Brett Heavner and Juris Klavins

partner and staff attorney at Finnegan (U.S.)

The Trademark Journey of Obsidian Flames: A Narrative Exploration of the U.S. Trademark System

Meet Obsidian Flames – a European band revered for its innovative fusion of classical, rock, country, pop, and world music elements. What started out as a small spark of creativity in their home region, has now resonated across the globe, and the band has decided the time has come to solidify its identity through trademark registration in one of their key target markets, the United States using the Madrid Protocol. This article follows their journey through the complexities of the trademark registration process with the United States Patent and Trademark Office (USPTO), the challenges posed by non-traditional trademarks, common law marks, adversarial proceedings, and recent trends in U.S. trademark practice.

I. Trademark Registration Process

The first thing Obsidian Flames should consider is that under U.S. law, applicants must have a bona fide intention to use the mark in U.S. commerce. Madrid applicants are frequently surprised to learn that U.S. extensions are also subject to this "bona fide intention to use" requirement and that it applies to *all* the goods and services listed in the application.[1] Lack of bona fide intent to use the mark makes the application vulnerable to cancellation of the entire resulting registration.

Under U.S. law, a bona fide intention means a good faith intent to use the mark in connection with a product or service in the ordinary course of trade and not merely a desire to reserve a mark. Thus, "defensive" registrations for goods and services that an applicant has no intention of offering are invalid. Further, the "bona fide" nature of an applicant's intent is judged objectively and requires that the applicant provide evidence of specific plans or ongoing efforts to use the mark. Failure to produce a business plan, schematics, or any documentation of steps to use the mark creates an inference that bona fide intent is lacking.[2] Unsupported declarations or statements of subjective intent will not meet the legal test.[3]

Having scheduled tour dates for concerts in the U.S., the band should have no problem satisfying the bona fide intent to use the Obsidian Flames name in connection with at least entertainment services in the nature of live performances by musical bands. Additionally, to diversify its revenue streams, the band has decided to sell merchandise at venues during their upcoming tour which will feature the name Obsidian Flames as well as their logo depicting a smooth, igneous rock surrounded by colorful flames. Since they are not yet selling t-shirts, stickers, shaker cups, or other merchandise, what should they do from a trademark perspective? It is perfectly fine for them to file applications covering products that are in development.[4] Obsidian Flames should simply be prepared to show that it (a) is capable of offering the listed goods and services, and (b) has a documented plan to do so. However, they should refrain from using excessively long lists of goods/services and only designate goods and services for the U.S. extension that they have plans to offer. Their trusted counsel will use clear language to describe the intended goods and services, referring to the USPTO's Trademark Identification Manual when applicable.

Additionally, the application will include a detailed description of the logo, specify any literal components, and use a high-quality image. If the band wishes to register its logo in specific colors, they will have to declare the names of the colors depicted in the logo in plain wording, i.e., red, yellow, and black instead of using, for example, hex codes (#FF000, #FFFF00, #000000) or other codes. Knowing that the band's creative sparks tend to fly in different directions, including with respect to the continually changing color schemes of their logo, the band's counsel recommends they file for a black and white logo, instead of specific colors, to cover all color variations of the rock and flame logo. This should future-proof the logo and help avoid specimen of use issues at the time of filing Declarations of Use under Sections 8 or 71.[5]

Regarding fees, the band's counsel advised them that as of February 18, 2025, as part of an across-the-board overhaul of filing and maintenance fees, the USPTO has increased the filing fees for in-bound

1 15 U.S.C. § 1141f(a).
2 *L.C. Licensing, Inc. v. Berman*, 86 U.S.P.Q.2d 1883 (T.T.A.B. 2003).
3 *Ibid.*
4 House Judiciary Committee Report on H.R. 537, H.R. No. 100-1028, p. 9 (Oct. 3, 1988).
5 TMEP §§ 807.07, 1604.13, and 1613.13.

filings under Section 66(a) of the Lanham Act from $500 per class to $600 per class. Counsel also noted that domestic applicants incur a $100 per class surcharge for using a free-form text box – instead of selecting language directly from the Identification of Goods and Services Manual – to describe the goods and services in their application. However, due to technical limitations at WIPO, the USPTO is *not* applying surcharges for using the free-form text box to enter an identification statement for Section 66(a) (Madrid) applications.[6]

Having heard about all these requirements and fees, the band asked whether they could forego the registration process and establish their trademark rights through use under common law. Their counsel explained that while it is true that in the United States, one can accrue rights in a mark through use without going through a formal registration process and incurring fees at the USPTO, there are some significant drawbacks to this approach. First, the band would only be able to assert its rights over an unregistered mark within the geographic region(s) where it is used. In contrast, federal registrations offer nationwide protection. Second, a federal trademark registration establishes a legal presumption of ownership of the mark whereas marks under the common law do not carry the same presumption. Third, as the owner of a federally registered trademark, the band would have additional remedies available to it compared to a plaintiff who owns only common law trademark rights. Such remedies may include monetary damages (e.g., disgorgement of the infringer's profits), statutory damages, and punitive damages.

The band is currently scheduled to tour in the upper northeast of the United States and they are concerned that another band may adopt a similar name in other parts of the country, which will likely make future enforcement more challenging and costly. Thus, the band decided to file applications for their name and logo with the USPTO.

The band's counsel then outlined what to expect once a filing is made. After receiving an application, the USPTO will on average take between 6-9 months to examine an application. Fortunately, the examiner assigned to the band's word mark and logo applications did not refuse the applications on substantive grounds, such as likelihood of confusion under Section 2(d), or mere descriptiveness under Section 2(e)(1) of the Lanham Act. However, they did object to the identification of goods and services as being indefinite. As a Madrid applicant, Obsidian Flames has six months to file a response (non-Madrid applicants are given 3 months to respond with an option to extend for another three months in exchange for payment of a $125 governmental fee). Additionally, they must designate a U.S.-licensed attorney to respond to or appeal the refusal.[7] Keen to obtain the right to use the ® symbol, for which having a registered mark is a prerequisite, the band directs its U.S. counsel to prepare a response agreeing to the requested amendments, and, within a few weeks, the word mark and logo applications are approved for publication.

II. Oppositions before the Trademark Trial and Appeal Board

Marks that have passed the examination stage are published in the USPTO's Official Gazette. This publication gives third parties 30 days to oppose, or file an extension to oppose, any application they believe will harm their trademark rights.

On the very last day of the 30-day publication window, Obsidian Flames' word mark application encountered a challenge from a rival. A renowned classical music ensemble filed an opposition, claiming that the band's name Obsidian Flames was confusingly similar to their own. Strongly believing that the marks in question are not similar, the band is perplexed as to what to do next.

To give the band some peace of mind, their counsel provides them with the following brief overview of U.S. trademark opposition proceedings. Oppositions before the Trademark Trial and Appeal Board ("TTAB" or "Board"), the judicial arm of the USPTO, are somewhat similar to a civil action in court, but address solely whether a party has the right to register a trademark. The TTAB does not have the power to issue injunctions or award monetary damages. The classical music ensemble, acting as the Opposer, will file a Notice of Opposition with the TTAB. This document, akin to a complaint, will outline the grounds for their opposition, such as likelihood of confusion and dilution. The TTAB will then issue an institution order to both parties, detailing the discovery and trial schedule, and giving Obsidian Flames 40 days to file their Answer. Answers will typically include a short denial of the allegations and applicable affirmative defenses and counterclaims.

Within 30 days of filing the Answer, both parties will hold a discovery/settlement conference pursuant to requirements identified by Federal Rule of Civil Procedure ("FRCP") 26(f). During this conference, the parties will discuss various topics, including settlement, modifications to the discovery/trial calendar, expert testimony, and any changes to the TTAB's Standard Protective Order (this order automatically protects confidential information disclosed during inter partes trademark proceedings). Thereafter, the parties will be obligated to serve Initial Disclosures (preliminary information about witnesses, documents, and other evidence) before they can serve any discovery requests.

6 https://www.finnegan.com/en/insights/blogs/incontestable/uspto-trademark-fees-changes-for-2025.html and https://www.finnegan.com/a/web/9e2RYHh3jcqVdmXbKZB5Bx/microsoft-word-uspto-trademark-fees-changes-for-2025.pdf

7 37 C.F.R. §2.11(a); TMEP §601.01(a).

The Discovery Period will then open, lasting for 180 days, though it can be extended by agreement or motion granted by the Board. As in a federal court action, both parties will engage in fact-finding, exchanging information and evidence through interrogatories, document requests, requests for admission, and depositions. The same motions available in federal and state courts are generally available in oppositions before the Board (e.g., motions to dismiss, motions to compel, motions for summary judgment).

Of particular relevance to Obsidian Flames, in Board cases, unlike civil actions, depositions of foreign parties or their representatives may be taken only upon written questions unless (1) the parties stipulate to an oral deposition, or (2) by order of the Board, upon motion of the party seeking the oral deposition, and where there is a show of good cause. However, if the band or its representatives will be in the U.S. during the discovery period, they may be deposed by notice. 30 days prior to the close of discovery, both parties will disclose their expert testimony. Each party will then make pretrial disclosures, identifying witnesses and summarizing their expected testimony.

Perhaps the most significant difference between an opposition and a civil action is that the Board does not sit for a live, in-person trial. Instead, an opposition trial is conducted through "testimony periods" with written submissions. First, the Opposer will submit their evidence, followed by a period for Obsidian Flames to submit its evidence, and then a rebuttal period for the Opposer. Evidence will be submitted through depositions, declarations, and Notices of Reliance.

After the testimony periods, both parties will file trial briefs summarizing the evidence and presenting their arguments. Either party will be able to request an oral hearing before a panel of three Administrative Trademark Judges. During the oral hearing, each party will have 30 minutes to present their arguments.

After about three to six months, the TTAB will issue a final decision. If the decision is unfavorable, the losing party will be able to request reconsideration or file an appeal either to the U.S. Court of Appeals for the Federal Circuit or a U.S. District Court. If Obsidian Flames ultimately prevails, its application will be approved for registration. Thus, the USPTO will issue the Certificate of Registration, officially registering the trademark.

As with the vast majority of oppositions before the TTAB, the classical ensemble settles its dispute once Obsidian Flames agreed to narrow its identification of goods and services in the pending application and by the parties agreeing to certain minor limitations on the visual presentation of their future performances.

III. Registration of Non-Traditional Trademarks

Going through the trademark registration and opposition process has been enlightening for the band in many respects. They see just how valuable a brand can be. This has prompted the band to think outside the box and explore whether they can leverage non-traditional marks. During a post-concert debriefing session, the band decides to launch a non-alcoholic line of beverages to be sold at concert venues and stores across the United States. Could they use a catchy jingle as a sound mark in the advertisement of the beverage? With their imaginations sparked, the band is also wondering if they could perhaps register a signature dance move that one of the band members always performs as a motion mark or an aroma therapy scent that they release during their concerts to get the audience in the right frame of mind. The band arranges a meeting with their trusted counsel who gives them the following overview of non-traditional marks.

Under U.S. law, the Supreme Court has read the statutory language of the Lanham Act to be non-restrictive when it defined a trademark as "any word, name, symbol, or device," suggesting that "almost anything at all is capable of carrying [trademark] meaning."[8] Thus, almost anything that can be perceived by consumers can serve as a trademark so long as it can be used to identify and distinguish the source of one's goods or services.

While the Lanham Act's language is broad, there are important conditions which the mark must satisfy before it can be registered. Most notably, it cannot be functional and, if it is not inherently distinctive, the applicant must show acquired distinctiveness (i.e., the mark must have been promoted for a sufficient period of time that consumers view it as a source identifier, also known as consumer "secondary meaning").

A finding of functionality will preclude a business from monopolizing a beneficial product feature by claiming it as an identifier of the product's source. A proposed mark that is found to be functional cannot be registered, irrespective of any evidence in support of showing acquired distinctiveness.

According to U.S. case law, a feature is functional if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article."[9] In determining whether a feature is functional, the USPTO considers several factors, including the existence of utility patents that disclose the feature's functional/utilitarian advantages, advertising by the applicant highlighting the feature's benefits, the availability of alternative designs, and whether the design results from a simple or inexpensive method of manufacture.

8 Qualitex Co. v. Jacobson Prod. Co., 514 U.S. 159 (1995) (holding single colors can be trademarks).

9 TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001).

Non-traditional marks that lack inherent distinctiveness, such as color, scent, shape, and flavor/taste marks, require proof of acquired distinctiveness for registration on the Principal Register. For example, General Mills' application for the color yellow for its Cheerios cereal was denied by the TTAB due to the widespread use of yellow-packaged cereals from various sources.[10] Sound, motion, and touch marks could be inherently distinctive and might not need such proof.

To register a sound mark with the USPTO, an applicant has to show that its mark has "[assumed] a definitive shape or arrangement" and "creates in the hearer's mind an association of the sound" with a good or service.[11] The same section further distinguishes between "unique, different or distinctive sounds" and sounds that are more "commonplace." Commonplace sound marks "include goods that produce sound in their normal course of operation (e.g., alarm clocks, appliances with audible alarms or signals, telephones, and personal security alarms)."[12] This clarification does not imply that commonplace sound marks are inherently unprotectable. Rather, Federal trademark registrations for commonplace sound marks can generally be obtained if the applicant demonstrates that the commonplace sound mark has acquired distinctiveness under Section 2(f) of the Lanham Act. See, for example, U.S. Reg. No. 2712396 covering the sound of Federal Signal Corporation's sirens.

In the United States, sound marks have long been recognized as registrable source identifiers. For example, the National Broadcasting Company (NBC) obtained registration for a sound mark (U.S. Reg. No. 0523616) covering radio broadcast services in 1950 (claiming first use in 1927). Other sound mark examples include AOL's "You've Got Mail" greeting (U.S. Reg. No. 2821863), MGM's iconic lion roar (U.S. Reg. No. 1395550), T-Mobile's jingle (U.S. Reg. No. 2459405), McDonald's five-note "I'm Lovin' It" jingle (U.S. Reg. No. 3034331), and Duracell's three-note "slamtone" (U.S. Reg. No. 7215662).

Counsel advises that the band cannot simply claim trademark rights in one of their songs, as the sound itself is the service offered and thus does not function as a source identifier. However, if the sound is used in the promotion of its beverages, it can likely be registered.

Consumers may also come to use the look and feel of unusual motions associated with a product as a trademark. For example, Lamborghini successfully registered as a trademark for "the unique motion in which the door of a vehicle is opened (U.S. Reg. No. 2793439). For a motion mark, the USPTO requires that the drawing accurately and sufficiently depict the motion so as to show how the motion is used in connection with the goods or services. In Lamborghini's case, the carmaker submitted four freeze frames drawings depicting the doors at different intervals of the motion. In another example, Yamaha registered the motion of a three-dimensional spray of water issuing from the rear of jet-propelled watercraft with a claim of acquired distinctiveness (U.S. Reg. No. 1946170). Could the band's signature dance move be protected as a trademark? Most likely not because, unlike Lamborghini's or Yamaha's motion marks, the band's dance moves do not serve as a source identifier because the dance itself is part of the service that's offered to the concertgoers.

What about registering the scent that is released as part of the smoke and light show during the band's performances? With a showing of acquired distinctiveness, the band could potentially succeed. For example, Le Vian Corp. registered the scent of chocolate for jewelry stores (U.S. Reg. No. 4966487); Hasbro successfully demonstrated to the USPTO that the scent for its PLAY-DOH product had acquired consumer secondary meaning through its exclusive and continued use since 1955 (U.S. Reg. No. 5467089). Similarly, Grendene S.A. proved that its bubble gum-scented MELISSA sandals possessed secondary meaning and could be registered as a trademark (U.S. Reg. No. 4754435). It offered twenty-six exhibits showing advertising highlighting the scent, as well as nationwide media coverage of this unique olfactory feature.

After providing this overview to the band, their counsel advised that, while Obsidian Flames would likely face a substantial challenge in proving their sensory mark(s) are nonfunctional, inherently distinctive, and/or have acquired secondary meaning, the benefits of owning a distinctive sensory mark are significant. Sensory features such as smells, sounds, and motions can differentiate a product from competitors and make it instantly recognizable to consumers. As shown by successful cases, overcoming this challenge is possible. By emphasizing the sensory mark in advertising, so consumers associate the specific sound, scent, or motion with the product, the band will increase its chances of establishing secondary meaning. To pass the functionality test, it's essential to avoid claims that the sensory feature has utilitarian value.

IV. Recent Trends in Trademark Practice

Having gone through the trademark registration process, adversarial proceedings, as well as having gained familiarity with non-traditional marks, the band's counsel then found it prudent to advise them of recent developments in the USPTO's practice, particularly since these changes may affect Madrid registrants.

Counsel first notes that false claims of use of a mark may invalidate the entire registration. As such, when the time comes for Obsidian Flames to show

10 In re General Mills IP Holdings II, LLC, Serial No. 86/757,390, August 22, 2017.

11 TMEP § 1202.15.

12 *Ibid.*

use of their mark, they should not attempt to cling to every item listed in their trademark registrations, which – as is often the case with marks registered through the Madrid Protocol – contain a rather long list of goods and services. This is particularly important since the USPTO expanded its audit program in late 2024, hoping to crack down on the ever-increasing problem of overbroad trademark registrations and fake specimens of use.

As indicated above, the U.S. trademark system is at its core a use-based system. During a mark's registration, although a specimen of use is required for domestic applicants (Madrid applicants do not have to show use to attain registration), only a single specimen is required per class, regardless of how many goods or services are listed in that class. Once a mark is registered, the United States requires that trademark owners (including owners of registrations filed through the Madrid protocol) periodically demonstrate that their marks remain in active use to avoid cancellation of their registration. This policy aims to keep the trademark register relatively free of registrations for marks not actually used in U.S. commerce. Nevertheless, many registrants try to keep their registrations alive in connection with *all* of the goods or services listed in the registration certificate, even though in reality the mark may have only been used for *some* of those goods or services. Some registrants even go so far as to submit digitally created or altered mockups of specimens or e-commerce websites created solely for the purpose of generating specimens to subvert the USPTO's requirement to show use of a mark in commerce, also known as "specimen farms."

If declaration of use filings under Sections 8 and 71 appear to contain digitally altered specimens or printouts from a specimen farm, the USPTO will issue an initial office action to request proof of use for some or all of the goods or services covered by the registration, and may further request any additional information deemed relevant, especially for post-registration maintenance documents exhibiting signs of fraudulent or digitally manipulated specimens.

The key takeaway for the band is that they should delete all items that are no longer being used when filing a declaration of use under Sections 8 or 71 and keep only the goods and services they are actively using in U.S. commerce to avoid cancellation of the entire registration.

V. Conclusion

Obsidian Flames' journey through the U.S. trademark system illustrates the complexities and nuances faced by trademark applicants. By strategically navigating the registration process, addressing non-traditional trademarks, overcoming oppositions, and adapting to recent trends, the band is well on its way to building a solid trademark portfolio. Their experience serves as a valuable guide for trademark law practitioners and underscores the critical role of both advance planning and precise documentation in achieving trademark success.