ASSESSING THE UTILITY OF CHATGPT AS A TRADEMARK PRACTICE TOOL

Artificial Intelligence Subcommittee of the Emerging Issues Committee

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Introduction

With the increasing popularity of generative AI tools like ChatGPT, there is growing interest in the trademark community as to how these tools can help supplement (or replace) elements of our practice. To understand the present capabilities and limitations, the Emerging Issues Artificial Intelligence Subcommittee analyzed the impact and viability of using ChatGPT to perform various trademark prosecution-related tasks, including: (i) drafting a trademark application, (ii) conducting a trademark clearance, and (iii) drafting a reply to an office action issuing a refusal based on descriptiveness. The AI Subcommittee conducted the exercise in China, the US, the UK, the EU, Canada, Austria, and Nigeria, in order to see whether ChatGPT would capture the jurisdictional nuances of different territories. To that end, across each task the AI Subcommittee used the same fictional children's toy – the "Etch Board" – to identify how the output differed when the input was effectively the same. Each contributor prepared a SWOT[1] (Strength, Weaknesses, Opportunities, and Threats) analysis for each exercise, in each territory. Those findings are summarized below.

Trademark Application:

Tested Jurisdictions: *US, China[2], and Colombia*

Strengths: Across all jurisdictions, ChatGPT provided a useful draft outline for a trademark application. The Class IDs were thorough and detailed, and ChatGPT effectively broadened or narrowed IDs when instructed to do so. In the US, ChatGPT's draft IDs closely followed the USPTO's ID Manual, and it provided a decision tree when asked whether there were other classes that should be considered. In each case, ChatGPT proved efficient, easy to use, and responsive to natural language prompts.

Weaknesses: As a threshold issue, ChatGPT is not available in Mainland China. In the US, ChatGPT's initial ID drafts were very narrow and specific (though, as mentioned above, ChatGPT did well broadening the IDs upon request). In both the US and Colombia, ChatGPT included information in the application that was either inaccurate or not prompted by the user.

[1] *SWOT analysis: What it is and how to use it* <https://asana.com/resources/swot-analysis>

[2] ChatGPT is not available in Mainland China. As such, the findings here are not specific to ChatGPT's effectiveness in drafting a trademark application, but rather, a SWOT analysis of ChatGPT's potential in the territory, generally.

Opportunities: Among the tasks tested in this exercise, ChatGPT provided the best results for application drafting. The decision tree approach ChatGPT provided to identify appropriate class registrations gives users an easy-to-follow path for creating the right filing strategy, useful for both practitioners and lay people. In the US, ChatGPT appeared to apply certain trademark office and registry information (at least to some degree). Elsewhere, ChatGPT's results conformed to more universal, general trademark practice points. If ChatGPT were to partner with trademark offices to provide complete and up-to-date guidelines and registry data, there is considerable potential as supplemental tool for application drafting.

Threats: Even where ChatGPT provided usable and accurate Class IDs, it did not vet the ID drafts against existing registrations, leaving open the possibility of suggesting conflicting or infringing goods and services. And as noted below, ChatGPT is not sufficiently capable of conducting reliable trademark searches in any jurisdiction. As such, even where ChatGPT is able to produce a compelling application, attorney consultation is necessary to avoid prosecution hurdles and potential infringement. Similarly, because ChatGPT is capable of drafting a seemingly-credible application to non-professionals, it is possible that trademark offices may experience an increase in filings that do not conform to applicable guidelines, creating an administrative burden. Finally, while the draft IDs were relatively accurate for this exercise (at least in the US), that may not be the case for all goods and services, particularly for new product lines and/or novel technologies.

Trademark Clearance:

Tested Jurisdictions: *Canada, Austria, Nigeria, and EUIPO*

Strengths: ChatGPT was consistently able to identify the appropriate class for a clearance (in this case, Class 28). While ChatGPT lacked access to registry information for every tested jurisdiction, in some cases (depending on the prompt), it was able to provide a functional, basic template for a search report, including: (i) the framework for an analysis of potentially conflicting trademarks, (ii) a comparison of goods and services, and (iii) a corresponding risk assessment. ChatGPT was also able to identify where and how the user could conduct the search on their own, and/or provided general issues to consider in conducting a clearance search. In some cases (again, depending on the prompt and jurisdiction), ChatGPT also provided instructions on how to register a trademark.

Weaknesses: ChatGPT was ultimately unable to provide usable clearance results for any jurisdiction, as it lacked access to up-to-date registry information, and has limited potential value in territories that require a manual search, like Nigeria. Without registry information, any utility (from a clearance perspective) is restricted to users with little to no trademark experience, as practitioners would already be familiar with the limited, general information ChatGPT currently provides.

Opportunities: ChatGPT is already capable of providing easily accessible and cost-effective educational and functional resources (i.e., templates, instructions, general registry information, and basic trademark guidance). In jurisdictions that have online trademark databases, ChatGPT showed the potential to provide a starting point for a sufficient clearance search, based on the template framework mentioned above. However, clearance results would likely need careful oversight from a practitioner, given that ChatGPT consistently returned incomplete and inaccurate information.

Threats: In Austria, ChatGPT returned example results in the clearance search that did not actually exist in the Austrian Trademark Register. While ChatGPT did offer disclaimers noting that it lacked any specific registry access and information, and that any results were purely theoretical, it's possible that a novice user might draw false or inaccurate conclusions from the response. Similarly, in Nigeria, while ChatGPT attempted to provide resources to an official registry site to conduct a manual search, the information and website were inaccurate.

Office Action Response:

Tested Jurisdictions: *UK, Canada, Austria, Nigeria, and EUIPO*

Strengths: ChatGPT provided a good structure for a draft office action response, usable across most tested jurisdictions. Generated responses were quick and appropriately responsive to natural language prompts, proving very easy to use. ChatGPT suggested applicable arguments that considered use, likelihood of confusion, and acquired distinctiveness. When prompted, it also effectively modified its response based on the user's request (including addressing additional topics for argument), and added citations when asked to do so. The draft response was well-structured, and English-language responses read naturally (as though it was human-authored).

Weaknesses: Unless prompted, ChatGPT did not support arguments with citations. In multiple jurisdictions, when prompted, ChatGPT cited non-existent decisions or statutes. In certain cases where the cited references were real, ChatGPT did not accurately describe applicable facts or law, and failed to identify the correct court. In addition to inaccurate citations, the responses provided by ChatGPT did not conform to local requirements in both form and content. Inconsistency was also a problem – depending on how the prompt was framed, ChatGPT returned a range of different responses, some much better than others. Users from non-English speaking territories noted that ChatGPT's responses appeared to be translated from English, and did not read like natural language. Further, while the arguments ChatGPT presented were on-point, they lacked sophistication and nuance, and did not rise to the level of a trademark practitioner. In some jurisdictions, ChatGPT failed to apply basic local legal principles, leaving the substance of the draft unusable.

Opportunities: As with application drafting, ChatGPT provides some utility in providing a starting point or outline for a draft office action response. It can propose responsive arguments, though they will need to be independently researched and cited. And again,

with access to up-to-date registry information and precedent, in time, ChatGPT may be able to substantively respond to simple office actions.

Threats: The biggest threat in using ChatGPT for this sort of exercise is the user's over-reliance on the generated response. As noted, the information provided is not accurate enough to be dependable. Without verification, submitting a response with inaccurate or invented citations could result in a failure to successfully overcome refusal, and (in some cases) may even lead to sanctions for trademark professionals. This is a particularly relevant threat for non-practitioners looking to use a tool like ChatGPT to prosecute their own trademark applications, and may not have the experience or understanding necessary to identify false, contradictory, or inadequate arguments and information.

Conclusion

ChatGPT shows promise as a resource for trademark professionals, and has present value as a cost-effective educational resource for non-practitioners. It can provide users with serviceable initial drafts, outline the necessary steps from clearance to registration, provide a framework to move through the prosecution process, and help brainstorm relevant considerations along the way (i.e., which classes to include in a trademark application, which arguments to put forth in an office action response).

That said, in its current state ChatGPT is not capable of reliably conducting any of the tested exercises on its own. It is not available in all territories, and there is considerable variance in the scope of relevant underlying data across jurisdictions. Even in regions where more comprehensive data is available (like the US), it was not sufficiently current or complete to rely on for a clearance search, application, or office action response. Similarly, the usefulness of the output was highly dependent on the prompt – different inputs steering toward the same goal produced a wide range of responses. ChatGPT will need to both consider and relay complete and current trademark data within a given jurisdiction, and provide more uniform and accurate responses, before it is a reliable supplemental practice tool for practitioners.

While that future does not seem far off given the speed at which generative AI continues to evolve, and feasible with deliberate partnership from trademark offices and registries, it is harder to envision a scenario where AI tools like ChatGPT completely replace trademark attorneys and legal professionals. ChatGPT's ability to quickly parse through enormous amounts of data and draw relevant connections in that data point toward its potential as an innovative practice tool that could make the underlying work involved in trademark prosecution practice much more efficient, and could open certain basic functions up to non-experts. But it lacks the ability of specialized practitioners to consider nuances in the law, needs of their clients, and the practical risk assessments that drive effective trademark counsel at the prosecution stage.