

From PLI's Course Handbook

*Navigating Trademark Practice Before the PTO 2006: From Filing
Through the TTAB Hearing*

#8848

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**TRADEMARK TRIAL AND
APPEAL BOARD PRACTICE**

Rany Simms
*Former Administrative Trademark
Judge
Trademark Trial and Appeal Board*

Presented by:
Hon. J. David Sams
Hon. Charles Bottorff
Hon. Carlisle Walters
Trademark Trial and Appeal Board

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*Navigating Trademark Practice Before
the PTO 2005: From Filing Through
the TTAB Hearing* (Order #6025)

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I. GENERAL INFORMATION

A. Composition of Board

1. Sixteen Administrative Trademark Judges—David Sams, Rany Simms, Robert Cissel, Ellen Seeherman, Timothy Hanak, Jeffrey Quinn, Douglas Hohein, Paula Hairston, Carlisle Walters, Beth Chapman, Helen Wendel, David Bucher, Charles Bottorff, Terry Holtzman, Gerard Rogers and Al Drost
2. Sixteen Interlocutory Attorneys—Jyll Taylor, Linda Skoro, Cheryl Butler, Albert Zervas, Thomas Wellington, Cindy Greenbaum, Karen Kuhlke, David Mermelstein, Frances Wolfson, Peter Cataldo, Andrew Baxley, Karyn Ryan, Nancy Omelko, Angela Lykos, Elizabeth Dunn and Cheryl Goodman

B. Jurisdiction of the Board

1. Trials—Oppositions, Cancellations and Concurrent Use Proceedings
 - a. Oppositions brought within 30 days of publication or within an extension of time
 - b. Cancellations
 - (1) Within five years on all grounds available
 - (2) At any time on grounds specified in Sec. 14(3) or (5), or against Supplemental Register registration
 - c. Concurrent Use proceedings—applicant seeks registration restricted as to mode or place of use
2. Appeals (see below)

II. PLEADINGS

A. Standing

1. For likelihood of confusion, real commercial interest in mark; an application that has been refused registration because of defendant's registration; bona fide intent to

use the same mark; defendant has asserted likelihood of confusion vs. plaintiff's mark in another proceeding

2. For descriptiveness, an interest in using the term descriptively
3. If you have standing for one ground, then you may assert any available ground

B. Grounds

1. Likelihood of confusion (and priority)—Section 2(d)
 - a. Ownership of a registration or prior use of an unregistered mark or trade name
 - b. Ownership of a prior filed application (subject to registration) *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991)
 - c. Prior use analogous to trademark use—*T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996)
 - d. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) is seminal case
2. Mere Descriptiveness—Section 2(e)(1)
3. Abandonment
 - a. Nonuse for three years is now prima facie abandonment. See Sec. 45 definition
 - b. Course of conduct by defendant causing mark to lose its significance as a mark
4. Fraud
 - a. Must be asserted with particularity (Fed. R. Civ. P. 9 (b))
 - b. Includes fraud in filing affidavits under Secs. 8, 9 and 15

5. False Suggestion of a Connection—Section 2(a)
 - a. Often raised after Principal Register registration is over five years old
 - b. Plead that defendant’s mark falsely suggests a connection with plaintiff or its persona

POINTER: DO NOT USE THIS AS A SUBSTITUTE FOR LIKELIHOOD OF CONFUSION—IT IS DIFFERENT

C. Filed in duplicate

D. Answer

1. Assert defenses and counterclaims (if known) at this time
 - a. Availability of laches and acquiescence limited in oppositions. *National Cable Television Inc. v. America Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991)
 - b. Assert defense that defendant is entitled to a registration with a particular restriction. See Sec. 18

III. MOTIONS

A. Concerning Pleadings

1. Motions to dismiss for failure to state a claim
 - a. Should be brought before or at time of filing of answer

POINTER: IF CONFRONTED WITH TRUE FED. R. CIV. P. 12(b)(6) MOTION, DON’T RESPOND BY ARGUING MERITS OF CASE BUT RATHER WHETHER PLEADED CLAIM IS SUFFICIENT. IF YOU REALIZE YOUR PLEADING IS DEFICIENT, SUBMIT AMENDED PLEADING

- b. Includes motion that defendant owns a previously registered mark on the Principal Register for the same or substantially identical goods or services (but motion will be treated as motion for summary judgment)

- (1) Defense not available where grounds are descriptiveness, ornamentation, fraud or abandonment
2. Motions to strike—Fed. R. Civ. P. 12(f)
 - a. Allegations concerning unfair competition and anti-trust violations are irrelevant
3. Motions to amend pleading under Fed. R. Civ. P. 15(a)
4. Motions for default judgment (for failure to answer)
5. Motions for judgment on the pleadings

B. Motions to extend (good cause) and reopen (excusable neglect)

POINTER: WE GRANT ONLY WHAT IS ASKED. IF YOU WANT THE DISCOVERY PERIOD TO BE EXTENDED ALONG WITH YOUR TIME TO ANSWER OUTSTANDING DISCOVERY REQUESTS, ASK FOR IT

POINTER: CONSENTED MOTIONS TO EXTEND AND STIPULATIONS EXTENDING TIME SHOULD BE FILED IN TRIPLICATE. HOWEVER, THE BOARD DOES NOT REQUIRE OR WANT EXTRA COPIES OF MOTIONS OR OTHER PAPERS, INCLUDING DISCOVERY

C. Motions to suspend

1. For settlement
2. Pending civil litigation

D. Motions to consolidate

POINTER: INFORM US OF RELATED CASES AND MOVE TO CONSOLIDATE UNDER FED. R. CIV. P. 42(a) ONCE ISSUES ARE JOINED

E. Motions to compel

1. Must be supported by a statement that moving party has made good faith effort, by conference or correspondence, to resolve issues raised by motion

2. Does not have to be filed within discovery period but must be filed before testimony opens

POINTER: REMEMBER THAT IF YOU CONSENT TO AN EXTENSION OF TIME TO ANSWER DISCOVERY REQUESTS, MAKE SURE THE ANSWERS ARE DUE BEFORE TESTIMONY OPENS, SO THAT YOU CAN MOVE TO COMPEL IF THEY ARE DEFICIENT

F. Motions for summary judgment

1. Should be filed prior to opening of first testimony period, as originally set or as reset
2. May use Fed. R. Civ. P. 56(f) if party opposing motion needs discovery in order to respond to motion on the merits. This motion must be filed within 30 days of service

POINTER: BE SURE YOU ARE MOVING ON A PLEADED GROUND

POINTER: IF YOU ARE THE PLAINTIFF, BE SURE THAT YOU ALSO PROVE YOUR STANDING ON SUMMARY JUDGMENT

POINTER: IF YOU ARE OPPOSING A MOTION FOR SUMMARY JUDGMENT, BE SURE TO SET FORTH THE GENUINE ISSUES OF FACT THAT YOU BELIEVE ARE IN DISPUTE. IF YOU BELIEVE THERE ARE FACTS IN DISPUTE, SUBMIT EVIDENTIARY SUPPORT SHOWING THEY ARE IN DISPUTE

POINTER: MOST OF THESE MOTIONS ARE DENIED

G. Motions to restrict under Section 18

1. Defendant requests that, if Board determines that defendant is not entitled to registration without a restriction, application or registration be amended

POINTER: BE SURE THAT THIS REQUEST IS MADE EARLY SO AS TO GIVE THE PLAINTIFF ADEQUATE NOTICE

H. Motions for judgment under Rule 2.132

1. Where plaintiff has failed to take testimony or offer other evidence during its testimony period—Rule 2.132(a)
2. Where plaintiff has offered no evidence other than PTO records, typically status and title copies of its pleaded registrations—Rule 2.132(b)
3. Board does not entertain any other motions for judgment relating to sufficiency of trial evidence

POINTER: DO NOT FILE A MOTION FOR DIRECTED VERDICT

IV. DISCOVERY

A. Generally, Federal Rules of Civil Procedure apply but the automatic disclosure provisions, as amended Dec. 1, 1993, are not applied in Board proceedings

B. Generally, we apply the goose-gander rule—a party may not be heard to argue that a discovery request is proper when propounded by it but improper when propounded by its opponent

C. Specific discovery matters

1. The discovery deposition of a person residing in a foreign country who is a party or an officer, director or managing agent thereof shall be taken by written questions unless the Board, on motion for good cause, or the parties, stipulate that the deposition be taken by oral examination—Rule 2.120(c)(1); *Orion Group In. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989)
2. Upon stipulation or motion, a deposition may be taken or attended by telephone

3. Interrogatories, counting subparts, may not exceed 75, except the Board may allow more upon a showing of good cause or on stipulation
 - a. Board counts each subpart within an interrogatory as a separate interrogatory

POINTER: REMEMBER TO RESERVE SOME PORTION OF THE 75 FOR FOLLOW-UP DISCOVERY

4. Interrogatories and other discovery requests may be served through the last day of the discovery period, even though responses will not be due until after the discovery period has closed

POINTER: USE REQUESTS FOR ADMISSION TO HELP PROVE YOUR CASE

5. If you indicate in discovery response that you do not have information or documents sought or object to the request, you may be barred from later introducing as part of your evidence the information or documents sought (provided that the opposing party objects)

V. TESTIMONY

A. Fruits of discovery offered into evidence by adverse party's notice of reliance—Rule 2.120(j)(1)

1. Exception is that if fewer than all of the discovery responses are offered in evidence, the responding party may introduce under a notice of reliance any other responses which should in fairness be considered so as to not make misleading what was offered by the inquiring party (but responding party should support notice with written statement explaining why it needs to rely on additional discovery)
2. Documents produced by adversary in response to request for production may not generally be made of record by notice of reliance (except to the extent they may be admissible under another provision). Some of the ways they may be introduced:

- a. Discovering party may serve requests for admission of the authenticity of the documents, and then rely upon the responses thereto along with documents
- b. Offer them in evidence as exhibits in connection with taking of discovery deposition
- c. Take the testimony of adversary as an adverse witness during own testimony period and introduce the documents as exhibits
- d. Combine the request for production with notice of taking discovery deposition
- e. If documents are provided as part of answers to interrogatories, they may be relied on as interrogatory answers by notice
- f. By agreement of the parties

POINTER: RELY ON ONLY THOSE PARTS OF DISCOVERY RESPONSES OR DISCOVERY DEPOSITIONS THAT ARE RELEVANT TO YOUR CASE. DONT PROVE YOUR OPPONENT’S CASE!

POINTER: REMEMBER THAT EXHIBITS ATTACHED TO PLEADINGS OR SUBMITTED ON SUMMARY JUDGMENT ARE NOT PART OF THE EVIDENTIARY RECORD AT FINAL DECISION, WITH ONE EXCEPTION (STATUS AND TITLE COPY OF REGISTRATION SUBMITTED WITH PLEADING)

B. Testimony

1. Subpoena may be necessary to secure attendance of unwilling adverse or nonparty witness—*Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990)
2. Testimony deposition taken in a foreign country must be taken upon written questions unless the Board, on motion for good cause, orders that deposition be taken orally, or parties so stipulate—Rule 2.123(a)(2)

3. By stipulation, testimony of a witness may be submitted in affidavit form—Rule 2.123(b)
4. On stipulation or on motion granted by Board, a deposition may be taken or attended by telephone

C. Registrations

1. Of record if Office status and title copies are attached to the pleading

POINTER: THIS IS THE ONLY CASE WHERE EXHIBITS ATTACHED TO PLEADINGS ARE OF RECORD

2. By notice of reliance on Office status and title copy filed during testimony period
3. By introduction as an exhibit during the testimony of a knowledgeable witness

D. Printed publications and official records made of record by notice—Rule 2.122(e)

POINTER: REMEMBER THAT ARGUMENT DOES NOT EQUAL EVIDENCE. IF YOU PLAN TO ARGUE A POINT, SUPPORT IT WITH EVIDENCE

VI. BRIEFS

- A. Main brief limited to 55 pages in its entirety and reply brief limited to 25 pages in its entirety—Rule 2.128(b)**

POINTER: FINAL BRIEFS (EXCEPT IN EX PARTE APPEALS) SHOULD BE FILED IN TRIPPLICATE

POINTER: DON'T MISSTATE THE FACTS. YOU WILL LOSE CREDIBILITY.

VII. ORAL ARGUMENT

- A. Request by separate paper filed not later than ten days after due date for reply brief**

(The Board rarely conducts oral hearings on motions)

POINTER: CONCEDE WEAK POINTS AND DON'T PRESS A LOSING ARGUMENT. FOR EXAMPLE, DON'T ARGUE THAT YOUR SHIRTS ARE SOLD IN DIFFERENT CHANNELS OF TRADE FROM PLAINTIFF'S PANTS UNLESS THE DESCRIPTIONS OF GOODS IN THE RESPECTIVE APPLICATION AND REGISTRATION ARE SO RESTRICTED. ARGUE YOUR STRONGEST POINTS

VIII. THE DECISION PROCESS

- A. How cases are assigned (randomly)**
- B. Length of time to decision (it's getting shorter)**
- C. Requests for reconsideration**
 - a. Must be filed within one month from date of decision—Rule 2.129(c)

POINTER: THINK CAREFULLY BEFORE FILING ONE—THEY ARE RARELY GRANTED AND THEY PERMIT THE BOARD TO SHORE UP ITS OPINION

- IX. APPEALS FROM BOARD DECISION ARE TO THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT OR BY WAY OF A CIVIL ACTION IN A U.S. DISTRICT COURT WITHIN TWO MONTHS—SECTION 21 AND RULE 2.145**

X. EX PARTE APPEALS TO THE BOARD FROM THE EXAMINING ATTORNEY

- A. Be sure case is ripe for appeal—repeated or final refusal or repeated requirement. Board has no jurisdiction to entertain premature appeal**
- B. Be sure issue is a proper one for the TTAB and not a petitionable matter for the Commissioner for Trademarks**
 - 1. Substantive matters are appealable
 - 2. Generally, petitionable if a nonfinal refusal on a procedural or technical requirement—Rule 2.146(a)(3)
- C. Filed within six months of the final or repeated refusal (may be accompanied by a request for reconsideration)**

POINTER: A REQUEST FOR RECONSIDERATION OF FINAL REFUSAL IS GENERALLY THE LAST TIME AN APPLICANT HAS TO INTRODUCE EVIDENCE (BUT BE CAREFUL—IT MAY BACKFIRE)

POINTER: IF APPROPRIATE, ARGUE IN THE ALTERNATIVE; FOR EXAMPLE, THAT YOU BELIEVE THAT YOUR MARK IS NOT MERELY DESCRIPTIVE BUT THAT, IF THE BOARD FINDS THAT IT IS, YOU BELIEVE THAT THE MARK HAS ACQUIRED DISTINCTIVENESS (WITH SUPPORT)

POINTER: APPEAL MUST BE ACCOMPANIED BY A FEE OR CASE WILL BE HELD ABANDONED

- D. Appeal brief is due within 60 days of the notice of appeal (unless a request for reconsideration is filed with the notice of appeal)**

POINTER: DOCKET THE BRIEF DUE DATE. DON'T RELY ON THE BOARD SENDING A NOTICE TELLING YOU WHEN YOUR BRIEF IS DUE

- E. Applicant’s reply brief is due within 20 days of the mailing of the Examining Attorney’s brief**
- F. Request for remand may be filed to introduce additional evidence—Rule 2.142(d)**
 - 1. Must show good cause, such as evidence not previously available, new attorney has taken over the case (not one firm member replacing another), or the Examining Attorney has agreed to the remand
 - 2. If granted, the Examining Attorney has opportunity to rebut newly submitted evidence
- G. Oral hearing (see VII. above)**
 - 1. Note that applicant has only 20 minutes total for argument (the Examining Attorney is allowed ten)—Rule 2.142(e)(3)
- H. Requests for reconsideration must be filed within one month of the decision**

POINTER: REMEMBER TO CHECK TO SEE IF THE CITED REGISTRATION IS STILL SUBSISTING

XI. MISCELLANEOUS

Important **excusable neglect** case—*Pumpkin, Ltd. v. The Seed Corps*, 42 USPQ2d 1582 (TTAB 1997)

Important **Section 18** case—*Eurostar, Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994)(to prevail on request for restriction in case involving likelihood of confusion, party must plead and prove that entry of the restriction will avoid likelihood of confusion and that opponent is not using mark on goods/services sought to be excluded by the restriction)

Discussion of **“use in commerce”** as amended by TLRA—*Paramount Pictures Corp. v. James E. White*, 31 USPQ2d 1768 (TTAB 1994)

Dilution—Note that dilution is now a ground for opposition and cancellation (see Sections 2, 13, 14 and 24) but it is not a ground for refusal by the Examining Attorney case. Can amend

pleading to assert dilution claim—Boral Ltd. v. FMC Corp., 59 USPQ2d 1701 (TTAB 2000). Recent important dilution case—Toro Company v. ToroHead, Inc., ___ USPQ2d ___ (TTAB December 12, 2001).

The Trademark Manual of Board Practice (TMBP) may be ordered from the Superintendent of Documents, U.S. Government Printing Office, at 202-512-1800. It is also available on the Internet at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp>.