

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Introduction to the Trademark Trial and Appeal Board (TTAB)

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Deputy Chief Administrative Trademark Judge

Trademark Trial and Appeal Board

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UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Board personnel

- Administrative Trademark Judges (24)
- Interlocutory Attorneys (19)
- Paralegals (10)
- Management, admin and support staff

# Jurisdiction of the Board

- Administrative tribunal under the Trademark Act of 1946 (Lanham Act)
- We determine trademark **REGISTRATION ONLY**
- **NOT:**
  - Trademark infringement
  - Copyright infringement
  - Unfair competition



# Administrative trademark judges

- Preside at oral hearings and issue final decisions on the merits of:
  - Appeals from trademark examining attorney refusals
  - Oppositions; cancellations, concurrent use proceedings
- Consult with interlocutory attorneys on dispositive motions

# Interlocutory attorneys

- Trial cases only
- Draft and issue orders
  - Contested dispositive motions – “signed” by judges
  - Contested non-dispositive motions – “signed” by attorney
  - May conduct phone conference on contested motion
- Participate in discovery conferences

# Paralegals

- Draft and issue orders in trial cases on consented and uncontested motions
- Draft and issue orders in appeal cases
- Extensions of time to oppose

# U.S. counsel rule – for all TTAB cases

- “An applicant, registrant, or party to a proceeding whose domicile is not located within the United States or its territories must be represented by an attorney” who is admitted before a state or district of the U.S.
  - Effective August 2019
- This applies to parties before the TTAB. *Cloudworks Consulting v. Ongoing Operations*, 2020 USPQ2d 10019 (TTAB 2020).



# Types of proceedings

- Appeal: Appeal from trademark examining attorney's refusal to register
- Opposition: Challenge by any party believing it would be damaged by registration of pending application
- Cancellation: Challenge by any party believing it would be damaged by existing registration
- Concurrent Use: Request for a geographically limited registration

# Ex parte appeals

- Appeal may be taken from any “final decision” (Final Office Action) of the trademark examining attorney
- Final Office Action = Second refusal on same grounds or repeated requirement -  
37 CFR § 2.141

# Oral hearing

- 10% of ex parte cases ready for decision request hearing
  - January 2, 2021: new fee for requesting oral hearing
- Heard by panel of three judges
- Trademark examining attorney will appear to represent Office
- Judges, examining attorneys, or applicants may attend remotely
  - Currently, everyone is attending remotely
- Oral argument limited to:
  - 20 minutes for applicant
  - 10 minutes for examining attorney

# Grounds for refusal - 15 U.S.C. § 1052(c)


## OBAMA PAJAMA

for pajamas:



- Board held: Refusal affirmed under Section 2(c) of the Trademark Act, which prevents registration of a mark that identifies “a particular living individual except by his written consent.” 15 U.S.C. § 1052(c).
- *In re Hoefflin*, 97 USPQ2d 1174 (TTAB 2010).

# 15 U.S.C. § 1052(e)(1): Merely descriptive

- If a word immediately conveys information about a good or service, it is merely descriptive, and can be used by all competitors. No one competitor can claim it.
- Applied for **SCOOP** for ice cream. Mascot:  

- Board: Merely describes a portion of ice cream: a scoop.

Affirmed refusal to register. ***In re Yarnell Ice Cream*, 2019 USPQ2d 265039 (TTAB 2019).**

# Generic

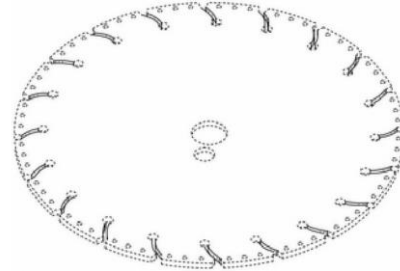
- The ultimate in descriptiveness, a generic term names a category of goods or services.
- Generic terms must be free for all to use.
- So when an applicant applied to register for medical treatment of allergies, the Board found that the words "**ALLERGY CARE**" were generic.
- Applicant was required to disclaim the words "**ALLERGY CARE**", and was allowed place the applied-for mark on the Supplemental Register, as its design was capable of becoming distinctive.



*In re Haden*, 2019 USPQ2d 467424 (TTAB 2019).

# 15 U.S.C. § 1052(e)(5): Functional

- Applicant applied to register a circular saw blade design as its trademark for circular saw blades:



The Board agreed with the examining attorney: the slot design on the periphery of the blade helped it cut better. Its function dictated its design.

So the refusal to register was affirmed. *In re MK Diamond Products*, 2020 USPQ2d 10882 (TTAB 2020).

# Failure to function as a trademark

- Matter that does not indicate the source or origin of the goods or services and distinguish them from those of others does not meet the statutory definition of a trademark and may not be registered.

15 U.S.C. § 1127.

- “.CAM” is a new generic top-level domain, short for “camera.”
- Board: “It also is clear from applicant’s website that .CAM is intended to be used by multiple parties as part of their domain names to identify multiple websites offering multiple goods and services.”
- So it failed to function as a mark for most goods and services.

*In re AC Webconnecting*, 2020 USPQ2d 11048 (TTAB 2020).



# Stages of an inter partes (trial) case

- Pleading – parties define issues in the case
- Discovery – parties exchange information
- Trial – parties present evidence
- Briefing/oral hearing – parties present arguments
- Post-trial – request reconsideration or appeal

# Oral hearing

- About 25% of inter partes cases ready for decision go to oral hearing
  - January 2, 2021: New fee for requesting oral hearing
- Before a 3-judge panel
- 30 minutes for each side
- No new evidence or testimony may be presented

# Final decision

- Sustain or dismiss opposition
- Grant or deny cancellation
  - Board cannot grant damages or issue injunctions, and does not award attorney fees
  - But TTAB proceedings are faster and less expensive than court litigation

# Who may oppose?

- Any person who believes they would be damaged by the registration of another's mark
- Injury must be real or potential, but not necessarily economic
- Timing – must be within publication period or an extension period

Trademark Act §§ 13, 14,  
15 U.S.C. §§ 1063, 1064



# 15 U.S.C. § 1052(a): False suggestion of a connection with a person or institution

- Trademark Act Section 2(a) (15 U.S.C. § 1052(a)).
- **FRANKS ANATRA**  
for food and drink



- **Under Section 2(a): falsely suggests a connection with Frank Sinatra.**
- *Frank Sinatra Enterprises v. Loizon*, **2012 Westlaw 4361418 (TTAB 2012).**

# 15 U.S.C. § 1052(d): Likely to cause confusion

- *Mark not registrable if likely to cause confusion among consumers with a trademark previously registered or used in the U.S.*  
--15 U.S.C. § 1052(d).
- Example: Applicant applied to register **RICHARD MAGAZINE** for a website for fashion and beauty products and presentations.
- Opposer owns a registration of **RICARDO** for kitchen utensils, publications and television programs in the culinary field.  
Board held: Even though **RICHARD** is the English for the Spanish **RICARDO**, consumers are not likely to stop and translate one to the other.  
Because the marks are dissimilar, the opposition was dismissed.
- *Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 (TTAB 2019).

# Dilution: 15 U.S.C. § 1125(c)

- Protects famous marks “widely recognized by the general consuming public” against dilution, impairing their distinctiveness.
- Broad protection across all International Classes of goods and services.
- Applicants applied for **JUST DREW IT** for athletic clothing.
- NIKE opposed based on **JUST DO IT** for clothing and other items.
- Board: **JUST DO IT** is a household name.
  - Enjoys the highest level of fame.
  - Became famous long before applicants applied for their mark.
  - Opposition sustained; registration refused.
- *Nike v. Caldwell*, 2020 Westlaw 3027610 (TTAB 2020).

# 15 U.S.C. § 1052(e)(2): Primarily geographically descriptive

- One business cannot monopolize a geographic name; its competitors get to use it, too.
- *Spiritline Cruises v. Tour Management Services*, 2020 USPQ2d 48324 (TTAB 2020) sustained a competitor's opposition to registration of CHARLESTON HARBOR TOURS for sightseeing tours.





# Abandonment

- Striatum registered:



- for software via the Madrid Protocol – extension of protection
- Wirecard petitioned to cancel based on abandonment.
  - A mark is abandoned “When its use has been discontinued with intent not to resume such use.”
  - “Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.”  
15 U.S.C. § 1127.
- But the Board found Striatum carried its burden of proving intent to commence use during the 3 years, through contracts directed toward a product launch in 2019. So not abandoned.

*Wirecard v. Striatum*, 2020 USPQ2d 10086 (TTAB 2020).

# Appeals from TTAB decisions

- Two options:
  - Federal Circuit – appeal on TTAB record
  - U.S. District Court – new trial
    - USPTO attorney fees no longer awarded in appeals of ex parte decisions to district court
    - Further appeal to regional Circuit Courts of Appeal
- **U.S. Supreme Court**
  - Discretionary review – rarely granted

# Recent Supreme Court decisions

- *Section 2(a): Disparaging* to persons or institutions

*Example: "THE SLANTS" for an Asian musical group.*



*Matal v. Tam*, 137 S.Ct. 1744, 122 USPQ2d 1757 (2017)  
(disparagement refusal unconstitutional; free speech).

# Recent Supreme Court decisions

- *Iancu v. Brunetti*, 139 S.Ct. 2294 (2019)
  - “FUCT” for athletic apparel refused as immoral/scandalous under 15 U.S.C. § 1052(a).
  - Supreme Court: Refusal is unconstitutional violation of free speech.
- *USPTO v. BOOKING.COM*, 140 S.Ct. 2298 (2020).
  - “BOOKING.COM” – refused as generic for booking reservations.
  - Supreme Court: Reversed - not per se generic.

