DO TRADEMARK LAWYERS MATTER?

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This Article empirically examines whether lawyers make a difference in prosecuting trademark applications, and if so, how much. Working from a wealth of data the USPTO released in 2012, we examine the twenty-five year period of 1985-2010 to determine how much legal counsel matters in various stages of the trademark application process. First, we show how trademark publication and registration rates changed. Against that background, we examine how these rates differ if the applicant had legal counsel. By illustrating these differences over time, we show whether the USPTO has become more accommodating to pro se applicants.

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

Finally, this Article examines whether experience with the trademark application process impacts publication and registration rates. We categorize 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 populations in the data are experienced lawyers and inexperienced pro se applicants. Therefore, the Article concludes by analyzing how much a pro se applicant may improve its chances of registration by hiring an experienced trademark lawyer.