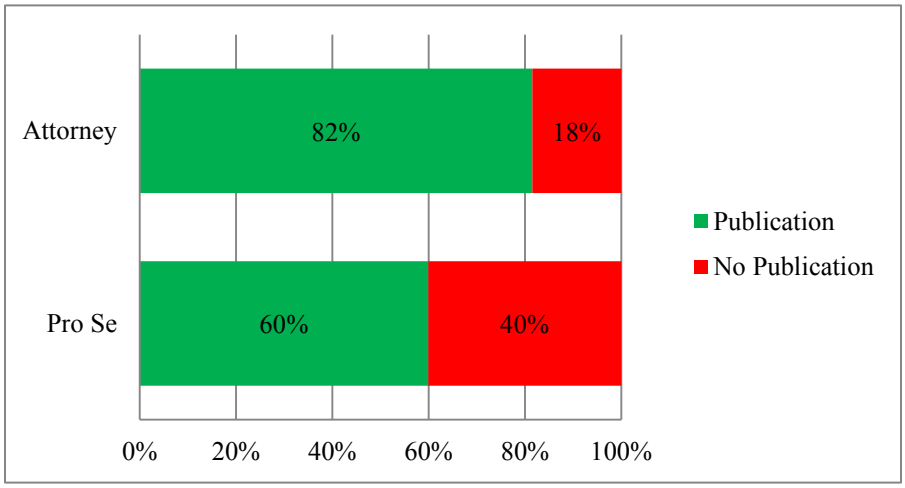
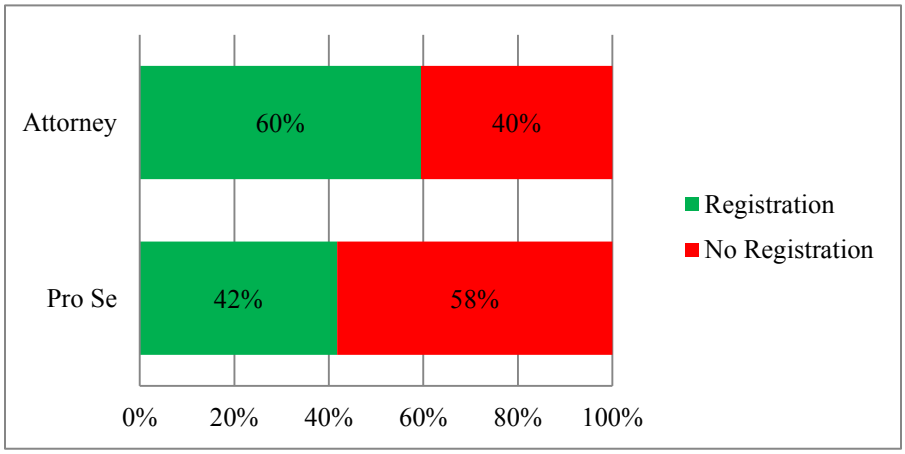


FIGURE 7: IMPACT OF LEGAL COUNSEL ON TRADEMARK REGISTRATION



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

Success rates are significantly lower in Figure 7 than in Figure 6. This difference is not surprising. As indicated in Figure 2, since intent to use became a viable filing basis in 1989, registration rates have been consistently lower than publication rates. Many published marks fail to register because the applicant does not submit evidence of use before the deadline. As demonstrated in Figures 4 and 5, the lower rates may be explained by a high percentage of abandoned ITU applications. In fact, the data indicate that a higher percentage of ITU applications are prosecuted by attorneys, relative to use-based applications.[107] Therefore, one might expect a lower registration rate for applications filed by attorneys, if all other circumstances were equal. Despite this handicap of carrying more ITU applications, many of which did not mature from publication to registration, applications prosecuted by lawyers were still significantly more likely to register than those handled by non-attorneys. The registration rate increased by 18 percentage points for applicants represented by counsel, reflecting a 43% increase in the success rate.

Figure 8 shows this same data over time, illustrating registration and publication rates for lawyers and pro se applicants from 1984 to 2010. Over the entire time period, lawyers have consistently had higher success rates at both points in the trademark life cycle. In the pre-ITU years, both the publication and registration bars for each group track almost identically. Attorney publication rates (dashed red bar) virtually match the corresponding registration rates (solid red bar) until 1989, when ITU applications became available and registration rates dropped. The same pattern holds true at a lower level for the pro se publication (dashed blue bar) and registration (solid blue bar) rates.

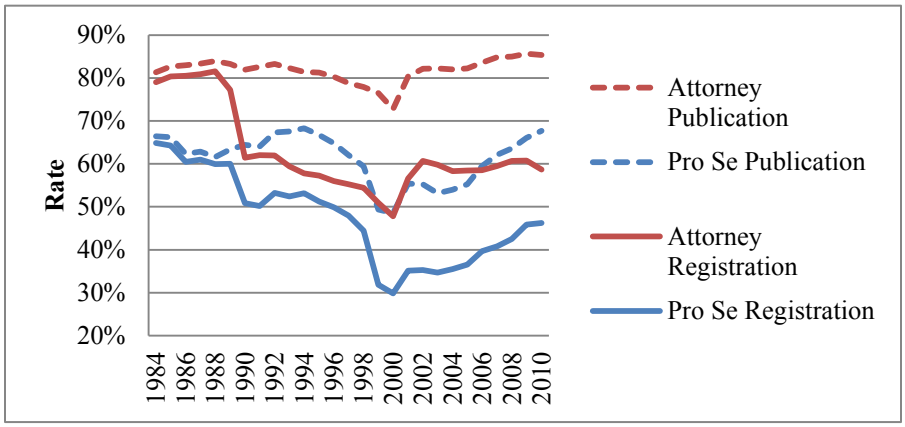
Figure 8 further reveals that pro se applicants dramatically improved their success rates between 2000 and 2010. In a decade, the pro se publication rates climbed from 49% to 68% (39% improvement), and the registration rates rose from 30% to 46% (53% improvement). One possible explanation for these increases is that the USPTO's continuous efforts to make the system easier to navigate paid off. During this decade, the USPTO improved the online registration form, added a menu for selecting pre-approved goods and services descriptions, and created tools such as FAQs and online videos to educate applicants about trademark registration requirements. Another possible reason for the improvement is the increasing use of more informal procedures for curing defects in the application. In place of mailing a formal Notice of Opposition, examining attorneys began reaching out to applicants by email or telephone, where the defects could be discussed without the necessity of a more formal and legalistic written response.[108]

---

107. Lawyers filed 80% of ITU applications and 76% of use-based applications (multi-basis applications excluded).

108. *See* U.S. PATENT & TRADEMARK OFFICE, *supra* note 41 (discussing informal procedures such as telephone and email communication for minor corrections).

FIGURE 8: PUBLICATION AND REGISTRATION RATES FOR REPRESENTED AND PRO SE APPLICANTS



These data show a strong relationship between the presence of counsel and success in the registration process, but we do not claim that lawyers cause or are the only factor that contributes to this success. Other variables that may affect success rates in trademark prosecution include the nature and size of the applicant, whether an availability search was conducted, class of goods or services, inherent strength of the mark, and the quality of the application itself. As indicated in Figures 4 and 5, some differences in registration rates may be due to the filing basis. This study provides important baseline values for the entire application pool. We hope these findings will motivate further research in which other variables are tested against this general landscape.

One variable of particular concern is the type of applicant. It is reasonable to hypothesize that large businesses may have stronger bases for registering marks than smaller enterprises or individual entrepreneurs, irrespective of the level of experience of the filer or whether the application was filed by an attorney.[109] Larger businesses with many brands may have more sophistication in selecting marks that will have a better chance of succeeding before the USPTO, and it may be difficult to disentangle sophistication from the presence of counsel in analyzing success rates. In order to begin assessing whether differences in the nature of the applicant account for the results of this study, we identified 27,940 applicants who had filed two trademark applications: one pro se and one with counsel. These applicants succeeded in getting their marks published 61% of the time when they acted pro se, but their marks published 79% of the time when they were represented by counsel. For these applicants, the presence of a lawyer marked a considerable increase in their publication rates—a full 18 percentage points—improving their success rates by 30% when counsel was present. Their registration rates also benefitted from the presence of counsel. When lawyers helped these applicants, their registration rates

109. *See* Beebe, *supra* note 3, at 765-66 (showing that individuals had lower publication and registration rates than other types of entities).

increased 14 percentage points from 47% to 64%, reflecting a 36% boost. These differences in success rates are both practically and statistically significant, indicating that inexperienced pro se applicants may substantially improve their chances of success before the USPTO when they are represented by counsel.[110]

C. *Impact of Legal Counsel and Experience on Publication Rates*

Now that it appears clear that having a lawyer correlates with success in the application process, the next important question is whether it makes a difference to work with an experienced trademark lawyer. Would an applicant have an advantage if represented by experienced counsel, or would anyone with a JD and a license to practice achieve the same results? We also were intrigued to learn whether practical experience makes a difference for non-lawyers, and if experience prosecuting applications was as beneficial as having a law degree.[111]

To explore these questions, the next several figures illustrate whether it is experience, a law degree, or a combination of both that impact the likelihood of succeeding in the trademark registration process. The USPTO data may include the name of the lawyer who prosecuted an application. The lawyer identification data are by no means a perfect measure of experience, competence, expertise, or perhaps even the presence of legal counsel, but they do provide a reasonable estimate of whether a lawyer prosecuted the application and how much exposure the applicant has had to the trademark application process.[112] As explained in the methodology section, we base the following findings on the assumption that the number of trademark applications filed by an individual or entity reflects some degree of experience with trademark prosecution. Accordingly, in the charts below, we use the number of applications prosecuted as our measure of experience.

Figure 9 displays how experience affects the likelihood that a mark will be approved by the USPTO and published in the Official Gazette. As displayed earlier in Figure 4, if one does not consider experience, the average publication rate is 77%, which may lead one to believe that the trademark office is a "rubber stamp."[113] Figure 9 undercuts that theory, showing that experience is

---

110. Two sample t-tests confirm that the results of the analyses are statistically significant at the 99% confidence level, indicating that inexperienced applicants generally may benefit from the assistance of counsel in both phases of the trademark application process.

111. Assessing experience in a dataset with millions of observations is, by necessity, a quantitative question that ignores differences in the quality of legal services that may make an even more significant impact than experience.

112. *See supra* note 69 and accompanying text.

113. *See, e.g.*, Beebe, *supra* note 3 (noting that the article's title is adapted from Mark A. Lemley & Bhaven Sampat, *Is the Patent Office a Rubber Stamp?*, 58 Emory L.J. 181 (2008)).

meaningfully associated with whether an application will advance past the gatekeepers at the USPTO.

FIGURE 9: IMPACT OF LEGAL COUNSEL AND EXPERIENCE ON PUBLICATION RATES

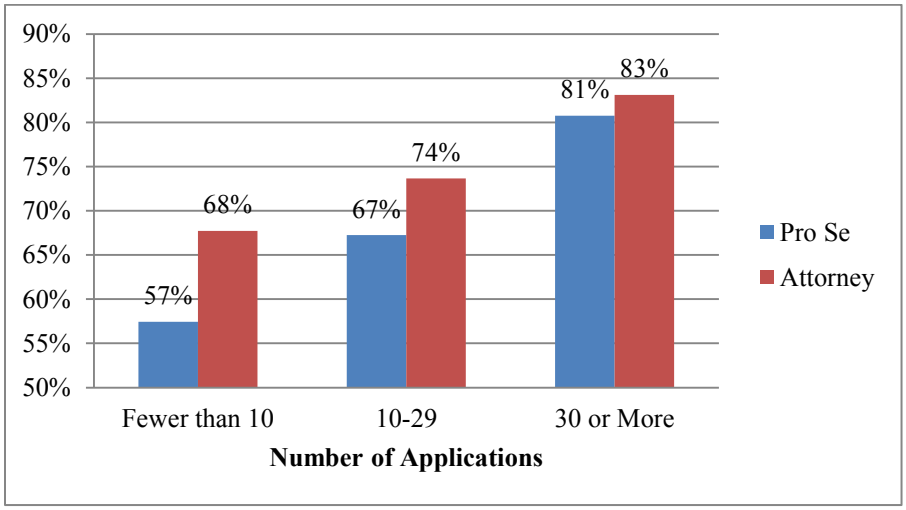


Figure 9 displays three sets of bars. Each set includes a blue bar for the percentage of pro se applications that succeeded to publication and a red bar for applications filed by attorneys. Each set represents an experience level. The first set displays publication rates for those whom we classify as the least experienced because their names appear in fewer than 10 applications. The second set represents moderately experienced trademark applicants who filed between 10 and 29 applications. The third set represents experienced persons who filed 30 or more trademark applications with the USPTO.[114]

A layperson without much experience filing trademark applications had a 57% chance of succeeding. Assuming that publication (generally leading to registration unless the applicant abandons the mark) is some measure of success, this statistic alone should be heartening to a pro se applicant with limited resources. Nearly 6 out of 10 of these applications succeeded in obtaining USPTO approval. The presence of an experienced trademark lawyer increased the success rate by 26 percentage points, a 46% increase over the rate for inexperienced pro se applicants. A moderately experienced lawyer improved the likelihood of publication by 30% (17 percentage points), and even help from an inexperienced lawyer increased the likelihood of publication by 19% (11 percentage points).

The practical significance of Figures 9 (and Figures 11, 12 and 15) may be better understood knowing how much of the applicant pool is represented by

114. These experience categories were selected because they corresponded to meaningful differences in success rates for attorney and pro se applications.

each bar. Therefore, Table II shows the numbers and percentages of attorney and pro se applications, categorized according to the three levels of experience.

TABLE II: EXPERIENCE CATEGORIES

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

The two largest populations prosecuting federal trademark applications are the most experienced lawyers and the least experienced pro se applicants. While 88% of applications with counsel were backed by lawyers who had filed 30 or more applications, only 8% of pro se applicants had that much experience. By contrast, while only 7% of attorney applications had experience with less than 10 applications, 85% of pro se applicants fell into this most inexperienced category. The greatest real world significance of Figure 9 is the substantial difference in publication rates between inexperienced pro se applicants and the most experienced lawyers.

Nonetheless, an important theme apparent in Figure 9 is that experience matters at this stage in the application process. As seen in Figure 6, lawyers succeeded in getting marks published 82% of the time, compared to a 60% success rate for non-lawyers, but those data hide important differences that may be accounted for by experience. Figure 9 shows how experience is related to those average numbers. Among those with the greatest experience, the significance of a license to practice law is reduced almost to its vanishing point. In the highest experience category of 30 or more applications, applications handled by lawyers published 83% of the time, compared to 81% of pro se applications.

A closer look at the most experienced pro se applicants reveals that the category is dominated by corporations with significant resources to hire outside counsel when needed, or perhaps have in-house counsel down the hall available to assist with trademark applications informally without appearing as counsel of record. The chart below contains the top 20 pro se filers, their 2011 revenue figures, and information about the numbers and percentages of pro se applications filed:

TABLE III: MOST FREQUENT PRO SE APPLICANTS

Applicant	2011 Revenue in billions[115]	Applications		
		Total	Pro Se	% Pro Se
American Greetings	$1.6	1,814	1,744	96%
20th Cent. Fox Film (News Corp.)	$32.7	2,496	1,275	51%
Bally Technologies	$.8	1,319	1,127	85%
Hasbro	$4.3	4,224	1,041	25%
International Data Group	$3.2	2,107	1,026	49%
Conair	$2.0	1,376	915	66%
Avon Products	$10.9	1,436	767	53%
Hershey	$5.7	875	709	81%
The Home Depot	$68.0	926	680	73%
Aristocrat Technologies	$.7	901	642	71%
American Express	$30.2	640	630	98%
Nestle	$112.0	1,762	609	35%
HE Butt Grocery	$15.6	1,087	586	54%
Victoria's Secret	$9.6	790	579	73%
The Wine Group	$1.0	627	512	82%

115. Unless separately noted in this footnote, the revenue data were taken from the 2011 Fortune 500 rankings. *Fortune 500 2011: Annual ranking of America's largest corporations from Fortune Magazine*, http://money.cnn.com/magazines/fortune/fortune500/2011/index.html (last visited May 11, 2013). Am. Greetings: AMERICAN GREETINGS, *American Greetings Announces Fourth Quarter and Full Year Earnings*, http://investors.americangreetings.com/index.php?s=43&item=318 (Apr. 26, 2012). Bally Techs: BALLY TECHNOLOGIES, *Bally Technologies, Inc. Reports Fiscal 2011 Results*, http://news.ballytech.com/press-release/company/bally-technologies-inc-reports-fiscal-2011-results (August 11, 2011). Hasbro: HASBRO, *Hasbro Reports Revenue and Earnings Per Share Growth for 2011*, http://investor.hasbro.com/releasedetail.cfm?ReleaseID=646231 (Feb. 6, 2012). Int'l Data Group: FORBES, #122 International Data Group, http://www.forbes.com/lists/2011/21/private-companies-11_International-Data-Group_6BOM.html (last visited May 25, 2013). Conair: FORBES, #209 Conair, http://www.forbes.com/lists/2011/21/private-companies-11_Conair_TNZE.html (last visited May 25, 2013). Aristocrat Techs: Aristocrat Leisure Limited, 2011 Profit Announcement, http://www.aristocrat.com.au/company/investor/Documents/Financial%20Results/1%202011%20Results%20Announcement%20Pack.pdf. HEB Grocery: FORBES, #12 HE Butt Grocery, http://www.forbes.com/lists/2011/21/private-companies-11_HE-Butt-Grocery_S854.html (last visited May 25, 2013). The Wine Group: Shanken News Daily, *Wine Group's Kent Becomes Vice Chairman, Vos Is Named President And CEO* (Aug. 21, 2012), http://www.shankennewsdaily.com/index.php/2012/08/21/3825/wine-groups-kent-becomes-vice-chairman-vos-is-named-president-and-ceo/ (last visited May 25, 2013). Ainsworth Game Tech., Annual Report 2011, http://www.ainsworth.com.au/investor_pdfs/asx/2011/AGT%20AGM%202011_ANNUAL%20REPORT.pdf.

XEROX	$21.6	1,269	498	39%
Bristol-Myers Squibb	$19.5	3,071	495	16%
Dupont	$32.7	1,655	430	26%
Ainsworth Game Technology	$1.0	446	430	96%
Monsanto	$10.5	438	411	94%

The above pro se applicants likely had daily access to in-house and outside legal counsel. Indeed, as the table shows, each has filed at least ten applications with the help of a lawyer. Therefore, one should be cautious about concluding from these data that experience matters as much as the presence of counsel because the nature of the applicants and the information in Table III suggest that many experienced pro se applicants have counsel involved with managing their trademark portfolios. It is easy to envision a corporate legal department in which paralegals and in-house attorneys work together on brand strategy, so that whether an attorney or trademark professional's name appears on the application does not make much of a difference. The vanishing difference between the experienced pro se applicants and the experienced lawyers may mask the fact that often, these bars may reflect the work of the same people.

As experience declines, the success rate declines for both lawyers and non-lawyers, and the difference between the two groups increases. Marks prosecuted by people who filed between 10 and 29 applications published 74% of the time if the person was a lawyer, and 67% of the time if prosecuted by a non-lawyer. In the set with the least experience, lawyers succeeded in getting marks published 68% of the time, while non-lawyers succeeded only 57% of the time. Therefore, the data show that experience matters, especially if the person handling the application is pro se.

There are many possible explanations for these differences, some of which are explored below as we report what happens to lawyer and pro se applications when they confront an obstacle in the application process.[116] If lawyers provided value that derived from their legal training alone, then their success would always substantially exceed that of pro se applicants, even among the

116. To the extent that the data available to us provide insights into these reasons, they are discussed below. However, we recognize that there may be many other reasons that are beyond the scope of this Article. For example, lawyers may have academic and practical training that make them especially well-equipped to assist clients in selecting marks that are more likely to register. Because lawyers have ethical duties of competency to their clients, they may have a vested interest in making sure that they do the best they can to recommend filing applications only if the mark is likely to succeed and advocate for registration even when confronting a barrier. Once an application has been filed, a lawyer's training and professional obligations may create greater facility and incentives to confront barriers in the application process and see marks through to registration. For these reasons, a novice lawyer may have a better chance of success than a novice applicant. In addition, lawyers often have greater experience with bureaucratic and administrative work, and therefore may be less conflict averse in dealing with office actions or opposition proceedings. *See supra* note 78 and accompanying text.

very experienced. Clearly, it does not.

The next two charts illustrate the impact of counsel when the applicant confronts an impediment from the USPTO before publication. The data confirm our hypothesis. The presence of a lawyer made a greater difference if the examining attorney issued an office action indicating that the application was defective. Trademark applications drafted by lawyers—especially experienced intellectual property lawyers—may be less likely to prompt the USPTO to issue an office action because these lawyers understand how to avoid common problems.[117] Of course, they may also take more chances, knowing that if an office action is issued, they will know how to correct the defect. These suppositions cannot be tested from this dataset because applications are treated as prosecuted by counsel if a lawyer became involved at any time before registration. In addition, the data do not show the grounds on which office actions were issued.[118] However, they do show that most applications prompted at least one office action.[119] Office actions were issued in 72% of applications that remained pro se throughout the process, versus 64% of applications in which an attorney appeared.

Figure 10 shows how the assistance of counsel affects success rates when an office action presents a potential barrier to publication. The first important finding in Figure 10 is that office actions create formidable barriers to publication.[120]

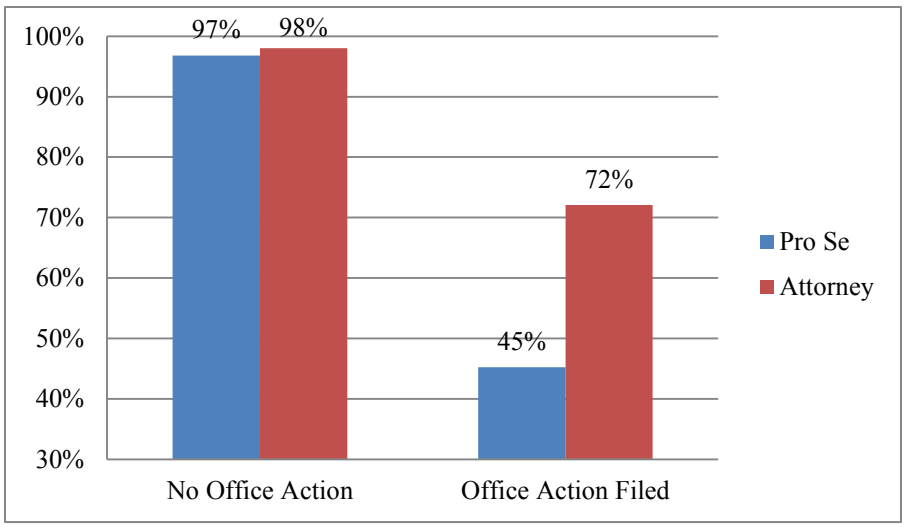
117. Federal law prohibits registration of marks for a variety of reasons. The prohibited categories include symbols that are immoral, deceptive, scandalous, functional, or false geographic designations. Marks also may not be registered if they are descriptive unless the applicant can demonstrate that the mark has "become distinctive of the applicant's goods in commerce." 15 U.S.C. § 1052 (2013); *see supra* notes 35-38 and accompanying text.

118. This issue may provide fertile ground for future research, in which samples of trademark applications prompting similar types of office actions could be examined.

119. *See* Graham et al., *supra* note 2.

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

FIGURE 10: IMPACT OF OFFICE ACTIONS AND PRESENCE OF COUNSEL ON PUBLICATION RATES



As discussed in the methodology section, the presence of an office action was strongly negatively correlated with publication in the Official Gazette.[121] When the USPTO issued an office action objecting to an application, the applicant overcame the barrier 72% of the time if represented by counsel, but had only a 45% success rate if the applicant was pro se. Therefore, the data suggest that when responding to an office action, the presence of a lawyer makes a significant difference in overcoming this obstacle. Applicants with counsel had a success rate 60% higher (27 percentage points) than pro se applicants in overcoming office actions and proceeding to publication.

Perhaps even more telling, the data suggest that lawyers make a difference in overcoming office actions even when the defect is easy to correct. According to the USPTO website, examining attorneys will generally transmit office actions by letter.[122] However, "[i]f only minor corrections are required, the examining attorney may contact the applicant by telephone or email (if the applicant has authorized communication by email)."[123] Among applications in which an office action was transmitted by email but not by mail, those handled pro se proceeded to publication at a 39% rate, whereas those handled with the assistance of an attorney published at a 74% rate. These data unequivocally show that even requests for minor changes have taken pro se applications off the track to publication much more frequently than applications that were prosecuted by lawyers.

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

---

121. *See supra* note 73 and accompanying text.
122. U.S. PATENT & TRADEMARK OFFICE, *supra* note 41.
123. *Id.*

FIGURE 11: IMPACT OF ATTORNEY AND EXPERIENCE ON PUBLICATION AFTER OFFICE ACTIONS ARE FILED

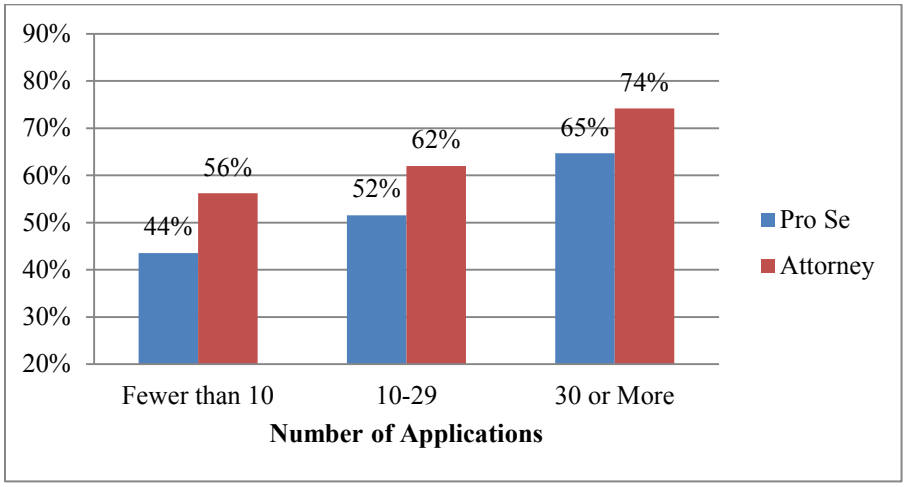


Figure 11 shows that the presence of counsel may be especially helpful when the USPTO issues an office action.[124] Compared to Figure 9, which shows publication rates generally, Figure 11 illustrates that the differential in publication rates between lawyers and non-lawyers expands at every experience level. In the novice category, the differential increases by one percentage point, from 11% to 12%. In the 10-29 group, the differential increases from 7% to 10%, and for those most experienced, it increases from 2% to 9%.

Many possible explanations may be explored to determine exactly why the moment a conflict arises is precisely when lawyers are especially beneficial, even among the most experienced applicants. One reason is that lawyers may have more familiarity with trademark doctrine. The data support further investigation of this theory, because as Figure 11 indicates, lawyers with more experience succeeded more frequently in publishing marks that faced an office action. This trend held true even though one would expect the especially challenging applications to be handled by the most experienced trademark lawyers. Interestingly, when faced with this obstacle, even the presence of inexperienced lawyers increased publication rates. One possible reason is that they have a greater understanding of how to conduct legal research to understand and address an examiner's objections. Also, some pro se applicants may be conflict averse by nature, preferring not to fight, and therefore abandon

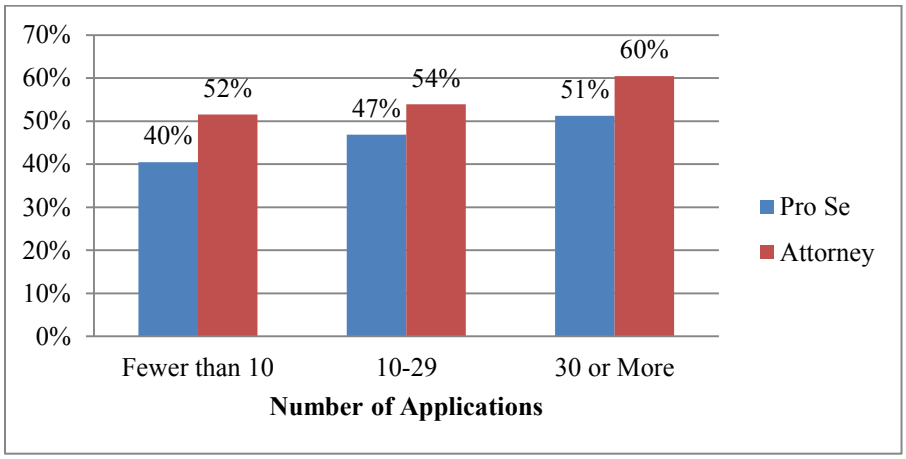
124. The numbers of applications in each group are: pro se applicants with fewer than 10 applications, 661,618; attorney applicants with fewer than 10 applications, 180,740; pro se applicants with 10-29 applications, 48,041; attorney applicants with 10-29 applications, 137,780; pro se applicants with 30 or more applications, 42,027; and attorney applicants with 30 or more applications, 2,035,269.

applications rather than responding. Irrespective of the reasons for these trends, the data in Figures 10 and 11 reinforce the value that lawyers can and do provide when their expertise is likely to be of greatest need—when applicants encounter difficulties navigating the waters of legal procedures.

D. *Impact of Legal Counsel and Experience on Registration Rates*

The ultimate goal of a trademark application is admission to the Principal Register, the second win in our analysis of the trademark application process. Therefore, this section explores the impact of legal counsel and experience on registration rates. Figure 12 displays the percentages of applications that matured to registration, broken out by experience level and the presence of counsel.

FIGURE 12: IMPACT OF LEGAL COUNSEL AND EXPERIENCE ON REGISTRATION RATES



These results reflect success in one important respect because registration is the ultimate goal of a trademark application. However, these data reflect less about the value of legal counsel than that portrayed in the previous figures related to publication. Many published marks fail to register simply because the applicant began with a good faith intent to use the mark but later decided not to proceed within the time allotted by the USPTO. If the applicant misses the deadline for filing its statement of use and specimen showing actual use of the mark in commerce, the mark will not be registered.[125] Many applications fail between publication and registration, not because of any lack of expertise, but because a business decision was made not to continue seeking protection for the brand.[126] Nonetheless, similar, albeit less dramatic, patterns to those we

125. 15 U.S.C. § 1051 (2013).
126. *See infra* Figure 13.

saw in Figures 9 through 11 are apparent.

The data show that lawyers were much more likely to succeed in getting marks registered than inexperienced pro se applicants. Applications prosecuted by even an inexperienced lawyer had a 30% greater likelihood of obtaining registration than those prosecuted by similarly inexperienced pro se applicants (12 percentage points). If the lawyer was moderately experienced, the rate of registration increased by 35% (14 percentage points), and if the lawyer was very experienced, the success rate increased by 50% (20 percentage points). However, these data should be viewed with some caution because the success rate differential is skewed by the presence of abandoned intent to use applications. By contrast, these effects did not skew the data in Figures 9 through 11 because statements of use for ITU applications are filed after publication. Accordingly, one important lesson to draw from Figure 12 is that effectiveness of experienced counsel may be better understood by looking at publication rates than overall registration rates.

Figure 13 illustrates our basis for concluding that the lower registration rates in Figure 12 were due in large part to the presence of ITU applications.

FIGURE 13: STATUS CODES OF PUBLISHED APPLICATIONS THAT FAILED TO REGISTER

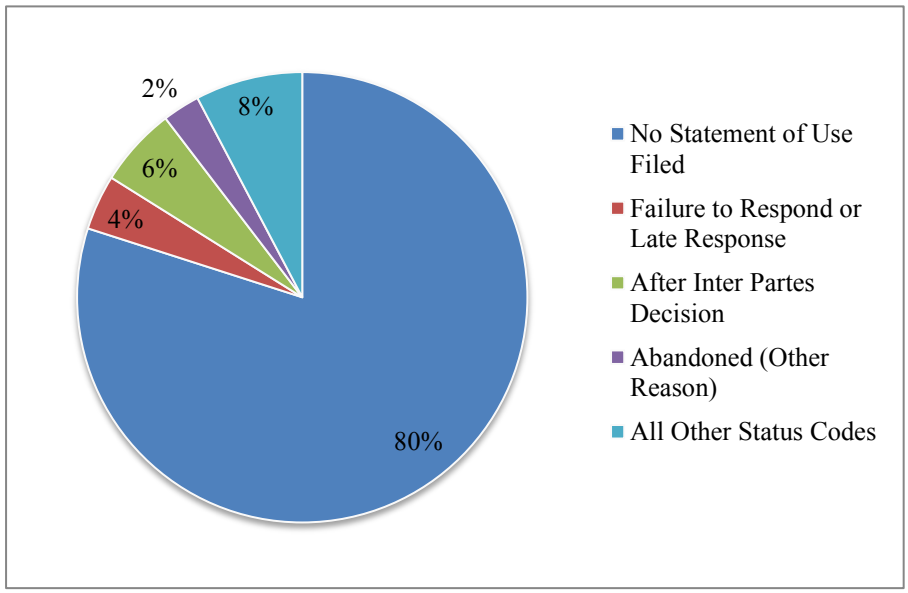


Figure 13 shows the reasons why published marks did not mature to registration. The vast majority (80%) failed to register because the applicant never filed the required statement indicating that it began using the mark with the goods or services identified in the application.

The next two figures illustrate the impact of having trademark counsel when a third party opposes the registration of a published mark. After the USPTO approves the application and publishes the mark in the Official

Gazette, a 30-day time window opens in which third parties (perhaps a competitor using a similar brand) may object to the registration. While office actions issued by the USPTO before publication are common obstacles, private opposition proceedings are filed much less frequently. Of applications containing complete prosecution history, 66% had at least one office action filed prior to publication, while fewer than 3% had an opposition instituted prior to registration.[127]

Although less common than office actions, opposition proceedings are generally more difficult to surmount. Figure 14 illustrates the impact of oppositions on registration rates, and Figure 15 breaks down these results into representation and experience categories.[128] In order to isolate the effect of opposition proceedings, we excluded ITU applications so that the results would not be affected by applications abandoned for failure to file a statement of use. For published marks, an opposition poses a formidable barrier.[129] In Figure 14, the set of bars on the left indicates that when no opposition was filed, a published mark registered 99% of the time when counsel was present and 98% of the time when the applicant was pro se. Most published marks followed this path. However, when an opposition proceeding was filed, the mark was substantially less likely to register. Only 47% of all applicants that faced an opposition proceeding ended up registering their marks; for applicants represented by counsel, the registration rate was 49%, but for pro se applicants, the registration rate was only 34%.

127. Oppositions were filed in 8,048 of 321,721 published pro se applications (2.5%) and 35,671 of 1,356,682 published attorney applications (2.6%). These statistics exclude ITU applications.

128. Throughout this study, the "attorney-name" field was used as a proxy for whether an attorney assisted in the trademark application process. It is unclear from the data structure whether an attorney's name would appear in the field if the attorney were hired solely to defend an applicant in an opposition proceeding. This omission in the data may have led us to underestimate the impact of legal assistance in overcoming an opposition proceeding.

129. *See supra* note 74 and accompanying text.

FIGURE 14: REGISTRATION RATES WHEN OPPOSITION FILED

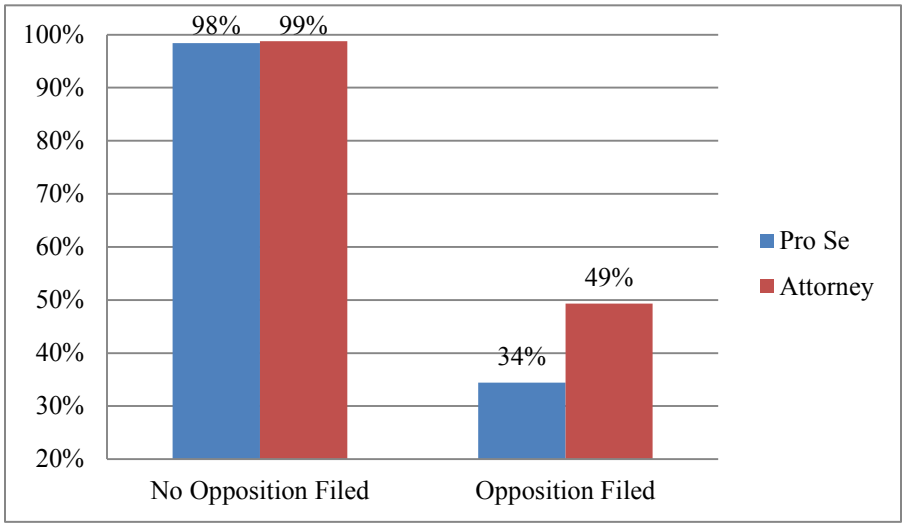
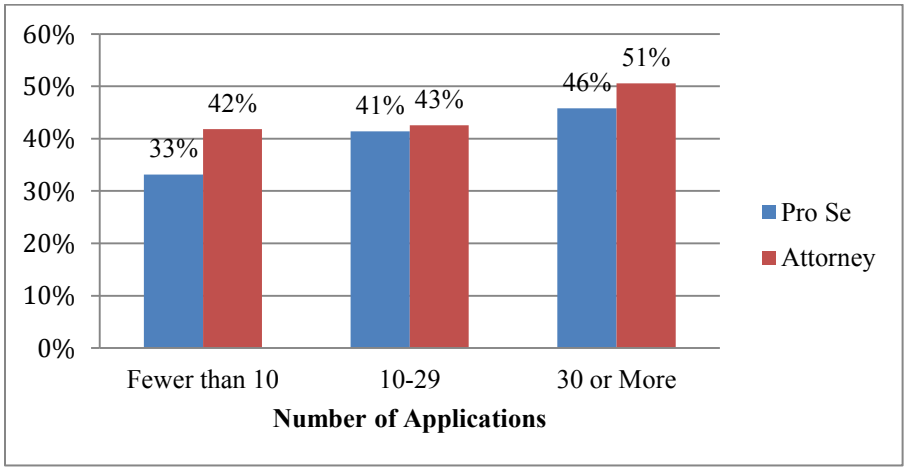


Figure 15 shows the data from Figure 14 in greater detail by displaying how experience and the presence of legal counsel affected registration rates when an opposition was filed.

FIGURE 15: IMPACT OF LEGAL COUNSEL AND EXPERIENCE ON REGISTRATION RATES WHEN OPPOSITION FILED



This figure illustrates another variation on themes observed earlier. Both experience and a law degree mattered, and the data indicate that they mattered more (as we saw earlier with office actions) in situations in which the application faced a legal challenge. Applications facing an opposition proceeding with an inexperienced lawyer had a 27% greater likelihood of

maturing to registration (9 percentage points) than those defended by inexperienced pro se applicants. With the presence of highly experienced counsel, the registration rate was 55% higher (18 percentage points) than it was for inexperienced pro se applicants. Although they were not filed frequently, opposition proceedings were often fatal to trademark applications—but an application was much more likely to overcome this obstacle when an experienced attorney handled the application.

CONCLUSION

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

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

Most people who prosecuted federal trademark applications fell into two categories: experienced lawyers and inexperienced pro se applicants. Overall, applications prosecuted by experienced counsel were 50% more likely to register than those handled by inexperienced pro se applicants (20 percentage points). If an application confronted an obstacle, the presence of counsel made an even more significant difference. Most applications had to overcome at least one office action before advancing to publication. When an office action was issued, applications handled by an experienced trademark lawyer were 68% more likely to publish than those that were handled by an inexperienced pro se applicant (30 percentage points). On rare occasions when an opposition was filed after publication, experienced attorneys were able to successfully overcome such oppositions at a 55% higher rate than inexperienced pro se applicants (18 percentage points). When a proposed trademark is important to an inexperienced pro se applicant, having an attorney may significantly increase the likelihood of overcoming barriers in the process and obtaining a certificate of registration.