

UNITED STATES
PATENT AND TRADEMARK OFFICE



Introduction to the Trademark Trial and Appeal Board (TTAB)

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and

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Acting Deputy Chief Administrative Trademark Judge

Trademark Trial and Appeal Board

USPTO Hour



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

General information about TTAB

Limited jurisdiction

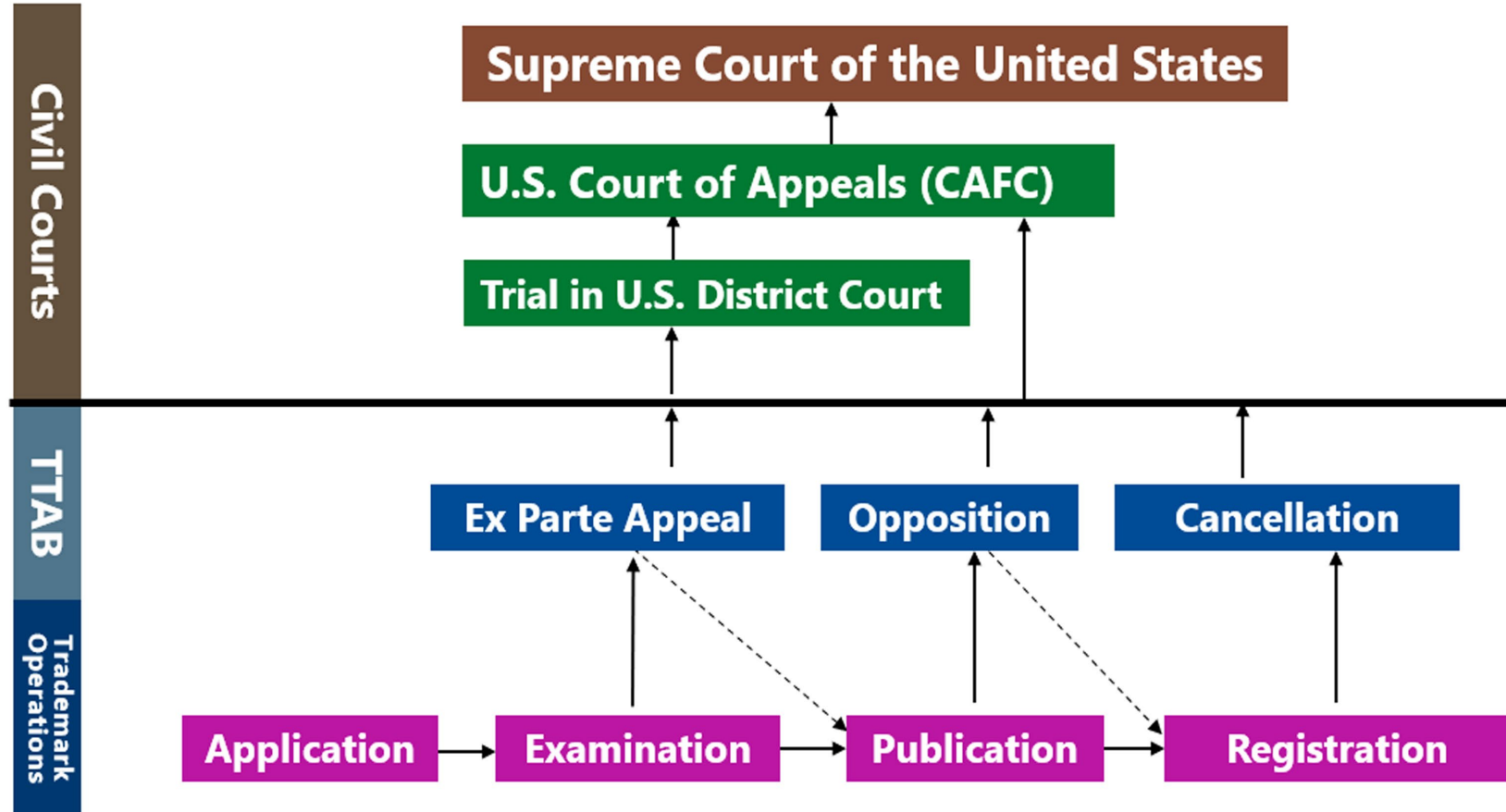
- Right to registration: TTAB considers only the right to registration, not the right to use
- Related issues: TTAB may not resolve related issues such as contract or licensing disputes
- Limited remedies: TTAB cannot award damages or attorney fees, or issue injunctions, etc.
- BUT administrative proceedings can be faster and less expensive



Types of proceedings

- **Ex parte appeals, applications:** Appeal from a trademark examining attorney's refusal to register a mark
- **Ex parte appeals, registrations:** Appeal from a final office action in an expungement or reexamination proceeding
- **Oppositions:** Challenge by any party believing it would be damaged by registration of a pending application
- **Cancellations:** Challenge by any party believing it would be damaged by an existing registration
- **Concurrent use:** Request for a geographically limited registration

Administrative proceedings



Meet the TTAB

Board personnel

- Chief Administrative Trademark Judge
- Deputy Chief Administrative Trademark Judge
- Senior Level attorney and Editor of the TTAB Manual of Procedure
- Managing Interlocutory Attorney
- Administrative Trademark Judges (22)
- Interlocutory Attorneys (15)
- Chief Clerk
- Lead Paralegal and Paralegals (10)
- Administrative Officer
- Administrative & technical staff (analytics and IT)

Administrative Trademark Judges

- **Final decisions:** Draft final decisions on merits of appeals, oppositions, cancellations, and concurrent use proceedings
- **Preside:** At hearings
- **Dispositive orders:** Review and approve orders on dispositive or potentially dispositive motions

Interlocutory Attorneys

- **Draft and issue orders on non-dispositive motions**
 - Discovery motions
 - Contested scheduling motions
 - Complicated uncontested motions
- **Draft orders on dispositive motions for approval by judges**
 - Motions for summary judgment
 - Motions for sanctions
 - Motions to dismiss

Paralegals

- **Draft and issue orders** on consented motions and uncontested motions
 - Extensions of time to oppose
 - Extension or suspension of proceedings
 - Stipulated dispositions
- **Draft orders for interlocutory attorney** signature
- **Draft and issue orders** on appeal cases
- **Docket** management

Client Services

- Information Specialists
 - **Answer public inquiries** by telephone and email about TTAB practice and electronic filing
 - 571-272-8500
 - TTABInfo@uspto.gov
- Hearing and Decision Specialist
- Supervisor



The rest of the TTAB team

- Chief Clerk
- Analytics and Information Technology
- Administrative Team
 - TTAB administration
 - Human capital
 - Budget and contracts
 - Telework, communications, and office space
 - Visual information

Ex parte appeals

Procedure: Ex parte appeals (1 of 2)

- Final refusal to register or second refusal on the same issue
- Must file an appeal within a set period from issuance of the final office action
 - Three months for an application
 - Optional three-month extension may be requested for a fee
 - Six months for a Madrid application (Trademark Act § 66(a))
 - Three months for a registration
 - Optional one-month extension may be requested for a fee
- Do not file both a notice of appeal and an extension request to respond following a final office action
 - May file notice of appeal and request for reconsideration simultaneously



Procedure: Ex parte appeals (2 of 2)

- Appellant and examining attorney submit briefs
- No new evidence permitted during appeal
- Appellant may request a hearing
 - In person or virtual

Grounds for refusal (1 of 4)

- Trademark Act Sections 1, 2, & 45
 - § 45 defines “trademark” and “service mark”
 - Word, name, symbol, or device, or any combination thereof
 - Used (or “bona fide intention to use”) in commerce
 - “[T]o identify and distinguish” goods or services from those of others and to indicate source
 - §§ 1, 2: only “trademarks” may be registered
 - § 3 makes §§ 1 & 2 applicable to “service marks”



Grounds for refusal (2 of 4)

- Common examples of § 1, 2, & 45 refusals
 - Applicant not the owner
 - Generic term (“antithesis of a trademark”)
 - Fails to function as “trademark” because evidence shows it is perceived as something else, e.g.,
 - “Merely informational” matter
 - Universal symbol
 - Title of single creative work
 - Identifies/distinguishes goods or services other than those listed in application
 - Model or grade designation only

Grounds for refusal (3 of 4)

- Trademark Act Section 2
 - § 2(a) Deceptive, false suggestion of connection
 - No longer immoral or scandalous
 - *Iancu v. Brunetti*, 139 S. Ct. 2294, 2019 USPQ2d 232043 (2019)
 - No longer disparaging
 - *Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017)
 - § 2(b) Government flag, coat of arms, insignia
 - § 2(c) Name or likeness of living individual
 - § 2(d) Likely to cause confusion as to source

Grounds for refusal (4 of 4)

- § 2(e)(1) - Merely descriptive or deceptively misdescriptive
- § 2(e)(2) - Primarily geographically descriptive
- § 2(e)(3) - Primarily geographically deceptively misdescriptive
- § 2(e)(4) - Primarily merely a surname
- § 2(e)(5) - Comprises matter that is functional

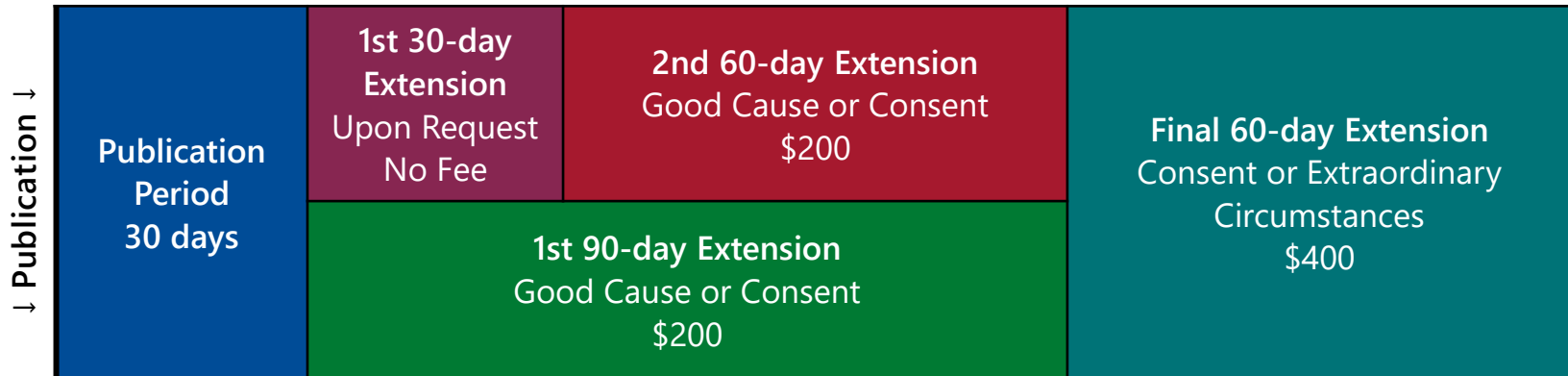
5 Do's and don'ts in appeals

- Do make a complete record during prosecution (including declarations)
- Do consider a different approach and refined arguments on appeal from those adopted and made during prosecution
- Don't argue the actual use of the involved marks in a Section 2(d) appeal except in the very rare circumstances in which that is appropriate
- Don't argue a *DuPont* factor in a Section 2(d) appeal where you have no good argument
- Don't attach any materials to your appeals briefs unless they are properly the subject of judicial notice

Inter partes (trial) proceedings

Publication for opposition and EOTs

- Official Gazette – published weekly
- Initial opposition period is 30 days
- Extensions of time to oppose (“EOTs”) may be granted to a maximum of 180 days from publication
- EOT fee is per application



Opposition: Filing

- Registration may be opposed by any entitled party which believes it would be damaged by registration
- Opposer must file a notice of opposition within thirty days of publication or within a granted extension of time to oppose
- Must include the filing fee, which is per class



Cancellation: Filing

Same as opposition but filed after registration

- **Filed within five years of registration** – Cancellation may be based on any ground for refusal
- **Filed after five years** – Certain grounds for cancellation unavailable, including common grounds such as likelihood of confusion and descriptiveness
 - Always available: genericness, functionality, abandonment, obtained by fraud
- **Must wait until three years after registration** – Expungement



Grounds to oppose/cancel

- Grounds and related provisions available in appeal and trial cases:
 - Trademark Act §§ 1, 2(a)-(e)
 - Trademark Act §§ 6 (disclaimers) & 23 (Supplemental Register)
 - Trademark Act § 45
- Additional grounds available in inter partes cases:
 - Non-use (Trademark Act § 1(a))
 - Lack of bona fide intent to use (Trademark Act § 1(b))
 - Abandonment (Trademark Act § 14(3))
 - Dilution (Trademark Act § 43(c))
 - Fraud (Fed. R. Civ. P. 9)

Applicable authority

Procedure: Federal Rules of Civil Procedure apply “wherever applicable and appropriate” and “[e]xcept as otherwise provided” in 37 C.F.R. Part 2

Substantive law:

- Trademark Act, 15 U.S.C. § 1051 et seq.
- Binding decisional law:
 - Registration decisions of the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit
 - TTAB decisions designated as precedents
 - Other federal court decisions potentially persuasive

Evidence: Unless stipulated otherwise, Federal Rules of Evidence, Title 28 U.S.C., and 37 C.F.R. Part 2 apply.



Inter partes timeline: Pleadings

- Pleadings define the issues in the case
- Complaint: Either a notice of opposition or petition for cancellation
 - Consists of a “short and plain” statement of
 - Entitlement to oppose or petition to cancel — reasons plaintiff believes it will be damaged by registration
 - Grounds — provide fair notice of the basis for each claim and be plausible
- Answer: Response to complaint
 - Affirmative defenses may be asserted
- Counterclaim: To cancel plaintiff’s pleaded registration(s)
 - Plaintiff allowed time to answer counterclaim



Pleading tips

- No need to outline entire case or evidence at the pleading stage
- Aside from pleaded registrations, exhibits to pleadings are not evidence at trial on behalf of the party to whose pleading they are attached
- Defenses must set forth sufficient facts to provide fair notice for the basis of each defense
- The time to act against an application runs from when the mark was published for opposition; laches and acquiescence are generally unavailable defenses in oppositions
- Some defenses are not available against all grounds. For example, equitable defenses are unavailable against claims of fraud, abandonment, genericness, and mere descriptiveness due to public interest

Inter partes timeline: Discovery

- **Discovery conference**
 - Topics: Discovery planning, Fed. R. Civ. P. 26(f)
 - Board participation may be upon request of one party or upon the Board's own discretion
- **Initial disclosures, Fed. R. Civ. P. 26(a)**
 - Individuals likely to have discoverable information
 - Documents which may be used to support claims or defenses
- **Discovery**
 - Interrogatory requests for written answers
 - Requests for production of documents or things
 - Depositions: Live testimony under oath
 - Requests for admission: Requests to admit facts
- **Expert disclosures**

Discovery tips

- Discovery in a Board proceeding is generally more narrow than discovery in district court
- Discovery requests must be served early enough so that responses will be due no later than the close of discovery
- The Board expects the parties to cooperate with one another in discovery and each party must make a good faith effort to meet the discovery needs of its adversary
- A party cannot file a motion to compel unless it has made a good faith effort to try to resolve the issue first; include copies of any emails or correspondence evidencing your good faith effort with your motion

Inter partes timeline: Trial

- **Pre-trial disclosures**
- **Plaintiff's trial period: 30 days**
 - Testimony: By deposition or affidavit
 - Notices of reliance: Only certain types of documentary evidence
 - Discovery materials: Rule 2.120(j)(3)(i)
 - Registrations: Rule 2.122(d)(2)
 - Printed publications and official records: Rule 2.122(e)
 - Trademark Rule 2.132 motions
- **Defendant's trial period: 30 days**
- **Rebuttal period: 15 days**
 - Limited to rebuttal of defendant's evidence

Trial tips

- Potential witnesses must be disclosed in pretrial disclosures (or timely supplementation)
- Prior to final decision, the Board will generally only strike evidence on procedural grounds where the issue can be resolved without a review of the evidence; substantive objections are resolved at final decision
- Raise substantive objections during an oral deposition and maintain in brief
- Raise substantive objections to a testimony affidavit or declaration by (1) serving objections and maintaining them in brief, or (2) filing a motion to strike by expiration of time to elect to take oral cross-examination.
 - Propounding party may then seek to reopen testimony period to correct deficiencies

Briefs

- Written arguments on law and facts
- No new evidence
- Attachments discouraged (and usually ignored)
- Page limits strictly enforced
- Cite to evidence by referring to TTABVUE docket entry and page numbers



Inter partes timeline: Briefing

- **Plaintiff's main brief**
 - 55 page maximum
 - Due 60 days after close of rebuttal testimony
- **Defendant's main brief**
 - 55 page maximum
 - Due 30 days after due date of plaintiff's brief
- **Plaintiff's rebuttal brief**
 - 25 page maximum
 - Due 15 days after due date of defendant's brief



Inter partes timeline: Hearing

- Scheduled only at the request of either party
- Attendance of non-requesting party not required
- Participation scheduled by video; in-person participation may be scheduled upon request
- Not a formal part of the record; no transcript or recording
- No new evidence or testimony at hearing
- In person or virtual

Decisions

- **Decision: The explanation of the Board's judgment**
 - Panel of three administrative judges
 - Requires consideration of all relevant evidence and arguments
 - Findings of fact and conclusions of law
 - A judge who disagrees with the result may write a dissenting opinion
 - A judge who agrees with the result, but not the reasoning of the majority, may write a concurring opinion

Abbreviated proceedings

- Motions to dismiss or for judgment on the pleadings, Fed. R. Civ. P. 12(b)(6) or 12(c)
 - When the facts alleged do not constitute legally sufficient grounds for relief, the proceeding may be dismissed
- Motion for summary judgment, Fed. R. Civ. P. 56
 - No genuine dispute of material fact
 - Movant is entitled to win as a matter of law
- Accelerated Case Resolution (ACR)
 - Similar to summary judgment, but the Board may determine disputed facts
 - Parties may agree to streamlining parameters

Alternative Dispute Resolution

- Negotiation
 - Parties may generally settle on any mutually agreeable terms
- Third-party dispute resolution
 - Arbitration
 - Mediation
- Extension/suspension: TTAB will suspend proceedings to allow settlement negotiation

Review of Board decisions

- **Judicial review of Board's decision**
 - Must be taken within sixty-three days of final decision
- **U.S. Court of Appeals for the Federal Circuit**
 - Appeal on the administrative record
 - Briefs and potentially oral argument
 - Deferential review of Board factfinding
- **United States District Court**
 - Administrative record admitted on request of either party
 - New testimony or evidence allowed
 - De novo review and possible trial (unless no new evidence or testimony)
 - Additional claims allowed in inter partes cases

5 Do's and don'ts in trial cases

- Do make pleaded registrations of record correctly
- Do establish your entitlement to the statutory cause of action (e.g., opposition or cancellation) on summary judgment or at trial
- Do refer to the record by citing to the TTABVUE docket entry and TTABVUE page number
- Don't provide unrelated or unnecessary background or argue the merits on a motion where not appropriate; stick to the issues pertinent to the motion before the Board
- Don't submit the same evidence twice

Updates from the TTAB

TTAB workload: Fiscal year 2024

- Appeals: 3,491
- Extensions of time to oppose: 17,765
- Oppositions: 6,651
- Cancellations: 2,475
- Concurrent Use: 36

Ex parte appeals

Fiscal year ending September 30, 2024

New appeals filed: 3491

Appeals terminated without formal decision: 3221

Final decisions issued: 357

Appeals pending: 1982

Oppositions and cancellations

- Fiscal year ending September 30, 2024
- New proceedings filed:
 - Oppositions: 6651
 - Cancellations: 2475
- Proceedings terminated
 - Without decisions: 8934
 - **Final decisions issued: 187**
- Proceedings pending: 7066

Pretrial Conference pilot program

- Commenced April 1, 2023
- Not intended for use in all (or even most) cases
- Cases are selected for inclusion in the program based on various factors, including overly large or unfocused records, unclear pleadings, contentious history, etc.
- After an initial orientation conference, parties prepare/submit a proposed final pretrial conference order using a model template provided by the Board
- Parties participate in final pretrial conferences before a Board judge and attorney
- The Board issue a final pretrial conference order governing trial



Preliminary results FY 24

- Five oppositions and four cancellations identified as pilot-worthy
- Three cases went to trial, one without FPC order but many stipulations, one via ACR, and one following bifurcation to try entitlement alone, before merits
- One case settled after orientation conference
- One case suspended for civil action
- Four cases have involved various conferences/orders

Useful resources

- Trademark Statute and Rules
 - <https://tfsr.uspto.gov/RDMS/TFSR/current>
 - Trademark Act of 1946 (as amended) — 15 USC § 1051, et seq.
 - Rules of Practice in Trademark Cases — 35 CFR § 2.1, et seq.
 - Representation of Others Before the USPTO — 35 CFR Parts 10 & 11
- Trademark Manual of Examining Procedure (TMEP)
 - <https://tmepp.uspto.gov/RDMS/TMEP/current>
- Trademark Trial and Appeal Board Manual of Procedure (TBMP)
 - <https://tbmp.uspto.gov/RDMS/TBMP/current>
- TTABVue (TTAB electronic dockets and case files)
 - <http://ttabvue.uspto.gov/ttabvue/>
- TTAB decision summaries at TTAB Reading Room
 - <https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions>
- Official Gazette of the USPTO
 - www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog

Other USPTO links

- USPTO home page
 - www.uspto.gov
- Trademark Examining Operations
 - www.uspto.gov/trademark
 - Search pending and registered trademarks (Trademark search)
 - File trademark applications and documents (TM Center & TEAS)
 - Check status and view trademark files (TSDR)
- Trademark Trial and Appeal Board
 - www.uspto.gov/ttab
 - File TTAB documents (TTAB Center & ESTTA)
 - View TTAB dockets and files (TTABVUE)
 - Statute and Rules
 - TTAB Manual (TBMP)



