

Lesson from the COVID-19 Pandemic for Trademark Law? The Case (for a Better Way) to Prevent Opportunistic Trademark Applications

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Abstract

In a previous paper published in 2021, I presented an empirical review of the over 800 trademark applications that were filed with the USPTO in 2020 for the terms “Covid,” “Covid-19,” and “Coronavirus.” Not surprisingly, the COVID-19 pandemic proved to be unprecedented also for the number of “COVID-19 related” trademark applications. The data presented offered insights into various problematic issues related to these applications, notably a large number of applications filed by individuals for unrelated or merchandising products. In particular, the papers concluded predicting that a considerable number of these applications would be rejected for failure to function as mark or because the sign would be found to be used descriptively or misleadingly. The paper also predicted that several applications would be abandoned during the examination process.

The paper that I will present the 2022 ATRIP Conference would continue the analysis and review the previously studied applications in order to establish whether the applications are still “live” and how many, on the other hand, have been either rejected or abandoned. The paper would also update the analysis of the applications including the wordings at issue that have been filed in 2021 to better study the trends from a larger sample of applications over a longer period of time. In particular, the objective of the paper is to expose even further and with stronger evidence the problem of “opportunistic filings” and their negative impact on the trademark system. Notably, attempts to register trademarks including terms related to sensational events is not a new phenomenon. However, this phenomenon remains a weak aspect of the trademark system and the Covid-19 pandemic exposed it to an unprecedented level. The dataset presented in this paper would confirm that is taking months, endless office actions, examiners’ time and efforts, and in turn resources from our public administration to process these filings, many of which are ultimately rejected or abandoned. It is the hope of the author to use these additional data to further underline the negative effects of opportunistic filings and formulate solutions to address them such as specific prohibitions and higher fees for rejected applications based on failure to function as marks.